

## Third Party Observations – An underused tool?



From Dr. Isabel Knoke

### I. Introduction

Whilst monitoring the patent applications of a competitor, you notice an application which is considered by the Patent Office to be patentable over to the previous prior art, but for which you are aware of additional, as yet uncited, prior art?

In addition to awaiting the end of the examination proceedings and filing an opposition post-grant, there is another, earlier possibility of raising questions as to patentability: filing third-party observations.

### II. What are Third Party Observations?

By means of third-party observations (or third-party objections), documents, e.g. patent publications, can be introduced by any third party for consideration as further prior art; this can be done during the search phase as well as during examination proceedings and also opposition proceedings. In this manner, prior art which is known to the third party can be taken into account by the Examiner, perhaps at an earlier stage in the proceedings, and the grant of an undesirable patent can perhaps be prevented. In German, UK, European

and International patent law, third-party observations are possible to a varying extent.

### III. Third-Party Observations against a German patent application

The basis for third-party observations against a German patent application can be found in Sec. 43(3) 2 German Patents Act (PatG): *"Any person shall be entitled to provide the German Patent and Trademark Office with information with respect to the prior art that could prejudice the grant of a patent."*

A third-party observation, or third-party objection, can thus be made by anybody. Since April 1, 2014, the prior art which can be indicated to the patent office, is no longer limited to public publications. This means, for example, that public prior use can also be specified. The third party may also remain anonymous, if desired.

The Applicant will normally be informed of the third-party observation. The Examiner may further request the Applicant to comment on the newly cited prior art, wherein this is particularly the case if the specified prior art is deemed relevant by the Examiner. The third party, however, does not become a party to the proceedings and therefore has no opportunity, or is explicitly not invited, to explain any possible lack of clarity. Furthermore, the third party does not obtain any rights to be informed of the result of the observations. The third party can, of course, obtain information as to the extent to which the third-party observations have an effect on the further examination proceedings, by inspecting the files.

It is therefore recommended to not only file the newly cited document(s) or the other prior art, but also to sufficiently demonstrate its relevance to the subject-matter of the application. Proceeding in this manner helps to convince the

Examiner that the subject-matter of the application is not patentable.

When the patent in question is under opposition proceedings, the third-party observations offer the third party the possibility, whilst not being a party to said proceedings, to introduce further prior art; this is on the basis of Sec. 59(5) in conjunction with Sec. 43(3)2 German Patent Act.

#### **IV. Third Party Observations against a European patent application**

The basis for third-party observations in European patent law, is found in Art. 115 EPC: *"In proceedings before the European Patent Office, following the publication of the European patent application, any third party may, in accordance with the Implementing Regulations, present observations concerning the patentability of the invention to which the application or patent relates. That person shall not be a party to the proceedings"*.

Furthermore, the Implementing Regulation R114 EPC states:

*(1) Any observations by a third party shall be filed in writing in an official language of the European Patent Office and state the grounds on which they are based. Rule 3, paragraph 3, shall apply.*

*(2) Any such observations shall be communicated to the applicant for or proprietor of the patent, who may comment on them.*

Third-party observations in accordance with Art. 115 can be applied during both application and opposition proceedings. The European Patent Office has provided an online form use in the filing of third-party observations, which can be used for both anonymous and named third-party observations. It is also possible to submit third-party observations in writing, without the use of the form.

Third-party observations are discussed in the Guidelines for the Examination, paragraph E VI 3 and in the publication of

the Official Journal 2017 A86. It is possible, during application proceedings, to make objections against all aspects of patentability. This means that, in addition to objections relating to novelty and inventive step, objections relating to clarity or inadmissible amendments, for example, may also be filed. It is thus of particular note that the objections that may be raised by a third party during pre-grant proceedings, extend beyond those grounds available during a potential opposition. After a formal examination, observations from third parties are published in the online register and are forwarded to the Applicant. However, objections which are received are only considered, published and forwarded to the Applicant prior to the date that the decision on patentability has been made. Third-party observations received after the Decision to Grant has been finalised are admitted to the file, but are only considered, published and forwarded to the Patentee in case an opposition is filed.

