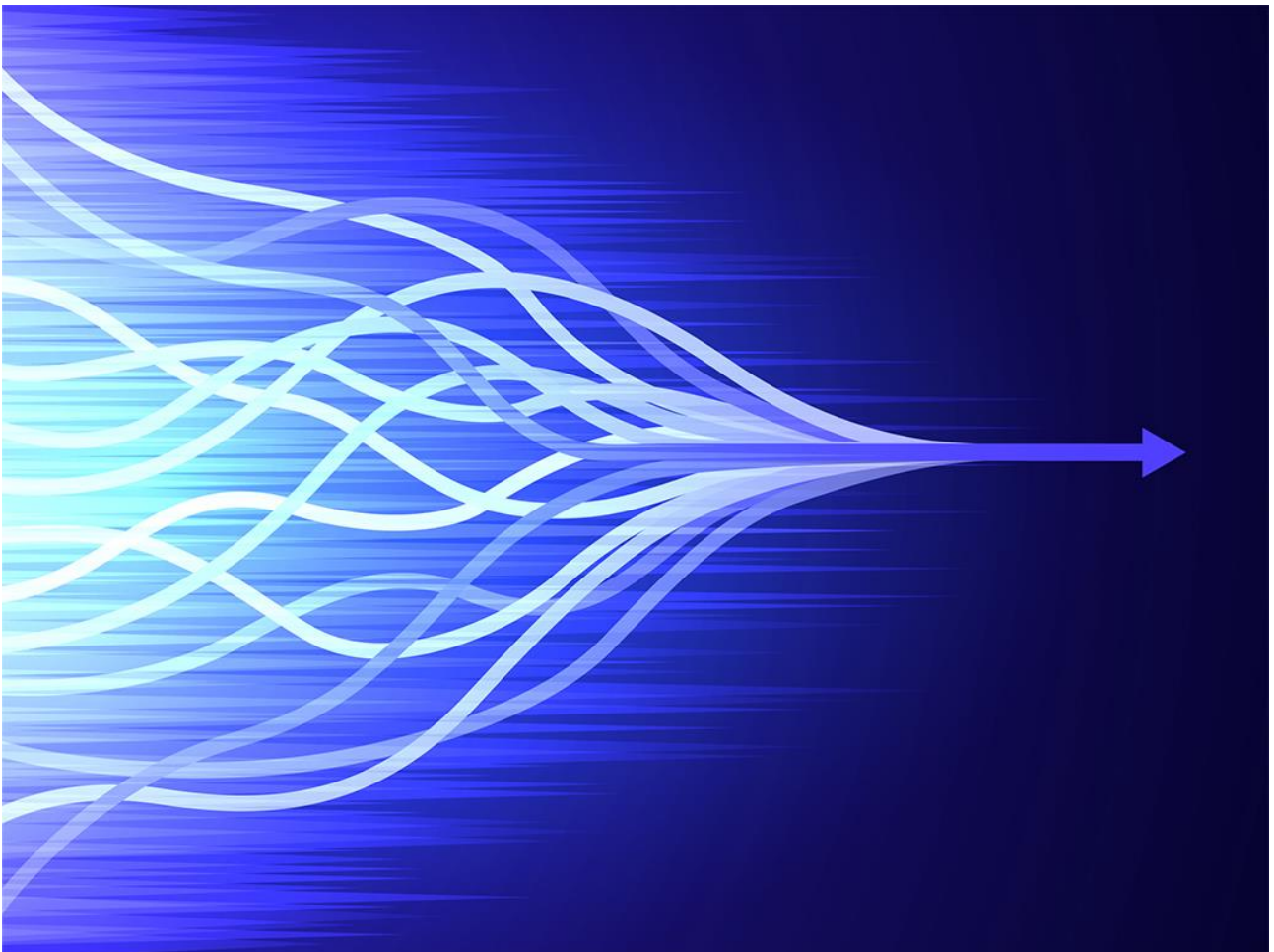


Convergence of practice

Common practice as regards observations by third parties

March 2025



Common practice as regards observations by third parties

Considering that observations by third parties enable any third party to present arguments and information concerning the patentability of the invention to which a patent application or patent relates;

Considering that observations by third parties serve the public interest and contribute to enhancing patent quality;

Considering that they can help to avoid the grant of patents that are subsequently found to be invalid and that they contribute to a fair and transparent patent system;

Considering that they allow third parties to contribute to the examination process (including opposition proceedings) at a low cost, increasing the chances of finding relevant prior art and potentially influencing the outcome of the patent examination process;

Noting that any common practice will be implemented on a voluntary basis;

Having regard to the opinion of the Committee on Patent Law;

The Administrative Council of the European Patent Organisation at its meeting on 20 March 2025 approved the following common practice as regards observations by third parties:

Possibility of filing observations by third parties

- Offices are to provide for the possibility to file observations by third parties.

