3. Oppositions, Disputes and Extensions

3.1 Role and Powers of the Commissioner in Hearings

The Commissioner performs the function of an administrative tribunal and therefore exercises an administrative rather than a judicial role in matters arising from the administration of the Act (see the Queen v Quinn: Ex-Parte Consolidated Food Corporation 1A IPR 537). The proceedings are less formal than in a court and the Commissioner’s primary concern is that all parties concerned have adequate opportunity to present their case to the Commissioner’s delegate.

Regulation 22.22 outlines the Commissioner’s powers in relation to a hearing. The hearing officer, as the Commissioner’s delegate, assumes full authority over the proceedings. In exercising the discretion under subregulation 22.22(2), the Commissioner is not bound by the strict rules of evidence, as are the courts. In the words of Lord Denning MR in T.A. Miller Ltd v The Minister for Housing and Local Government, [1969] RPC 91 at 93:

“A tribunal of this kind is master of its own procedure, provided that the rules of natural justice are applied. … Tribunals are entitled to act on any material which is logically probative, even though it is not evidence in a court of law,….. Hearsay is clearly admissible before a tribunal. No doubt in admitting it, the tribunal must observe the rules of natural justice, but this does not mean that it must be tested by cross-examination. It only means that the tribunal must give the other side a fair opportunity of commenting on it and of contradicting it … ”

Certain powers of the Commissioner under section 210 are relevant to hearing procedures. Under this section the Commissioner may, for the purposes of the Act:

- summon witnesses;
- receive written or oral evidence on oath or affirmation;
- require the production of documents or articles; and
- award costs against a party to proceedings before the Commissioner.

For further information see 3.6 Production of Documents, Summonsing Witnesses; 3.5 Evidence; 3.9 Costs
3.2 Oppositions, Disputes and Other Proceedings - Procedural Summaries

In this topic:

Introduction

Oppositions

A number of potential actions by the Commissioner of Patents can be opposed.

“Substantive” oppositions generally focus on patentability issues and the patent term, and are oppositions to the following actions by the Commissioner:

- grant under section 61 of a standard patent (see 3.2.1 Section 59 - Opposition to grant of a standard patent);
- certification under section 101E of an innovation patent (3.2.2 Section 101M - Opposition to an innovation patent); or
- an extension of term under section 76 of a patent for a pharmaceutical product (3.2.3 Section 75(1) - Opposition to an extension of term of a pharmaceutical patent).

“Procedural” oppositions are oppositions to matters that arise during pre-grant processing of a patent application and the post-grant lifetime of a patent. Procedural oppositions involve an opposition to:

- an amendment under section 104 to a patent request, specification or other filed document (3.2.4 Section 104(4) - Opposition to a request to amend a filed document);
- an extension of time under section 223 for performing an action in relation to a patent, patent application, or any proceedings under the Patents Act that is required to be done, but was not done, within a certain time (3.2.5 Section 223(6) - Opposition to an extension of time under subsection 223(2) or 223(2A)); or
- grant of a licence under regulation 22.21(5) (3.2.6 Reg 22.21(4) - Opposition to grant of a licence).
Disputes and other proceedings

Disputes may arise as to the entitlement of a legal person to ownership of a patent, for example who is the actual inventor or who derives entitlement from them. Similarly, a patent may be granted to a person who is not entitled to the invention, or the name of an entitled person may be omitted from the Register.

Disputes and other proceedings may arise as a result of:

- requests under section 32 in relation to joint applicants;
- applications for a declaration (and directions) under section 36;
- an application for a determination under section 35, as a result of the revocation of a patent under section 137 following an offer to surrender; and
- application for a declaration under section 191A.

The practice and procedures involved in resolving oppositions, disputes and other proceedings before the Commissioner are summarised in this section of the manual.

3.2.1 Section 59 - Opposition to Grant of a Standard Patent

Modified Date: 02 April 2013

3.2.1 Section 59 - Opposition to Grant of a Standard Patent

Note: This information applies on and after 15 April 2013.

In this topic:

Relevant Legislation

The Act

Section 18  Patents inventions

Section 33  Applications by opponents etc.
Under section 59 of the Patents Act 1990, 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 no others:

a. that the nominated person is either:

i. not entitled to grant of a patent for the invention (section 33(1))

ii. entitled to grant of a patent for the invention but only in conjunction with some other person (section 33(2));

b. that the invention is not a patentable invention (i.e. it does not satisfy the requirements of section 18);

c. that the specification filed in respect of the complete application does not comply with section 40(2) or 40(3).
An opposition to grant of a standard patent is generally filed by a person (the “opponent”) who will be in some way affected by the grant. The opposition process provides the opponent with the opportunity to make out a case to persuade the Commissioner that the patent should not be granted.

An opposition under section 59 commences when a person files a notice of opposition in the approved form within the period allowed by the regulations, and pays the appropriate fee. Subsequently, the opponent files a statement of grounds and particulars, setting out the grounds upon which grant of the patent is opposed and the facts and circumstances supporting the grounds. Both parties are provided with periods for filing evidence to establish their respective cases, after which the Commissioner will hear and decide the matter.

The procedures involved in this process are explained more fully in the following sections.

**3.2.1.1 Commencing the Opposition - Filing a Notice of Opposition**

**Note:** This information applies on and after 15 April 2013.

In this topic:

**Timing and requirements for filing a notice of opposition**

When a patent request and complete specification for a standard patent is accepted, a notice of acceptance is published in the *Official Journal of Patents* under section 49(5)(b).

To oppose grant of a standard patent under section 59, a person must file a notice of opposition with the Commissioner within 3 months from the day the notice of acceptance is published (reg 5.4). The notice of opposition must be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (see Schedule 7, item 216).

When a notice of opposition is filed, the opposition officer will acknowledge receipt to the opponent and applicant (the “parties”) and will give the applicant a copy of the notice as soon as practicable.
3.2.1.2 Filing the Statement of Grounds and Particulars

Extending the time to file a notice of opposition

In some circumstances, a short extension of time to file a notice of opposition may be available under section 223 (see 3.11.1 Extensions of Time – section 223). However, once a patent is granted, a notice of opposition to grant of a patent will be of no effect.

Amending a notice of opposition

Under regs 5.14 and 5.15, an opponent may request an amendment to the notice of opposition to correct a clerical error or obvious mistake, or to change the name of the opponent where the opponent's right or interest in an opposition is transferred to another person.

For more information see 3.4.3 Amending opposition documents.

Withdrawal of the opposition

An opponent may withdraw an opposition at any time, by filing a signed notice of withdrawal in the approved form (available on the IP Australia website).

For more information see 3.7.1 Withdrawal of an Opposition.

Note: This information applies to oppositions commenced on or after 15 April 2013.
3.2.1.2 Filing the Statement of Grounds and Particulars

Where specified, information is also provided for oppositions commenced before 15 April 2013 in which the statement of grounds and particulars was not served before 15 April 2013.

Note: As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

The statement

The statement of grounds and particulars in an opposition under section 59 is governed by reg 5.5, or, for oppositions commenced before 15 April 2013, reg 5.4 as in force immediately before 15 April 2013.

The statement of grounds and particulars must set out the grounds the opponent intends to rely on to establish the opposition, and the facts and circumstances (the particulars) forming the basis for the grounds (reg 5.2 “Definitions”).

The grounds of opposition under section 59 are limited to one or more of the following:

a. that the nominated person is either:
   i. not entitled to grant of a patent for the invention (section 33(1)); or
   ii. entitled to grant of a patent for the invention but only in conjunction with some other person (section 33(2));

b. that the invention is not a patentable invention (i.e. it does not satisfy the requirements of section 18);

c. that the specification filed in respect of the complete application does not comply with section 40(2) or 40(3).

For more information on the function and content of the statement of grounds and particulars see 3.4.2 The Statement of Grounds and Particulars.
Timing and requirements for filing the statement of grounds and particulars and the documents mentioned in the statement

**Note:** Where an opposition commenced before 15 April 2013; and the statement of grounds and particulars is due to be served on a party on or after 15 April 2013; and the statement has not been served before 15 April 2013; the statement must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy to the other party.

**Oppositions commenced before 15 April 2013**

In oppositions commenced before 15 April 2013, the opponent must file the statement of grounds and particulars in the approved form (available on the IP Australia website) within 3 months of filing the notice of opposition.

The relevant provisions are reg 5.4 as in force immediately before 15 April 2013, subject to reg 23.36(2).

**Oppositions commenced on or after 15 April 2013**

The opponent in an opposition under section 59 must file a statement of grounds and particulars in the approved form (available on the IP Australia website), within 3 months from the day the notice of opposition was filed.

The statement of grounds and particulars must be accompanied by a copy of each document mentioned in the statement unless the document is open for public inspection (see “Open for public inspection” below) and relates to a patent or patent application (reg 5.5(2)). The provision of documents at this stage of the opposition provides all parties with an early indication of the case to be answered.

The approved form of the statement of grounds and particulars contains a Schedule in which every document mentioned in the statement must be listed, together with an indication that:

- the document has been filed with the statement; or
- the document is open for public inspection (see “Open for public inspection” below) and relates to a patent or patent application. (Where the document is made open for public inspection on the file of a related Australian patent or patent application, the opponent must identify the relevant patent or patent application.)
3.2.1.2 Filing the Statement of Grounds and Particulars

Open for public inspection

A patent document is open for public inspection for the purposes of reg 5.5(2) if, at the time of filing the statement:

- the document was open to public inspection at the patent office in Australia; or
- the document relates to a PCT application designating Australia that had been published by World Intellectual Property Organisation (WIPO).

Unless the document is on the file of a related Australian application and thereby open for public inspection at the patent office in Australia, documents that are not open for public inspection include:

- any overseas patent specification (eg. US, EP, GB specifications);
- the specification of a patent application filed via the PCT designating Australia, that had not been published by WIPO at the time of filing the statement of grounds and particulars; and
- citations raised in examination and re-examination reports.

Initial processing of the statement

Once the opponent complies with the requirements of reg 5.5, or reg 5.4 as in force immediately before 15 April 2013 (subject to reg 23.36(2)), the opposition officer will give the applicant a copy of the statement and accompanying documents as soon as practicable.

Dismissal of the opposition

The Commissioner may dismiss the opposition if the prescribed documents are not filed with the statement
For oppositions commenced on or after 15 April 2013, if copies of the required documents are not filed with the statement of grounds and particulars, the Commissioner may dismiss the opposition under reg 5.18.

**Other grounds for dismissal**

Other grounds for dismissal of an opposition include that the opposition has no reasonable prospects of success. For more information see 3.7.2 Dismissal of an Opposition.

**Requests for dismissal**

The applicant may, **within 1 month** of receiving the statement of grounds and particulars, request the Commissioner to dismiss an opposition.

However, if the application is re-examined under section 97(1), the request for dismissal should be made **within 1 month** from the day re-examination is completed under reg 9.5.

The provisions governing dismissal are:

- for oppositions commenced on or after 15 April 2013, reg 5.17; or
- for oppositions commenced before 15 April 2013, reg 5.5 as in force immediately before15 April 2013.

For more information see 3.7.2 Dismissal of an Opposition.

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### Extending the time to file a statement of grounds and particulars

In some circumstances, an extension of time to file the statement of grounds and particulars may be available under section 223 (see 3.11.1 Extensions of Time – section 223).

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### Deficient particulars - further and better particulars

Where the particulars of the opposition are deficient, the applicant may request the Commissioner to issue a direction for further and better particulars.
3.2.1.3 Evidence and Evidentiary Periods

For more information on directions for further and better particulars, see 3.3.1.2.

Amending the statement of grounds and particulars

An opponent may request the Commissioner in writing to amend its statement of grounds and particulars to:

- correct an error or omission in the grounds of opposition;
- update the grounds of opposition to reflect an amendment to the complete specification to which the statement relates; or
- to amend the facts and circumstances (the particulars) forming the basis for the grounds.

However, the Commissioner has no power to amend the statement where an application for dismissal of the opposition is under consideration, or where an opposition under section 59 has commenced and re-examination of the specification is underway but not yet completed.

The relevant provisions are:

- for oppositions commenced on or after 15 April 2013, reg 5.16; or
- for oppositions commenced before 15 April 2013, reg 5.9 as in force immediately before 15 April 2013.

For more information see 3.4.3 Amending Opposition Documents.

Note: This information applies to oppositions commenced on or after 15 April 2013.

Where specified, the information applies to oppositions commenced before 15 April 2013, provided an evidentiary period commenced on or after 15 April 2013.
3.2.1.3 Evidence and Evidentiary Periods

**Note:** As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

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**General information**

For oppositions commenced on or after 15 April 2013, the procedures for filing evidence and the evidentiary periods in a substantive opposition are governed by regs 5.7 and 5.8, respectively.

In oppositions commenced prior to 15 April 2013, the evidentiary stages are governed by reg 5.8, as in force immediately before 15 April 2013, subject to reg 23.36(2).

For information on evidence in general see 3.5 Evidence.

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**Physical evidence**

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

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**Filing evidence**

**Note:** Where an opposition commenced before 15 April 2013, and evidence is due to be served on a party on or after 15 April 2013, and the evidence has not been served before 15 April 2013, the evidence must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy of the evidence to the other party.
In an opposition commenced before 15 April 2013, pursuant to reg 23.36(2), if the party is given the evidence after the date it is filed, the Commissioner will extend the subsequent evidentiary period by the number of days equal to the number of days between the filing date and the date the evidence was given to the other party.

After 15 April 2013, regardless of when the opposition commenced, a party seeking to rely on evidence in an opposition under section 59 must file the evidence with the Commissioner within the evidentiary periods indicated below.

**Note:** Physical evidence should not be filed unless requested or directed by the Commissioner.

Where an opposition commenced on or after 15 April 2013, if a party files all of the evidence before the end of an evidentiary period, the party must inform the Commissioner of this fact.

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**Initial processing of evidence**

When evidence is filed, it will be given to the other party and the opposition officer will acknowledge receipt to the parties. Unless the evidence is clearly stated to be “part evidence”, the opposition officer will confirm that all the evidence for the evidentiary period has been filed.

Where evidence is filed early, the other party will be given the evidence before the end of the evidentiary period. Otherwise, the evidence will be given to the other party as soon as practicable after the relevant evidentiary period ends. Where no evidence was filed, the other party will be notified accordingly.

Where appropriate, the opposition officer will advise the parties that the next evidentiary stage has commenced.

The times for filing evidence (the evidentiary periods) are as follows:

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**Evidence in support**
3.2.1.3 Evidence and Evidentiary Periods

**Note:** The provisions of reg 5.5(2), that documents mentioned in the statement of grounds and particulars must be filed with the statement, does not replace the need for documents to be adduced in evidence. All documents that the opponent intends to rely on to establish the grounds of opposition must be filed with the evidence in support. Alternatively, the Commissioner may, if requested by the opponent during the evidence in support period, direct that any documents filed together with the statement of grounds and particulars be treated as evidence in support.

The opponent must file any evidence in support of the opposition to grant of a standard patent **within 3 months** from the day the opponent files (or before 15 April 2013, serves) the statement of grounds and particulars.

**Evidence in answer**

**Oppositions commenced on or after 15 April 2013**

If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the evidence in support **within 3 months** from the day they are given a copy of the evidence and notified that all the evidence in support has been filed.

Where the opponent does **not** file any evidence in support, the applicant must file any evidence in answer to the statement of grounds and particulars **within 3 months** from the day the opposition officer notifies the applicant that no evidence in support was filed.

**Oppositions commenced before 15 April 2013**

Pursuant to reg 23.36(2), If the opponent files (or before 15 April 2013, serves) evidence in support of the opposition, the applicant must file any evidence in answer to the evidence in support **within 3 months** after being given (or being served with) the evidence in support.

Where the opponent does **not** provide any evidence in support of the opposition, the applicant must file any evidence in answer to the statement of grounds and particulars **within 3 months** from the day the evidence in support was due to be filed (or before 15 April 2013, served under the regulation in force immediately before 15 April 2013).
3.2.1.3 Evidence and Evidentiary Periods

Evidence in reply

**Oppositions commenced on or after 15 April 2013**

If the applicant files evidence in answer, the opponent must file any evidence in reply to the evidence in answer, **within 2 months** from the day the Commissioner gives a copy of the evidence in answer to the opponent and notifies the parties that all the evidence in answer has been filed.

**Oppositions commenced before 15 April 2013**

Pursuant to reg 23.36(2), if the applicant files (or before 15 April 2013, serves) evidence in answer, the opponent intending to rely on evidence in reply must, **within 1 month** of receiving the evidence, file:

- evidence in reply to the evidence in answer; or
- a copy of a notice of intention to serve evidence in reply.

Pursuant to reg 23.36(2), if a notice of intention is filed, the opponent must file the evidence in reply **within 3 months** of being given the evidence in answer (or, before 15 April 2013, served with the evidence in answer under reg 5.8, as in force immediately before 15 April 2013).

Extending an evidentiary period

**Where an evidentiary period commenced before 15 April 2013**

A party may apply under reg 5.10 as in force immediately before 15 April 2013, for an extension of an evidentiary period that commenced prior to 15 April 2013.

See 3.11 Extensions of Time.

**Where an evidentiary period commenced on or after 15 April 2013**

Under reg 5.9, the Commissioner may extend the time for filing evidence in an opposition, either on request of a party in writing, or on the Commissioner’s own initiative.
An extension of time to file evidence under reg 5.9 will only be available where the party making the request can establish that:

- the party seeking the extension has made all reasonable efforts to comply with all relevant filing requirements, and has been unable to file their evidence despite acting promptly and diligently to ensure it is filed in time; or

- there are exceptional circumstances that warrant the extension.

Where an extension of time to file evidence is refused, the requesting party will not be allowed a short extension to file evidence that is immediately available, or to validate evidence that has already been filed out of time.

For more information and the bases upon which an evidentiary period can be extended see 3.11 Extensions of Time.

Extensions of time in a substantive opposition are not available by direction

The Commissioner cannot make a direction under reg 5.22 to extend an evidentiary period in a substantive opposition.

However, where there is another proceeding or action in relation to an opposed application (e.g. amendments to the specification under section 104), it may be appropriate to stay the opposition until the other matter is finalised (see 3.3.1 Directions in Opposition Proceedings). A stay is an exceptional circumstance, and can form the basis for an extension of time.

Further evidence

Further evidence is not available for oppositions commenced on or after 15 April 2013.

For oppositions commenced before 15 April 2013, a party may request leave to file further evidence under the provisions of reg 5.10(4) as in force immediately before 15 April 2013.

Any request for an extension of time to file evidence responding to the further evidence, should be made under reg 5.10(2) as in force immediately before 15 April 2013. The request should be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 218 as in force before 15 April 2013). The request will be processed in accordance with reg 5.10(5) as in force immediately before 15 April 2013.
For more information on further evidence and extensions of time to file evidence responding to the further evidence see 3.5 Evidence.

3.2.1.4 Finalising the Opposition

Note: Unless explicitly stated otherwise, the information in this part applies to:

(i) oppositions commenced on or after 15 April 2013; and
(ii) oppositions commenced before 15 April 2013 in which the Commissioner has not set a hearing date or issued a notice of hearing to the parties before 15 April 2013, or re-examined the complete specification under section 97(1).

Pursuant to reg 23.36(2), for oppositions referred to in (ii), a reference in reg 5.20 (as in force from 15 April 2012) to regs 5.26, 5.19 or Part 5.4 should be read, respectively, as regs 5.15, 5.6 or 5.5 as in force immediately before 15 April 2013. Regulation 5.12 as in force before 15 April 2013 is taken not to apply.

In this topic:

Overview

Providing the opposition has not been withdrawn or dismissed, the next step in the opposition process is a hearing of the matter, after which a decision is issued. The function of the hearing is to enable the parties to fully present their views supported by reasons and evidence, in order that the hearing officer is in a position to make a correct and just decision.

Where an opposition has not been set for hearing prior to 15 April 2013, and no re-examination has taken place, the hearing and decision are governed by reg 5.20, subject to the transitional reg 23.36(2) where appropriate. Regulation 5.19 applies to the hearing and decision in oppositions commenced on or after 15 April 2013 where re-examination under section 97(1) is complete.
3.2.1.4 Finalising the Opposition

An opposition will be set for hearing either on the request of a party or on the Commissioner's own initiative. Once the hearing officer decides the opposition, the parties will be notified of the decision as soon as practicable.

For more information on hearings and decisions, see 3.9 Costs.

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**Timing and requirements for requesting a hearing of the opposition**

**After re-examination**

Where an opposition commenced on or after 15 April 2013 and the complete specification is re-examined under section 97(1), the Commissioner may hear the opposition if the opponent requests a hearing less than 1 month after the date that re-examination is completed under reg 9.5 (reg 5.19(2)(b)). A request for a hearing must be filed in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 230).

On receipt of a request, the opposition officer will give a copy to the applicant as soon as practicable.

**In other circumstances**

In other circumstances, providing the evidentiary periods have ended, and the opposition has not been withdrawn, dismissed or previously heard and decided, the opponent may request a hearing. The request must be made in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 230).

On receipt of a request for a hearing, the opposition officer will give a copy to the applicant as soon as practicable.

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**Nature of the hearing**

The hearing may be held orally or by written submissions at the Commissioner's discretion (reg 5.20(3)).
**Oral hearings**

Where the Commissioner decides on an oral hearing, the opposition officer will notify the parties of the date, time and place of the hearing. For more information on the hearing process, see 3.8 Hearings and Decisions.

**Regulation 5.20(4)** requires both parties to file a summary of their submissions prior to the hearing. The opponent must file the summary at least 10 business days before the hearing, and the applicant at least 5 business days before the hearing.

**Note:** As of 15 April 2013, the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

If a party fails to file a summary of submissions within the time prescribed by the regulations, under reg 5.20(6), the hearing officer will consider this in making an award of costs in the opposition.

On receipt of a summary of submissions, the opposition officer will give a copy of a party’s summary to the other party as soon as practicable.

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**Hearings by written submissions**

Where an opposition is set for hearing by written submissions, the delegate will issue a direction to the parties specifying the process and time frame in which the written submissions are to be filed (see 3.3.1 Directions in Opposition Proceedings).

For more information on the hearing process, see 3.8 Hearings and Decisions.

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**The decision**

Once the opposition is decided, the parties will be notified of the decision as soon as practicable. For more information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs in the opposition. For more information on costs see 3.9 Costs.

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**Appeal of a decision**

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
The hearing officer’s decision in an opposition under section 59 to grant of a patent may be appealed to the Federal Court under section 60(4).

3.2.2 Section 101M - Opposition to an Innovation Patent

Modified Date: 02 April 2013

3.2.2 Section 101M - Opposition to an Innovation Patent

Note: This information applies on or after 15 April 2013.

In this topic:

Relevant Legislation

The Act

Section 18  Patentable inventions
Section 33  Applications by opponents etc.
Section 40  Specifications
Chapter 9A  Examination, re-examination and opposition – innovation patents
Section 223  Extensions of time

The Regulations

Chapter 5  Opposition
Reg 22.8  Costs
Overview

Under section 101M of the Patents Act 1990, the Minister or any other person may, in accordance with the regulations, oppose a certified innovation patent and seek revocation of it, on one or more of the following grounds of invalidity, but no others:

a. that the patentee is either:
   i. not entitled to the patent (section 33(3))
   ii. entitled to the patent but only in conjunction with some other person (section 33(4));

b. that the complete specification does not comply with section 40(2) or 40(3);

c. that the invention is not a patentable invention because it does not comply with paragraph 18(1A)(a), (b) or (c);

d. that the invention is not a patentable invention under subsection 18(2) or (3).

An opposition to an innovation patent will generally be filed by a person (the "opponent") who is in some way affected by the certified patent. The opposition process provides the opponent with the opportunity to make out a case in order to persuade the Commissioner that the patent should be revoked.

An opposition under section 101M commences when a person files a notice of opposition, a statement of grounds and particulars and the evidence in support of the opposition, and pays the appropriate fee. The parties are provided with periods for filing evidence in answer and reply, after which the Commissioner will hear and decide the matter.

The procedures involved in this process are explained more fully in the following sections.
3.2.2.1 Commencing the Opposition - Filing the Opposition Documents

**Note:** This information applies to oppositions commenced **on and after** 15 April 2013.

**Note:** As of 15 April 2013, the opposition documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

Please contact the Oppositions and Examination Practice section by email at OHL@ipaustralia.gov.au or by phone on 1300 651 010 before filing the opposition documents.

In this topic:

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### Timing and requirements for filing the opposition documents

When an innovation patent is examined and the Commissioner is satisfied that the requirements for certification have been met, a notice to this effect is advertised in the *Official Journal of Patents* under section 101E(2)(b).

At any time after certification, a person may oppose an innovation patent under reg 5.6. To commence the opposition, the person must:

- pay the fee for filing a notice of opposition (see Schedule 7, item 216); and
- file all of the following documents with the Commissioner **at the same time**:
  - a notice of opposition in the approved form (available on the IP Australia website);
  - a statement of grounds and particulars in the approved form (available on the IP Australia website);
  - the evidence in support of the opposition; and
  - a copy of each document mentioned in the statement of grounds and particulars, **unless**:
    - i. the document is open for public inspection and relates to a patent or patent application and/or
    - ii. the document has been filed as evidence in support.
The statement of grounds and particulars

The statement of grounds and particulars must set out the grounds the opponent intends to rely on to establish the opposition, and the facts and circumstances (the particulars) forming the basis for the grounds (reg 5.2 "Definitions").

The grounds of opposition under section 101M are limited to one or more of the following:

a. that the patentee is either:
   i. not entitled to the patent (section 33(3))
   ii. entitled to the patent but only in conjunction with some other person (section 33(4));

b. that the complete specification does not comply with section 40(2) or 40(3);

c. that the invention is not a patentable invention because it does not comply with paragraph 18(1A)(a), (b) or (c);

d. that the invention is not a patentable invention under subsection 18(2) or (3).

For more information on the function and content of the statement of grounds and particulars see 3.4.2 The Statement of Grounds and Particulars.

The approved form of the statement of grounds and particulars (available on the IP Australia website) contains a Schedule in which every document mentioned in the statement must be listed, together with an indication that:

- the document has been filed with the statement; or
- the document has been filed with the evidence in support; or
- the document is open for public inspection (see "Open for public inspection" below) and relates to a patent or patent application. (Where the document is made open for public inspection on the file of a related Australian patent or patent application, the opponent must identify the relevant patent or patent application.)

Note: The requirement of reg 5.6(1)(c), that documents mentioned in the statement of grounds and particulars must be filed with the opposition documents, does not replace the need for the cited documents to be adduced in evidence. All documents that the opponent intends to rely on to establish the grounds of opposition must be filed as part of the evidence in support.
Open for public inspection

A patent document is open for public inspection for the purposes of reg 5.6(1)(c) if, at the time of filing the statement:

- the document is open for public inspection at the patent office in Australia; or
- the document relates to a PCT application designating Australia that had been published by World Intellectual Property Organisation (WIPO).

Unless the document is on the file of a related Australian application and thereby open for public inspection at the patent office in Australia, documents that are not open for public inspection include:

- any overseas patent specification (eg. US, EP, GB specifications);
- the specification of a patent application filed via the PCT designating Australia, that had not been published by WIPO at the time of filing the statement of grounds and particulars; and
- citations raised in examination and re-examination reports.

Initial processing of the opposition documents

Once the opponent has complied with requirements of reg 5.6(1)-(2), the opposition officer will acknowledge receipt of the documents to the parties, and give the patentee a copy as soon as practicable.

Deficient particulars - further and better particulars

Where the particulars of the opposition are deficient, the patentee may request the Commissioner to issue a direction for further and better particulars.

For more information on directions for further and better particulars see 3.3.1.2.
3.2.2.1 Commencing the Opposition - Filing the Opposition Documents

Amending opposition documents

The notice of opposition

Under regs 5.14 and 5.15, an opponent may request an amendment to the notice of opposition to correct a clerical error or obvious mistake, or to change the name of the opponent where the opponent’s right or interest in an opposition is transferred to another person.

For more information, see 3.4.3 Amending Opposition Documents.

The statement of grounds and particulars

Under reg 5.16, an opponent may request the Commissioner in writing to amend its statement of grounds and particulars to:

- correct an error or omission in the grounds of opposition; or
- update the grounds of opposition to reflect an amendment to the complete specification to which the statement relates; or
- to amend the facts and circumstances (the particulars) forming the basis for the grounds.

However, the Commissioner has no power to amend the statement where an application for dismissal of the opposition is under consideration (reg 5.16(3)(a))

For more information, see 3.4.3 Amending Opposition Documents.

Dismissal of the opposition

The Commissioner may dismiss the opposition if the prescribed documents are not filed with the statement
If copies of the required documents are not filed with the opposition documents or as part of the evidence in support, the Commissioner may dismiss the opposition under reg 5.18(2).

**Other grounds for dismissal**

Other grounds for dismissal of an opposition include that the opposition has no reasonable prospects of success. For more information see 3.7.2 Dismissal of an opposition.

**Requests for dismissal of the opposition**

Under reg 5.17 a patentee may, **within 1 month** of the receipt of the statement of grounds and particulars, request the Commissioner to dismiss an opposition.

For more information, see 3.7.2 Dismissal of an opposition.

**Withdrawal of the opposition**

Under reg 5.26, an opponent may withdraw an opposition at any time, by filing a notice of withdrawal in the approved form (available of the IP Australia website). For notices of withdrawal filed **before** 25 August 2018 there is a requirement that the notice be signed.

For more information, see 3.7.1 Withdrawal of an Opposition.

**Note:** This information applies to oppositions commenced **on or after** 15 April 2013. Where specified, the information applies to oppositions commenced **before** 15 April 2013, **provided an evidentiary period commenced on or after** 15 April 2013.
3.2.2.2 Evidence and Evidentiary Periods

**Note:** As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

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**General information**

For oppositions commenced on or after 15 April 2013, the procedures for filing evidence and the evidentiary periods in a substantive opposition are governed by regs 5.7 and 5.8, respectively.

In oppositions commenced prior to 15 April 2013, the evidentiary stages are governed by reg 5.8, as in force immediately before 15 April 2013, subject to reg 23.36(2).

For information on evidence in general see 3.5 Evidence.

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**Physical evidence**

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

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**Filing evidence**

**Note:** Where an opposition commenced before 15 April 2013, and evidence is due to be served on a party on or after 15 April 2013, and the evidence has not been served before 15 April 2013, the evidence must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy of the evidence to the other party.
3.2.2.2 Evidence and Evidentiary Periods

In an opposition commenced before 15 April 2013, pursuant to reg 23.36(2), if the party is given the evidence after the date it is filed, the Commissioner will extend the subsequent evidentiary period by the number of days equal to the number of days between the filing date and the date the evidence was given to the other party.

On or after 15 April 2013, regardless of when the opposition commenced, a party seeking to rely on evidence in an opposition under section 101M must file the evidence with the Commissioner within the evidentiary periods indicated below.

Note: Physical evidence should not be filed unless requested or directed by the Commissioner.

Where an opposition commenced on or after 15 April 2013, if a party files all of the evidence before the end of an evidentiary period, the party must inform the Commissioner of this fact.

Initial processing of evidence

When evidence is filed, it will be given to the other party and the opposition officer will acknowledge receipt to the parties. Unless the evidence is clearly stated to be “part evidence”, the opposition officer will confirm that all the evidence for the evidentiary period has been filed.

Where evidence is filed early, the other party will be given the evidence before the end of the evidentiary period. Otherwise, the other party will be given the evidence as soon as practicable after the relevant evidentiary period ends. Where no evidence was filed, the other party will be notified accordingly.

Where appropriate, the opposition officer will advise the parties that the next evidentiary stage has commenced.

The times for filing evidence are as follows:

Evidence in support
3.2.2.2 Evidence and Evidentiary Periods

Note: The provisions of reg 5.5(2), that documents mentioned in the statement of grounds and particulars must be filed with the statement, does not replace the need for documents to be adduced in evidence. All documents that the opponent intends to rely on to establish the grounds of opposition must be filed with the evidence in support.

The opponent must file any evidence in support of the opposition to an innovation patent at the same time as it files the opposition documents under reg 5.6(1).

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Evidence in answer

Oppositions commenced on or after 15 April 2013

If the opponent files evidence in support of the opposition, the patentee must file any evidence in answer to the evidence in support within 3 months from the day they are given a copy of the evidence and notified that all the evidence in support has been filed.

Where the opponent does not file any evidence in support, the patentee must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the opposition officer notifies the patentee that no evidence in support was filed.

Oppositions commenced before 15 April 2013

Pursuant to reg 23.36(2), if the opponent served evidence in support of the opposition, the patentee must file any evidence in answer to the evidence in support within 3 months after being served with the evidence in support.

Where the opponent does not provide any evidence in support of the opposition, the patentee must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the notice of opposition and the statement was served.

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Evidence in reply

Oppositions commenced on or after 15 April 2013
If the patentee files evidence in answer, the opponent must file any evidence in reply to the evidence in answer, **within 2 months** from the day the opposition officer notifies the parties that all the evidence in answer has been filed.

**Oppositions commenced before 15 April 2013**

Pursuant to reg 23.36(2), if the patentee files (or before 15 April 2013, serves) evidence in answer, the opponent intending to rely on evidence in reply must, **within 1 month** of being given or served with the evidence, file:

- evidence in reply to the evidence in answer; or
- a copy of a notice of intention to serve evidence in reply.

Pursuant to reg 23.36(2), if a notice of intention is filed, the opponent must file the evidence in reply **within 3 months** of being given the evidence in answer (or, before 15 April 2013, served with the evidence in answer under reg 5.8, as in force immediately before 15 April 2013).

**Extending an evidentiary period**

**Where an evidentiary period commenced before 15 April 2013**

A party may apply under reg 5.10 as in force immediately before 15 April 2013, for an extension of an evidentiary period that commenced prior to 15 April 2013.

See 3.11 Extensions of Time.

**Where an evidentiary period commenced on or after 15 April 2013**

Under reg 5.9, the Commissioner may extend the time for filing evidence in an opposition, either on request of a party in writing, or on the Commissioner’s own initiative.

An extension of time to file evidence under reg 5.9 will only be available where the party making the request can establish that:
3.2.2.2 Evidence and Evidentiary Periods

- the party seeking the extension has made all reasonable efforts to comply with all relevant filing requirements, and has been unable to file their evidence despite acting promptly and diligently to ensure it is filed in time; or
- there are exceptional circumstances that warrant the extension.

Where an extension of time to file evidence is refused, the requesting party will not be allowed a short extension to file evidence that is immediately available, or to validate evidence that has already been filed out of time.

For more information and the bases upon which an evidentiary period can be extended see 3.11 Extensions of Time.

Extensions of time in a substantive opposition are not available by direction

The Commissioner cannot make a direction under reg 5.22 to extend an evidentiary period in a substantive opposition.

However, where there is another proceeding or action in relation to an opposed application (eg. amendments to the specification under section 104), it may be appropriate to stay the opposition until the other matter is finalised (see 3.3.1 Directions in Opposition Proceedings). A stay is an exceptional circumstance, and can form the basis for an extension of time.

Further evidence

Further evidence is not available for oppositions commenced on or after 15 April 2013.

For oppositions commenced before 15 April 2013, a party may request leave to file further evidence under the provisions of reg 5.10(4) as in force immediately before 15 April 2013.

Any request for an extension of time to file evidence responding to the further evidence, should be made under reg 5.10(2) as in force immediately before 15 April 2013. The request should be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 218 as in force before 15 April 2013). The request will be processed in accordance with reg 5.10(5) as in force immediately before 15 April 2013.

For more information on further evidence and extensions of time to file evidence responding to the further evidence see 3.5 Evidence.
3.2.2.3 Finalising the Opposition

**Note:** Unless explicitly stated otherwise, the information in this part applies to:

(i) oppositions commenced on or after 15 April 2013; and
(ii) oppositions commenced before 15 April 2013 in which the Commissioner has not set a hearing date or issued a notice of hearing to the parties before 15 April 2013.

Pursuant to reg 23.36(2), for oppositions referred to in (ii), a reference in reg 5.20 (as in force from 15 April 2012) to regs 5.26, 5.19 or Part 5.4 should be read, respectively, as regs 5.15, 5.6 or 5.5 as in force immediately before 15 April 2013. Regulation 5.12 as in force before 15 April 2013 is taken not to apply.

In this topic:

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### Overview

Providing the opposition has not been withdrawn or dismissed, the next step in the opposition process is a hearing of the matter, after which a decision is issued. The function of the hearing is to enable the parties to fully present their views supported by reasons and evidence, in order that the hearing officer is in a position to make a correct and just decision.

Where an opposition has not been set for hearing prior to 15 April 2013, the hearing and decision are governed by reg 5.20, subject to reg 23.36(2) where appropriate.

An opposition will be set for hearing either on the request of a party or on the Commissioner's own initiative. Once the hearing officer decides the opposition, the parties will be notified of the decision as soon as practicable.

For more information on hearings and decisions, see 3.9 Costs.

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Effective Date: 25 September 2019
3.2.2.3 Finalising the Opposition

Timing and requirements for requesting a hearing

Providing the evidentiary periods have ended, and the opposition has not been withdrawn, dismissed or previously heard and decided, the opponent may request a hearing. The request must be made in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 230).

On receipt of a request for a hearing, the opposition officer will give a copy to the patentee as soon as practicable.

Nature of the hearing

The hearing may be held orally or by written submissions at the Commissioner’s discretion (reg 5.20(3)).

Oral hearings

Where the Commissioner decides on an oral hearing, the opposition officer will notify the parties of the date, time and place of the hearing. For more information on the oral hearing process, see 3.8 Hearings and Decisions.

Regulation 5.20(4) requires both parties to file a summary of their submissions prior to the hearing. The opponent must file the summary at least 10 business days before the hearing, and the patentee at least 5 business days before the hearing.

**Note:** As of 15 April 2013, the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

If a party fails to file a summary of submissions within the time prescribed by the regulations, under reg 5.20(6), the hearing officer will consider this in making an award of costs in the opposition.

On receipt of a summary of submissions, the opposition officer will give a copy of a party’s summary to the other party as soon as practicable.

Hearings by written submissions
Where an opposition is set for hearing by written submissions, the delegate will issue a direction to the parties specifying the process and time frame in which the written submissions are to be filed (see 3.3.1 Directions in Opposition Proceedings).

For more information on the hearing process, see 3.8 Hearings and Decisions.

### The Decision

Once the opposition is decided, the parties will be notified of the decision as soon as practicable. For more information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs in the opposition. For more information on costs see 3.9 Costs.

### Appeal of a Decision

The hearing officer’s decision in an opposition under section 101M to an innovation patent may be appealed to the Federal Court under section 101N(7).

3.2.3 Section 75(1) - Opposition to an Extension of Term of a Pharmaceutical Patent

Modified Date: 02 April 2013

3.2.3 Section 75(1) - Opposition to an Extension of Term of a Pharmaceutical Patent

**Note:** This information applies on and after 15 April 2013.

In this topic:
3.2.3 Section 75(1) - Opposition to an Extension of Term of a Pharmaceutical Patent

Relevant Legislation

The Act

Chapter 6  Grant and term of patents
Section 223  Extensions of time

The Regulations

Chapter 5  Opposition
Reg 9.5  Completion of re-examination
Reg 22.8  Costs
Reg 23.36(2)  Transitional provisions
Schedule 7  Fees

Overview

Under section 75 of the Patents Act 1990, the Minister or any other person may oppose the grant of an extension of the term of a standard patent. The opposition may only be on the ground that one or more of the requirements of sections 70 and 71 are not satisfied in relation to the application for an extension of term.

An opposition to an extension of term of the patent is generally filed by a person (the “opponent”) who would be in some way affected by the grant. The opposition process provides the opponent with the opportunity to make out a case to persuade the Commissioner that the term of the patent should not be extended.

Since the only grounds for opposition are that the application for extension of the patent (section 70) and the form and timing of the application (section 71) have not met the requirements of the Act, patentability issues such as novelty, inventive step, manner of manufacture and utility cannot be brought into the opposition.
An opposition under section 75(1) commences when a person files a notice of opposition in the approved form within the period allowed by the regulations, and pays the appropriate fee. Subsequently, the opponent files a statement of grounds and particulars, setting out the grounds upon which the extension of term is opposed, and the facts and circumstances supporting the grounds. Both parties are provided with periods for filing evidence to establish their respective cases, after which the Commissioner will hear and decide the matter.

The procedures involved in this process are explained more fully in the following sections.

**Note:** This information applies on and after 15 April 2013.

In this topic:

## Timing and requirements for filing a notice of opposition

When an application for an extension of term of a standard patent is accepted, a notice of acceptance is published in the *Official Journal of Patents* under section 74(2)(b).

To oppose the grant of an extension of term of a standard patent under section 75(1) of the Patents Act, a person must file a notice of opposition with the Commissioner within 3 months from the day the notice of acceptance is published. The notice of opposition must be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (see Schedule 7, item 216).

When a notice of opposition is filed, the opposition officer will acknowledge receipt of the notice to the opponent and the patentee ("the parties") and will give the patentee a copy of the notice.
Extending the time to file a notice of opposition

In some circumstances, a short extension of time to file a notice of opposition may be available under section 223 (see 3.11.1 Extensions of Time – section 223). However, once an extension of term is granted, a notice of opposition will have no effect.

Amending a notice of opposition

Under regs 5.14 and 5.15, an opponent may request an amendment to the notice of opposition to correct a clerical error or obvious mistake, or to change the name of the opponent where the opponent’s right or interest in an opposition is transferred to another person.

For more information see 3.4.3 Amending opposition documents.

Withdrawal of the opposition

An opponent may withdraw an opposition at any time, by filing a signed notice of withdrawal in the approved form (available on the IP Australia website).

For more information see 3.7.1 Withdrawal of an Opposition.

3.2.3.2 Filing the Statement of Grounds and Particulars

Note: This information applies to oppositions commenced on or after 15 April 2013. Where specified, information is also provided for oppositions commenced before 15 April 2013 in which the statement of grounds and particulars was not served before 15 April 2013.
3.2.3.2 Filing the Statement of Grounds and Particulars

**Note:** As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

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**The statement**

The statement of grounds and particulars in an opposition under section 75(1) is governed by reg 5.5, or, for oppositions commenced before 15 April 2013, reg 5.4 as in force immediately before 15 April 2013.

The statement of grounds and particulars must set out the grounds the opponent intends to rely on to establish the opposition, and the facts and circumstances (the particulars) forming the basis for the grounds (reg 5.2 “Definitions”).

An opposition under section 75(1) to the grant of an extension of term of a standard patent must be made on the ground that one or more of the requirements of sections 70 and 71 are not satisfied in relation to the application for the patent term extension.

For more information on the function and content of the statement of grounds and particulars see 3.4.2 The Statement of Grounds and Particulars.

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**Timing and requirements for filing the statement of grounds and particulars and the documents mentioned in the statement**

**Note:** Where an opposition commenced before 15 April 2013; and the statement of grounds and particulars is due to be served on a party on or after 15 April 2013; and the statement has not been served before 15 April 2013; the statement must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy to the other party.
Oppositions commenced before 15 April 2013

In oppositions commenced before 15 April 2013, the opponent must file the statement of grounds and particulars in the approved form (available on the IP Australia website) within 3 months of filing the notice of opposition.

The relevant provisions are reg 5.4 as in force immediately before 15 April 2013, subject to reg 23.36(2).

Oppositions commenced on or after 15 April 2013

The opponent in an opposition under section 75(1) must file a statement of grounds and particulars with the Commissioner in the approved form (available on the IP Australia website) within 3 months from the day the notice of opposition was filed.

The statement must be accompanied by a copy of each document mentioned in the statement, unless the document is open for public inspection and relates to a patent or patent application (reg 5.5(2)). The provision of documents at this stage of the opposition provides all parties with an early indication of the case to be answered.

The approved form of the statement of grounds and particulars (available on the IP Australia website) contains a Schedule in which every document mentioned in the statement must be listed, together with an indication that:

- the document has been filed with the statement; or
- the document is open for public inspection and relates to a patent or patent application. (Where the document is made open for public inspection on the file of a related Australian patent or patent application, the opponent must identify the relevant patent or patent application.)

If required, more information regarding the meaning of open for public inspection for the purposes of reg 5.5(2) can be found at 3.2.1.2 under the heading “Open for public inspection in Australia”.

Initial processing of the statement

Once the opponent complies with the requirements of reg 5.5(2), or reg 5.4 as in force immediately before 15 April 2013 (subject to reg 23.36(2)), the opposition officer will give the patentee a copy of the statement and accompanying documents as soon as practicable.
3.2.3.2 Filing the Statement of Grounds and Particulars

Dismissal of the opposition

The Commissioner may dismiss the opposition if the prescribed documents are not filed with the statement

For oppositions commenced on or after 15 April 2013, if copies of the required documents are not filed with the statement of grounds and particulars, the Commissioner may dismiss the opposition under reg 5.18.

Other grounds for dismissal

Other grounds for dismissal of an opposition include that the opposition has no reasonable prospects of success. For more information see 3.7.2 Dismissal of an Opposition.

Requests for dismissal

A patentee may, within 1 month of receiving the statement of grounds and particulars, request the Commissioner to dismiss an opposition.

The provisions governing dismissal are:

- for oppositions commenced on or after 15 April 2013, reg 5.17; or
- for oppositions commenced before 15 April 2013, reg 5.5 as in force immediately before 15 April 2013.

For more information see 3.7.2 Dismissal of an Opposition.

Extending the time to file a statement of grounds and particulars
3.2.3.3 Evidence and Evidentiary Periods

In some circumstances, an extension of time to file the statement of grounds and particulars may be available under section 223 (see 3.11.1 Extensions of Time – section 223).

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**Deficient particulars - further and better particulars**

Where the particulars of the opposition are deficient, the patentee may request the Commissioner to issue a direction for further and better particulars.

For more information on directions for further and better particulars, see 3.3.1.2.

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**Amending the statement of grounds and particulars**

An opponent may request the Commissioner in writing to amend its statement of grounds and particulars to correct an error or omission in the grounds of opposition, or to amend the facts and circumstances (the particulars) forming the basis for the grounds.

However, the Commissioner has no power to amend the statement where an application for dismissal of the opposition is under consideration.

The relevant provisions are:

- for oppositions commenced on or after 15 April 2013, reg 5.16; or
- for oppositions commenced before 15 April 2013, reg 5.9 as in force immediately before 15 April 2013.

For more information see 3.4.3 Amending Opposition Documents.

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Note: This information applies to oppositions commenced on or after 15 April 2013.

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Where specified, the information applies to oppositions commenced before 15 April 2013, provided an evidentiary period commenced on or after 15 April 2013.

Note: As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

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### General information

For oppositions commenced on or after 15 April 2013, the procedures for filing evidence and the evidentiary periods in a substantive opposition are governed by regs 5.7 and 5.8, respectively.

In oppositions commenced prior to 15 April 2013, the evidentiary stages are governed by reg 5.8, as in force immediately before 15 April 2013, subject to reg 23.36(2).

For information on evidence in general see 3.5 Evidence.

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### Physical evidence

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

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### Filing evidence

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
3.2.3.3 Evidence and Evidentiary Periods

Note: Where an opposition commenced before 15 April 2013, and evidence is due to be served on a party on or after 15 April 2013, and the evidence has not been served before 15 April 2013, the evidence must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy of the evidence to the other party.

In an opposition commenced before 15 April 2013, pursuant to reg 23.36(2), if the party is given the evidence after the date it is filed, the Commissioner will extend the subsequent evidentiary period by the number of days equal to the number of days between the filing date and the date the evidence was given to the other party.

After 15 April 2013, regardless of when the opposition commenced, a party seeking to rely on evidence in an opposition under section 75(1) must file the evidence with the Commissioner, within the evidentiary periods indicated below.

Note: Physical evidence should not be filed unless requested or directed by the Commissioner.

Where an opposition commenced on or after 15 April 2013, if a party files all of the evidence before the end of an evidentiary period, the party must inform the Commissioner of this fact.

Initial processing of evidence

When evidence is filed, it will be given to the other party and the opposition officer will acknowledge receipt to the parties. Unless the evidence is clearly stated to be “part evidence”, the opposition officer will confirm that all the evidence for the evidentiary period has been filed.

Where evidence is filed early, the other party will be given the evidence before the end of the evidentiary period. Otherwise, the other party will be given the evidence as soon as practicable after the relevant evidentiary period ends. Where no evidence was filed, the other party will be notified accordingly.

Where appropriate, the opposition officer will advise the parties that the next evidentiary stage has commenced.

The times for filing evidence (the evidentiary periods) are as follows:
3.2.3.3 Evidence and Evidentiary Periods

Evidence in support

Note: The provisions of reg 5.5(2), that documents mentioned in the statement of grounds and particulars must be filed with the statement, does not replace the need for documents to be adduced in evidence. All documents that the opponent intends to rely on to establish the grounds of opposition must be filed with the evidence in support.

The opponent must file any evidence in support of the opposition to an extension of term of a standard patent within 3 months from the day the opponent files (or before 15 April 2013, serves) the statement of grounds and particulars.

Evidence in answer

Oppositions commenced on or after 15 April 2013

If the opponent files evidence in support of the opposition, the patentee must file any evidence in answer to the evidence in support within 3 months from the day the Commissioner provides a copy of the evidence and notifies the patentee that all the evidence in support has been filed.

Where the opponent does not file any evidence in support of the opposition, the patentee must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Commissioner notifies the patentee that no evidence in support was filed.

Oppositions commenced before 15 April 2013

Pursuant to reg 23.36(2), if the opponent files (or before 15 April 2013, serves) evidence in support of the opposition, the patentee must file any evidence in answer to the evidence in support within 3 months after being given (or being served with) the evidence in support.

Where the opponent does not provide any evidence in support of the opposition, the patentee must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the evidence in support was due to be filed (or before 15 April 2013, served under the regulation in force immediately before 15 April 2013).
3.2.3.3 Evidence and Evidentiary Periods

Evidence in reply

Oppositions commenced on or after 15 April 2013

If the patentee files evidence in answer, the opponent must file any evidence in reply to the evidence in answer, **within 2 months** from the day the Commissioner gives a copy of the evidence in answer to the opponent and notifies the parties that all the evidence in answer has been filed.

Oppositions commenced before 15 April 2013

Pursuant to reg 23.36(2), if the patentee files (or before 15 April 2013, serves) evidence in answer, the opponent intending to rely on evidence in reply must, **within 1 month** of receiving given the evidence, file:

- evidence in reply to the evidence in answer; or
- a copy of a notice of intention to serve evidence in reply.

Pursuant to reg 23.36(2), if a notice of intention is filed, the opponent must file the evidence in reply **within 3 months** of being given the evidence in answer (or, before 15 April 2013, served with the evidence in answer under reg 5.8, as in force immediately before 15 April 2013).

Extending an evidentiary period

Where an evidentiary period commenced before 15 April 2013

A party may apply under reg 5.10 as in force immediately before 15 April 2013, for an extension of an evidentiary period that commenced prior to 15 April 2013.

See 3.11 Extensions of Time.
3.2.3.3 Evidence and Evidentiary Periods

Where an evidentiary period commenced on or after 15 April 2013

Under reg 5.9, the Commissioner may extend the time for filing evidence in an opposition, either on request of a party in writing, or on the Commissioner’s own initiative.

An extension of time to file evidence under reg 5.9 will only be available where the party making the request can establish that:

- the party seeking the extension has made all reasonable efforts to comply with all relevant filing requirements, and has been unable to file their evidence despite acting promptly and diligently to ensure it is filed in time; or
- there are exceptional circumstances that warrant the extension.

Where an extension of time to file evidence is refused, the requesting party will not be allowed a short extension to file evidence that is immediately available, or to validate evidence that has already been filed out of time.

For more information and the bases upon which an evidentiary period can be extended see 3.11 Extensions of Time.

Extensions of time in a substantice opposition are not available by direction

The Commissioner cannot make a direction under reg 5.22 to extend an evidentiary period in a substantive opposition.

However, where there is another proceeding or action in relation to an opposed application (eg. amendments to the specification under section 104), it may be appropriate to stay the opposition until the other matter is finalised (see 3.3.1 Directions in Opposition Proceedings). A stay is an exceptional circumstance, and can form the basis for an extension of time.

Further evidence

Further evidence is not available for oppositions commenced on or after 15 April 2013.

For oppositions commenced before 15 April 2013, a party may request leave to file further evidence under the provisions of reg 5.10(4) as in force immediately before 15 April 2013.

Any request for an extension of time to file evidence responding to the further evidence, should be made under reg 5.10(2) as in force immediately before 15 April 2013. The
request should be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 218 as in force before 15 April 2013). The request will be processed in accordance with reg 5.10(5) as in force immediately before 15 April 2013.

For more information on further evidence and extensions of time to file evidence responding to the further evidence see 3.5 Evidence.

Note: Unless explicitly stated otherwise, the information in this part applies to:

(i) oppositions commenced on or after 15 April 2013; and
(ii) oppositions commenced before 15 April 2013 in which the Commissioner has not set a hearing date or issued a notice of hearing to the parties before 15 April 2013.

Pursuant to reg 23.36(2), for oppositions referred to in (ii), a reference in reg 5.20 (as in force from 15 April 2012) to regs 5.26, 5.19 or Part 5.4 should be read, respectively, as regs 5.15, 5.6 or 5.5 as in force immediately before 15 April 2013. Regulation 5.12 as in force before 15 April 2013 is taken not to apply.

In this topic:

Overview

Providing the opposition has not been withdrawn or dismissed, the next step in the opposition process is a hearing of the matter, after which a decision is issued. The function of the hearing is to enable the parties to fully present their views supported by reasons and evidence, in order that the hearing officer is in a position to make a correct and just decision.

Where an opposition has not been set for hearing prior to 15 April 2013, the hearing and decision are governed by reg 5.20, subject to reg 23.36(2) where appropriate.
3.2.3.4 Finalising the Opposition

An opposition will be set for hearing either on the request of a party or on the Commissioner's own initiative. Once the hearing officer decides the opposition, the parties will be notified of the decision as soon as practicable.

For more information on hearings and decisions, see 3.9 Costs.

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Timing and requirements for requesting a hearing of the opposition

Providing the evidentiary periods have ended and the opposition has not been withdrawn, dismissed or previously heard and decided, the opponent may request a hearing. The request must be made in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 230).

On receipt of a request for a hearing, the opposition officer will give a copy to the patentee as soon as practicable.

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Nature of the hearing

The hearing may be held orally or by written submissions at the Commissioner's discretion (reg 5.20(3)).

Oral hearings

Where the Commissioner decides on an oral hearing, the opposition officer will notify the parties of the date, time and place of the hearing. For more information on the hearing process, see 3.8 Hearings and Decisions.

Regulation 5.20(4) requires both parties to file a summary of their submissions prior to the hearing. The opponent must file the summary at least 10 business days before the hearing, and the patentee at least 5 business days before the hearing.

If a party fails to file a summary of submissions within the time prescribed by the regulations, under reg 5.20(6), the hearing officer will consider this in making an award of costs in the opposition.
3.2.3.4 Finalising the Opposition

**Note:** As of 15 April 2013, the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

On receipt of a summary of submissions, the opposition officer will give a copy of a party’s summary to the other party as soon as practicable.

**Hearings by written submissions**

Where an opposition is set for hearing by written submissions, the delegate will issue a direction to the parties specifying the process and time frame in which the written submissions are to be filed (see 3.3.1 Directions in Opposition Proceedings).

For more information on the hearing process, see 3.8 Hearings and Decisions.

**The decision**

Once the opposition is decided, the parties will be notified of the decision as soon as practicable. For more information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs in the opposition. For more information on costs see 3.9 Costs.

**Appeal of a decision**

The hearing officer’s decision in an opposition under section 75(1) may be appealed to the Federal Court under section 75(4).

**3.2.4 Section 104(4) - Opposition to a Request to Amend a Filed Document**

Modified Date: 02 April 2013
3.2.4 Section 104(4) - Opposition to a Request to Amend a Filed Document

Note: This information applies on or after 15 April 2013.

In this topic:

Relevant Legislation

The Act

Chapter 10 Amendments
Section 104 Amendments by applicants and patentees
Section 223 Extensions of time

The Regulations

Chapter 5 Opposition
Reg 9.5 Completion of re-examination
Chapter 10 Amendments
Reg 22.8 Costs
Reg 23.36(2) Transitional provisions
Schedule 7 Fees

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Effective Date: 25 September 2019
Overview

Under section 104(4) of the *Patents Act*, the Minister or any other person may, subject to and in accordance with the regulations, oppose the Commissioner allowing an amendment to a patent request, specification or other filed document.

On and after 15 April 2013, a section 104 amendment request may only be opposed on the ground that the amendment is not allowable under section 102 or regulation 10.3.

An opposition to a request for leave to amend a relevant document is generally filed by a person (the "opponent") who will be in some way affected by the amendment. The opposition process provides the opponent with the opportunity to make out a case to persuade the Commissioner that the amendment should not be allowed.

An opposition under section 104(4) commences when a person files a notice of opposition in the approved form within the period allowed by the regulations, and pays the appropriate fee. Subsequently, the opponent files a statement of grounds and particulars, setting out the grounds upon which the amendment is opposed and the facts and circumstances supporting the grounds. Where appropriate, the parties will be provided with periods for filing evidence to establish their respective cases, after which the Commissioner will hear and decide the matter.

Under *reg 5.12*, the Commissioner may decide the practice and procedure to be followed and direct the parties accordingly.

The procedures involved in this process are explained more fully in the following sections.

3.2.4.1 Commencing the Opposition - Filing a Notice of Opposition

**Note:** This information applies **on or after** 15 April 2013.

In this topic:

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**Timing and requirements for filing a notice of opposition**

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
3.2.4.1 Commencing the Opposition - Filing a Notice of Opposition

When leave is granted to amend a filed document after acceptance, in certain circumstances a notice of that fact is published in the *Official Journal of Patents* under reg 10.5(2).

**Regulation 5.10(1)** sets out the requirements for the notice of opposition where a person seeks to oppose allowance of an advertised amendment.

**Amendment requests advertised on or after 15 April 2013**

To oppose an amendment request advertised under reg 10.5(2) on or after 15 April 2013, a person must file a notice of opposition with the Commissioner within 2 months from the day a notice is published that leave has been granted for the amendment (reg 5.10(1)).

**Amendment requests advertised before 15 April 2013**

Where the amendment request which was advertised before 15 April 2013, the opponent must file its notice of opposition with the Commissioner within 3 months from the day a notice is published that leave has been granted for the amendment (reg 5.10(1), subject to reg 23.36(2)).

In each case, the notice of opposition must be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (see Schedule 7, item 216).

The opposition officer will acknowledge receipt of the notice to the parties and give the patent applicant or patentee a copy of the notice as soon as practicable (reg 5.10(4)).

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**Extending the time to file a notice of opposition**

In some circumstances, a short extension of time to file a notice of opposition may be available under section 223 (see 3.11.1 Extensions of Time – section 223). However, a notice of opposition will be of no effect if it is filed after an amendment is allowed, or a patent granted in respect of the amended application.
3.2.4.2 Filing the Statement of Grounds and Particulars

**Amending a notice of opposition**

Under regs 5.14 and 5.15, an opponent may request an amendment to the notice of opposition to correct a clerical error or obvious mistake, or to change the name of the opponent where the opponent’s right or interest in an opposition is transferred to another person.

For more information see 3.4.3 Amending opposition documents.

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**Withdrawal of the opposition**

An opponent may withdraw an opposition at any time, by filing a signed notice of withdrawal in the approved form (available on the IP Australia website).

For more information see 3.7.1 Withdrawal of an Opposition.

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**3.2.4.2 Filing the Statement of Grounds and Particulars**

**Note:** This information applies to oppositions commenced on or after 15 April 2013. Where specified, information is also provided for oppositions commenced before 15 April 2013 in which the statement of grounds and particulars was not served before 15 April 2013.

**Note:** As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

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The statement

The statement of grounds and particulars in an opposition under section 104(4) is governed by reg 5.11 or, for oppositions commenced before 15 April 2013, reg 5.4 as in force immediately before 15 April 2013.

The statement of grounds and particulars must set out the grounds the opponent intends to rely on to establish the opposition, and the facts and circumstances (the particulars) forming the basis for the grounds (reg 5.2 "Definitions").

Under reg 5.21, the only ground for an opposition under section 104(4) is that the amendment is not allowable under section 102 or reg 10.3.

For more information on the function and content of the statement of grounds and particulars see 3.4.2 The Statement of Grounds and Particulars.

Timing and requirements for filing the statement of grounds and particulars

Note: Where an opposition commenced before 15 April 2013; and the statement of grounds and particulars is due to be served on a party on or after 15 April 2013; and the statement has not been served before 15 April 2013; the statement must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy to the other party.

Oppositions commenced before 15 April 2013

In oppositions commenced before 15 April 2013, the opponent must file the statement of grounds and particulars in the approved form (available on the IP Australia website) within 3 months of filing the notice of opposition.

The relevant provisions are reg 5.4 as in force immediately before 15 April 2013, subject to reg 23.36(2).

Oppositions commenced on or after 15 April 2013

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
3.2.4.2 Filing the Statement of Grounds and Particulars

Under reg 5.11 the opponent in a section 104(4) opposition must file a statement of grounds and particulars in the approved form (available on the IP Australia website) **within 1 month** from the day the notice of opposition was filed.

The statement of grounds and particulars must be accompanied by a copy of each document mentioned in the statement unless the document is open for public inspection (see “Open for public inspection” below) and relates to a patent or patent application (reg 5.11(2)). The provision of documents at this stage of the opposition provides all parties with an early indication of the case to be answered.

The approved form of the statement of grounds and particulars (available on the IP Australia website) contains a Schedule in which every document mentioned in the statement must be listed, together with an indication that:

- the document has been filed with the statement; or
- the document is open for public inspection (see “Open for public inspection” below) and relates to a patent or patent application. (Where the document is made open for public inspection on the file of a related Australian patent or patent application, the opponent must identify the relevant patent or patent application.)

