

Third-Party Patent Challenges in Europe, the United States and Australia: A Comparative Analysis

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Third parties are now playing a key role in the processes leading to the grant, and validation, of patents. This article looks at the key differences between three systems of third-party challenge, which have the common goal of providing patentees and their competitors with a forum, other than the courts, where issues of patent validity may be challenged and resolved. Those systems are post-grant opposition before the European Patent Office, pre-grant opposition in Australia and re-examination in the United States. Various aspects of the systems are looked at, including an overview of the procedures, avenues of appeal and statistics on their use. Insufficient empirical evidence is available to permit a comprehensive assessment of which system is the most effective; however, the data available do allow some conclusions to be drawn—including the suggestion that one reason for the differences in levels of use of the three systems may be the perceptions of US Patent and Trademark Office examiners and the culture that has built up within the US patent attorney profession. The degree of divergence in the three systems further indicates that more work needs to be carried out if reforms to the procedures are to be based on need rather than supposition.

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The granting of a patent can no longer be seen solely as an arrangement between the patent applicant and the patent office. Given the pressures on patent systems around the world, third parties are playing a key role in the processes leading to the grant, and validation, of patents. Generally speaking, there are three mechanisms currently operating around the world—post-grant opposition, pre-grant opposition and re-examination. This diversity is in contrast with the current trend to increase international harmonization of patent systems and procedures, a priority for a number of international organizations including the World Intellectual Property Office, the European Patent Office (EPO) and the US Patent and Trademark Office (USPTO).

This article, a broadly descriptive piece, compares the systems of patent review—post-grant in Europe, pre-grant in Australia and re-examination in the United States.¹ The major characteristics and issues associated with each process are identified, as are the differences. Further, statistics of use are considered in the context of the variations in procedures. Overall, the intention is to uncover the key differences between the three systems of third-party challenges, which have the