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PRE-GRANT OPPOSITION

A lengthy or onerous pre-grant patent opposition system can place undue burdens on patent applicants and create additional costs to patent offices, thereby causing uncertainty and deterring innovators and enterprises that would otherwise bring innovative products and services to TPP partners. Third parties may exploit pre-grant opposition processes to harass the examiner and/or applicant and seek to delay or confuse the examination process. Moreover, third parties can overburden already strapped patent offices, decrease the efficiency of examination, and delay the granting of pending rights.

In our experience, the goal of ensuring high-quality examination procedures and patents can be addressed by other means that are less susceptible to abuse. The U.S. patent system contains two important pre-grant features that help ensure that these goals can be met.

- First, the U.S. patent rules permit third parties to submit prior art documents for consideration by the examiner in a pending published application.¹ Submission of these materials may be made within two months of publication or before the mailing of a notice of allowance, whichever occurs first. Indeed, third parties may often have access to relevant prior art that should be brought to the attention of the patent office, and an examiner's access to the best prior art enhances both the quality and efficiency of the patent examination process.
- Second, under U.S. patent rules, a member of the public may also file a "protest" against a pending application.² A protest must be filed prior to the date the application is published, or a notice of allowance is mailed, whichever occurs first. The protest must include a listing and copies of the patents, publications, or other information relied upon, and a concise explanation of the relevance of each document. A notification to the patent applicant is also required.

Under U.S. patent rules, the prior art submission and protest procedures do not trigger multiple lines of patent prosecution for one application, as the procedures do not require responses from the patent examiners. Accordingly, these procedures protect against the risk of third party misuse, and are done in a manner that is less disruptive to the patent examination system and does not unnecessarily add to the patent backlog.

The U.S. delegation is interested in learning from other TPP partners whose patent rules currently provide for a formal, pre-grant opposition system. We have the following questions for those TPP partners:

¹ See 37 CFR 1.99, available at <http://www.gpoaccess.gov/cfr/>

² See 37 CFR 1.291, available at <http://www.gpoaccess.gov/cfr/>

1. How does the pre-grant opposition proceeding work in that TPP partner?

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2. How often are these oppositions filed? What are the results? Are there any relevant statistics that are publicly-available?

3. Are there any safeguards that are put into place to prevent unreasonable delay or misuse by third parties?

4. Is there a time window within which a third party must initiate a pre-grant opposition proceeding? Is there a temporal limit for such proceedings, i.e., how long do such proceedings usually take?

5. What kinds of documents are required from the opposing party and the applicant? Are there oral arguments?

6. Who is responsible for conducting the proceeding? Is there any training required for that official?

7. Is there a possibility for appeal?