

## OPPOSITION

Australia operates a pre-grant opposition system for standard patent applications,<sup>1</sup> where any person may oppose the granting of a patent by filing a Notice of Opposition within three months of acceptance of the application<sup>2</sup> being advertised in the Official Journal of Patents. According to Section 59 of the Patents Act, the Minister or any other person may, in accordance with the Regulations, oppose the grant of a standard patent on one or more of the following grounds, but on no other ground:<sup>3</sup>

- (i) that the nominated person<sup>4</sup> is either (a) not entitled to the grant of a patent for the invention; or (b) entitled to the grant of a patent for the invention, but only in conjunction with some other person;
- (ii) that the invention is not a patentable invention<sup>5</sup>;
- (iii) that the specification filed in respect of the complete application does not comply with subsection 40(2) or (3).<sup>6</sup>

As provided in Section 60 of the Patents Act, the opposition is heard by the Commissioner, who must decide the case in accordance with the Regulations. The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding the case. The Commissioner may, in deciding the case, take into account any ground on which the grant of a standard patent may be opposed, whether relied upon by the opponent or not. The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this Section. Oppositions can also arise with regard to procedural matters including:

- (i) amendments: under Section 104(4) of the Patents Act, any person may oppose the allowance of an amendment. Section 102 of the Patents Act provides that amendment of complete specification is not allowable if, as a result of the amendment, the amended specification would claim or disclose matter that is not in substance disclosed in the filed specification or other prescribed documents (if any);
- (ii) extensions of time: under Section 223(6) of the Patents Act, any person may oppose the granting of an extension of time;
- (iii) extension of term for a pharmaceutical patent: under Section 70 of the Patents Act, any person may oppose the grant of an extension of term under Section 75 but only on the grounds that any of the requirements specified in Section 70 (defines what subject matter is available for extension of term) and/or Section 71 (relating to the form and timing of an application) are not met;

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<sup>1</sup> There are two types of patents in Australia, the “standard” patent and the “innovation” patent (similar to utility model). Oppositions to innovation patents can only be initiated after the patent has been granted and then certified.

<sup>2</sup> Section 49 (1) of the Patents Act provides that, subject to Section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent, if: (a) the Commissioner is satisfied that the invention satisfies the criteria mentioned in paragraph 18(1)(b), i.e., novelty and inventive step; and (b) the Commissioner considers that: (i) there is no lawful ground of objection (other than a ground in respect of paragraph 18(1)(b)) to the request and specification; or (ii) any such ground of objection has been removed.

<sup>3</sup> Section 101M allows for opposition under analogous grounds for certified innovation patents, with an innovative step instead of an inventive step.

<sup>4</sup> The applicant is taken to be the nominated person for the grant of the patent (Regulation 3.1A), and in this context the term “person” means a legal person and includes a body politic (e.g. Commonwealth of Australia, French Republic) and a body corporate (e.g. a company incorporated under the laws of the State of Victoria), as well as a natural person.

<sup>5</sup> Under s 18(1), this includes a lack of novelty or inventive step, manner of manufacture or utility.

<sup>6</sup> Subsection 40(2) of the Patents Act provides that a complete specification must (a) disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; and (aa) disclose the best method known to the applicant of performing the invention. Article 40(3) states that the claims or claim must be clear and succinct and supported by matter disclosed in the specification.

(v) grant of a licence to exploit an invention: under Regulation 22.21(4) of the Patents Regulations 1991, a person who receives a copy of an application for a licence can oppose the granting of that licence.

## RE-EXAMINATION

Chapter 9 of the Australian Patents Act provides for re-examination of applications for standard patents and granted standard patents under certain circumstances. Re-examination of innovation patents is also provided for under Section 101G.

The re-examination is instigated at the Commissioner's discretion, upon request by the patentee or any interested person, or by the direction of a prescribed court before which the validity of the patent in question is in dispute. Re-examination can be in relation to any of the grounds considered during examinations; i.e. novelty, innovative step when compared with prior art base. There are no other grounds for the revocation of a patent, according to Section 98. The procedure is *ex parte*, i.e. the person who requests re-examination has limited opportunity to submit evidence and be heard in the process. The options for initiating a re-examination depend on the stage of the patent cycle. Between the time of acceptance and grant of a standard patent, only the Commissioner can initiate re-examination. This may happen due to an adverse finding of an internal quality review, the emergence of new prior art (whether due to submissions by their parties under Section 27, or from other sources), or in response to a withdrawn opposition. At any time after grant of a standard patent or certification of an innovation patent, the patentee, any third party, or a court may request re-examination. In this circumstance, the Commissioner must re-examine the patent. The Commissioner can also initiate a re-examination without an external request.

The Commissioner will instigate re-examination voluntarily only if intending to issue an adverse re-examination report. In contrast, the Commissioner must re-examine where the patentee or third party requests re-examination regardless of whether the report is adverse or not. The applicant or patentee has the opportunity to respond to any adverse report through amendments and/or submissions and if the adverse findings are not resolved, the Commissioner has the power to refuse the application or revoke the patent.

The applicant or patentee may appeal to the Federal Court against a decision of the Commissioner, according to Section 100A(3) and 101(4), respectively.

## THIRD PARTY SUBMISSIONS

Section 27 of the Australian Patents Act states that:

27 Notice of matters affecting validity of standard patents

(1) A person may, within the prescribed period after a complete specification filed in relation to an application for a standard patent becomes open to public inspection, notify the Commissioner, in accordance with the regulations, that the person asserts, for reasons stated in the notice, that the invention concerned is not a patentable invention because it does not comply with paragraph 18(1)(b).

(2) The Commissioner must inform the applicant for the patent in writing of any matter of which the Commissioner is notified and send the applicant a copy of any document accompanying the notice.

(3) The Commissioner must otherwise consider and deal with a notice in accordance with the regulations.

(4) A notice and any document accompanying it are open to public inspection.

Section 27 enables any person to file a notice asserting that the invention in a standard patent application is not patentable due to a lack of novelty and/or inventive step. This notice must be filed between the date the application was opened for public inspection and three months after publication of the acceptance of the application. The notice must include reasoning as to why there is a lack of novelty and/or inventive step, accompanied by prior art documents used to support this contention. Section 28 provides analogous procedures for innovation patents to allow any person to allege a lack of compliance with s 18(1A)(b) due to lack of novelty and/or innovative step.