

# **Patent Opposition Practice - Australia**

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intellectual property

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**[pof.com.au](http://pof.com.au)**



# Outline

- Opposition in Australia is pre-grant
- All grounds available for revocation are available in Opposition
- Evidence by way of expert declarations
- Hearing before a delegate of the Commissioner
- Appeal available to a single judge of the Federal Court



# Pre Grant Options

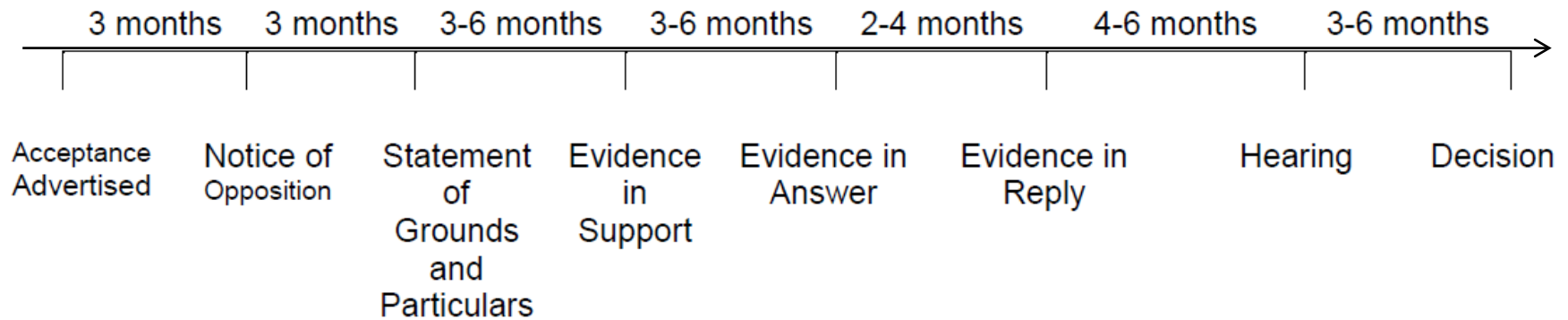
	Third Party Observations (section 27)	Re-Examination (only if initiated by Commissioner)	Opposition
<b>When</b>	After OPI but before 3 months after Acceptance Advertised	After Acceptance and before patent grant	Within 3 months of advertisement of Acceptance
<b>Grounds</b>	Novelty/Inventive Step	s.40 – support, clarity, subject matter, novelty/inventive step/utility	Entitlement s.40 – support clarity, subject matter, novelty/inventive step/utility
<b>Right to a Hearing</b>	No	No	Yes
<b>Before Whom</b>	Examiner	Examiner	Delegate of Commissioner
<b>Anonymity</b>	Yes	Yes	No
<b>Average Time</b>	6 – 12 months	6 – 12 months	1 – 3 years
<b>Appeal</b>	Yes (applicant only)	Yes (applicant only)	Yes. Applicant or Opponent

# Post Grant Options

	<b>Re-Examination (Third party or Patentee Request)</b>	<b>Revocation</b>
<b>When</b>	Any time after grant	Any time after grant
<b>Grounds</b>	s.40 – support, clarity, subject matter novelty/inventive step/utility	All grounds
<b>Right to a Hearing</b>	No	Yes
<b>Before Whom</b>	Senior Examiner	Judge
<b>Anonymity</b>	Yes	No
<b>Average Time</b>	6 -12 Months	1 – 3 Years
<b>Appeal</b>	Yes (Patentee only)	Yes



# Outline of Opposition Procedure



# Details of Procedure

- Notice of Opposition
- Statement of Grounds and Particulars
- Dismissal Application
- Request for further and better particulars
- Evidence
- Extensions for Evidence
- Written Submissions
- Hearing
- Decision
- Appeal

# Amendment to Claims during Opposition

- Generally, if an amendment request is made during a substantive opposition the proceedings will be stayed until the amendment application has been resolved.
- Opponent or any other party may oppose the amendment request – this involves a separate opposition with evidence and a hearing.



