

## **PATENT COOPERATION TREATY (PCT) WORKING GROUP**

**Third Session**  
**Geneva, June 14 to 18, 2010**

### **THIRD PARTY OBSERVATIONS SYSTEM**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. The Working Group is invited to comment on draft proposals for a system permitting third party observations to be made in the international phase. The observations would be made on an informal basis, without any specific new Rules, using a Web-based system. The results would be made available to Offices and the general public in a variety of different formats. The results would be used by designated Offices in the manner and to the extent which is considered appropriate under the relevant national law and by International Authorities (mainly the International Preliminary Examining Authority) to the extent which appeared justified in the context.

#### **BACKGROUND**

2. One of the key features of the PCT system is that it seeks to provide sufficient information relating to the prior art to meet several needs:
  - (a) to help the applicant decide whether it is worth pursuing the international application in the national phase in different States;
  - (b) to give designated and elected Offices a more complete picture of the prior art than most small Offices would be capable of discovering for themselves, so as to give them a good head-start in deciding whether the application meets the local requirements for grant of a valid patent; and

- (c) to help third parties assess the possible scope of patents which might be granted and consequently their risk of infringement if they pursue any particular course of action.
3. The most important aspect of work to ensure that this aim is met must be efforts to improve the quality of the international search, ensuring that the examiner in the International Searching Authority properly considers as wide a range of prior art as reasonably possible. However, it must be recognized that it is impossible for any examiner to perform a perfect search. Amongst many other difficulties, much prior art is simply not recorded in databases likely to be searched by an examiner in any Office. The people most likely to be aware of such prior art are likely to be commercial competitors of the applicant. Furthermore, it is possible that someone working in the relevant area may recognize the importance of a particular document which might not be immediately obvious to an examiner, even though it might be a patent document or other document forming part of his normal search collection.
  4. A number of patent systems have an explicit provision for third parties to make observations which can be taken into account by examiners. In general, this does not provide the third party with any special status in the application, as distinct from systems of opposition or invalidation proceedings where that person becomes a party to the action. A brief overview of some of these national third party observation systems is set out in Annex I, which also includes mention of the “peer-to-patent” pilot in the United States of America, where a community-based review is conducted and the best citations are referred on to the examiner for consideration. A similar pilot has also recently begun in Australia and similar projects are under consideration elsewhere.
  5. In the second session of the Working Group, document PCT/WG/2/3 proposed a review of a number of areas to ensure that the system delivered results which were useful to all Contracting States and interested parties. One of the concrete proposals was to develop a system for third party observations on novelty and inventive step to be furnished and made available to the International Preliminary Examining Authority and designated Offices. Such an arrangement would allow a low cost way for any person concerned about the validity of potential patent rights flowing from an international application to bring relevant prior art to the attention of Offices in many different designated States, reducing the risk of invalid patents being granted. This proposal was generally well-received in principle, subject to the need to review details carefully to ensure that it was sufficiently easy to use, did not interfere with existing national pre-grant opposition procedures or other aspects of national law and did not introduce unreasonable burdens on applicants or Offices.

## **KEY ISSUES**

6. The International Bureau sees the following as key issues in developing a third party observation system under the PCT which would both be useful and avoid introducing unreasonable burdens:
  - (a) The system must be easy to use for third parties who are aware of prior art which they believe is relevant to patentability under at least some of the national laws of PCT Contracting States.
  - (b) The system should not impinge on the right of national Offices to decide how to determine patentability in accordance with their national laws and should not prevent the effective use of national opposition systems.

- (c) The system should deliver information to Offices, applicants and third parties in ways which are appropriate to their differing needs.
  - (d) The system should minimize the risk of very large quantities of observations being made, such that it is difficult to identify citations which might be of greater relevance than others which had already been found.
  - (e) The system should not require applicants to respond to third party observations as such (of course, if an Office chose to use information from an observation in an examination report the applicant would need to respond just as to any other objection by the Office).
7. Other issues to consider include:
- (a) The permitted timing of observations in relation to the international publication date and the end of the international phase;
  - (b) whether anonymous observations should be permitted; and
  - (c) the relationship with other arrangements where comments on the application may be made, including informal observations by the applicant on the written opinion of the International Searching Authority, quality feedback from designated Offices (see also document PCT/MIA/17/3) and any arrangements for sharing of search and examination information from the various national phases of an international application.