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**Open for public inspection**

A document is open for public inspection for the purposes of reg 5.11(2) if, at the time of filing the statement:

- the document was open to public inspection at the patent office in Australia; or
- the document relates to a PCT application designating Australia that had been published by World Intellectual Property Organisation (WIPO).

**Unless** the document is on the file of a related Australian application and thereby open for public inspection at the patent office in Australia, documents that are **not** open for public inspection include:

- any overseas patent specification (e.g. US, EP, GB specifications);
- the specification of a patent application filed via the PCT designating Australia, that had not been published by WIPO at the time of filing the statement of grounds and particulars; and
- citations raised in examination and re-examination reports.
Initial processing of the statement

Once the opponent complies with the requirements of reg 5.11, or reg 5.4 as in force immediately before 15 April 2013 (subject to reg 23.36(2)), the opposition officer will give the applicant or patentee a copy of the statement and any accompanying documents as soon as practicable.

Dismissal of the opposition

The Commissioner may dismiss the opposition if the prescribed documents are not filed with the statement

For oppositions commenced on or after 15 April 2013, if copies of the required documents are not filed with the statement of grounds and particulars, the Commissioner may dismiss the opposition under reg 5.18.

Other grounds for dismissal

Other grounds for dismissal of an opposition include that the opposition has no reasonable prospects of success. For more information see 3.7.2 Dismissal of an Opposition.

Requests for dismissal

The applicant or patentee may, within 1 month of receiving the statement of grounds and particulars, request the Commissioner to dismiss an opposition.

The provisions for dismissal are:

- for oppositions commenced on or after 15 April 2013, reg 5.17; or
- for oppositions commenced before 15 April 2013, reg 5.5 as in force immediately before15 April 2013.

For more information, see 3.7.2 Dismissal of an Opposition.
3.2.4.2 Filing the Statement of Grounds and Particulars

Extending the time to file a statement of grounds and particulars

In some circumstances, an extension of time to file the statement of grounds and particulars may be available under section 223 (see 3.11.1 Extensions of Time – section 223).

Deficient particulars - further and better particulars

Where the particulars of the opposition are deficient, the applicant or patentee may request the Commissioner to issue a direction for further and better particulars.

For more information on directions for further and better particulars, see 3.3.1.2.

Amending the statement of grounds and particulars

An opponent may make a request in writing to amend its statement of grounds and particulars to correct an error or omission in the grounds of opposition, or to amend the facts and circumstances (the particulars) forming the basis for the grounds.

However, the Commissioner has no power to amend the statement where an application for dismissal of the opposition is under consideration.

The relevant provisions are:

- for oppositions commenced on or after 15 April 2013, reg 5.16; or
- for oppositions commenced before 15 April 2013, reg 5.9 as in force immediately before15 April 2013.

For more information see 3.4.3 Amending Opposition Documents.
3.2.4.3 Evidence and Evidentiary Periods

**Note:** Information is provided for oppositions commenced **before, on or after** 15 April 2013, as specified.

**Note:** As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

### General Information

For oppositions commenced before 15 April 2013, a party seeking to rely on evidence in an opposition under [section 104(4)](https://www.ipaustralia.gov.au) must file it with the Commissioner within the evidentiary periods prescribed by reg 5.8 as in force immediately before 15 April 2013, subject to [reg 23.36(2)](https://www.ipaustralia.gov.au).

For oppositions commenced on or after 15 April 2013, where a party wishes to file evidence the evidentiary periods will be set by direction under [reg 5.12](https://www.ipaustralia.gov.au).

The process and procedure for filing evidence is summarised below.

### Physical evidence

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

For information on evidence in general see [3.5 Evidence](https://www.ipaustralia.gov.au).

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Effective Date: 25 September 2019
Filing evidence in oppositions commenced before 15 April 2013

Note: Where an opposition commenced before 15 April 2013, and evidence is due to be served on a party on or after 15 April 2013, and the evidence has not been served before 15 April 2013, the evidence must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy of the evidence to the other party.

Pursuant to reg 23.36(2), if the party is given the evidence after the date it is filed, the Commissioner will extend the subsequent evidentiary period by the number of days equal to the number of days between the filing date and the date the evidence was given to the other party.

In oppositions commenced prior to 15 April 2013, the evidentiary stages are governed by reg 5.8, as in force immediately before 15 April 2013, subject to reg 23.36(2) where appropriate.

Note: Physical evidence should not be filed unless requested or directed by the Commissioner.

The evidentiary periods are as follows.

Evidence in support

After 15 April 2013, the opponent must file any evidence in support of the opposition within 3 months after the day the opponent files (or before 15 April 2013 serves) the statement of grounds and particulars (reg 5.8(1) as in force immediately before 15 April 2013, subject to reg 23.36(2) item 4).

Evidence in answer

If the opponent files (or before 15 April 2013 serves) evidence in support of the opposition, the applicant or patentee must file any evidence in answer to the evidence in support within 3 months after being given (or being served with) the evidence in support.

Where the opponent does not provide any evidence in support, the applicant or patentee must file any evidence in answer to the statement of grounds and particulars within 3 months.
3.2.4.3 Evidence and Evidentiary Periods

**Evidence and Evidentiary Periods**

**Evidence in reply**

If the applicant/patentee files (or before 15 April 2013 serves) evidence in answer, the opponent intending to rely on evidence in reply must, ***within 1 month*** of receiving the evidence, file:

- evidence in reply to the evidence in answer; or
- a copy of a notice of intention to serve evidence in reply.

If a notice of intention is filed, the opponent must file the evidence in reply ***within 3 months*** of being given (or, before 15 April 2013, being served with) the evidence in answer.

*(Reg 5.8(4) as in force immediately before 15 April 2013 subject to reg 23.36(2) item 4)*

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**Filing evidence in oppositions commenced on or after 15 April 2013**

Evidence is not always required or relied on in a procedural opposition. Therefore, for oppositions commenced on or after 15 April 2013, once the statement of grounds and particulars has been filed, the parties will be asked to indicate if they wish to file evidence.

**Note:** The provisions of *reg 5.11(2)*, that documents mentioned in the statement of grounds and particulars must be filed with the statement, does not replace the need for documents to be adduced in evidence. All documents that the opponent intends to rely on to establish the grounds of opposition must be included in the evidence in support.

A party intending to file evidence will be required to specify the nature and significance of the evidence, and how long they will need to prepare the evidence.

A delegate will consider the information, and propose a direction under *reg 5.12*. Where a direction is given for a party to file evidence, the other party will normally be provided with a period in which to file responding evidence. For more information on directions for evidence in a procedural opposition, see *3.3.1.4*.
3.2.4.3 Evidence and Evidentiary Periods

When evidence is filed, the opposition officer will acknowledge receipt to the parties and give a copy of the evidence to the other party.

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**Extending the time for filing evidence**

**Opposition and evidentiary period commenced before 15 April 2013**

A party may apply under reg 5.10(2) as in force immediately before 15 April 2013, for an extension of an evidentiary period that commenced prior to 15 April 2013.

See [3.11.3.2 Extensions under Reg 5.10(2)]

**Opposition commenced before 15 April 2013 and evidentiary period commenced on or after 15 April 2013**

Pursuant to reg 23.36(2) item 2, reg 5.9 applies to extend an evidentiary period in this situation.

For more information see [3.11.2 Extensions of Time – Reg 5.9] and [3.3.1.4 Time for Filing Evidence in a Procedural Opposition]

**Opposition and evidentiary period commenced on or after 15 April 2013**

In this situation, the Commissioner may extend an evidentiary period by direction under reg 5.12.

For more information see [3.3.1.4 Time for Filing Evidence in a Procedural Opposition]

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**Further evidence**

Further evidence is not available for oppositions commenced on or after 15 April 2013.
For oppositions commenced before 15 April 2013, a party may request leave to file further evidence under the provisions of reg 5.10(4) as in force immediately before 15 April 2013.

Any request for an extension of time to file further evidence or evidence responding to the further evidence, should be made under reg 5.10(2) as in force immediately before 15 April 2013. The request should be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 218 as in force before 15 April 2013).

The request will be processed in accordance with reg 5.10(5) as in force immediately before 15 April 2013.

For more information on extensions of time under reg 5.10(2) as in force immediately before 15 April 2013 see 3.11.3.2.

Modified Date: 02 April 2013

3.2.4.4 Finalising the Opposition

Note: Unless explicitly stated otherwise, the information in this part applies to:

(i) oppositions commenced on or after 15 April 2013; and
(ii) oppositions commenced before 15 April 2013 in which the Commissioner has not set a hearing date or issued a notice of hearing to the parties before 15 April 2013.

For oppositions referred to in (ii), a reference in reg 5.20 (as in force from 15 April 2012) to regs 5.26, 5.19 or Part 5.4 should be read as regs 5.15, 5.6 or 5.5, respectively, as in force immediately before 15 April 2013. Regulation 5.12 as in force before 15 April 2013 is taken not to apply.

In this topic:

Overview

Providing the opposition has not been withdrawn or dismissed, the next step in the opposition process is a hearing of the matter, after which a decision is issued. The function of the hearing is to enable the parties to fully present their views supported by reasons and
3.2.4.4 Finalising the Opposition

evidence, in order that the hearing officer is in a position to make a correct and just decision.

Where an opposition has not been set for hearing prior to 15 April 2013, the hearing and decision are governed by reg 5.20 subject to the transitional reg 23.36(2) where appropriate.

An opposition will be set for hearing either on the request of a party or on the Commissioner's own initiative. Once the hearing officer decides the opposition, the parties will be notified of the decision as soon as practicable.

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Timing and requirements for requesting a hearing

Providing any evidentiary periods have ended, and the opposition has not been withdrawn, dismissed or previously heard and decided, the opponent may request a hearing. The request must be made in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 230).

On receipt of a request for a hearing, the opposition officer will give a copy to the applicant or patentee.

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Nature of the hearing

The hearing may be held orally or by written submissions at the Commissioner's discretion (reg 5.20(3)).

Oral hearings

Where the Commissioner decides on an oral hearing, the opposition officer will notify the parties of the date, time and place of the hearing. For more information on the hearing process, see 3.8 Hearings and Decisions.

Reg 5.20(4) requires both parties to file a summary of their submissions prior to the hearing. The opponent must file the summary at least 10 business days before the hearing, and the applicant or patentee at least 5 business days before the hearing.
If a party fails to file a summary of submissions within the time prescribed by the regulations, under reg 5.20(6), the hearing officer will consider this in making an award of costs in the opposition.

**Note:** As of 15 April 2013, the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

On receipt of a summary of submissions, the opposition officer will give a copy of a party’s summary to the other party as soon as practicable.

### Hearings by written submissions

Where an opposition is set for hearing by written submissions, the delegate will issue a direction to the parties specifying the process and time frame in which the written submissions are to be filed (see 3.3.1 Directions in Opposition Proceedings).

For more information on the hearing process, see 3.8 Hearings and Decisions.

### The decision

Once the opposition is decided, the parties will be notified of the decision. For more information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs in the opposition. For more information on costs see 3.9 Costs.

### Appeal of a decision

The hearing officer’s decision in an opposition under section 104(4) to a request for leave to amend may be appealed to the Federal Court under section 104(7).

**3.2.5 Section 223(6) - Opposition to an Extension of Time under Subsection 223(2) or 223(2A)**
3.2.5 Section 223(6) - Opposition to an Extension of Time under Subsection 223(2) or 223(2A)

Note: This information applies to oppositions commenced on or after 15 April 2013.

In this topic:

Relevant Legislation

The Act

Section 223 Extensions of time
Section 224 Review of decisions

The Regulations

Chapter 5 Opposition
Reg 22.8 Costs
Reg 23.36(2) Transitional provisions
Schedule 7 Fees

Overview
3.2.5.1 Commencing the Opposition - Filing a Notice of Opposition

Under section 223(6) of the Patents Act 1990, a person may, in accordance with the regulations, oppose the grant of an extension of time to do a relevant act under subsections 223(2) or 223(2A).

Extensions of time under subsections 223(2) or 223(2A) can only be opposed where the Commissioner is required to advertise the extension request in the Official Journal of Patents under reg 223(4), because:

- the period of the extension is more than 3 months; or
- the requested extension is for paying a continuation or renewal fee outside the "grace period" prescribed by the regulations.

Where the Commissioner is satisfied that the extension would not be granted even in the absence of an opposition, the application will be refused (section 223(6A)). In this situation, the extension will not be advertised and cannot be opposed (reg 223(6A)). This provision saves a potential opponent from going to the expense of filing an opposition to the grant of an application that the Commissioner does not intend to grant.

In general, an opposition to an extension of time to do a relevant act will be filed by a person (the "opponent") who will be in some way affected by the consequences of the extension. For example, a lapsed patent may be restored if the patentee is provided with an extension of time to pay a renewal fee. The opposition process provides the opponent with the opportunity to make out a case to persuade the Commissioner that the extension should not be granted.

An opposition under section 223(6) commences when a person files a notice of opposition in the approved form within the period allowed by the regulations, and pays the appropriate fee. Subsequently, the opponent files a statement of grounds and particulars, setting out the grounds upon which the extension of time is opposed and the facts and circumstances supporting the grounds. Where appropriate, the parties will be provided with periods for filing evidence to establish their respective cases, after which the Commissioner will hear and decide the matter.

The procedures involved in this process are explained more fully in the following sections.
Timing and requirements for filing a notice of opposition

Regulation 5.10(2) sets out the requirements for the notice of opposition where a person seeks to oppose a request for an extension of time under section 223(2) or 223(2A).

In order to oppose the grant of an extension of time under section 223(6) of the Act, a person must file a notice of opposition with the Commissioner within 2 months from the day a notice of the request for an extension of time is published in the Official Journal of Patents under section 223(4).

The notice of opposition must be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (see Schedule 7, item 216).

The opposition officer will acknowledge receipt of the notice to the parties and give the applicant or patentee a copy of the notice as soon as practicable (reg 5.10(4)).

Extending the time to file a notice of opposition

In some circumstances, a short extension of time to file a notice of opposition may be available under section 223 (see 3.11.1 Extensions of Time – section 223). However, once an extension of time is granted, a notice of opposition will be of no effect.

Amending a notice of opposition

Under regs 5.14 and 5.15, an opponent may request an amendment to the notice of opposition to correct a clerical error or obvious mistake, or to change the name of the opponent where the opponent’s right or interest in an opposition is transferred to another person.

For more information see 3.4.3 Amending Opposition Documents.
Withdrawal of the opposition

An opponent may withdraw an opposition at any time, by filing a signed notice of withdrawal in the approved form (available on the IP Australia website).

For more information see 3.7.1 Withdrawal of an Opposition.

3.2.5.2 Filing the Statement of Grounds and Particulars

Note: This information applies to oppositions commenced on or after 15 April 2013. Where specified, information is also provided for oppositions commenced before 15 April 2013 in which the statement of grounds and particulars was not served before 15 April 2013.

Note: As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

The statement

The statement of grounds and particulars in an opposition under section 223(6) is governed by reg 5.11 or, for oppositions commenced before 15 April 2013, reg 5.4 as in force immediately before 15 April 2013.

The statement of grounds and particulars must set out the grounds the opponent intends to rely on to establish the opposition, and the facts and circumstances (the particulars) forming the basis for the grounds (reg 5.2 “Definitions”).

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Effective Date: 25 September 2019
3.2.5.2 Filing the Statement of Grounds and Particulars

An opposition under section 223(6) may only be on the ground that the application for the extension does not satisfy the requirements of sections 223(2) or 223(2A), as appropriate.

For more information on the function and content of the statement of grounds and particulars see 3.4.2 The Statement of Grounds and Particulars.

Timing and requirements for filing the statement of grounds and particulars and the documents mentioned in the statement

Note: Where an opposition commenced before 15 April 2013; and the statement of grounds and particulars is due to be served on a party on or after 15 April 2013; and the statement has not been served before 15 April 2013; the statement must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy to the other party.

Oppositions commenced before 15 April 2013

In oppositions commenced before 15 April 2013, the opponent must file the statement of grounds and particulars in the approved form (available on the IP Australia website) within 3 months of filing the notice of opposition.

The relevant provisions are reg 5.4 as in force immediately before 15 April 2013, subject to reg 23.36(2).

Oppositions commenced on or after 15 April 2013

Under reg 5.11, the opponent in an opposition under section 223(6) must file a statement of grounds and particulars in the approved form (available on the IP Australia website) within 1 month from the day the notice of opposition was filed.

The statement of grounds and particulars must be accompanied by a copy of each document mentioned in the statement unless the document is open for public inspection and relates to a patent or patent application (reg 5.11(2)). The provision of documents at this
stage of the opposition provides all parties with an early indication of the case to be answered.

The approved form of the statement of grounds and particulars (available on the IP Australia website) contains a Schedule in which every document mentioned in the statement must be listed, together with an indication that:

- the document has been filed with the statement; or
- the document is open for public inspection and relates to a patent or patent application. (Where the document is made open for public inspection on the file of a related Australian patent or patent application, the opponent must identify the relevant patent or patent application.)

If required, more information regarding the meaning of open for public inspection for the purposes of reg 5.11(2) can be found at 3.2.4.2 under the heading “Open for public inspection”.

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**Initial processing of the statement**

Once the opponent complies with the requirements of reg 5.11, or reg 5.4 as in force immediately before 15 April 2013 (subject to reg 23.36(2)), the opposition officer will give the applicant or patentee a copy of the statement and accompanying documents as soon as practicable.

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**Dismissal of the opposition**

The Commissioner may dismiss the opposition if the prescribed documents are not filed with the statement

For oppositions commenced on or after 15 April 2013, if copies of the required documents are not filed with the statement of grounds and particulars, the Commissioner may dismiss the opposition under reg 5.18.

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**Other grounds for dismissal**

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Effective Date: 25 September 2019
3.2.5.2 Filing the Statement of Grounds and Particulars

Other grounds for dismissal of an opposition include that the opposition has no reasonable prospects of success. For more information see 3.7.2 Dismissal of an Opposition.

Requests for dismissal of the opposition

An applicant or patentee may, within 1 month of receiving the statement of grounds and particulars, request the Commissioner to dismiss an opposition.

The provisions governing dismissal are:

- for oppositions commenced on or after 15 April 2013, reg 5.17; or
- for oppositions commenced before 15 April 2013, reg 5.5 as in force immediately before 15 April 2013.

For more information see 3.7.2 Dismissal of an Opposition.

Extending the time to file a statement of grounds and particulars

In some circumstances, an extension of time to file the statement of grounds and particulars may be available under section 223 (see 3.11.1 Extensions of Time – section 223).

Deficient particulars - further and better particulars

Where the particulars of the opposition are deficient, the applicant or patentee may request the Commissioner to issue a direction for further and better particulars.

For more information on directions for further and better particulars, see 3.3.1.2.
Amending the statement of grounds and particulars

An opponent may request the Commissioner in writing to amend its statement of grounds and particulars to correct an error or omission in the grounds of opposition, or to amend the facts and circumstances (the particulars) forming the basis for the grounds.

However, the Commissioner has no power to amend the statement where an application for dismissal of the opposition is under consideration.

The relevant provisions are:

- for oppositions commenced on or after 15 April 2013, reg 5.16; or
- for oppositions commenced before 15 April 2013, reg 5.9 as in force immediately before 15 April 2013.

For more information see 3.4.3 Amending Opposition Documents.

Note: Information is provided for oppositions commenced before, on or after 15 April 2013, as specified.

Note: As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

General information

For oppositions commenced before 15 April 2013, a party seeking to rely on evidence in an opposition under section 223(6) must file it with the Commissioner within the evidentiary periods prescribed by reg 5.8 as in force immediately before 15 April 2013, subject to reg 23.36(2).
3.2.5.3 Evidence and Evidentiary Periods

For oppositions commenced on or after 15 April 2013, where a party wishes to file evidence the evidentiary periods will be set by direction under reg 5.12.

The process and procedure for filing evidence is summarised below.

**Physical evidence**

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

For information on evidence in general see 3.5 Evidence.

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**Filing evidence in oppositions commenced before 15 April 2013**

**Note:** Where an opposition commenced before 15 April 2013, and evidence is due to be served on a party on or after 15 April 2013, and the evidence has not been served before 15 April 2013, the evidence must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy of the evidence to the other party.

Pursuant to reg 23.36(2), if the party is given the evidence after the date it is filed, the Commissioner will extend the subsequent evidentiary period by the number of days equal to the number of days between the filing date and the date the evidence was given to the other party.

In oppositions commenced prior to 15 April 2013, the evidentiary stages are governed by reg 5.8, as in force immediately before 15 April 2013, subject to reg 23.36(2) where appropriate. The evidentiary periods are as follows.

**Note:** Physical evidence should **not** be filed unless requested or directed by the Commissioner.
3.2.5.3 Evidence and Evidentiary Periods

**Evidence in support**

After 15 April 2013, the opponent must file any evidence in support of the opposition within 3 months after the day the opponent files (or before 15 April 2013 serves) the statement of grounds and particulars (reg 5.8(1) as in force immediately before 15 April 2013, subject to reg 23.36(2) item 4).

**Evidence in answer**

If the opponent files (or before 15 April 2013 serves) evidence in support of the opposition, the applicant or patentee must file any evidence in answer to the evidence in support within 3 months after being given (or being served with) the evidence in support.

Where the opponent does not provide any evidence in support, the applicant or patentee must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the evidence in support was due to be filed (or before 15 April 2013 served).

(Reg 5.8(2)-(3) as in force immediately before 15 April 2013 subject to reg 23.36(2) item 4)

**Evidence in reply**

If the applicant/patentee files (or before 15 April 2013 serves) evidence in answer, the opponent intending to rely on evidence in reply must, within 1 month of receiving the evidence, file:

- evidence in reply to the evidence in answer; or
- a copy of a notice of intention to serve evidence in reply.

If a notice of intention is filed, the opponent must file the evidence in reply within 3 months of being given (or, before 15 April 2013, being served with) the evidence in answer.

(Reg 5.8(4) as in force immediately before 15 April 2013 subject to reg 23.36(2) item 4)

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**Filing evidence in oppositions commenced on or after 15 April 2013**

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Effective Date: 25 September 2019
Evidence is not always required or relied on in a procedural opposition. Therefore, for oppositions commenced on or after 15 April 2013, once the statement of grounds and particulars has been filed, the parties will be asked to indicate if they wish to file evidence.

**Note:** The provisions of reg 5.11(2), that documents mentioned in the statement of grounds and particulars must be filed with the statement, does not replace the need for documents to be adduced in evidence. All documents that the opponent intends to rely on to establish the grounds of opposition must be included in the evidence in support.

A party intending to file evidence will be required to specify the nature and significance of the evidence, and how long they will need to prepare the evidence.

A delegate will consider the information, and propose a direction under reg 5.12. Where a direction is given for a party to file evidence, the other party will normally be provided with a period in which to file responding evidence. For more information on directions for evidence in a procedural opposition, see 3.3.1.4.

When evidence is filed, the opposition officer will acknowledge receipt to the parties and give a copy of the evidence to the other party.

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**Extending the time for filing evidence**

**Opposition and evidentiary period commenced before 15 April 2013**

A party may apply under reg 5.10(2) as in force immediately before 15 April 2013, for an extension of an evidentiary period that commenced prior to 15 April 2013.

See 3.11.3.2 Extensions under Reg 5.10(2)

**Opposition commenced before 15 April 2013 and evidentiary period commenced on or after 15 April 2013**

Pursuant to reg 23.36(2) item 2, reg 5.9 applies to extend an evidentiary period in this situation.

For more information see 3.11.2 Extensions of Time – Reg 5.9 and 3.3.1.4 Time for Filing Evidence in a Procedural Opposition
3.2.5.4 Finalising the Opposition

**Opposition and evidentiary period commenced on or after 15 April 2013**

In this situation, the Commissioner may extend an evidentiary period by direction under reg 5.12.

For more information see 3.3.1.4 Time for Filing Evidence in a Procedural Opposition.

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**Further evidence**

Further evidence is not available for oppositions commenced on or after 15 April 2013.

For oppositions commenced before 15 April 2013, a party may request leave to file further evidence under the provisions of reg 5.10(4) as in force immediately before 15 April 2013.

Any request for an extension of time to file further evidence or evidence responding to the further evidence, should be made under reg 5.10(2) as in force immediately before 15 April 2013. The request should be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 218 as in force before 15 April 2013).

The request will be processed in accordance with reg 5.10(5) as in force immediately before 15 April 2013.

For more information on extensions of time under reg 5.10(2) as in force immediately before 15 April 2013 see 3.11.3.2.

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**3.2.5.4 Finalising the Opposition**

**Note:** Unless explicitly stated otherwise, the information in this part applies to:

(i) oppositions commenced on or after 15 April 2013; and
(ii) oppositions commenced before 15 April 2013 in which the Commissioner has not set a hearing date or issued a notice of hearing to the parties before 15 April 2013.

Pursuant to reg 23.36(2), for oppositions referred to in (ii), a reference in reg 5.20 (as in force from 15 April 2012) to regs 5.26, 5.19 or Part 5.4 should be read, respectively, as regs...
3.2.5.4 Finalising the Opposition

5.15, 5.6 or 5.5 as in force immediately before 15 April 2013. Regulation 5.12 as in force before 15 April 2013 is taken not to apply.

In this topic:

Overview

Providing the opposition has not been withdrawn or dismissed, the next step in the opposition process is a hearing of the matter, after which a decision is issued. The function of the hearing is to enable the parties to fully present their views supported by reasons and evidence, in order that the hearing officer is in a position to make a correct and just decision.

Where an opposition has not been set for hearing prior to 15 April 2013, the hearing and decision are governed by reg 5.20 subject to the transitional reg 23.36(2) where appropriate.

An opposition will be set for hearing either on the request of a party or on the Commissioner's own initiative. Once the hearing officer decides the opposition, the parties will be notified of the decision as soon as practicable.

Timing and requirements for requesting a hearing

Providing any evidentiary periods have ended, and the opposition has not been withdrawn, dismissed or previously heard and decided, the opponent may request a hearing. The request must be made in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 230).

On receipt of a request for a hearing, the opposition officer will give a copy to the applicant or patentee.
3.2.5.4 Finalising the Opposition

Nature of the hearing

The hearing may be held orally or by written submissions at the Commissioner's discretion (reg 5.20(3)).

Oral hearings

Where the Commissioner decides on an oral hearing, the opposition officer will notify the parties of the date, time and place of the hearing. For more information on the hearing process, see 3.8 Hearings and Decisions.

Reg 5.20(4) requires both parties to file a summary of their submissions prior to the hearing. The opponent must file the summary at least 10 business days before the hearing, and the applicant at least 5 business days before the hearing.

If a party fails to file a summary of submissions within the time prescribed by the regulations, under reg 5.20(6), the hearing officer will consider this in making an award of costs in the opposition.

Note: As of 15 April 2013, the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

On receipt of a summary of submissions, the opposition officer will give a copy of a party's summary to the other party as soon as practicable.

Hearings by written submissions

Where an opposition is set for hearing by written submissions, the delegate will issue a direction to the parties specifying the process and time frame in which the written submissions are to be filed (see 3.3.1 Directions in Opposition Proceedings).

For more information on the hearing process, see 3.8 Hearings and Decisions.

The decision
Once the opposition is decided, the parties will be notified of the decision. For more information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs in the opposition. For more information on costs see 3.9 Costs.

### Review of a decision

An application for review of the hearing officer’s decision in an opposition under section 223(6) to a request an extension of time may be made to the Administrative Appeals Tribunal under section 224.

### Relevant Legislation

**The Act**

- Section 6 Deposit requirements
- Section 41 Specifications: micro-organisms
- Section 104 Amendments by applicants and patentees
- Chapter Special provisions related to associated technology

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Effective Date: 25 September 2019
The Regulations

Chapter 5  
Opposition

Reg 22.21  
Protection or compensation of certain persons

Reg 22.8  
Costs

Reg 23.36(2)  
Transitional provisions

Schedule 7  
Fees

Overview

The Patents Regulations 1991 include provisions for the protection or compensation of persons who availed themselves of or exploited, or took definite steps by contract or otherwise to avail themselves of or exploit, an invention within a period specified in:

- section 41(4)(c) – in which the deposit requirements of section 6(c) or (d) were not satisfied for a specification relating to a micro-organism;
- section 150(4) – in which an application was lapsed under section 148; or
- section 223(9) – in which the patent was lapsed or ceased because of the failure to do the relevant act.

Such a person may apply to the Commissioner under reg 22.21(2) for a licence to exploit the invention.

Under reg 22.21(4) certain persons specified in reg 22.21(3) (broadly the applicant, or patentee of the relevant patent) may oppose the Commissioner granting a licence.

An opposition commences when a relevant person files a notice of opposition in the approved form within the period allowed by the regulations, and pays the appropriate fee. Subsequently, the opponent files a statement of grounds and particulars, setting out the
grounds upon which grant of the licence is opposed and the facts and circumstances supporting the grounds. Where appropriate, the parties will be provided with periods for filing evidence to establish their respective cases, after which the Commissioner will hear and decide the matter.

The procedures involved in this process are explained more fully in the following sections.

### 3.2.6.1 Commencing the Opposition - Filing a Notice of Opposition

**Note:** This information applies on or after 15 April 2013.

In this topic:

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#### Timing and requirements for filing a notice of opposition

*Regulation 5.10(3)* sets out the requirements for a notice of opposition where a relevant person seeks to oppose a request for a licence under *reg 22.21(4)*.

Under *reg 22.21(4)* a relevant person opposes the grant of a licence by filing a notice of opposition, in the approved form, **within 2 months** from the day the Commissioner gives the person a copy of the application under *reg 22.21(3)*.

The notice of opposition must be in the approved form and be accompanied by the appropriate fee (see *Schedule 7, item 216*).

The opposition officer will acknowledge receipt of the notice to the parties and give a copy to the applicant for a licence as soon as practicable (*reg 5.10(4)*).

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#### Extending the time to file a notice of opposition

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3.2.6.2 Filing the Statement of Grounds and Particulars

In some circumstances, a short extension of time to file a notice of opposition may be available under section 223 (see 3.11.1 Extensions of Time – section 223). However, once a licence is granted, a notice of opposition will be of no effect.

Amending a notice of opposition

Under regs 5.14 and 5.15, an opponent may request an amendment to the notice of opposition to correct a clerical error or obvious mistake, or to change the name of the opponent where the opponent’s right or interest in an opposition is transferred to another person.

For more information see 3.4.3 Amending opposition documents.

Withdrawal of the opposition

An opponent may withdraw an opposition at any time, by filing a signed notice of withdrawal in the approved form (available on the IP Australia website).

For more information see 3.7.1 Withdrawal of an Opposition.
3.2.6.2 Filing the Statement of Grounds and Particulars

**Note:** As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

### The statement

The statement of grounds and particulars in an opposition under reg 22.21(4) is governed by reg 5.11 or, for oppositions commenced before 15 April 2013, reg 5.4 as in force immediately before 15 April 2013.

The statement of grounds and particulars must set out the grounds the opponent intends to rely on to establish the opposition, and the facts and circumstances (the particulars) forming the basis for the grounds (reg 5.2 “Definitions”).

The grounds upon which the grant of a licence can be opposed are that the applicant for a licence does not satisfy the requirements for grant of a licence under the protection and compensation provisions of reg 22.21.

For more information on the function and content of the statement of grounds and particulars see 3.4.2 The Statement of Grounds and Particulars.

### Timing and requirements for filing the statement of grounds and particulars and the documents mentioned in the statement

**Note:** Where an opposition commenced before 15 April 2013; and the statement of grounds and particulars is due to be served on a party on or after 15 April 2013; and the statement has not been served before 15 April 2013; the statement must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy to the other party.

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Effective Date: 25 September 2019
3.2.6.2 Filing the Statement of Grounds and Particulars

**Oppositions commenced before 15 April 2013**

In oppositions commenced before 15 April 2013, the opponent must file the statement of grounds and particulars in the approved form (available on the IP Australia website) **within 3 months** of filing the notice of opposition.

The relevant provisions are reg 5.4 as in force immediately before 15 April 2013, subject to reg 23.36(2).

**Oppositions commenced on or after 15 April 2013**

Under reg 5.11 the opponent in an opposition under reg 22.21(4) must file a statement of grounds and particulars in the approved form (available on the IP Australia website) **within 1 month** from the day the notice of opposition was filed.

The statement of grounds and particulars must be accompanied by a copy of each document mentioned in the statement unless the document is open for public inspection and relates to a patent or patent application (reg 5.11(2)). The provision of documents at this stage of the opposition provides all parties with an early indication of the case to be answered.

The approved form of the statement of grounds and particulars (available on the IP Australia website) contains a Schedule in which every document mentioned in the statement must be listed, together with an indication that:

- the document has been filed with the statement; or
- the document is open for public inspection and relates to a patent or patent application. (Where the document is made open for public inspection on the file of a related Australian patent or patent application, the opponent must identify the relevant patent or patent application.)

If required, more information regarding the meaning of open for public inspection for the purposes of reg 5.11(2) can be found at 3.2.4.2 Filing the Statement of Grounds and Particulars under the heading “Open for public inspection”.

**Initial processing of the statement**

Once the opponent complies with the requirements of reg 5.11, or reg 5.4 as in force immediately before 15 April 2013 (subject to reg 23.36(2)), the opposition officer will give the
applicant for a licence a copy of the statement and accompanying documents as soon as practicable.

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**Dismissal of the opposition**

**The Commissioner may dismiss the opposition if the prescribed documents are not filed with the statement**

For oppositions commenced on or after 15 April 2013, if copies of the required documents are not filed with the statement of grounds and particulars, the Commissioner may dismiss the opposition under reg 5.18.

**Other grounds for dismissal**

Other grounds for dismissal of an opposition include that the opposition has no reasonable prospects of success. For more information see 3.7.2 Dismissal of an Opposition.

**Requests for dismissal of the opposition**

An applicant for a licence may, **within 1 month** of receiving the statement of grounds and particulars, request the Commissioner to dismiss the opposition.

The provisions governing dismissal are:

- for oppositions commenced on or after 15 April 2013, reg 5.17; or
- for oppositions commenced before 15 April 2013, reg 5.5 as in force immediately before 15 April 2013.

For more information see 3.7.2 Dismissal of an Opposition.

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**Extending the time to file a statement of grounds and particulars**

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
In some circumstances, an extension of time to file the statement of grounds and particulars may be available under section 223 (see 3.11.1 Extensions of Time – section 223).

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**Deficient particulars - further and better particulars**

Where the particulars of the opposition are deficient, the applicant for a licence may request the Commissioner to issue a direction for further and better particulars.

For more information on directions for further and better particulars, see 3.3.1.2.

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**Amending the statement of grounds and particulars**

An opponent may request the Commissioner in writing to amend its statement of grounds and particulars to correct an error or omission in the grounds of opposition, or to amend the facts and circumstances (the particulars) forming the basis for the grounds.

However, the Commissioner has no power to amend the statement where an application for dismissal of the opposition is under consideration.

The relevant provisions are:

- for oppositions commenced on or after 15 April 2013, reg 5.16; or
- for oppositions commenced before 15 April 2013, reg 5.9 as in force immediately before 15 April 2013.

For more information see 3.4.3 Amending Opposition Documents.

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**Note:** Information is provided for oppositions commenced **before, on or after** 15 April 2013, as specified.
3.2.6.3 Evidence and Evidentiary Periods

**Note:** As of 15 April 2013, the statement of grounds and particulars and accompanying documents, the evidence in an opposition and the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

In this topic:

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**General information**

For oppositions commenced before 15 April 2013, a party seeking to rely on evidence in an opposition under reg 22.21(4) must file it with the Commissioner within the evidentiary periods prescribed by reg 5.8 as in force immediately before 15 April 2013, subject to reg 23.36(2).

For oppositions commenced on or after 15 April 2013, where a party wishes to file evidence the evidentiary periods will be set by direction under reg 5.12.

The process and procedure for filing evidence is summarised below.

**Physical evidence**

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

For information on evidence in general see 3.5 Evidence.

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**Filing evidence in oppositions commenced before 15 April 2013**
3.2.6.3 Evidence and Evidentiary Periods

**Note:** Where an opposition commenced before 15 April 2013, and evidence is due to be served on a party on or after 15 April 2013, and the evidence has not been served before 15 April 2013, the evidence must be filed with the Commissioner on or before the due date for service and the opposition officer will give a copy of the evidence to the other party.

Pursuant to reg 23.36(2), if the party is given the evidence after the date it is filed, the Commissioner will extend the subsequent evidentiary period by the number of days equal to the number of days between the filing date and the date the evidence was given to the other party.

In oppositions commenced prior to 15 April 2013, the evidentiary stages are governed by reg 5.8, as in force immediately before 15 April 2013, subject to reg 23.36(2) where appropriate.

**Note:** Physical evidence should not be filed unless requested or directed by the Commissioner.

The evidentiary periods are as follows.

**Evidence in support**

After 15 April 2013, the opponent must file any evidence in support of the opposition within 3 months after the day the opponent files (or before 15 April 2013 serves) the statement of grounds and particulars (reg 5.8(1) as in force immediately before 15 April 2013, subject to reg 23.36(2) item 4).

**Evidence in answer**

If the opponent files (or before 15 April 2013 serves) evidence in support of the opposition, the applicant for a licence must file any evidence in answer to the evidence in support within 3 months after being given (or being served with) the evidence in support.

Where the opponent does not provide any evidence in support, the applicant must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the evidence in support was due to be filed (or before 15 April 2013 served).

(Reg 5.8(2)-(3) as in force immediately before 15 April 2013 subject to reg 23.36(2) item 4)
Evidence in reply

If the applicant for a licence files (or before 15 April 2013 serves) evidence in answer, the opponent intending to rely on evidence in reply must, within 1 month of receiving the evidence, file:

- evidence in reply to the evidence in answer; or
- a copy of a notice of intention to serve evidence in reply.

If a notice of intention is filed, the opponent must file the evidence in reply within 3 months of being given (or, before 15 April 2013 being served with) the evidence in answer.

(Reg 5.8(4) as in force immediately before 15 April 2013 subject to reg 23.36(2) item 4)

Filing evidence in oppositions commenced on or after 15 April 2013

Evidence is not always required or relied on in a procedural opposition. Therefore, for oppositions commenced on or after 15 April 2013, once the statement of grounds and particulars has been filed, the parties will be asked to indicate if they wish to file evidence.

Note: The provisions of reg 5.11(2), that documents mentioned in the statement of grounds and particulars must be filed with the statement, does not replace the need for documents to be adduced in evidence. All documents that the opponent intends to rely on to establish the grounds of opposition must be included in the evidence in support.

A party intending to file evidence will be required to specify the nature and significance of the evidence, and how long they will need to prepare the evidence.

A delegate will consider the information, and propose a direction under reg 5.12. Where a direction is given for a party to file evidence, the other party will normally be provided with a period in which to file responding evidence. For more information on directions for evidence in a procedural opposition, see 3.3.1.4.

When evidence is filed, the opposition officer will acknowledge receipt to the parties and give a copy of the evidence to the other party.
Extending the time for filing evidence

Opposition and evidentiary period commenced before 15 April 2013

A party may apply under reg 5.10(2) as in force immediately before 15 April 2013, for an extension of an evidentiary period that commenced prior to 15 April 2013.

See 3.11.3.2 Extensions under Reg 5.10(2)

Opposition commenced before 15 April 2013 and evidentiary period commenced on or after 15 April 2013

Pursuant to reg 23.36(2) item 2, reg 5.9 applies to extend an evidentiary period in this situation.

For more information see 3.11.2 Extensions of Time – Reg 5.9 and 3.3.1.4 Time for Filing Evidence in a Procedural Opposition

Opposition and evidentiary period commenced on or after 15 April 2013

In this situation, the Commissioner may extend an evidentiary period by direction under reg 5.12.

For more information see 3.3.1.4 Time for Filing Evidence in a Procedural Opposition

Further evidence

Further evidence is not available for oppositions commenced on or after 15 April 2013.

For oppositions commenced before 15 April 2013, a party may request leave to file further evidence under the provisions of reg 5.10(4) as in force immediately before 15 April 2013.

Any request for an extension of time to file further evidence or evidence responding to the further evidence, should be made under reg 5.10(2) as in force immediately before 15 April 2013. The request should be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 218 as in force before 15 April 2013).
3.2.6.4 Finalising the Opposition

The request will be processed in accordance with reg 5.10(5) as in force immediately before 15 April 2013.

For more information on extensions of time under reg 5.10(2) as in force immediately before 15 April 2013 see 3.11.3.2.

Note: Unless explicitly stated otherwise, the information in this part applies to:

(i) oppositions commenced on or after 15 April 2013; and
(ii) oppositions commenced before 15 April 2013 in which the Commissioner has not set a hearing date or issued a notice of hearing to the parties before 15 April 2013.

Pursuant to reg 23.36(2), for oppositions referred to in (ii), a reference in reg 5.20 (as in force from 15 April 2012) to regs 5.26, 5.19 or Part 5.4 should be read, respectively, as regs 5.15, 5.6 or 5.5 as in force immediately before 15 April 2013. Regulation 5.12 as in force before 15 April 2013 is taken not to apply.

In this topic:

Overview

Providing the opposition has not been withdrawn or dismissed, the next step in the opposition process is a hearing of the matter, after which a decision is issued. The function of the hearing is to enable the parties to fully present their views supported by reasons and evidence, in order that the hearing officer is in a position to make a correct and just decision.

Where an opposition has not been set for hearing prior to 15 April 2013, the hearing and decision are governed by reg 5.20 subject to the transitional reg 23.36(2) where appropriate.
An opposition will be set for hearing either on the request of a party or on the Commissioner's own initiative. Once the hearing officer decides the opposition, the parties will be notified of the decision as soon as practicable.

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**Timing and requirements for requesting a hearing**

Providing any evidentiary periods have ended, and the opposition has not been withdrawn, dismissed or previously heard and decided, the opponent may request a hearing. The request must be made in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee ([Schedule 7, item 230](#)).

On receipt of a request for a hearing, the opposition officer will give a copy to the applicant for a licence.

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**Nature of the hearing**

The hearing may be held orally or by written submissions at the Commissioner's discretion ([reg 5.20(3)](#)).

**Oral hearings**

Where the Commissioner decides on an oral hearing, the opposition officer will notify the parties of the date, time and place of the hearing. For more information on the hearing process, see [3.8 Hearings and Decisions](#).

[Reg 5.20(4)](#) requires both parties to file a summary of their submissions prior to the hearing. The opponent must file the summary at least 10 business days before the hearing, and the applicant for a licence at least 5 business days before the hearing.

If a party fails to file a summary of submissions within the time prescribed by the regulations, under [reg 5.20(6)](#), the hearing officer will consider this in making an award of costs in the opposition.

**Note:** As of 15 April 2013, the summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.
On receipt of a summary of submissions, the opposition officer will give a copy of a party’s summary to the other party as soon as practicable.

Hearings by written submissions

Where an opposition is set for hearing by written submissions, the delegate will issue a direction to the parties specifying the process and time frame in which the written submissions are to be filed (see 3.3.1 Directions in Opposition Proceedings).

For more information on the hearing process, see 3.8 Hearings and Decisions.

The decision

Once the opposition is decided, the parties will be notified of the decision. For more information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs in the opposition. For more information on costs see 3.9 Costs.

Review of a decision

An application for review of the hearing officer’s decision in an opposition under reg 22.21(4) to a request for a licence may be made to the Administrative Appeals Tribunal under section 224.

3.2.7 Sections 17 & 32 - Disputes Between Applicants and Co-Owners

Modified Date: 02 April 2013

3.2.7 Sections 17 & 32 - Disputes Between Applicants and Co-Owners

Note: This information applies to section 17 applications and requests under section 32 filed on or after 15 April 2013.

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In this topic:

relevant legislation

the act

section 17 directions to co-owners
section 32 disputes between applicants
section 224 review of decisions

the regulations

reg 22.24 practice and procedure other than for opposition proceedings
reg 22.8 costs
schedule 7 fees

overview

the commissioner has power under section 17(1) to give directions to settle disputes between co-owners of a patent as to dealings with the patent, the grant of licences under it or the exercise of a right under section 16.

similarly section 32 provides a mechanism for the commissioner to determine a dispute between any two or more joint applicants in relation to a patent application whether, or in what manner, the application should proceed.

where a request under section 32 is made, the commissioner is empowered to make any determinations the commissioner thinks fit for enabling the application to proceed in the
name of one or more of the applicants alone, or for regulating the manner in which it is to proceed, or both, as the case requires.

A request may be made under section 32 whether or not the application has lapsed.

**Note:** From 15 April 2013, section 32 is limited to disputes arising between joint applicants (as was the case under the equivalent section 63 of the 1952 Act). Entitlement disputes involving third parties may be pursued under section 36.

**Requests under sections 17 and 32**

A request under section 17 must comply with the requirements of reg 2.1 - it must be in the approved form (available on the IP Australia website), be accompanied by a notice setting out the facts on which the application is based, and a copy of the application and notice must be served on the other party.

A request under section 32 must comply with the requirements of reg 3.6 - it must be in the approved form (available on the IP Australia website) and have with it a notice stating the grounds on which the request is made. It may also be accompanied by evidence supporting the request.

Following receipt of a request under either section 17 or section 32 the practice and procedure to be followed is determined by the Commissioner in accordance with reg 22.24 and directions to the parties will be made accordingly.
Evidence

**Note:** As of 15 April 2013, any evidence, and summaries of submissions for the hearing must be filed electronically with IP Australia by means approved by the Commissioner.

Physical evidence should not be filed unless requested or directed by the Commissioner.

Depending on the nature of the dispute evidence may not be required or relied on. Therefore, once the request has been filed, the parties will be asked to indicate if they wish to file evidence (if evidence has not already been filed).

A party intending to file evidence will be required to specify the nature and significance of the evidence, and how long they will need to prepare the evidence. A delegate will consider the information, and propose a direction. Where a direction is given for a party to file evidence, the other party will be normally be provided with a period in which to file responding evidence. Extensions of time to file evidence will only be granted in exceptional circumstances.

**Physical evidence**

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

**3.2.7.2 Finalising the Proceedings**

**Note:** This information applies to requests made before, on or after 15 April 2013.

In this topic:

The final step in the proceedings is a hearing into the matter, after which a decision is issued. The function of a hearing is to enable the parties to fully present their views.
supported by reasons and evidence (as required), in order that the hearing officer is in a position to make a correct and just decision. The procedure for hearing and decision for section 17 and section 32 matters is determined by the Commissioner in accordance with reg 22.24.

After any evidentiary periods are completed the dispute will be set for hearing by the Commissioner. Once the hearing officer decides the matter, the parties will be notified of the decision.

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**Nature of the hearing**

The hearing may be held orally or by written submissions at the Commissioner's discretion (reg 22.24).

**Oral hearings**

Where the Commissioner decides on an oral hearing, under reg 22.23, the parties will be notified of the date, time and place of the hearing. A party may appear in person, or by telephone, or other means of telecommunication that the Commissioner reasonably allows.

The procedure to be followed for written submissions in an oral hearing will be set by direction under reg 22.23(5), at the Commissioner's discretion.

The Commissioner requires parties to file a summary of their submissions prior to the hearing. Where both parties appear, the requestor must file the summary at least 10 business days before the hearing, and the respondent at least 5 business days before the hearing.

On receipt of a summary of submissions, the opposition officer will give a copy of a party's summary to the other party or parties as soon as practicable.

If only one party appears then their summary of submissions must be filed at least 5 business days before the hearing.

Where applicable, if a party fails to file a summary of submissions within the time set by the regulations, the hearing officer will consider this in making an award of costs in the matter.

For more information on the oral hearing process, see 3.8 Hearings and Decisions.

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**Hearings by written submissions**
Where a matter is set for hearing by written submissions, under reg 22.23(1), the parties will be notified of the period in which the submissions must be filed. The hearing officer will determine the matter after considering the written submissions.

For more information on hearings by written submissions, see 3.8 Hearings and Decisions.

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**The decision**

Once the matter is decided, the parties will be notified of the decision. For further information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs. For further information see 3.9 Costs.

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**Appeal of a decision**

An application for review of the hearing officer’s decision under section 17 or section 32 may be made to the Administrative Appeals Tribunal under section 224.

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**3.2.7.3 Relevant Cases**

Note: This information applies to requests made before, on or after 15 April 2013.

The following examples may be relevant to section 32. For cases relevant to determining entitlement between joint applicants see 3.2.8

- a person claiming to be a joint applicant:

  * Moriarty v Collins* 26 IPR 21

  * Magee v. Farrell* (1985) AIPC 90-296 (Note - decided under reg 76(3) and section 34(4) of the 1952 Act; a different outcome might be expected under section 32 of the 1990 Act)
3.2.7.3 Relevant Cases

- a joint applicant refusing to sign a notice of entitlement:
  
  Application by Willems, Fritz, et al 21 IPR 569


- a person requesting the application proceed in their name only:
  
  Carroll v Harper 1 IPR 537 - where one party did not fulfil its contractual obligations

  Tribe v Ranken 1 IPR 561 - where application erroneously include the name of a second person.

  Milward-Bason and Burgess (1988) AIPC 90-475 - involving breach of agreement, unauthorised assignment, and non-co-operation and inaction in instigating infringement actions and marketing.

Three decisions appearing in the RPCs, which may be useful to persons involved in section 32 actions are:

- Novocretes Ltd.’s Application 43 RPC 171

- Lanfranconi’s Applications 53 RPC 317

- R&S Trailers Ltd.’s Application 60 RPC 7

The only Office decision relevant to section 17(1) is re Applications by Millward-Bason and Burgess (1988) AIPC 90-475 (which was dealt with under the equivalent provisions of the Patents Act 1952). In that case it was disclosed that the applicants had applied for four patents, one had been granted and the other three applications were additional to and further to the granted patent. Concurrent applications under sections 63 and 154 [1952 Act, equivalent to sections 32 and 17 of the 1990 Act] were made by M-B relating to the pending applications and the granted patent respectively.

Evidence was adduced by M-B relating to breaches of an agreement between the parties, assignment by B without M-B’s consent, non-co-operation and inaction by B in their instigating infringement actions and marketing the invention, and reluctance by B to share costs.

The following matters were decided (with reference to the provisions of the 1952 Act):

- B’s assignment was not in accordance with section 153(3), was therefore invalid and could not be registered under section 21

- Section 153(2) was applicable to M-B’s attempts at marketing the invention

- B’s obstruction of actions against an alleged infringer was not a matter relevant to sections 153 and 154, since infringement actions are dealt with by the Courts according to Part XIII of the Act.
Re section 154(1), M-B’s application did not specify the nature of directions sought from the Commissioner, and because the Commissioner's powers under this section are limited, only one direction as such was made. The Deed of Letters Patent had been returned to the Patent Office by a firm of attorneys, and because of B’s lack of interest in the progress and development of the patent, and the probability that M-B would be primarily involved in any future dealings, the Commissioner's delegate directed that the Deed be placed in the possession of M-B.

### Relevant Legislation

#### The Act

- **Section 15**  
  Who may be granted a patent
- **Section 22A**  
  Validity not affected by who patent granted to
- **Section 33**  
  Applications by Opponents
- **Section 34**  
  Applications by eligible persons arising out of Court proceedings
- **Section 35**  
  Applications by eligible persons following revocation by the Commissioner
- **Section 36**  
  Other applications by eligible persons
- **Section 138**  
  Revocation of patents
Overview

Subsection 15(1) of the Act specifies a patent for an invention may only be granted to a person who:

(a) is the inventor; or

(b) would, on the grant of a patent for the invention, be entitled to have the patent assigned to the person; or

(c) derives title to the invention from the inventor or a person mentioned in paragraph (b); or

(d) is the legal representative of a deceased person mentioned in paragraph (a), (b) or (c).

This raises particular issues where there are disputes about who is the actual inventor or who derives entitlement from them. Similarly when, due to an error, a patent is granted to a person who is not entitled or the name of an entitled person is omitted.

Notably section 22A provides that a patent is not invalid merely because it (or a share in the patent) was granted to a person not entitled or was not granted to a person who is entitled.
3.2.8.1 Procedure - Requests for the Commissioner to Make a Determination of Entitlement

Consequently the Act provides a number of avenues for matters of entitlement to be resolved and for applications and patents to proceed in the name of the correct parties. These include:

- requests under section 32 in relations to joint applicants;
- applications for a declaration (and directions) under section 36;
- application for a determination under section 35, as a result of the revocation of a patent under section 137 following an offer to surrender;
- opposition under section 59 to the grant of a standard patent;
- revocation of a patent by a Court section 138;
- application for a declaration under section 191A;
- application for a Court order under section 192.

All but sections 138 and 192 fall within the Commissioner's authority to determine.

Following a determination of entitlement it is usual for a direction to be made that the application proceed in the name of the entitled persons or, for a patent, for the Register to be rectified to reflect the correct patentees. However, the Act also provided in some circumstances for a new application to be filed by an entitled person - see sections 33, 34, 35 and 36. This may be appropriate where the relevant application has lapsed or the patent revoked or where parts of an application with different entitlement can be separated out and subject to new applications in the name of the relevant entitled person.
3.2.8.1 Procedure - Requests for the Commissioner to Make a Determination of Entitlement

The procedure to be followed in requesting determination of entitlement by the Commissioner depends on the relevant statutory provisions. Generally for applications entitlement disputes will be raised under section 36 but may be raised under section 32 (if solely involving a dispute between joint applicants) or in section 59 oppositions. For patents usually a request is made under section 191A but may be made under section 35 if a patent has been revoked after an offer to surrender.

Note that while section 32 and section 36 permit consideration of the entitlement of an invention disclosed in an application, section 35, section 59 and section 191A are limited to determinations on the basis of the invention claimed. Also a request may be made under section 32 or section 36 whether or not the application has lapsed.

For the procedure for section 32 requests and their determination see 3.2.7.

For the procedure for section 59 oppositions and their determination see 3.2.1.

A request under section 36 or section 35 must comply with reg 3.7, that is, be:

- in the approved form; and
- have with it a notice by the applicant stating the grounds on which the application is made.

For section 191A a request must also be in the approved form (see reg 10.7). This requires that the proposed rectification of the register be identified and the reasons for the proposed rectification given. A request under section 191A will usually be advertised (see 3.10.3.1) however a declaration or rectification of the register cannot proceed while relevant proceedings in relation to the patent are pending.

In all cases it is usual for evidence to be filed with the request. Processing thereafter will depend on whether the request is filed by the applicant or patentee or by a third party. If the latter, the applicant or patentee (and any other party) will be provided a copy of the request as soon as practicable and asked to indicate whether they wish to contest the request.

Where the request is not contested, a delegate of the Commissioner will then proceed to determine the request. They may require that additional submissions or evidence be filed before making the determination.

Where the request is contested, including where a person requests to be heard under section 191A or reg 10.7, the practice and procedure to be followed is determined by the Commissioner in accordance with reg 22.24 and directions to the parties will be made accordingly. This usually will involve the opportunity for the parties to file evidence in which case the following applies.
3.2.8.2 Finalising the Request

Evidence

**Note:** As of 15 April 2013, any evidence and the summaries of submissions for an oral hearing must be filed electronically with IP Australia by means approved by the Commissioner.

Physical evidence should not be filed unless requested or directed by the Commissioner.

The parties will be asked to indicate if they wish to file evidence.

A party intending to file evidence will be required to specify the nature and significance of the evidence, and how long they will need to prepare the evidence. A delegate will consider the information, and propose a direction. Where a direction is given for a party to file evidence, the other party will be normally be provided with a period in which to file responding evidence. Extensions of time to file evidence will only be granted in exceptional circumstances.

Physical evidence

Physical evidence should not be filed. Rather, the documentary evidence should include a description of the physical item including, as appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

The Commissioner may subsequently order inspection of the item or direct that it be filed, as the Commissioner determines to be appropriate.

This information applies to requests filed on or after 15 April 2013.

**3.2.8.2 Finalising the Request**

**Note:** This information applies to requests filed **on or after** 15 April 2013.

In this topic:

Where an entitlement matter is contested it is usual for the parties to be given the opportunity to be heard once any evidentiary stages are complete. When uncontested, the requestor may also request or be offered the opportunity to be heard.
The function of a hearing is to enable the parties to fully present their views supported by reasons and evidence (as required), in order that the hearing officer is in a position to make a correct and just decision. The procedure for the hearing and decision is determined by the Commissioner in accordance with reg 22.24 taking into account reg 22.23.

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**Nature of the hearing**

The hearing may be held orally or by written submissions at the Commissioner’s discretion (reg 22.24).

**Oral hearings**

Where the Commissioner decides on an oral hearing, under reg 22.23, the parties will be notified of the date, time and place of the hearing. A party may appear in person, or by telephone, or other means of telecommunication that the Commissioner reasonably allows.

The procedure to be followed for written submissions in an oral hearing will be set by direction under reg 22.23(5), at the Commissioner’s discretion.

The Commissioner requires parties to file a summary of their submissions prior to the hearing. Where both parties appear, the requestor must file the summary at least 10 business days before the hearing, and the respondent at least 5 business days before the hearing.

On receipt of a summary of submissions, the opposition officer will give a copy of a party’s summary to the other party or parties as soon as practicable.

If only one party appears then their summary of submissions must be filed at least 5 business days before the hearing.

Where applicable, if a party fails to file a summary of submissions within the time set by the regulations, the hearing officer will consider this in making an award of costs in the matter.

For more information on the oral hearing process, see 3.8 Hearings and Decisions.

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**Hearings by written submissions**

Where an opposition is set for hearing by written submissions, under reg 22.23(1), the parties will be notified of the period in which the submissions must be filed. The hearing officer will determine the matter after considering the written submissions.
3.2.8.3 Remedies Where Declaration Made

For more information on hearings by written submissions, see 3.8 Hearings and Decisions.

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The decision

Once the matter is decided, the requestor and any other parties will be notified of the decision. This may be the making of a declaration of entitlement and any necessary direction (see 3.2.8.3 Remedies Where Declaration Made) or that a declaration and/or direction should not be made. For further information on decisions see 3.8 Hearings and Decisions.

The decision will usually include an award of costs in the opposition. For further information see 3.9 Costs.

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Appeal of a decision

A decision under sections 35, 36 or 191A may be appealed to the Federal Court under subsections 35(3), 36(5) and 191A(6), respectively.

Note: This information applies to requests for determinations filed under sections 35, 36 and 191A, and patent applications made for sections 33, 34, 35, and 36, on or after 15 April 2013.

Where a declaration of entitlement is made it will be that a person currently recorded as an applicant or patentee is not entitled or that a person not recorded as a patentee or applicant is entitled. The Act provides several remedies to ensure that as a consequence of the declaration the correct entitlement is recorded in relation to an application or patent.

- Under section 32 or section 36 the Commissioner may direct that the application proceed in the name of all persons found entitled or may, subject to submissions
made by the parties, make another direction that resolves the matter. This might, for example, allow the application to proceed only in the name of the original applicant if disputed subject matter is deleted.

- Under section 191A the Commissioner may rectify the Register to name as patentees the persons found to be entitled to a share in the patent.

- Sections 33 to 36 enable a person who has been determined to be an eligible person to make a complete application which maintains the priority date of the other application or patent (See 3.2.8.4).

3.2.8.4 Patent Applications under Sections 33 to 36

Note: This information applies to patent applications made for sections 33, 34, 35, and 36 on or after 15 April 2013.

In this topic:

Sections 33 to 36 enable a person who has been determined to be an eligible person to make a complete application which maintains the priority date of the other application or patent. Reg 3.8 requires that application to be made within 3 months of the relevant decision or declaration referred to in the relevant one of those sections.

Where a new application has been made pursuant to section 33, 34 or 35 for the whole (or part) of the subject matter of an application or patent on which the determination was made, it is not necessary for that new application to be examined, and advertised accepted as per normal procedures - this has already been done in respect of the subject matter insofar as it appeared in the original application. It is essential, however, that the new application be drafted in terms corresponding to those of the original application or patent, subject to the decision of the delegate of the Commissioner or the Court - this means that the new application should be identically worded to corresponding parts of the original, or should represent the original in an amended form which meets the terms of the decision.

See e.g. Massey v Noack 11 IPR 632, (1988) AIPC 90-505.

This, of course, excludes the possibility of inclusion of "new matter" in the new application, and limits the scope of the new claims to falling within the scope of the claims of the original application, unless the decision requires otherwise, e.g. on the basis that a relevant original claim did not define the invention.
Once the new application is lodged, and the above conditions are met, the delegate may direct the application be granted, subject to any appeal on the decision. However, if appropriate, the Commissioner may direct re-examination of the application.

Applications made pursuant to a declaration under section 36 are not treated any differently to other applications excepting in relation to priority dates as provided by section 36(4) and the date of the patent, if granted.

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**Patent Term**

The term of the new patent generally runs from the date of the patent of the original application or patent. See reg 6.3.

It should also be noted that an action for infringement only lies from the date of publication of the new patent. The "rectified grantee" acquires rights in respect of infringement only prospectively. *GS Technology Pty Ltd v Elster Metering Pty Ltd [2008] FCA 17* at [78] to [79]

If an original patent has been extended the extension of term does not flow on to the new patent.

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**Priority dates**

For section 33, 34 and 35 the priority date of a claim in a patent granted on the new application is the same as the priority date of the relevant claim or claims in the original application or patent.

The priority date for a claim in a patent application filed pursuant to section 36 is determined under reg 3.13.

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**Application requirements for sections 33, 34 or 35.**
A person seeking to invoke section 33, 34 or 35 must file with the Commissioner a new application containing:

- patent request form
- specification
- request for publication (optional)
- filing fee

and a clear indication that section 33, 34 or 35 is invoked.

The new filing is processed normally, and is advertised. The date of filing given to the new application is the actual filing date, and no priority details are recorded at this time.