List of grounds that can be invoked

- Offices are to state a list of the grounds that can be invoked when filing observations by third parties.

Formal requirements

- Offices are to provide that observations by third parties must be filed in writing and must include a statement of the grounds, i.e. the reasons on which they are based.

Anonymous filing of observations by third parties

- Offices are to provide that observations by third parties may also be filed anonymously.

Online filing

- Offices are to provide that observations by third parties may be filed online, including the upload of any kind of supporting documents.

Observations by third parties as part of the public file

- Offices are to provide that observations by third parties are accessible to the public, i.e. available via file inspection

Processing of observations by third parties filed during the PCT international phase

- Offices are to provide that observations by third parties filed during the PCT international phase are duly considered upon entry into the national phase.

Filing of observations by third parties free of charge

- Offices are to provide that observations by third parties can be filed free of charge

1. Introduction

The convergence of practice programme is a cornerstone of the EPO's Strategic Plan 2028. On the basis of this programme and with the involvement of user associations, the EPO and the national offices strive to find common ground in areas where diverging administrative practices exist. After the completion of the first convergence cycle, the Administrative Council approved the continuation of the convergence of practice programme and the launch of six new topics for a second cycle (CA/73/22 Rev. 1). The second pair of topics was rolled out in 2024/2025 namely "Observations by third parties" and "Practices concerning assignment".

Pursuant to the working method established by the Committee on Patent Law (CA/PL 14/19), Working Group 9 on "Observations by third parties" was set up. A call for interest was launched in December 2023, whereupon 24 EPC contracting states, 1 extension state, and 1 validation state indicated their interest in participating in the discussions of Working Group 9. BusinessEurope, epi and WIPO each nominated one representative as an observer in the discussions of the Working Group.

The composition of the Working Group was as follows: Albania, Austria, Bosnia and Herzegovina, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Moldova, Morocco, Netherlands, North Macedonia, Norway, San Marino, Slovakia, Spain, Sweden, United Kingdom, BusinessEurope, epi, WIPO, and EPO.

In February 2024, the chairperson of the Working Group (a representative of the EPO) issued a detailed questionnaire to identify the administrative practices regarding observations by third parties and to determine any differences and similarities among these practices. The answers from the participants were compiled in a summary document which served as a basis for the discussions within the Working Group.

The Working Group held four virtual meetings (18 April 2024, 24 May 2024, 4 July 2024, 26 September 2024). Based on the discussions in these meetings and considering the results of the questionnaire, the Working Group identified eight areas where a convergence of practice was considered to particularly benefit both users and patent offices.

In parallel to the discussions in the Working Group and in accordance with the methodology agreed by the Committee on Patent Law (see CA/PL 14/19, point 21), users were consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 11 April 2024 and 24 October 2024. In order to further broaden the scope of the consultation process, on 21 October 2024 the EPO organised the fifth virtual platform on convergence of practice and informed users and offices of the results achieved within Working Groups 9 and 10 until then.

At its fourth meeting on 26 September 2024, the Working Group agreed upon a draft common practice as regards observations by third parties. The Working Group also agreed upon explanatory remarks to the eight different areas contained in this draft common practice which are reflected below.

2. Explanatory remarks

2.1 Possibility of filing observations by third parties

Almost all Offices confirmed that their jurisdiction provides for the possibility to file observations by third parties. However, the replies to the questionnaire showed that a few Offices do not provide for such a possibility. As set out in the preamble to the common practice, the Working Group recognises that observations by third parties provide significant advantages to the patent grant procedure. They enable any third party to present arguments and information concerning the patentability of the invention to which a patent application or patent relates. They serve the public interest and contribute to both enhancing patent quality, as they can help to avoid the grant of patents that are subsequently found to be invalid, and to a fair and transparent patent system. They also allow third parties to contribute to the examination process at a low cost, increasing the chances of finding relevant prior art and potentially influencing the outcome of the patent examination process and other relevant proceedings. Given these benefits and the objective of ensuring a consistent practice, the Working Group recommends that Offices are to provide for the possibility to file observations by third parties.