#### **PROPOSED FEATURES OF THE SYSTEM**

8. In view of the great commonality of basic principles among existing national systems, it seems to be possible to identify most of the main features which should form part of any international arrangement. The differences lie essentially in matters of timing, fees and the extent to which comments are permitted which go beyond mere references to potentially relevant documents. Certain features will also need to be considered carefully on the basis of whether they might risk bringing unwarranted burdens on either applicants or Offices in certain circumstances.
9. Some of these main features of a proposed system are summarized in Annex II.
10. A system of this type does not appear to raise any risk of conflict with national laws, provided that:
- (a) it is made clear that Member States are under no obligation to give any special treatment to the observations made through the system – it is up to each national Office to decide whether to look at the observations and what to do with them in accordance with individual national laws and policy of the Office; and
  - (b) the system is sufficiently flexible as to allow national Offices to retrieve limited views of the information submitted, which are equivalent to what third parties are permitted to submit under their national laws, should this be considered appropriate in Offices whose national laws make strict restrictions on the permitted types of observation.

#### **Legal Framework**

11. It is proposed that a system should be developed on an informal basis with no special provisions in the Regulations or Administrative Instructions. It would be up to individual Offices to determine how the observations would be used (if at all) in the national phase.

12. In relation to international phase processing, submissions which had been made sufficiently early would be forwarded to the International Preliminary Examining Authority or to any International Searching Authority specified for supplementary international search. The International Search and Preliminary Examination Guidelines would initially merely encourage the Authority to consider the documents cited, but would not require any specific comment to be made on cited documents in reports and would not require consideration of all documents in cases where submissions were unclear, seemed likely to be irrelevant, or were too numerous to be considered efficiently. The guidelines would then be revised over time in the light of experience with the system.

### **Other General Principles**

13. It is proposed that the system should:
  - (a) *be free of charge to the person making observations*: To be beneficial to interested parties of all types from all Contracting States, the system needs to be easy to use and accessible; charging fees would make it significantly harder to use the system and could be a strong disincentive for individuals and small businesses to contribute information which might be useful – if there are concerns about abuse of the system or examiners being overwhelmed by observations, technical solutions should be used in preference to financial ones.
  - (b) *allow anonymous observations*: The important issue for an examiner is the quality of the citation, not the person who submitted it. To force a person to reveal their identity may reduce the use of the system, since a competitor may not wish to reveal its interest in a particular patent. It would also not be practical to demand the sender's identity, since the International Bureau would in most cases have no way of verifying whether any particular observation was in fact sent by the stated person or organization.
  - (c) *allow submissions in any PCT language of publication (with cited document titles in the language of their publication, whether that is a PCT language of publication or not)*: It is important that the system be practical for the International Bureau to support, but be easily accessible to as large a part of the world's population as possible. The International Bureau would not at present (assuming that this was to be a free service) be able to provide official translations of the submissions, but references to documents are essentially language-independent and it may be possible to provide machine translations in a limited range of languages for comments explaining the relevance of the document. The PCT languages of publication seem to offer an appropriate compromise between accessibility for people making observations and ease of support for providing useful information in languages which can be understood by national Offices.

### **References to Prior Art**

14. The system should allow the person making the observations to cite documents. To aid automated location of these documents by interested Offices, the citations should be entered in Web forms which encourage the entry of information in standard formats appropriate to the different types of patent and non-patent literature, based on WIPO Standard ST.14 and the related XML definitions in WIPO Standard ST.36.

15. The system should permit the applicant to identify specific relevant claims, relevant passages and make a brief commentary on the relevance of the document to the claimed invention.
16. Furthermore, the system should extend to providing references to documents which are not strictly prior art according to the PCT, but which provide evidence of earlier use or oral disclosures which might be relevant in some Contracting States, equivalent to the provision for such documents in PCT Rule 33.1(b) in relation to international search reports.