OH&L will arrange for an Examiner to check that the specification of the new application is the same as that of the original, and that the new application is in order for grant (e.g. the patent request is in order). OHL will then prepare a notice including the relevant declaration to be signed by the Deputy Commissioner (OHL). ERA will then grant the new patent. A copy of the notice and declaration will be placed in the file of the new patent.

ERA will then change the following data in relation to the new patent (on the advice of OH&L):

- The date of the patent calculated according to reg 6.3.
- The anniversary on which fees are due is the same as that applying to the original application/patent. The next fee due is the same as the next continuation/renewal that would have applied to the original application/patent.
- The priority date of the patent is the same as that of the original application/patent

The filing date of the new patent is not altered.

ERA will then write to the patentee advising them that the patent has been granted, the date of the patent, and the date that the next renewal fee will be due.
Inventorship

The law in relation to inventorship and entitlement was recently considered by the Full Court of the Federal Court of Australia in *University of Western Australia v Gray* [2009] FCAFC 116. The Court accepted that entitlement is assessed by considering three matters:

- Identify the “inventive concept” of the invention as defined in the claims;
- Determine inventorship including the person responsible for the inventive concept and the time of conception as distinct from its verification and reduction into practice; and
- Determine if contractual or fiduciary relationships between the parties at the time of the inventorship give rise to the proprietary rights in the invention.

As noted by French J, the inventive concept marks the boundary between invention and verification. Thus, inventorship ends at the time of conception and is distinct from verification and reduction to practice. He referred to the following principles as established by US appellate courts:

- Conception is the touchstone of inventorship, the completion of the mental part of inventions.
- Conception is the “formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is hereafter to be applied in practice”. It is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice without extensive research or experimentation.
- An inventor need not know that the invention will work for conception to be complete. The inventor need only show that he or she had the idea. The discovery that an invention actually works is part of its reduction to practice.
- It is not the law that the inventor’s definite and permanent idea must include a reasonable expectation that the invention will work for its intended purpose even when it deals with uncertain or experimental disciplines where the inventor cannot reasonably believe that an idea will be operable until some result supports that conclusion.

In *Polwood Pty Ltd v Foxworth Pty Ltd* [2008] FCAFC 9 the Federal court noted that in determining inventorship ‘what one is normally looking for is “the heart” of the invention. There may be more than one “heart” but each claim is not to be considered as a separate “heart” on its own’ (per Jacob LJ in *Markem Corp.v Zipher Ltd* [2005] All ER 377).
3.2.8.5 Relevant Cases

**Employment**

The Full Court in *Gray* acknowledged that there was a principle in common law whereby inventions developed by employees in the course of their employment would belong to their employer as an implied term of contract. Nettle J summarised this principle in *Victoria University of Technology v Wilson* [2004] VSC 33 (18 February 2004) at [104]:

> “The law is well settled upon the position of an officer or employee who makes an invention affecting the business of his or her employer. It is an implied term of employment that any invention or discovery made in the course of the employment of the employee in doing that which he is engaged and instructed to do during the time of his employment, and during working hours, and using the materials of his employers, is the property of the employer and not of the employee. Having made a discovery or invention in course of such work, the employee becomes a trustee for the employer of that invention or discovery, and he is therefore as a trustee bound to give the benefit of any such discovery or invention to his employer.”

The implied term of contract arises from the fiduciary nature of the employer-employee relationship as a master-servant. Lord Reid articulated this concept in *Patchett v Sterling Engineering Coy Ltd* (1955) at [58]:

> “… No doubt the respondent was the inventor and in the ordinary case the benefit of an invention belongs to the inventor. But at the time when he made these inventions he was employed by the Appellant as their Chief Designer and it is, in my judgment, inherent in the legal relationship of master and servant that any product of the work which the servant is paid to do belongs to the master. I can find neither principle nor authority for holding that this rule ceases to apply if a product of that work happens to be a patentable invention. Of course, as the relationship of master and servant is constituted by contract, the parties can, if they choose, alter or vary the normal incidents of the relationship, but they can only do that by express agreement or by an agreement which can be implied from the facts of the case.”

However, the mere fact that there is an employee-employer relationship does not necessarily mean that the employer owns the invention even where the employee used the employer’s time and resources to create an invention. As Nettle J observed in *Victoria University of Technology v Wilson* [supra]:

> “…The mere existence of the employer/employee relationship will not give the employer ownership of inventions made by the employee during the term of the relationship. And that is so even if the invention is germane to and useful for the
3.3 Directions

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employer's business, and even though the employee may have made use of the employer's time and resources in bringing the invention to completion. Certainly, all the circumstances must be considered in each case, but unless the contract of employment expressly so provides, or an invention is the product of work which the employee was paid to perform, it is unlikely that any invention made by the employee will be held to belong to the employer."

The test for whether an implied term applies is whether the invention was made by the employee in the course of his employment which was “part of his duty to make.” (Sterling Engineering Co Ltd v Patchett (1955) AC 534 at 544) The UK court in Harris’ Patent [1985] RPC 19 found that this “duty” imposed an obligation to invent. This approach was accepted by the Full Court in Gray [2009] FCAFC 116 at [152].

“...The end of this inquiry is to ascertain whether, if at all, it was part of an employee’s engagement with his or her employer to utilise his or her “inventive faculty” (cf Sterling Engineering at 544, Vokes at 136) in an agreed way or for an agreed purpose for the benefit of, or to further the purposes of, the employer. To use the shorthand of Electrolux Ltd v Hudson [1977] FSR 312 at 326, was the employee “employed to make or discover inventions at all?” or as French J put it, did the employee have a “duty to invent”...

In determining whether an employee has a “duty to invent”, the courts will generally give consideration to the nature and seniority of the employee's position, the nature of the employee's duties and whether the employee received a specific directive relating to the invention. The Court in Gray also considered whether there were any terms which were inconsistent with, or negated, the “duty to invent”.

3.3 Directions

In this topic:

 Relevant Legislation

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114
The Act

**Section 17** Directions to co-owners

**Section 55** Documents open for public inspection

**Section 56** Certain documents not to be published

**Section 113** Persons claiming under assignment or agreement

The Regulations

**Reg 4.3** Prescribed documents: public inspection

**Reg 5.12** Practice and Procedure

**Reg 5.22** Commissioner may give directions

**Reg 22.23** Written submission and oral hearings

**Reg 22.24** Practice and procedure other than for opposition proceedings

Overview

A number of provisions in the Patents Act and Regulations provide the Commissioner with the power to make directions in certain circumstances. These are summarised below.

The Commissioner may make directions for the conduct of opposition proceedings under **regs 5.12** and **5.22** (see **3.3.1 Directions in Opposition Proceedings**). In hearings other than opposition proceedings, the practice and procedure is determined by the Commissioner in accordance with **reg 22.24** and the parties directed accordingly (see **3.2.8 Entitlement - Sections 33, 34, 35, 36 and 191A**; and **3.2.8.1 Procedure - Requests for the Commissioner to Make a Determination of Entitlement**).

**Regulation 22.23** provides that the Commissioner may make directions regarding written submissions in hearings proceedings (see **3.2.7.2, 3.2.8.2**).

**Section 17** provides that the Commissioner may give directions to settle disputes between co-owners of a patent as to dealings with the patent, the grant of licences under it or the
exercise of a right under section 16. For more information see 3.2.7 Sections 17 & 32 - Disputes Between Applicants and Co-Owners).

Under section 113 the Commissioner may direct that a patent application proceed in a different name or that a joint applicant be recorded. See 3.3.2 Directions that an application proceed in different name(s) – Section 113.

Under reg 4.3(2)(b) the Commissioner may direct that a document is not open for public inspection; and under section 56 may order inspection of a document. See 3.13 Documents not OPI – Orders for inspection or 3.6.5 Complying with a Notice or Summons; Reasonable Excuses.

3.3.1 Directions in Opposition Proceedings

Note: This information applies to oppositions commenced on or after 15 April 2013.

In this topic:

Relevant Legislation

The Regulations

Chapter 5 Opposition

Schedule 7 Fees

Overview

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Effective Date: 25 September 2019
3.3.1 Directions in Opposition Proceedings

The *Patents Act 1990* introduced into the opposition procedure “directions” for the conduct of proceedings. In broad terms, directions enable the Commissioner to have greater control over the conduct of an opposition. The relevant provisions are in regs 5.12 and 5.22 as follows:

**5.12 Practice and procedure**

The Commissioner may:

(a) decide the practice and procedure to be followed in a procedural opposition; and

(b) direct the parties accordingly.

**5.22 Commissioner may give directions**

(1) The Commissioner may give a direction in relation to an opposition to which this Chapter applies:

(a) if requested by a party in writing; or

(b) on the Commissioner’s own initiative.

(2) If the Commissioner proposes to give a direction, the Commissioner must give the parties an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

(4) The Commissioner must notify the parties of the direction as soon as practicable.

See “Requesting a direction” below in relation to fees which may be applicable for making representations under regulation 5.22(2).

The directions process can be initiated by a party to the action, or by the Commissioner.

Directions in relation to transitional applications (applications under opposition, where an evidentiary period had commenced but had not been completed prior to 15 April 2013) are covered in [3.3.1.1 Direction to Stay an Opposition Pending Another Action](#).

There is also provision in reg 22.14 for the Commissioner to “give notice” to a person to perform an act, file a document or produce evidence. These matters would normally be dealt with by the Deputy Commissioner in OH&L, and are not covered in this chapter.

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**Requesting a direction**

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Effective Date: 25 September 2019
Directions can be requested by either party, in writing. Alternatively, directions can be made by the Commissioner, without the need for a request.

Where a party requests a direction, the Commissioner will provide the other party with an opportunity to make representations prior to making a decision. The fee for making a formal representation objecting to a proposed direction (i.e. leading to a hearing on the proposed direction) can be found at Schedule 7, item 220. No fee is payable for merely making representations to the Commissioner expressing a viewpoint on the proposed direction, where the representations do not comprise a formal objection to the proposed direction. Once a decision is made, the Commissioner must notify the parties of the direction.

The Commissioner must only make a direction if satisfied that it is appropriate. See Mobay Corp. v Dow Chemical Co. 24 IPR 379; (1982) AIPC 90-895, in which it was said:

“The first point that should be made is that the power is discretionary. Consequently, the Commissioner must be satisfied that the exercise of the power is appropriate in the circumstances.”

Directions that can be given

The range of directions that can be made is wide. The only limitation imposed by the Regulations is that they must not be inconsistent with the Act or Regulations.

The following parts of the Manual discuss some of the more common directions. Most of these directions can be requested by a party, or proposed by the Commissioner of their own initiative.

Note: This information applies to oppositions commenced before, on or after 15 April 2013.

Where there is another proceeding or action in relation to an application or patent that is under opposition, it may be appropriate to stay the opposition until the other matter is finalised.
The most common examples will be amendment of the specification, or amendment of the statement of grounds and particulars in the opposition. Where the way in which the opposition progresses is highly dependent on the outcome of the amendment, it is sensible for the opposition to be stayed. However, if the amendment does not significantly alter the scope of the opposition, the opposition will not be stayed.

The form of the stay would typically be:

The opposition is stayed until the Commissioner advises the parties that <the amendment> has been allowed, refused or withdrawn.

A stay may also be available during appeal or review of a decision.

A stay does not halt the evidentiary periods for filing evidence in a substantive opposition. Rather, the fact that the opposition has been stayed is an exceptional circumstance, that can provide the basis for an extension of time for filing evidence. Therefore, in the presence of a stay the Commissioner may exercise initiative and extend the period for filing evidence by direction, without the need for a party to gain extensions of time during the period specified in the direction. In the case of procedural oppositions, see 3.3.1.4 Time for Filing Evidence in a Procedural Opposition.

An opponent may request directions for further and better particulars. In *Mobay Corp. v The Dow Chemical Company* [1992] APO 25; 24 IPR 379, in the context of directions provisions of the 1952 Act, it was said:

“... further and better particulars are a logical part of a system of particulars, as they provide a simple mechanism to correct deficiencies in particulars. The amendment provision of regulation 5.9 provides a mechanism for inserting improved particulars. This differs from directing that an applicant amend in a specified way because the nature and form of the amendment is up to the applicant. Thus, further and better particulars are entirely consistent with the scheme set up by the Regulations."

A direction for further and better particulars should specify the time within which the opponent is to reply, and impose terms on the opponent in the event of its failing to respond. Suitable terms could be a direction that the opponent will be precluded from arguing in support of those grounds for which particulars were ordered but not delivered."
A direction to provide further and better particulars can also arise as a result of a dismissal action.


### 3.3.1.3 Time for Filing Evidence in a Substantive Opposition

**Note:** This information applies to oppositions commenced on or after 15 April 2013, and substantive oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

Directions under reg 5.22 must not be inconsistent with the *Regulations*. The *Regulations* make provision for the extension of evidentiary periods in reg 5.9. It would be inconsistent with the *Regulations* to provide for a *de facto* extension of time by a different means (especially considering that extensions under reg 5.9 are only available in limited circumstances). Consequently, extensions of time in substantive oppositions are not available by a direction.

Where the Commissioner has made a direction to stay an opposition (see 3.3.1.1), this provides the basis for an extension of time (because it is an exceptional circumstance).

### 3.3.1.4 Time for Filing Evidence in a Procedural Opposition

**Note:** Information is provided for oppositions under sections 104(4), 223(6) and reg 22.21(4) commenced before 15 April 2013 or on or after 15 April 2013, as specified.

In this topic:

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Effective Date: 25 September 2019
**Procedural oppositions commenced on or after 15 April 2013**

In the case of procedural oppositions, evidence is not always required or relied on. Consequently, in procedural oppositions commenced on or after 15 April 2013, there are no set time periods for the filing of evidence. Once the statement of grounds and particulars has been filed, the parties will be asked to indicate if they wish to file evidence. If a party intends filing evidence, they must specify the nature and significance of the evidence, and how long they will need to prepare the evidence. A delegate will consider the information, and propose a direction under reg 5.12.

The setting of evidentiary periods by direction is a procedural ruling. The procedure established must accord the parties natural justice, by allowing each of them to “have the opportunity to advance its case and to meet the case of [the other party]” ([Somnomed Ltd v Commissioner [2006] FCA 765 at [23]](https://www.federalcourt.gov.au/files/misc/765.pdf)). However, provided natural justice is observed, the Commissioner can adopt any reasonable procedure.

**Extending the time for filing evidence**

Regulation 5.9 cannot be used to extend an evidentiary period in a procedural opposition where the opposition commenced on or after 15 April 2013. Instead, any extension must be done as a new direction under reg 5.12.

It would be inconsistent with the thrust of the Regulations for extensions of the evidentiary periods for procedural oppositions to be obtained on criteria less stringent than those applying to substantive oppositions. Consequently, the criteria considered under reg 5.9 are relevant to any request for a direction under reg 5.12 that extends the time for filing evidence.

Where a procedural opposition has been stayed, the delegate will also extend the period for filing evidence. The normal direction would be that:

> The evidence is due to be filed <xx> months after the stay has ended.

**Procedural oppositions commenced before 15 April 2013**
3.3.1.5 General Conduct of Proceedings

For oppositions under sections 104(4), 223(6) and reg 22.21(4) commenced before 15 April 2013, the evidentiary periods are prescribed by reg 5.8 as in force immediately before 15 April 2013.

For a summary, see:

- **3.2.4.3 Evidence and Evidentiary Periods** (section 104(4) oppositions);
- **3.2.5.3 Evidence and Evidentiary Periods** (section 223(6) oppositions); and
- **3.2.6.3 Evidence and Evidentiary Periods** (reg 22.21(4) oppositions).

### Extending an evidentiary period commenced before 15 April 2013

Reg 5.10(2) as in force immediately before 15 April 2013 applies to extend an evidentiary period that commenced prior to 15 April 2013.

See [3.11.3 Extensions of Time - Reg 5.10](#).

### Extending an evidentiary period commenced on or after 15 April 2013

Pursuant to reg 23.36(2) item 2, reg 5.9 applies to extend an evidentiary period in a procedural opposition provided that:

- i. the opposition commenced before 15 April 2103; and
- ii. the evidentiary period commenced on or after 15 April 2013.

See [3.11.2 Extensions of Time – Reg 5.9](#).

Occasionally, events surrounding an opposition result in some confusion as to the status of material filed or served, and/or what actions are required next. See for example, *Leonardis v St Alban* 24 IPR 351, (1992) AIPC 90-929.

In such circumstances the Commissioner will use the directions mechanism to rectify the situation.
3.3.1.6 Further Directions

Where any direction has been given, the Commissioner retains the power to make further directions. For instance, where an opposition is stayed due to a pending amendment, the Commissioner will monitor the progress of the amendment to ensure that the stay does not unnecessarily prolong the opposition. Where appropriate, the stay can be lifted.

3.3.2 Directions that an Application Proceed in Different Name(s) - Section 113

In this topic:

**Relevant Legislation**

**The Act**

- Section 113 Persons claiming under assignment or agreement

**The Regulations**

- Reg 10.14 Persons claiming under assignment or agreement
- Schedule 7 Fees
Introduction

Section 113 empowers the Commissioner to direct that a patent application proceed in a different name or that a joint applicant be recorded where a person has become entitled, by virtue of assignment or agreement or by operation of law, to the interest of the original applicant or to an undivided share in that patent or in that interest.

Section 113 is as follows:

113. Persons claiming under assignment or agreement:

(1) Where, before a patent is granted, a person would, if the patent were then granted, be entitled under an assignment or agreement, or by operation of law, to:

(a) the patent or an interest in it; or

(b) an undivided share in the patent or in such an interest;

the Commissioner may, on a request made by the person in accordance with the regulations, direct that the application proceed in the name of the person, or in the name of the person and the applicant or the other joint applicant or applicants, as the case requires.

(2) Where the Commissioner gives a direction:

(a) the person is to be taken to be the applicant, or a joint applicant, as the case requires; and

(b) the patent request is to be taken to have been amended so as to request the grant of a patent to the person, either alone or as a joint patentee, as the case requires.

Note: Before grant of an application, if the applicant has merely changed their name, this can be recorded by way of an amendment to the patent request under sec 104.

For more information see 2.6.4.2 Section 113 Amendments (Assignment, Agreement or Operation of Law).

Requesting a direction under section 113
A request for the Commissioner's direction under sec 113 must be made in accordance with reg 10.14 in the approved form (available on the IP Australia website) and be accompanied by the prescribed fee.

In order for the Commissioner to be satisfied that a sec 113 direction should be made, the requestor must file relevant documents which establish the proposed applicant's entitlement. Similar documents and requirements apply as for recording an interest in the Register of Patents - see 3.10.2.1 Recording New Particulars in the Register, 3.10.2.1.1 Assignment under the heading 'Evidence required'.

**Note:** Where a direction is given under sec 113, the person is recorded as both the applicant and nominated person. Thus, although a patent application need not be made by an eligible person (and indeed can be made by an unincorporated body of persons), a person making a sec 113 request must be an eligible person.

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**Exercise of the Commissioner's discretion**

The Commissioner has a discretion under sec 113 whether to provide a direction as requested.

Before directing the application to proceed in a different name, the Commissioner must be satisfied that the new entitlement has been created. If there is any doubt, more evidence or clarification may be requested.

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**Lapsed applications**

The Commissioner can give a direction under sec 113, if the application has lapsed. The requestor will however need to apply under sec 223 to get the application restored (see 3.11.1 Extensions of Time – Section 223).

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**3.4 Opposition Documents - Requirements and Amendments**
3.4.1 The Notice of Opposition

Note: This information applies to oppositions commenced on or after 15 April 2013.

In this topic:

A number of actions by the Commissioner can be opposed by filing a notice of opposition in the approved form (available on the IP Australia website).

Timing and requirements for filing a notice of opposition

The nature of the actions that can be opposed, and the timing and requirements for filing a notice of opposition to commence procedural and substantive oppositions can be found at 3.2 Opposition, Disputes and Other Proceedings – Procedural Summaries.

When a notice of opposition is filed, the opposition officer will acknowledge receipt to the opponent and applicant and will give the applicant a copy of the notice as soon as practicable.

Extending the time to file a notice of opposition

In some circumstances, a short extension of time to file a notice of opposition may be available under section 223 (see 3.11.1 Extensions of Time – section 223). However, once a patent is granted, a notice of opposition to grant of a patent will be of no effect.

Amending a notice of opposition
3.4.2 The Statement of Grounds and Particulars

Under regs 5.14 and 5.15, an opponent may request an amendment to the notice of opposition to correct a clerical error or obvious mistake, or to change the name of the opponent where the opponent’s right or interest in an opposition is transferred to another person. For more information see 3.4.3 Amending Opposition Documents.

Note: This information applies to oppositions commenced on or after 15 April 2013.

In this topic:

The statement of grounds and particulars sets out the basis of the opposition.

Timing and requirements for filing a statement of grounds and particulars

The statement of grounds and particulars must be filed in the approved form (available on the IP Australia website).

As of 15 April 2013, at the time of filing, the statement of grounds and particulars must be accompanied by a copy of each document mentioned in the statement unless the document is open for public inspection and relates to a patent or patent application (reg 5.5(2)).

For more information on the timing and requirements for filing the statement of grounds and particulars in the various substantive and procedural opposition proceedings see the section “Filing the Statement of Grounds and Particulars” for the relevant opposition under 3.2 Oppositions, Disputes and Other Proceedings – Procedural Summaries, or for oppositions under section 101M see 3.2.2.1 Commencing the Opposition - Filing the Opposition Documents.

The function and consequence of the statement

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Effective Date: 25 September 2019
The function of the statement of grounds and particulars is to give the applicant fair notice of the case to be met, and to define the issues of the opposition. The opponent is bound by the statement of grounds and particulars, and its case is confined to the issues raised in that statement, unless it is amended under reg 5.16.

The statement may also provide the basis for re-examination under chapter 9 or 9A (see 2.22 Re-Examination (Chapter 9 and Section 101G)) or summary dismissal of the opposition (see 3.7.2 Dismissal of an Opposition).

Any evidence adduced by the opponent which is not related to matters encompassed by the statement of grounds and particulars, will not be considered as forming part of the evidence for the purposes of the opposition proceedings. Nevertheless, the Commissioner may have regard to any relevant document provided in evidence but not included in the statement of grounds and particulars, which may, for example, provide a basis for re-examining the application.

The particulars in the statement must be substantiated by the evidence. There may be instances where a particular does not require supporting evidence and can be argued on the basis of the specification without resort to evidence - for example section 40 matters. However, grounds such as novelty and inventive step require a citation and/or evidence of the common general knowledge. If the document relied on is not in evidence before the Commissioner, the opponent will be unable to argue their case with reference to the citation, nor rely on the availability of the citation in the Patent Office. See, e.g. Coal Corporation of Victoria v Hinkley & Anor [1993] APO 56.

The grounds of opposition

The statement of grounds should clearly identify the particular ground(s) of opposition available under the Act on which the opponent relies to establish the opposition.

The grounds for oppositions under sections 59, 75, 101M and 104 are clearly set out in the Act. Note that section 59(b) and (c) and section 104(5) make reference to other sections of the Act, importing these as the grounds of opposition. That is, for oppositions under section 59, 59(b) provides three grounds of opposition - manner of manufacture (18(1)(a)), novelty (18(1)(b)(i)) and inventive step (18(1)(b)(ii)). Similarly, grounds of opposition to amendments under section 104 include those individually set out in 102(1), 102(2)(a), and 102(2)(b). See Fujisawa Pharmaceutical Co Ltd v Banyu Pharmaceutical Co Ltd [1994] APO 52.

For oppositions under section 223(6) the available grounds are that the application does not satisfy the requirements of section 223(2) or 223(2A). For oppositions under reg 22.21(4)
the grounds of opposition are that the applicant for a licence does not satisfy the requirements for grant of a licence under the provisions of reg 22.21.

The particulars of opposition

The statement of grounds and particulars must include a corresponding statement of particulars for each ground of opposition. A statement of grounds that is not supported by a statement of particulars is open to dismissal under reg 5.18.

The statement of particulars should be in summary form, and be as brief as the nature of the opposition permits. However, it is essential that the particulars set out the material facts on which each ground of opposition is based. A material fact is a fact which is necessary for the purpose of formulating a complete ground of opposition. The opponent is not required to state the legal effect of the facts on which they rely; they are only required to state the facts themselves.

The particulars do not need to refer to the evidence by which those facts are proved. However, where a ground of objection is dependent upon a document (e.g. a citation in an opposition to grant), the particulars should clearly, specifically and unambiguously, identify that document.

Where a ground of opposition relates to deficiencies in the specification or other documents, the particulars should identify those deficiencies.

Whatever the generality adopted in the statement, it must be consistent with the purpose of the statement of grounds and particulars. Although a statement of particulars may bring in all the facts necessary to establish a ground of opposition, it will be defective if it is of such generality that it is insufficient to properly inform the applicant of the case it has to meet.

When the statement of particulars is deficient, the Commissioner may make directions requiring the opponent to file further and better particulars (see 3.3.1.2 Further and Better Particulars).

A ground can be dismissed where none of the particulars provide material facts.

Information required in the particulars

Examples of the type of information needed in a statement of grounds and particulars include:
for documents, where the number cited exceeds 7 to 10, the relevance of the reference to the ground together with page and line references to direct the reader to the specific part of the document that is to be relied on. Also, where patent documents have been published in more than one version, then the version being relied on should be identified and if reference is made to patent family members then material facts relevant to the family member should also be clearly identified;

for common general knowledge, a brief description of the technological nature of the particular aspect of common general knowledge relied on;

for manner of manufacture, a brief description of the particular type of manner of manufacture, e.g. a mere mixture of known ingredients, together with brief details of material facts to establish a *prima facie* case;

for matters such as prior knowledge, sale, prior use, a brief description of their relevance to the ground together with brief details of the material facts to support a *prima facie* case, for example, (a) the date and place of any use, (b) the person or persons to whom the invention was allegedly disclosed or sold;

for trade marks or trade names, a brief description of the nature of the material together with a description of its relevance to the opponent's case. Of themselves, references to trade marks or trade names are meaningless particulars; it is quite possible for the constituents of a product to be changed and for the product to continue to be sold under the same trade mark or trade name;

for section 40 matters, a brief description of the specific subject matter causing section 40 not to be satisfied, a clear statement of the specific statutory requirement and identification of the deficient part of the specification (by reference to page and line and/or claim numbers);

where the opposition is dependant upon the operation of section 114 (i.e. on a finding of a priority date later than the filing date of the application), the facts relevant to establishing that late priority date. See *Fujisawa Pharmaceutical Co Ltd v Banyu Pharmaceutical Co Ltd* [1994] APO 52.

**More than 10 documents particularised**

Where the statement of grounds and particulars particularises more than 10 documents for any one ground, the statement is required to briefly and generally identify what information in each of these documents is relied upon in relation to the particular ground of opposition (*Imperial Chemical Industries plc v Irenco Inc* 26 IPR 154).

Where a statement of grounds and particulars particularises a huge number of documents by reference to a document number or non-patent literature reference only for any ground of
3.4.2 The Statement of Grounds and Particulars

opposition - for example, a list of more than about 70 to 100 (although with large and complex documents the number may be less), it may be reasonable to infer that:

- nothing has been 'particularised' as the applicant will have no idea whatsoever of the case they have to defend;
- the opponent has served speculative particulars and is not undertaking a serious opposition; and
- the ground of opposition would open for dismissal.

Amending the statement of grounds and particulars

Under reg 5.16, an opponent may request amendment of the statement of grounds and particulars. For further information see 3.4.3 Amending Opposition Documents.

Requests for further and better particulars

Where the particulars of the opposition are deficient, the applicant may request the Commissioner to issue a direction for further and better particulars (see 3.3.1.2 Further and Better Particulars).

Requests for dismissal of the opposition

Under reg 5.17 an applicant may, within 1 month of the receipt of the statement of grounds and particulars, request the Commissioner to dismiss an opposition. See 3.7.2 Dismissal of an Opposition.

Modified Date: 19 December 2016
3.4.3 Amending Opposition Documents

Note: This information applies to oppositions commenced before, on or after 15 April 2013, as specified.

In this topic:

 Relevant Legislation

The Act

Section 59  Opposition to grant of standard patent
Section 75  Opposition to grant of an extension

The Regulations

Chapter 5  Opposition
Reg 9.5  Completion of re-examination
Schedule 7  Fees

The provisions of reg 22.22 do not apply to amendments to opposition documents (reg 5.13). Consequently, a party does not have a right to be heard independently of the express provisions of regs 5.14 and 5.15.

Amending a Notice of Opposition

Note: This information applies to oppositions commenced before, on or after 15 April 2013, as specified.
An opponent may request the Commissioner in writing to amend its notice of opposition to:

- correct a clerical error or obvious mistake (reg 5.14, or reg 5.3A as in force immediately before 15 April 2013), or
- change the name of the opponent where the opponent's right or interest in an opposition is transferred to another person (reg 5.15, or reg 5.3B as in force immediately before 15 April 2013).

There are no legislative provisions allowing a request to be made for any other type of amendment to the notice.

On receipt of a request to amend the notice of opposition, the applicant or patentee will be notified of the opponent's request, and the parties will be given an opportunity to make representations about the proposed amendment. The fee for making a formal representation objecting to a proposed amendment (i.e. leading to a hearing on the proposed amendment) can be found at Schedule 7, item 219. No fee is payable for merely making representations to the Commissioner expressing a viewpoint on the proposed amendment, where the representations do not comprise a formal objection to the proposed amendment.

The parties will be notified of the delegate’s decision in the matter as soon as practicable. If the amendment is allowed, the applicant or patentee will be given a copy of the amended notice of opposition.

Where the amendment to the notice is to change the name of the opponent, the opposition officer will ensure that the opposition proceeds in the name of the new opponent.

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**Amending a Statement of Grounds and Particulars**

**Note:** This information applies to oppositions commenced before, on or after 15 April 2013, as specified.

Under reg 5.16, or reg 5.9 as in force immediately before 15 April 2013, an opponent may request the Commissioner in writing to amend its statement of grounds and particulars to:

- correct an error or omission in the grounds of opposition;
- to update the grounds of opposition to reflect an amendment to the patent request or complete specification to which the statement relates; or
- to amend the facts and circumstances (the particulars) forming the basis for the grounds.
3.4.4 Filing Opposition Documents

On receipt of the request, the applicant or patentee will be notified of the opponent's request and the parties will be given an opportunity to make representations about the amendment. The fee for making a formal representation objecting to a proposed amendment (i.e. leading to a hearing on the proposed amendment) can be found at Schedule 7, item 219. No fee is payable for merely making representations to the Commissioner expressing a viewpoint on the proposed amendment, where the representations do not comprise a formal objection to the proposed amendment.

The statement of grounds and particulars must not be amended where:

- an application for dismissal of an opposition is being considered (reg 5.16(3)(a)); or
- the application has been opposed under section 59 and the opposed specification is being re-examined, and re-examination is not completed as required by reg 9.5 (reg 5.16(3)(b)).

In all other circumstances, the amendment will be made providing the delegate is satisfied that it is appropriate to do so.

Relevant factors to be taken into account in determining whether it is appropriate to make the amendment were considered in CSL Limited v Isconova AB et al [2016] APO 82, and include:

- the prospect of undue prejudice to a party – for example, the applicant may be unduly prejudiced by unnecessary delays in seeking amendment, or by the introduction of further particulars that change the case the applicant has to answer (see Diamond Scientific Company v CSL Limited [1992] APO 55);
- the timing of the amendment request and the reasonableness of the explanation of the delay;
- the public interest – noting that a correct determination of the opposition is one based on the issues properly raised in the opposition proceedings.

The parties will be notified of the delegate's decision in the matter as soon as practicable and, if the amendment is to be made, must give the applicant a copy of the amended statement.

**Note:** This information applies to oppositions and other proceedings commenced before, on or after 15 April 2013 where a document or evidence is filed on or after 15 April 2013.
3.4.4 Filing Opposition Documents

In this topic:

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**Relevant Legislation**

**The Act**

- [Section 214](#) Filing of documents
- [Section 214A](#) Approved means of filing documents
- [Section 214B](#) Directions by Commissioner for filing of documents
- [Section 214C](#) Directions by Commissioner for filing of evidence

**The Regulations**

- [Reg 22.16A](#) Consequences for evidence not meeting filing requirements
- [Reg 22.24](#) Practice and procedure other than for opposition proceedings

See also:

**Electronic Transactions Act 1999**

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**General**

**Note:** The obligation to serve a document or evidence on another party has been removed with effect from 15 April 2013. Documents and evidence need only be filed with IP Australia and the Commissioner is responsible for making a copy of the document available to the other party.

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Effective Date: 25 September 2019
Under sec 214B and sec 214C, the Commissioner may give a direction about filing a document or evidence respectively. (Note that reg 5.3 previously applied to documents or evidence filed before 24 February 2019).

Under sec 214C(2), the Commissioner may give a direction specifying:

(a) the number of copies of evidence to be filed;

(b) the form in which the evidence is to be filed (including the circumstances in which physical articles, other than documents, are or are not permitted to be filed);

(c) the means by which evidence is to be filed.

Under reg 22.16A, if a person does not comply with the direction under sec 214C, the Commissioner may treat the evidence:

(a) as not having been filed and notify the person, including in the notification a statement indicating how the direction has not been complied with; or

(b) as having been filed, but direct the person to do such things as are necessary to ensure that the direction is complied with.

Where the person does not comply with the direction under reg 22.16A within 2 months of the day it was given, the Commissioner must treat the evidence as not having been filed.

Normally a document or evidence may be filed in person or by post or by means specified in IP Australia's Electronic Business Rules.

The Commissioner has however directed (under reg 5.3) that certain opposition documents and evidence must be filed electronically with IP Australia by means approved by the Commissioner.

The Commissioner has also directed that physical articles should not be filed unless directed by the Commissioner.

For proceedings that are not oppositions these directions are made under reg 22.24.

Documents that must be filed electronically

Note: This information applies to oppositions and other proceedings commenced before, on or after 15 April 2013 where a document or evidence is filed on or after 15 April 2013.
The Commissioner has directed that the following documents and evidence must be filed electronically by the approved means for that purpose – currently **Objective Connect**:

- Statement of Ground and Particulars (SGP)
- A copy of any document cited in the SGP
- Evidence required to be produced by the Commissioner
- Evidence in Support
- Evidence in Answer
- Evidence in Reply
- Evidence in procedural oppositions or proceedings under sec 32 and sec 36, etc
- Summary of submissions for oral hearings.

Also, for oppositions commenced before 15 April 2013:

- Further evidence
- Further evidence in response.

For oppositions under sec 101M **only**, a notice of opposition may also be filed by the approved means but only after contacting Patent Oppositions Hearings & Legislation for assistance.

The requirements for document naming, file formats and process for filing documents and evidence using **Objective Connect** are specified in the [Patents User Guide](https://www.example.com).

Note that in addition to the above documents, covering letters associated with the SGP, evidence and other permitted document types can also be filed using **Objective Connect**. These should be contained in a separate file and include in its name the descriptor ‘letter’ and the date e.g. Evidence in support – Letter 15-04-2013.

Other opposition documents and correspondence including requests for extensions of time to file evidence (except where accompanied by evidence) must not be filed using Objective Connect. If so, these may be treated as not filed.

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**Date of filing**
3.5 Evidence

Note: This information applies to oppositions and other proceedings commenced before, on or after 15 April 2013 where a document or evidence is filed on or after 15 April 2013.

The date of filing a document through the approved electronic means is determined under the *Electronic Transactions Act 1999*. The time of filing is the time (and date) in Canberra, i.e. AEST or AEDT as applicable, when the requirements for filing in the system have been met and recorded.

If a document is filed other than in the approved means, the Commissioner may treat the document as not filed or may treat it as filed and direct that the party concerned comply. In the latter case, the filing date of the document is preserved despite it not being filed according to the Commissioner's requirements.

Physical Evidence

Note: This information applies to oppositions and other proceedings commenced before, on or after 15 April 2013 where a document or evidence is filed on or after 15 April 2013.

Physical articles may only be filed with leave of the Commissioner. It is preferred that documentary evidence includes a description of any relevant physical article and as appropriate a photograph or video recording as well as an indication of the place at which the item may be inspected.

On application, and in the absence of agreement between the parties, the Commissioner may order inspection at a place and on terms that the Commissioner considers appropriate. The Commissioner may also direct that the item be produced but will do so only where the Commissioner considers it necessary for the determination of the opposition or other proceeding.

3.5 Evidence

Modified Date: 25 February 2019

3.5 Evidence
Note: This information applies on or after 15 April 2013.

In this topic:

Relevant Legislation

The Act

Section 55 Documents open to public inspection
Section 210 Commissioner’s powers
Section 214 Filing of documents
Section 214C Directions by Commissioner for filing of evidence

The Regulations

Reg 4.3(2)(b) Prescribed documents: Public inspection
Chapter 5 Opposition
Reg 5.8 as in force immediately before 15 April 2013 Time for Giving of Evidence (oppositions filed before 15 April 2013)
Reg 5.10 as in force immediately before 15 April 2013 Conduct of proceedings to which this Chapter applies (in oppositions filed before 15 April 2013)
Reg 22.12 Giving of oral evidence
Reg 22.13 Declarations
Reg 22.15 Requirements for filing documents
Reg 22.24 Practice and procedure other than for opposition proceedings

General

Note: The obligation to serve a document or evidence on another party has been removed with effect from 15 April 2013. Documents and evidence need only be filed with IP Australia by the approved means and the Commissioner is responsible for making a copy of the document available to the other party.

Chapter 5 of the Regulations provides for the filing of evidence in opposition proceedings. Evidence may also be filed in support of other proceedings as directed by the Commissioner under reg 22.24 or as otherwise provided by the Act and Regulations.

The Commissioner is an administrative decision maker and is not restricted by the formalities which might be applicable to court actions, and strict evidentiary and other procedures are not applicable.

Please note that:

- Information about when evidence must be filed, including for oppositions filed before 15 April 2013, is contained in 3.2 Oppositions, Disputes and Other Proceedings - Procedural Summaries.

- From 15 April 2013 evidence must be filed electronically by approved means. Information about how evidence (and other documents) is to be filed can be found at 3.4.4 Filing Opposition Documents.

- In certain circumstances, an extension of an evidentiary period can be granted. The law that applies depends on when the evidentiary period commenced. For evidentiary periods that commenced on or after 15 April 2013 see 3.11.2 Extensions of Time - Reg 5.9. For evidentiary periods commencing before 15 April 2013 see 3.11.3 Extensions of Time - Reg 5.10.

Confidential Evidence
Under section 55(2) documents filed in opposition proceedings, such as the evidence, are open to public inspection (OPI). In limited circumstances the Commissioner may however direct that a document not be OPI and may then allow inspection of the documents under specific conditions (see 3.13 Documents not OPI - Orders for Inspection).

3.5.1 Presentation of Evidence

Overview

Written and documentary evidence must be in the approved form and be filed with the Commissioner electronically by approved means. For information on the approved form of written and documentary evidence, see 3.5.1.1 Written Evidence and Declarations. Information about how evidence is to be filed can be found at 3.4.4 Filing Opposition Documents.

**Note:** If documents have been filed together with the statement of grounds and particulars, the opponent may, during the evidence in support period, request a direction that those documents be treated as evidence in support, rather than refiling them as evidence.

The Commissioner requires that filed evidence comply in terms of the file format, file size and naming conventions (see the Objective Connect User Guide – Patents which is available on the IP Australia website). If evidence is not presented in suitable format, the party who filed it may be requested to re-file the evidence in the appropriate format. Files found to be corrupted and unreadable will not be taken to be filed. The parties will be notified as soon as possible after a corrupted file has been identified.

**Note:** Physical evidence should **not** be filed unless requested or directed by the Commissioner (see 3.5.1.3 Physical Evidence – Special Considerations).

3.5.1.1 Written Evidence and Declarations

In this topic:
3.5.1.1 Written Evidence and Declarations

Overview

Under section 214C, a direction may require written evidence to be presented in declaratory form. (Note that reg 22.12 previously applied to written evidence filed before 24 February 2019). Reg 22.13 sets out the requirements for declarations and the manner in which they may be given to the Commissioner. Written evidence and documentary evidence must be in English, unless it is accompanied by a translation (reg 22.15). (For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided).

In general, where a declaration is required or permitted by the Patents Act or Regulations, a statutory declaration is not necessary - a declaration under the Patents Act 1990 and reg 22.13 of the Patents Regulations 1991 is sufficient. A declaration under the Patents legislation must be in the approved form (available on the IP Australia website).

Where a declaration is to be filed for the purposes of an opposition or other proceeding (e.g. under sections 32 and 36), it must be filed electronically via the approved means for that purpose (see 3.4.4 Filing Opposition Documents). If filed for other purposes, a declaration or statutory declaration may be given to the Commissioner in electronic form via the eServices portal.

What is the difference between a Statutory Declaration and a Declaration under the Patents legislation?

A statutory declaration under the Statutory Declarations Act 1959 is a written statement declared before, and witnessed by, a person specified in that Act. The penalties for a false statement in a statutory declaration include a fine or incarceration.

In comparison, a declaration under the Patents legislation does not need to be witnessed and the penalties for a person making a false statement under the Statutory Declarations Act do not apply. Nevertheless the consequences of making a false declaration may be serious including the potential for any decision obtained on the basis of the evidence to be found invalid.
3.5.1.1 Written Evidence and Declarations

The approved form for a Declaration under the Patents legislation

A declaration under the Patents Act and regulation 22.13 must:

a. be headed with the title of the matter for which the declaration is made; and
b. be expressed in the first person; and
c. state the name and address of the person making the declaration; and
d. state the date on which, and the place at which, the declaration is made; and
e. be divided into paragraphs, each of which must be:
   i. numbered consecutively; and
   ii. as far as practicable, confined to 1 subject; and
      f. be signed by the person making the declaration; and
      g. state that the person believes the declaration to be true and correct.

If the declaration is made for the purposes of a business whose details are set out in the declaration, it must also state:

a. the office or position in the business held by the person who makes the declaration; and
b. the address of the place at which the business is conducted or principally conducted.

It is no longer a requirement that a declaration must be made before another person. A declaration under the Patents legislation may also be given in an electronic form by means of an electronic communication: see section 11 of the Electronic Transactions Act 1999.

Declaration forms that are in the approved form are provided on the IP Australia website (See also the official notice dated 21 June 2012 for further detail).

Declarations not properly presented

Where evidence is not properly presented, a hearing officer may rule (e.g. at the hearing, or subsequently in a decision) that the material concerned is not admissible. Alternatively, they might admit the evidence if it might be probative but weigh it accordingly. (For more information see 3.5.2 Admissibility of Evidence)
Occasionally declarations filed in evidence may incorrectly identify one or other of the parties, and in such cases the declaration is effective provided the Commissioner can determine the purpose of the declaration. Regard should also be had to the actions of the other party on receipt of that evidence, which may be indicative of whether or not that other party has been disadvantaged by the error. (See Porter v Arbortech Investments [1994] APO 55 at page 11)

In this topic:

### Overview

Section 210 of the Patents Act provides authority for the Commissioner to summon witnesses and to take evidence under oath or affirmation for the purposes of the Act.

A witness may only appear before the Commissioner as a result of:

- the Commissioner issuing a summons following a request by one of the parties;
- the Commissioner issuing a summons of his or her own volition; or
- the Commissioner directing that the witness may appear voluntarily.

The Commissioner will require or allow oral evidence only in exceptional circumstances. Oral evidence is given under section 210 and is generally not considered to be evidence in support, in answer or in reply or further evidence regulated by Chapter 5 of the Patent Regulations. Consequently a witness may, according to the terms of the summons or Commissioner’s direction appear for the purpose of providing evidence in chief or for cross-examination on evidence already provided in declaratory form. If providing evidence in chief, the other party generally has the right to cross-examine the witness under oath. In either case the witness may also be re-examined.

For more information on the Commissioner’s role in summoning witnesses see 3.6 Production of Documents, Summonsing Witnesses.
Where a person does not comply with a summons without reasonable excuse, the Commissioner may take a number of actions under section 210A (see 3.6.6 Sanctions for Non-Compliance).

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**Receiving oral evidence on Oath or Affirmation**

Section 210(b) of the Act specifically allows the Commissioner to take evidence on oath or affirmation.

The taking of evidence on oath is not confined to the Christian or any other specific religion. An oath may be taken in such form and with such ceremonies as the person taking it declares to be binding upon him or her. If the witness is of a mind that an oath would not be binding upon them, or if on religious considerations they cannot make an oath, the witness may make an affirmation.

The hearing officer must be assured that the witness to be examined fully understands the solemnity and sanctions inherent in the making of an oath or an affirmation.

Certain evidence may be taken unsworn; e.g. from a child, or from a person doing no more than presenting a document in answer to a subpoena, or an advocate giving evidence of a compromise reached by the parties.

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**Swearing in**

A person appearing before the Commissioner to give oral evidence will be sworn in using the standard forms of "oath" and "affirmation" used by the ACT Supreme Court. These are as follows:

**OATH**

The oath must reflect the witness's beliefs. For example, a Christian would make the following oath holding a copy of the Bible in their right hand.

"I swear by almighty God that the evidence I shall give shall be the truth, the whole truth and nothing but the truth."

**AFFIRMATION**

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"I solemnly declare and affirm that the evidence I shall give shall be the truth, the whole truth and nothing but the truth."

The oath or affirmation is administered by an official of the Patent Office other than the hearing officer, for example the opposition officer.

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**Examination procedures for oral evidence**

**Examination in chief**

A witness may provide oral evidence in chief in an opposition or other matter. If oral evidence-in-chief is given, leading questions are not normally permitted in that they suggest coaching, or that the evidence is being suggested by the advocate rather than being stated from the witness's own knowledge. In particular, questions that suggest the answer that the advocate wants, or assumes the existence of a fact yet to be proved are leading questions. However, the following types of leading questions are generally permissible:

- undisputed introductory material, e.g. the "qualifications" of a witness in terms of name, address, occupation, academic and practical qualifications etc.;
- material to bring the witness quickly to the subject in issue, i.e. come straight to undisputed facts such as date, time, place, etc;
- questions that bring the witness quickly to a contradiction of what is alleged by the other party; and
- jogging the witness's memory (subject to discretion).

The Commissioner cannot require a witness to answer questions which the witness would not be required to answer in a court of law i.e. evidence in respect of which the witness could claim privilege.

**Cross-examination**

The fundamental difference between evidence-in-chief and cross-examination is that in cross examination leading questions may be put to the witness. Cross-examination is directed to two objectives; firstly to test the credibility of the witness and the accuracy and the completeness of his statements, and secondly to weaken, destroy or qualify the case of the other party.
Except for the matter of credit of the witness, cross-examination must be relevant to the facts in issue and must be confined to the admissible evidence (it is not confined to matters raised in the evidence-in-chief). Generally speaking, questions on the credibility of a witness relate to ambiguities in the language used; interests which throw doubts upon sincerity (whether conscious or not); factors which throw doubt on the accuracy of the evidence, and leave open other possible interpretations; and factors which may have affected or otherwise coloured the witness’s memory.

The distinction between cross-examination questioning that goes to the facts in issue, and that which goes to the credit of the witness, is sometimes difficult to assess. The witness’s credibility depends upon his or her knowledge of the facts, expertise, integrity, and veracity; and questions may be asked to investigate each and all of these. In terms of credit, the questions need not be otherwise relevant to the facts in issue and may be founded upon hearsay.

While leading questions may be asked during cross-examination, normal exercise of discretion would not allow "trap" questions, "double-barrelled" questions or questions that are vague or tend to mislead. Questions which are considered to be improper or offensive should not be allowed.

Questions which go to getting a contradiction of the evidence-in-chief should be put in such a manner that the witness has an opportunity to explain the contradiction. Where a cross-examining party intends to later contradict a witness (e.g. by calling further evidence or by suggesting that the witness’s testimony can be otherwise explained) the witness should be given the opportunity in cross-examination to comment on the contradictory version. (See the decision of the UK House of Lords in *Browne v Dunn* (1893) 6R 67 HL, which applies to cross-examination in Australia (Hunt J in *Allied Pastoral Holdings Pty Ltd v Commissioner of Taxation* [1983] NSWLR 1 at [16]).)

**Re-examination**

Whereas the purpose of cross-examination is to weaken or destroy the evidence-in-chief, the purpose of re-examination is to repair any such damage. In general, no new facts may be introduced at this stage and the re-examination must confine itself to explanations of matter arising in cross-examination. However, this is subject to the Commissioner’s discretion, e.g. when matters were unknown until this stage, or perhaps had been overlooked by the parties’ representatives. Nevertheless, the exercise of such discretion is, in effect, a re-opening of evidence-in-chief.
Unfavourable and hostile witnesses

An “unfavourable” witness is one whose testimony does not advance the case of the party who called them, despite the witness’s best intentions (for example due to forgetfulness or a genuine change in their interpretation of what they saw). A witness who is not willing to truthfully answer questions asked by the party which called them is termed a "hostile" witness. In this situation, the party calling the witness may ask the hearing officer to determine that the witness falls into either of the above categories.

Where the hearing officer makes a declaration that a witness is either unfavourable or hostile, the calling party is entitled to ask leading questions (e.g. in relation to previous conflicting statements).

Note that a declaration of hostility requires a finding that the witness is unwilling to tell the truth - a conclusion that cannot be lightly reached. The practical effect of such a declaration is to nullify the witness's testimony altogether.

Note: As the Commissioner is functioning as a Tribunal, it would only be in extreme circumstances that the Commissioner would contemplate making a declaration that a witness is either unfavourable or hostile.

Decisions influenced by a witness’s actions or demeanour

When a court or tribunal proposes to draw conclusions, on the basis of observations of the actions or demeanour of a witness, which would significantly influence the decision in a case, the court or tribunal is required to communicate to counsel that it may use the observations at a stage of the proceedings at which counsel can deal with them in a proper way. A decision will be invalidated by the failure to do so in a timely manner, unless the observations could not possibly have made any difference. See Marelic v Comcare, [1993] FCA 599.

Adjournments

When a witness is under cross-examination, they should not be assisted in any of their answers. When a hearing is adjourned mid-way through a cross-examination, an undertaking will be required that the witness will not consult with his or her legal advisers during the adjournment.
However, where the witness is closely associated with the conduct of the dispute (such as the actual inventor), the undertaking might be varied to allow their counsel to derive facts from them without suggesting what answers they should give in further cross examination.

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**Resolving objections during cross-examination**

During the cross-examination process, it is quite likely that objections will be raised by one or other of the parties in respect of procedural matters, or to the questions asked. In resolving such objections, hearing officers should bear in mind that, as a tribunal, they are there to determine the truth in the matter. That is, when arbitrating on an objection, the hearing officer should generally prefer a result which will lead to assistance in determining the truth in the matter to one which does not.

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**Note:** Physical evidence should not be filed unless requested or directed by the Commissioner.

At times a party’s evidence may include exhibited physical evidence, such as a piece of machinery. Physical articles should only be filed with the leave of the Commissioner. It is preferred that documentary evidence is filed in respect of the article, such as a description of any relevant physical article and, where appropriate, a photograph or video recording as well as an indication of the place at which the item may be inspected.

In general, physical evidence will not be released to a party for any purpose (e.g. for testing, whether destructive or not). However, in the absence of an agreement between the parties, the Commissioner may, on the application of a party, order inspection of the physical evidence at a place and on terms that the Commissioner considers appropriate.

The Commissioner may also direct that the item be produced but will do so only where the she or he considers it necessary for the determination of the opposition or other proceeding.
3.5.2 Admissibility of Evidence

In this topic:

Procedures for filing evidence in opposition proceedings specified in regs 5.4 and 5.10 are set out in Chapter 5 of the Patents Regulations 1991. In other actions, reg 22.24 empowers the Commissioner to determine the practice and procedure relating to evidence. The principles outlined in this part of the manual regarding the admissibility of the filed evidence have general applicability.

Where the Commissioner has to determine questions of fact, he or she is not obliged to decide in accordance with the rules of evidence applicable in a court of law. However, the Commissioner must make decisions on the basis of relevant and logically probative evidence.

Evidence not strictly in reply

Evidence-in-reply that contains evidence of new matters, and which in reality is evidence-in-support filed out of time, will not normally be considered in the determination of the opposition or other proceeding. The exception is where the Commissioner decides for oppositions filed before 15 April 2013 that the matter should be considered in the proceedings as further evidence, or decides to take the information into consideration under reg 5.23 (See 3.5.3 Evidence Filed Out of Time).

The parties to the proceedings should raise any issues with the evidence promptly. The Commissioner may then make a determination on the matter on an interlocutory basis or may direct that the matter be addressed in the substantive hearing of the matter.

Hearsay evidence

Evidence of a previous statement by another person is known as “hearsay” and is not eligible in court as proof of facts asserted in such a statement. This is defined in sec 59 of
3.5.2 Admissibility of Evidence

Hearsay evidence is admissible before the Commissioner. The Commissioner constitutes a tribunal and not a court, and she or he is not bound by rules of evidence that apply to a court.

Providing hearsay evidence can be considered reliable and is logically probative, the Commissioner may have regard to it in deciding a matter, provided that the parties are accorded natural justice. However, the weight which a hearing officer gives to hearsay evidence may be substantially different from the weight given to direct evidence.

That hearsay evidence may be admissible before a tribunal was confirmed by Deane J. in *Minister for Immigration and Ethnic Affairs v. Pochi* [1980] FCA 85 at [23]-[24] who agreed with the following statement by Diplock L. J in [1965] 1 QB 456 at p 488:

"These technical rules of evidence, however, form no part of the rules of natural justice. The requirement that a person exercising quasi-judicial functions must base his decision on evidence means no more than it must be based upon material which tends logically to show the existence or non-existence of facts relevant to the issue to be determined, or to show the likelihood or unlikelihood of the occurrence of some future event the occurrence of which would be relevant. It means that he must not spin a coin or consult an astrologer, but he may take into account any material, which as a matter of reason, has some probative value in the sense mentioned above. If it is capable of having any probative value, the weight to be attached to it is a matter for the person to whom Parliament has entrusted the responsibility of deciding the issue."

Similarly, in an earlier UK judgement Lord Denning M.R. said:

"A tribunal of this kind is master of its own procedure, provided that the rules of natural justice are applied. [There is] is no reason why hearsay should not be admitted where it can fairly be regarded as reliable. Tribunals are entitled to act on any material which is logically probative ... Hearsay is clearly admissible before a tribunal. No doubt in admitting it, the tribunal must observe the rules of natural justice, but this does not mean that it must be tested by cross-examination. It only means that the tribunal must give the other side a fair opportunity of commenting on it and of contradicting it, …”

(*T.A. Miller Ltd v the Minister for Housing and Local Government and Another* (1968) 1 WLR 992)

There may be many circumstances where hearsay evidence is the only evidence reasonably available. For example, the person in possession of the relevant information may be hostile or dead. However, a party seeking the exercise of a discretionary power ought not to rely on hearsay evidence merely to avoid inconvenience in obtaining a declaration from the person in possession of the facts. In those circumstances the Commissioner may reasonably require a declaration from the person in possession of the facts before being satisfied that she or he should exercise his or her discretionary powers.
3.5.2 Admissibility of Evidence

The Wayback Machine

The Internet Archive is a US non-profit organisation that aims to archive the internet, and is accessible through the Wayback Machine. The Wayback Machine can be used as a source of information relating to publication dates of material on the internet (see 4.1.4.3.3 Non-Patent Literature and 4.1 Annex L – Establishing Publication Dates and Capturing Internet Citations).

In Voxson Pty Ltd v Telstra Corporation Limited (No 10) [2018] FCA 376, Perram J found that pages obtained from the Wayback Machine were inadmissible hearsay.

“35. The operator of the Wayback Machine is therefore making a representation that it copied the webpage into its archive and recorded the date on which it did so and that the webpage which appears in its archive is the webpage which existed on that date. Since Voxson wishes to prove what the state of the Respondents’ websites was on the relevant dates using these pages, it follows that it wishes to adduce the pages generated by the Wayback Machine as evidence that those pages were, in fact, in that form on those dates. This is hearsay.”

As the Commissioner is not bound by the Rules of Evidence, evidence from the Wayback Machine can be considered on the balance of probabilities:

“… patent offices around the world do rely on internet documents as relevant prior art for the purposes of determining novelty and inventive step and the Wayback Machine is one of the ways to establish the publication date of an internet document. The Internet Archive may not be entirely reliable in respect to dates of availability or content on a particular date, but absent any reason or evidence of error then the dates and content on Wayback Machine should be accepted on the balance of probabilities.” [Sheng-Ping Fang [2011] APO 102 at 95]

However the nature of the evidence should be taken into account when according the appropriate weight to evidence from the Wayback Machine. For example:

“… the formatting is quite disordered and many of the photographs are missing. One does not perhaps need a particularly vivid imagination to think that these formatting problems are likely to be the result of some internal issue and may not affect the substance of the recording process. But there is no getting away from the proposition that the archiving process performed by the Wayback Machine plainly has limitations.” [Voxson at 40]
Libelous evidence

As a tribunal, the Commissioner of Patents can exercise the discretion to admit any evidence that may have some probity in an action before him or her. As to the weight given to such evidence, this is a matter for the Commissioner to decide after hearing the parties to the action.

The Commissioner has no power to consider the matter of libel which rightly falls within the jurisdiction of the Courts.

3.5.3 Evidence Filed Out of Time

In this topic:

It often happens that a party will attempt to introduce more evidence in the form of some kind of documentation outside of the time provided by the Act or Regulations and for which an extension of time is not available.

Oppositions commenced before 15 April 2013

Where an opposition commenced before 15 April 2013, a party seeking to adduce evidence outside the evidentiary timeframes may seek leave to file it as further evidence under reg 5.10(4) as in force immediately before 15 April 2013 (see 3.5.3.1 Further Evidence).

A party to the proceedings cannot rely on reg 5.11 as in force before 15 April 2013 to have the Commissioner treat such material as part of the inter partes opposition. The Commissioner will not use this reg 5.11 to allow a party to bypass the times for filing evidence set out in reg 5.8 as in force before 15 April 2013, nor the requirements for filing
3.5.3 Evidence Filed Out of Time

Further evidence provided by reg 5.10(4) as in force before 15 April 2013 (Leonardis v St Alban [1992] APO 38).

Oppositions commenced on or after 15 April 2013

There are no provisions for further evidence in an opposition commenced on or after 15 April 2013. However, reg 5.23 provides the Commissioner with the discretion to inform her or himself of a fact by reference to a document.

Regulation 5.23 is as follows:

Regulation 5.23 Commissioner may consult documents

1. For the purposes of deciding an opposition, the Commissioner may consult a document that:
   a. is relevant to the opposition; and
   b. has not been filed under this Chapter [Chapter 5 Oppositions]; and
   c. is available at the Patents Office.

2. If the Commissioner proposes to rely on the document, the Commissioner must give to the parties:
   a. notice of the Commissioner's intention to do so; and
   b. a copy of, or access to, the document; and
   c. an opportunity to give evidence or make representations about the document.

A party should not rely on further information in a document to avoid the evidentiary time frames prescribed by the regulations. While a party may file further information in the form of a document at any stage during the opposition proceedings for consideration by the Commissioner under reg 5.23, the power conferred by reg 5.23 is discretionary; the parties do not have a right to urge the Commissioner to make use of this power.

A document filed as further information during opposition proceedings, or a document filed with the evidence in reply that is not strictly in reply, is not evidence in the opposition. Where a document is filed, the Commissioner will exercise the discretion to determine the most appropriate course of action based on considerations such as the relevance of the

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information to the grounds of opposition and the stage at which the document is filed in the opposition process. Possible outcomes include that:

- the document may be admitted into the opposition proceedings for consideration with the benefit of submissions and/or evidence by the parties; or

- the document may be excluded from the opposition, but form the basis for re-examination of the specification under section 97 or section 101G once the opposition is concluded; or

- the document may be excluded from the opposition, and the Commissioner may take no further action in respect of the document.

Where the Commissioner admits a document into the opposition, the Commissioner will proceed in accordance with reg 5.23(2).

**Note:** If documents mentioned in or filed with the statement of grounds and particulars are not filed with the evidence in support, or included by way of a direction requested during the evidence in support period, the only means for such documents to be considered in the opposition is under reg 5.23.

**Implications of further information on costs in the opposition**

A document filed as further information during opposition proceedings, or a document not strictly in reply, is not evidence in the opposition. Therefore, where an opposition succeeds based on such material rather than the opponent’s evidence in support this will, where appropriate, be reflected in the award of costs.

**3.5.3.1 Further Evidence**

**Note:** The information in this part only applies to oppositions commenced before 15 April 2013.

Where an opposition commenced before 15 April 2013, and evidence is required under reg 5.10(4) to be served on a party on or after 15 April 2013, the evidence must be filed with the Commissioner, and the Commissioner will give a copy of the evidence to the other party.
Filing further evidence

For oppositions commenced before 15 April 2013, a party may request leave to file further evidence under the provisions of reg 5.10(4) as in force immediately before 15 April 2013.

Reg 5.10(4) as in force immediately before 15 April 2013 provides:

(4) The Commissioner may:

(a) on the application of a party; and

(b) on such reasonable terms (if any) as the Commissioner specifies;

permit the party to serve[*] further evidence on the other party.

Reg 5.10(5) as in force immediately before 15 April 2013 imposes further requirements:

(5) The Commissioner must not ... grant an application under subregulation ... (4) unless the Commissioner:

(a) if he or she proposes to grant an application by a party - is reasonably satisfied that the other party has been notified of the application; and

(c) …

(i) gives the parties a reasonable opportunity to make representations concerning the application or proposed action; and

(ii) is reasonably satisfied that ... the serving[*] of further evidence is appropriate in all the circumstances.

* Pursuant to the transitional reg 23.36(4) the requirement in reg 5.10 for evidence to be served, is taken to be a requirement to file the evidence.
Further evidence cannot be used a substitute for evidence in a proceedings

If a party has not filed evidence in the opposition proceedings, there is no basis for them to file “further” evidence. In order to be granted a request to file further evidence, a party must at least have already filed some evidence within the evidentiary period set by the regulations.