# Permissible Amendments

- Within the scope of the claims
- Not beyond disclosure
- Complies with s.40(2) or (3)
- Disclaimer practice uncertain

*Astra Zeneca v Apotex* [2014] FCAFC 99



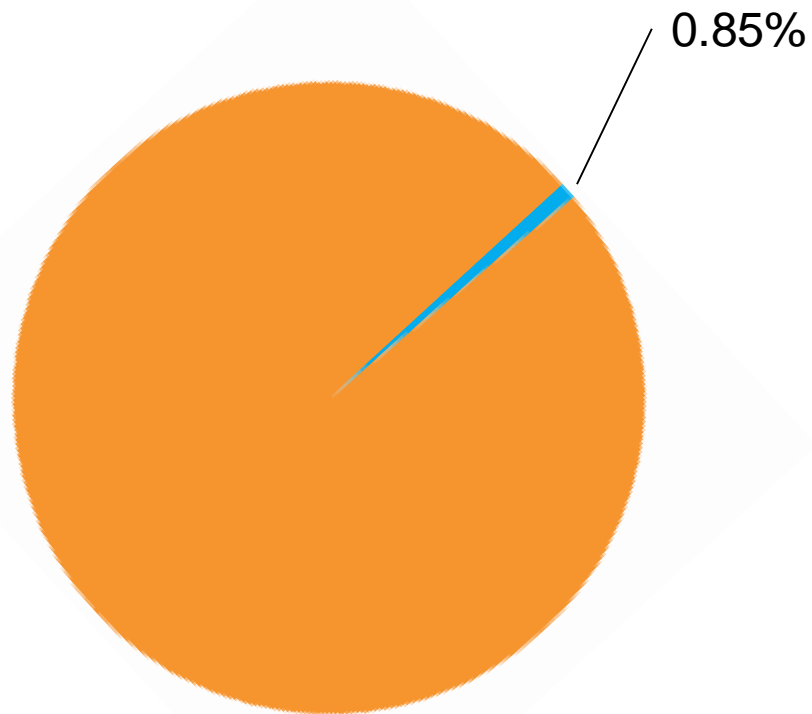
# Other Procedural matters

- No divisionals permitted during opposition. This is a recent change in practice
- Opposition withdrawal may lead to re-examination
- Leave required to withdraw an opposed application (section 141)
- Leave often dependant on whether there remains a pending divisional application

# Discovery/Notice to Produce/ Examination of Witnesses

- Discovery at large not available
- Notice to Produce
- Cross-examination of witnesses generally not available

# Opposition Statistics



Less than 1% of all applications are opposed.

2068 oppositions  
242,456 applications  
(1985 – 2000)

In 2013 the rate was lower than the long term average at just 0.53% - 98 oppositions to more than 18,000 applications.