#### **Observations on Other Subjects**

17. Among the third party observation systems reviewed in Annex I, all except for that of the United States of America permit observations to be made on a variety of subjects pertaining to whether the application meets the standards of patentability according to the national laws. Noting that:
  - (a) according to the principles suggested above, it would be up to each individual Office to decide the extent to which observations are taken into account;
  - (b) a well-structured system would allow Offices to select to view only the specific types of content which they find relevant, as described below; and
  - (c) the development involved would be largely the same irrespective of the nature of comments to be permitted,

it is proposed that an initial implementation allow a third party to comment on any way in which the international application fails to meet the requirements of the Treaty or Regulations. This could assist in bringing a wide variety of alleged defects to the attention of any given Office in a manner which allowed it to sort the different types of comment from one another and use the comments in the manner which seemed most relevant to the processing of the particular application according to the practice of that Office.

#### **Timing of Observations**

18. In principle, the file of an international application is confidential until the date of international publication. Nevertheless, there are many ways in which a third party might become aware of an unpublished application even if he is not aware of the details. For example, the applicant might print the international application number in association with related products.
19. A number of national third party observation systems do not officially recognize observations which are made prior to the publication of the relevant application but nevertheless take the pragmatic approach of putting such observations in the file anyway, for consideration by the examiner when he next looks at the application (whether before or after publication). Under a system where observations are made only through a Web interface, it would be possible to prevent receipt of observations at all before publication, if this were considered appropriate. Furthermore, since most international applications claim 12 months priority, they tend to be published around 6 months after having been filed, which leaves less time than for many national applications to become known to third parties. Consequently, there may be less need to deal with this issue. Nevertheless, some consideration should be given to whether there might be a need for observations on unpublished international applications.

20. At the other end of the international phase, it needs to be considered whether there should be a final date by which observations need to be submitted. On one hand, at any time after 30 months from the priority date, it is likely that an application will start to enter the national phase. To the extent that Offices might want to have observations sent to them automatically as a single bulk transfer for each application, it is likely that such a transfer would contain only those observations received prior to that 30 month time limit. On the other hand, there is an increasing desire for Offices to seek access to as much information as possible which has become available at any time before their national search and examination begins, including national search reports from other Offices. In that respect, it may be desirable to allow observations to be made at a much later stage and, once again, it would be for national Offices to decide whether they should make any effort to check for new comments.
21. In view of the above, the system should, at least initially, accept observations at any time from the date of international publication, even if this is later than 30 months from the priority date. If an application number was entered which corresponded to an international application of priority date more than 30 months earlier, the third party would be warned that his comments would not be notified automatically to designated Offices and would only be seen by such Offices if they specifically looked for new observations.
22. Even if it is agreed that the system should not accept observations prior to the international publication date, it should seek to avoid building in assumptions which would prevent this feature being added later, should a need be shown.

#### **Technical Arrangements for Submission of Comments**

23. The system should accept comments through the use of Web forms, which encourage the submitter to present the relevant information in a structured manner, which can then be transformed into different types of output for the benefit of different users of the information. The screens would include templates for the types of bibliographic information for different types of patent and non-patent literature specified in WIPO Standard ST.14, as well as free text areas for inclusion of comments.
24. While a prototype would probably be prepared in a limited number of languages, it is envisaged that eventually the system would support interfaces for all of the 10 PCT languages of publication, with the assumption that information entered would either be in the original language (in the case of names of cited documents) or else the language of the interface.
25. To reduce the risk of excessive and/or irrelevant comments being made, the citations in a single observation by a person would be limited to a number to be decided, probably initially 10, and the free text areas would have a maximum number of permitted characters. Multiple or automated observations by the same person would be reduced by technical measures, such as:
  - (a) The use of "captcha" images before the submission form is shown, to reduce automated attacks on the system;
  - (b) measures against multiple submissions in quick succession from the same IP address; and
  - (c) other typical bulletin-board arrangements used to identify submission of "spam" messages.