The request for further evidence

A request to file further evidence can be made at any time before, during or after the substantive hearing, providing the substantive action has not been concluded.

There is no “approved form” for requesting further evidence. However, unless a request is made orally at a hearing, it must be made in writing. As the request constitutes the basis for the exercise of the discretionary power under reg 5.10(4) as in force immediately before 15 April 2013, it must provide sufficient justification for the exercise of that power (irrespective of whether or not the request includes the evidence sought to be filed).

Procedure when a written request under regulation 5.10(4) is filed

When an application is made to file further evidence under reg 5.10(4) as in force immediately before 15 April 2013:

- the opposition officer will send a copy of the request to the other party, and:
  - will offer terms for allowing the request, including a period of time after the request is granted (usually one month) to file evidence in response; and
  - will invite the other party to make representations (including in respect of the terms) and to indicate whether they wish to be heard in the matter. The invitation will normally allow 21 days for a response.
3.5.3.1 Further Evidence

- the opposition officer will likewise advise the requester, by:
  - offering terms for allowing the request, to the effect that the other party will have a period of time after the request is granted to file evidence in response; and
  - inviting them to make representations (including in respect of the terms) and to indicate whether they wish to be heard in the matter. The invitation will normally allow 21 days for a response.

Where the other party has no objection to the request, the parties are in agreement with the terms, and the Commissioner has no objection to the request, the request will be granted and the parties notified accordingly.

If the only area of disagreement between the parties is with the terms to be imposed, the Commissioner will make reasonable efforts to settle the terms between the parties.

Where the other party objects to the request for further evidence, or there is an unresolved dispute regarding the reasonable terms, the Commissioner will set the matter for hearing.

Criteria for granting a request to file further evidence

Before granting a request to file further evidence, the Commissioner must be reasonably satisfied that the filing of further evidence is appropriate in all the circumstances.

The following decisions provide guidance for the exercise of the discretion.

- *Ferocem Pty Ltd v Commissioner of Patents* [1994] FCA 981 (Burchett J);
- *A Goninan & Co Ltd v Commissioner of Patents* [1997] FCA 424; 38 IPR 213 (Sackville J); and

The general principles that flow from these decisions are that:

- **The power is discretionary:** Regulation 5.10 confers a broad discretion, which cannot be reduced to imperative compliance with particular requirements. It is necessary to give genuine and proper consideration to all relevant considerations. (*Ferocem* [1994] FCA 981 at [11]; *Goninan* [1997] FCA 424; IPR at 220)

- **Explanation of delay:** The reasons why the evidence was not filed earlier are a relevant consideration, but a satisfactory explanation is not a mandatory requirement (*Ferocem* [1994] FCA 981 at [10]).
3.5.3.1 Further Evidence

- **The public interest**: The public interest in determining a serious opposition on its merits is a relevant consideration (*Goninan [1997] FCA 424*; IPR at 222).

  It is necessary for the Commissioner to form a view as to the nature of the evidence that it is sought to adduce, and the significance of that evidence for the opposition proceedings (*Goninan [1997] FCA 424*; IPR at 225-6). The significance of the evidence is assessed having regard to any relevant material available, not just the evidence itself (*National Starch [2001] FCA 33* at [33]). The public interest is not protected merely because some evidence has already been filed (*Goninan [1997] FCA 424*; IPR at 225).

- **The interests of the parties**: The interests of the party seeking the exercise of discretion are a relevant consideration (*Ferocem [1994] FCA 981* at [11]). It is also relevant to consider the disadvantage to the other party of delays in determining the opposition, and the effect of delays on the efficient and orderly administration of the Patent Office (*Ferocem [1994] FCA 981* at [11]; *Goninan [1997] FCA 424*; IPR at 222).

The criteria to be considered arise from the need to balance a serious opposition being determined on its merits and determining an opposition as expeditiously as possible.

In *Transgene SA v Virax Holdings Ltd [2002] APO 14*, the delegate considered that the relevance of evidence was a key factor that Sackville J in *Goninan* considered relevant in deciding whether evidence should be allowed:

“In order for the Commissioner or his delegate to give proper, genuine and realistic consideration to the aspect of the public interest I have identified, it is necessary to consider the nature of the evidence the opponent seeks to adduce and the significance of that evidence for the opposition proceedings."

However, as Sackville J went on to explain in *Goninan [1997] FCA 424*, this does not mean that the evidence has to be scrutinised in the same way as would occur at a hearing on the merits. Rather, it is necessary to form a *prima facie* view of whether that evidence is likely to be important in the opposition proceedings given the nature of the issues addressed by the proposed evidence. That is, based on its nature and the information supplied in the request, is the evidence sought to be filed relevant to the action - in the sense that it would contribute to a more correct, just, or expeditious result?

A number of Patent Office decisions have previously adopted certain "criteria" in determining whether the filing of further evidence is appropriate in all the circumstances, as set out for example in *Sandoz Ltd v Fujisawa Pharmaceutical Co. Ltd [1993] APO 53* and *Imperial Chemical Industries PLC v Mitsubishi Gas Chemical Co [1994] APO 26*. However, the reasoning in *Goninin* suggests that the requirements outlined in *Sandoz* and *ICI* are not prescriptive. Instead, the questions asked in those cases are only a guide to help identify the relevant aspects of a case so that “proper, genuine and realistic consideration” can be given to them as required by *Goninan*. 

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As noted above, reg 5.10, as in force immediately before 15 April 2013, confers a broad discretion which cannot be reduced to imperative compliance with particular requirements.

Relevance of the statement of grounds and particulars

The statement of grounds and particulars sets out the basis of the opposition. There is therefore no basis for allowing an opponent to file further evidence which is not relevant to particularised matter in the absence of a corresponding amendment to the statement of grounds and particulars.

Thus if an opponent discovers a new citation late in the proceedings, to have that citation considered in the inter partes opposition they will need to amend the statement of grounds and particulars and apply to file further evidence.

The statement of grounds and particulars is not per se a restriction on the applicant, as it is not a document of their creation. However, it is inappropriate for an applicant to file evidence which is not relevant to the opposition being mounted by the opponent. Thus, where an applicant seeks to file further evidence, the question to be asked is whether the further evidence is relevant to rebutting the opposition. (See Sue & Anor v Carpenter [1990] APO 29).

Reasonable terms

If the Commissioner permits a party to file further evidence, he or she may impose reasonable terms.

For reasons of natural justice the other party will usually be entitled to an opportunity to file responding evidence. Therefore, although each application will be dealt with on its merits, reasonable terms are likely to be imposed on most (if not all) requests to allow the other party to file evidence responding to the further evidence.
The time to file responding evidence, including extensions of time

A request to file further evidence is usually granted with reasonable terms allowing the other party a period of time to file evidence in response. The Commissioner would generally expect that the responding party would meet this deadline; however, the responding party can seek an extension under reg 5.10(2) as in force immediately before 15 April 2013 if this is not the case. In these circumstances, the Commissioner would expect detailed reasons explaining what progress had been made in the preparation of the further evidence and why the deadline could not be met.

Any request for an extension of time to file evidence responding to further evidence should be made under reg 5.10(2) as in force immediately before 15 April 2013. The request should be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (Schedule 7, item 218 as in force before 15 April 2013). The request will be processed in accordance with reg 5.10(5) as in force immediately before 15 April 2013.

Requests to file further evidence made at a hearing

It is the Commissioner's expectation that any request for further evidence be filed as soon as possible rather than at the hearing. However, on occasion, applications for further evidence arise at the substantive hearing. In this situation, the criteria for granting the request are the same as if the request is made outside of the hearing.

Where possible, the hearing officer will decide whether or not to grant leave at the hearing itself. Detailed reasons for the decision to allow or refuse the further evidence need not be given at the hearing, but will be provided in the written decision. If, in the course of writing the decision, the hearing officer concludes that the further evidence was not actually relevant, this does not affect their decision to allow the evidence in the first place, because allowance was based on the prima facie relevance of the evidence.

Where a request for further evidence is made at the hearing, the hearing officer may need to adjourn the hearing for a short time to consider the further evidence and decide whether it is appropriate to grant leave to file it. Alternatively, if the hearing officer cannot decide whether the further evidence is relevant until the "full picture" of the opposition is apparent, the decision on whether to grant leave for the further evidence can be reserved and made after the hearing. Note that the other party has the right to a reasonable opportunity to make representations concerning the application. In most cases it would be expected that this could be done at the main hearing. However, in some cases it may be appropriate to allow
the other party the opportunity after the hearing to make submissions on the admissibility of the material sought to be adduced as evidence, or to file responding evidence.

Regardless of the outcome of the application for further evidence, as much as possible of the main action should be heard. This is to prevent the need to reconvene the hearing at a later date. Irrespective of whether a decision to grant leave is made at the hearing or reserved, the party seeking leave to file further evidence should make submissions on the evidence at the hearing. The hearing officer can then ask the other party to provide submissions on the further evidence. This may be so even where the decision is reserved, in case leave is granted.

If possible, the other party's response should occur at the hearing. However, it may not be possible for the other party to respond to further evidence until after the hearing. In such cases the time period the hearing officer allows the other party to respond will be dependent on the circumstances. Normally one month from the date of the hearing is appropriate where the evidence is substantial.

In rare cases, the further evidence may be so crucial to the issues that leave to file it must be granted, but, because of the nature of the further evidence, the hearing has to be abandoned and reconvened at a later date when all evidence is finalised. In such an event, the hearing officer may consider whether a variation in the award of costs is appropriate so that, depending on the circumstances, one or the other of the parties pay the actual costs thrown away by the first hearing being abandoned. (See also 3.9.2 Scale of Costs, Variation of the Scale, and 3.9.5 Exemplary Situations in Awarding Costs, particularly the under the subheading Costs in Respect of Further Evidence)
3.6 Production of Documents, Summonsing Witnesses

**Relevant Legislation**

**The Act**

*Section 210* Commissioner’s powers

*Section 210A* Sanctions for non-compliance with Commissioner’s requirements

**The Regulations**

*Reg 22.14* Directions not otherwise prescribed

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**Overview**

Under *section 210(1)* of the *Patents Act* the Commissioner has the power to:

(a) summons witnesses; and

(c) require the production of documents or articles

However this power is limited by paragraph (2) which provides that a witness must not be summons unless the Commissioner is satisfied that:

(i) the witness has a substantial interest in the proceedings before the Commissioner;

(ii) the witness is likely to provide oral evidence of substantial relevance to a matter before the Commissioner;

(iii) receiving oral evidence from the witness is necessary or desirable in all the circumstances; and

the Commissioner notifies the witness of the actions the Commissioner may take under section 210A if the witness fails or refuses to comply with the summons.

Similarly the Commissioner must not require a person to produce a document or article unless satisfied that:

(i) the person has a substantial interest in the proceedings before the Commissioner;
3.6.1 Requests for the Commissioner to Exercise Powers under Section 210(a) and (c)

(ii) the document or article is likely to be of substantial relevance to a matter before the Commissioner; and

the Commissioner notifies the person of the actions the Commissioner may take under section 210A if the person fails or refuses to comply with the requirement.

It should be noted that under paragraphs 210(3) and (5) the Commissioner may summons a witness or require a person to produce a document or article whether the person is in or out of the patent area.

Furthermore under paragraph 210(6) the Commissioner’s powers to make a requirement of a person extend, if the person is a body corporate, to making that requirement of any person who is an officer, agent or employee of the body corporate.

The Act under section 210A prescribes a range of sanctions for non-compliance – See 3.6.6.

Regulation 22.14 provides the Commissioner the power to issue a notice to a person requiring that person to perform an act, file a document or produce evidence, if the Commissioner reasonably believes it is necessary for the prosecution or completion of proceedings. Unlike section 210, failure to comply with such a notice can only have such consequences that are otherwise available under the Act and Regulations including that a discretionary power may not be exercised in the favour of the person concerned. The power under regulation 22.14 is exercised only in rare circumstances and is not discussed further in this part.

Note: This information applies to powers exercised by the Commissioner under Section 210, on or after 15 April 2013.

The Commissioner may exercise the powers under section 210 on his or her own volition or on request, for example, by a party to an opposition or other proceeding.

A person seeking the exercise of the Commissioner’s powers must file all of the following:

- a request setting out the reasons for the request being made and particularly why the person to whom the summons or notice would be addressed has a substantial interest in the proceedings, why the evidence of the witness or the identified document or article is likely to be of substantial relevance to the matter before the
3.6.1 Requests for the Commissioner to Exercise Powers under Section 210(a) and (c)

Commissioner and, in the case of a summons, why the receiving of oral evidence is necessary;

- a schedule in the format specified in part 3.6.7 setting out the details of the proceeding, the name and address of the person to whom the summons or notice is directed and details of the specific matters on which the witness is being summons to give evidence or the documents or articles for which production is sought; and

- evidence that a legally enforceable offer to pay reasonable expenses has been made to the person to which the summons or notice would be directed.

**Note:** A draft summons or notice is no longer required.

Once these elements have been filed the Commissioner will consider whether a *prima facie* case exists for the issuance of a summons or notice. If not, the requestor will be informed and may have the opportunity to amend the request. Typically this would be in the case where a notice identifies a class of documents some of which are likely to be of substantial relevance and others not.

If the Commissioner considers that a *prima facie* case has been made for issuing a summons or notice he or she will invite submissions from the party or person to whom the notice or summons would be directed. The Commissioner will then decide whether or not to issue the notice or summons. An objection, for example that a document is subject to legal professional privilege, can be made at this stage or subsequently as an excuse for not complying with the notice or summons once issued.

The Commissioner is responsible for preparing and giving the summons or notice to the person concerned. The notice will include a statement of the actions under section 210A that may be taken if the person fails or refuses to comply. It will also specify a date and place for a witness to appear or a document or article to be produced. Generally production will be required within one month of the date of the notice but the Commissioner will vary this depending on the circumstances.

**Note:** After 15 April 2013, evidence required to be produced must be filed electronically with IP Australia by means approved by the Commissioner.

The Commissioner will only require production of physical articles to IP Australia in exceptional circumstances. If necessary the Commissioner may direct that an article be made available or produced for inspection *in situ* or at a suitable location.

**Note:** After 15 April 2013, under amended regulation 4.3(2)(b) a document is not open for public inspection (OPI) if the Commissioner has reasonable grounds for believing that it should not be OPI. Consequently a party no longer needs to seek a notice of production on itself to request that a filed document not be OPI in appropriate circumstances. See 3.13
3.6.2 Basis for Issuing a Summons

A summons can only be issued where:

(i) the witness has a substantial interest in the proceedings before the Commissioner;

(ii) the witness is likely to provide oral evidence of substantial relevance to a matter before the Commissioner;

(iii) receiving oral evidence from the witness is necessary or desirable in all the circumstances.

A witness having a “substantial interest” in the proceedings is one having a material stake in the outcome. This most particularly includes the parties and, in most cases an officer, agent or employee of a body corporate that is a party to proceedings. A substantial interest is not however necessarily limited to a direct commercial interest. For example, an inventor, or an expert who has already given documentary evidence in a proceeding, may be considered to have a substantial interest even if not associated with a party. On the other hand, third parties, including experts who have not previously given evidence in a matter will not be considered to have the requisite interest and are not liable to be summonsed.

“Likely to provide oral evidence of substantial relevance” means that the evidence of the witness is likely to be of substantial probative value in the determination of a matter before the Commissioner. This goes beyond evidence that may be merely relevant to the Commissioner’s determination. It requires a realistic expectation that the witness’ evidence is of such significance that it may be determinative of a matter before the Commissioner.

A witness will only be summoned where it is clear that a significant benefit will be gained such as where there is evidentiary conflict on a fact that is of substantial relevance in the matter and the Commissioner considers the conflict could be resolved by taking oral evidence. This is rare in proceedings before the Commissioner.

Unless the matter on which the person is summoned to give evidence is identified with sufficient particularity for its relevance to be determined, it cannot be the basis for a summons.

A witness may be summoned whether the person is in or out of the patent area.
3.6.3 Basis for Requiring Production

**Note:** This information applies to powers exercised by the Commissioner under [Section 210](#), on or after 15 April 2013.

The Commissioner may only require the production of documents or articles where:

(i) the person has a substantial interest in the proceedings before the Commissioner;

(ii) the document or article is likely to be of substantial relevance to a matter before the Commissioner.

A person having a “substantial interest” in the proceedings is one having a material stake in the outcome. This most particularly includes the parties and, by virtue of [section 210(6)](#), any officer, agent or employee of a body corporate that is a party to proceedings. A substantial interest is not necessarily limited to a direct commercial interest. For example, an inventor, or an expert who has already given documentary evidence in a proceeding, will be considered to have a substantial interest even if not directly associated with a party. On the other hand, third parties who have not previously given evidence in a matter will not be considered to have the requisite interest and are not subject to a requirement to produce.

“Likely to be of substantial relevance” means that the documents or articles required are likely to be of substantial probative value in the determination of a matter before the Commissioner. This goes beyond evidence that may be merely relevant to the Commissioner’s determination. It requires a realistic expectation that the documents or articles are of such significance that they may be determinative of a matter before the Commissioner.

Unless a document or article is identified with sufficient particularity for its relevance to be determined it cannot be the subject of a requirement to produce. [Section 210](#) is not an opportunity to discover what relevant documents are in possession of another party or to obtain documents of potential relevance. Requests of this nature will be refused.

A person may be required to produce a document or article whether the person (or the document or article) is in or out of the patent area.
3.6.4 Reasonable Expenses

Note: This information applies to powers exercised by the Commissioner under Section 210, on or after 15 April 2013.

It is expected that a party seeking the benefit of a summons or notice to produce will undertake to pay the reasonable expenses of the person concerned. That undertaking must be made before making the request in a manner that is legally enforceable, and in a form that can be demonstrated to the Commissioner.

Reasonable expenses would generally include:

- cost of locating the documents or articles
- copying and collating costs (if copying is appropriate)
- cost of legal advice in relation to the summons or notice
- travel costs
- compensation for loss of income (if applicable).

An offer of payment for reasonable expenses does not necessarily require an ‘up-front’ payment in cash – although payment of reasonable conduct money would generally be appropriate.

In the case of dispute over payments of reasonable expenses, the Commissioner has no power to enforce payment of moneys – enforcement of undertakings is a matter for the courts. Further, the Commissioner has no power to award cost in regard to reasonable expenses.

Where a party seeks costs associated with objecting to a notice of production those costs should be considered separately as part of a proceeding before the Commissioner and not as a reasonable expense.

3.6.5 Complying with the Notice or Summons; Reasonable Excuses

Note: This information applies to powers exercised by the Commissioner under Section 210, on or after 15 April 2013.
Once a summons or notice to produce is issued, the person concerned must comply or the sanctions under section 210A may apply. There is however a range of circumstances (reasonable excuses) where compliance will not be required and no sanction under section 210A can be applied. These include but are not limited to:

- withdrawal or failure to honour an offer to pay reasonable expenses
- insufficient time to comply
- documents or articles are not sufficiently identified or compliance is otherwise oppressive
- documents or articles (whether the original or a copy) are not in the possession or control of the person required to produce them
- documents include communications that are subject to legal professional privilege (including client/attorney privilege) and privilege has not been waived either explicitly or by implication.
- the documents are not relevant to the proceedings
- an undertaking has been given to a court preventing disclosure of the documents

Concerns about maintaining confidentiality are not a sufficient basis to avoid production. Under regulation 4.3(2)(b) the Commissioner may direct that a document is not to be open to public inspection and under section 56 may order inspection under appropriate conditions, including undertakings for non-disclosure. However a direction under regulation 4.3(2)(b) is only made where the Commissioner is satisfied that it is appropriate in the circumstances.

The person to whom the summons or notice is directed should either comply or inform the Commissioner of their objection by the due date. An objection to one document is not an excuse for not producing other documents to which the objection does not apply. If appropriate the Commissioner will hear the parties on any objection and make any necessary directions once the period for compliance has ended.

In some circumstances it may be necessary for the Commissioner to view a document in order to be satisfied that a reasonable excuse is properly made out – in which case the person will be expected to provide the Commissioner with a copy of that document for that purpose (with the document being subsequently returned if the excuse is sustained).
Note: This information applies to powers exercised by the Commissioner under Section 210, on or after 15 April 2013.

Under section 210A the Commissioner may take a number of actions where a person does not comply with a summons or notice to produce without reasonable excuse and the Commissioner is satisfied on the balance of probabilities that it is appropriate in the circumstances to take the action. These include:

(a) if the person is an applicant for a patent—a refusal to grant the patent (see subsection 61(1); and

(b) the drawing of an inference unfavourable to the person's interest in proceedings before the Commissioner; and

(c) actions of a kind that are prescribed by the regulations.

Currently no further actions are prescribed in the regulations. Normally if the Commissioner is satisfied that an action is appropriate it will be the drawing of an unfavourable inference, for example that a document not produced supports the case made against the party failing to comply. In the case of a declarant refusing to comply with a summons for cross-examination on their evidence-in-chief, the inference may amount to a finding that their evidence cannot be relied on in support of the party that adduced it.

Refusal to grant a patent is also an available sanction where an applicant fails to comply with a summons or requirement to produce. It is not intended that a patent be granted on the basis that information, which is of substantial relevance to the validity of a patent, is unreasonably withheld by the applicant.

It should be noted that the sanction provided by the Act directly affects only the parties to the proceedings and not any other person to whom the summons or notice has been directed. In these circumstances the Commissioner will be reluctant to draw an adverse inference if evidence is provided showing that, despite requests by the relevant party for the person to comply, that person was uncooperative for reasons unrelated to the veracity of their evidence.

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3.6.7 Schedule to Requests for Summons or Notice to Produce

Note: This information applies to powers exercised by the Commissioner under Section 210, on or after 15 April 2013.
A request for the Commissioner to summons a witness or require production of a document or article should be accompanied by a Schedule in the following form:

Request for [Summons][Notice to produce]

Proceeding: In the matter of Patent Application < > in the name of < > and an opposition thereto by < >

To: <Name of person to whom the summons/notice is to be directed>
    <Address of the person specified above>

Specific matter(s) to which the [Summons][Notice to produce] is addressed:

1. <List the specific matters, documents or articles for which it is intended that the person be summoned to give evidence or required to produce.

2. ....

The Commissioner will use this information to prepare a notice or summons, which the Commissioner will send to the person concerned.

Note that attention should be given to identifying the proper person to whom the summons or notice should be directed, and their correct address. In the case of a notice requiring production it is permissible for a notice to be directed to a firm or a body corporate, rather than a natural person.

Matters of 'substantial relevance' to which the summons or notice is to be directed must be identified specifically. Section 210 is not an opportunity to discover what relevant documents are in the possession of another party or to obtain documents of potential relevance. Requests of this nature will be refused.

3.7 Withdrawal and Dismissal of an Opposition

3.7.1 Withdrawal of an Opposition
3.7.1 Withdrawal of an Opposition

Note: This information applies to oppositions commenced before, on or after 15 April 2013, as specified.

In this topic:

Relevant Legislation

The Act

Section 18  Patentable inventions
Section 40  Specifications
Section 59  Opposition to grant of standard patent
Section 97  Re-examination of complete specifications
Section 98  Report on re-examination
Section 101G  Re-examination of complete specification of innovation patents
Section 141  Withdrawal of applications

The Regulations

Chapter 5  Opposition

Overview
3.7.1.1 Withdrawal of Section 59 and 101M Oppositions

While sections 137 and 141 provide for an opposed patent or application to be surrendered or withdrawn, respectively, an opponent may withdraw an opposition at any time, by filing a notice of withdrawal in the approved form (available on the IP Australia website). For notices of withdrawal filed before 25 August 2018 there is a requirement that the notice be signed.

The provisions for withdrawal of an opposition are:

- For oppositions commenced on or after 15 April 2013, reg 5.26;
- For oppositions commenced before 15 April 2013, reg 5.15, as in force immediately before 15 April 2013.

Withdrawal will only be effective on the basis of written advice in the approved form.

Failure to take action in an opposition does not constitute withdrawal

Where an opponent fails to take action in an opposition, even if this is done deliberately, it does not constitute withdrawal of the opposition. Similarly, if an opponent fails to appear at a hearing, either in person or by written submissions, the opposition is not deemed to be withdrawn.

Irrespective of which party fails to appear at a hearing, the Commissioner is required to consider the evidence filed and determine the opposition. (See Dart Industries v. Crest International (1979) 49 AOJP 2020)

Costs when an opposition is withdrawn

It is common practice for a withdrawing party to negotiate with the other party prior to the withdrawal, in order that each party bears its own costs.

If an opposition or an opposed application is withdrawn before a hearing, the Commissioner will not automatically make an award of costs but may do so on the application of a party. For information on costs see 3.9 Costs.
3.7.1.1 Withdrawal of Section 59 and 101M Oppositions

Note: This information applies to oppositions commenced before, on or after 15 April 2013.

In this topic:

The request for withdrawal

An opponent may withdraw an opposition at any time, by filing a signed notice of withdrawal in the approved form (available on the IP Australia website).

Processing the request

Where an opponent files a notice of withdrawal of the opposition in the approved form (available on the IP Australia website), the opposition officer will acknowledge the request and give the applicant a copy of the notice as soon as practicable.

Re-examination consideration after withdrawal

Note: A bar-to-grant will be placed on a patent application to prevent the patent being granted pending possible re-examination.

Where an opposition under section 59 or 101M is withdrawn, the Commissioner will consider any evidence filed during the proceedings to determine whether it provides grounds for re-examining the complete specification under section 97(1) or 101G(1), respectively.

Where the opposition is withdrawn after the hearing

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Effective Date: 25 September 2019
If the opposition is withdrawn after the hearing but before a decision is issued, no decision will issue in the opposition. The hearing officer will consider whether re-examination is appropriate, having due regard to the matters both on file, and argued at the hearing.

**Where the opposition is withdrawn before the hearing**

The opposition officer will check the status of the continuation/renewal fees on the application. Providing the fees are paid, a re-examination file will be created and sent to the Supervising Examiner of the relevant examination section, together with the statement of grounds and particulars and the evidence in the opposition.

If a continuation or renewal fee is outstanding, the opposition officer should advise the applicant or patentee accordingly. The file should not be sent to the Supervising Examiner until the fee is paid.

On receipt of the file, the Supervising Examiner in the exam section arranges for the material identified in the statement of grounds and particulars and the evidence to be considered for possible re-examination. In doing so, no more effort should be expended in obtaining copies of documents identified in the statement of grounds and particulars, but not provided in the evidence or attached to the statement of grounds and particulars, than would be given to obtaining non-patent literature in national searching. Likewise, where a large number of documents are given in the statement but not provided in evidence, discretion should be exercised as to which documents should be viewed.

Where an opposition under section 59 is withdrawn before a hearing, if the opposition material provides no grounds for re-examination, the Supervising Examiner will recommend that the application be granted. If the delegate in Patent Oppositions agrees, he or she will direct the application to grant, typically providing 1 month for grant to occur.

Where a section 101M opposition is withdrawn prior to hearing, if the opposition material provides no grounds for re-examination, the Supervising Examiner advises Patent Oppositions accordingly. If the delegate in Patent Oppositions agrees, no further action will be taken in this respect.

If an adverse report is to issue, the re-examination procedures in the examiners manual should be followed (see 2.22 Re-examination (Chapter 9 and Section 101G)).
Other than oppositions under sections 59 or 101M, the other major areas of opposition are concerned with:

- section 223 (extensions of time);
- section 104 (amendments); and
- section 75 (extensions of term).

At the stage of advertising the extensions or amendments for opposition purposes, the delegate will usually be satisfied that the applicant seeking the extension or amendment has prima facie satisfied all the conditions specified in the Act.

Should relevant evidence come to light during the opposition proceedings, the Commissioner will consider this evidence, before granting the extension or allowing the amendment, regardless of whether the opposition was withdrawn or whether the opponent attended the hearing.

If no evidence was filed before withdrawal of the opposition, the Commissioner would be bound to grant the extension or allow the amendment.
3.7.2 Dismissal of an Opposition

The Regulations

Section 97 Re-examination of complete specifications

The Regulations

Chapter 5 Opposition
Reg 9.5 Completion of re-examination
Reg 22.22 Exercise of discretionary powers by the Commissioner
Reg 22.26 Review of Decisions
Schedule 7 Fees

Introduction

The *Patents Act 1990* includes provisions to deal with unsubstantiated oppositions. The Commissioner may dismiss an opposition on the request of the applicant or on the Commissioner’s own initiative.

The relevant provisions for dismissal of an opposition are:

- for oppositions commenced on or after 15 April 2013, *regs 5.17* and *5.18*;
- for oppositions commenced before 15 April 2013, *reg 5.5* as in force immediately before 15 April 2013.

The principles of law developed for dismissal of an opposition under *reg 5.5* prior to 15 April 2013, continue to apply for *regs 5.17* and *5.18* as in force after this date.

Argument may be required to establish a case for dismissal

An opposition may be unsubstantiated even if it requires argument to establish that the opposition should be dismissed. The onus will initially be on the applicant to show that the
opposition has no reasonable prospects of success, but the onus may shift to the opponent to explain its case if a real issue is not self-evident.

See Les Laboratoires Servier v Apotex Pty Ltd [2008] APO 11 at [18] (although this decision was made prior to 15 April 2013, its reasoning is applicable to the equivalent regs after 15 April 2013). See also 3.7.2.3 Reasons for Dismissal.

The assessment of whether a reasonable prospect of success exists will not involve an in-depth consideration of the substantive opposition, but may involve sufficient analysis to determine if the opposition has reasonable prospects of success.

An opposition may be dismissed wholly or in part

An application for dismissal of an opposition should normally be in respect of the whole opposition.

The Commissioner may dismiss a particular ground of opposition (see for example L’Air Liquide, SA pour L’Etude et L’Exploitation des Procede Georges Claude v The Commonwealth Industrial Gases Ltd [1992] APO 1; 24 IPR 27). However, the Commissioner should not dismiss a ground of opposition merely because it is not supported by some of the particulars (Norwood Industries Pty Ltd v Macbird Floraprint Pty Ltd [1992] APO 39; 24 IPR 368).

Where a ground of opposition has been dismissed, the opposition will proceed as if that ground of opposition is not included in the statement of the grounds of the opposition.

The statement of grounds and particulars cannot be amended pending a decision on a request for dismissal

The statement of grounds and particulars cannot be amended while an application for dismissal of the opposition is being considered. If the Commissioner decides to dismiss the whole opposition, the opposition is concluded and the opponent cannot subsequently amend the statement of grounds and particulars.
3.7.2.1 Requests for Dismissal

The relevant provisions are: for oppositions commenced on or after 15 April 2013, reg 5.16(3)(a); for oppositions commenced before this date reg 5.9(2)(a) as in force immediately before 15 April 2013.

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Review of a decision on dismissal

A hearing officer’s decision with respect to dismissal of an opposition is subject to review by the Administrative Appeals Tribunal under reg 22.26(2)(iii).

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3.7.2.1 Requests for Dismissal

Note: This information applies to oppositions commenced before, on or after 15 April 2013, as specified.

In this topic:

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Time for requesting dismissal

The relevant provisions are: for oppositions commenced on or after 15 April 2013, reg 5.17(1); for oppositions commenced before this date, reg 5.5(1), as in force immediately before 15 April 2013.

After re-examination

If the patent request and complete specification has been accepted but not granted and is being re-examined under section 97(1), the applicant may request dismissal of the opposition within 1 month from the day that re-examination is completed within the meaning of reg 9.5.
3.7.2.1 Requests for Dismissal

In other circumstances

In all other circumstances, an applicant or patentee may request dismissal of an opposition within 1 month from the day they are given (or before 15 April 2013, served with) a copy of the statement of grounds and particulars in an opposition.

The request

The request for dismissal of the opposition must be in the approved form (available on the IP Australia website) and be accompanied by the appropriate fee (see Schedule 7, item 217).

A request for dismissal of an opposition should normally be in respect of the whole opposition, but the applicant may request dismissal of some grounds of opposition.

Processing the request

On receipt of a request for dismissal, the opposition officer will determine whether the request was filed in the time allowed, and if correctly filed, will give the opponent a copy as soon as practicable.

The Commissioner may clarify the issues in the dismissal before setting the matter for hearing. (For information on the hearing process, see 3.8 Hearings and Decisions).

If the Commissioner decides to dismiss the opposition, the parties will be notified as soon as practicable.

Withdrawal of a request for dismissal
Although there is no explicit provision in the legislation, a request for dismissal of an opposition can be withdrawn.

3.7.2.2 Dismissal on the Initiative of the Commissioner

Note: This information applies to oppositions commenced before, on or after 15 April 2013, as specified.

The Commissioner can dismiss an opposition at any time during the opposition on his or her own initiative, where it is appropriate to do so.

The relevant provisions are:

- for oppositions commenced on or after 15 April 2013, reg 5.18;
- for oppositions commenced before 15 April 2013, reg 5.5(3), as in force immediately before 15 April 2013.

The Commissioner has always had the power to dismiss an opposition where the opponent fails to file a statement of grounds and particulars.

For oppositions commenced on or after 15 April 2013, the Commissioner may dismiss an opposition where the opponent fails to file a document mentioned in the statement of grounds and particulars, in accordance with regs 5.5, 5.6 or 5.11.

In other circumstances, the Commissioner is likely to dismiss an opposition only where the basis for dismissal is readily apparent, and then only if the dismissal process would expedite determination of the opposition as a whole.

In accordance with reg 22.22, before exercising the discretionary power to dismiss an opposition, the Commissioner will give the opponent the opportunity to be heard in relation to the intended dismissal (See 3.8 Hearings and Decisions).

If the Commissioner decides to dismiss the opposition, the parties will be notified as soon as practicable.
3.7.2.3 Reasons for Dismissal

**Note:** This information applies to oppositions commenced **before, on or after** 15 April 2013.

In determining whether an opposition should be dismissed, the Commissioner will assess whether there exists a “reasonable prospect of success”. This test is set out in *Les Laboratoires Servier v Apotex Pty Ltd* [2008] APO 11 at [18]:

- An opposition need not be “clearly untenable” or “manifestly groundless” in order for it to be dismissed. An opposition may be dismissed if it is considered to have no reasonable prospects of success.

- In determining whether or not there is a real prospect of success, consideration is given as to whether there is a real rather than a fanciful issue to be decided. The onus will initially be on the applicant to show that the opposition has no reasonable prospects of success, but the onus may shift to the opponent to explain its case if a real issue is not self-evident. This will not involve an in-depth consideration of the substantive opposition, but may involve sufficient analysis to determine if a *prima facie* case has been established.

- A dismissal will generally be inappropriate where expert evidence is required to determine an issue. However, this does not preclude dismissal of an opposition where there is a clear deficiency in the case to be argued, such as a technical divergence of a citation and the application or where an opposition involves issues of construction and expert evidence is not necessary to clarify technical terms or other matters that are in doubt.

- Evidence of an “ambivalent character” will generally be sufficient to establish a reasonable prospect of success. However, if the evidence is only one-way, or can clearly lead only to a single conclusion, then a proceeding may be dismissed. If no particulars have been provided in relation to a ground of opposition then it may be considered to have no reasonable prospects of success.

- Care must be taken not to cause an injustice to a party by dismissing an opposition.

The assessment is to be made after consideration of the statement of grounds and particulars which will identify the material facts necessary for the particular grounds of opposition (*Mobay Corporation v The Dow Chemical Company* [1992] APO 25). This approach was accepted by the Administrative Appeals Tribunal in *Preference Manufacturing (Aust) Pty Ltd and Commissioner of Taxation and Breezway Australia (Holdings) Pty Ltd* (Joined Party) [2012] AATA 393.
3.7.3 Withdrawal of an Opposed Application

Note: This information applies to oppositions commenced before on or after 15 April 2013.

Under Section 141 an opposed application can only be withdrawn if the Commissioner has consented to the withdrawal.

This restriction is intended to limit the ability of an applicant to ‘side-step’ opposition proceedings while pursuing the grant of a patent in a related application eg a divisional application.

The Commissioner may not consent to the withdrawal of an opposed application in other circumstances, including where the opponent claims entitlement to the invention and withdrawal would avoid a decision under Section 60 that would allow an application to be made under Section 33.

An opponent is not precluded from seeking an award of costs merely because the application has been withdrawn.

3.8 Hearings and Decisions

In this topic:

Relevant Legislation

The Act

- Section 60 Hearing and decision by Commissioner
- Section 101N Hearing and decision by Commissioner
3.8 Hearings and Decisions

Section 216  
Exercise of discretionary power by the Commissioner

The Regulations

Regulation 5.19  
Hearing and decision – re-examination

Regulation 5.20  
Hearing and decision – other circumstances

Regulation 22.22  
Exercise of discretionary powers by the Commissioner

Overview

The Act requires the Commissioner to afford all parties to an action the opportunity to be heard. General provisions for hearings are set out in sec 216(1) and reg 22.22(1):

sec 216(1):  
The Commissioner must not exercise a discretionary power under this Act adversely to any person applying for the exercise of that power without first giving that person a reasonable opportunity to be heard.

reg 22.22(1):  
The Commissioner must give a person an opportunity to be heard before exercising a discretionary power under the Act or these Regulations adversely to the person.

Note: Section 216 only requires the Commissioner to hear the person requesting the exercise of the discretion, whereas reg 22.22 also requires the Commissioner to hear a person who is adversely affected by the decision.

Specific provisions for the Commissioner to hear the parties involved in standard opposition procedures are listed in Chapter 5 of the Regulations. Similarly, specific provisions for the Commissioner to hear certain persons are given in sec 17, sec 32, sec 35, sec 36, sec 42, sec 100A, sec 101, sec 106, sec 107, sec 137, reg 3.24, reg 3.25 and reg 10.2C.

Office Practice

Whenever a person would have rights to seek a remedy by appeal, prerogative writ or review, e.g. under the Administrative Decisions (Judicial Review) Act, that person is normally
offered the opportunity to be heard. This situation may result in an *inter partes* hearing, but not to an opposition in terms of the Patents Act.

### 3.8.1 Setting Down Hearings

**Note:**

In this topic:

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### Relevant Legislation

#### The Act

- **Section 60**: Hearing and decision by Commissioner
- **Section 101N**: Hearing and decision by Commissioner

#### The Regulations

- **Regulation 5.20**: Hearing and decision – other circumstances
- **Regulation 22.22**: Exercise of discretionary powers by the Commissioner
- **Regulation 22.23**: Written submissions and oral hearings

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### Overview

A hearing will be set down when:
3.8.1.1 Setting of Hearing

- a person makes a justifiable request to be heard;
- a party to a matter 'objects' to a request by another party for the exercise of a discretionary power of the Commissioner; or
- the evidentiary stages of an opposition have been completed.

Where there is more than one opponent, the practice of the Commissioner is to hear all the oppositions at the one hearing and issue one decision. In general, the Commissioner will proceed to set matters for hearing at the earliest reasonable date.

The Commissioner will decide whether a matter will be heard by way of written submissions or an oral hearing (reg 22.22(2)), taking into consideration the issues to be determined and any requests made by the relevant parties. In general, substantive oppositions will be heard by means of an oral hearing and procedural oppositions by way of written submissions.

Written Submissions

Where a matter is to be heard by way of written submissions, the Commissioner will notify the person of the period in which the submissions must be filed, being at least 10 business days (reg 22.23(1)).

Oral Hearings

Where a matter is to be heard by way of an oral hearing, the Commissioner will ask the parties to indicate dates when they will be available. Once a suitable date has been
3.8.1.2 Location and Options for Appearing

Under reg 22.23(4), the Commissioner may hold an oral hearing in which:

- a party appears in person; or
- a party appears by telephone or other means of telecommunication that the Commissioner reasonably allows.

In general, hearings will be held in Canberra. In this situation, a party may elect to:

- appear in person, by telephone or via video conference;
- not appear, but rely upon written submissions; or
- not appear, and make no written submissions.

Interstate Hearings

If the parties agree, a hearing may be held in Melbourne at the Melbourne Patent Examination Centre (MPEC), or in another capital city at an agreed location. In this situation, the parties must agree to share the travel expenses of the hearing officer and agree that those expenses will not be claimable under an award of costs.
Time Limits for Filing Summary of Submissions

When appearing in person, by phone or via video conference;

- the opponent must file a summary of submissions at least 10 business days before the hearing.
- the applicant must file a summary of submissions at least 5 business days before the hearing.

Where a party elects not to appear and rely upon written submissions only, a summary of submissions must be filed as indicated above and any further submissions must be filed by close of business the day before the hearing.

3.8.1.3 Hours of a Hearing

The nominal hours for conducting a hearing are 9.00am to 12.30pm and 1.30pm to 4.00pm. Thus, a hearing will normally be set to commence at 9.00am or, for a matter set to be heard in the afternoon, 1.30pm. The commencement time will be varied upon request where there is justification and agreement by the parties.

However, the actual times of the hearing are subject to discretion by the hearing officer. Thus, any adjournment for lunch etc should occur at a convenient time in the proceedings, rather than at any predetermined time. Where a hearing can be reasonably concluded without adjournment, it should be so conducted. In particular, all reasonable effort should be made to ensure that it is not necessary to adjourn the hearing to the following day, if the matter can be reasonably concluded by extending the hearing past 4.00pm.

3.8.1.4 Hearing Fee
3.8.1.5 Who May Appear at a Hearing?

The fees payable for a hearing are specified in schedule 7 of the Regulations (see in particular items 230, 231 and 231A). Any hearing fee must be paid prior to the commencement of the hearing and preferably at least 7 days beforehand.

Each party appearing at an oral hearing (whether in person, by telephone or by video conference), or being heard on the basis of written submissions, is required to pay the relevant hearing fee. Where a party does not appear in person, by telephone or by video conference, and does not make written submissions, no fee is payable for attending the hearing (unless the party requested the hearing).

Where several parties are represented by a common representative, each party is nevertheless required to pay the hearing fee.

Where the hearing is in respect of more than one action (e.g. an opposition by A against B and an opposition by B against A) heard concurrently, a hearing fee is required by each party in respect of each action.

If an oral hearing does not proceed, the hearing fee is refundable.

3.8.1.6 Relevant Court Actions Pending

Situations may arise where a matter before the Commissioner is simultaneously before the courts. This can arise, for example, where a standard patent application is concurrently before the court for an appeal from a decision in a procedural opposition to the allowability of an amendment and the Commissioner for an opposition.

For administrative convenience, the Commissioner may decide to defer the hearing, pending the outcome of the court action if both parties agree to the deferral.

However, before deciding to defer, the Commissioner should be satisfied that:
the matters in dispute are simply between the parties and have no significant consequential effects on third parties; and

neither party would be significantly disadvantaged by deferring the hearing.

In some circumstances, to protect the public interest where a deferral is requested, the Commissioner may ask for an undertaking from the applicant or patentee not to sue for infringement. The terms of the undertaking will be published in the Official Journal.

Where one party objects to the matter being deferred, the Commissioner will consider a range of factors before deciding whether or not to defer including:

- whether the court action will likely be resolved in the time frame envisaged by the Commissioner;
- whether all the issues before the Commissioner will be resolved by the court action;
- whether the evidence before the Commissioner is similar to that before the court; or
- whether, given the nature of the case, there is a clear public disadvantage to one of the parties or the public interest; the Commissioner has a duty to act in a way that leads to minimal prejudice to the respective parties (see Yamazaki Mazak Corporation v Ors 24 IPR 321, (1992) AIPC 90-879 which discusses prejudice to the applicant and Ferocem v Hightech Auto Tools (1994) 29 IPR 144 which discusses prejudice to the opponent).

Note: If the Commissioner issues a direction in the belief that a court action will be resolved in a particular time frame and this court action is subsequently delayed, the Commissioner will reconsider whether the direction is appropriate.

If the Commissioner considers that deferral is inappropriate and proceeds with hearing the matter, then the Commissioner must:

- not purport to be ‘reviewing’ a decision of a court; and
- recognise that the case being heard may be different to that argued before the court.

Even if the evidence before the Commissioner is the same as the evidence filed in the court action, the court proceedings may have been argued on only some of that evidence. Furthermore, the material before the Commissioner may include material not before the court.

The question of whether it is lawful to suspend opposition proceedings until a court hands down its judgement was considered in Cadbury UK Ltd v Registrar of Trade Marks [2008] FCA 1126. In this case the judge held that a decision by the Registrar to suspend proceedings could not stand, as to delay opposition proceedings for an indeterminate period amounted to a refusal by the delegate to hear those proceedings, and the delegate was intending to give too much significance to findings of fact made by the Federal Court.
3.8.2 Hearings Procedure

3.8.2.1 Overview of Proceedings

In this topic:

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Initial Procedure

It is general practice to record oral hearings, including where a party appears by telephone or video conference. The hearing officer should remind the parties of this at the commencement of the hearing and indicate when recording starts and finishes. Copies of the recording can subsequently be requested from Oppositions & Hearings in COG.

The hearing officer will also:

- clearly identify what the hearing is in respect of;
- obtain, for the record, the representations of the parties;
- raise any matters that need clarification before the hearing commences; and
- in substantive oppositions, clearly identify what the parties consider to be the specification being considered, and in particular the claims of the specification (there have been occasions where a party has prepared for the hearing on the basis of the wrong set of claims).

The substantive hearing follows thereafter.

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Presentation by Parties

The order of presentation is a matter within the discretion of the hearing officer. As it is incumbent on a party initiating an action to prove their case, that party will usually have the
right (or obligation) of first address. In general, where the Commissioner has considered the matter and would have proceeded to act on it but for the action, the party initiating that action is the opponent, informant or objector, otherwise the person initiating the action is the person who made the relevant request leading to the action.

If the parties are in agreement that a person other than as identified above should have first address, the hearing officer can consider whether the normal order should be reversed.

In presenting a case, a party may read the evidence, summarise or highlight particular points of interest or refer to case law. It is not necessary for a party to “read in” evidence and the practice is discouraged. If a party is reading the evidence in, hearing officers are at liberty to read ahead and indicate when appropriate that they have read that paragraph in order to expedite the process.

All parties have the right to speak without interruption, and the right of reply and response until they are satisfied their case has been fully presented. An exception to this may occur during reading or presentation of the main evidence for one party, where counsel or the attorney for the other party wishes to object to portions of that evidence, e.g. on the basis that those portions are so vague as to fail to establish any facts, or they are asserting conclusions of law. The hearing officer may rule on the point at once, or defer such ruling to be included in a written decision.

During the presentation the hearing officer may ask questions to clarify the submissions.

**Note:** There is no requirement that a hearing officer rule immediately on **any** point, unless the ruling is essential to the continuance of the proceedings. In general, hearing officers should reserve their decision on all substantive matters.

See also:

- *Dart Industries v Crest International* (1979) 49 AOJP 2020 at columns 1 and 2
- *The King v Commissioner of Patents; Ex Parte Weiss* 61 CLR 240.

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**Opponent’s Submissions, Matters Outside Statement of Grounds and Particulars**

The opponent's submissions should be confined to matters within the scope of the statement of grounds and particulars. As indicated in 3.4.2 The Statement of Grounds and Particulars, the opponent is bound by that statement, and confined to the issues raised therein. At the
hearing, the hearing officer will not monitor compliance, but will rule on the matter when and if the applicant objects.

Note that the Commissioner as a tribunal is not bound by the court rules of evidence. In addition, the primary role of the opposition is to determine the validity of patent. Given this, the Commissioner has broad powers under sec 60(3) and sec 101N(3) to decide an opposition on grounds whether they were raised by an opponent or not and, under reg 5.23, to consult a document which had not been raised by the opponent. In this context, technical issues such as whether the statement does (or does not) contain a particular argument, or whether the evidence in reply is (or is not) strictly in reply, are not helpful. As noted in the office decision of RGC Mineral Sands Ltd v Wimmera Industrial Minerals [1999] APO 79, it is not appropriate to shut out critical material which is determinative of the opposition on a technical point of evidence (see also Sonus Pharmaceuticals, Inc v Alliance Pharmaceutical Corp and Schering AG [2001] APO 13 and EWT Trade and Business Consultants NZ Ltd v Quickcut Pre Press Network Pty Ltd [2006] APO 11).

Instead, the hearing officer must consider whether the argument raised outside the statement of grounds and particulars is a significant issue of validity and/or whether evidence in reply is significant as a matter of fact. If the material is significant, the hearing officer should consider it in determining the matter, but ensure that the other party has had a reasonable opportunity to respond to the material in accordance with the principles of natural justice. This may mean that a party will have the opportunity to file evidence or submissions after the hearing. Such material must be provided to the party with the option to respond if necessary.

Often the true significance of the extra material will not be apparent until after the hearing officer starts to write the decision. In this case, the hearing officer will advise the parties that the material will be reviewed after the hearing and if it is relevant to the determination, will provide the parties with an opportunity after the hearing to address the material. This will usually be by submissions or evidence, however the hearing can be reconvened if the parties or the Commissioner consider it necessary.

**Views of Hearing Officer**

During the hearing, the hearing officer should make known to the parties their views on the issues, problems and technical difficulties with the case (see Vakauta v Kelly (1989) 87 ALR 633 at 635). This will ensure that the parties are fully aware of the case that they have to answer, and that the hearing officer fully understands the case being put by the parties. It is not necessary to obtain agreement with the hearing officer's point of view.
3.8.2.2 Adjournment of Hearings

Costs

At the end of the hearing, if the parties have not raised the matter of costs, the hearing officer will seek submissions on costs.

Adjournment of a hearing is governed by reg 22.23(3), which states:

"The Commissioner may adjourn an oral hearing from time to time or from place to place by notifying the person."

However, it is the practice of the Commissioner to hear as much as possible of a case at the appointed time. Thus, if an application for filing further evidence under reg 5.9 is lodged at a hearing, the hearing should proceed in relation to the other evidence on file, regardless of whether that application is heard at the time.

Circumstances where an adjournment (other than adjournments for lunch etc) may be appropriate are:

- illness or another situation preventing a party or the hearing officer from continuing with the hearing.
- a party having had insufficient time to reasonably prepare their case (or has prepared their case on the basis of the wrong specification), and to start or continue with the hearing would be a denial of natural justice.
- material being adduced at the hearing; if that material is properly adduced (either by agreement at the hearing, or by subsequent decision), the other party is entitled to have time to consider and rebut that material, which is properly done at an adjourned hearing (or by written submissions). Nevertheless, the hearing should proceed in respect of the evidence on file.
- inability of a party to attend a hearing for reasons beyond their control, e.g. public transport strike.
3.8.2.3 Contact with Parties Outside of Hearing

Consideration should be given to conducting any further hearing by means of written submissions.

Note: A hearing may be adjourned even if it has not commenced.

3.8.2.3 Contact with Parties Outside of Hearing

Hearing officers should not privately communicate with the parties on matters relating to the hearing outside the forum of the hearing. See Re J.R.L.; Ex Parte C.J.L.; 161 CLR 342, in which Mason J cited with approval the following statement by McInerney J in R v Magistrates’ Court at Lilydale; Ex parte Ciccone [1973] VR 122:

“The sound instinct of the legal profession - judges and practitioners alike - has always been that, save in the most exceptional cases, there should be no communication or association between the judge and one of the parties (or the legal advisers or witnesses of such a party), otherwise than in the presence of or with the previous knowledge and consent of the other party. Once the case is under way, or about to get under way, the judicial officer keeps aloof from the parties (and from their legal advisers and witnesses) and neither he nor they should so act as to expose the judicial officer to a suspicion of having had communications with one party behind the back of or without the previous knowledge and consent of the other party. For if something is done which affords a reasonable basis for such suspicion, confidence in the impartiality of the judicial officer is undermined.”

If either one of the parties attempts to initiate a private communication with the hearing officer, they should be referred to the Deputy Commissioner OEP. Where the Deputy Commissioner OEP is involved in the matter in question, a suitable alternative contact will be arranged.

3.8.2.4 Hearings Involving Confidential Material

On rare occasions, a hearing can involve consideration of confidential material. This may arise when the hearing involves an application that is not OPI, where reg 4.3(2)(b) has been invoked in respect of certain documents, or where reg 4.3(2)(a) applies, there being a
relevant court or tribunal order in respect of certain material. Where consideration of confidential material is required, special requirements apply:

- usually hearings before the Commissioner are open to the public. Where confidential material is being discussed, the hearing should be closed to the public. For an example of a hearing closed to the public, see *Iluka Midwest Limited v Industrial Minerals Pty Ltd* [2001] APO 58.

- in the overall decision-making process, hearing officers should ensure that there is an appropriate degree of security with any confidential material in their possession (including the recordings of the hearing).

- if the reasons for a decision need to discuss the confidential material (such that the reasons will result in disclosure of the confidential material), the hearing officer will need to write two versions of the decision; a “full” decision for the parties, which can specifically refer to confidential information, and an “edited” version for publication, which omits this material (*Hassle v Commissioner* 14 IPR 578). For examples, see *Secton v Delawood* 21 IPR 136 at 197, where entire paragraphs which referred to confidential material were omitted, *Hassle v Commissioner of Patents* 14 IPR 585, where confidential figures were replaced by “x” and *Iluka Midwest Limited v Industrial Minerals Pty Ltd (supra)*.

- there will need to be an appropriate degree of security when forwarding the full reasons for the decision to the parties and storing the recordings of the hearing.

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3.8.2.5 Consultation with Other Hearing Officers

Hearing officers may consult with other hearings officers (or other staff members) in formulating their decisions; see, for example, *Re J.R.L.; Ex Parte C.J.L.*, 161 CLR 342 at 351:

“This proscription does not, of course, debar a judge hearing a case from consulting with other judges of his court who have no interest in the matter or with court personnel whose function is to aid him in carrying out his judicial responsibilities. The same standard is applied in the Code of Judicial Conduct for United States Judges, approved by the Judicial Conference of the United States: see Canon 3 and commentary.”

Ultimately, however, the decision remains the full responsibility of the delegated hearing officer.

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Effective Date: 25 September 2019
3.8.2.6 Hearings and the Police

The attendance of a party at a hearing may be of interest to other authorities, including the police. For example, in a hearing on application 59510/90, the police apparently relied upon the attendance at the hearing of a party to effect an arrest.

A hearing by the Commissioner is not like a court hearing. If police entered a court to serve a document or arrest a person, they would be held in contempt of court. However, there is no equivalent restraint on hearings before the Commissioner.

Consequently, when police wish to serve a document or arrest a person during a hearing, the hearing officer should not obstruct them in their duty. However, where circumstances permit, the police should be requested to respect the proceedings before the Commissioner and wait for an appropriate break before carrying out their duty.

3.8.3 Ex Parte Hearings

3.8.3.1 Overview of Proceedings

In this topic:

In general, ex parte hearings arise from a dispute between the person concerned and the Commissioner. In this situation, the person may request a hearing at any time. If the Commissioner perceives that a stalemate has been reached, it may be suggested that the person request a hearing.
3.8.3.1 Overview of Proceedings

*Ex parte* hearings are usually a dispute with the Commissioner during the examination process. The following information relates to hearings in this context, however also applies as appropriate to other situations.

A request for a hearing may be received in response to an "invitation" issued in an examination report (see PERP codes [P6] and [H41]). Examiners should note that a report containing these PERP codes are not to issue without the agreement of the supervising examiner in consultation with another the Supervising Examiner (OEP).

Where a request for a hearing (or written decision) is received, the application will be referred to OEP for review prior to setting the matter for hearing.

Where the hearing request has not been received in response to a [P6] "invitation", OEP may refer the case to an independent supervising examiner for advice. If the supervising examiner indicates that the case has been inadequately handled (e.g. if the search is incomplete or otherwise incorrectly done), the file will be returned to the examination section for rectification. If, as a result, new objections arise, a further adverse report is to issue, explaining the situation and giving the applicant an opportunity to respond to the new objections before the matter is set for a hearing.

The Commissioner can set a hearing to resolve matters even if the applicant has not requested to be heard (*Miles v Commissioner of Patents* [2014] FCAFC 109).

**Note:** In these circumstances, an extension of time under [223](#) may be justified in respect of the time for acceptance.

### Hearing Procedure

If the hearing is held in Canberra, the hearing officer should invite the examiner of the case concerned and, where appropriate, the relevant supervising examiner, to attend. As the hearing is an independent assessment of outstanding objections, the examiner is only at the hearing as an observer and does not take part.

If the hearing is requested in relation to matter constituting only part of an examiner's report, this matter can be dealt with (presuming it is independent of the remainder of the report with respect to the issues involved) and appropriate action taken. Thereafter, the case is to be referred back to the examiner for action pursuant to the remaining objections.

If the hearing officer concludes that the hearing resulted from a less than ideal handling of the application during examination, a refund of some, or all, of the hearing fee may be due. This will likely occur only when the application is accepted without a written decision being issued. However, acceptance without a written decision does not mandate a refund of the
3.8.3.2 Hearings Near the Final Date for Acceptance

Applications where request for examination was filed on or after 15 April 2013

For standard patent applications where the request for examination was filed on or after 15 April 2013 and a hearing is requested within the period for gaining acceptance, the time for acceptance may be extended until 3 months from the date the decision is made (reg 13.4(1)(g)).

This provision only applies if a decision issues (and the application is not refused in the decision).

Note that similar provisions apply to innovation patents – where the request for examination was filed on or after 15 April 2013 and a hearing is requested within the period for gaining certification, the time for certification may be extended until 3 months from the date the decision is made (reg 9A.4(f)).

Applications where request for examination was filed before 15 April 2013

For standard patent applications where the request for examination was filed before 15 April 2013, the fact that a hearing has been requested does not change the final date for acceptance (FDA). In this situation, the Commissioner is not favourably disposed to requests for a hearing received less than several months before the FDA.

Any request must allow sufficient time before the FDA for the hearing to take place and a decision to issue.

Note that the applicant's rights in the application, and options to amend, are only preserved if a decision is issued before the application lapses. The closer the FDA, the less likely it is that a hearing officer can properly consider the matter.

Where a hearing is conducted or requested close to the FDA, there are a number of options available including:

- if the application is to be refused in toto, this decision could be given verbally or in the form of a letter to the applicant or attorney, with the explanation that written reasons will follow later.
- if there is patentable subject matter, but amendments are required, a verbal or written direction could be given, again with the explanation that written reasons will follow...
later. In this situation, if the applicant or attorney is satisfied with the outcome, it may not be necessary to issue a decision.

- the applicant could be entitled to an extension of time for acceptance, under sec 223(2).
- it may be clear from the file history that during the prosecution of the application there has been unwarranted delay in the Office. (The application of reg 22.6(2) is clear evidence of such delay, but is not a prerequisite for the finding that delay has occurred in the Office). If such a delay has occurred, sec 223(1) should be invoked.
- the applicant could file a divisional application.

Where a hearing is requested and, despite the above options, there is insufficient time for a hearing officer to properly consider the matter before the FDA, Patent Oppositions will contact the applicant, explain the situation and draw attention to the possibility of filing a divisional application.

### 3.8.4 Natural Justice and Bias

In this topic:

In all matters before the Commissioner, the hearing officer must ensure that no party is denied natural justice.

The chief rules of natural justice are:

- a party must have notice of the case they have to answer.
- each party must have the opportunity of adequately stating their case, including sufficient time to prepare their case, and correcting or contradicting any relevant statement prejudicial to their case. Note that there is no requirement for the Commissioner to ensure a party takes advantage of that opportunity.
- a party must not be heard behind the back of the other party.
- relevant documents which are considered by the hearing officer should be disclosed to the parties.
3.8.4.1 Rules

- hearing officers must not be a judge in their own cause. Thus, a hearing officer must declare any interest they have in the subject matter of the dispute. This may (*inter alia*) disqualify a hearing officer from hearing a substantive sec 59 opposition where that officer was directly involved in the examination of the application.

- the hearing officer must act fairly, in good faith and in a judicial temper.

The rules of natural justice require that not only should justice be done, but that it should be seen to be done.

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**Case Law**

The High Court in *Johnson v Johnson* [2000] HCA 48 heard an appeal based on judicial bias, following the judge in question stating that he would be placing greater weight on independent evidence, rather than the testimony of the two parties in a Family Court matter. The judgement provides guidance on the appearance of bias:

"It has been established by a series of decisions of this Court that the test to be applied in Australia in determining whether a judge is disqualified by reason of the appearance of bias (which, in the present case, was said to take the form of prejudgment) is whether a fair-minded lay observer might reasonably apprehend that the judge might not bring an impartial and unprejudiced mind to the resolution of the question the judge is required to decide"

and

"At the same time, two things need to be remembered: the observer is taken to be reasonable; and the person being observed is ‘a professional judge whose training, tradition and oath or affirmation require [the judge] to discard the irrelevant, the immaterial and the prejudicial’".

The court also noted that judges who express tentative views are not on that account alone to be taken to indicate prejudgment. In the court’s view, judges are not expected to wait until the end of a case before they start thinking about the issues, or to sit mute while evidence is advanced and arguments are presented. On the contrary, they will often form tentative opinions on matters in issue, and counsel are usually assisted by hearing those opinions, and being given an opportunity to deal with them.

"At the trial level, modern judges, responding to a need for more active case management, intervene in the conduct of cases to an extent that may surprise a person who came to court expecting a judge to remain, until the moment of pronouncement of judgment, as inscrutable as the Sphinx. In *Vakauta v Kelly* [1989]..."
3.8.4.2 Waiving of Objection of Bias by Standing by until Decision Issued

HCA 44 Brennan, Deane and Gaudron JJ, referring both to trial and appellate proceedings, spoke of ‘the dialogue between Bench and Bar which is so helpful in the identification of real issues and real problems in a particular case.’

Where a party has a perception of bias arising out of the conduct of proceedings, it:

“is not entitled to stand by until the contents of the final judgment are known and then, if those contents prove unpalatable, attack the judgment on the ground that … there has been a failure to observe the requirement of the appearance of impartial judgment. By standing by, such a party has waived the right subsequently to object.” (Vakauta v Kelly [1989] HCA 44 at [5]; 167 CLR 568)

However, notwithstanding that a party has so stood by, if whatever comments that gave rise to a perception of bias are carried over into the actual decision and have the effect of conveying an appearance of impermissible bias in the decision, the party has the right to object (Vakauta v Kelly supra at [7]).

