



Australian Patent Oppositions

What is an Opposition?

A number of options are available in Australia to those seeking to affect the grant of a patent right. The following actions can be opposed:

- the grant of a patent
- the extension of the term of a patent, and
- post acceptance amendments.

This information sheet deals with oppositions to the grant of a standard patent.

There are a number of grounds on which the grant of a patent can be opposed, including that:

- the claimed invention is not a patentable invention
- the claimed invention lacks novelty and/or an inventive step
- the best method of performing the invention is not disclosed
- the claimed invention is not useful, and
- the claims are not supported by the description.

What is the Process?

The first step is for an opponent to file a Notice of Opposition within the three month period commencing on the date the acceptance of the patent application is advertised. The three month period for filing the Notice cannot be extended.

The opponent is then required to prepare and file a Statement of Grounds and Particulars within three months of filing the Notice of Opposition. This Statement will need to specify the exact grounds of opposition relied upon by the opponent and the material facts upon which each ground is based. IP Australia has the power to dismiss an opposition if the grounds in the Statement are not sufficiently particularised.

After the Statement is filed, the parties have an opportunity to file evidence. Evidence must be filed in the form of one or more expert declaration(s) and there are strict requirements governing the timing for filing the evidence.

First, the opponent has a three month period within which to file Evidence in Support of the opposition. Secondly, the applicant has a three month period within which to file Evidence in Answer. Finally, the opponent has a two month period within which to file Evidence in Reply.

Extensions of time for filing evidence

Extensions of time for filing evidence will only be granted at the discretion of IP Australia and extensions may only be given if:

- (i) the Registrar is satisfied that all reasonable efforts have been made to meet a deadline, and failure to meet the deadline is despite acting promptly and diligently; or
- (ii) if there are exceptional circumstances.

In practice, extensions of time are difficult to obtain.

How is a decision made?

Once the evidence stage is complete, both parties will be given an opportunity to request a hearing.

If a hearing is requested, the parties will have an opportunity to make submissions before a hearing officer. A hearing officer will decide whether to hold an oral hearing or whether the parties will only be given an opportunity to make written submissions. If an oral hearing is held, this may be attended online (which is the preference) or in person.

If there is an oral hearing, it is usual for parties to be represented by a patent attorney and a barrister. After the hearing, the hearing officer will issue a written decision.

If there is no oral hearing, a decision will be issued based on the evidence and any written submissions filed by the parties.

Hearing decisions may be appealed to the Federal Court of Australia.

How much do Oppositions cost?

The costs involved will depend on a number of factors including the type of grounds raised, the nature and extent of the evidence filed, whether extensions of time are requested and whether the opposition progresses to a hearing. In some cases, the opposition is resolved between the parties during the course of the proceedings and the timing of settlement will affect the costs involved.

About 3 months after the hearing, IP Australia will issue a decision including the hearing officer's findings on whether the grounds on which the opposition was contested have been established. The decision will also generally include an award of costs.

We tailor our services and advice to suit the commercial needs of each client. Our services include:

- developing IP strategies for patents, trade marks, designs, circuit layouts, plants breeders' rights, confidential information and trade secrets
- patent and trade mark searching
- providing patentability advice for new innovations and inventions
- providing registrability advice for new trade marks
- drafting, preparing and filing applications
- prosecuting applications through to grant/registration
- offering advice to develop and strengthen existing IP portfolios
- offering freedom to operate and infringement advice
- performing watching searches to monitor third party activities
- representing clients at patent and trade mark opposition proceedings
- providing litigation support

Australian Standard Patent Opposition Process