26. It is expected that, at least until there was confidence that the system was being used responsibly, observations would be moderated by the International Bureau. This would extend only to a cursory check that the content was not clearly irrelevant or offensive and would not attempt to verify the accuracy of the citations or the relevance of the comments.
27. The system would not require the user to identify himself, though it would allow a name to be provided if desired. No check would be made on such names.
28. The system should permit the upload of documents by third parties in cases where there is a risk that the document might not be easily available to examiners. However, it is likely that such documents would not be made available to the general public, to reduce the risk of copyright issues.
29. If required, the system could also permit comments to be made on paper, using a form to encourage the information to be provided in the desired structure. It should be possible for the International Bureau to scan or transcribe such observations without an undue burden. In the event of mass campaigns, the International Bureau would reserve the right not to transcribe all submissions, but only a representative sample.

#### **Making the Observations Known to Applicants and Offices**

30. The applicant should be informed of all observations by means of an automatically generated letter or e-mail. However, in view of the fact that it can be costly in agents' fees simply to receive a letter, such mailings would only be made periodically (for example, no more than once a month) and would include details of all the observations which had been received during that period.
31. The system should be kept flexible in its ability to deliver information to Offices and third parties in different ways. It should certainly include the observations for download on demand from the PATENTSCOPE<sup>®</sup> Website entry for the particular international application (either manually, or using the Web services tools which permit automated access to the files of published international applications). The International Bureau would also consult with Offices as to whether the information needed to be made available in any other ways.
32. The information should be available to Offices (and also to any person looking at the file of the application through PATENTSCOPE<sup>®</sup>) in several different forms to serve different needs, including at least:
  - (a) A PDF or similar pure text view of all the collected comments for easy reading.
  - (b) An HTML view of at least the document citations, including hypertext links to the relevant documents to the extent that these can be automatically generated by PATENTSCOPE<sup>®</sup> (likely initially to be limited to those patent documents included in at least one of the major free patent databases).
  - (c) An XML version of the complete observations, marked up as far as possible using the same elements as are used in the international standards for XML search reports and written opinions, to allow easy integration of the citation data into lists of citations made by Offices.
  - (d) A list of only the cited documents, for use in Offices whose third party observation systems do not permit commentary on the relevance of the documents.

33. Examiners in national Offices would presumably simply read the observations and decide whether or not to raise objections based on that material in their national examination reports. However, noting that other Offices may also need to assess the value of particular observations, Offices may wish to give consideration to future arrangements allowing national Offices to give feedback indicating their views of the relevance of particular observations. On the other hand, a more efficient approach would probably be to ensure that national search and examination reports were themselves made more easily available to examiners from Offices dealing with the same application in a different national phase.

#### **Right of Response**

34. As noted in paragraph 6(e), above, the applicant should not be required to respond to any observation. If an Office wishes a particular point to be answered, the substance of the observation should be included in a national examination report (or, in some cases, an international report such as the written opinion of the International Preliminary Examining Authority). However, it would be appropriate for the applicant to have the option to rebut any observations in a way which is helpful to Offices viewing the observations.
35. The applicant already has the right to make informal comments on a written opinion of the International Searching Authority. It is proposed that a similar right be recognized for the case of third party observations. Initially, in view of the lack of any means of identifying the applicant from any other person online, this would probably be exercised by sending in comments as a letter. However, in the longer term, with the introduction of login systems at the International Bureau, the right of response should be permitted through a similar set of Web pages to those used for the third party observations.

#### **Relationship With Other Systems**

36. It is recalled that, at its sixteenth session, the Meeting of International Authorities (PCT/MIA/16) “agreed that the Secretariat should, in consultation with the Swedish Patent and Registration Office, develop more detailed proposed system requirements with a view to establishing an e-based feedback system [for designated Offices to comment on reports established by International Authorities], for consideration by the Meeting at its next session” (see paragraph 63 of document PCT/MIA/16/15). This issue is further considered in document PCT/WG/3/7.
37. It is also observed that many Offices processing national applications, including PCT national phase entries, desire to access search reports established by other Offices on family members. To the extent that arrangements for this are increasingly made, the system should seek to ensure that the formats in which the information is made available and the methods for automatically accessing the information should be compatible with combining citation information from third party observations with citation information from search reports, to ease access to potential prior art for consideration by examiners.