3.8.4.3 Bias as a Result of Contact with Parties Outside of Hearing

Private communication with the parties on matters before a hearing officer could result in allegations of bias. Hearing officers are not to participate in such communications (see 3.8.2.3 Contact With Parties Outside of Hearing).

3.8.4.4 Bias as a Result of Other Proceedings Involving the Same Parties
The fact that a hearing officer has been involved in earlier proceedings in relation to the same matter, e.g. an extension of time or a sec 104 amendment, does not disqualify that person from hearing subsequent proceedings, such as the substantive opposition, because of an apprehension of bias (see Re J.R.L.; Ex Parte C.J.L., 161 CLR 342 at 352).

3.8.5 Principles of Conduct

Decisions of the Commissioner under the Patents Act are made within a broader administrative law framework to which the Public Service Act 1999 and legislation such as the AD(JR) Act 1977 are relevant. Principles that flow from these, and as reflected in the APS Values and Code of Conduct, are discussed in the following sections.


3.8.5.1 Lawfulness

Hearing officers must act in accordance with the law. This requires both knowledge of, and compliance with, the Patents Act and other laws that are relevant to the proceedings and decision made by the hearing officer, and a demonstrated commitment to the legal principles that apply to public officers in the making of administrative decisions.

In this regard, sec 6 of the AD(JR) Act 1977 is indicative of the improper and unlawful exercise of administrative powers that should be avoided and includes:

- taking an irrelevant consideration into account;
- failing to take a relevant consideration into account;
- exercising a power for a purpose other than a purpose for which the power is conferred;
- exercising a discretionary power in bad faith;
3.8.5.2 Fairness

- exercising a personal discretionary power at the direction or behest of another person;
- exercising of a discretionary power in accordance with a rule or policy without regard to the merits of the case;
- exercising a power that is so unreasonable that no reasonable person could have so exercised the power;
- exercising a power in such a way that the result of the exercise of the power is uncertain; and
- exercising a power in a way that constitutes abuse of the power.

These also relate to the principles of fairness, rationality and openness that are discussed in the following sections.

Key considerations for hearing officers in regard to lawfulness are:

- Does the Patents Act authorise the decision that is proposed to be made?
- Do they have power under the Act to make the decision?
- Do they understand the law and any procedures required by law that are relevant to the decision?

If hearing officers are in any doubt, advice should be sought from OEP.

For information on the powers that are delegated to hearing officers, see 3.8.10.4 Hearing Officer Delegations.

3.8.5.2 Fairness

In this topic:

Procedural fairness requires public servants to make reasonable, fair, just and transparent decisions. The three central rules of procedural fairness are:

- the hearing rule;
- the bias rule; and
- the no evidence rule.
Hearing Rule

The person whose interests will be adversely affected by a decision should be given the opportunity to be heard and to hear the case made against them. This principle is reflected in a number of the provisions of the Patents Act, for example reg 22.22, that allow for the hearing of a party before the Commissioner. Note that the right to be heard does not always mean a right to an oral hearing (*Ashmore v Commissioner for Superannuation* (2000) 62 ALD 97 at [58]), however the Act generally provides that opportunity.

The hearing rule also encompasses other issues related to the preparation of a party’s case including:

- Allowing sufficient time for a party to prepare.
- Giving sufficient time for a party to respond to new evidence or material, including matter raised by hearing officers from their own investigations or technical knowledge.
- Accommodating the limited knowledge that a party may have of proceedings before the Commissioner, e.g. unrepresented parties.

Bias Rule

Bias may be actual or perceived and may arise in the decision maker’s personal circumstances or in the conduct of proceedings. Actual bias generally requires a party to prove a decision maker was actually prejudiced against them and failed to give proper consideration to the facts relevant to the decision. Apprehended (perceived) bias relates to whether there is some circumstance or conduct involving the decision maker that might undermine public confidence in the administrative process.

The test is whether a “fair-minded lay observer might reasonably apprehend that the judge might not bring an impartial mind to the resolution of the question the judge is required to decide” (*Ebner v The Official Trustee in Bankruptcy; Clenae Pty Ltd v ANZ Banking Group* [2000] HCA 63).

Apprehended bias might arise in the following circumstances:
• A hearing officer has a social or personal relationship with a party or witness.

• A hearing officer has a financial interest in a party or in a matter under consideration, e.g. a directorship or shareholding.

• A hearing officer has preconceived views of a matter relevant to the matter under consideration

• A party or witness communicates separately with the hearing officer outside of established procedures (see 3.8.2.3 Contact with Parties Outside of Hearing).

When allocated a case, hearing officers should consider the possibility of an apprehension of bias and, if appropriate, disqualify themselves at an early stage to enable the case to be reassigned. A common example is where the hearing officer has previously been involved in the examination of the application. However, this does not automatically disqualify that person from hearing the case (see 3.8.4.4 Bias as a Result of Other Proceedings Involving the Same Parties).

If proceeding with the case, the hearing officer must disclose to the parties any matter that might give rise to an apprehension of bias and invite submissions on whether the issue of disqualification arises. Where an objection is raised only after the decision is issued, see 3.8.4.2 Waiving of Objection of Bias by Standing by Until Decision Issued.

In any event, hearing officers must approach proceedings with an open mind and avoid any conduct that suggests that they have prejudged that matter or are biased in favour of a particular party.

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**No Evidence Rule**

This rule requires decisions to be made upon findings of fact which are based on logically probative material (see, for example, *Australian Broadcasting Tribunal v Bond* (1990) 170 CLR 321).
Hearing officers are expected to be reasonable and only consider the merits of a case when making a decision. This includes taking into account relevant considerations and evidence, and ignoring those factors that are irrelevant to the matter required to be determined.

Note that a decision is not unreasonable merely because on review a different decision can be reached based on the relevant facts. A decision will only be unreasonable if no reasonable person in the circumstances could have reached the same conclusion.

Rationality also extends to the decision following logically from the material facts and considerations relevant to the case. A well-structured statement of reasons will assist hearing officers in making logical decisions consistent with the facts (see 3.8.6.1 Written Decisions).

Openness or transparency is required to ensure public confidence in the decision making process and that such processes are, and are seen to be, fair and reasonable. Transparency also protects decision makers against allegations of bias or partiality, or that they have taken into account irrelevant considerations.

Aspects of transparency applied in proceedings before the Commissioner include:

- The holding of public hearings.
- Production of written reasons for decisions following hearings or on request.
- Ensuring that submissions of a party and any responses are made available to other parties and are recorded appropriately.
- Informing the parties of any information that hearing officers have consulted of their own volition and providing an opportunity for them to address that material.

Hearing officers should be particularly cautious about material or submissions that they are given or become aware of after a case has been heard. If relevant to their decision, all such information should be copied to the parties and a reasonable opportunity provided for them to make submissions and, where appropriate, to file evidence addressing the matter.
Independence

A related matter is the independence of the decision maker. A decision maker must not act under the direction of another officer. However, this does not mean that appropriate guidance cannot be provided to assist the decision maker. It is also appropriate for hearing officers to consult with their peers on questions of law or on other issues where this will assist them in the decision making process.

Ultimately, however, the decision remains the full responsibility of the delegated hearing officer. The internal processes for peer review of the statement of reasons and of the performance or competency of hearing officers are specifically designed not to compromise the independence of the hearing officer in deciding a particular matter (see also 3.8.9 Quality).

3.8.5.5 Diligence and Efficiency

The Customer Service Charter Timeliness Guidelines provide that decisions will be issued within 13 weeks from the date of the hearing, unless further submissions or evidence is filed.

Hearing officers should provide an indication to the parties of the likely timeframe for the issuing of their decision (usually at the hearing) and explain and accept responsibility for any delays that occur, other than delays attributable to the parties. For additional information on time frames, including indicative times for procedural matters and decisions on examiner’s objections, and the issuance of apologies, see 3.8.6.2 Time for Issuing a Decision.

Efficiency, however, extends beyond the timeliness of issuing decisions. It also includes the conduct of the proceedings up to and including the hearing. In this regard, it is important that proceedings are streamlined as much as possible to reduce costs and unnecessary delays while not compromising procedural fairness. Achieving an appropriate balance can be difficult, however hearing officers should ensure that they retain control of proceedings, establish clear expectations for the parties and take action to prevent them from making repetitious and irrelevant submissions. In this regard, it is important that the hearing officer is sufficiently prepared and is able to identify and question the parties on those issues that are most pertinent to the matter at hand.
3.8.5.6 Courtesy and Integrity

Hearing officers must ensure that parties appearing before them are treated with dignity, respect and courtesy. Officers need to have an awareness of, and sensitivity to, the diversity of the Australian community and, in particular, the obligations that arise under the Racial Discrimination, Sex Discrimination and Disability Discrimination Acts.

Thus, special effort may be required when explaining the proceedings or to otherwise accommodate the special needs of certain parties. It will certainly mean that parties are heard patiently and carefully and that disparaging remarks are not made by the hearing officer at the hearing or in their decision and that such remarks made by other parties are not tolerated. Cross examination can also raise particular issues, for example where questioning is overly aggressive or the credibility of a witness is attacked on irrelevant grounds.

Similarly, hearing officers are expected to act honestly and truthfully in the conduct of their duties and to disclose any conflict of interest that may arise. They must not use confidential information that may be available to them for advantage and must at all times act in a way that upholds the integrity of the Australian Public Service and the decision making process.

3.8.6 Decisions

3.8.6.1 Written Decisions

In this topic:

Statements of Reasons

Statements of reasons provide transparency in the decision making process and allow the parties affected by the decision the opportunity to exercise their right of appeal or review on an informed basis. Reasons also assist hearing officers in reaching their decision in a careful, diligent and logical manner while identifying principles to guide future decision making.

Statements of reasons should:
3.8.6.1 Written Decisions

- Be clearly presented, use plain language where possible and apply legal and technical terminology in a consistent and appropriate manner.
- Clearly set out the relevant background and major issues to be decided.
- Set out findings on material questions of fact drawn from relevant evidence and particularly explain findings where evidence is conflicting.
- Give proper consideration to the issues including the submissions made by the parties.
- Identify and apply current legal precedent and practice.
- Make the reasoning behind the decision clear and logically support the conclusion reached.

However, it is “not necessary that reasons address every issue raised in proceedings; it is enough that they deal with the substantive issues upon which the decision turns” (Total Marine Services Pty v Kiely (1995) 51 ALD 635).

Office practice is to generally provide a statement of reasons with all decisions that follow a hearing. In some circumstances, reasons may not be given with the decision, but must be provided within 28 days pursuant to AAT or AD(JR) Acts.

For general guidance on statements of reasons, see the Practical Guidelines for Preparing Statements of Reasons prepared by the Administrative Review Council and Judgement Writing by Rt Hon Sir Harry Gibbs (former Chief Justice of the High Court of Australia) published in The Australian Law Journal, Volume 67 at page 494.

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Privacy Considerations

Hearing officers may have to deal with personal information relating to individuals. Personal information is defined as information or opinions, whether true or not, about an individual whose identity is apparent or can be reasonably ascertained. This may include information such as racial or ethnic origin, political opinions, religious beliefs, membership of organisations, sexual preference, criminal record or health information. Personal information only relates to a living natural person and not companies.

When writing decisions, two key principles govern the use of personal information:

- The personal information is **only to be used for a relevant purpose**. For example, the presence of a medical condition could be relevant to the failure to do an act in time.
• The personal information should **not be disclosed unless necessary.** Maintaining privacy should be balanced with the need to produce a statement of reasons that fully supports the decision. In some circumstances, this may be done by referring to matters in general, for example “a serious medical condition”, without needing to specify the exact condition.

For further guidance, hearing officers should consult the Privacy Officer.

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**Decision Format**

All written decisions must follow a similar format and use the template on the [Oppositions and Examination Practice Workbench](#). A copy of the [Guidelines for Hearings Decisions](#) is also located on the workbench.

The following points should also be noted:

• The template is broken up into two sections. The Decision section at the start of the document enables all relevant matters decided to be summarised in one area and also permits the hearing officer to record any directions regarding the application. The Reasons for Decision section should be broken up into parts using appropriate headings, e.g. Background, Evidence, Specification, Claims Construction, Proposed Amendments, Novelty, Conclusion, Costs etc. This format is particularly helpful for lengthy or complex decisions, but equally useful in short decisions.

• Care should be taken in referring to the parties to the action. For example, if the patent applicant is Joe Bloggs or PDC Ltd, then references to the applicant should be in the singular (e.g. his/its evidence). If A and B are opposing a patent grant, then they are opponents (plural).

• The paragraphs in decisions should be consecutively numbered. Hearing officers should take care using paragraph numbers when referring to other parts of the decision, as these references will not be automatically updated if the paragraph numbering is changed (e.g. if another paragraph is inserted).

• In some circumstances, it may be appropriate to append a drawing from a patent specification to the decision, if it will aid in the understanding of the decision. A suitable reference should be included in the text to the attached drawing. Care should be taken with the electronic formatting, as if the size of attachment is too large, there may be problems uploading it onto the AustLII website (see [3.8.6.3 Publication of Decisions](#)).
• Reasons should usually be consistent with previous office decisions. If a hearing officer is instigating a change of practice, they should ensure that the Patent Manual of Practice and Procedure is updated and that the change is communicated to examiners, other relevant staff and users of the patent system.

Actions When Decision Completed

Following formal review (see 3.8.9.2 Peer Review), a copy of the final decision must be saved on the G: drive at G:\P&PBR\Secure\PMOG\POH\Documents & drafts\Drafts. The red decision folder containing a copy of the decision, the opposition file, evidence and any other relevant material should be returned to OEP.

OEP will subsequently arrange issuance of the decision to the parties, publication actions and implementation of any practice changes that flow from the decision.

Parties must not be verbally informed of the decision until it has been given to OEP and is ready to issue.

3.8.6.2 Time for Issuing a Decision

The Customer Service Charter Timeliness Guidelines provide that decisions will be issued within 13 weeks from the date of the hearing, unless further submissions or evidence is filed.

Where it appears that a decision will not issue within 13 weeks, OEP should be advised and given reasons for the actual or possible delay.

Notwithstanding the Customer Service Charter, unnecessary delay in issuing decisions is contrary to the principles of fairness and efficiency in decision making (see 3.8.5.5 Diligence and Efficiency). Therefore, unless there are special circumstances, a decision should be ready to issue within the following timeframes from the date of the hearing:

• procedural issues – 20 working days

• substantive oppositions – 13 weeks

• decisions on examiner's objections – earlier of 8 weeks, or before acceptance.

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Effective Date: 25 September 2019
Where a decision on a substantive opposition has not issued within 13 weeks of the hearing, the hearing officer should arrange for a letter of apology to be issued. The letter should indicate generally the cause of delay and the likely timeframe for the decision to issue, e.g. “by the end of this month” or “within the next three weeks”.

For hearings on procedural matters, letters of apology are not expected to be sent until 13 weeks from the date of the hearing have elapsed, unless the hearing officer has indicated (e.g. at the hearing) that the decision will issue in a shorter period.

3.8.6.3 Publication of Decisions

OEP will arrange for the publication of office decisions. Full copies of decisions are published by AustLII, CCH & Butterworths, Thomson Reuters and Time Base. Abstracts of decisions are published in the Australian Official Journal of Patents (AOJP) and the AOJP (Supplement).

Copies of oral recordings of public hearings are also available from Oppositions & Hearings in COG on request.

3.8.6.4 Rectification of Errors or Omissions in Decisions

It is well established that if a judgement or order has been expressed ambiguously, or fails to express the court's intentions correctly because of an accidental error or omission, it may be amended (see Australian Civil Procedure, 3rd edition, B. C. Cairns, The Law Book Company Limited, 1992, pages 233-235).

This power of correction is part of a court's inherent jurisdiction, and administrative agencies such as the Administrative Appeals Tribunal have, at times, exerted a similar corrective power (see Re Brown and Acting Commissioner for Superannuation (1980) 3 ALD 185).

If it is clear that the final conclusions of a decision do not reflect the intentions of the Commissioner, as shown in the body of the decision, due to clerical, typographical, spelling or other accidental errors or omissions, then it is possible to amend the decision. This approach is consistent with the “slip” rule used in judicial matters. This will usually be done by issuing a corrected decision including a corrigendum, accompanied by a covering letter to
3.8.6.5 Revocation of Decisions

the parties explaining the error or omission. Note that the corrected version will replace the original published decision.

The Commissioner does not have the power to withdraw a decision and make a fresh decision in the absence of a jurisdictional error (see *Ex parte Mole Engineering Pty Ltd* (1981) 35 ALR 119). Thus, as no new decision has been made when making corrections, the original date of the decision stands. This may be important when considering time limits for actions such as appeals or amendments.

**Note:** For corrected decisions, the Decision Date field should take the format:

Decision Date: old date (Corrected on new date)

The decision should also include a corrigendum stating the date of correction and listing the parts of the decision that have been corrected. The corrigendum should appear on a new page after the decision abstract, but before the pages of the decision itself. If a table is required, OEP should be notified to allow for appropriate formatting steps before publication.

**Note:** If a decision is erroneous, but nonetheless expresses the intention of the Commissioner at the time the decision was made, it may not be set aside or varied except under appeal (see 3.8.7 Further Hearings).

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3.8.6.5 Revocation of Decisions

The Commissioner has no power to repeal, rescind, revoke or amend a decision, unless this is specifically provided for by the Patents Act (see *Jiejing Pty Ltd v Commissioner of Patents and Ron Thomas and Allan Garnham* (unreported decision by the AAT in relation to application 42052/89, issued 13 April 1995) and *Ex parte Mole Engineering Pty Ltd* (1981) 35 ALR 119).

Thus, the Commissioner generally has no power to change a decision once it has been made. However, there are two exceptions:

- if the decision does not reflect the decision maker’s intention (see 3.8.6.4 Rectification of Errors or Omissions in Decisions); and
- if the decision was *ultra vires* because the Commissioner had no jurisdictional power to make the decision.

See also AGS Legal Briefing No. 67, Don’t Think Twice – Can Administrative Decision Makers Change Their Mind?

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Effective Date: 25 September 2019
3.8.7 Further Hearings

A hearing officer may become aware of relevant evidence or facts once a hearing has been completed. In this situation, reg 5.23 applies and the parties should be offered a further hearing at which they can argue the material which the hearing officer has become aware of. In general, such further hearings are heard by way of written submissions.

Note that once a decision has been made, that decision cannot be re-heard or challenged, except on appeal (R v Smith; Ex parte Mole Engineering Pty Ltd [1981] HCA 25).

3.8.8 Final Determinations

3.8.8.1 Overview of Proceedings

Where a decision finds certain defects in an application, the applicant will usually be provided with an opportunity to propose amendments to address these. In this situation, a final decision or determination is required to conclude proceedings, unless the opponent withdraws the opposition.

Once the amendments have been allowed, the matter is set for final determination and the parties provided with an opportunity to be heard. The reason for this process is that in general, the criteria for allowability of amendments do not correspond to the grounds of opposition. Thus, the amended specification may be in a form such that it could not properly be said to have been the subject of argument on the basis of one or more of the grounds of opposition.

Any resulting hearing is conducted under the provisions of sec 216 and reg 22.22. The original hearing officer will conduct the final determination hearing, unless there are extenuating circumstances which make this impossible, and issue a formal decision.

The issues to be considered in a final determination are whether or not the amendments to the specification overcome the findings in the original decision, and whether the
amendments introduce any new deficiencies. Matters that were decided in the earlier decision have been decided once and for all, and are not open to challenge in the final determination (see *Ex parte Mole Engineering Pty Ltd* (1981) 35 ALR 119 and *Iluka Midwest Ltd v Technological Resources Pty Limited* [2002] FCA 49 & [2002] FCA 1233). New deficiencies are grounds of opposition that arise solely from the amendment of the specification.

The final determination is itself a decision that is capable of appeal.

**Note:** A “final determination” is not necessarily the only opportunity the applicant has to rectify any defects. If the hearing officer considers that the applicant has genuinely attempted to overcome the defects, the applicant is likely to be provided with another opportunity to amend.

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**Opponent Does Not Wish to be Heard**

If an opponent does not want to be heard (the usual case), the hearing officer will consider whether the amendments overcome the grounds of objection. If the application is in order, the hearing officer should write a file note to that effect and direct the application to be granted. Note that under sec 61(2) and reg 6.2(b)(ii), the hearing officer should give a date by which grant is to occur, usually a date 1 month from the date of the final determination. If the hearing officer finds certain grounds of objection (still) exist, the hearing officer may either:

- provide the applicant with a further opportunity to amend; or
- if the circumstances justify it, initiate action to refuse the application.

In some circumstances, an opponent may not wish to be heard, however still provides written submissions for the hearing officer to consider in the final determination. In this situation, the hearing officer should write a letter to both parties that addresses the submissions and either directs the application to grant or, if the submissions are persuasive, invite further amendments from the applicant. However, where an issue is particularly complex, it may be appropriate to write a formal final determination decision.
If an applicant does not propose amendments to address the defects in an application within the time allowed and without good reason, the Commissioner will initiate action to refuse the application.

Wherever possible, the original hearing officer should deal with the matter. Before formally refusing the application, the applicant must have an opportunity to be heard. Any such hearing will be restricted to matters of why the amendments have not been proposed in the time allowed. Arguments to the effect that the original decision was wrong are inadmissible (see *Ex parte Mole Engineering Pty Ltd* [1981] HCA 25).

If a hearing is held, the opponent will be invited to attend.

**Note:** If the Commissioner refuses an application, the Commissioner becomes *functus officio* at the time the decision to refuse becomes operative, and any pending amendment requests are *res nullae* (see *Kyowa’s Application* [1969] FSR 183).

If an opponent withdraws an opposition, there is no need for a final decision to conclude the opposition. Thus, provided the hearing officer is satisfied that the amendments overcome the grounds of objection specified in their decision, the application can be directed to proceed to grant.

If the opponent withdraws the opposition after the decision is issued, but before any amendments are proposed, it is not open for the applicant to argue that the application should be granted without amendment. Where a decision has identified grounds of objection, the applicant must either address those objections by way of amendment, or dispute them by way of appeal.

**3.8.9 Quality**

Decisions under the Patents Act should meet all the administrative law requirements as outlined in 3.8.5 Principles of Conduct.
For the purposes of providing quality service, the following are key elements of performance:

- The proceedings as a whole are conducted fairly and efficiently.

  Parties to proceedings before the Commissioner have sufficient opportunity to present their case and respond to the case made against them. However, unnecessary delay and expense are avoided.

- Hearings are conducted professionally.

  The hearing officer is prepared for the hearing (which includes understanding both the facts of the case and the relevant law), is courteous, confident and in control of proceedings.

- The statement of reasons properly supports and explains the decision.

  Statements of reasons meet the requirements outlined in 3.8.6.1 Written Decisions.

- Decisions are issued in a timely manner.

  Written decisions are issued within 13 weeks from the date of the hearing, unless further submissions or evidence is filed.

All decisions are subject to a formal peer review before issuance. It should be emphasised that peer review is not directed at the correctness of a hearing officer's decision, but whether it meets appropriate administrative law principles (as stated in 3.8.5 Principles of Conduct).

On completion of the decision, the hearing officer will ask a peer review panel, comprising a hearing officer peer and a member of the Hearing Officer Standards Panel (HOSP) with an appropriate technological background, to provide feedback on the decision and statement of reasons.

Where substantive changes to the decision are required as a result of the review, a copy of the revised decision should be given to the reviewers for comment. However, where any changes required are only minor in nature, it is not necessary for the reviewers to consider the revised decision before issuance.
3.8.10 Appointment of Hearing Officers and Assistant Hearing Officers, Hearing Officer Standards Panel, Hearing Officer Delegations

3.8.10.1 Hearing Officers

Hearing officers are appointed from amongst patent examination staff members that have undergone appropriate training and met defined competency standards (see IP Rights Learning and Development Manual).

Hearing officers are generally assigned to hear matters based on considerations of administrative efficiency, but with due regard to:

- the specific suitability of the officer given the field of technology of the case and any particular legal issues that arise; and
- the availability of the officer.

Assignments will also have regard to any actual or potential conflict of interest, for example, hearing officers will not usually hear an opposition if they have previously been involved in the examination of the application.

3.8.10.2 Assistant Hearing Officers

Assistant hearing officers may be appointed to assist a hearing officer in the preparation for a hearing and the preparation of the statement of reasons in the written decision. However, the decision remains the sole responsibility of the hearing officer and any assistance provided is at the direction of the hearing officer.

Duties of an assistant hearing officer may include:

- preparing a summary of the key issues, authorities and evidence (without conclusions) prior to the hearing;
- preparing an initial draft of the statement of reasons under the direction of the hearing officer; and
- drafting an abstract of the decision and any consequential manual changes that may be necessary.
Assistant hearing officers are selected on merit with particular regard to their potential for development as hearing officers and are generally examiners or senior examiners.

3.8.10.3 Hearing Officer Standards Panel

The Hearing Officer Standards Panel (HOSP) is responsible for the development and assessment of hearing officers and the maintenance of appropriate standards in the opposition and hearings process, including adherence to the principles of conduct.

The standards panel generally comprises the Deputy Commissioner (OEP) and a number of experienced hearing officers representing each main technology grouping.

3.8.10.4 Hearing Officer Delegations

In order to hear and decide an opposition, and refuse to accept an application, hearing officers require a delegation from the Commissioner to exercise the relevant powers.

The Supervising Examiner (OEP) is responsible for the preparation of delegations for the Commissioner’s signature, including the hearing officer delegation.

New hearing officers, or those returning after an absence, should ensure that they have the appropriate delegation in place.

3.9 Costs

Note: This information applies to awards of costs whether made before, on or after 15 April 2013.
3.9 Costs

In this topic:

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### Relevant Legislation

#### The Act

- **Section 210**: Commissioner’s powers
- **Section 211**: Recovery of costs awarded by the Commissioner
- **Section 219**: Security for costs

#### The Regulations

- **Reg 22.8**: Costs
- **Schedule 7**: Fees
- **Schedule 8**: Costs, expenses and allowances

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#### Overview

The Commissioner’s power to award cost is set out in section 210(d) of the Patents Act:

"210. The Commissioner may, for the purposes of this Act:

(d) award costs against a party to proceedings before the Commissioner."

Section 211 should also be noted:

"211. Costs awarded by the Commissioner against a party are recoverable as a debt."
Regulation 22.8 further prescribes the costs that may be awarded:

"22.8(1) The Commissioner must not award costs in proceedings to which this Division applies, other than costs specified in Schedule 8 unless each party to the proceedings has had the reasonable opportunity to make a submission on the matter of the award of those costs.

(2) The Commissioner may award an amount:

(a) for costs in respect of a matter specified in column 2 of an item of Part 1 in Schedule 8; or

(b) in respect of the expenses or allowances of a person in relation to proceedings to which this Division applies."

The power of the Commissioner of Patents to award costs under section 210(d) of the Patents Act 1990 was challenged in the Federal Court in Stack and Another v Commissioner of Patents and Others [1999] FCA 148; (1999) 43 IPR 663 on the ground that it was an impermissible conferral of judicial power on an administrative body. Drummond J rejected the argument, holding that power to award costs under the Patents Act cannot be described as an essential element of the exercise of judicial power - R v Quinn; Ex Parte Consolidated Foods Corporation [1977] HCA 62; (1977) 138 CLR 1 applied.

The Court also indicated that “proceedings” were matters related to a determination involving the exercise or non-exercise of a power conferred by the Act which the Commissioner is permitted to make “only after hearing the persons with opposing interests in the exercise of the power”. Consequently the Commissioner’s power to award costs is not limited to opposition proceedings but extends to inter partes actions generally, such as objections to extensions of time, e.g. for lodging evidence, section 32 matters etc. See also Super Internet Site System Pty Ltd v Sensis Pty Ltd [2006] APO 27.

It follows that an award of costs is only appropriate in inter parte matters. In ex parte matters the party seeking the exercise of the Commissioner’s powers bears its own costs.

Under reg 22.8(2) an amount may be awarded in proceedings in relation to both (a) and (b) and any individual cost item can come from either subparagraph (a) or (b) (GS Technology Pty Ltd v GSA Industries (Aust) Pty Ltd [2000] APO 12).

It should also be noted that in the Act and Regulations “costs” is used broadly and, for example, includes both the specific cost items set out in part 1 of Schedule 8 as well as expenses and allowances set out under parts 2 and 3.
3.9.1 Principles in Awarding Costs

Note: This information applies to awards of costs whether made before, on or after 15 April 2013.

The Federal Court in *Patent Gesellschaft AG v Saudi Livestock Transport and Trading* 33 IPR 461 set out a number of principles relevant to the award of costs:

1. As a general proposition, in the absence of special circumstances, costs follow the event but the costs should reflect the degree of success obtained and the successful party may be ordered to pay some costs in respect of unsuccessful aspects of the case. - *Hughes v Western Australian Cricket Association Inc* (1986) 66 ALR 660; ATPR 40-748, *Ruddock v Vardalis* [2001] FCA 1865. Relevant matters in relation to this issue include: relative failures and successes of the parties, time spent on particular issues, the interrelationship between issues, and the level of involvement of the various parties in leading evidence and making submissions at the hearing. – *H Lundbeck A/S v Alphapharm Pty Ltd* (No 2) [2009] FCAFC 118.

2. The community’s interest in economy and efficiency in litigation may be reflected in qualification of the presumption that a successful party is entitled to its costs. - *Dodds Family Investments Pty Ltd v Lane Industries Pty Ltd* (1993) 26 IPR 261.

3. The costs order in a patent case should, where appropriate, reflect the extent to which significant sums of costs have been thrown away by reason of one party, albeit successful overall, raising and pursuing unsuccessful points. - *C Van Der Lely NV v Ruston’s Engineering Co* [1993] RPC 45.

4. Where a successful party raises issues or allegations improperly or unreasonably, the court may not only deprive him of costs but might order him to pay the whole or part of the unsuccessful party’s costs. - *Rediffusion Simulation Ltd v Link-Miles Ltd* [1993] FSR 369.

5. However, a successful party who neither improperly nor unreasonably raised issues or made allegations on which he failed ought not to be ordered to pay any part of the unsuccessful party’s costs. - *Rediffusion Simulation Ltd v Link-Miles Ltd* [1993] FSR 369

In relation to proceedings discontinued before hearing or determination:

“It will rarely, if ever, be appropriate, where there has been no trial on the merits, for a court determining how the costs of the proceedings should be borne to endeavour to determine for itself the case on the merits or, as it might be put, to determine the outcome of a hypothetical trial” *Aussie Red Equipment Pty Ltd v Antsent Pty Ltd* [2001] FCA 1641.
However in this regard the courts have recognised a distinction between cases where it can be said that one party has effectively surrendered to the other, and cases where some supervening event or settlement so removes or modifies the subject of the dispute that no issue remains except that of costs. The first type generally will attract the usual award of costs, for example where an opposition or an opposed application is withdrawn. The second type generally will not attract an award of costs unless it is apparent that one party was almost certain to have succeeded or the conduct of a party otherwise makes an award of costs appropriate. (Kiama Council v Grant [2006] NSWLEC 96, Super Internet Site System Pty Ltd v Sensis Pty Ltd [2006] APO 27, Amgen, Inc. v Genentech, Inc. [2016] APO 15)

Note: This information applies to awards of costs whether made before, on or after 15 April 2013.

In this topic:

Costs are an indemnity to the successful party, and they in general include fees to counsel, to solicitors, fees of court, necessary disbursements, and witness expenses. As a general rule the only limit to their amount is that they must be necessary and reasonable. However costs of proceedings before the Commissioner are normally awarded according to the scale of costs specified in Schedule 8 of the regulations and the Commissioner will not depart from an award of costs on this basis unless the circumstances clearly warrant doing so (Colgate-Palmolive Co and another v Cussons Pty Ltd, 28 IPR 561).

Schedule 8

Schedule 8 of the regulations sets out the scale of costs relevant to proceedings before the Commissioner, as well as (in Part 2) expenses and allowances that may be included in an award of costs. These include a prescribed fee, such as the hearing fee, paid in relation to the proceedings, reasonable travel and accommodation expenses and allowances for witnesses and experts summons to appear before the Commissioner.
If there is a change in the scale of costs, the scale used is that which is current when the costs are awarded (e.g. the date of the written decision) and no other date, as for example the date of commencement of the proceedings.

Schedule 8 applies to proceedings before the Commissioner and is not limited to Chapter 5 proceedings. However not all items will apply to all proceedings. For example a request under section 32 does not equate to a notice of opposition. However, if evidence is filed in a proceeding and can be categorised as evidence in support, answer or reply, the relevant costs items will apply.

Other considerations relevant to the application of the Schedule include:

- The word "or" as it is used in Items 12 and 13 of the Schedule is used in a disjunctive sense, i.e. one thing or the other, but not both. Any award of costs according to the Schedule only entitles the claiming of costs in relation to attendance at a hearing by either a patent attorney or a solicitor, not both (Emory University V Biochem Pharma Inc [2000] APO 53);

- Item 14 of Schedule 8 relates exclusively to attendance at a hearing by Counsel in the singular, not plural (Emory University V Biochem Pharma Inc [2000] APO 53) - this reasoning would appear to apply equally to the attendance of patent attorneys or solicitors under items 12 and 13;

- The scale of costs contains no items in relation to further evidence and hence no costs are awardable in relation to further evidence unless the scale is varied (Colin Leslie Young v W. Neudorff GmbH KG & Arthur Yates & Co [2002] APO 7). The filing of further evidence may however be relevant to the decision to award costs in the proceedings – see 3.9.5 Exemplary Situations in Awarding Costs;

- Preparation of a case for hearing in Item 11 includes cost relating to preparation irrespective of whether the hearing proceeds (Hiltive Pty Ltd v Rudolf Hartmann [2002] APO 46). In some circumstances it may also include preparation of written submissions in lieu of appearing at the hearing (John Edward Vines v John McDonald [2005] APO 25).

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**Certain Fees not Claimable**

A person who pays a fee prescribed in the regulations in respect of a matter relating to proceedings before the Commissioner may be paid the amount of the fee (paragraph 1 of division 1 of part 2 in Schedule 8). But it does not follow that all the fees listed in Schedule 7 are relevant to an award of costs.
A party should be awarded a fee from Schedule 7 as costs if the fee gives the party its right to start the proceedings. However, a party should not be awarded a fee from Schedule 7 as costs if the fee is to request an indulgence from the Commissioner - unless the actions of the other party directly caused it to need the Commissioner's indulgence. Thus fees paid for extending the time for serving evidence in the proceedings will normally not be awarded as costs.

See *Prudhoe v ICI Aust* 27 IPR 100, (1993) AIPC 90-986

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**Cost of Attending Hearing**

An award of costs includes the cost of attendance for persons attending on behalf of the successful party, provided the attendance of that person was reasonable. Thus the expenses of the counsel and attorneys that were necessary for the hearing can be claimed. Where a party is represented by more than one counsel and one patent attorney, the expenses of the additional representatives will only be available if there has been a variation of the scale.

Where a witness attends on behalf of the successful party, their expenses can be claimed (provided their attendance was necessary). Where the successful party summoned a witness (and thus met their reasonable expenses of attending), they can claim the expenses of the witness attending. See Witness Expenses below for more about whether attendance of a witness is necessary.

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**Witness Expenses**

Expenses for witnesses are set out in Schedule 8, Part 2, Division 2.

The fact that a witness was not examined does not disentitle a party to costs attendant on his proof and attendance - *Clark, Tait & Co. v. Federal Commissioner of Taxation* (1931) 47 CLR 142 at 146 and further on page 147, where it was said that the witness "was essential to the proper and prudent conduct of the case even though he was not called as a witness".

See also *Russo v. Russo*, [1953] ALR 95 and discussion thereof at 27 ALJ 332.
Note also that the cross-examination of witnesses, in itself, is not a special or unusual situation which would warrant variation of the scale of costs (E.I. Du Pont De Nemours and Company v ICI Chemicals & Polymers Limited [2007] APO 12).

### Variation of the Scale

**Regulation 22.8(1)** provides that the Commissioner must not award costs, other than costs (including expenses and allowances) specified in **Schedule 8**, unless each party to the proceedings has had the reasonable opportunity to make a submission on the matter of the award of those costs.

Thus, any award of costs for a greater quantum than specified in the schedule, or for a matter not specified in the schedule, cannot be made unless the parties have had a reasonable opportunity to make submissions. Usually this will be at the hearing which determines the proceedings.

While the Commissioner will not normally award costs other than on the basis of **Schedule 8**, such an award will be appropriate "when the justice of the case so requires or where there may be some special or unusual feature in the case" (Re Wilcox; Ex parte Venture Industries Pty Ltd and Others, 141 ALR 727). This could include circumstances where because of the complexity or importance of the case the Schedule provides inadequate recompense or where the conduct of one or other of the parties indicates that variation of the scale is appropriate (see GS Technology Pty Ltd v Davies Shephard Pty Ltd [2000] APO 49). The basic question to consider is "whether the justice of the case requires variation of the schedule" (E.I. Du Pont De Nemours and Company v ICI Chemicals & Polymers Limited [2007] APO 12), and principles relevant to the variation of the scale have been discussed in a number of Office decisions including, for example, Sterling Drug Inc v Boots Company PLC, 35 IPR 630, E.I. Du Pont De Nemours and Company v ICI Chemicals & Polymers Limited [2007] APO 12 and Viskase Corporation v W.R. Grace & Co.-Conn [1998] APO 47. Situations where an award of this nature has been considered appropriate include:

- The opposed application was withdrawn after a divisional application was filed (Super Internet Site System Pty Ltd v Sensis Pty Ltd [2006] APO 27).
- The opposed application was withdrawn after filing of evidence in support, despite an intention to withdraw apparently being formed much earlier in the opposition process, resulting in the opponent incurring substantial unnecessary costs in preparing for a hearing (Amgen, Inc. v Genentech, Inc. [2016] APO 15). A party used senior and junior counsel and it was considered that the case required this level of representation for its proper conduct (HPM v. Sturdee (1967) 37 AOJP 2077)

Conduct that the Courts have found to warrant the award of costs on an indemnity basis includes misconduct that causes loss of time to the court and to other parties; making allegations which ought never to have been made, or unduly prolonging a case by groundless contentions; commencing or continuing an action for some ulterior motive, or with wilful disregard of the known facts or the clear law in circumstances where the applicant, properly advised, should have known there was no chance of success; and abusing the process of the court, in the sense that the court's time, and the litigants' money, has been wasted on totally frivolous and thoroughly unjustified proceedings (*Rouse v Shepherd (No 2)* (1994) 35 NSWLR 277 at 279-280). See also *Colgate-Palmolive Co and another v Cussons Pty Ltd*, 28 IPR 561.

Conduct both in and leading up to proceedings may be taken into account when considering an award of costs (*Evans and Another v Maclean Shire Council and Another* [2004] NSWLEC 89, *Oshlack v Richmond River Council* [1998] HCA 11; (1998) 193 CLR 72 at 97-98).

Costs awarded in relation to proceedings on the basis of a variation of the scale may include items included in the Schedule on full or partial indemnity basis or additional items that may otherwise be relevant to the proceedings. In this regard the Federal Court Scale of Costs may be a useful guide.

Costs are generally awarded on the basis of which party won the case overall, rather which party prevailed on particular points of the case. On the other hand, an apportionment of costs can be made if a particular issue is a separate and distinct from the main issue being considered: see *Dr Martens Australia Pty Ltd v Figgins Holdings Pty Ltd (No 2)* [2000] FCA 602 at [54] where Goldberg J said:

“A court should not be too ready to disallow costs simply because a party has failed upon an issue, unless it is quite a separate and distinct issue from the issues in respect of which it succeeded or unless there be some element of unreasonableness or inappropriate conduct in relation to that issue.”

That is, in circumstances where it is fair to do so, an “issues” approach to awarding costs may be adopted, such that the costs awarded against an unsuccessful party may be reduced to reflect the degree of success on the issues in the opposition. In considering the variation to the costs in this approach there should not be a mathematical analysis of the degree of success and failure in the opposition, but a “rough and ready” determination of what is a “fair estimate” in the circumstances (*H Lundbeck A/S v Alphapharm Pty Ltd (No 2)* [2009] FCAFC 118, *SNF (Australia) Pty Ltd v Ciba Specialty Chemical Water Treatments Limited* [2016] APO 22, *CSR Building Products Limited v United States Gypsum Company* [2016] APO 7, *Bowen Investments Pty Ltd v Tabcorp Holdings Ltd (No 2)* [2008] FCAFC 107).
Relevant factors to consider when adopting this approach include the “relative failures and successes of the parties, the time spent on particular issues, the interrelationship between different issues, and the level of involvement of the various parties in leading evidence and making submissions at the hearing” (H Lundbeck A/S v Alphapharm Pty Ltd (No 2) [2009] FCAFC 118 at [15]), as well as the conduct of the parties (SNF (Australia) Pty Ltd v Ciba Specialty Chemical Water Treatments Limited [2016] APO 22).

Situations where this approach has been adopted include:

- Costs awarded against the applicant were reduced to reflect that although the opposition succeeded to a significant extent there was a lack of success on several substantial grounds (CSR Building Products Limited v United States Gypsum Company [2016] APO 7).

- Costs awarded against the applicant were reduced in light of the opponent’s pursuit of grounds previously argued unsuccessfully in the Federal Court without significant new evidence, which constituted conduct contributing substantially to the cost and complexity of the opposition (SNF (Australia) Pty Ltd v Ciba Specialty Chemical Water Treatments Limited [2016] APO 22).

**Note:** This information applies to awards of costs whether made before, on or after 15 April 2013.

In this topic:

### Awarding costs

The awarding of costs is a discretionary matter to be determined by the hearing officer after taking into account all the facts of the case (American National Can Co. v W.R. Grace & Co.-Conn [1994] APO 29; (1994) AIPC 91-063; 30 IPR 292). In this sense there are no hard-and-fast rules to be followed in awarding costs.

However, generally costs are awarded for each determination or decision that may be made within the broader proceedings, including matters concerning dismissal of opposition,
extensions of time and further evidence, rather than waiting for final determination of the proceedings. However, in complex situations it may be more convenient to defer the award until the matter is finally determined. See e.g. *Re Application by Guertler* 4 IPR 208.

Hearing officers should ensure that the parties have the opportunity to make submissions on costs at the hearing of the substantive matter or, in appropriate circumstances, in writing following the hearing. For administrative efficiency separate costs hearings should be avoided unless made necessary by the particular circumstances of the case.

The hearing officer’s finding on costs will usually be included at the end of the decision on the substantive matter and more often will involve an award of costs against one or other of the parties or will specify no award of costs. Costs are awarded AGAINST a party, rather than TO a party, so as to clearly identify who has to pay the costs. See also the wording of section 211, which states that costs awarded by the Commissioner AGAINST a party are recoverable as a debt.

For exemplary situations in awarding costs see 3.9.5.

Usually the matter of costs is settled to the mutual satisfaction of the parties without further involvement of the hearing officer. However where agreement is not reached a party may request taxing of costs.

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**Agreement Between Parties**

Parties sometimes make agreements between themselves as to costs and ask the Commissioner to award costs accordingly. This commonly occurs where a party withdraws from the action.

Disputes on the existence of such agreements most frequently arise when a party advises the other party that they intend to withdraw from the matter on the basis of each party bearing its own costs - and the other party makes no formal acceptance of the offer. In such cases the Commissioner will proceed on the basis that no agreement existed.

See *Wormald v. May Oatway* (1965) 35 AOJP 3422.

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**Taxing of Costs**
A party to proceedings may request taxation of an amount awarded under reg 22.8(2).
There is no fee for taxation of costs.

On receipt of that request, the opposition officer sends a copy of the claim to the party liable for costs, providing 21 days for comment or filing an objection to the claim. After this period the request is submitted to the taxing officer, who (acting under reg 22.8(3)) applies the scale of costs. Finally, a letter setting out the taxed costs is sent to the parties, indicating that those costs will be certified at the expiration of 21 days.

Where the amount of costs set by the taxing officer is challenged, the taxation is subject to review by the Commissioner (reg 22.8(4)). In these circumstances the parties will be asked to provide submissions (and may be heard in the matter), and a delegate of the Commissioner (typically the original hearing officer) will issue a decision in the matter.

It is important to note that a review of taxation is restricted to the correctness of the taxation in the context of the award of costs made in the decision which awarded costs. It is not a forum to dispute the correctness of the award of costs (GS Technology Pty Ltd v GSA Industries (Aust) Pty Ltd [2000] APO 12). (There is no basis during taxation for a hearing officer to change an award of costs, if in hindsight, a different award of costs might have been more appropriate. It is only possible if the words used to express the award of costs, does not give effect to the hearing officer’s intention at the time the decision was issued - a situation which should never arise).

In the event of an appeal being filed against a decision of the Commissioner, the parties frequently do not seek taxation of their costs before the Commissioner until the appeal has been resolved. Nevertheless, the mere fact that a decision is appealed does not prevent a party from seeking a taxation of its costs before the Commissioner, nor prevent the Commissioner from dealing with that taxation - and arguments that, if the appeal is successful, a party will have difficulty recovering costs it will have paid on taxation, are not relevant. Note, however, that the Commissioner cannot proceed to tax the costs if the appellant has obtained an order of the court (or AAT) staying the decision.
Introduction

The Commissioner is empowered under section 219 of the Patents Act 1990 to require security for costs in the case of a person who gives notice of opposition under the act, and who "neither resides nor carries on business in Australia" - in default of which the proceeding may be dismissed.

Section 219 has application only where a notice of opposition under the Act is filed. Proceedings which are not oppositions are not subject to a requirement for security for costs.

The sum requested as security is at the discretion of the Commissioner. The main consideration for an order for security being made is to provide for the plaintiff to have assets in Australia to which the defendant can have access if successful. Applications involving security for costs are relatively rare, and will only be taken at the request of one of the parties. If the parties cannot agree on the matter, the matter may be decided in a preliminary hearing.

The main consideration for an order for security being made is that the plaintiff has assets in the jurisdiction, to which the defendant can have access if successful.

See Farmitalia Carlo Erba Srl v Delta West Pty Ltd 28 IPR 336, (1994) AIPC 91-085; Kohn v. Rinson (1947) 2 All ER 840; C.A. Aeronave SPA v. Westland Charters Ltd. (1971) 3 All ER 532

In the latter case, Denning M.R. said "... if the defendant succeeds and gets an order for his costs, it is not right that he should have to go to a foreign country to enforce the order".

It is important to note that it is not appropriate to investigate the merits of the case on an application for security of costs unless it can be clearly demonstrated one way or the other that there is a high probability of success or failure.


Quantum of Security

Generally, the amount of security can be reached by agreement or negotiation between the parties, having regard to the likely costs to be incurred by the applicant for the patent.
Security does not include Reasonable Expenses as the Commissioner has no power to award cost in regard to Reasonable Expenses.

The matter of security for costs in a patent matter were discussed in *Farmitalia Carlo Erba SrL v Delta West Pty Ltd* 28 IPR 336, (1994) AIPC 91-085. Where there is no agreement between the parties, the Commissioner will be required to assess the quantum of security on the basis of the information available. Conflicting evidence can be resolved in favour of the person seeking the security, if they can show that it is based on an examination of the actual files and discussions with that party’s legal advisers.

The quantum of security was also discussed in *New York University v Nissin Molecular Biology Institute, Inc.* (No 2) (1994) AIPC 91-090, in relation to a security for a breach of an undertaking made in respect of the release of a sample of a deposited microorganism.

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**Award of Costs when a Security has been Paid**

Where an award of costs is made and the opponent has paid a security against costs, the decision awarding costs will need to deal with the security. Some issues that are likely to need consideration are:

- if costs are awarded against the applicant should the security be released to the opponent or are there further matters in the proceedings against which the security must be retained?

- if costs are awarded against the opponent, what is a reasonable time for the applicant to claim costs against the security? If those costs are not claimed by the applicant in that time, should that part of the security be available to the opponent?

- if the award of costs against the opponent is less than the security, should the residuum be released to the opponent upon settlement of the applicant’s claim, or are there further matters in the proceedings against which the security must be retained?

When the party who provided security before the Commissioner has no costs awarded against them, they are entitled to a return of their security. That situation is not altered in the event of an appeal against the Commissioner’s decision. Any issues relating to security for costs (including the possibility that the court reverses the Commissioner’s award of costs) is a matter to be dealt with entirely in the court proceedings.
3.9.5 Exemplary Situations in Awarding Costs

Note: This information applies to awards of costs whether made before, on or after 15 April 2013.

In this topic:

Opposition/Application Withdrawn or Lapsed; Opposition Dismissed

Where proceedings are discontinued through the withdrawal of the opposition or patent application, it will often be appropriate for the Commissioner to conclude that the party withdrawing has “effectively surrendered” to the other and an award of costs can be made, save any consideration related to the conduct of the parties.

However, while withdrawal from proceedings may suggest prima facie that one party has succeeded over the other, an award of costs in that situation is not automatic and reference must be made to the particular circumstances of each case.

See Super Internet Site System Pty Ltd v Sensis Pty Ltd [2006] APO 27.

Accordingly the practice of the Commissioner is not to automatically award cost in these circumstances. However, if a request for an award of costs is filed, the opposition officer will write to the parties indicating that the Commissioner intends to award costs and that comments or objections can be filed within 21 days. The Commissioner will then, as appropriate, make the award of costs, seek further submissions or set the matter for hearing.

Similar considerations apply when an opposition is dismissed either because it is unsupported or for other reasons.

Special considerations may apply where:

- withdrawal of an application follows the filing of a divisional application – See 3.9.2 Scale of Costs, Variation of the Scale
- withdrawal of an application occurs at a very late stage relative to the formation of the intention to withdraw - See 3.9.2 Scale of Costs, Variation of the Scale
- withdrawal of the opposition occurs following an amendment of the application (see below).
In circumstances where an opposed application lapses it may also be appropriate for the Commissioner to act on the assumption that proceedings have been discontinued and that applicant has “effectively surrendered” to the opponent. Generally this will be where the applicant is aware of the application lapsing and has made no attempt to seek restoration of that application within a reasonable period. In such cases the Commissioner will proceed on the same basis as if the application has been withdrawn.

In *William King and v KMJ Corporation Pty Ltd* [2005] APO 37 however the delegate decided to issue a decision in the matter and awarded costs on the basis that the applicant had demonstrated continuing interest in the application.

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**Opponent Fails to Establish any Grounds of Opposition**

The general rule is that costs are awarded against the opponent where they fail to establish any grounds of opposition. However if the hearing officer finds major defects not raised by the opponents they may decide not to make an award of costs.

In *Proline Industries v Ford* (1976) 46 AOJP 2887 the opponent failed on all grounds. However the specification was held not to comply with sec 40, for reasons not raised by the opponent.

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**Opponent Succeeds in Some, but not all, Grounds of Opposition**

In general, when an opposition succeeds on a substantial ground, costs will be awarded against the applicant:


However if the successful ground of objection is not substantial, costs may be awarded totally or partially against the opponent or not at all.

See:

- *Rose Holdings v Carlton Shuttlecocks* (1958) 28 AOJP 133
3.9.5 Exemplary Situations in Awarding Costs

- IBM v Columbia Ribbon (1970) 40 AOJP 1056
- PPG Industries Inc. v Stauffer Chemical Co. 5 IPR 496.

In some cases, despite there being success on a substantial ground of opposition, the fairness of the case may support an “issues” approach to the award of costs, whereby costs awarded are modified to reflect the degree of success in the opposition (H Lundbeck A/S v Alphapharm Pty Ltd (No 2) [2009] FCAFC 118, Ruddock v Vadarlis [2001] FCA 1865; 188 ALR 143, SNF (Australia) Pty Ltd v Ciba Specialty Chemical Water Treatments Limited [2016] APO 22, CSR Building Products Limited v United States Gypsum Company [2016] APO 7). For factors that may be considered in determining costs based on an issues approach, see 3.9.2 Scale of Costs, Variation of the Scale.

More Than One Opponent

Where there are several opponents, and there is one hearing in respect of all oppositions, the general rule is that costs are awarded between the applicant and each opponent according to the success or failure of each opposition where it is clear that the evidence (even though similar) has been independently adduced. That is, it is possible to apportion costs, see Rayson Industries, Smiths Industries and Westaflex v Vulcan (1976) 46 AOJP 1899. In that case, two of the three opponents established their respective grounds of opposition, whilst the third did not. The applicant had to pay the costs of the successful opponents whilst the unsuccessful opponent had to pay the costs of the applicant.

See also Malleys Ltd. v Whirlpool Australia and Others 2 IPR 441;
Hitachi Limited v Hoover (Australia) Pty. Ltd. and Another 5 IPR 569.

However where one opponent lodges evidence which is, in total, a mere photocopy of another opponent's evidence it might not be appropriate to award costs to that one opponent, who, in effect, has not mounted a case. Nothing, of course, prevents the two opponents concerned from sharing costs in such circumstances.

Where opponents have used identical evidence, costs against the applicant have been split accordingly between the opponents.

See, e.g. Snappy Panties & Another v Alleyne & Ombo. (1975) 45 AOJP 1000.

Similarly costs of joint counsel have been apportioned:

3.9.5 Exemplary Situations in Awarding Costs

**Specification Amended**

As a general rule, where there is no action of substance following amendment of the specification, including when the opposition is withdrawn (whether or not a hearing has been held), and the amendment can reasonably be seen to have been made as a result of the opposition “without the close examination of a case” ([*We Two Pty Ltd v Shorrock* [2002] FCA 875]) then costs are generally awarded against the applicant. See e.g. [*Faulding v Bickford* (1952) 22 AOJP 2045]

However where an opposition is withdrawn and it is not clear that the amendment was the result of matters raised in the opposition and would, in effect, require a determination of the merits of the case it will generally be appropriate to make no award of costs. [*Super Internet Site System Pty Ltd v Sensis Pty Ltd* [2006] APO 27].

If after the amendment of the specification there is further substantive action (i.e. the matter proceeds to a main hearing, or a further or “final” hearing), the Commissioner’s general practice has been that costs are awarded against the applicant up to, and including, the date of advertisement of allowance of the amendment (which amendment has the effect of removing the ground of objection) and costs are awarded against the opponent thereafter. However, variations to the transition date have occurred.

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**Conduct by a Party**

In exercising his discretion as to costs, a judge may have regard to the conduct of any party which is calculated to occasion unnecessary expense. Such conduct need not be misconduct, but only such as can be seen by a judge to have brought about or substantially contributed to the costs which he is considering.

See [*Keddie v Foxall* (1955) ALR 835, the note in 30 ALJ 27;]

[*Weir Pumps v CML Pumps* 2 IPR 129 at page 154 re discussion on [*Ungar v Sugg* (1891) 8 RPC 113].

The Commissioner has exercised similar discretion, and as a tribunal and not a court, may act on the basis of natural justice, not being restricted by rules of court or rules of evidence.

Conduct both in and leading up to proceedings may be taken into account when considering an award of costs ([*Evans and Another v Maclean Shire Council and Another* [2004])

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For conduct that may be taken to justify award above the Schedule of costs see [3.9.2 Scale of Costs, Variation of the Scale](#).

Note also that in making an award of costs, [regulation 5.20(6)](#) provides that the Commissioner may consider a failure by a party to file a summary of submissions as required by [regulation 5.20(4)](#).

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**Costs in Respect of Further Evidence**

The award of costs in respect of further evidence is in general based upon the merits of each case, that is, the costs will normally follow the event. However a factor that may vary the general rule is when the further evidence was filed. Thus, in *Mayfield v Radcliff* (1993) AIPC 90-962 further evidence was served on the day before the hearing; although the opposition succeeded on the basis of that further evidence, no costs were awarded. See also *Inexa, Industria Extractora C.A. v OmniActive Health Technologies Limited*[2013] APO 32, *GS Technology Pty Ltd v Davies Shephard Pty Ltd*[2000] APO 49.

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3.10 The Register of Patents

Modified Date: 02 April 2013

### 3.10 The Register of Patents

#### Relevant Legislation

**The Act**

- **Section 61** Grant of standard patent
- **Section 62** Grant and publication of innovation patent
- **Chapter 19** The Register and official documents
- **Section** Death of applicant or nominated person

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Effective Date: 25 September 2019
3.10.1 What is the Register?

The Commissioner of Patents maintains a Register of Patents containing details of standard patents and innovation patents. Patents are granted by entering particulars into the Register (sections 61 and 62).

The Register is prima facie evidence of any particulars registered in it (section 195(1)).

Pursuant to section 186(2), the Register may be kept wholly or partly by use of a computer. Until 9 February 2009, the Register was held solely in paper form, and entries in the Register were made manually. An alteration to an entry in the Register occurred by manually “striking through” a reference to the relevant entry and then making a notation as to the reason for the strike through. Therefore when a correction was made, all reference to the amended entry was not omitted; it was still possible to read the previous position. A copy of a paper Register entry can be obtained from the Commissioner.

From 9 February 2009, the Register changed to electronic form for all patents granted from 24 May 2001. These patents are covered solely by the electronic Register. The Register is embodied in a series of electronic databases where the particulars of patents are kept. Data is extracted from these databases and appears to the public via the AusPat system. What appears on AusPat is not the Register.

When required, an extract from the Register is produced as an automated function by extracting data from the source databases. This extract can be obtained from the AusPat system. The extract contains the same types of information that were recorded in the paper Register. The extract contains the most recent particulars in relation to the patent, as well as the details of the most recent change (if any) to a particular. Some Court orders do not presently appear in the extract. If required for the purposes of section 195(2), a signed copy of the extract from the Register can be obtained from the Commissioner, and is admissible in any proceedings as prima facie evidence of those particulars. Requests for a signed copy of

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an extract from the Register should be directed to IP Australia, through any of the normal communication channels.

The full Register differs from the extract in that it includes the full transaction history of the particulars that appear in the extract, and all Court orders. A full Register entry is not available as an automated function.

The Register is restricted to the particulars that are listed in 3.10.2, and does not include other information in relation to the patent that is stored in the electronic databases, such as the specification of the patent.

3.10.2 Recording Particulars in the Register

The particulars that are recorded in the Register are as follows:

- Patent number
- The name and address of the patentee(s)
- The name of the inventor(s)
- Title of the patent
- Term of the patent
- Date accepted
- Date granted
- Date of patent
- Status of the patent
- Expiry date
- Date ceased
- Date revoked
- Priority details
- Divisional and/or additional details
3.10.2.1 Recording New Particulars in the Register

- Alteration or correction of ownership details
- Mortgagee, licensee or other interests
- Transfer of entitlement to the patent or licence, or a share in the patent or licence
- Extension of term
- Restoration
- Court orders

At grant, the particulars applying at that time are entered into the Register.

Section 187 together with reg 19.1(1)(a) and (b) provide that entitlement or certain interests in a patent can be recorded in the Register. For that to occur, an application must be made in the approved form, and there must be proof to the reasonable satisfaction of the Commissioner (reg 19.1(2)).

To establish the applicant's particular title to, or interest in, the patent, the following are illustrative of material that may require to be filed:

- a deed of assignment signed by both the assignee and assignor
- a deed of sale
- a letter from the Registrar of a Court, or order of a Court dealing with appointment of receiver, and various supporting evidence in bankruptcy and liquidation actions
- a court order providing authority for transfer of title
- an authenticated copy of the grant of Probate, or Letters of Administration (note that the transfer cannot be to "the estate of X")
- mortgage documents (or a document signed by all relevant parties recording the existence of the mortgage)
- a licence agreement (or a document signed by all relevant parties recording the existence of, and any restrictions in, the licence)

In order for the Commissioner to have proof to his reasonable satisfaction, attested copies of all deeds and documents need to be supplied to the Commissioner for retention on the official file. It will be adequate authentication if the copy carries or has attached to it a signed
certificate to the effect that it is an accurate, or true, or correct copy of the original. Such a certificate may be given by any person who has compared the copy with the original; it need not be given by a Justice of the Peace, Notary Public, or other official. Where a document contains commercially sensitive information, a redacted copy of the document can be supplied to the Commissioner. However, portions relevant to the purpose for which the document is filed cannot be blanked out because the document would then be incomplete and misleading.

In recording an interest pursuant to reg 19.1, the Commissioner is required to enter "particulars of ...(the entitlement)". This will require a clear identification of the particular instrument - e.g. "licence agreement dated ...". The main function of the Register is to identify the proprietor, and it is less important how they became the proprietor (see Coflexip Stena Offshore Ltd’s Patent [1997] RPC 179 at 193). Consequently, the nature of the instrument need not be identified in detail.

Section 187 is specifically concerned with patents in force, but only in so far as the time at which the matter requiring recording in the register took place is concerned. That is, the Commissioner will record title to, or interest in, a patent whether or not it is in force - provided that title or interest arose while the patent was still in force. In circumstances where a patent has ceased and is subject to restoration proceedings under section 223, the Commissioner will not record any change in title or interest occurring after cessation until after the restoration of the patent. If the term of a patent has expired, the Commissioner will not record any change in proprietorship occurring after expiry unless and until the term of the patent is extended whether by way of extension of term or re-grant. See the judgements in:

- Re Usines de Melle’s Patent (1954) 91 CLR 42 and
- Re Sanofi’s Petition for Extension of Term (1981) 51 AOJP 2142.

Any documents filed pursuant to section 187 are available for inspection under section 193.
Assignment occurs when the patentee transfers their ownership to another person.

**Assignment by a Co-owner**

A co-owner of a patent cannot assign an interest in the patent without the consent of the other co-owners (section 16(1)). Before the Commissioner will record an assignment from a co-owner, he or she must be reasonably satisfied of their consent. Consent must be a positive act (such as by signing a document), not inferred from a failure to object: see Re Milward-Bason and Burgess (1988) AIPC 90-475. Also, an agreement between the parties which merely repeats the requirements of section 16(1) does not constitute consent.