When the third-party observations are filed by a named person/entity, according to Kley's Commentary on the EPC 2000: Art. 115, the third party will be informed of obvious defects in said observations and given a deadline for remedying the same. Furthermore, the EPO announced in the Official Journal 2017 A86 that in the case of substantiated third-party observations which are not submitted anonymously, the subsequent procedural step on the part of the EPO, e.g. the issue of the next examination report, will be accelerated as far as possible.

#### **V. Third-Party Observations against an International patent application**

Third-party observations are, since July 1, 2012, governed in Part 8 of the PCT Administrative Instructions in sections 801 to 805.

Observations may be filed between the publication of the international application and the expiry of 28 months from the priority date.

Third-party observations may be filed online, wherein anonymous filings are possible, wherein the identity of the person making the observations is known to the Office, but

For further information:

Meissner Bolte ■ Dr. Isabel Knoke ■ Bankgasse 3 ■ 90402 Nuremberg ■ Germany  
Phone +49-911-214 72 50 ■ Fax +49-911-24 36 86 ■ E-mail: mail@nuernberg.mb.de

The information contained in this newsletter may or may not reflect the most current legal developments; accordingly, information in this newsletter is not promised or guaranteed to be correct or complete, and should not be considered an indication of future results. Meissner Bolte expressly disclaims all liability in respect to action taken or not taken based on any or all contents in this newsletter.

is not made public. Each third-party can submit only one observation against an international application, the total number in an application being limited. It is possible to submit a maximum of 10 citations and comment on the relevance of the citations. The administrative instructions provide for objections to be raised, only regarding novelty and inventive step. It remains to be seen, however, whether comments concerning further points, such as technicality or feasibility, will be ignored or if they will be considered.

Observations are examined and published in Patentscope if there are no grounds to oppose this. The observations will be forwarded to the Applicant and to the Offices of the designated states. The Applicant may, within thirty months from priority, submit comments in response to any third-party observations. Third-party observations against an international application shall not exclude further observations from being made during the national or regional examination e.g. at the European Patent Office.

## VI. Benefits and Risks of a Third-Party Observation during Examination Proceedings

In some cases there are good arguments in favour of filing third-party observations against a pending application, either to direct the grant procedure in a desired direction, away from a certain scope of protection, or even to prevent the grant of a patent entirely. In other cases, there may be better, tactical reasons to wait for a patent to grant before filing an opposition. This is illustrated by the following case studies:

Example 1) In patent application 1 (PA1), only feature A is disclosed and claimed. The subject-matter of feature A is known to you from the prior art in D1, e.g. a second patent application. Hence, feature A is not patentable, in particular it lacks novelty over D1.

- If prior art D1 is brought into the proceedings via third-party observations, a patent grant can be stopped owing to a lack of novelty.

- Waiting until PA1 grants before filing an opposition, allows the patentee the chance of asserting rights from the granted patent.

Example 2) In patent application 2 (PA2), feature A is disclosed and claimed for. A sub-claim is directed to feature B and the description also discloses the subject-matter of features A and C. The applicant has limited the independent claim to the subject-matter with features A and B, which appears patentable with respect to the prior art document D2 already known from the examination proceedings.

The prior art document D3, known to you, discloses the subject-matter of features A and B, but does not disclose with a combination of features A and C. Caution is now required.

- D3 could be brought into the examination proceedings by means of third-party observations, so that the subject-matter of the restricted claim would not be patentable. In that case, however, the applicant would have the possibility to restrict to a claim which is directed to a subject-matter with features A and C. Thus, no patent would be granted on the subject-matter with features A and B, but possibly on the combination of features A and C.
- Alternatively, one could await the end of examination proceedings, so that a patent is granted with an independent claim directed to the subject-matter with features A and B. Subsequently, in opposition proceedings, one could an opposition on a lack of novelty over D3. Under both European and German law, the patentee cannot amend the claim in such a way as to extend (broaden) the scope of protection of the original grant. The legal bases for this are: Art. 123(3) EPC for a European application, and Sec. 22 (1) Alt. 2 PatG in German patent law. Hence, the patentee could not restrict the independent claim to a combination of features A and C, but at most to a combination of features A; B and C, provided that this subject-matter is patentable.