## DISCUSSIONS BY THE MEETING OF INTERNATIONAL AUTHORITIES (PCT/MIA/17)

38. The proposals set out in this document and its Annexes were discussed at the 17<sup>th</sup> session of the Meeting of International Authorities (PCT/MIA), held in Rio de Janeiro, Brazil, from February 9 to 11, 2010. The discussions of the Meeting of International Authorities are outlined in document PCT/MIA/17/12, paragraphs 63 to 66, reproduced in the following paragraphs:

### “Third Party Observations

- “63. Discussions were based on document PCT/MIA/17/2.
- “64. All Authorities which took the floor on the matter supported the principle of a third party observation system under the PCT, considering that this was a practical and effective method of allowing improvements in the information on which designated Offices took their decisions on whether to grant patents in the national phase. Depending on the timing of the observations and the establishment of the relevant reports, it might also improve the quality of some international reports. One Authority considered that a well designed international system should be significantly more used than most national systems.
- “65. Comments on details of the proposal included the following:
- “(a) It was important to ensure that the system minimized the risk of burden on examiners, particularly due to excessive numbers of citations being submitted.
- “(b) Observations should be available to examiners responsible for any international search report, supplementary international search report, written opinion or international preliminary report on patentability which had not yet been established.
- “(c) The use of any observations should remain at the discretion of the (national or international) examiner in all cases.
- “(d) The system must be as accessible as possible to third parties: providing the interface in all PCT languages of publication should assist this.
- “(e) Systems for notifying observations to applicants and Offices would need to be carefully considered to avoid complicating procedures. It may be necessary to allow different options to be selected.
- “(f) The observations should be free for all designated Offices and International Authorities to use and be made available through PATENTSCOPE<sup>®</sup> in a way which is easy to use.
- “(g) It may be desirable to introduce a basic system and conduct a pilot for 1 year to identify issues and modes of use before introducing further developments or providing for a specific legal basis.

“(h) Some International Authorities considered that observations should be permitted even after the beginning of the normal national phase. On the other hand, other Authorities considered that this might be detrimental to applicants since they should always have the opportunity (but not the obligation) to respond to comments, but late comments might be used as “harassment”. Furthermore, once the national phase had begun, the International Bureau might no longer know who the applicant was, since this would not necessarily be the same as during the international phase. In addition, there might be confusion if comments were possible by both a national and an international route at the same time.

“(i) Some International Authorities considered that there would be no difficulty in accepting observations before international publication and that it might be useful to feed such observations into the international search report. Others stated that such an option would need careful consideration.

“(j) While applicants should not be required to respond to observations simply because they have been made through the system, it should be clear that Offices can require any further information or comment as would be normal as part of their national processing.

“(k) Most International Authorities agreed with the proposal that the third party observation system should be operated on an informal basis, though one Authority considered that the introduction of a specific legal basis might give greater clarity to applicants and third parties.

“(l) While all International Authorities agreed that, for simplicity, there should be no fee for submission of observations initially, one Authority noted that it might be necessary to review this situation at a later stage depending on how the system was used.

“(m) While anonymous observations should be permitted, it should equally be possible to give a name when submitting observations.

“(n) The system should encourage the uploading of citations which might be difficult to obtain (including some patent citations which might not be readily available online): copyright issues would need to be considered, but would not be relevant in all cases and third parties might have the right to make the citations available in other cases.

“(o) The 2000 character limit shown in the mock-up screen in Annex II of document PCT/MIA/17/2 might not be considered to be a “brief” explanation of a document’s relevance.

“(p) Some Authorities considered that observations should be limited to novelty and inventive step since other issues varied too greatly between the national laws of Contracting States. On the other hand, it was observed that it would be difficult to prevent third parties from making comments on any subject in free text fields and that observations on any subject might be useful to an examiner.

“(q) It may be desirable to allow a specific area for third parties to provide translations of relevant sections of a document.