**Assignment in part**

A patent may be assigned for a part of the patent area (section 14(2)) or for a limited period of time. If the assignment is for a period of time with a specified date for its conclusion, the Register will record that period. If there is no specified date for the end of the period, the Register will not record the conclusion of the assignment unless the relevant parties makes a request to so record.

There are some difficulties if an assignment is for only some of the claims of a patent. The only case law on this subject is *Dunnicliff v Mallet* 141 ER 795, where it was said that the nature of the interest of the assignee was a tenancy in common. However, in *Walton v Lavater* 141 ER 1127, where Erle CJ referred to *Dunnicliff* as decided "rightly or wrongly" (at page 1136). It seems unlikely that a tenancy in common is in fact created (as that is an equal interest in the whole of the patent). The preferred result is probably that rejected in *Dunnicliff*: a licence is created by attempting to assign the patent in part. The question is likely to be significant if the ‘assignee’ wishes to assign their interest, or to take infringement action. Recognising these difficulties, in such cases the Register will record the relevant
details as an ‘assignment/licence’. Similarly, if only some of the rights of exploitation are assigned (e.g. the right to make, but not the right to sell), then the effect of such an assignment is also probably to create a licence; and in such cases the Register will record the relevant details as an ‘assignment/licence’.

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**Assignment by a Minor/Infant**

It appears to be accepted that an infant or minor (i.e., a person under the age of 18 years) can own intellectual property and assign it: see re *D'Ambigou, Andrews v Andrews* (1880) 15 Ch D 222 and *Chaplin v Lesley Frewin (Publishers) Ltd* (1966) Ch 71. However, should the assignment be required to be by way of deed, this may not be effective as the disposition is voidable by the child when they come of age.

In the case of the *Patents Act*, the assignment is not required to be by way of deed, but is merely required to be in writing signed by or on behalf of the assignor and assignee (*section 14* of the Act).

The Patents Act provides a system for granting patents by registering prescribed particulars of the patent in the Register (*sections 61 and 62*). Generally where there is a system of registration of title it would be expected that once registration has occurred, be it the grant of a patent or an assignment, there would be no power to transfer the interest back in the absence of an order of an appropriate court.

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**Evidence required**

An assignment must be in writing, signed by, or on behalf of the assignor and assignee (*section 14(1)*). There is no basis to waive this requirement merely because it is not a requirement in the country in which the assignment was executed.

A mere parol agreement could not be registered because the Commissioner would not receive it, but a subsequent memorandum in writing between the parties may be capable of registration (*In the Matter of Fletcher's Patent* 10 RPC 252).

The Commissioner does not necessarily require a copy of an assignment that sets out commercial dealings between the parties. All that is required is a document signed by the assignee and assignor that makes clear that the specified patent has been assigned.
Of course, the assignee can file a copy of a 'commercial' deed of assignment as proof. A photocopy is sufficient for this purpose. If the deed is defective, it is possible to file a declaration by all the parties to the assignment as to what they had intended by the deed. It may be possible to obtain information about what the deed should have said (i.e. what the intention of the parties was) from other sources, but it must be sufficient to achieve a reasonable satisfaction of the entitlement of the person (see the file of patent 535211). In the case *Westpac Banking Corp v Dawson* (1990) 8 ACLC 681 it was held that an accidental mistake in the name of a party to a contract does not invalidate the contract.

Where the assignee has changed their name between the date of assignment and registration, the Commissioner will require appropriate evidence of the name change sufficient to establish that the assignment is being recorded to the correct person. Documents filed as evidence should be accepted on their face. No substantial investigation is required, and the Commissioner must not go behind the Register to check the entitlement of the recorded patentee. (See *George Stack v State of Queensland* [1996] FCA 739).

An agreement executed before the grant of a patent may be capable of being registered on the Register, though there may be a great many obstacles to registering such a document (see *In the Matter of Parnell's Patent* 5 RPC 126, and 27 RPC Comptroller's Ruling E: “an assignment of a patent dated before its grant operates only as an equitable assignment, but notice of the interest of assignment may be entered on the Register”). It appears that an assignment can be registered if it is clear that the patent, when granted, is to be assigned. The document needs to be clear and precise. Note that section 113 is available before grant.
Register of Patents. Where the Commissioner receives a request to record a trustee in bankruptcy in the Register, the trustee is to be recorded provided there is relevant proof - such as a sequestration notice or other document or order declaring the current holder of patent rights bankrupt. As there will be no deed of assignment, the entry should refer to the sequestration order or other document as giving rise to the trustee's entitlement.

When dealing with a request by a trustee in bankruptcy to be recorded on the Register, the following points should be noted:

1. Before recording a transfer to a trustee, the Commissioner must check that the patent is the property of the bankrupt (is the bankrupt recorded as the patentee, is there joint ownership of the patent).

2. Recording the fact that the person is a trustee is inappropriate, as this is recording notice of a trust.

3. Information extracted from the National Personal Insolvency Index is prima facie evidence of the facts listed (Bankruptcy Regulations 1996, reg 13.10).

**Note 1:** The assignment of a bankrupt’s property to his trustees in bankruptcy (or whoever is the representative of his creditors) under the law of a country which has jurisdiction over his person operates as an assignment of the movables of the bankrupt wherever locally situate, but only to the extent where the assignment is made in accordance with the laws of the situ of the movables (Radich v Bank of New Zealand (1993) 45 FCR 101).

**Note 2:** The effect of bankruptcy on the ownership of a patent was discussed by the Administrative Appeals Tribunal in the matter of Reilly v Commissioner of Patents 36 IPR 314. In that case, the patentee became bankrupt after the patent was granted. The patent ceased through non-payment of the renewal fee. Issues arising were who was responsible for paying the fee, whether the patent belonged to Reilly or his trustee in bankruptcy, and whether the trustee in bankruptcy can be entered on the Register. The following is the portion of that decision that dealt with the bankruptcy issues:

“29. Mr Hanson has submitted that the property in the patent has passed to the trustee. That would amount to an assignment by law rather than a voluntary assignment by Mr Reilly. Whether or not that has occurred depends on the operation of the Bankruptcy Act.

30. Sub-section 116(1) of the Bankruptcy Act provides, in so far as it is applicable to this case, that

“(1) Subject to this Act:

(a) all property that belonged to, or was vested in, a bankrupt at the commencement of the bankruptcy, or has been acquired or is acquired by him, or
has devolved or devolves on him, after the commencement of the bankruptcy and before his discharge;

... is property divisible amongst the creditors of the bankrupt.”

Sub-sections 116(2)-(8) qualify the general provision of sub-section 116(1) but they are not relevant to the circumstances of this case.

31. The word ‘property’ is defined in sub-section 5(1) to mean

"... real or personal property of every description, whether situated in Australia or elsewhere, and includes any estate, interest or profit, whether present or future, vested or contingent, arising out of or incident to any such real or personal estate."

As a patent is personal property (see paragraph 20 above), it is among the property which is divisible among the creditors of a bankrupt person.

32. Section 138 of the Bankruptcy Act limits the trustee's power in respect of certain industrial property. It applies to the situation in which the bankrupt person is liable to pay royalties or a share of the profits to a person in respect of those rights. While it underlines the fact that a patent is amongst the property which passes to the trustee, section 138 does not apply to a situation in which the bankrupt person is the grantee of the patent as was Mr Reilly.

33. Section 116 identifies the property which is available for distribution among the creditors but it is left to other provisions of the Bankruptcy Act to deal with the manner in which the trustee takes possession of the property and realises it. Subsection 129(1), for example, provides that the trustee shall forthwith take possession of all property capable of manual delivery. Possession is different from proprietary rights. Those rights are the subject of section 132. Subsection 132(1) provides that, where a trustee is appointed by the creditors, the property of the bankrupt passes to and vests in the trustee.

34. Sub-sections 132(2) provides generally that

"Subject to this section, the property of the bankrupt passes from trustee to trustee and vests in the trustee for the time being during his continuance in office or, if the Official Trustee becomes the trustee, in the Official Trustee, without any conveyance, assignment or transfer."

35. Sub-section 132(3) provides for an exception to the general position. It provides that:

"Where a law of the Commonwealth or of a State or Territory of the Commonwealth requires the transmission of property to be registered, and enables the trustee to be registered as the owner of any such property that is part of the property of the..."
bankrupt, that property, notwithstanding that it vests in equity in the trustees by virtue of this section, does not vest in the trustee at law until the requirements of that law have been complied with."

36. It is clear from the provisions of section 187 of the Patents Act and regulation 19.1 of the Patents Regulations that I have already set out (see paragraphs 22-24 above), that particulars of a transfer of an entitlement to a patent must be registered. From the provisions of section 188 of the Patents Act it is equally clear that notice of "any kind of trust" is not registrable.

37. Section 187 and regulation 19.1 are provisions which require the transmission of the patent to be registered within the meaning of sub-section 132(3) of the Bankruptcy Act. The transmission of the patent to the trustee in bankruptcy would, therefore, have to be registered before it vests in him at law. This is not altered by section 188 for that does not prevent the trustee from being registered as the owner. It simply states that notice of a trust may not be registered. It follows that the patent vested in equity in the trustee in bankruptcy but did not vest in him at law as I am satisfied on the evidence that the trustee was not entered on the Register of Patents in any capacity at all.

38. So long as the trustee did not have his name entered on the Register of Patents as the proprietor of the patent, this patent vested in him in equity but he could not be regarded as the 'patentee'. As is clear from the definition of 'Patentee' (see paragraph 19 above), a finding that a person is a patentee is not dependent upon his legal or equitable interest in the patent but upon his being entered in the Register of Patents as either the grantee or as the proprietor. As the trustee is not entered as the proprietor (even though he would be entitled to be entered), the patentee must continue to be Mr Reilly. It must be Mr Reilly, therefore, who as the patentee, could pay the renewal fee.”
3.10.2.2.5 Death of Patentee

a company, which should occur before the company is deregistered. If a company has been
deregistered before the assets have been distributed, then generally the company will need
to be reconstituted so that the assets can be distributed in accordance with law. Assertions
by the 'former directors' of the company that the rights in a patent belong to them following
deregistration are inadequate; there needs to be a formal assignment from the company to
themselves - and this cannot occur after the company has been deregistered. If an
assignment is executed after deregistration, it will need to be re-done once reinstatement
occurs (since entry on our Register does not establish validity of title). However, in some
circumstances it is possible for ASIC to execute the assignment on the company's behalf.

Where an applicant company was wound up before the patent was granted, the
Commissioner can amend the Register under section 215(3) to substitute the name of the
person to whom the patent should have been granted. Regulation 22.9 specifies that
suitable evidence must be filed to support such an amendment.

If a patentee died before the grant of a patent, the Commissioner can amend the Register
under section 215 to substitute the name of the person to whom a patent should have been
granted. Regulation 22.9 specifies that suitable evidence must be filed to support such an
amendment.

Where a patentee dies after the grant of a patent, the ownership of the patent will be
devolved according to the will of the patentee.

A patent cannot proceed in the name of "the estate of X". See Trivett Classic Pty Ltd v

The Personal Property Securities Act 2009 established a national online PPS Register with
electronic registration and search processes. The PPS Register replaces over 40 different
registers of security interests in Australia, including the Register of Patents.
3.10.2.4 Licences

The Personal Property Securities (Consequential Amendments) Act 2009 amended the Patents, Trade Marks, Designs and Plant Breeder’s Rights Acts to change the recording of security interests against these rights and standardise the rules of priority.

Accordingly the Register of Patents is no longer a legal securities Register.

From 30 January 2012, mortgages and other security interests newly recorded on the Register of Patents may have no legal effect. Existing and new security interests over patents need to be recorded by the secured party on the PPS Register.

Security interests previously recorded on the Register of Patents were not automatically migrated to the PPS Register. Secured parties that had interests recorded on the Register of Patents have a transitional period of 24 months to 30 January 2014 in which to record those interests on the PPS Register and maintain their priority. All new security interests must be recorded on the PPS Register from 30 January 2012.

Secured parties will continue to be able to record their interests on the Register of Patents. This will enable registrants to receive notifications, be given an opportunity to be heard, or given the opportunity to make submissions, where appropriate. Parties will need to obtain their own advice on whether they also need to register their interest on the PPS Register.

3.10.2.4 Licences

There are two major types of licences:

- sole licences: prohibit the patentee granting other licences, but the patentee is allowed to exploit the invention
- exclusive licences: only the licensee, and persons authorised by him, can exploit the invention.

It is the instrument that creates the exclusive licence, not registration (Vitamins Australia Ltd v Beta-Carotene Industries Pty Ltd (1987) AIPC 90-417 and Grant v Australian Temporary Fencing Pty Ltd [2003] QSC 194).

3.10.2.5 Court Orders

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Effective Date: 25 September 2019
3.10.2.6 Equitable Interests

Regulation 19.1 identifies three categories of orders that are to be recorded on the Register: orders under section 105, orders under Chapter 12, and orders made on appeal in relation to a patent.

Orders issued under Chapter 12 of the Patents Act are to be served on the Commissioner by the Registrar of the Court (see section 140). In practice these orders are provided by one of the parties rather than the Registry, and the Commissioner does not insist that they be served by the Registrar.

3.10.2.6 Equitable Interests

There is no problem with registering legal interests, but equitable interests presents a problem. The distinction that needs to be drawn is between a document which deals with the patent, and in doing so creates a trust, and a document which simply declares the existence of a trust (eg. a declaration of trust). The former are registrable and the latter are not.

Stewart v Casey 9 RPC 9:

"you must draw a distinction between agreements and other things which do affect the proprietorship and simple notices of trust ... notice of trust is not to be put on, documents which affect the proprietorship, whether by creating trusts or otherwise, are not to be excluded" (at page 11)

"equitable assignments for a patent, or of a share in a patent, may be entered on the register" (at page 13)

"The rights of proprietorship are purely legal rights; but any other rights – any right that may appear on the register - must therefore be, if not a legal right to proprietorship, either a legal right of some lesser description or an equitable right, and, therefore, it seems to me to be plain that the legislature contemplated the prescription by the Rules of a power to enter on the register, rights which are not rights of proprietorship, including equitable rights." (at page 16)

"it is impossible to say that the fact that this equitable assignment may create a trust prevents it from creating an interest within the meaning of the word used in the Rule or a right within the meaning of the 87th Section which would preclude its being put on the register." (at page 16)

Haslett v Hutchinson 8 RPC 457
3.10.2.7 Effect of Registration or Non-Registration

"unless the plaintiffs are in a position to obtain specific performance, they are not a shadow of interest, legal or equitable" (at page 466)

3.10.2.7 Effect of Registration or Non-Registration

In this topic:

Registered interests

The Register does not provide a system of title by registration. Rather the Register is a system of registration of interests of which the Commissioner has been notified; upon the receipt of evidence sufficient to satisfy the Commissioner of the interest that is to be registered, that interest must be entered in the Register. Evidence is not sufficient if it is considered to be incomplete or misleading to the public.

A patentee may deal with the patent, subject only to the rights appearing on the Register (section 189). However, the Register is not definitive proof of ownership of rights. Rather, as is specified by section 195(1), the Register is prima facie evidence of any particulars registered in it in (section 195(1)).

In Stack v Brisbane City Council [1999] FCA 1279 the court stated:

"38 The underlying policy of the Act is to deal with ownership of a patent by registration of the original grant and by registration of any subsequent dealings in or with the patent in the Register. The scheme is to treat the registered proprietor as the owner of the patent subject to any interests in it created by the owner and registered in the Register and thereby to ensure some certainty and finality as regards title to patents: Stack v the State of Queensland (1996) 68 FCR 247 at 251-2 citing with approval Martin and the Miles Martin Pen Coy Ld v Scrib Ld (1950) 67 RPC 127 at 133. Registration in the Register, while prima facie evidence of any particulars registered in it (s 195) and prima facie evidence of entitlement to ownership of the patent says nothing as to the validity of the patent.

39 Disputes as to ownership of patents and interests held in or over them are to be resolved primarily, but not exclusively, in proceedings for rectification of the Register between the rival claimants to the property interests; s 192. Such proceedings
3.10.2.7 Effect of Registration or Non-Registration

assume the continued existence of the patent, with patent rights being held by those properly entered in the Register."

Note: The Register does not record caveats. Further, there is no procedure for notifying interested parties as a condition precedent to the registration of an interest.

Unregistered interests

It follows from section 189 that an unregistered interest may be defeated by a legitimate dealing with the patent. This provision was discussed in Using Intellectual Property as a Security Australian Intellectual Property Journal Vol 7, page 135, Aug 1996, where it was argued:

“... s.189(1) is also relevant to conflicts between two unregistered interests. Under s.189(1), the holder of a subsequently arising interest is entitled to deal with the patent as the “absolute owner” of the patent. Although absolute owner is not defined, it presumably means free of prior interests (unless, of course, they are registered). In consequence, the subsequently created interest will always prevail over the prior unregistered interest, even if the subsequent interest does not itself ever get registered. The result is a curious perversion of the usual priority rules. Under s.189(1), priorities between successive unregistered interests in patents are resolved in favour of the last to be created interest. As a result the only way to prevent an interest in a patent being defeated by a subsequent interest, registered or unregistered, is to register the interest promptly after creation.”

It may thus be seen that the failure to record an assignment (or any other registrable matter) is at the assignee’s peril. The only remedy available to a person who fails to record their interest, if that interest is affected by the subsequent registration of another interest, is to take action before the courts to establish that they indeed have an equitable interest, and seek to have the Register rectified. The Commissioner is unable to otherwise take any action to record the earlier interest.

Other issues resulting from non-registration are:

- a document which has not been registered is not admissible in any proceedings in proof of the title to a patent or to an interest in a patent unless the court or tribunal otherwise directs or the proceedings are for an order for rectification or to enforce an equity (section 196). A court has the power to admit an unregistered instrument (Martin Engineering Co v Matflo Engineering Pty Ltd (1987) AIPC 90-430)
• situations can arise where an equitable owner wishes to take infringement proceedings. As the right to take action for infringement belongs solely to the registered proprietor of the patent, the equitable owner cannot bring the action in their name. However they can bring the action in the name of the registered owner if they provide the registered owner with appropriate indemnities (Stack v Brisbane City Council (No 2) 35 IPR 296.)

• unregistered equities may be enforced against the patentee except to the prejudice of a bona fide purchaser for value without notice (section 189(3)).

Entitlement of Later Registered Patentee

The entitlement of an assignee is determined by reference to the eligibility of the original grantee under section 15. Any subsequent holder of the title to the patent stands in the shoes of the person from whom title was acquired by assignment or by devolution of law. No holder in the chain of title obtains a better entitlement to the patent than the immediate predecessor in the chain and ultimately of the original grantee. If at the time of filing the applicant had full entitlement to the invention, any assignments that occur after filing and before grant can be recorded at any time - including after grant. Note that a patent is not invalid merely because it was granted to a person who was not entitled, or was not granted to a person who was entitled (section 22A).

Assignment of a Patent when there is a Registered Interest

It will sometimes happen that a patentee will assign a patent in respect of which there is a registered interest, such as a licence or a mortgage. Provided the evidence of the assignment is sufficient to satisfy the Commissioner of the entitlement of the assignee, the assignment is to be recorded.
Section 188 of the Patents Act provides that:

“Notice of any kind of trust relating to a patent or licence is not receivable by the Commissioner and must not be registered.”

A trust relationship arises where a person has property or rights which they hold or are bound to exercise for or on behalf of another for the accomplishment of some particular purpose.

The requirement that a trust is not receivable means no more than the Commissioner is precluded from ‘receiving’ the trust in the same way as a court would ‘not receive’ inadmissible evidence. That is, a notice of trust can be placed before the Commissioner, but the Commissioner can not act upon such a notice to alter the registered particulars. Nor is the Commissioner obliged to consult or seek the approval of beneficiaries if a trustee who is registered, assigns or takes other actions in regard to those rights.

The requirement that a notice of trust must not be registered does not exclude registration of a trustee if the trustee holds the legal interest in the patent rights. Section 188 merely prevents notification of the trust or details of the trust being recorded. That is, section 188 permits trustees who have good title to the legal interest in the rights to be registered, the Commissioner being obliged to record the details of those prima facie so entitled without noting the trust relationship.

Thus, where a request is made to record a trustee in the Register, the trustee can be recorded so long as the usual requirement for supporting evidence has been met. The Register entry should make no reference to the person's status as trustee. Any provisions in a deed of assignment setting out obligations as between the trustee and the beneficiaries of that trust are not relevant and must not be recorded in the Register.

Section 191 of the Patents Act provides:

“A person must not knowingly or recklessly:

(a) make a false entry in the Register; or

(b) cause a false entry to be made in the Register; or

(c) tender in evidence a document that falsely purports to be a copy of or extract from an entry in the Register.”
‘Recklessly’ has been held to “mean something more than mere negligence or inadvertence. .... means deliberately running an unjustifiable risk” Reed (Alber E) & Co Ltd v London and Rochester Trading Co Ltd [1954] 2 Lloyd’s Rep 463. Carelessness whilst of itself may not be recklessness, could be considered an element of recklessness; gross carelessness may be recklessness. Substantially, recklessly implies that a person has no real basis of facts on which to support the statement.

‘Knowingly’ may refer either to an intentional untruth, or wrong fact. It probably requires a mental element, not merely that the facts are untrue.

Section 191 is a penal provision of the Act. Where such a situation exists, section 191 does not provide a mechanism for rectification of the Register. However the facts that would support an action under section 191 would almost certainly support a separate application for rectification of the Register.

3.10.3 Amendment of the Register

Modified Date: 03 July 2017

3.10.3 Amendment of the Register

The Register is not a filed document, so cannot be amended under section 104. Updating the Register to record new particulars (e.g. transfers of ownership, licences, mortgages, Court orders) is effected under section 187. Where the Register contains an error or omission, this can be rectified under section 191A.

Section 191A allows the rectification of a wide range of errors in the Register. A request under section 191A must be in the approved form (reg 10.7). Where the error relates to entitlement, there are specific procedures that the Commissioner must follow (see 3.10.3.3).

In addition, Courts have the power to correct errors under section 192.

The Commissioner cannot make a declaration or rectify the Register while relevant proceedings are pending (see section 191A(5)). The Commissioner will not take any action to process such requests until the proceedings are finalised, as the parties can utilise section 192 to achieve the same outcome.
3.10.3.1 Procedure on Receipt of an Application for Recitification

In this topic:

Section 191A can be invoked by the Commissioner of her own volition, or on the request of a party.

Commissioner initiated rectification

Generally the Commissioner will only initiate rectification of the Register to correct errors by staff of the Patent Office. For instance, where it is apparent that information provided by the patentee at filing was not accurately transcribed into the official record systems that constitute the Register (i.e. there was a clerical error), then the Commissioner will initiate rectification.

Pursuant to section 191A(4), the Commissioner will inform the patentee of the intended rectification and give them an opportunity to be heard (pursuant to reg 22.22).

There is no requirement to advertise an intention for the Commissioner to rectify the Register of her own volition.

Patentee requested rectification

Most commonly, rectification of the Register will be requested by the patentee. Under reg 10.7(3), the Commissioner will advertise the receipt of a request for rectification EXCEPT if the rectification relates to:

- the address of the patentee
- the name of the patentee (but not the identity of the patentee)
- the title of the patent
- an obvious mistake in the Register
3.10.3.2 Amendment of Errors (excluding Entitlement Disputes)

- alteration that does not materially alter the meaning or scope of an entry in the Register

Advertising gives third parties an opportunity to request to be heard in relation to the rectification.

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**Third party requested rectification**

Where a third party requests rectification of the Register, the Commissioner will inform the patentee of the request. In addition, the Commissioner will advertise the receipt of the request for rectification to give the patentee and other parties an opportunity to request to be heard (in the same way as described above).

3.10.3.2 Amendment of Errors (excluding Entitlement Disputes)

The Commissioner can rectify the Register in the case of:

- an omission of an entry from the Register
- an entry made in the Register without sufficient cause
- an entry wrongly existing in the Register
- an error or defect in an entry in the Register.

These matters will be referred to collectively as errors or omissions. Errors relating to entitlement are discussed at 3.10.3.3.

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Effective Date: 25 September 2019
3.10.3.2.2 Discretionary Considerations

The range of errors that can be corrected under section 191A is very wide. For instance:

- Change of name or address of the patentee
- Clerical errors by either the patentee or the Commissioner
- Obvious mistakes in the Register
- Insertion of priority information
- Insertion of inventor information
- Remove any reference to an extension of term to which the patentee was not entitled.

A merger of two companies to produce a new entity (with a different name or the same name as one of the original entities) can be recorded under section 191A.

However, section 191A cannot be used to revoke a patent by expunging an entry from the Register entirely (Arbitron v Telecontrol Aktiengesellschaft [2010] FCA 302).

The recordal of new particulars, such as an assignment or licence, is specifically provided for by section 187, and is not necessary to utilise section 191A for such matters.

In this topic:

Section 191A is a discretionary power. Consequently it is necessary to have regard to all relevant factors, in order to decide whether (on the balance of probabilities) there is sufficient reason to make the rectification.

Matters that can be relevant are:

- Is there an error in the Register
- The purpose of the rectification
- Delays in making the rectification
- The consequences of making the rectification
- Whether there has been a disclosure of all relevant matters
Is there an error in the Register?

Section 191A is predicated on the existence of an error or omission in the Register. Consequently, the Commissioner will need to be satisfied that:

i. the Register is in error, and

ii. the alteration will rectify that error.

It is the responsibility of the patentee to establish these basic facts.

Where the patentee cannot establish, on the balance of probabilities, that there is an error in the Register, and that the alteration would rectify that error, then the Commissioner will not make the alteration.

For instance, if the patentee requests a change in the inventor listed on the Register but it is uncertain who is the actual inventor, then it is neither clear that the Register is in error, nor that the alteration is a rectification.

A declaration will usually be necessary to satisfy the Commissioner that there has been an error. However where the error is self-evident, such as where an alteration to the title is sought and the former title is clearly inadequate, extensive evidence will not be required.

The purpose of the rectification

Where the error in the Register arose unintentionally, and as a result of an accidental error by the patentee or the Commissioner, that is a consideration that lies in favour of allowing the rectification.

In this regard, the concept of an error or omission developed in relation to section 223 is relevant. The decision of Jenkinson J in Kimberly-Clark Ltd v Commissioner of Patents (No 3) 13 IPR 569 provides useful guidance:

"the word 'error' is not easily assigned a clear meaning restricted by reference to one or several particular categories of flawed mental function. The attempt is likely to lead to the drawing of fine and often unrealistic distinctions. And some errors of judgement
by agents and attorneys may be as bizarre and as little to be anticipated as lapses of memory and accidental slip. …"

"By no means every judgement … which can be shown to have been mistaken will answer the description "error or omission" in the ordinary meaning of those words"

On the other hand, where the error in the Register was the consequence of a deliberate decision, and there has been a subsequent change of mind, that is a consideration that lies against allowing the rectification.

---

### Delay in correcting the error

The Register is a publicly available record of important information in relation to patents. Consequently, it is not in the public interest for the Register to be inaccurate, or for it to remain inaccurate for any longer than is necessary.

Errors in the Register generally arise from the provision of inaccurate information by the patentee either at filing of the application or during prosecution. The period between the provision of the inaccurate information (or the omission to provide relevant information) and the rectification of the Register needs to be explained and considered.

It is particularly important to consider the length of time between discovering the error in the Register and seeking rectification. Consequently it is expected that where such a delay has occurred an explanation in declaratory form will be provided.

---

### Consequence of the alteration

Some changes to the Register have significant consequences. For instance, the addition of a priority claim may convert an invalid patent into a valid patent - which could significantly affect the public.

Where the rectification of the Register is likely to have a significant impact on third parties, that is a consideration that lies against allowing the rectification.

In other instances an alteration would be inconsistent with other provisions of the Act or Regulations. For instance, an alteration to include a claim to divisional status where the parent case was lapsed at the time of filing the present patent. Since the claim to divisional
status would be invalid, it would be inappropriate to alter the Register to include an invalid claim.

Other situations would be the inclusion of a basic document that was filed more than 12 months before the filing date of the present patent. Since the priority claim could not be valid, it would be inappropriate to alter the Register to include an invalid priority claim.

Additionally, in a situation where an alteration would remove a patent of addition status, it is likely that the patent would immediately become invalid as lacking inventive step in the light of the "parent" patent. It would be inappropriate to allow such an alteration.

Has there been a disclosure of all relevant considerations?

Finally, it is incumbent on a patentee to disclose all relevant matters relating to the error or omission in the Register. Where a patentee fails to do so, that lies against allowing the rectification.

3.10.3.3 Entitlement Disputes

Section 191A empowers the Commissioner to make a declaration as to a person's "entitlement to a patent, or a share in a patent". Thus, where the Commissioner is satisfied that a patent was granted to the wrong person or persons, she may correct the ownership details recorded in the Register. See 3.2.8.
3.11 Extensions of Time and Restoration of the Right of Priority

- an entry wrongly existing on the Register
- an error or defect in an entry.

See for example *Lundbeck A/S v Alphapharm Pty Ltd* [2009] FCAFC 70 where the court ordered that the Register should be rectified by the omission from it of any reference to an extension of term of a patent to which the patentee was not entitled.

However, the court cannot expunge an entry from the Register.

See *Arbitron v Telecontrol Aktiengesellschaft* [2010] FCA 302 at [175] where Emmett J stated that:

“The Register of patents is merely a public record of rights and their history. Thus, entries in the Register are never removed. Rather, they are only ever altered in a way that shows what changes have occurred. Even when the patent is revoked by order of a court, the entry in the Register is not removed. Rather, the entry is marked and endorsed with the terms of the order.”

### 3.11 Extensions of Time and Restoration of the Right of Priority

Modified Date: 01 July 2015

#### Relevant Legislation

**The Act**

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**The Regulations**
3.11 Extensions of Time and Restoration of the Right of Priority

Reg 5.9 Extension of time for filing evidence

Reg 5.10 as in force immediately before 15 April 2013 Conduct of proceedings to which this Act applies

Reg 5.22 Commissioner may give directions

Reg 22.24 Practice and procedure other than for opposition proceedings

Overview

The Patents Act and Regulations contain provisions allowing the Commissioner to extend the time for performing specific actions in certain circumstances. Where the time for performing an action is extendible under the legislation, the nature of the action will determine which provision applies.

Section 223, reg 5.9, and reg 5.10(2) as in force immediately before 15 April 2013, are exclusively extension of time provisions. Extensions under these provisions are discussed more fully in the following sections. See 3.11.1 Extensions of Time – Section 223, 3.11.2 Extensions of Time – Regulation 5.9, and 3.11.3 Extensions of Time – Reg 5.10.

The more broadly applicable direction provisions of reg 5.12 and reg 5.22 may be used to extend time periods during procedural oppositions commenced on or after 15 April 2013 (see 3.3.1 Directions in Opposition Proceedings). Similarly, reg 22.24 may be used to extend time periods where the Patents legislation authorises the Commissioner to hear and decide a matter that is not an opposition (e.g. in proceedings under sections 33, 34, 35, 36 see 3.2.8 Entitlement).

In its role as a Receiving Office or International Searching Authority (ISA), IP Australia considers applications under the PCT Rules to restore the right of priority where an international application is filed after the end of the normal 12-month priority period. See 3.11.4 Restoration of the Right of Priority under the PCT.
The relationship between regulation 5.9 and section 223

Section 223 is universally applicable, except in respect of prescribed actions (see section 223(11) and reg 22.11). The prescribed actions that are excluded from the operation of section 223 are:

- any action in Chapter 5 of the Regulations, except the filing of a notice of opposition (under reg 5.4 or reg 5.10) or the filing of a Statement of Grounds and Particulars (under reg 5.5 or reg 5.11);

- filing an application for an extension of term of a pharmaceutical patent AFTER the normal term of the patent has expired; and

- any action in Chapter 20 of the Regulations.

Regulation 5.9 allows the Commissioner to extend the time for an “evidentiary period” specified in reg 5.8. Regulation 5.9 does not permit the extension of any other time period specified in Chapter 5.

Consequently, there are no time periods where both section 223 and reg 5.9 can apply. Also, there are some time periods that cannot be extended by either provision. As the tests applying to section 223 and reg 5.9 are different, it is essential to determine which extension provision is applicable to the situation.

3.11.1 Extensions of Time - Section 223
The Regulations

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Introduction

Each of the *Patents, Trade Marks*, and *Designs Acts* contain specific provisions for extensions of time. While there are some similarities in the general principles of law applicable to granting extensions of time, the specific provisions of the individual Acts differ.

The legal precedent for section 223 arises from extensions considered under this section of the *Patents Act 1990*; the corresponding provisions of section 160 of the *Patents Act 1952*; and, in some circumstances, under the equivalent provisions of the *Trade Marks Act*.

Section 223 is universally applicable, except in respect of prescribed actions (see section 223(11) and regulation 22.11).

Regulation 22.11(1A) and (1B) deal explicitly with the situation where a request is made to do a future act, and that request is opposed. The period of the extension must be extended by the Commissioner to cover the time lost because of the opposition.

Protection or Compensation Provisions

The provisions in section 223(9) and (10) and regulation 22.21 provide for the protection or compensation of parties who exploited an invention in a patent application that had lapsed or a patent that had ceased, but was restored as the result of an extension of time being given.
3.11.1.1 Relevant Act

Overview

The Commissioner can only extend the time period under section 223 for doing a relevant act. Section 223(11) defines this term:

*relevant act* means an action (other than a prescribed action) in relation to a patent, a patent application, or any proceedings under this Act (other than court proceedings), and includes the making of a Convention application within the time allowed for making such applications.

The prescribed actions for which extensions under section 223 must not be granted include:

- any action mentioned in Chapter 5 of the Regulations (oppositions provisions), other than filing a notice of opposition or statement of grounds and particulars;
- filing an application under section 70(1) for an extension of term of a pharmaceutical patent after the normal term of the patent has expired (Aspen Pharma Pty Ltd and Ors and Commissioner of Patents and H Lundbeck (Joined Party) [2012] AATA 851; followed in Merck Sharp and Dohme Corp and Commissioner of Patents [2013] AATA 71);
- any action in Chapter 20 of the Regulations (these relate to the registration, privileges and professional conduct of patent attorneys).

“relevant act that is required to be done within a certain time”
3.11.1.2 Subsection 223(1) - Office Error

The time can only be extended for those acts for which there is a legislative requirement that the act be done within a certain time.

Thus, in *Ashmont Holdings v Nature Vet and American Home Products* [2001] APO 43, section 223(2) was considered to be applicable to extend the time period prescribed by reg 2.3(2) for filing a complete application for the purposes of section 24(1)(b).

However, in *Norman Stibbard v The Commissioner of Patents* 7 IPR 337, the AAT upheld the delegate’s decision to refuse an extension of time to lodge a complete patent application where no earlier priority rights existed, on the basis that there was no time period in the legislation that was not complied with.

Other actions that do not constitute a ‘relevant act’ for the purposes of section 223; and the time for which cannot be extended under section 223 include:

- making a micro-organism deposit under the Budapest Treaty;
- where examination was requested prior to 15 April 2013, filing an examination response within 12 months from the date of the examiner’s 1st report.
- requesting examination wherein an applicant seeks an extension of time to avoid the application of amended legislation (*Sunesis Pharmaceuticals Inc V Commissioner of Patents* [2015] FCAFC 29)

**Note:** Extensions of time under section 223(1) can only be granted by the Deputy Commissioner (OEP)

In this topic:

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**Overview**

Section 223(1) is as follows:
(1) The Commissioner must extend the time for doing a relevant act that is required to be done within a certain time if the act is not, or cannot be, done within that time because of an error or omission by:

(a) the Commissioner or a Deputy Commissioner; or

(b) an employee; or

(c) a person providing, or proposing to provide, services for the benefit of the Patent Office;

(d) the receiving Office; or

(e) the International Bureau of the World Intellectual Property Organization

The power to grant an extension under this subsection is not discretionary once it has been established that an error or omission on the part of a person or office identified in section 223(1) caused a failure to do a relevant act within the required time.

For the meaning of “relevant act” see 3.11.1.1

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**Patent Office error**

The duties of all employees at IP Australia employed under the *Public Service Act 1999*, include the duty to assist the Commissioner of Patents to perform his or her function. Therefore, an error or omission by any one or more employees of the Patent Office, provided that it caused a failure to do a relevant act in the required time, could form the basis for an extension of time under section 223(1).

---

**Errors by the Receiving Office or International Bureau**

Sections 223(1)(d) and (1)(e) allow for the grant of an extension pursuant to an error or omission by the Receiving Office (RO) or the International Bureau (IB) in relation to a PCT application. In this context, the extension would need to relate to some act required to be done in relation to the PCT application in the national phase before the Patent Office.

Where an extension is sought based on actions by the IB or an overseas RO, unless the error or omission is evident from the Australian casefile or Patentscope, the onus will rest...
with the applicant to provide evidence to establish the "error or omission" by the relevant authority.

Where there is an allegation that an RO or the IB has made an error, the applicant may be in dispute with the RO or IB over the existence of the error or omission. If so, the Commissioner will not be in a position to conclude that there has been an error or omission by the RO or IB in the absence of manifestly clear and unambiguous evidence.

---

**Investigation of the error or omission**

If the Patent Office identifies a need for an extension of time under section 223(1), or if an applicant/patentee does so and notifies the Commissioner, the circumstances surrounding any error or omission by a person at the Patent Office can, in many cases, be investigated by the Office itself.

The delegate considering the section 223 request should make enquiries with the appropriate areas to determine whether an error or omission was made by a person at the Patent Office, and whether it led to the relevant act not being done in time.

Where there is sufficient evidence on the case file or elsewhere at the Patent Office to support an extension of time, it is not necessary that the applicant/patentee file a declaration in respect of the error or omission. However, in some circumstances a declaration is required.

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**Where a declaration is necessary**

It is sometimes necessary that a declaration is filed by the person requesting the extension setting out the grounds upon which the request is made. The approved form of a declaration under the *Patents Act* can be found on the [IP Australia website](https://www.ipaustralia.gov.au) as can the approved form for an "Application for an extension of time under section 223" (available).

If, for example, a person misses a time limit as a result of receiving misinformation from the Office, it will normally be necessary to provide a declaration stating that the person relied on the incorrect information. It is also expected that the applicant has acted in good faith in relying upon our representations of the facts.
As a further example, it has happened that an attorney has acted on the basis of information obtained from the Patent Office electronic information system at a time when incorrect data had been entered on the system by an Office employee. At the time the application for extension was received, that data had been corrected, so there was no way the delegate of the Commissioner could verify the attorney's allegation. The problem was resolved by the attorney filing his own print out (including the incorrect data) annexed to an explanatory declaration.

**Causative error**

A finding that there has been an error or omission is not, in itself, enough to require the grant of an extension of time. There must be a causal link between the error or omission and a relevant act that is required by the legislation to be done within a certain time, but which is either not done or cannot be done within that time.

Errors by a person which are claimed to be due to incorrect advice from the Commissioner will generally fall under section 223(1) if the person:

- sought advice from the Commissioner;
- in seeking the advice, provided all relevant information, or provided sufficient information for the Commissioner to realise that further information was required before providing the advice;
- the advice given was demonstrably wrong;
- the applicant acted on that wrong advice; and
- as a result, a relevant act was not done within the required time.

See *R Thomas & A Gamham v Jeijing Pty Ltd* 29 IPR 441, and the decision on review *Jiejing Pty Ltd v Commissioner of Patents & Ors* (1995) AIPC 91-144.

In this situation, it will normally be necessary to provide a declaration stating that the person relied on the incorrect information.

In *Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V. and Regeneron Pharmaceuticals, Inc v Amgen, Inc* [1997] APO 69, a potential opponent in a procedural opposition sought copies of relevant material from the Patent Office. That material was not provided until after the opposition period had expired and as a result, the opposition was filed late. The delegate, in allowing an extension under section 223(1), held that the failure of the Commissioner to timely respond to the request for information was an omission that
prevented the opponent from making any responsible decision as to whether they should file an opposition, thereby preventing it from filing a notice of opposition.

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**Extensions of time under section 223(1) can only be granted by the Deputy Commissioner (OEP)**

Only the Deputy Commissioner in OEP can allow an extension of time on the basis of an error or omission by a person at the Patents Office, Receiving Office or International Bureau.

After investigation, a person at the Office may prepare a casenote (see [Annex A](#)) for review by the Deputy Commissioner who will allow the extension only if satisfied that there has been an error or omission by a person at the Patents Office, Receiving Office or International Bureau that caused a relevant act not to be done in time.

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**Grant of an extension under section 223(1)**

Where the Deputy Commissioner (OEP) grants an extension of time under [section 223(1)](#) it is advertised as allowed under [reg 22.11(2)](#), and cannot be opposed ([section 223(6)](#)).

However, where there is a known third party whose interests may be adversely affected, the Deputy Commissioner will not proceed to grant an extension until he or she has ascertained whether that party objects to the grant. (This situation arises most commonly during opposition proceedings, where there is clearly an interested third party - see [R Thomas & A Garnham v Jeijing Pty Ltd](#) 29 IPR 441, and the decision on review [Jeijing Pty Ltd v Commissioner Of Patents & Ors.](#) (1995) AIPC 91-144).

**Period of Extension Granted**

Where an extension is granted, the length of the extension is to be determined from the circumstances of the action which led to the necessity for an extension. Needless to say, this period may not necessarily coincide with the period actually applied for, and could be longer or shorter.
3.11.1.2.1 Extensions under Subsection 223(1) to Gain Acceptance

The general rule is that the applicant for an extension under section 223(1) is entitled to an extension period - nett of administrative delays and the like - which equates to the period which would have been available had the error or omission not occurred.

Where an extension of time proceeds to grant under section 223(1), the applicant or patentee will need to ensure any actions that fall due before the section 223 request is determined are done at the relevant time (eg. payment of continuation or renewal fees). Failure to perform those actions at the relevant times may not be covered by the section 223(1) extension under consideration by the Deputy Commissioner.


3.11.1.2.1 Extensions under Subsection 223(1) to Gain Acceptance

It is not possible to list all possible sources of "error or omission" by a person at the Patent Office that could give rise to an extension of time under section 223(1).

However, examples of situations where an error could be said to have occurred to cause the failure to gain acceptance are:

- PAMS was not available to complete the acceptance task by the close of business on the final date for acceptance;

- an error message in PAMS prevented the completion of the acceptance task by the close of business on the final date for acceptance;

- a examination response was received by the Office a week before the final date for acceptance, but not forwarded to the examiner;

- the examination response was in the examiner’s possession, but there was a failure to act in a timely manner.

A situation which does not involve an error or omission within the meaning of section 223(1) is where the response was filed on the last day for acceptance, with insufficient time to create and consider an exam response task. There is an expectation that the applicant must take reasonable steps to ensure that the response reaches the examiner in time for it to be considered and processed for acceptance.
If an examiner believes that an extension of time for acceptance under section 223(1) is warranted, they must bring the matter to the attention of their Supervising Examiner. If in agreement, the Supervising Examiner fills in a case note (a blank copy of which is included at Annex A). The case note should:

- set out the basis for the exercise of the delegation (i.e. identify the error or omission), and include a statement that the application is (on the basis of the material filed before the date for acceptance) otherwise ready for acceptance; and
- recommend the exercise of power by Deputy Commissioner (OEP).

The file note is to be given to Deputy Commissioner (OEP) for a decision as to whether the extension is to be granted. If the extension is granted, the Deputy Commissioner (OEP) will sign the file note and arrange for it to be added to the casefile.

All extensions granted under section 223(1) are advertised in the Australian Official Journal of Patents (AOJP). Therefore, where a section 223(1) extension is granted, the file must be referred to ERA for advertisement.

### 3.11.1.3 Subsection 223(2) - Error or Omission and Circumstances Beyond Control

Section 223(2) is as follows:

(2) Where, because of:

(a) an error or omission by the person concerned or by his or her agent or attorney; or

(b) circumstances beyond the control of the person concerned;

a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Commissioner may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.

For the meaning of “relevant act” see 3.11.1.
3.11.1.3.1 The Law

Extensions of time under section 223(2)(a) and 2(b) cannot properly be dealt with in the absence of a full knowledge of the source law. The law has been developed by the Courts and the AAT in relation to section 223 of the Patents Act 1990 and the similar section 160 of the Patents Act 1952.

The most relevant cases for section 223(2)

1. *Scania Inventor v Commissioner of Patents* [1981] FCA 84 - Applicability of section 160 generally, and in particular to time for lodging Convention applications; general analysis of the section; meaning of "act or step", "certain time", "required to be done or taken" etc.

2. *APM Ltd v CIL Inc* [1981] HCA 64 - Similar to 1, above


4. *Board of Control of Michigan Technological University v Deputy Commissioner of Patents*
   c. AAT - (1982) 52 AOJP 1992

   Applicability of section 160 to extend the time for applying for restoration pursuant to reg 7B. Public interest, circumstances beyond the control and undue delay considered.

5. *Stibbard v. Commissioner* 7 IPR 337, (1985) AIPC 90-316 (AAT) - Applicability of section 160 where there is no "certain time", e.g. lodgement of a complete application where no earlier priority rights exist.


9. *Kimberly-Clark Ltd v. Commissioner and Minnesota Mining and Manufacturing Co (No 3)* 13 IPR 569 - Applicability of section 160 to time for lodging notice of opposition; error and omission discussed fully; chain of causation in error or omission discussed.

10. *Abbott and Lamb Pty Ltd v Registrar of Trade Marks* [1991] AATA 441 - Applicability of section 131 of the *Trade Marks Act 1955* to time for lodging notice of opposition; circumstances beyond control considered.

11. *Jiejing Pty Ltd v Commissioner of Patents and Ron Thomas and Allan Garnham* [1995] AATA 100 - Application of section 223 to the time for acceptance; whether decision to extend could be revoked, nature of error or omission under section 223(1) and 223(2)(a), and whether circumstances beyond control considered.

12. *Solar Mesh Pty Ltd v Commissioner of Patents* [1995] AATA 101 - Application of section 223 to the time for serving a statement of grounds and particulars; nature of error or omission under sub-section 223(2), circumstances beyond control considered.

13. *Hugh Macdonald Reilly v Commissioner of Patents* [1996] AATA 130; 36 IPR 314 - Application of section 223 to paying a renewal fee due when the patentee was bankrupt; consideration of who was responsible for paying the fee, and the role and powers of the trustee in bankruptcy; bankruptcy not a circumstance beyond control for the purpose of section 223(2)(b).


15. *Total Peripherals Pty Ltd v Commissioner of Patents and International Business Machines Corporation*, [1998] AATA 784 - Found that an error or omission may exist in a "flaw in mental function" where well-established systems or routines were not followed (AAT)

16. *Lazer Safe Pty Ltd v Commissioner of Patents* [2001] AATA 967 - Cessation of patent due to non-payment of renewal fee. Whether jurisdiction to grant extension of time for payment of renewal fee due to error or omission after anniversary date.

17. *GS Technology Pty Ltd v Commissioner of Patents* [2004] FCA 1017 - Application of section 223 for an extension of time to pay a continuation fee. Errors of judgment by agents and attorneys such as "lapses of memory" or "accidental slips" (bizarre or as little to be anticipated as those errors might be) are within the section.

18. *Apotex Pty Limited v Commissioner of Patents and Les Laboratoires Servier (Party Joined)* [2008] AATA 226 - Where an error precludes the forming of an intention to do the relevant act, it is sufficient for the purposes of section 223 if the error contributed to cause the failure to perform the act.

19. *Aspen Pharma Pty Ltd and Ors v Commissioner of Patents and H Lundbeck (Joined Party)* [2012] AATA 851 – The Tribunal found that section 223 is available to extend the time
for making a request under section 70 within the term of the patent. An earlier, timely application under section 70 was found by the Full Federal Court not to be based on the first inclusion in the ARTG of a relevant product. As a consequence the extension of term granted on this basis was invalid. Lundbeck awaited the final outcome of Federal Court proceedings before filing a second request under section 70 based on the earliest listing. The tribunal found that Lundbeck’s delay in making the second request was not unreasonable in the circumstances, and affirmed the delegate’s decision to grant an extension of 11 years to file a request under section 70. The case proceeded on appeal to the Federal Court and then the High Court where the first instance decision was confirmed (Alphapharm Pty Ltd v H Lundbeck A/S [2014] HCA 42).

20. Merck Sharp & Dohme Corp v Commissioner of Patents [2013] AATA 71 – Where the patentee was aware of the deadline for filing an application for an extension of term of the patent, in the absence of a sufficient disclosure of the circumstances in which the patentee failed to file the application, or a reasonable explanation for the failure to take action in the interim, an extension of close to 10 years to file a request under section 70 was refused. In these circumstances, the mere absence of any detriment to any other person is not sufficient to warrant the grant of an extension.

21. Sunesis Pharmaceuticals Inc v Commissioner of Patents [2015] FCAFC 29 – A full Federal Court confirmed that section 223(2) of the Patents Act, which allows the Commissioner of Patents to grant an extension of time to complete a required act, cannot be used to delay the effects of the commencement of legislative amendments. The Court found that section 223 does not operate to back date a required act. In this sense as the provision suggests, section 223 operates only to extend the time in which a required act can be done.
The failure to do the act or take the step, cannot itself be the error or omission by which the failure occurred (Kimberly-Clark Ltd v. Commissioner and Minnesota Mining and Manufacturing Co (No 3) 13 IPR 569).

Although there is no clear or complete meaning for the words "error or omission" a distinction should be drawn between:

- errors or omissions affecting the carrying out of the party's intentions; and
- the consequences of deliberate decision (Total Peripherals Pty Ltd v IBM & Commissioner of Patents [1998] AATA 784).

The definition of an error or omission was provided by Jenkinson J in Kimberly-Clark 13 IPR 569 in the context of section 160 of the Patents Act 1952, the equivalent of section 223:

"It is in my opinion difficult to suppose that only the inadvertence and accidental steps, and not errors resulting from faulty reflection, of the former class of persons were intended by the draftsman to be within s 160 (1). Further, the word 'error' is not easily assigned a clear meaning restricted by reference to one or several particular categories of flawed mental function. The attempt is likely to lead to the drawing of fine and often unrealistic distinctions. And some errors of judgement by agents and attorneys may be as bizarre and as little to be anticipated as lapses of memory and accidental slip. ..."

"I do not think that the conclusion I have reached reduces s 160(2)(a) to a mere general power of extension. By no means every judgement by "the person concerned" or by "his agent or attorney" which can be shown to have been mistaken will answer the description "error or omission" in the ordinary meaning of those words, which in their context carry, in my opinion, a connotation of obviousness of error."

This definition was further considered in G S Technology Pty Limited v Commissioner of Patents [2004] FCA 1017 and G S Technology Pty Limited and Commissioner of Patents and Anor [2004] AATA 1391.

"Most errors and omissions which lead to a failure to do an act or take a step are the result of negligence or incompetence. Where such errors and omissions are made against a clearly demonstrated desire to maintain the application (and thus not have it lapse), and where attempts are made to remedy the error or omission as soon as its consequences are discovered and the existence of the error or omission learnt, as is the case here, the considerations in favour of an extension seem to me to be quite persuasive."

"The observations of Jenkinson J in Kimberly-Clark specifically note that an extension can occur with or without moral fault on the part of the agent."
“Assessing the conduct and state of mind of a person who is not a patent attorney against standards of what a competent attorney would have known, or would have done, to determine whether a discretion should be exercised, is wrong in principle.”

“There cannot be a difference between a sophisticated system for alerting a patentee to a time limit for payment which fails because of some programming error and the failure of the more basic system of sticking a note on the wall.”

In *New Clear Water Pty Ltd v Atlantis Corporation Pty Ltd* [2001] APO 48, a Deputy Commissioner concluded that it was not appropriate in all the circumstances to visit the consequences of the actions of the attorney on his client because the client would not have been aware of the situation.

It is clear from *Kimberly-Clark* that an error or omission involves some type of flawed mental function in carrying out of a party’s intentions and does not have to be "accidental due to an inadvertent source". Errors or omissions resulting from faulty reflection, deliberation or mistaken judgment all fall within the scope of *section 223*.

In *Total Peripherals Pty Ltd and Commissioner of Patents and International Business Machine Corporation* [1998] AATA 784, the Tribunal found that "there has not been a failure to act by Mr Holcombe but rather, on review, a flaw in his mental function in carrying out his intentions, which is an error made by him". The Tribunal was satisfied that there was "an unexpected failure of a servant to exercise due diligence when giving directions".

Error or omission may include a breakdown in procedure or a failure to exercise due diligence (*Oz Technology v Boral Energy Ltd* [1999] APO 18).

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**The error must be causally linked to the failure to do the relevant act**

There must be a casual connection between the error or omission and the failure to do the relevant act that is required to be done within the prescribed time.

In the majority of cases, the applicants for an extension must demonstrate that they had an intention to do the relevant required act, and that an error or omission on their, or their agent’s, behalf reasonably could be said to have caused the failure to complete the relevant act in the time prescribed (see *Kimberly-Clark* 13 IPR 569).

However, in some circumstances the error or omission may have led to a failure to form an intention to do the relevant act. Where an error or omission contributes to cause the failure to perform the relevant act, that is sufficient to satisfy the required causal connection (see...
Overview

The meaning of the words "circumstances beyond the control of the person concerned" in section 223(2)(b) has been interpreted from the following cases:

- **Michigan Technological University Board of Control v. Deputy Commissioner**
  - AAT - (1982) 52 AOJP 199


- **Abbott & Lamb Pty Ltd v. Registrar of Trade Marks** [1991] AATA 441; (1991) AIPC 90-806

- **Jiejing Pty Ltd v Commissioner of Patents and Ron Thomas and Allan Garnham** [1995] AATA 100; 1995 AIPC 91-144


The principles arising from these cases and others are summarised below.
Force majeure

Section 223(2)(b) is a "force majeure" provision, where the failure to perform the relevant act is outside the control of the person concerned and something that could not have been avoided by that person's exercise of due care.

Actions of an agent or employee

The actions of an attorney, agent or employees are not considered to be beyond the control of a person. The Courts consider that the applicant or patentee "stands in the shoes of his agent", to the extent that errors or omissions made by the agent (or by the agent's employees) are attributed also to the applicant. "Employee" here means a direct employee and not an intermediary such as a courier or a postal authority (see "Postal delays" below).

Lack of funds

Becoming bankrupt is not a circumstance beyond a person's control within the meaning of section 223. A sequestration order is made as the culmination of a sequence of events which the applicant could have avoided by the exercise of due care. Similarly, a lack of funds is not considered to be a circumstance beyond a person's control. (Vrubel v Upham (1996) 36 IPR 220)

Postal delays

Delays by post and courier are generally circumstances beyond a person’s control, and historically have constituted the major source of extensions under section 223(2)(b).
3.11.1.3.4 Filing a Request under Subsection 223(2)

**Sickness or accident**

In some situations sickness or accident may satisfy the requirement of section 223(2)(b), for example if an applicant prosecuting his or her own case becomes ill, and is unable to rely on another person to carry out the relevant act, they will be entitled to an extension.

Alternatively, if a technical assistant to a firm of Attorneys missed a time limit owing to an illness, it would be expected that the firm would have made arrangements accordingly, in anticipation of this kind of occurrence. While and error or omission might be involved (section 223(2)(a)), circumstances beyond control would not.

**Awaiting a court judgement**

Anticipation of a Court judgement has been held to be a circumstance beyond a person's control (see *Jiejing Pty Ltd v Commissioner of Patents and Ron Thomas and Allan Garnham* [1995] AATA 100 at [105]).

Overview

An applicant seeking an extension of time under section 223(2) must:

- file a request for an extension of time in the approved form (available on the IP Australia website);
- file a declaration setting out the grounds on which the application is made;
- pay the fee for requesting the extension.
The declaration and fee are discussed further below.

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**The Declaration**

The approved form of the request under section 223 contains the form for making a declaration under the *Patents Act*. The person making the declaration must sign it.

In the declaration, the applicant for extension of time needs to provide a full and frank disclosure of all the surrounding circumstances that led to the relevant act not being done in time as a result of an error or omission or circumstances beyond the control of the person concerned.

For an extension to be granted under section 223(2)(a) – error or omission - the declaration must establish that an error or omission occurred, which contributed to cause the failure to perform the relevant act. The declaration should identify the error or omission and explain the circumstances or sequence of events that led to the relevant act not being done in the time required by the legislation, thereby identifying the causal connection between the error or omission and the failure to do the act within the prescribed time. Note that the failure to do the relevant act cannot itself be the error or omission by which the failure occurred (*Kimberly-Clark Ltd v. Commissioner and Minnesota Mining and Manufacturing Co* 13 IPR 569).

The provision of section 223(2)(b) – circumstances beyond the control of the person concerned - has been interpreted by the courts to be, in effect, a “force majeure” provision where the circumstances are beyond the control of the person and could not have been avoided by that person’s exercise of due care. Therefore, the declaration should set out the circumstances that prevented the applicant from performing the relevant act in the time provided by the legislation.

Where it is not possible for the applicant to file the declaration with the application form, the declaration should be filed as soon as practicable thereafter. A delay in filing the declaration is a factor the Commissioner needs to consider when exercising discretion on the application. In fact, given the provisions of reg 22.11(1), the application under section 223 is not made until such time as the declaration is filed.

Where a declaration is not filed with the application, the Commissioner will allow 2 months for a party to file their declaration. If no declaration is filed within this time, the extension under section 223 may be refused unless the person requests a hearing. Any declaration received before the hearing will be considered as quickly as possible, with the hearing being cancelled if it is no longer necessary.
The Fee

Fee items 226 to 227 of Schedule 7 of the regulations indicate the fees payable for requesting an extension of time under section 223(2). The fee payable is determined by the length of the extension requested, not by the date on which the extension is granted or refused.

Fee items 226 to 227 specifies fees "on filing an application", and so the appropriate fees as calculable at that time should accompany the application. Under reg 22.2C, if the section 223 fees are not paid when the application is filed, an ITP (invitation to pay) will issue. Failure to issue the notice within time will enliven the provisions of reg 22.2F (see 2.27 Payment of Fees for further information).

Regarding the potential for refunds of section 223 fees, see 2.27.9 Exemption from Fees for a discussion of the issues.

If an extension is opposed and the relevant act has not been done, the operation of regulation 22.11(1A) and (1B) affects the fees payable under item 226.

Common deficiencies in the request

Where a request under section 223 is deficient, a further request and/or declaration may be required.

An indication of common deficiencies to be avoided in section 223 requests is provided at 3.11.1.5.
3.11.1.3.5 The Commissioner's Discretion

General principles of the law

A number of guiding principles relevant to the exercise of the Commissioner's discretion under section 223(2) arise from the decided cases referred to at 3.11.1.3.1 The Law. A summary is provided below.

Beneficial nature of section 223

Section 223 is beneficial in nature and should be applied beneficially (Sanyo Electric Co Ltd v Commissioner of Patents [1996] AATA 832). The extension of time provision is a general remedial section and has general application, and is applicable unless there is some clear indication to the contrary (Scaniainventor v Commissioner of Patents [1981] FCA 84 and Danby Pty Ltd v Commissioner and Rib Loc Group Ltd [1988] FCA 43. These cases were decided under the similar provisions of section 160 of the 1952 Act and are relevant to section 223 of the 1990 Act).

Burden of justifying an extension

While the applicant has the burden of placing before the Commissioner the circumstances which it claims will justify the grant of an extension of time, that does not amount to a burden of proof and it is not appropriate that it should be so described (Sanyo Electric Co Ltd v Commissioner of Patents [1996] AATA 832).

General Considerations

An extension of time under section 223(2) may be granted at the Commissioner's discretion. This is in contrast to subsections 223(1) and 223(2A) which are mandatory in their exercise. Therefore, even though the terms of section 223(2)(a) or (b) may be satisfied, the Commissioner is not obliged to grant an extension.

It must be remembered that the granting of an extension is the granting of an indulgence, and an indulgence should not be granted in some circumstances, for example where the extension serves no useful purpose, or where the Commissioner is functus officio. The fact that there are protection and compensation provisions may also influence the exercise of discretion in some cases.
These factors are discussed further below, together with the general considerations for exercising the Commissioner’s discretion to allow an extension of time under section 223(2).

No useful purpose

The discretion to allow an extension should not be exercised where the extension would serve no useful purpose.

Where it is manifestly clear that it would not be possible to accept an application under the terms of the Act, an extension of time to gain acceptance should not be granted. Similarly, an extension of time for depositing a micro-organism after the filing date of a specification would serve no useful purpose, given the requirements of section 6(d).

Section 223 cannot be used to extend the time period for acts that must, by necessity, precede grant of a standard patent or certification of an innovation patent, if the request is made after grant or certification. For such acts, allowing an extension of time requested after grant or certification would serve no useful purpose as the decision by the Commissioner to grant or certify cannot be withdrawn or revoked. However, if a decision to grant or certify a patent is ultra vires, for example because a request for an extension of time for filing a notice of opposition was properly filed before grant took place, then the section 223 request could be considered (principle derived from British Sky Broadcasting Limited v The Registrar of Trade Marks [2002] FCA 1556).

Other examples of extensions that would not be allowable since they serve no useful purpose are:

- an extension of time to file amendments to a specification that do not comply with section 102(2) after acceptance or certification; and
- an extension of time to oppose an application or request, where the extension is filed after grant has occurred.

Functus Officio

The discretion should not be exercised to allow an extension, where the extension relates to matters where the Commissioner has become functus officio. As a general rule, administrative decision-makers cannot re-make a final decision unless the relevant legislation permits them to do so. The decision-maker, having made a decision in the exercise of a statutory power, has nothing more to do with it, and is then said to be functus officio. In this regard, the Patents Act does not make provision (either express or implied) for
the Commissioner to withdraw or revoke the valid grant of a patent or certification of an innovation patent.