In Example 2, it would be necessary to clarify whether a patent directed to a combination of features A and C would be an issue, or whether there is further prior art which would

For further information:

Meissner Bolte ■ Dr. Isabel Knoke ■ Bankgasse 3 ■ 90402 Nuremberg ■ Germany  
Phone +49-911-214 72 50 ■ Fax +49-911-24 36 86 ■ E-mail: mail@nuernberg.mb.de

The information contained in this newsletter may or may not reflect the most current legal developments; accordingly, information in this newsletter is not promised or guaranteed to be correct or complete, and should not be considered an indication of future results. Meissner Bolte expressly disclaims all liability in respect to action taken or not taken based on any or all contents in this newsletter.

also call into question the patentability of this subject-matter. It is worth remembering, however, that filing third-party observations does not preclude the filing of a subsequent opposition.

Example 3) In patent application 3 (PA3), feature A is disclosed and claimed for along with the optional feature B. During Examination proceedings, the independent claim is impermissibly extended by feature C, subject matter which is not disclosed. Assuming that document D4 anticipates the subject-matter of feature A in a novelty destroying manner, whilst also rendering obvious the subject-matter of feature C together with document D5:

- Specifying documents D4 and D5 in third party observations as additional prior art, allows the applicant the option of restricting the claims to the subject-matter of features A and B. If, in particular, the unsupported combination of features A and C is raised by means of third party- observations, as is permissible in European proceedings, the applicant would have the option of amending the claims to remove the impermissible extension.
- During an opposition, in accordance with European patent law, the patentee would be in the so-called inescapable trap pursuant to Art. 123(2) and 123(3) EPC: the patentee cannot remedy the impermissible extension. According to German patent law, the patentee could, where appropriate, additionally restrict the claim with feature B, the patentability of which would have to be examined in the individual case.

In each individual case, depending on the desired objectives, one must carefully consider whether filing third-party observations or an opposition will lead to the best outcome.

## VII. Conclusion

During the international application procedure, third-party observations are a simple and inexpensive means of submitting prior art into the international file. Given that it is left to the individual designated office to decide how to deal with the identified prior art, however, the language in which the documents and statement of grounds is submitted, should be carefully chosen. Additionally, it must be clarified whether it makes sense to submit new third-party observations to the designated office in the respective official language.

During the European examination procedure, far-reaching possibilities exist for questioning the patentability of an application by means of third-party observations. In particular, such a practice provides the opportunity to comment on, and possibly take into account, aspects which do not constitute a ground for opposition. Due to the lack of procedural involvement, a careful substantiation of the lack of patentability is appropriate in order to achieve the desired results.

During German examination procedures, third-party observations are least regulated and apparently less apparent due at least partially, to the missing publication in the online file registry. Nevertheless, third-party observations may also constitute effective means for preventing a German patent from granting.

When opting for third-party observations, the applicant's greater opportunity for making amendment to the application, in comparison with the amendment options after the grant of a patent, must also be taken into account.

**We would be happy to assist you in acquiring the necessary know-how by offering you our in-house seminars either personally or via WebEx. Simply get in touch with us.**

For further information:

Meissner Bolte ■ Dr. Isabel Knoke ■ Bankgasse 3 ■ 90402 Nuremberg ■ Germany  
Phone +49-911-214 72 50 ■ Fax +49-911-24 36 86 ■ E-mail: mail@nuernberg.mb.de

The information contained in this newsletter may or may not reflect the most current legal developments; accordingly, information in this newsletter is not promised or guaranteed to be correct or complete, and should not be considered an indication of future results. Meissner Bolte expressly disclaims all liability in respect to action taken or not taken based on any or all contents in this newsletter.