“(r) It would be important to record the date when an observation was made.

“(s) In terms of feedback on observations from designated Offices, it was likely that the most efficient mechanism would be for Offices to make their national reports available so that other Offices could see which documents were actually cited.

“66. The Meeting agreed that the International Bureau should continue to develop proposals for a third party observation system, to be presented to the next session of the PCT Working Group, based on document PCT/MIA/17/2 and the above comments.”

39. *The Working Group is invited to comment on the desirability of an international system for third party observations and on the proposed features of a system which might be developed, as set out in paragraphs 8 to 35, above.*

[Annexes follow]

## ANNEX I

## REVIEW OF NATIONAL THIRD PARTY OBSERVATION SYSTEMS

85. The following paragraphs provide information regarding third party observation mechanisms contained in some national and regional laws. These are, with the exception of the additional entry on the Republic of Korea, copied from document SCP/14/5. It should be noted that the focus of that document was on opposition systems rather than third party observation systems and this was not intended to be a comprehensive review of such laws or a definitive analysis of those laws which were mentioned.

**China**

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

**Japan**

87. Rules 13*bis* and 13*ter* of the Regulations under the Japanese Patent Law provide that any person may submit information relating to patentability of claimed inventions contained in a patent application or a granted patent to the Commissioner of the Japan Patent Office (JPO). Such information can be submitted anonymously. The content of the submitted information is open to public inspection. No fee is required for the submission of this information.
88. The information that third parties may submit shall be on the following grounds, which shall be substantiated by written evidence:
- the claimed invention is not patentable subject matter or it does not meet the requirement of novelty, inventive step or industrial applicability;
  - double patenting or the claimed invention is contained in an application filed earlier but published later than the filing date of the application/patent concerned (non-compliance with Article 29, 29*bis* or 39(1) to (4) of the Japanese Patent Law);
  - the description requirement has not been met (non-compliance with Article 36(4) or (6) (except (6)(iv)) of the Japanese Patent Law);
  - the patent application was amended in a manner that new matter going beyond the scope of the disclosure at the time of the filing date has been included (non-compliance with Article 17*bis*(2)(iii) of the Japanese Patent Law);
  - the scope of the Japanese translation of an application filed in a foreign language goes beyond the scope of the application as filed;
  - the patent was corrected in a manner not in compliance with Article 126(1), *provisio*, (3), (4) or (5), or Article 134*bis*, *provisio*.
89. The submitted information will be notified by the JPO to the applicant concerned (or the patentee concerned). Upon request, it is possible to obtain feedback as to whether the submitted information has been utilized by an examiner for the purpose of substantive examination or not.

90. In addition to paper submissions, relevant information may be submitted on-line to the JPO. In 2007, 7,487 submissions were made in total, and 76% of them were utilized by examiners.<sup>1</sup> Inspired by the Peer Review Prior Art pilot project conducted by the USPTO (see below), the JPO has started a Community Patent Review pilot since June 2008. The pilot project has, in general, produced positive results.<sup>2</sup>

### Philippines

91. Section 47 of the Intellectual Property Code (Republic Act No. 8293) states that, following the publication of an application, any person may present observations concerning the patentability of the invention. Such observations must be filed in writing and must include a statement, in English or Filipino, of the grounds on which they are based.<sup>3</sup> The person who submitted the observations shall not be a party to the proceedings before the Bureau of Patents.<sup>4</sup> No fee is required to submit observations. Since opposition proceedings before the Bureau of Patents are not provided for in the Intellectual Property Code, the third party observation system is considered to be a low-cost way to challenge a potential patent.<sup>5</sup>
92. 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.<sup>6</sup>
93. If the observations relate to alleged prior art other than in written form, for example, prior 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

94. Early initiation of third Party observation proceeding is allowed according to the Korean Patent Act. Any person may furnish the Commissioner with information and evidence including prior art references which may negate the patentability of the invention claimed in the patent application, even before the patent application is laid open<sup>7</sup>. This provision only applies for applications filed on or after October 1, 2006.
95. Article 63*bis* of the Patent Act "Provision of Information on Patent Applications" reads as follows<sup>8</sup>: "After a patent application has been filed, any person may provide the Commissioner of the Korean Intellectual Property Institute with evidence of the reasons to reject the patent application. However, this provision shall not apply if the requirements stipulated in Article 42(8) and 45 are not satisfied."