**Protection or Compensation Provisions**

The provisions in section 223(9) and (10) and regulation 22.21 provide for the protection or compensation of parties who exploited an invention in a patent application that had lapsed or a patent that had ceased, but was restored as the result of an extension of time being given. It is a relevant consideration when exercising a discretion under section 223 that anyone making practical use of the invention is protected under these provisions. ([Sanyo Electric Co Ltd v Commissioner of Patents][1996] AATA 832).

Protection is achieved by the Commissioner granting a licence after a request under reg 22.21. An application for a licence under regulation 22.21 was considered by a Deputy Commissioner in [HRC Project Design Pty Ltd v Orford Pty Ltd](1997) 38 IPR 121. The refusal of a licence under analogous provisions of the Designs Act is reported in [Pacrim Trading Co Pty Ltd v Ford Motor Company of Australia Ltd][2007] ADO 3.

The person seeking a licence is required to serve a copy of their application on the patentee or patent applicant, and such other persons as the Commissioner reasonably directs (regulation 22.21(3)). The situations in which the Commissioner will direct that copy of the application for a licence be served on a third party are discussed in [Law v Razer Industries](87 IPR 229).

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**Balance of factors**

The balance of the relevant factors must favour the exercise of the discretion in favour of the applicant for an extension. The Commissioner, in balancing these factors, is entitled to proceed on the basis that it is more important to consider the consequences of extending or refusing to extend time than to debate the reasons why the act was not done in time ([Sanyo v Commissioner of Patents][1996] AATA 832).

Relevant factors include whether an applicant for an extension has given a full and frank disclosure of the circumstances surrounding the error or omission or circumstances beyond control. For section 223(2)(a) – error or omission - this would include all the surrounding circumstances that led to the error or omission, including a disclosure of the chain of causation. In [Kimberly-Clark Ltd v. Commissioner and Minnesota Mining and Manufacturing Co (No 3)] 13 IPR 569, in the context of an application to extend time for the lodging of an...
objection to the grant of a patent, Jenkinson J found that, in order to make out a proper case justifying an extension:

"an applicant would in my opinion have to go beyond a disclosure of the processes by which an agent's errors came to be committed, and would have to expose frankly, inter alia, all the conduct, knowledge, beliefs and mental processes (or, in the case of corporation aggregate, of the relevant officers and other agents) relevant to an understanding of the way the failure to do the act or take the step occurred, or relevant to an evaluation of the reasonableness of that conduct."

Considerations for exercising the discretion

In considering an application under section 223(2), there are a number of important factors to be considered, which were summarised in Vangedal-Nielsen v Smith (Commissioner of Patents) [1980] FCA 163; (1980) 33 ALR 144 at 150 as follows:

i. whether the Commissioner is satisfied that a proper case has been made out justifying an extension;

ii. where appropriate, whether a serious opposition has been foreshadowed;

iii. whether there has been undue delay in seeking an extension of time;

iv. the interests of the parties in refusing or granting an extension;

v. the public interest.

In balancing these factors, it is “more important to consider the consequences of extending or refusing to extend time than to debate the reasons why the act was not done in time” (Re Sanyo Electric Co Ltd v Commissioner of Patents [1996] AATA 832 at [16]).

Proper case

The factors to be taken into account in considering whether a proper case has been made out are summarised elsewhere – see 3.11.1.3.2 for 223(2)(a) and 3.11.1.3.3 for 223(2)(b) and 3.11.1.3.4 Filing a Request under Subsection 223(2).

Serious opposition
Where an opponent seeks an extension of time for a relevant act related to opposition proceedings, it needs to be clear that a serious opposition is in train. There should be no doubt that the opponent has serious, or potentially serious, opposition grounds. However, simply because an opposition is serious does not of itself justify an extension of time.

**Delay**

Inordinate delay in filing an application for an extension of time, or in filing available relevant material in support of the application, is potentially detrimental to the public interest. Consequently it is expected that where such a delay has occurred an explanation in declaratory form will be provided. In any event, the Commissioner will need to be satisfied that any further or unnecessary delay which has hampered having the matter dealt with at the earliest possible date was not caused to any significant extent by the actions of the applicant for the extension of time (*Sanyo Electric Co Ltd v Commissioner of Patents* [1996] AATA 832).

It should be remembered that because of the provisions of reg 22.11(1), strictly the application is not made until such time as the declaration is filed.

**The interests of the parties and the public interest**

In considering the interests of the parties, any other party involved (e.g. a patent applicant where the applicant for the extension is a prospective opponent) will be invited to comment on the extension request and to be heard as a matter of choice, pursuant to the requirements of reg 22.22. This is separate to the potential for opposition if an extension request is advertised under section 223(4).

The public interest lies in the efficient and orderly processing of matters before the Patent Office, and can best be related to the question of delay. Inordinate delay in performing a relevant act, for example filing documents in an opposition or in paying continuation/renewal fees creates uncertainty and is potentially detrimental to the public interest.

**The Period of the Extension**

Where granted, the length of the extension period is to be determined from the circumstances of the action which led to the necessity for an extension. Needless to say,
this period may not necessarily coincide with the period actually applied for, and could be longer or shorter.

Where an error or omission or circumstances beyond control is involved, the applicant for the extension is entitled to an extension period - **nett of administrative delays and the like** - which equates to the period which would have been available had the error or omission or circumstances beyond control not occurred. If this period is inadequate to meet the purpose of an extension under **section 223(2)**, the applicant has not, on the face of the application, justified the extension.

Where an applicant files a request under **section 223**, they will need to ensure any subsequent actions with a due date falling before the **section 223** request is determined are done at the relevant time. Failure to perform those actions at the relevant times would potentially be a new “error or omission” not covered by the **section 223** request under consideration. (G & J Koutsoukos Holdings Pty Ltd v Capral Aluminium Limited [2003] APO 28 and International Business Machines Corporation v Total Peripherals [2000] APO 44).

See also **3.11.1.12 Payment of Continuation or Renewal Fees Pending a Section 223 Application** in relation to subsequent continuation or renewal fees.

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### The extension period where an opposition is filed

Where an extension of time under **section 223(2)** is opposed, **reg 22.11(1A) and (1B)** apply to extend the time to include the period from the day on which the notice of opposition is filed to the end of:

a. if an application is made to the AAT for a review of a decision of the Commissioner – the day when the application is withdrawn or finally dealt with or determined; or

b. in any other case – 21 days after the end of the day on which the Commissioner decides the application.

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**3.11.1.4 Subsection 223(2A) - Despite Due Care**

**Section 223(2A)** is as follows:

(2A) If:
(a) a relevant act that is required to be done within a certain time is not done within that time; and

(b) the Commissioner is satisfied, on the balance of probabilities, that the person concerned took due care, as required in the circumstances, to ensure the doing of an act within that time;

the Commissioner must, on application made by the person concerned in accordance with the regulations and within the prescribed period, extend the time for doing the act.

Under section 223(2B), 223(3A) and reg 22.11(1D):

- the time for doing a relevant act can only be extended under section 223(2A) after the time period has expired;

- the request under section 223(2A) must be filed within two months after the circumstances that prevented the person from doing the relevant act within the time required, ceases to exist; and

- the maximum extension available under section 223(2A) is 12 months after the end of the time within which the act is required to be done.

The fee for an extension of time under section 223(2A) can be found at Schedule 7, item 228.

Unlike section 223(2), once grounds under section 223(2A) have been established, there is no discretionary power to be exercised.

Although the fees are the same, section 223(2A) is of narrower scope than the provisions of section 223(2)(a), and will only be applicable in limited circumstances. Extensions of time under section 223(2A) would only arise where the person concerned had appropriate systems in place and did everything that could reasonably be expected to ensure the relevant act was done and despite that, a relevant act was not done in time.

A reasonable enquiry is whether the systems or mechanisms put in place were appropriate to ensure the relevant act was performed in time. If the person concerned did not have adequate systems in place or had not done everything reasonably possible to ensure the relevant act was done in time, an extension under section 223(2A) would not be appropriate.
Overview

Pursuant to reg 22.11(1), an applicant seeking an extension of time under section 223(2A) must:

- file a request for an extension of time in the approved form (available on the IP Australia website)
- file a declaration setting out the grounds on which the application is made; and
- pay the fee for requesting the extension - see Schedule 7, item 228.

The Declaration

The approved form of a declaration under the Patents Act can be found on the IP Australia website as can the approved form for an “Application for an extension of time under section 223”. The person making the declaration must sign it.

In the declaration, the applicant for an extension of time under section 223(2A) must establish that he or she exercised due care as required by the circumstances, to ensure the act was done in the prescribed time, despite which, the act was not done in time. The declaration should provide a full and frank disclosure of all the surrounding circumstances, and explain the systems that were in place and everything that was done, that could reasonably be expected to ensure that the relevant act was done within the required time.

Where it is not possible for the applicant to file the declaration with the application, the declaration should be filed as soon as practicable thereafter. Given the provisions of reg 22.11(1), the application under section 223 is not made until such time as the declaration is filed.

Where a declaration is not filed with the application, the Commissioner will allow 2 months for a party to file their declaration. If no declaration is filed within this time, the extension under section 223 may be refused unless the person requests a hearing. Any declaration received before the hearing will be considered as quickly as possible, with the hearing being cancelled if it is no longer necessary.
The Fee

Fee item 228 in Schedule 7 of the regulations indicates the fee for extensions under section 223(2A). The amount payable is determined by the length of the extension granted, not by the date on which the extension is granted.

Fee item 228 specifies the fee "on filing an application", and so the appropriate fees as calculable at that time should accompany the application. Under reg 22.2C, if the section 223 fees are not paid when the application is filed, an ITP (invitation to pay) will issue. Failure to issue the notice within time will enliven the provisions of reg 22.2F (see 2.27 Payment of Fees for further information).

Regarding the potential for refunds of section 223 fees, see 2.27.9 Exemption from Fees for a discussion of the issues.

Common deficiencies in the request

Where a request under section 223 is not sufficient a further request and/or declaration may be required.

An indication of common deficiencies to be avoided in section 223 requests is provided at 3.11.1.5.

In this topic:

There are a number of common deficiencies that occur in applications for an extension of time under section 223. These are:
3.11.1.5 Common Deficiencies in Requests under Section 223(2) or (2A)

The request identifies the wrong period

Where the extension of time is required to do an act in the future, the applicant must ensure that the extension period requested is sufficient to complete the relevant act.

Where the extension of time is requested to gain acceptance, the applicant will need to apply for sufficient time not only to address the reasons for lapsing, but also sufficient time to gain acceptance. See 3.11.9 Extensions of Time to Gain Acceptance for guidance on the time required to gain acceptance.

The request identifies the wrong type of action

For example, where a divisional application is being filed it is necessary to extend the time for filing a divisional rather than the time for gaining acceptance of the parent.

The particular time period cannot be extended

Extensions of time can only be granted to perform a “relevant act” within the meaning of section 223(11). For example, an extension under section 223 cannot be granted for making a deposit of a microorganism; or for filing a first-instance application (see 3.11.1 Relevant Act). Furthermore, the Commissioner will not grant an extension under section 223(2) where the extension would serve no useful purpose, or for an action where the Commissioner has become functus officio (see 3.11.3.5 The Commissioner’s Discretion).

The evidence is not sufficient

A declaration may be of low evidentiary value if it relies on hearsay. For example "I declare that the [foreign] associate has told me that his client has told him that....".

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Hearsay evidence is particularly a problem in situations where there is no apparent reason (other than mere inconvenience) why the person having the direct knowledge of the circumstances cannot provide a declaration. This is to be contrasted with the situation where "person X, formerly of our employ" committed an error, where hearsay evidence may be the only evidence obtainable.

Declarations that apparently provide “selective” extracts of supporting documents whilst avoiding documents that may be less favourable to their case may have low evidentiary value. A particular subset of this situation is declarations which refer or allude to documents as supporting their case, but fail to provide copies of them.

Advertisement and opposition

Under section 223(4), it is mandatory to advertise an application made under section 223(2) or (2A) for an extension of time for more than 3 months, unless the Commissioner is satisfied that the application would not be granted even in the absence of opposition (section 223(6A)). This provision saves third parties from going to the expense of filing an opposition to the grant of an application that the Commissioner does not intend to grant.

Where an application under section 223 is advertised, under section 223(6) a person may oppose the granting of an extension under section 223(2) or (2A). For more information on opposing an amendment request under section 223 see 3.2.5.

Therefore, generally speaking, before directing advertisement the Commissioner will need to be satisfied that grounds for the extension have been established so that, in the absence of any opposition being filed to the extension application, the extension could be granted. As to the degree of satisfaction needed, this will require the existence of at least "some evidence on which the Commissioner could decide to grant the extension of time" even though there is other evidence on which the application could be refused (Kimberly-Clark Corporation v Proctor & Gamble Company [1992] APO 2).

When an extension of time is granted under section 223, pursuant to reg 22.11, a notice of the grant will be published in the Australian Official Journal of Patents.
3.11.1.7 Extension of Time for an Extension of Term

Note: Section 223 is not available to extend the time for filing a request for an extension of term of a patent to a date after the end of the 20 year patent term.

For an extension of the term of a patent to be considered, pursuant to section 71(2) the application must be filed:

1. within the original term of the patent; and
2. within 6 months of the latest of the following dates:
   a. the date the patent was granted;
   b. the date of the first inclusion in the Australian Register of Therapeutic Goods (ARTG) or
   c. the date section 71 commenced (27 January 1999).

Consistent with the policy behind the Patents Act, the provisions of section 223 are generally available to the various stages of an application for an extension of term of a patent. However, there is a specific limitation provided by reg 22.11(4)(b), which provides that a relevant act for the purposes of section 223 does not include:

   “filing, during the term of a standard patent as required by subsection 71(2) of the Act, an application under section 70(1) of the Act for an extension of term of the patent”

This is to prohibit an extension to the time for filing a request for an extension of term where the request is filed outside the term of the patent. An extension of time is intended to be available only for a request for an extension of term filed during the term of the patent.

Accordingly, in Aspen Pharma Pty Ltd and Ors v Commissioner of Patents and H Lundbeck (Joined Party) [2012] AATA 851, the Tribunal found that section 223 provides the Commissioner with the power to extend the time for making a request under section 70, providing the request is made within the term of the patent (confirmed on appeal in Alphapharm Pty Ltd v H Lundbeck A/S [2014] HCA 42). This reasoning was followed by the tribunal in Merck Sharp and Dohme Corp and Commissioner of Patents [2013] AATA 71 at [12].

Where the application for an extension of term is filed before the end of the original 20 year term but after the relevant time limit of (2) above, an extension under section 223 can be sought to allow the application to be considered.
3.11.1.8 Grace Period Extensions

Regulation 22.11(3) permits extensions of time for errors or omissions that occurred in the "grace period" for payment of continuation or renewal fees, effectively allowing an extension of the grace period to pay the fee. However, any such extension must be advertised for opposition purposes even if the extension sought is only for 1 day (refer to subsection 223(4)(b)). Furthermore, the protection and compensation provisions of regulation 22.21 apply.

In applying for an extension of the grace period, the extension period required begins with the expiration of the grace period, and not at the anniversary date.

The grace period fees still need to be paid when extending that period. That is, the total fees due for an extension of the grace period are the continuation or renewal fee due at the relevant anniversary date, the full grace period fee and the fee for the extension of time request which is calculated from the end of the grace period.

3.11.1.9 Extension of Time to Gain Acceptance

Where an applicant applies for an extension of time to gain acceptance of the patent application, the extension period should provide sufficient time for the delegate to consider the section 223 request (and where necessary time for advertising and allowance the extension), in addition to sufficient time for the examiner to consider any response or proposed amendments.

When considering the time required to gain acceptance, the applicant should take into account that an extension of more than 3 months will need to be advertised for a period of 2 months for opposition purposes. The examiner will not consider any response to an examination report during this period. The applicant should also consider the nature of any outstanding objections and whether these can be overcome at the first attempt. If a further examination report is issued additional time will be required to gain acceptance.

As a general guideline, if advertisement of the extension is necessary, and assuming that the request is accompanied by satisfactory reasons, the applicant should request an extension to a date which is at least five months from the date of filing the request under section 223.

If insufficient time has been asked for, the applicant can amend the extension request to reflect the new "end date" and pay any additional monthly fees. This must be done before

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any possible advertisement. If a request to amend the extension period is received after advertisement, then a further advertisement is required and potentially more fees paid.

Failure to specify sufficient time in which to gain acceptance may cause the extension request to be refused (see 3.11.1.3.5 under “Lack of Purpose”), or if granted, the patent application will immediately lapse as acceptance failed to occur within the extended period.

Where the acceptance date passes pending restoration of a lapsed application

Where an application lapses after the first examination report has issued, but before the application is accepted, the time for acceptance may expire before the application is restored. In such cases, the applicant will need to allow sufficient time in their extension request not only to address the reasons for lapsing, but also sufficient time to gain acceptance.


Section 223(1) may be applicable to extend the time for acceptance where an examiner’s first report was established but was not received due to an error by a person at the Patent Office. For example, it may have been sent to the wrong address for service.

If the report was sent to the correct address but was delayed or not received (e.g. delayed or not delivered by post) then section 223(2)(b) is more applicable. On the other hand, if the report was received but misplaced by the applicant, it is likely that section 223(2)(a) would be the appropriate remedy.

See 2.2.4.2 Delayed or Non-Receipt of the Report by the Applicant or Attorney for more detail regarding delays or non-receipt of examiner's reports.
3.11.1.11 Co-pending Section 104 Application - Budapest Treaty Details

Section 6(c) requires the specification to include Budapest treaty deposit details by the end of the period prescribed in reg 1.5. Where an applicant applies for an extension of this time, there will generally also be a co-pending section 104 action to insert the Budapest treaty deposit details. The relevant time must be extended up to when the amendments have been allowed.

Therefore the extension request will need to allow sufficient time for the examiner to consider and allow the section 104 request.

Any shortfall of the total fees payable is covered by reg 22.2C and will need to be paid within the time frame set by that regulation.

Note: An extension of time under section 223 is not available to make a deposit of a micro-organism under the Budapest Treaty. See 3.11.1.1 Relevant Act and 3.11.1.3.5 The Commissioner's discretion under “No useful purpose”

3.11.1.12 Payment of Continuation or Renewal Fees Pending a Section 223 Application

Situations sometimes arise where a request under section 223 has been filed to pay a continuation or renewal fee - and a subsequent anniversary passes after the request has been filed but before the request is allowed.

If a section 223 request has been filed for the purposes of paying a continuation or renewal fee, applicants intending to maintain their application or patent should ensure that any continuation or renewal fees falling due after the date of the section 223 request, and before the date of allowance of that request, are timely paid - even though the section 223 request has not yet been allowed. If the section 223 request is not allowed, any continuation fee or renewal fee payments that are of no effect will be refunded.

Applicants should note that the allowance of the section 223 request is not dependent on payment of the fee for that later anniversary and that there is no requirement or obligation for the Commissioner to advise the applicant of an outstanding fee or ask for payment. Consequently, failure to timely pay subsequent continuation or renewal fees while a section 223 request is pending may result in the application or patent being restored in respect of
the historic period - but remaining lapsed or ceased as of the date of allowance of the
request through the failure to pay the later anniversary fee.

Furthermore, the grace period fees for those continuation or renewal fees that fall due after
the section 223 application has been filed will need to be paid. Failure to pay the fee within
the period of grace will result in the application lapsing or the patent ceasing,
notwithstanding that for the historic period, the section 223 request may be allowed.

See for example: Total Peripherals Pty Ltd v Commissioner of Patents and International
Business Machines Corporation (1998) AATA 784 and International Business Machines
Corporation v Total Peripherals Pty Limited [2000] APO 44.

3.11.1.13 Person Concerned: Change of Ownership

Usually the applicant or patentee of record makes the application under section 223.
However, occasionally there is a change of owner of the patent or application that has not
been registered or recorded before the section 223 application is made. In such cases,
processing of the application will be conditional upon the filing of a request to record the
transfer of interest from the applicant or patentee of record.

In the case of an application, the Commissioner may give a direction under section 113,
even if the application has lapsed - see 3.3 Directions. Similarly, a transfer can be recorded
on the Register even if the patent has ceased.

In all circumstances, the applicant for an extension of time will need to establish that any
error or omission, circumstances beyond control or despite due care involved the person
concerned at the relevant time. In the case of an assignment that was made after the
patent/application ceased or lapsed, the relevant error or omission or circumstances beyond
control must necessarily be associated with the actions of the patentee/applicant of record,
and the evidence in support of the extension must be on that basis.

In The University of Newcastle Research Associates Limited [2001] APO 64, the equitable
owner took an assignment after the owner of record had made a deliberate decision not to
proceed with national phase entry. As a consequence, the equitable owner was unable to
satisfy the requirements of section 223.

On the other hand, where an assignment was made before the patent/application ceased or
lapsed, the relevant error or omission or circumstances beyond control are those of the
assignee. Of course, in order to overcome the type of issues that arose in Reilly v
Commissioner of Patents 36 IPR 314 (where a trustee in bankruptcy was not registered as
the patentee), the assignee of a patent/application will need to explain in their section 223

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application any failure to record the assignment at an earlier date (see Litton Bionetics, Inc [2002] APO 15). If there was a deliberate intention not to record an assignment, it is unlikely that the Commissioner's discretion would be exercised favourably.

3.11.14 Date of a Patent Where an Extension of Time is Granted to Claim Priority

Where an extension of time under section 223 is granted to extend the period for filing a complete application associated with a provisional application, or for filing a convention application, the date of the patent will be the end of the 12-month period for filing an associated application or filing a convention application - not the date on which the application was actually filed. See regulation 6.3(9)-(11), respectively.

For such cases the due date for payment of continuation/renewal fees is not the anniversary of the date of actually filing the application - rather it is the anniversary of when the application should have been filed.

3.11.2 Extensions of Time - Reg 5.9

Note: This information applies to oppositions commenced on or after 15 April 2013 and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

In this topic:

Relevant Legislation

The Regulations
Introduction

The Commissioner has always had the power to manage time periods during patent oppositions. Prior to 15 April 2013, reg 5.10 gave the Commissioner the power to extend time if “reasonably satisfied” that the extension was appropriate in all the circumstances. However, the law developed in such a way as to significantly narrow the Commissioner’s discretion to disallow extensions.

Amendments to the Patents Regulations which came into effect on 15 April 2013 introduced a new Chapter 5. Under this new regime extensions are provided for by reg 5.9, which introduces a new test for whether an extension of time is justified.

Under reg 5.9, the Commissioner may extend the time to file evidence in support, answer or reply, in a substantive opposition, either on the request of a party in writing, or on the Commissioner’s own initiative.

Reg 5.9 also applies to extend an evidentiary period in an opposition commenced before 15 April 2013, providing the evidentiary period commenced on or after 15 April 2013 (reg 5.9, subject to reg 23.36(2) item 2).

What periods can be extended under reg 5.9?

Regulation 5.9 allows the Commissioner to extend the time for an "evidentiary period" specified in reg 5.8 as in force either immediately before, or on or after 15 April 2013 (see reg 23.36(2) item 2).

Consequently, the time for filing evidence in support, evidence in answer or evidence in reply can be extended under reg 5.9 in the following oppositions:

- substantive oppositions commenced on or after 15 April 2013;
- any opposition commenced before 15 April 2013, provided the evidentiary period commenced on or after 15 April 2013.
3.11.2.1 Requesting an Extension of Time

Regulation 5.9 cannot be used to extend the time for requesting dismissal of an opposition (under reg 5.17).

Procedural oppositions commenced on or after 15 April 2013 do not have fixed evidentiary periods under reg 5.8, so these periods cannot be extended under reg 5.9. Instead, these matters are managed by directions under regs 5.12 or 5.22 (see 3.3.1 Directions in Opposition Proceedings).

Note: This information applies to oppositions commenced on or after 15 April 2013, and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

The former reg 5.10 continues to apply to extend an evidentiary period that commenced before 15 April 2013. (See 3.11.3 Extensions of Time – Regulation 5.10).

Timing and requirements for filing the application

An application for an extension of time may be made under reg 5.9 before or after the time sought to be extended has elapsed.

The party must file the application, in writing, with the Commissioner. There is no requirement for the party to provide a copy to the other party.

Processing the request

Upon receipt of an application for an extension of time, the opposition officer will provide a copy of the application to the other party.

Subsequently, the Commissioner will generally process the application as follows:

1. A delegate will consider whether the application contains sufficient justification for an extension.
2. If satisfied that the extension is justified, the parties will be advised and the other party will be asked if they wish to object. If there is an objection, the matter will immediately be set for hearing. In the absence of an objection, the extension will be granted.

3. If the delegate is not satisfied that the extension is justified, they can either request further information or immediately set a hearing. The other party may appear at the hearing, subject to the payment of the appropriate fee (see Schedule 7, item 231 or 231A).

**Note:** This information applies to oppositions commenced on or after 15 April 2013, and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

The former reg 5.10 continues to apply to extend an evidentiary period that commenced before 15 April 2013. (See 3.11.3 Extensions of Time – Regulation 5.10).

In this topic:

**Introduction**

The Commissioner has a limited discretion to allow an extension of time, and an extension cannot be allowed under reg 5.9 unless at least one of the following conditions is satisfied:

a. the party seeking the extension has made all reasonable efforts to comply with all relevant filing requirements, and has been unable to file their evidence despite acting promptly and diligently to ensure it is filed in time; or

b. there are exceptional circumstances that warrant the extension.
Extension on the Commissioner's own initiative

The Commissioner can grant an extension of time without a request by a party. This will most commonly occur where the Commissioner has become aware of exceptional circumstances.

All reasonable efforts, and despite acting promptly and diligently

An extension of time is only available if the party has made all reasonable efforts to meet the time period AND is unable to do so despite acting promptly and diligently.

What amounts to reasonable efforts must be determined in each case. However, a party would not have established reasonable efforts if:

- there are unexplained periods of delay;
- the party had delayed before seeking to engage an expert;
- the party had delayed before seeking to engage an additional expert;
- the expert had delayed before providing a draft of their evidence;
- the applicant had delayed before providing instructions to their representative; or
- the applicant had delayed in order to await the outcome of proceedings in another jurisdiction.

A party seeking an extension of time must have acted promptly and diligently at all times to ensure that the evidentiary stage is completed on time.

Exceptional circumstances

Regulation 5.9(5) defines exceptional circumstances as including the following:
3.11.2.2.1 Application of Regulation 5.9

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**General Principles**

Under reg 5.9(2), the Commissioner may extend an evidentiary period only if the Commissioner is satisfied that:

a. a circumstance beyond the control of a party that prevents the party from complying with a filing requirement

b. an error or omission by the Commissioner that prevents a party from complying with a filing requirement

c. an order of a court, or a direction by the Commissioner, that the opposition be stayed pending the completion of a related proceeding or action

Circumstances that normally arise during the preparation of evidence cannot be regarded as exceptional. For instance, unavailability of experts for periods of time due to leave, work commitments, personal commitments or even short periods of illness are not exceptional.

A significant change in circumstances may not in itself be exceptional. For example, if a preferred expert becomes suddenly unavailable but other experts could be called on to complete the evidence in time, the sudden loss of the preferred expert is not an exceptional circumstance.

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**Note:** This information applies to oppositions commenced on or after 15 April 2013, and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

The former reg 5.10 continues to apply to extend an evidentiary period that commenced before 15 April 2013. (See 3.11.3 Extensions of Time – Regulation 5.10).
3.11.2.2.1 Application of Regulation 5.9

i. has made all reasonable efforts to comply with all relevant filing requirements under Chapter 5; and

ii. despite acting promptly and diligently at all times to ensure the appropriate evidence is filed within the period, is unable to do so; or

b. there are exceptional circumstances that warrant the extension.

The construction of reg 5.9 was considered in TRED Design Pty Ltd v Julie-Anne McCarthy and Bradley McCarthy [2013] APO 57 (TRED). The delegate found that:

- whilst the two ‘legs’ of reg 5.9(2)(a) are similar, the ‘reasonable’ leg relates to ‘all relevant filing requirements’, whereas the ‘promptly and diligently’ leg relates to the period for filing ‘the appropriate evidence’ (TRED at [28]). Thus, reasonableness relates to conduct over the whole of the opposition and not just a particular evidence stage. Often where a person has acted reasonably, they will also have acted promptly and diligently.

The question to consider is whether a person seeking an extension satisfies each leg of the test. Where they fail to satisfy one of the legs, an extension will not be available (in the absence of exceptional circumstances) (TRED at [28]).

- ‘the party’ means ‘party and their attorney or agent’ and therefore the actions of attorneys or agents are relevant considerations when determining whether or not to allow an extension of time (TRED at [29]).

To determine whether an extension may be granted, the following questions should be considered:

1. Has the party (and their attorney or agent) made all reasonable efforts to comply with all relevant filing requirements?

2. Was the failure to file the evidence in time despite the party (and their attorney or agent) acting promptly and diligently at all times to ensure the evidence is filed in time?

3. Were there exceptional circumstances that warrant the extension?

An extension of time for filing evidence may only be granted if the answer to questions 1 and 2 is YES, or the answer to question 3 is YES. Where this requirement is met, the Commissioner must then consider whether there are any discretionary reasons why the extension should not be granted (TRED at [34]-[35]).

Reasonable Efforts, Prompt and Diligent Actions
The factors to consider when determining whether a party has made all reasonable efforts are generally relevant to the question of whether the party has acted promptly and diligently (TRED at [62]). It is also necessary to consider the whole of the evidentiary period, rather than each event that occurred during the period in isolation (TRED at [60]).

In particular, attention should be given to the actions undertaken by the party during at least the period in question. An understanding of what was done, when it was done, how it was done and by whom it was done, and the nature of the evidence being prepared, will assist the Commissioner in deciding whether a party has made all reasonable efforts to comply with the relevant filing requirements (TRED at [40]).

In seeking an extension of time, parties should provide sufficient information to enable the Commissioner to determine whether their actions have been reasonable, prompt and diligent:

‘An attorney does not need to account for every minute of their day, but they must provide enough information to enable a delegate of the Commissioner to form their own opinion on whether the party has acted reasonably, promptly and diligently. The kind of information that could be provided is a brief account of actions taken (for instance, an outline of what was done, when it was done, by whom it was done, as appropriate to the case) covering the period in question.’ (TRED at [76])

In acting reasonably, it is not expected that a person do the impossible (TRED at [51]).

**Exceptional Circumstances**

Exceptional circumstances include circumstances beyond the control of a party that prevents the party from complying with a filing requirement, an error or omission by the Commissioner that prevents a party from complying with a filing requirement, or an order of a court.

‘These matters give some guide to the other situations that would be regarded as exceptional circumstances: matters outside the normal evidentiary process, and outside the control of the party, where it would be unreasonable to insist on a party filing their evidence’. (TRED at [64])

Further information on the application of reg 5.9 is provided below.

**How Much Information is Required?**
3.11.2.2.1 Application of Regulation 5.9

General comments: The party seeking an extension must provide sufficient information for the Commissioner to be satisfied that an extension is appropriate. What is sufficient depends on the case, but in general there should be an explanation of the overall approach that the party has adopted (i.e. the strategy for preparing evidence), a description of what was done, and when it was done (focusing on the major parts of the evidence preparation process), and a discussion of any unexpected difficulties that arose. Where the information is insufficient to satisfy the delegate, the delegate may allow an opportunity for the party to provide further information. However, if the information is grossly inadequate, the delegate may set the matter for hearing immediately.

When applying for an extension of time, parties should provide sufficient information to enable the Commissioner to determine whether their actions have been reasonable, prompt and diligent.

‘A party seeking an extension of time will assist the Commissioner (and advance their own cause) if they provide information about what they did, when they did it, and how long those actions took. When considering such information, it is relevant to consider whether there have been any significant unexplained delays. The presence of significant delays without a reasonable explanation is the antithesis of acting promptly and diligently.’ (Fugro Airborne Surveys Corp v Geotech Airborne Limited [2014] APO 23 at [20])

Whilst a list of actions undertaken provides some information, it is the narrative that puts those actions into context that is important (Clarus Therapeutics, Inc. v Lipocine, Inc. [2014] APO 50 at [21]). Parties should explain their strategy for preparing evidence and not rely on an inference drawn from their submissions (Commonwealth Scientific and Industrial Research Organisation v BASF Plant Science GmbH [2014] APO 74 at [20]). Thus, a long chronology that is provided without adequate explanation may not assist in determining whether a party has made reasonable efforts or acted promptly and diligently (Sportingbet Australia v Tabcorp International Pty Ltd [2014] APO 21).

Parties should endeavour to provide all relevant information at the time of applying for an extension, as opposed to waiting until the delegate requests further information (Osmose New Zealand v Zelam Limited [2014] APO 49 at [15]).

Reasonable Efforts to Comply

Time Period to Consider
The condition in paragraph 5.9(2)(a)(i), that a party make all reasonable efforts to comply with all relevant filing requirements, is intended to import a consideration of the reasonableness of a party’s conduct over the totality of the opposition proceedings, rather than its compliance with a particular evidentiary period in question (Merial Limited v Novartis AG [2013] APO 65 at [16]; Innovia Security Pty Ltd v Visual Physics LLC [2014] APO 15 at [18]).

**Actions of Applicant**

When seeking an extension of time to file evidence in answer, if an applicant can demonstrate that it had given consideration to its case at an early stage, such information will assist the Commissioner. However, given the costs associated with engaging appropriate experts and drafting declarations, it may be reasonable for the applicant to defer such actions until the evidence in support is filed (Shelford Services Pty Limited v Baylor Research Institute [2014] APO 20 at [18]; Sportingbet Australia v Tabcorp International Pty Ltd [2014] APO 21 at [28]).

The volume of evidence can also be a relevant consideration when assessing whether the actions of the applicant were reasonable. (Aquatron Robotic Technology LTD v Zodiac Pool Care Europe [2016] APO 88 at [48])

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**Establishing Prompt and Diligent Action**

**Time Period to Consider**

When determining whether a party has acted promptly and diligently at all times, consideration should be given to all the actions of the party in relation to compliance with the evidentiary period as a whole. Thus, where a request for an extension of time follows the grant of a previous extension of time, all actions of the party during the evidentiary period should be considered and not just its failure to comply within the period of the extension already granted (Merial Limited v Novartis AG [2013] APO 65 at [18]).

**Length of Time Taken to Complete Actions**

The fact that an action takes place over several months does not automatically mean that a party has not been prompt and diligent (Osmose New Zealand v Zelam Limited [2014] APO...
Consideration should be given to whether the nature of the action is such that it would be reasonably expected to take an extended time, and whether the time taken to complete a task prevents other actions from occurring concurrently. In considering the length of time taken, it should be noted:

‘While it might have been possible to carry out some activities faster, the time taken is not outside the range of prompt and diligent given the work that was involved.’
(\textit{Osmose New Zealand supra} at [22])

It should also be remembered that ‘promptly and diligently’ is not setting a standard of perfection (\textit{Mineral Technologies Pty Ltd v Orekinetics Investments Pty Ltd} [2014] APO 63 at [33]).

\section*{Misunderstanding of Law}

‘While a misunderstanding of the law may be the cause of a failure to act promptly and diligently, I do not accept that it can make the actions of a party prompt and diligent where they otherwise would not have been.’ (\textit{Fonterra Co-operative Group Limited v Meiji Dairies Corporation} [2014] APO 11 at [19])

\section*{Explanation of Delay}

Where there are significant delays or gaps in a chronology, an explanation should be provided. As stated in \textit{Shelford Services Pty Limited v Baylor Research Institute} [2014] APO 20 at [19]:

‘Any significant gaps or delays in a chronology, where relevant action would generally be expected, should be explained. The nature of the delay and what was done to attempt to mitigate the delay would be a relevant consideration for an extension of time. An explanation of the unforeseen and what was done to mitigate that would generally be considered favourably. A failure to file evidence due to foreseen or foreseeable circumstances would generally not be considered favourably, and effort to address such circumstances in an application or submissions for an extension of time would generally be counter-productive.’
Consideration of Exceptional Circumstances

A change in the Regulations would not make it unreasonable to insist that a party file its evidence and is not an exceptional circumstance (TRED at [67]). Similarly, a short period of illness is not exceptional (Novartis Vaccines & Diagnostics, Inc. v Wyeth Holdings Corporation [2014] APO 65 at [49]).

Although circumstances may not be regarded as exceptional when considering the preparation of evidence, they may be a relevant context when assessing whether a party has acted promptly and diligently (Mineral Technologies Pty Ltd v Orekinetics Investments Pty Ltd [2014] APO 63 at [46]).

Discretionary Matters

The power to extend an evidentiary period under reg 5.9 is discretionary. Thus, where the requirements of reg 5.9(2)(a) or reg 5.9(2)(b) have been met, an extension of time is not automatic. Where a party deliberately misleads the Commissioner in order to obtain an extension, either by explicit statement or omission, the Commissioner would be entitled to take this into account when exercising her discretion (Commonwealth Scientific and Industrial Research Organisation v BASF Plant Science GmbH [2014] APO 74 at [34]).

Consideration may also be given to the nature and significance of the evidence that is being prepared, as well as the private and public interests that exist.
Regulation 5.9 states that the Commissioner can extend a time period ONLY IF satisfied of certain matters. Consequently, the regulation imposes an onus on the party seeking an extension to make out an appropriate case.

The Commissioner will not extend a time period solely because of delays caused by an agent or legal representative failing to act promptly or diligently, difficulties in obtaining expert evidence that could have been anticipated and acted on, or by attempts to settle the proceedings.

An extension is available if a party fails to meet the time period **despite** acting promptly and diligently at all times. It follows that the Commissioner will not extend a time period because of delays **caused** by a failure to act diligently or promptly either by the party, their agent or legal representative, or an expert engaged by them.

A party is required to make “all reasonable efforts” to comply with relevant filing requirements, and to have acted “promptly and diligently at all times”. Consequently, a party making a request to the Commissioner for an extension of time should be able to demonstrate a consistent overall pattern of reasonable effort, promptness and diligence in relation to all their endeavours so far to file their evidence within the statutory timeframe.

The party seeking an extension must present sufficient information to justify the extension. It is not sufficient to assert that an extension should be allowed unless the Commissioner, or the other party, can show that the extension is not appropriate.

Parties will need to provide an explanation of why it was not possible to complete the evidence on time. This necessarily focuses attention on the actions that the party has taken throughout the preparation of their evidence, not on the actions that they intend taking if the extension is granted. For instance, an extension is not available merely "in order to allow a declaration to be signed by the expert", because that does not explain why the evidence was not completed in time. Rather, in order to obtain an extension a party will need to explain why they were unable to have the declaration signed during the existing time period, despite having been prompt and diligent to ensure it was done in time.

The following matters would suggest that a party had not made all reasonable efforts and acted promptly and diligently to comply with an evidentiary period:

- unexplained delays, e.g. in settling on an expert, in briefing an expert, in preparing a draft by the expert, in finalising the evidence of the expert
- delays in obtaining expert evidence that could have been anticipated and acted on
- unavailability of experts due to involvement in other matters, unless the party had exhausted all efforts to find alternative experts
- the extension is being sought to obtain evidence of matters not referred to (either directly or by clear implication) in the statement of grounds and particulars
3.11.2.4 Discretionary Matters

- delays due to intervening holidays, leave, etc which were known or could have been expected

- the adoption of an inherently lengthy process of evidence preparation, when alternatives exist. For instance, parties are not required to prepare their evidence in a two stage manner (as distinct from the requirements of the *Federal Court in Minnesota Mining & Manufacturing Company v Tyco Electronics Pty Ltd* [2002] FCAFC 315). Consequently, the use of a two stage process is a matter of choice, and parties must ensure that no delay arises from this choice.

Where a party can justify the preparation of their evidence in a two stage manner (as described in *Minnesota Mining & Manufacturing Company v Tyco Electronics Pty Ltd* [2002] FCAFC 315), they will need to show that they have diligently and promptly implemented that process.

The nature and the significance of the evidence that is being prepared may be relevant to the reasonableness of the actions of the party.

Issues relating to parties undertaking negotiations (see 3.11.2.7).

**Note:** This information applies to oppositions commenced on or after 15 April 2013, and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

The former reg 5.10 continues to apply to extend an evidentiary period that commenced before 15 April 2013. (See 3.11.3 Extensions of Time – Regulation 5.10).

Once the mandatory requirements of reg 5.9(2) have been met, there is a discretion whether to grant an extension. This follows from the use of the term "may" in reg 5.9(1).

Considerations that would be relevant to whether to refuse an extension of time are those identified under the former law:

- the nature and significance of the evidence that is being prepared; and

- the private and public interests.

In *CSIRO v BASF* [2014] APO 74 the delegate identified another consideration: had the party deliberately misled the Commissioner, either by explicit statement or omission, in order to obtain an extension.
The private and public interests

The private and public interests are not relevant to whether a party has acted promptly and diligently in preparing their evidence. The balancing of private and public interests may be relevant to the exercise of discretion.

Note: This information applies to oppositions commenced on or after 15 April 2013, and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

The former reg 5.10 continues to apply to extend an evidentiary period that commenced before 15 April 2013. (See 3.11.3 Extensions of Time – Regulation 5.10).

If the Commissioner decides that an extension should be allowed, she must separately determine what period is appropriate. Regulation 5.9(3) requires the Commissioner to determine the length of the extension having regard to what is "reasonable in the circumstances". Consequently, a party will need to explain why the period sought is appropriate.

The period of the extension must relate to the reasons why the evidence was not filed within time. For instance, if the Commissioner grants an extension because a party is sick for a week, the Commissioner would grant the extension for a week. Where a party cannot justify the full extension sought, the Commissioner will grant a period that is reasonable. The Commissioner will not grant an extension longer than is justified.

The Commissioner cannot allow an unsuccessful party a short extension to file evidence that is immediately available, or to validate evidence that has already been filed out of time - Regulation 5.9 is not a discretion similar to that considered in Ferocem. Evidence filed out of time is discussed at 3.11.2.9.

3.11.2.6 A Hearing in Relation to an Extension

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On receipt of a request for an extension of time, a delegate will consider the reasons provided.

If the delegate is satisfied that the extension is appropriate, the delegate will allow a short period for the other party to comment or object to the extension. If the other party formally opposes the extension, a hearing will be set. The hearing will be conducted by an independent hearing officer.

If the delegate is not satisfied that there is sufficient justification for the extension of time, they can either request further information or immediately set a hearing. If a hearing is set, the other party will have the opportunity to appear and make submissions. If the other party objects to the extension of time and pays the appropriate fee for a hearing, the Commissioner will set a hearing.

The Commissioner will not extend a time period because of negotiations to settle the proceedings.

When parties are in negotiations, they will need to continue to prepare their evidence expeditiously, and an extension is only available if the party has continued to make all reasonable efforts to complete their evidence in time.

Settlement negotiations are not an exceptional circumstance.
3.11.2.8 Review of a Decision to Grant or Refuse an Extension

**Note:** This information applies to oppositions commenced on or after 15 April 2013, and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

The former reg 5.10 continues to apply to extend an evidentiary period that commenced before 15 April 2013. (See 3.11.3 Extensions of Time – Regulation 5.10).

A decision to grant or refuse an extension of time can be reviewed by the Federal Court under the Administrative Decisions (Judicial Review) Act. While the judicial review is pending, the Commissioner will stay the opposition (see 3.3.1.1). The effect of the stay is that exceptional circumstances exist and extensions of the current evidentiary stage will be able to be obtained.

The extensions obtained on the basis of the stay merely preserve the situation until the stay is lifted (i.e. after the judicial review is completed), and do not extend the period regardless of the outcome of the review. Consequently if the original extension is ultimately refused, any evidence filed during the extension(s) is out of time (see 3.11.2.9).

**3.11.2.9 "Out of Time" Evidence**

**Note:** This information applies to oppositions commenced on or after 15 April 2013, and oppositions commenced before 15 April 2013 provided an evidentiary period commenced on or after 15 April 2013.

The former reg 5.10 continues to apply to extend an evidentiary period that commenced before 15 April 2013. (See 3.11.3 Extensions of Time – Regulation 5.10).

Sometimes evidence is filed while an extension of time is pending. If the extension of time is granted, the evidence will have been filed in time and is part of the evidence in the opposition.
If the extension of time is not granted, the "out of time" evidence has not been properly filed, and consequently is not part of the opposition. For oppositions commenced before 15 April 2013, the party can seek to serve this material as further evidence. In other cases the Commissioner may consider the material under reg 5.23.

**3.11.3 Extensions of Time - Reg 5.10 (as in force immediately before 15 April 2013)**

**Note:** This information applies to oppositions commenced before 15 April 2013, provided the evidentiary period sought to be extended commenced before 15 April 2013. (An exception applies to Further Evidence filed under reg 5.10(4) for oppositions commenced before 15 April 2013, see 3.5.3.1 Further Evidence).

**Note:** The regulations referred to in this section of the manual are those in force immediately before 15 April 2013.

In this topic:

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**Relevant Legislation**

**The Regulations (as in force immediately before 15 April 2013)**

- Chapter 5  Opposition
- Schedule 7  Fees
Introduction

Regulation 5.10, as in force immediately before 15 April 2013, provides for extensions of time in opposition proceedings which are conducted in accordance with Chapter 5 as in force immediately before 15 April 2013.

Extensions of time to take a step or to extend a prescribed period may be considered under reg 5.10(1), (2) or (3), as in force immediately before 15 April 2013.

Under reg 5.10(1), the Commissioner may extend certain periods prescribed in Chapter 5 following a directions hearing: such an extension can arise "on the application of a party". Regulation 5.10(2) allows the parties in an opposition to apply for an extension of time to take a step prescribed in the opposition proceedings except the step of filing a notice of opposition and serving (or after 15 April 2013, filing) a statement of grounds and particulars. Regulation 5.10(5)(c)(ii), requires the Commissioner to be reasonably satisfied that an extension "is appropriate in all the circumstances" before directing an extension under reg 5.10(1) or granting an extension under reg 5.10(2).

Regulation 5.10(3) allows the time for a party to take a step prescribed in Chapter 5 to be extended, when the applicant is given an opportunity to be heard in relation to amendments directed by the Commissioner. The length of the extension is equal to the period from the day of the hearing or proposed hearing to the day when the decision is made as to whether the amendments are allowable.

3.11.3.1 Extensions under Reg 5.10(1)

Note: This information applies to oppositions commenced before 15 April 2013, provided the evidentiary period sought to be extended commenced before 15 April 2013.

Note: The regulations referred to in this section of the manual are those in force immediately before 15 April 2013.

The Commissioner may extend a prescribed period under reg 5.10(1) on his or her own motion, or on the application of a party. Before deciding to extend a prescribed period under this regulation, the Commissioner will have regard to the delay arising in the proceedings by such an extension, when considering whether an extension is appropriate in all the circumstances in accordance with reg 5.10(5).
Applications for extension under reg 5.10(1) should normally be made at an early stage of the prescribed period sought to be extended, thus allowing the Commissioner time to consider the application before the period expires. Thus, for example, an application to extend a 3 month time period prescribed in reg 5.8 should be filed within the first month of that period.

Where a party applies for a directions hearing seeking a determination that a prescribed period be extended under reg 5.10(1)(b), the Commissioner may exercise a broad discretion if the extension is sought at an early stage in the opposition. The party seeking the extension must establish or provide good reasons why the prescribed time for doing the particular action should be extended under the provisions of reg 5.10(1)(b).

Where a party applies for a directions hearing other than at an early stage in the opposition, the Commissioner may exercise his or her discretion under reg 5.10(1)(b) only if unusual circumstances, or circumstances beyond the control of the party and its declarants, are established. Some examples of such circumstances are:

- where a current court action in Australia may directly affect the opposition;
- in some circumstances where a statement of grounds or particulars has been amended; or
- where amendments to an opposed specification (sec 59 opposition) are being considered.

In this context, circumstances such as unavailability of experts and declarants, pressure of work, mail delays and the like will not normally be considered as unusual circumstances.

If a period is extended under this regulation, then any further extension of the period, considered later also under reg 5.10(1), will only be granted where exceptional, unforeseen circumstances occurred after the initial grant.

An application made under reg 5.10(1) and refused by the delegate, may be converted and reconsidered under reg 5.10(2), for example at a directions hearing. (see 3.11.3.2 Extensions Under Regulation 5.10(2).)
Introduction

Regulation 5.10(2), as in force immediately before 15 April 2013, allows the parties in an opposition to apply for an extension of time to take a step prescribed in the opposition proceedings except the steps of filing a notice of opposition and a statement of grounds and particulars, or filing evidence in support in an opposition under section 101M.

An application for extension of time may be made under reg 5.10(2) before or after the time sought to be extended has elapsed.

A fee is payable for each month of extension applied for under reg 5.10(2) (see Schedule 7 item 218, as in force immediately before 15 April 2013).
Initial processing of the request

Upon receipt of an application for an extension of time, the opposition officer will provide a copy of the application to the other party.

Subsequently, the Commissioner will generally process the application as follows:

1. A delegate will consider whether the application contains sufficient justification for an extension.

2. If satisfied that the extension is justified, the parties will be advised and the other party will be asked if they wish to object. If there is an objection, the matter will immediately be set for hearing. In the absence of an objection, the extension will be granted.

3. If the delegate is not satisfied that the extension is justified, they can either request further information or immediately set a hearing. The other party may appear at the hearing, subject to the payment of the appropriate fee (see Schedule 7, item 231 or 231A). The Commissioner will likely direct that the matter be heard on the basis of written submissions.

Hearing where an objection is filed

Where the other party objects to the requested extension of time, the matter will be set for a hearing. So that the opposition proceedings are not unnecessarily delayed, the Commissioner will establish a hearing date as soon as possible, subject to reg 22.23.

In most instances the parties should expect that a hearing will be set for a date within 14 to 21 days of the filing of the objection. The Commissioner will not be sympathetic to any delay in hearing the matter without very strong justifications. The Commissioner will likely direct that the matter be heard on the basis of written submissions.
3.11.3.2.2 Applicable Law

**Note:** This information applies to oppositions commenced before 15 April 2013, provided the evidentiary period sought to be extended commenced before 15 April 2013.

**Note:** The regulations referred to in this section of the manual are those in force immediately before 15 April 2013.

In this topic:

Under reg 5.10(5) as in force immediately before 15 April 2013, an extension of time under reg 5.10(2) to take a step must not be granted unless the Commissioner:

- has notified the parties as appropriate;
- gives the parties a reasonable opportunity to make representations concerning the proposed extension; and
- is reasonably satisfied that the extension of time is appropriate in all the circumstances.

In applying the law to decide whether an extension is justified, several matters need to be considered. The Court decisions most relevant to an extension of time under reg 5.10(2) are:

- *Ferocem Pty Ltd v Commissioner of Patents* [1994] FCA 981; 28 IPR 243
- *A Goninan & Co Ltd v Commissioner of Patents* [1997] FCA 424; 38 IPR 213
- *National Starch & Chemical Co v Commissioner of Patents* [2001] FCA 33; 50 IPR 398

The general principles that flow from these decisions are as follows:

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**The power is discretionary**

Regulation 5.10 confers a broad discretion, which cannot be reduced to imperative compliance with particular requirements. It is necessary to give genuine and proper consideration to all relevant considerations. (*Ferocem* [1994] FCA 981 at [11] *Goninan* 38 IPR 213 at 220)
3.11.3.2.3 Justification for the Extension

Explanation of delay

The reasons why the evidence was not served earlier are a relevant consideration, but a satisfactory explanation is not a mandatory requirement (Ferocem [1994] FCA 981 at [10]).

The public interest

The public interest in determining a serious opposition on its merits is a relevant consideration (Goninan 38 IPR 213 at 222). It is necessary for the Commissioner to form a view as to the nature of the evidence that is sought to be adduced, and the significance of that evidence for the opposition proceedings (Goninan 38 IPR 213 at 225-6). The significance of the evidence is assessed having regard to any relevant material available, not just the evidence itself (National Starch [2001] FCA 33 at [33]). The public interest is not protected merely because some evidence has already been served (Goninan 38 IPR 213 at 225).

The interests of the parties

The interests of the party seeking the exercise of discretion are a relevant consideration (Ferocem [1994] FCA 981 at [11]).

It is also relevant to consider the disadvantage to the other party of delays in determining the opposition, and the effect of delays on the efficient and orderly administration of the Patent Office. (Ferocem [1994] FCA 981 at [11], Goninan 38 IPR 213 at 222).

Modified Date: 05 June 2013

3.11.3.2.3 Justification for the Extension

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Effective Date: 25 September 2019
Before granting an extension of time under reg 5.10(2), the Commissioner must be reasonably satisfied that the extension is "appropriate in all the circumstances" (reg 5.10(5)). This gives the Commissioner a broad discretion, one which should be exercised only after due regard is given to the various considerations relevant to an extension of time.

*Burchett J. in Ferocem Pty Ltd v Commissioner of Patents* [1994] FCA 981; 28 IPR 243, in discussing the considerations for determining an application for an extension of time under reg 5.10(2), inter alia referred to the observations of Bowen C.J. in *Vangedal-Nielsen v. Smith* [1980] FCA 163, noting "he ... set out some of the considerations involved upon an application for an extension of time".

From these judgements these considerations can be stated generally as follows:

- the Commissioner, before allowing an extension, must be satisfied that the person seeking the extension has made out a proper case justifying the extension
- the Commissioner must consider not only the private interests of applicants for patents and opponents, but also the public interest, by ensuring that invalid patents are not granted, and that proceedings are not unreasonably protracted.

The Commissioner should also be mindful of the procedural framework in which oppositions under the *Patent Regulations 1991* are conducted (refer to 3.11.3.2.2 Applicable Law). For example, relevant factors to consider where an extension of time for filing evidence is requested may include:

- is the extension being sought for reasons which are based on matters not referred to (either directly or by clear implication) in the statement of grounds and particulars? (*Kent-Moore Corp v. Environmental Products Amalgamated Pty Ltd* [1992] APO 47; *Sandoz v. Fujisawa* 26 IPR 426, *Kimberly-Clark v. Procter & Gamble* 24 IPR 345)

- is the extension being sought to find evidence to support speculative or non-specific particulars? (*Kent-Moore* [1992] APO 47);

- is the extension being sought because the opponent requires more time to determine whether a particularised document is relevant? (*Kent-Moore* [1992] APO 47);

- has there been any undue delay in putting the evidence together? (*Kent-Moore* [1992] APO 47, *Sandoz v. Fujisawa*)
3.11.3.2.3 Justification for the Extension

- Has there been a satisfactory explanation of why a delay occurred? \((\text{Ferocem Pty Ltd v Commissioner of Patents [1994] FCA 981})\)


- The seriousness of the opposition \((\text{ICI v. Irenco, E.I. DuPont v. DowElanco})\)


- Complexity of the evidence \((\text{DuPont v. DowElanco (29.11.93), Kimberly-Clark v. Procter & Gamble 26 IPR 581, ICI v. Irenco})\)

- Intervening holidays, leave, etc \((\text{Kimberly-Clark v. Procter & Gamble 26 IPR 581})\)

- Unavailability of people due to overseas prosecutions \((\text{Genetics Institute v. Johnson & Johnson 27 IPR 277, Kimberly-Clark v. Procter & Gamble 26 IPR 581})\)

- Parties undertaking negotiations \((\text{see 3.11.3.2.6 Parties Involved in Negotiations})\)

- The nature and the significance of the evidence \((\text{Goninan v Commissioner [1997] FCA 424})\)

All relevant matters must be taken into consideration. However, the absence of a satisfactory explanation of the delay does not preclude an extension of time being granted if an extension is appropriate in the circumstances \((\text{Ferocem [1994] FCA 981})\).

The onus rests with the party seeking an extension of time to justify its grant by the Commissioner. Accordingly, the extension request should provide sufficient details of the grounds and circumstances necessitating the extension sought to allow the Commissioner to be reasonably satisfied that the extension is appropriate in all the circumstances.

A \text{Goninan v Commissioner [1997] FCA 424} notes that in order to give proper, genuine and realistic consideration to the public interest of having proceedings determined on their merits, the delegate needs to consider the nature and the significance of the evidence sought to be adduced.

\textit{National Starch & Chemical Company v Commissioner of Patents [2001] FCA 33} notes that the delegate does not need to have seen this evidence sought to be adduced to determine its nature and significance, but that these can be determined from the context of the other material on file.

“It was said that the error of fact was that there was material before the delegate from which he could make a determination of the significance of the evidence. I do not consider that is a correct characterisation of the error into which the delegate fell. If
there was material before the delegate from which findings could be made as to the significance of the evidence, it was incumbent upon the delegate to address that issue in the context of that material. By failing to consider the significance of the evidence in respect of the patent specification, the grounds of opposition and the particulars of the grounds and the material which had already been filed, the delegate failed to give proper, genuine and realistic consideration to the significance of that evidence, which had a flow on effect on consequence in relation to the consideration of the public interest in determining a serious opposition on its merits. To that extent the delegate failed to take into account a relevant consideration.”

3.11.3.2.4 The Private and Public Interests

Note: This information applies to oppositions commenced before 15 April 2013, provided the evidentiary period sought to be extended commenced before 15 April 2013.

Note: The regulations referred to in this section of the manual are those in force immediately before 15 April 2013.

The statement of grounds and particulars provides the basis of the opposition. If there is no evidence in support filed, the opposition nevertheless continues, and the opponent can still appear at the hearing. Even if the opposition is withdrawn, the Commissioner may conduct a "bar-to-grant" action on the basis of material referred to in the statement (see 3.7.1.1 Withdrawal of Section 59 and 101M Oppositions). In so doing, the public interest in ensuring that only valid patents are granted is largely met. ‘See Kent-Moore Corp v. Environmental Products Amalgamated Pty Ltd [1992] APO 47.

Public interest considerations were addressed by Burchett J. in Ferocem Pty Ltd v Commissioner of Patents [1994] FCA 981; 28 IPR 243 where he said:

"The determination of an application for an extension of time under reg 5.10(2) involves a balancing exercise, in which competing considerations must be taken into account. There are the interests of the persons directly concerned with application and opposition in question. There are also the public interests, which are not necessarily all ranged on the same side. They include the expeditious disposal of matters in the Patents Office, and questions of cost, of efficiency, and of insistence upon proper professional standards being maintained by those who deal with the office. But they also include, as Kitto J. pointed out in Kaiser Aluminium & Chemical Corporation v. The Reynolds Metal Company (1969) 120 CLR 136 at 143, 'the public interest that a serious opposition by a person entitled in fact to oppose the grant of a
3.11.3.2.5 Period of Extensions to be Granted

patent should be dealt with on the merits, rather than that it should be shut out in consequence of a failure in procedure, lamentable though the failure may be."

The balance of the interests of the parties, and of the public interest, is against unnecessarily protracted opposition proceedings however, the Commissioner in deciding whether an extension of time is appropriate in all the circumstances had to give proper, genuine and realistic consideration to all the relevant factors surrounding the extension of time request (A Goninan & Co Ltd v Commissioner of Patents [1997] FCA 424; 38 IPR 213).

Chapter 5 of the Regs, as in force immediately before 15 April 2013, provides a procedural framework whereby opposition matters can be expeditiously determined. This needs to be remembered when extensions of time are considered under reg 5.10 as in force immediately before 15 April 2013.

As a general proposition, the periods prescribed in Chapter 5 of the Regs should normally be sufficient to enable the completion of the relevant actions. Thus parties to an opposition should not assume that any extension of time will be granted. Furthermore, in providing reasons to justify an extension, a party should demonstrate that the circumstances giving rise to the need for an extension are not normal; for example, demonstrate that delays that have resulted in the need for an extension are both unexpected and reasonable.

Where an extension is sought, the period of time granted should be realistic when compared to the prescribed periods. For example, where reg 5.8 as in force immediately before 15 April 2013, allows evidence to be filed within three months, an extension for more than three months would seem unrealistic in the context of the legislation. In general, where extensions are appropriate in the circumstances, the period of extension granted should not adversely affect the expeditious resolution of the opposition.

Any extension of time that the Commissioner grants will only be for the purposes (as well as for any steps or actions consequential to these) for which the extension was applied and the Commissioner found to be justified. To this end, the Commissioner will, where necessary, grant the extension of time subject to terms. When the Commissioner intends to impose
3.11.3.2.6 Parties Involved in Negotiations

terms, he or she will advise the applicant and request their agreement or comments on the proposed terms.

In a situation where the Commissioner considers that an application for an extension of time is not justified, but that there may be reason to conclude that some evidence may be available for service, Burchett J. observed in Ferocem Pty Ltd v Commissioner of Patents [1994] FCA 981; 28 IPR 243 that:

"... even where an application for a particular period ... is regarded as unjustified, it seems to me a decision maker, having a discretion of the kind conferred by Regulation 5.10, should always consider whether some short period ought to be allowed, so that an applicant who may have assumed some extension would be granted will not be shut out entirely from presenting evidence that may be immediately available. I am speaking of a case such as the present, where it was clear the applicant might well have a quantity of evidence ready to file, although its desire was to lodge all the evidence at the same time and in conjunction with the presentation of evidence in the Federal Court Proceedings."

Consequently the Commissioner will consider allowing, where an extension of time is otherwise unjustified, a short extension of time to enable service of "evidence that may be immediately available" to conclude the particular evidence stage.

In effect this may mean that the Commissioner will consider allowing:

- where the requested extension period has not elapsed at the date of the Commissioner’s decision (whether communicated by letter or by written decision), an extension of time to no more than 5 working days from the date of the decision (5 days should normally be more than adequate); or

- where the requested extension period has already elapsed prior to the Commissioner’s decision being issued and evidence has already been filed and served in that period, an extension of time to the date of service of that evidence.

The fact that the evidence is immediately at hand does not impose a duty of the Commissioner to allow an extension of time in opposition proceedings to admit the evidence (see A Goninan & Co Ltd v Commissioner of Patents [1997] FCA 424; 38 IPR 213).