# Opposition Statistics

## Outcomes

Opposition partially successful.  
Leave to Amend  
Patent Application  
58%

Opposition Successful  
10%

Opposition Unsuccessful  
32%

1986 - 2000

Recent data shows similar proportions

# Opposition Statistics

## Outcomes

Opposition  
proceeded to  
hearing  
22%

Opposition withdrawn  
59%

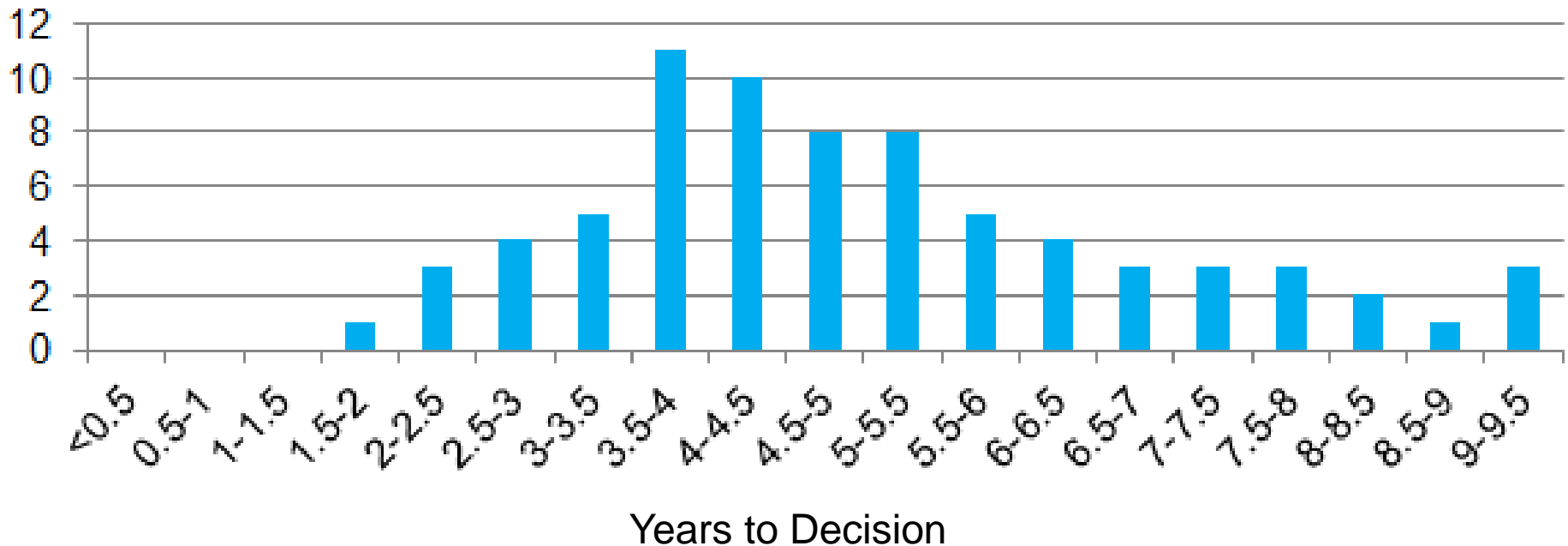
Patent Application withdrawn  
19%

1986 - 2000

Recent data shows similar proportions



# Opposition Statistics



# Opposition/Revocation: Pros and Cons

## Opposition

### Pros

- Delays grant
- Less costly than revocation
- Provides ample opportunity to negotiate resolution

### Cons

- Limited discovery
- Applicant has broad opportunity to amend

## Revocation

### Pros

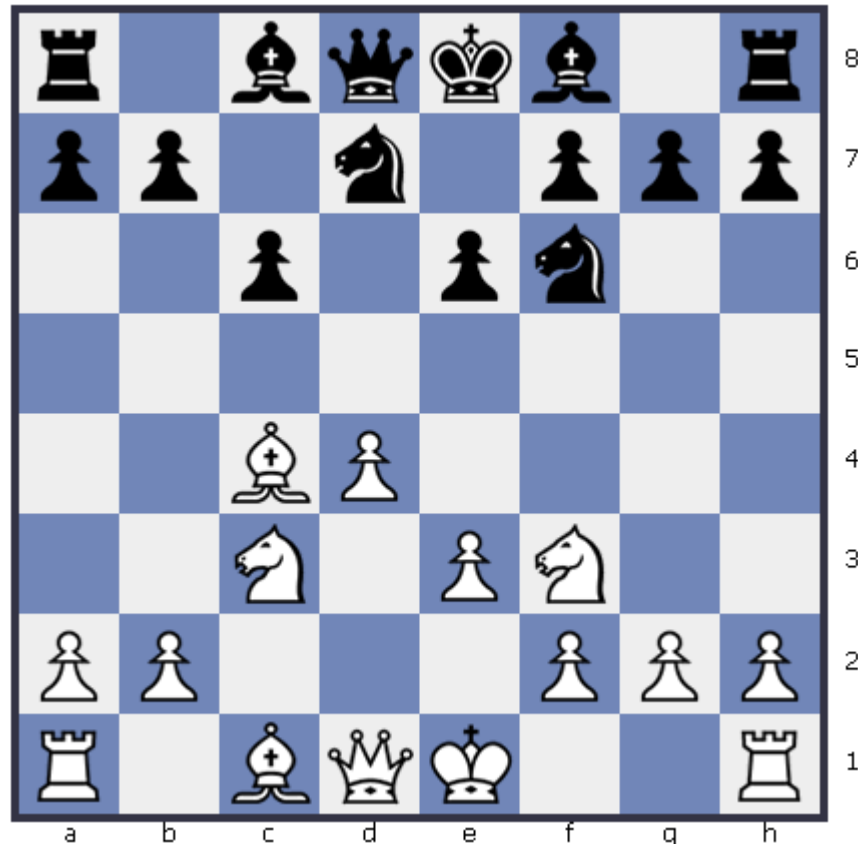
- Full discovery
- Applicant has more limited rights to amend

### Cons

- More costly than opposition
- Can be simultaneously sued for infringement



# Queen's Gambit Declined Meran variation



# Questions

Thank - you