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<sup>1</sup> JPO Annual Report 2008

<sup>2</sup> The report is available at: [http://www.peertopatent.org/CPR\\_Pilot\\_Report.pdf](http://www.peertopatent.org/CPR_Pilot_Report.pdf)

<sup>3</sup> Manual for Substantive Examination Procedure, Chapter VI.11

<sup>4</sup> Ibid

<sup>5</sup> Ibid

<sup>6</sup> Ibid

<sup>7</sup> <http://www.lawleeko.com/sub/whats/list.asp?number=19&mode=view&gotopage=3>

<sup>8</sup> <http://www.kipo.go.kr/kpo/user.tdf?a=user.english.html.HtmlApp&c=60201&catmenu=ek60201>

### **United Kingdom**

96. 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.
97. Rule 33 of the Patents Rules 2007 provides detailed procedures regarding third party observations. The controller must send to the applicant a copy of the observations on patentability, unless they disparage any person in a way likely to damage such person or are generally expected to encourage offensive, immoral or anti-social behavior. The controller may, if necessary, send to the applicant a copy of any document referred to in the observations. It is recommended that any observations be filed within three months after the application has been published, as a patent may be granted after that period.<sup>9</sup> The observations must be made in writing, and can be filed on paper or electronically. They shall be supported by evidence wherever possible.
98. The Office will acknowledge receipt of the submitted observations if contact information of the submitter is available. Where observations were made before the grant of the patent, an examiner will take them into account when deciding upon the patentability of the invention concerned. The observations will be added to the official file, which is available to the public, and a copy of the observations will be sent to the applicant. Even if the observations are received after the grant of the patent, they will be placed in the patent file, and a copy of the observations will be sent to the patentee.

### **United States of America**

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

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<sup>9</sup> <http://www.ipo.gov.uk/types/patent/p-other/p-object/p-observation/p-observation-making.htm>

101. 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 reply to such submission. The submitter of the information will not receive any communication from the USPTO relating to such submission, except where it has 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.
102. In 2007, the USPTO started a pilot project, "Peer Reviewed Prior Art Pilot", to determine the extent to which the organized submission of documents together with comments by the public will provide useful prior art for examiners.<sup>10</sup> Following a proposal by a group of academic and business professionals, the pilot tests a collaborative, on-line, community process where the public may locate potential prior art information on a dedicated Peer-to-Patent Website developed by the Community Patent Review Project of the Institute for Information Law and Policy at New York Law School.<sup>11</sup> The pilot, in particular, analyzes whether such collaborative public review would effectively identify prior art that might not otherwise be found during the ordinary examination process.
103. 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 applications in the fields of computer architecture, computer networks, cryptography and security and business methods.
104. The USPTO has lately been evaluating the impact of public input on improving patent quality through the Peer-to-Patent review process. As of October 1, 2009, office actions have been taken with respect to 104 pilot applications. Among those, 21% referred to prior art found by third parties through the Peer-to-Patent review. Among such prior art found by third parties, half of them, however, were also found by examiners independently.<sup>12</sup>

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

105. 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, following publication of the European patent application. That person may not be a party to the proceedings before the EPO. No fee is required for the submission of observations.
106. Such observations shall be filed in writing in an official language of the EPO, and state the grounds on which they are based.<sup>13</sup> Documentary evidence and, in particular, publications submitted in support of the arguments may be filed in any language. However, the EPO may request that a translation into one of its official languages be filed; otherwise the evidence will be disregarded.<sup>14</sup>

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<sup>10</sup> Information concerning the Peer Reviewed Prior Art Pilot is available at:  
[http://www.uspto.gov/patents/init\\_events/peerpriorartpilotindex.jsp](http://www.uspto.gov/patents/init_events/peerpriorartpilotindex.jsp)