2.2 List of grounds that can be invoked

It emerged from the results of the questionnaire that not all jurisdictions expressly provide for a list of grounds on which observations by third parties can be based. The Working Group believes that it is helpful to expressly list the possible grounds that can be invoked as this gives guidance to those interested in filing observations by third parties. Offices should therefore provide a list of the grounds that can be invoked when filing observations by third parties.

2.3 Formal requirements

The results of the questionnaire show that nearly all Offices require observations by third parties to be filed in writing. Moreover, a majority of jurisdictions require that the grounds be stated. It is therefore suggested to align the practices between the participating Offices by providing a common practice which sets out that observations by third parties have to be filed in writing and must include a statement of the grounds on which they are based. Both formal requirements are considered to facilitate the examination of observations by third parties. It is understood that the statement of grounds is a minimum requirement which should encourage third parties to furnish one or several reasons why the application should be rejected, and which should be liberally interpreted by Offices.

2.4 Anonymous filing of observations by third parties

The results of the questionnaire were mixed as to whether observations by third parties can be filed anonymously. Twelve Offices allow anonymous filing of observations by third parties whereas ten Offices do not. Three Offices answered that anonymous filing of observations by third parties can be allowed in certain specific circumstances. The Working Group believes that there are evident benefits of providing for the possibility of filing observations by third parties anonymously. This allows any third party to submit any relevant information without the need to identify themselves, which can be advantageous for the third party e.g. for business reasons. Consequently, the Working Group considers that Offices should provide that observations by third parties may be filed anonymously.

This is without prejudice to the practice CA/5/25 4 of some Offices which, for the purpose of permitting a traceability, require the identity of the third-party filing observations to be indicated while not making any data as to the identity available to the public (except to the applicant upon request).

2.5 Online filing

Not all participating jurisdictions provide for the online filing of observations by third parties. The online filing of observations by third parties has evident advantages as it is convenient and provides for an accessible and easy way of filing observations by third parties. This, in turn, can contribute to timeliness in the processing of observations by third parties. It may also facilitate the filing of anonymous observations by third parties. The Working Group recognises the value of providing the possibility to file using an online filing tool (without prejudice to the possibility of filing for example by post or in person) and also considers that it should permit including all kinds of cited documents (patent literature, non-patent literature, evidence). It therefore proposes that offices are to provide for the online filing of observations by third parties and that they allow for the upload of any kinds of supporting documents. This is without prejudice to the right of the Offices to determine the allowable form (i.e. written form, video or audio recording etc.) of these supporting documents. The online filing of observations by third parties does not preclude that they are submitted by any other means accepted by the relevant Office such as post, e-mail etc.

The Working Group also recognises that dedicated online forms may offer a convenient and easy way of filing observations by third parties. They can facilitate and promote the filing of well-structured and concise observations. This, in turn, facilitates the examination of observations by third parties by the Offices. Accordingly, the Working Group encourages Offices to provide a specific online form for filing observations by third parties. The use of such a form for the purpose of filing observations by third parties should however not be mandatory.

2.6 Observation by third parties as part of the public file

It emerged from the questionnaire that some jurisdictions do not prescribe that observations by third parties become part of the publicly available file. The Working Group believes that observations by third parties serve the public interest and the transparency of the procedure and that they should therefore be accessible to the public, i.e. available to anyone via file inspection. Accordingly, the Working Group suggests that Offices are to provide that observations by third parties are to be accessible to the public, i.e. available via file inspection. It is left to the Offices to exclude information from the public file such as disparaging statements and copyrighted documents.

2.7 Processing of observations by third parties filed during the PCT international phase

The results of the questionnaire showed that a large majority of Offices do not process observations by third parties received during the international phase when they become available to it. The Working Group recognises that it would be very useful if observations by third parties which are anyhow available are taken into account by the designated/elected Offices, as they serve the public interest. It therefore suggests a common practice under which Offices shall take into account observations by third parties filed during the PCT international phase upon entry into the national phase. This does not entail any further mandatory action by CA/5/25 5 the examiner such as the

mention of the observations by third parties filed during the PCT international phase or their content in any Office action.

2.8 Filing of observations by third parties free of charge

It emerged from the replies to the questionnaire that all Offices apart from two confirmed that their jurisdiction does not prescribe that a fee is to be paid when filing observations by third parties. The Working Group recognises that observations by third parties serve the public interest and that their main purpose is to provide an easy and low-cost possibility to submit information as to whether a patent should be granted or not. The Working Group therefore considers that Offices should provide that observations by third parties can be filed free of charge