<sup>11</sup> <http://www.peertopatent.org/>

<sup>12</sup> <http://www.uspto.gov/web/patents/peerpriorartpilot/p2ppie.pdf>

<sup>13</sup> Rule 114(1) of the Implementing Regulations under the EPC

<sup>14</sup> EPO Examination Guidelines, Part E, VI.3

107. The observations made by a third party will be communicated to the applicant (or the patentee), who may comment on them.<sup>15</sup> If they call into question the patentability of the invention in whole or in part, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated, i.e. they must be admitted to the proceedings.<sup>16</sup> If the observations relate to alleged prior art available other than from a document, e.g. from use, this should be taken into account only if the alleged facts either are not disputed by the applicant (or the patentee) or are established beyond reasonable doubt.<sup>17</sup> Observations received after the conclusion of the proceedings will simply be added to the file.<sup>18</sup> Although the third party is sent acknowledgment of the receipt of his observations, the EPO does not inform him of any further action it takes in response to them.<sup>19</sup>

[Annex II follows]

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<sup>15</sup> Rule 114(2) of the Implementing Regulations under the EPC

<sup>16</sup> EPO Examination Guidelines, Part E, VI.3

<sup>17</sup> *Ibid*

<sup>18</sup> *Ibid*

<sup>19</sup> *Ibid*



## ANNEX II

## SUMMARY OF PROPOSED SYSTEM

1. The following diagrams and commentary illustrate the principle of how the proposed system might work. They are not intended to show the specific detail of how parts of the system would look or exactly what information would be included.

**Making the Observations**

2. The third party would enter the observations using Web forms. (In addition, the system would also support paper-based observations.)
3. A first screen would require the international application number or publication number on which the observations were to be made.
4. Assuming that the number of a published international application was entered, the system would indicate basic bibliographic details to confirm that it was the correct application. If it was already more than 30 months from the application's priority date, the system would offer a warning that the observations might not be noticed by designated Offices. The system might also offer an option to indicate which version of the application was being commented on (as filed or including Article 19 amendments would normally be the only options open to public inspection).
5. The third party would then enter citations and comments using a structured form, such as that shown overleaf. The appropriate balance would need to be found between ease of data entry and sufficient structure to allow effective automation of document retrieval for examiners considering the observations and separation of different types of comment.
6. The International Bureau would (for at least the initial phase) check the observations, but only to the extent of ensuring that what had submitted *prima facie* included comments about the international application and were not, for example, advertising spam which had slipped past the filters.

**Consideration by Applicant**

7. The applicant would be notified of the existence of observations but would not be required to respond. If he chose to respond, it would be by making an informal comment similar to the permitted response to a written opinion of the International Searching Authority. Preferably, the system should allow this to be done using a Web form similar to that used to make the observation. However, the system would also support paper-based responses.

**Consideration by Offices and Third Parties**

8. The observations would appear on the PATENTSCOPE<sup>®</sup> view of the particular international application as both human readable (for example, PDF) and machine readable (XML) views of the submitted data. Access to these documents could be automated using the Web Services tools which are already available.

## Third Party Observation

Preparing observations on international application:

Application number (publication number): PCT/EP2008/000001 (WO 2009/080000 A1)

Applicant: ABC Company

Title: An invention

Filing date: 03 January 2008

Observations made on the basis of the claims as amended under Article 19

Novelty and inventive step

Industrial applicability

Clarity

Support

Other

### Add Citation

- Patent document
- Monograph (eg conference proceedings)
- Journal
- Book
- Database entry
- Other online reference
- Reference to prior use or oral disclosure
- Other

An allegation that a claimed invention is not new or not inventive needs to be backed up by a disclosure of the invention or something which would make the invention obvious. Apart from certain special cases relating to earlier patent applications, that disclosure must have taken place before the priority date of the application (or the filing date if there is no valid priority date).

You can make observations including up to 10 cited documents. To assist Offices in finding the relevant documents efficiently, please enter the details using the most relevant template selected from those on the left.

\* Country Code

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\* Publication Number

3744403

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