Note: This information applies to oppositions commenced before 15 April 2013, provided the evidentiary period sought to be extended commenced before 15 April 2013.
3.11.4 Restoration of the Right of Priority under the PCT

Note: The regulations referred to in this section of the manual are those in force immediately before 15 April 2013.

Where it is clear that both parties are involved in negotiations, the Commissioner may be reasonably satisfied that a short extension is "appropriate in all the circumstances" provided that:

- if the extension is for more than 1 month, the application for the extension includes something from the other party to confirm that negotiations are occurring;

- where negotiations have been occurring for more than 3 months, the Commissioner will expect to be provided with details of why negotiations have not yet been concluded and an indication of when agreement is likely. The Commissioner will not grant an extension unless conclusion of negotiations appears to be imminent.

3.11.4 Restoration of the Right of Priority under the PCT

In this topic:

For international applications filed after 1 April 2007 the PCT Rules provide for the restoration of the right of priority where an international application is filed up to two months after the end of the normal 12-month priority period. Formally this is not an extension of the priority period – but it has the same practical effect.

Subject to reservations by particular PCT member states, restoration of the right of priority may be made by either the Receiving Office or a Designated Office. Australia does not have reservations to these provisions and hence requests for restoration may be filed with IP Australia as either a Receiving Office or Designated Office.

Restoration of Priority by the Receiving Office

The restoration mechanism is largely dealt within Rule 26bis.3, and operates as follows:
3.11.4 Restoration of the Right of Priority under the PCT

- Restoration is available in respect of priority applications filed between 12 and 14 months before the International Filing Date [Rule 26bis.3(a)].

- The request for restoration must be filed no later than 14 months from the filing date of the priority application [Rule 26bis.3(e)].

The request should be accompanied by a declaration or other evidence in support of the requested restoration [Rule 26bis.3(b)(iii)], and the Receiving Office may require the declaration be filed with it ‘within a time limit which shall be reasonable in the circumstances’ [Rule 26bis.3(f)].

- An extension can be granted on the basis that the Receiving Office is satisfied that the failure to file the international application within the priority period:
  - occurred in spite of due care required by the circumstances having been taken;
  - or
  - was unintentional.

- Subject to reservations being made, each Receiving Office shall apply at least one of these criteria, and may apply both. **IP Australia will apply both criteria.**

- A Receiving Office may charge a fee for processing requests for restoration of priority [Rule 26bis.3(d)].

- The request must state the reasons for failure to file the international application within the priority period, and preferably be accompanied by a declaration [Rule 26bis.3(b)]. The requirements of this declaration are the same as for declarations required to support an extension of time under s.223 of the **Patents Act 1990**.

- A request cannot be refused without giving the applicant an opportunity to make observations on the intended refusal [Rule 26bis.3(g)].

- Where an extension is granted, that fact, and the criteria applied, will be published on the pamphlet [Rule 48.2(a)(xi) and (b)(vi) and (vii)].

- **Subregulation 3.13A** provides for the restoration of the right of priority provided that the restored right of priority has not been found to be ineffective under **Rule 49ter.1**.

An important issue is the basis of the restoration. If the restoration occurs under the ‘in spite of due care’ criterion, that restoration must be recognised by all designated offices (subject to reservations having been made). Restorations based on the ‘unintentional’ criterion will only be recognised by those countries that apply ‘unintentional’ in their national law. Accordingly an extension granted on the basis of ‘in spite of due care’ is far preferable in terms of coverage than one based on ‘unintentional’.
IP Australia requires a declaration setting out the facts which support the request for restoration and will charge a fee of $200 for processing these requests, regardless of whether a request is made under either or both criteria (fee item 308). Note however, that if the applicant provides sufficient reasons in the first instance for restoration of priority, but not in the form of a declaration, it is not necessary to request those reasons in declaratory form.

The requirements of the declaration are the same as for declarations required to support an extension of time under s.223 of the Patents Act 1990 (see 3.11.1 Extensions of Time – Section 223 and/or 3.5.1.1 Written Evidence and Declarations). The time limit for filing the declaration and paying the fee will be the same as the time limit applicable under Rule 26bis.3(e) (ie. normally 2 months from the expiration of the priority period).

If IP Australia intends to refuse a request for restoration of priority, the applicant will be provided a notice of intended refusal according to form PCT/RO/158 and given at least one opportunity to make observations and, where applicable, to submit further declaratory evidence supporting the request for restoration. The period provided for observations or submission of further evidence will be at least one month.

The Rules have put in place a regime that seeks to provide a high degree of certainty. However there is a need for checks and balances at the Designated Office stage. Accordingly, if a restoration is granted:

- the extension is not effective in a Designated State where the Designated Office or a court finds that the requirements to justify the restoration were not complied with [Rule 49ter.1(c)]. This particularly relates to the existence of the relevant criterion; but

- a Designated Office shall not review a decision of the Receiving Office unless it reasonably doubts (in particular) the relevant requirements were met [Rule 49ter.1(d)].

The fact that a Receiving Office refuses a request for restoration does not prevent the applicant applying for restoration under its national law, with Rule 49ter.2 setting out the requirements of national law that must be available (subject to any reservations made).

In general, the criterion of ‘unintentional’ can be equated to the s.223(2)(a) condition of ‘error or omission’. The requirement of ‘in spite of due care’ is of narrower ambit. It would include the force majeure situations that arise under the s.223(2)(b) condition of ‘circumstances beyond control…’. It would also cover a range of s.223(2)(a) errors or omissions. But it would not cover situations where the applicant or their agent had not exercised due care to try to ensure the application was filed within the priority period. For example, a failure to maintain a diary system would probably be taken as an absence of due care. See 3.11.1.4 for more information on the meaning of “despite due care”. Also see the PCT Receiving Office Guidelines – Restoration of the Right of Priority: 166J-166M.
3.12 Extension of Term of Standard Patents Relating to Pharmaceutical Substances

Restoration of the Right of Priority by IP Australia as a Designated Office

In the circumstances indicated above the PCT also provides for restoration by a Designated Office on the basis that the failure to file the international application in time occurred in spite of due care or was unintentional.

If a request is made to IP Australia seeking restoration of the right of priority on the basis of Rule 49ter.2 it will be treated as a request for an extension of time under Section 223 of the Act.

3.12 Extension of Term of Standard Patents Relating to Pharmaceutical Substances

Modified Date: 01 June 2016

3.12 Extension of Term of Standard Patents Relating to Pharmaceutical Substances

In this topic:

Relevant Legislation

The Act

Section 70 Applications for extension of patent
Section 71 Form and timing of an application
Section 74 Acceptance or refusal of application
Section 75 Opposition to grant of extension
Section 76 Grant of extension

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Effective Date: 25 September 2019
Overview

The Intellectual Property Laws Amendment Act 1998 amended the Patents Act 1990 to provide for an extension of term for pharmaceutical patents. The scheme allows patentees to apply for an extension of term of up to 5 years for a standard patent that claims a pharmaceutical substance.

Requirements for Obtaining an Extension of Term

In order to obtain an extension of term for a patent, the following requirements must be met:

- the patent must, in substance, disclose and claim a pharmaceutical substance per se, or a pharmaceutical substance when produced by recombinant DNA technology;
- goods containing or consisting of that pharmaceutical substance must be included in the Australian Register of Therapeutic Goods (ARTG); and
- the first regulatory approval for that pharmaceutical substance must have occurred more than 5 years after the date of the patent.

Provided the requirements of the Act are satisfied, the term of the patent (in its entirety) may be extended.

Rights of Patentee During the Extended Term
The rights of a patentee during the extended term of a patent are however limited over the normal rights in a patent. Although the term of the patent as a whole is extended, exploitation of any form of the invention that is not a pharmaceutical substance and exploitation of pharmaceutical substances for nontherapeutic uses do not constitute infringement of the patent during the extended term (sec 78).

### 3.12.1 Section 70 Considerations

Section 70 sets out certain requirements for obtaining an extension of term.

Under sec 70(2), either or both of the following conditions must be satisfied:

- one or more pharmaceutical substances *per se* must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification;

- one or more pharmaceutical substances when produced by a process that involves the use of recombinant DNA technology, must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification.

In addition, sec 70(3) provides that the following criteria must be satisfied in respect of at least one of those pharmaceutical substances:

- goods containing, or consisting of, the substance must be included in the Australian Register of Therapeutic Goods (ARTG);

- the period beginning on the date of the patent (as determined under sec 65) and ending on the first regulatory approval date must be at least 5 years.
An extension of term is only available in respect of a pharmaceutical substance *per se* that in substance falls within the scope of a claim of a patent, except for substances produced by a process involving the use of recombinant DNA technology.

The Explanatory Memorandum to the *Intellectual Property Laws Amendment Bill 1997* noted that claims to pharmaceutical substances *per se* would usually be restricted to new and inventive substances.

The Memorandum also specified certain circumstances where an extension would not be available:

"Patents that claim pharmaceutical substances when produced by a particular process (product by process claims) will not be eligible unless that process involves the use of recombinant DNA technology. Claims which limit the use of a known substance to a particular environment, for example claims to pharmaceutical substances when used in a new and inventive method of treatment, are not considered to be claims to pharmaceutical substances *per se*." 

This distinction is specifically evident as between the reference in the Act to 'pharmaceutical substances *per se*', and to 'pharmaceutical substances when produced by a process that involves the use of recombinant DNA technology'. The use of the word '*per se*' requires the claim to the substance to be unqualified by process, temporal, or environmental components.


### Claims to Substance per se

In order for the term of a patent to be extended, the patent must contain one or more claims to a pharmaceutical substance *per se*, for example:

- a substance of formula ----- ;
- substance X mixed with substance Y.

Substances for which extensions of term are available include both new compounds *per se* and novel and inventive formulations of known drugs.
Examples of claims that are not directed to substances *per se* are:

- substance X when used .... ;
- substance X when produced by method Y;
- a method of preparing substance X;
- a substance of formula ...., where component Y is produced by .... ;
- 'Swiss' style claims referring to substance X;
- use of substance X in the treatment of Y;
- substance X for use .... ;
- (a specified quantum) of substance X;
- an antiseptic comprising substance X.

**Note:** In some circumstances, a qualifying term, e.g. 'for use', 'when used' or 'an antiseptic', will have no limiting effect on a claim. That is, the claim with the limitation is of the same scope as the claim without the limitation. In these situations, the claim will be directed to a pharmaceutical substance *per se*. However, an objection should be taken if it is uncertain that the qualification has no limiting effect.

**Note:** A reference to a specified quantum of a substance contained within a composition or formulation is not always objectionable (see *Spirit Pharmaceuticals Pty Ltd v Mundipharma Pty Ltd* [2013] FCA 658; *iCeutica* [2018] APO 76, 78).

**Note:** In limited circumstances, a substance may be new and inventive, but can only be defined by reference to the process by which it was made (for example, compound X obtainable by process Y) because the chemical structure or composition is undetermined. In this situation, a claim which defines the substance by reference to such method steps would be a claim to the substance *per se* (see *Zentaris AG* [2002] APO 41). See also *Pharmacia Italia SpA v Mayne Pharma Pty Ltd* [2006] FCA 305.

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**Case Law**

Relevant case law includes the following:

**Boehringer Ingelheim International v Commissioner of Patents [2000] FCA 1918**

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The meaning of the words "pharmaceutical substance per se" was fully considered by Heerey J:

"The 1990 Act in its present form manifests a policy which draws a distinction between, on the one hand, a pharmaceutical substance that is the subject of patent claim and, on the other hand, a pharmaceutical substance that forms part of a method or process claim. The specific exception to the latter (an exception which proves the rule) is the provision for recombinant DNA technology in s 70(2)(b)."

Thus, the extension right is only granted under sec 70 where there is a claim to a pharmaceutical product that is new and inventive, unless the exception under sec 70(2)(b) can be invoked.

This decision was upheld on appeal to the Full Court in *Boehringer Ingelheim International GmbH v Commissioner of Patents* [2001] FCA 647.

**Celgene Corporation [2011] APO 37**

In this case, the patent contained a claim to a pharmaceutical composition when used for treating a particular disorder. It was concluded that the claim was to a process and not a pharmaceutical substance *per se* and consequently the patent did not meet the requirements of sec 70.

**The Children's Medical Center Corporation [2011] APO 80**

The claims under consideration were directed to a combination comprising an amount of thalidomide and an amount of a steroid. The reference to "combination" included combinations where the 2 drugs were presented as an admixture in a single unit dosage form, as well as combinations where the 2 drugs were presented as separate dosage forms of the individual drugs.

It was held that the term "pharmaceutical substance *per se*" is intended to be a pharmaceutical that is presented as a single entity, and not in the form of a kit or as separate dosage forms. Thus, the combination of thalidomide and at least one steroid did not constitute a pharmaceutical substance *per se*.

**Celgene Corporation and Commissioner of Patents and Children's Medical Center Corporation (Joined Party) [2013] AATA 55 (1 February 2013)**
The *Celgene* [2011] and *Children’s Medical Center Corporation* [2011] decisions were both appealed to the Administrative Appeals Tribunal, resulting in the decisions being affirmed.

**LTS Lohmann Therapie-Systeme AG and Schwarz Pharma Limited [2009] APO 16 (21 August 2009)**

The patent contained claims to a transdermal therapeutic system (a transdermal patch) comprising an inert backing layer, a matrix layer containing the active and a protective layer, which is to be removed before application. It was found that the claimed system comprised a pharmaceutical substance in combination with a separate integer (protective layer) and therefore did not constitute a pharmaceutical substance *per se*.

**LTS Lohmann Therapie Systems AG and Schwarz Pharma Ltd and Commissioner of Patents [2010] AATA 809 (22 October 2010)**

The claims were amended and the Lohmann [2009] decision was appealed to the Administrative Appeals Tribunal, where the decision was affirmed.

The granted claims were amended to “pharmaceutical compound for the treatment of diseases adapted to be transdermally administered...” comprising a polymer matrix containing the active, an inert backing layer and a protective layer. However, the altered phrasing for the transdermal patch was not found to change the substance of what was claimed.

**Spirit Pharmaceuticals Pty Ltd v Mundipharma Pty Ltd [2013] FCA 658**

The relevant claims were directed to controlled release formulations of oxycodone characterised by dosage amounts, excipients and/or release profile. Claiming by result (i.e. the desired release profile) was found to have the effect of defining the necessary characteristics of the excipients to be selected in order to achieve that result, and the Court concluded that the pharmaceutical substance *per se* was the mixture of oxycodone and relevant excipients achieving the claimed result.

**Commissioner of Patents v AbbVie Biotechnology Ltd [2017] FCAFC 129**

The Full Court of the Federal Court, overturning the AAT, held that Swiss claims are not claims to pharmaceutical substances. They are directed to (1) a method or process in which a substance is used to produce a medicament and (2) an additional method or process element characterised by a specific purpose for which the medicament is to be used.

**iCeutica Pty Ltd [2018] APO 76, 77, 78**

The Deputy Commissioner considered three patents for which the relevant product listed on the ARTG was a composition containing nanoparticulate diclofenac. While diclofenac was responsible for the relevant chemical or physico-chemical interaction, it was apparent that
the particle size contributed to the solubility and activity of the diclofenac, and it was found that this physical form of the pharmaceutical constituted a pharmaceutical substance *per se*.

In two of these patents ([2018] APO 76, 78) the claims defined unit doses containing specific quantities of diclofenac. The Deputy Commissioner indicated that such a limitation “is only a feature of a pharmaceutical substance *per se* if it is selected so as to achieve the chemical or physico-chemical interaction with the human physiological system.” As the quantity identified in the claim was the same as that in the goods listed on the ARTG, it was a reasonable inference that it had been so selected, and was not merely an arbitrary or convenient selection, and the relevant pharmaceutical substance *per se* was the unit dose having the defined quantity of diclofenac.

3.12.1.2 Meaning of Pharmaceutical Substance

Schedule 1 defines a pharmaceutical substance as follows:

"pharmaceutical substance means a substance (including a mixture or compound of substances) for therapeutic use whose application (or one of whose applications) involves:

(a) a chemical interaction, or physico-chemical interaction, with a human physiological system; or

(b) action on an infectious agent, or on a toxin or other poison, in a human body;

but does not include a substance that is solely for use in *in vitro* diagnosis or *in vitro* testing".

From this definition, the substance must have at least one therapeutic use, which is defined in schedule 1 as follows:

"therapeutic use means use for the purpose of:

(a) preventing, diagnosing, curing or alleviating a disease, ailment, defect or injury in persons; or

(b) influencing, inhibiting or modifying a physiological process in persons; or

(c) testing the susceptibility of persons to a disease or ailment".

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Effective Date: 25 September 2019
3.12.1.3 Meaning of "when produced by a process that involves the use of recombinant DNA technology"

If a substance is listed in the ARTG, there is a *prima facie* assumption that the substance is a pharmaceutical substance, and therefore the Commissioner is unlikely to query whether a substance is a pharmaceutical substance within the meaning of the Act without good reason.

Under sec 70(2)(b), an extension of term is available in respect of a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology.

The issue of whether a process involves the use of recombinant DNA technology was considered in *ImmunoGen, Inc. [2014] APO 88*. In this case the pharmaceutical substance was an antibody conjugated to a cytotoxic drug. The Deputy Commissioner held that the requirement that a process “involves” the use of recombinant DNA technology does not mandate that the process involve new recombinant DNA technology, or that the process be limited entirely to recombinant techniques (*ImmunoGen supra* at [20]). The process for preparing the conjugate as a whole was new but the antibody was produced via known recombinant techniques and this was found to satisfy the requirement of sec 70(2)(b).

Similarly, in *Novartis Vaccines and Diagnostics S.r.l. [2015] APO 2* a pharmaceutical substance comprising “a protein antigen” was held to encompass the antigen produced by recombinant means that was disclosed in the specification.

In *Commissioner of Patents v AbbVie Biotechnology Ltd* [2017] FCAFC 129 and Thrombogenics NV [2015] APO 44, it was found that Swiss claims were not directed to substances when produced by a process *that involves the use of recombinant DNA technology*. The substance is further limited by the therapeutic use. Claim types that have been found to be directed to a substance when produced by recombinant DNA technology include:

Claim types that have been found to be directed to a substance when produced by recombinant DNA technology include:

- Process for preparing a substance (by a process that does not relate to recombinant DNA in the claim, but can only be carried out by recombinant DNA technology) – *ImmunoGen, Inc. [2014] APO 88*
3.12.1.4 Meaning of "mixture or compound of substances"

- A substance prepared by a process (that does not refer to recombinant DNA technology, but can include recombinant DNA technology) – Novartis Vaccines and Diagnostics S.r.l. [2015] APO 2

Claim types that have been found not to be directed to a substance even when involving recombinant DNA technology include:

- Swiss type claims – Commissioner of Patents v AbbVie Biotechnology Ltd [2017] FCAFC 129

The definition of a “pharmaceutical substance” provided in schedule 1 refers to:

"a substance (including a mixture or compound of substances) for therapeutic use …”.

Other than the passing remarks made by Burchett J that the expression “a mixture or compound of substances” was unusual in a scientific context (Virbac (Australia) Pty Limited and Ancare Distributors Limited v Merck Patent GmbH [1994] FCA 1255), this phrase has not been the subject of judicial consideration. However, it has been the subject of Office decisions including Sanofi-Aventis [2007] APO 35 and N. V. Organon [2009] APO 8.

In Sanofi (supra), the claims were to a biphasic composition presented in the product as a bi-layered tablet. In N. V. Organon (supra), the invention involved a steroidal mixture contained in a thermoplastic polymer core, over which was laid a permeable thermoplastic skin through which the steroidal mixture diffused and was delivered in use.

More specifically, in N. V. Organon (supra) it was stated:

“In this light it appears to me that a pharmaceutical substance (including a mixture or compound of substances) can include a compound with a controlled spatial configuration if, as a whole, it can still be considered a pharmaceutical “substance” but the combination of such a substance with what would reasonably be considered a separate physical device, layer or structure or, from Sanofi, “any purely physical integers” is excluded and indeed would not be a “pharmaceutical substance per se”.”

It was recognised that it may be difficult to determine whether a particular feature of a product is correctly considered part of a “substance” rather than a separate physical integer. However, in the circumstances of that case, it was found that the product as a whole exhibited a level of integration or interaction between the component parts that was
3.12.1.5 Meaning of "in substance disclosed"

considered more characteristic of a pharmaceutical substance itself, rather than a substance combined with another element or integer.

It therefore follows that other inventions which potentially involve a spatial configuration need to be considered on their merits.

There is also a need to consider whether a composition claim encompasses a single pharmaceutical substance or a mixture or compound of substances. Where the claim is directed to a mixture or compound of substances, the same must also be found in the goods.

The pharmaceutical substance on which an application for an extension of term is based must in substance be disclosed in the complete specification. The established criteria for determining whether a substance is “in substance disclosed” in the specification apply.

Thus, a substance that has been exemplified in the specification will prima facie have been in substance disclosed.

However, the absence of any explicit examples does not necessarily mean that a substance is not in substance disclosed. The principles of Hoffman-La Roche & Co. AG v Commissioner of Patents (1971) CLR 529 should be applied. In this case, Gibbs J had to determine whether a specific compound was in substance disclosed in a basic application that contained a broad description of a class of compounds, but did not specifically exemplify the particular compound claimed. Gibbs J applied the Mond Nickel Rules from Re Mond Nickel Co. Ltd's Application [1956] RPC 189 and concluded that there was a clear disclosure of the compound in the basic application.

The issue of selection patents in the context of a request for an extension of term was considered in Pfizer Inc v Commissioner of Patents [2005] FCA 137. In this case, the ‘parent patent’ contained a generic disclosure of a compound that was the subject of a ‘selection patent’. It was held that the existence of the selection patent was irrelevant for the purpose of determining whether the parent patent satisfied the disclosure requirements of sec 70(2).

3.12.1.6 Meaning of "in substance fall within the scope of the claim"
3.12.1.6 Meaning of "in substance fall within the scope of the claim"

The test for whether a pharmaceutical substance in substance falls within the scope of a claim was considered in Boehringer Ingelheim International GmbH v Commissioner of Patents [2001] FCA 647. At [42] it is stated as:

"in the context of s 70(2)(a), we think that falling within the scope of a claim in a patent specification means included amongst the things claimed."

This means that the things that are within the scope of a claim are not the integers that appear within the claim, but the total invention that the claim defines.

In Prejay Holdings Ltd v Commissioner of Patents [2003] FCAFC 77, all of the claims were directed to methods. Wilcox and Cooper JJ (Allsop J concurring) held (at [24]) that a substance that is mentioned in the context of a method claim does not per se fall within the scope of a method claim:

"for a substance to fall within s 70(2)(a) it must itself be the subject of a claim in the relevant patent. It is not enough that the substance appears in a claim in combination with other integers or as part of the description of a method (or process) that is the subject of a claim."

In Idenix Pharmaceuticals, Inc., L'Universite Montpellier II and Centre National De La Recherche Scientifique [2012] APO 113, the delegate considered a "when used' claim and stated:

"I conclude that a pharmaceutical substance per se will not in substance fall within the scope of a claim that is directed to a method."

The meaning of “in substance fall within the scope of the claim” was recently considered in the context of sec 70(2)(b). In ImmunoGen, Inc. [2014] APO 88, a claim was directed to a process for producing an antibody conjugate, the process involving recombinant DNA technology. The Deputy Commissioner concluded that a claim to a product made by a particular process is substantially indistinguishable in scope from a claim to the particular process used to make the product. Consequently, it was held that the conjugate, when produced by a process that involves the use of recombinant DNA technology, in substance falls within the scope of a claim to a process for preparing the conjugate.

In Commissioner of Patents v AbbVie Biotechnology Ltd [2017] FCAFC 129 and Thrombogenics NV [2015] APO 44, it was found that a pharmaceutical substance when produced by a process that involves recombinant DNA technology did not in substance fall within the scope of a Swiss claim, since such a claim includes a method or process element directed to the intended purpose of the pharmaceutical substance. See also 3.12.1.3.
3.12.1.7 Included in the Goods

In this topic:

Under sec 70(3), goods containing, or consisting of, a pharmaceutical substance must be included in the Australian Register of Therapeutic Goods (ARTG). The issue of what are the goods included in the ARTG, and whether they contain or consist of the sec 70(2) substance, has been considered in several decisions, as outlined below.

Merck & Co., Inc v Arrow Pharmaceuticals Limited [2002] APO 13

The nature of the ARTG and its relationship with sec 70(3) was discussed in detail. The hearing officer concluded that not all of the documents held on the Therapeutic Goods Administration file for a particular pharmaceutical substance form part of the Register.

Merck & Co., Inc v Arrow Pharmaceuticals Ltd [2003] FCA 1344

Wilcox J determined that a pharmaceutical substance should be considered to be included in the ARTG where it can be demonstrated that the substance is contained in a good which is included in the ARTG. The particular pharmaceutical substance need not be a named active ingredient in the ARTG, but may be an impurity present in only small amounts, e.g. a metabolite. Provided it can be established that the substance is included, then the entry can be considered to satisfy the requirements of sec 70(3).

H Lundbeck A/S v Alphapharm Pty Ltd [2009] FCAFC 70
3.12.1.7 Included in the Goods

The subject of the patent was the (+)-enantiomer of the drug citalopram. Pharmaceutical substances containing the racemic form of citalopram (Cipramil) were included in the ARTG. In relation to sec 70(3), the Court considered the question:

“are there goods on the ARTG that contain (+)-citalopram, the (+) enantiomer?”

In addressing this issue, the Court stated:

“it is a simple comparison of the pharmaceutical substance with the “ingredients” of the goods on the ARTG. The question is whether Cipramil contains or consists of the (+)-enantiomer molecule. Given that the racemic mixture includes both the (-)-enantiomer and the (+)-enantiomer in equal parts, Cipramil must “contain” the (+)-enantiomer.”

Thus, inclusion of goods containing, or consisting of, a racemic mixture in the ARTG, amounts to inclusion of goods containing, or consisting of, the individual enantiomers.

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**Celgene Corporation [2011] APO 37**

The pharmaceutical substance in question was a specific crystalline form (polymorph) of lenalidomide. In determining the goods included in the ARTG, consideration was given to the ARTG certificate. The certificate included information regarding approval to supply the product ‘REVLIMID lenalidomide’ and ‘Product Specific Indications’ relating to the use of the drug.

It was concluded that in identifying the goods included in the ARTG, no account should be taken of any ‘indications’, i.e. the ‘goods’ for the purposes of sec 70(3) is the product appearing on the ARTG certificate. As the certificate did not specify the crystal form of lenalidomide present in REVLIMID, there were no goods that contained, or consisted of, the polymorph of lenalidomide.

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**The Children’s Medical Center Corporation [2011] APO 80**

The patentee identified the pharmaceutical substance (for the purposes of sec 70(2)) as a combination of thalidomide and at least one steroid. The ARTG certificate stated that the patentee had approval to supply thalidomide, whilst the ‘Product Specific Indications’ stated that the thalidomide could be used in combination with a steroid for the treatment of multiple myeloma.
Consistent with *Celgene (supra)*, it was held that the indication provided, i.e. the use of a combination of thalidomide and a steroid, was not an element of the goods in the ARTG. Thus, the therapeutic ‘goods’ included in the ARTG was thalidomide and not the combination.

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**iCeutica Pty Ltd [2018] APO 78**

The pharmaceutical substance for the purposes of sec 70(2) was characterised by a dissolution profile. No evidence establishing that the relevant goods exhibited that profile was provided, but the attorney for the patentee stated that they were “instructed that the [pharmaceutical substance] is contained or comprised in [the goods]”. The Deputy Commissioner concluded that this was insufficient to satisfy him, on the balance of probabilities, that the requirement of sec 70(3) was satisfied.

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Under [sec 70(3)](https://www.faa.gov/regulations_policies/laws_statutes/), the period beginning on the date of the patent and ending on the first regulatory approval date for the pharmaceutical substance must be at least 5 years. The first regulatory approval date, in relation to a pharmaceutical substance, is defined in [sec 70(5)](https://www.faa.gov/regulations_policies/laws_statutes/) as:

- where there is no pre-TGA marketing approval in relation to the substance, the date of commencement of the first inclusion in the ARTG of goods that contain, or consist of, the substance; or

- where there is pre-TGA marketing approval in relation to the substance, the date of the first approval.

Goods may be included in the ARTG as registered goods, provisionally registered goods, listed goods, biologicals or medical devices. Importantly, not everything that is included in
the ARTG will satisfy the other requirements of section 70 (for example, medical devices, or biologicals which are used to replace parts of the anatomy in a person, are unlikely to be considered pharmaceutical substances per se).

‘First inclusion in the ARTG’ means the first time the goods are included in the ARTG, regardless of what part of the register the goods are included in.

**Note:** ‘Registered goods’ are assessed by the TGA for quality, safety and efficacy. ‘Listed goods’ are assessed for quality and safety, but not efficacy. ‘Biologics’ comprise, contain or are derived from human cells or tissues.

While the pharmaceutical substance on which an application for an extension of term is based must in substance fall within the scope of a claim, where the claims encompass more than one pharmaceutical substance, the ‘first inclusion in the ARTG’ refers to the earliest date on which at least one substance falling within the scope of the claims was included in the ARTG.

According to sec 71(2) an application for an extension of term must be made within 6 months of the latest of the date of grant of the patent or the date of commencement of the first inclusion in the ARTG of goods that contain, or consist of, any of the pharmaceutical substances referred to in sec 70(3) (see 3.12.2.2).

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**Case Law**

**Pfizer Corp v Commissioner of Patents [2006] FCAFC 190**

The case concerned 4 patents, each relating to a pharmaceutical substance. The term of each patent was extended on the basis that the first regulatory approval date was the date on which the relevant pharmaceutical substance was entered into the part of the ARTG relating to registered goods. However, it was subsequently found that the pharmaceutical substances had previously been entered into the part of the ARTG relating to listed goods. Consequently, the Commissioner altered the expiry date of the patents to reflect the date of first listing, thereby reducing the lengths of the extensions of term.

The Court considered the issue of whether the first regulatory approval date was the date on which the substance was entered into the part of the ARTG relating to registered goods, or the date on which the substance was entered into the part relating to listed goods. It was held that the goods in question were first included in the ARTG when they were included in that part relating to listed goods. Furthermore, there was no error on the part of the
Commissioner in treating the first inclusion of the relevant goods in the part of the ARTG relating to listed goods, as the first regulatory approval date of those goods.

**Pfizer Italia S.r.l. [2007] APO 2**

The patent in question related to a number of pharmaceutical substances. An extension of term was granted on the basis of one substance, Zavedos. The patentee subsequently notified the Commissioner that several other pharmaceutical substances claimed in the patent had first regulatory approval dates that were earlier than that of Zavedos.

Under sec 77, the length of an extension of term is equal to the period beginning on the date of the patent and ending on the earliest first regulatory approval date in relation to any of the pharmaceutical substances referred to in sec 70(2), reduced (but not below zero) by 5 years.

It was held that the correct interpretation of sec 77 is that the extension is determined on the earliest first regulatory approval date that applies to the substances in the patent and not only with regard to the substance on which the application for an extension is based.

In this case, the earliest first regulatory approval date was for the substance Adriamycin (13 November 1989) and not Zavedos (19 August 1999). As a consequence, the extension of term granted according to sec 77 was zero.

**G.D.Searle LLC [2008] APO 31**

The patentee applied for an extension of term based on the pharmaceutical substance darunavir. It was subsequently found during examination that there was another substance, amprenavir, which fell within the scope of the claims and was included in the ARTG. As amprenavir was registered before darunavir, the extension of term had to be based on the former substance. It was immaterial that the registration of amprenavir was sponsored by a person other than the patentee.

**AbbVie Biotechnology Ltd [2015] APO 45**

The earliest regulatory approval date was the date of the goods were first registered, not the date of subsequent inclusions for various different indications. This decision was affirmed by the AAT in *AbbVie Biotechnology Ltd v Commissioner of Patents* [2016] AATA 682 at [82]-[89].
iCeutica Pty Ltd [2018] APO 77

The patent included a claim directed to a composition comprising nanoparticles of diclofenac, olanzapine, raloxifene or fenofibrate. The patentee applied for an extension of term based on a composition comprising nanoparticles of diclofenac. It was subsequently found that the claims included a composition comprising nanoparticles of fenofibrate which was listed on the ARTG ten years earlier than the composition the subject of the sec 70 application. The application therefore did not comply with sec 71(2).

Note: The term of a patent cannot be extended if it has previously been extended under the Intellectual Property Laws Amendment Act 1998 (sec 70(4)).

An extension can be granted where a previous extension of term was granted, and subsequently found to be invalid. This was the situation with Alphapharm Pty Ltd v H Lundbeck A/S [2014] FCA 1185.

The relevant date for assessing compliance with sec 70(4) is the day on which the examination decision is made (Alphapharm Pty Let, Apotex Pty Ltd, Aspen Pharma Pty Ltd, Sandoz Pty Ltd v H Lundbeck A/S [2014] APO 41 at paragraph 56).

3.12.2.1 Documentation Required

In this topic:

Introduction

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Effective Date: 25 September 2019
An application for an extension of term must be in the approved form (Form P/00/052b available on the IP Australia website).

The application must include the following:

- applicant (patentee) and patent details;
- information regarding the pharmaceutical substance on which the application for an extension of term is based and the goods containing, or consisting of, the substance; and
- information to the best of the patentee’s knowledge about the first regulatory approval date relating to the substance and the earliest first regulatory approval date applying to the patent;
- information concerning the inclusion of the goods in the ARTG; and
- state that there are no relevant proceedings in relation to the patent, or provide details of the relevant proceedings.

### Applicant and Patent Details

The following information must be provided:

- the name of the patentee (or their agent);
- the address of the patentee (or agent);
- an address for service; and
- the patent number.

### Pharmaceutical Substance and Goods Containing, or Consisting of, the Substance

The application must identify the relevant pharmaceutical substance and the related goods containing or consisting of the substance that are included in the Australian Register of Therapeutic Goods (ARTG).
Regulation 6.8(3) requires the application to be accompanied by information identifying the substance, as it occurs in the goods, in the same way (as far as possible) as the substance is identified in the complete specification of the patent. Therefore, requests which merely mirror the claims may not properly reflect the proportions of the ingredients as they occur in the goods. (Southern Cross Pharma Ltd v Euro-Celtique S.A. [2016] APO 1).

The application must also separately indicate:

- how the pharmaceutical substance *per se* or when produced by a process that involves the use of recombinant DNA technology is in substance is disclosed in the complete specification; and
- how the pharmaceutical substance *per se* or when produced by a process that involves the use of recombinant DNA technology in substance falls within the scope of a claim or claims.

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**First and earliest first regulatory approval date**

The patentee must identify, to the best of their knowledge, the first regulatory approval date for goods containing, or consisting, of the relevant substance as well as the earliest first regulatory approval date in relation to the patent.

Often this will be the same date but may be different where, for example, the patent covers multiple substances.

The first regulatory approval date can include a listing for export however pursuant to ss 70(5A) an inclusion in the ARTG is to be disregarded if it was sought for the sole purpose of exporting goods containing the pharmaceutical substance from Australia to be used in an eligible importing country in circumstances governed by the TRIPS Protocol.

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**Information concerning the inclusion of the goods in the ARTG**

The application must include

- A copy of a print out from the ARTG, or other document, showing that the goods are currently included in the ARTG; and

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Effective Date: 25 September 2019
3.12.2.2 Time for Applying

- A certificate issued under the *Therapeutic Goods Act 1989*, or other document, showing the date of commencement of the first inclusion in the ARTG of goods that contain, or consist of, the substance.

### Information about relevant proceedings

The patentee must state either that there are no relevant proceedings (as defined in the Act) or identify the Court proceedings, usually by providing the court number, for example VID99/1999.

If there are relevant proceedings no decision can be made in relation to the application without leave of the Court. The application should be referred to Patent Oppositions.

3.12.2.2 Time for Applying

Under sec 71(2), an application for an extension of term of a standard patent must be made during the term of the patent and within 6 months after the latest of the following dates:

- the date the patent was granted;
- the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods (ARTG) of goods that contain, or consist of, any of the pharmaceutical substances referred to in sec 70(3);
- the date of commencement of the extension of term provisions (27 January 1999).

An application for an extension of term cannot be made before the patent is granted.

**Note:** The first inclusion in the ARTG refers to any inclusion, including registering export approval of a drug prior to obtaining marketing approval.
3.12.2.3 Extension of Time to Apply for an Extension of Term

In this topic:

Where an application for an extension of term is not made within the prescribed period (see 3.12.2.2 Time for Applying), the provisions of sec 223 are generally available to extend the time for doing a relevant act relating to the application, provided the patentee can demonstrate an error or omission, or circumstances beyond control.

Thus, where a request for an extension of term is filed during the term of a patent, but outside 6 months of the latest of the dates specified in sec 71(2), an extension of time under sec 223 may be sought to allow the request to be considered.

Exclusions

Under reg 22.11(4)(b), a relevant act for the purposes of sec 223 does not include:

"filing, during the term of a standard patent as required by subsection 71(2) of the Act, an application under subsection 70(1) of the Act for an extension of term of the patent".

Thus, it is not possible to obtain an extension to the time for filing a request for an extension of term where the request is filed outside the term of the patent. An extension of time is intended to be available for a request for an extension of term where the request is filed during the term of the patent.

Consequently, where a request for an extension of term is filed after the expiry of the original 20 year term, sec 223 cannot be used to allow the request to be considered.

Case Law

Relevant decisions relating to an extension of time to apply for an extension of term include:
3.12.3.1 Initial Processing

- **Boehringer Ingelheim International GmbH** [1999] APO 60, where an application for an extension of time was refused, as the patent had already expired when the request for an extension of term was filed.

- **Alphapharm Pty Ltd v H Lundbeck A-S** [2014] HCA 42, where the extension of term application is made during the term of the patent, section 223 can apply to extend the time to apply for an extension of term.

### 3.12.3 Processing an Application for an Extension of Term

**Modified Date: 01 July 2016**

### 3.12.3.1 Initial Processing

In this topic:

ERA will check that certain requirements have been met before forwarding an application for an extension of term to Examination Section CHEM 3. These include:

#### Application Made in the Name of the Patentee

The application for an extension of term must be made by the patentee, i.e. the person currently entered in the Register as the grantee or proprietor of the patent.

If the application is made by a person who is not the patentee or entered in the Register as the proprietor, ERA will advise the applicant:

- to take appropriate action under sec 187 (to register an assignment) or sec 191A (to correct the Register); and

- that the extension cannot be processed until the action under sec 187 or sec 191A is finalised.

The applicant will be given a reasonable period, for example 2 months, in which to correct the deficiency. If no response is received, the application is taken not to have been made. This cannot be later rectified by amending the name of the applicant to be that of the patentee, unless there has been a clerical error or obvious mistake.
3.12.3.2 Consideration of the Application

Address for Service

The patent attorney used by a patentee to prosecute an extension of term may be different from the attorney used to prosecute the patent application. However, there can be only one address for service for a patent. Where the address for service stated on the application for an extension of term is different from that on record, this will not be considered to be a notice under reg 22.10(2) to change the address for service. ERA will inform both patent attorneys of this fact and all correspondence relating to the extension of term will be sent to the official address for service.

Patent in Force

A patent must be in force when an application for an extension of term is made. If the patent is not in force, ERA will advise the patentee that the patent has ceased and invite them to pay the appropriate renewal fee. The patentee will be given a reasonable period, for example 2 months, in which to pay the fee. If no response is received, the application is taken not to have been made.

Where the term of a patent has expired before the application for an extension of term has been determined, then renewal fees for the twentieth and subsequent anniversaries are not due until 6 months after the extension of term is granted (reg 13.6(1A)).

Payment of Fees

If an application fee has not been paid, ERA will issue an invitation to pay the fee. If the fee is not paid by the due date, the application is taken not to have been made.
3.12.3.2 Consideration of the Application

Note: It is not in the public interest for the Commissioner to grant an extension of term on a patent that is clearly invalid.

Consequently, before proceeding to consider the extension of term application against the requirements of sec 70 and sec 71, examiners are to check whether there is any information relevant to the validity of the patent that was not available at the time the patent application was accepted. This could be information that is available due to the examination of an equivalent patent application in another jurisdiction, or from court proceedings in Australia or overseas.

If relevant information is found, examiners should consider whether the patent should be re-examined according to the procedures in 2.22 Re-Examination (Chapter 9 and Section 101G).

In this topic:

An application should be considered as soon as possible after filing. Prior to granting an extension of term, examiners must determine whether the application meets the requirements of sec 70 and sec 71 (see also 3.12.1 Section 70 Considerations).

In general, patentees would be expected to comply with the requirements in the first instance. In this situation, the application for an extension of term should be accepted (see 3.12.3.3 Grant of Application for Extension of Term). However, if examiners identify any deficiencies, they should proceed as outlined below.

Deficiencies in Application

Where there are deficiencies in the application, examiners should issue the patentee with a notice outlining these and provide them with a 2 month period in which to provide further information (reg 6.11). Upon request from the patentee, the Commissioner can grant up to a 4 month extension of this period (i.e. 6 months in total from the initial notice). If the patentee requires more than 6 months from the initial notice, they will need to use the provisions of sec 223 and demonstrate that either:

- there was an error or omission by the person concerned or by their agent or attorney; or
- there were circumstances beyond the control of the person concerned.
3.12.3.3 Grant of Application for Extension of Term

Patentee Attempts to Rectify Deficiencies

If the patentee overcomes the deficiencies raised in the notice, the application should be accepted.

Where the patentee attempts to rectify the deficiencies, but deficiencies still remain, the Commissioner may again issue a notice as above, or may initiate action to refuse the application. In the latter situation, the case should be forwarded to the Deputy Commissioner OH&L or the Supervising Examiner OH&L for action.

Note: Section 104 may be used to amend the application for an extension of term to correct any deficiencies. However, if the amendments materially alter the scope or the meaning of the application (e.g. if the application referred to the wrong patent number), then they will have to be advertised (reg 10.5(2)).

Patentee Does Not Attempt to Rectify Deficiencies

Where the patentee does not take steps to rectify the deficiencies identified within the time allowed, the Commissioner will initiate action to refuse the application (see 3.12.3.4 Refusal of Application for Extension of Term).

3.12.3.3 Grant of Application for Extension of Term

Where the requirements of sec 70 and sec 71 have been met, the Commissioner must accept an application for an extension of term (sec 74).

Under sec 76(1), the extension of term will be granted if there is no opposition to the grant, or the opposition is unsuccessful. On granting the extension, AusPat and the Register will be updated to include the new expiry date.
3.12.3.3.1 Renewal Fees

Where an extension of term is granted on a standard patent, annual renewal fees are still due for each year, or part year, of the extension. The consequence of failing to pay these fees within the time limits prescribed by reg 13.6 will result in the patent ceasing. The annual fees for the twentieth and subsequent years are specified in schedule 7 (item 211). The final year of the extension may not be a full year due to the way the extension is calculated under sec 77. However, the annual fee for the last year will still be the same as if it was for a full year.

Where an extension of term is not granted before the twentieth anniversary, then regulation 13.6(1A) prescribes that the twentieth anniversary fee is due 6 months after the grant of the extension of term.

Modified Date: 01 June 2016

3.12.3.4 Refusal of Application for Extension of Term

Where the requirements of sec 70 and sec 71 have not been met, the Commissioner must refuse an application for an extension of term (sec 74). In this situation, OH&L will notify the patentee in writing of the reasons for refusal and publish a notice of refusal in the Official Journal.

Note that the patentee will be provided with an opportunity to be heard on the matter before refusal (sec 216) and any decision to refuse can be appealed to the AAT (sec 224(1)(a)).

Modified Date: 01 June 2016

3.12.4 Calculating the Length of the Extension of Term

The maximum length of an extension of term is 5 years. Under sec 77, the length of an extension is equal to the period between the date of the patent (sec 65) and the date of the earliest first regulatory approval, reduced (but not below zero) by 5 years. Thus:

- where the period between those two dates is 5 years or less, a patent will not be eligible for an extension of term;
- a period of 10 or more years will allow a full 5 year extension; and
3.12.4 Calculating the Length of the Extension of Term

- A period of in between 5 to 10 years will have an incremental extension of term somewhere between 0 and 5 years.

A simple way to calculate the date to which a patent can be extended is as follows:

<table>
<thead>
<tr>
<th>Time Between the Date of the Patent and the Date of First Regulatory Approval (Years)</th>
<th>Extension Granted</th>
</tr>
</thead>
<tbody>
<tr>
<td>Less than 5 years</td>
<td>No extension</td>
</tr>
<tr>
<td>Between 5 and 10 years</td>
<td>15 years from the date of first regulatory approval</td>
</tr>
<tr>
<td>10 years or more</td>
<td>25 years from the date of the patent</td>
</tr>
</tbody>
</table>

The date of a patent is usually the date of filing of the relevant complete specification. However, reg 6.3 provides for the determination of a different date in a number of circumstances. The most common of these is where there is a patent granted on a divisional application, in which case the date of the patent is the date of filing of the complete specification in which the invention was first disclosed. The other circumstances relate to applications made under sec 33 to sec 36.

Examples of Calculations

- The date of the patent was 14 August 1986 and therefore without an extension of term, the patent would expire on 14 August 2006. The first regulatory approval was given on 12 June 1990. The difference between the date of the patent and regulatory approval is less than 5 years and consequently there is no extension of term.

- The date of the patent was 28 November 1989, which was the date of filing of the complete specification. Without an extension of term, the patent would expire 20 years from that date on 28 November 2009.

  The first regulatory approval was given on 4 April 1996. The difference between the date of the patent and the marketing approval is more than 5 years but less than 10.

  The patent, if it met the requirements of sec 70 and sec 71, would be eligible to be extended until 15 years from the date of approval, i.e. an extension until 4 April 2011.
• The date of the patent was 20 June 1980 and therefore without an extension of term the patent would expire on 20 June 2000.

The first regulatory approval was given on 18 November 1991. The difference between the date of the patent and regulatory approval is more than 10 years. Consequently, the patent is entitled to a full extension of 25 years from the date of the patent, i.e. an extension until 20 June 2005.

Section 83 covers the extension of term provisions for patents of addition. In general, patents of addition remain in force for as long as the patent for the main invention remains in force. However, sec 83(3) and sec 83(4) provide exceptions to this rule.

Under sec 83(3), the term of a patent of addition may be extended even though the patent for the main invention is not. For example, a patent of addition may be granted for a pharmaceutical substance in situations where the substance is not patentable as a separate invention, as it does not involve an inventive step in respect of the disclosure of the patent for the main invention. If a pharmaceutical substance registered in the Australian Register of Therapeutic Goods is only in substance disclosed in the patent of addition, and not in the patent for the main invention, it will only be the patent of addition which is eligible to have its term extended. In this case, the patent of addition becomes an independent patent when the extension of term begins.

Under sec 83(4), where the patent for the main invention is extended and the term of the patent of addition is not, then the term of the patent of addition expires at the end of the unextended term of the patent for the main invention.

The patents derived from a parent application and its divisional application are each entitled to a separate extension of term. However, it should be noted that there are time limits for filing divisional applications. Consequently, it is unlikely that a divisional application will be filed to separate out different pharmaceutical substances with different ARTG registration dates from a single patent.
3.12.7 Opposition to Extension of Term

Once an application for an extension of term is advertised accepted, third parties have 3 months from the date of publication of the notice of acceptance in the Official Journal to file a notice of opposition to the extension of term (sec 75 and reg 5.4(2)).

The only grounds of opposition are that the requirements of sec 70 or sec 71 are not satisfied. Thus, issues such as novelty, inventive step, manner of manufacture and utility cannot be brought into the opposition.

Where there is an opposition, the provisions of Chapter 5 apply. Where a decision to grant or refuse an extension of term is issued following an opposition, the decision can be appealed to the Federal Court (sec 75(4)).

3.12.8 Relevant Court Proceedings Pending

Under sec 79A, the Commissioner must not make a decision regarding an extension of term without the leave of the court if relevant proceedings are pending. The Commissioner will therefore ask the patentee whether relevant proceedings are pending at the time of filing an application for an extension of term, as well as before an extension is granted or refused.

In general, the Commissioner will not seek approval from the court to proceed with an extension of term, but instead expect the patentee to do so expeditiously. However, there is a public interest in knowing whether an extension is to be granted. Therefore, if the relevant proceedings do not appear to be progressing, and the public interest is adversely affected by the delay, the Commissioner may consider seeking relevant directions from the court.

3.12.9 Rectification of the Register
Under sec. 191A, the Commissioner may rectify an error in the Register, for example to remove a reference to an extension of term to which a patentee is not entitled. For further information, see 3.10.3 Amendment of the Register.

### 3.13 Documents not OPI - Orders for Inspection

**Note:** This information applies on or after 15 April 2013 to documents filed before, on or after that date.

In this topic:

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**Relevant Legislation**

**The Act**

- Section 55  
  Documents open to public inspection
- Section 56  
  Certain documents not to be published

**The Regulations**

- Reg 4.3  
  Prescribed documents: public inspection

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This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
Section 55 and reg 4.3 (and equivalent provisions for PCT applications) provide that certain documents are open to public inspection (OPI) in certain circumstances. Otherwise section 56 prohibits publication and public inspection and mandates under section 56(1)(b) that the documents:

"are not liable to be inspected or produced before the Commissioner or in a legal proceeding unless the Commissioner, court, or any person having power to order inspection or production, directs that the inspection or production be allowed."

Documents that do not become OPI by virtue of reg 4.3 include:

- Reg 4.3(1)(c) - documents that would be privileged from production in legal proceedings on the ground of legal professional privilege (but only up to acceptance or grant of an innovation patent);
- Reg 4.3(2)(a) - a document that is subject to an order of a court or a tribunal that prohibits disclosure of the document or information in the document; and
- Reg 4.3(2)(b) - a document that the Commissioner has reasonable grounds for believing should not be open to public inspection.

Accordingly the Commissioner has the power under reg 4.3(2)(b) to direct that a document not be OPI (whether or not it has previously become OPI) and may direct that a document that is not OPI, whether because of reg 4.3(2)(b) or otherwise, may be inspected.

Inspection in these circumstances will invariably be subject to conditions as to access and require legally enforceable undertakings regarding confidentiality.
3.13.1 Documents not-OPI by direction of the Commissioner - Regulation 4.3(2)(b)

Reg 4.3(2)(b)

Under reg 4.3(2)(b) the Commissioner may direct that a document that is:

a. associated with a complete application, or with any provisional application associated with the application; and

b. in the possession of the Patent Office

is not open for public inspection (OPI) even though other documents in relation to an application are OPI under the legislation. This includes the specification of an associated provisional application but not the specification of the complete application which is specified explicitly in section 55 rather being prescribed under reg 4.3.

When will the Commissioner direct that a document is not OPI

The Commissioner may direct that a document (other than the complete specification) is not-OPI if she or he has reasonable grounds for believing that it should not be OPI. In applying this provision the Commissioner must take into account the purpose of the Act and the legislative scheme which ensures that, with few exceptions, documents filed in relation to a patent application are made available to the public after 18 months from the priority date. This is to ensure that the public disclosure of the invention that balances the grant of a patent is achieved, as well making available to the public the documents that formed the basis of the Commissioner’s decision to grant the patent and which are relevant for assessing its validity.

Consequently the Commissioner will only direct that a document is not OPI where the interests in maintaining confidentiality in the information contained in the document clearly outweighs the general public interest requiring disclosure. This may be the case where the information contains sensitive personal information, or disclosure risks some significant harm, including commercial harm, being done to the interests of a person concerned.

When weighing up the varying interests it is appropriate to consider whether the interests of a third party directly impacted by a direction, eg. an opponent, can be addressed by ordering inspection – see 3.13.2.

An example of when a direction will be appropriate is where information is provided to the Commissioner to justify an extension of time that includes details of serious medical conditions. In such circumstances, general availability to members of the public, with no direct interest in the matter, is not justified.

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
3.13.1 Documents not-OPI by direction of the Commissioner - Regulation 4.3(2)(b)

Another situation in which the Commissioner may direct that information be not-OPI is where evidence filed in opposition proceedings includes information that is highly commercially sensitive and the public interest in general disclosure is low. This will be the case where a filed document includes sensitive information that is incidental to the purpose for which the document was filed. However where, for example, the sensitive information goes directly to a question of validity it is more likely that the public interest will favour the document being OPI.

It is insufficient to merely assert that a document contains information that is “commercial in confidence” and that it should therefore not be OPI. Substantive reasons must be given as to why disclosure of the information will be harmful and the Commissioner may require evidence to support the request.

The Commissioner may direct that a document be not-OPI whether or not it has previously become OPI under the legislation. Where appropriate a direction that a document be not-OPI may be revoked either following a request or at the initiative of the Commissioner. The Commissioner will not proceed without inviting submissions from the persons concerned.

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**Redacted documents**

Under reg 4.3(2)(b) the Commissioner may only direct that a document is not OPI not a part of a document. However, where the Commissioner has directed that a document be not-OPI and the sensitive information forms a small or incidental part of the document, the Commissioner may request that a further copy of the document be provided with the sensitive information redacted or, alternatively, IP Australia may make a redacted copy. The redacted version would then be associated with the application and become OPI.

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**Procedure**

The legislation does not require the Commissioner to vet all filed documents for sensitive information. Rather, if the person filing the document requests that the Commissioner consider the matter or the Commissioner becomes aware of personally sensitive information in the ordinary course of her or his duties, the Commissioner will consider whether reg 4.3(2)(b) should be invoked.
3.13.2 Inspection of non-OPI documents

If a document is filed with a request that it be declared not-OPI under reg 4.3(2)(b), or a document is identified containing sensitive personal information of the type indicated above, the document should be referred to the Supervising Examiner OH&L.

If the document has been entered into PAMS it should be marked as deleted pending consideration of its status.

If a decision is made that the document be not-OPI the document will be removed from PAMS and held as physical media in the OH&L secure store. The applicant and other interested parties will be informed and copy of the decision will be included in the file (and will become OPI).

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**Appeal**

A decision made under reg 4.3(2)(b) to treat or not to treat a document as OPI is reviewable by the AAT under subparagraph 22.26(2)(a)(iia).

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**3.13.2 Inspection of non-OPI documents**

Note: This information applies on or after 15 April 2013 to documents filed before, on or after that date.

In this topic:

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**Introduction**

The Commissioner may order inspection of non-OPI documents under section 56(1)(b) of the Act. This is most likely to occur in relation to:

- ownership disputes;
- sec 223 requests; and
3.13.2 Inspection of non-OPI documents

- where production of documents has been ordered by the Commissioner.

Where a request is made for inspection of a document that is not OPI (whether by virtue of reg 4.3(2)(b) or otherwise), the person making the request, and any person having an interest in the documents concerned, may be entitled to be heard by the Commissioner. Thus any requests under sec 56(1)(b) must be forwarded to the Supervising Examiner or Deputy Commissioner in OH&L.

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**When is access granted**

An order for inspection is an exception to the fundamental rule requiring that documents not be published or available for inspection if they are not made OPI under the Act and Regulations. Inspection will however be allowed where it is appropriate, taking into account the interests of the relevant parties and the public interest. Most often this will be where the ability of a party to take some action under the Act, for example to oppose the grant of patent or extension of time, is significantly limited unless they are given access to documents that have been put before the Commissioner.

However, even then, the Commissioner will invariably impose conditions intended to maintain confidentiality in the information to the maximum extent possible. These will include requiring undertakings of confidentiality and restrictions on the persons who may inspect the documents. In appropriate cases it may also include providing inspection of documents from which sensitive information has been redacted.

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**Who access is granted to**

Where there is a justification for granting access to unpublished documents, the general rule is that they can be made available to a person’s legal representative on the making of appropriate undertakings regarding confidentiality. However the appropriateness of this must be assessed on the merits of each individual case.

Inspection will usually be limited to a party’s legal representative or an employee of the legal representative or an independent third party expert. In certain circumstances, such as ownership disputes, the other party would be granted restricted access if it could be shown that access was essential in the interests of justice and there would be no breach of duty of confidentiality. (See Davies v Eli Lilly & Co. (1987) 1 All ER 801)
Of course, if the parties can mutually agree to access, documents can be exchanged outside the Patents Act without involving the Commissioner.

In cases of disputed entitlement where inspection cannot be agreed, it may be appropriate to follow the process adopted in *Brisalebe v Searle* 30 IPR 91, (1994) AIPC 91-088:

- the person seeking access provides the Commissioner with a statement of what they allege their invention to be;
- a patent examiner (or other agreed third party) compares the statement of the alleged invention with the disclosure of the specification, and reports whether the alleged invention was disclosed in the unpublished specification;
- upon appropriate undertakings as regard confidentiality being made, the report is given to the person seeking access (or their legal representatives).

This approach was also followed in *Impact Post Anchors v Vincent Charles Carsburg* [1999] APO 15.

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**Place for inspection**

Inspection normally occurs at IP Australia’s premises in Canberra under the supervision of an IP Australia staff member.

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**Appeal**

A decision made by the Commissioner under section 56(1)(b) to order or not order inspection of a document is reviewable by the AAT under section 224(1)(a).

**3.14 Appeals, AAT and Judicial Review, Other Court Actions Involving the Commissioner, Section 105 Amendments**

Modified Date: 01 November 2013
3.14 Appeals; AAT and Judicial Review; Other Court Actions Involving the Commissioner; Section 105 Amendments

Note:

In this topic:

Relevant Legislation

The Act

Section 105
Amendments directed by a court

Section 139
Parties to proceedings

Section 140
Commissioner to be given copies of orders

Section 154
Jurisdiction of the Federal Court

Section 159
Commissioner may appear in appeals

Section 224
Review of decisions (AAT)

The Regulations

Regulation 22.26
Review of decisions (AAT)

See also:
3.14 Appeals; AAT and Judicial Review; Other Court Actions Involving the Commissioner; Section 105 Amendments

**Overview**

There are a number of mechanisms under which decisions of the Commissioner may be subject to judicial or administrative appeal or review. Which applies in any particular circumstance depends on the statutory power under which the decision was made. For example, decisions under sections 35, 36, 42, 51, 60, 75, 81, 82, 100A, 101, 101F, 101J, 101N, 104, 109 and 191A may be appealed to the Federal Court.

Review of decisions under the provisions of the Act and Regulations specified in sec 224 and reg 22.26 may be appealed to the Administrative Appeals Tribunal (AAT).

If the Act does not specify a right of appeal or review, then generally the only avenue is judicial review under the Administrative Decisions (Judicial Review) Act.

The period in which an appeal may be filed to the Federal Court (e.g. from a decision in a substantive opposition, determination of entitlement or a refusal of an application after examination or re-examination) is 21 days from the date of the decision.

For an application for review to the AAT (e.g. from a decision on an extension of time) or to the Federal Court under the AD(JR) Act the time period is generally 28 days from the date of the decision.

Further information about filing an appeal or application for review can be obtained from the Federal Court or AAT. It is strongly advised that professional legal advice be obtained before instituting proceedings noting that in court proceedings an unsuccessful party may be subject to an order for costs against them.

This part of the manual also covers other court proceedings in which the Commissioner is not a party but has a right to appear, and applications to amend a patent request or specification under sec 105.
3.14.1 Appeals to the Federal Court

In this topic:

What decisions can be appealed to the Federal Court

Section 154(1) of the Patents Act gives the Federal Court jurisdiction with respect to matters under the Act. Section 154(2) provides:

"(2) The jurisdiction of the Federal Court to hear and determine appeals against decisions or directions of the Commissioner is exclusive of the jurisdiction of any other court except the jurisdiction of the High Court under section 75 of the Constitution."

Decisions under sections 35, 36, 42, 51, 60, 75, 81, 82, 100A, 101, 101F, 101J, 101N, 104, 109 and 191A may be appealed to the Federal Court.

Procedure for appeals

The procedure for an appeal is set by the Federal Court Rules including those that are particular to patent appeals included in Division 34.3 - Intellectual Property. As provided in Rule 34.24, a notice of appeal of the Commissioner’s decision must be filed within 21 days of the date of the decision. The Federal Court provides a specific form for intellectual property appeals and the notice must include the matters required by Rule 34.24.

**Note:** The notice of appeal must be served on the other parties to the appeal and on the Commissioner within 5 days of filing with the Court.

Where the decision is in relation to oppositions and other *inter partes* proceedings, the Commissioner is not normally a party to the appeal and should not be named as a respondent – see [Role of the Commissioner](#).

Once served with the notice of appeal, the Commissioner is required within 14 days to lodge documents necessary for the hearing of the appeal with the Court and to provide each party to the appeal a notice of the documents filed – see Rule 34.30.
Nature of appeals

An appeal to the Federal Court is a proceeding in the original jurisdiction of the Court and is not an appeal in any technical sense. The appeal must be decided upon the evidence adduced before the Court and is in the nature of a rehearing de novo. The Court “stands in the shoes” of the Commissioner and exercises the judicial power of the Commonwealth in deciding the same controversy that was before the Commissioner.

Pursuant to Federal Court Rule 34.31, evidence before the Commissioner may be admissible in the appeal with the leave of the Court, however the provisions of the Evidence Act apply to the admissibility of such evidence.

See:

- *New England Biolabs Inc v F Hoffmann-La Roche AG* [2004] FCAFC 213 at [23]

Effect on implementing the decision

When the Commissioner issues a decision, it will normally have immediate effect unless the delegate decides otherwise. Where, pending an appeal, implementation has the potential to significantly prejudice the interests of one party over another or to create public confusion, the Commissioner may however decide to stay implementation of the decision or at least certain consequential actions during the appeal period and, if an appeal is filed, until the appeal is determined or discontinued. For example, if dismissing an opposition the Commissioner will generally not proceed to grant a patent until the appeal period has passed.

Whether or not to stay the implementation of a decision involves:

“considering the public interest and whether failure to stay the applications would permanently defeat rights or cause injustice to one or other of the parties. It involved a weighing process involving considerations of fairness and of the public interest” (*Joan Margaret Martin on behalf of the Widi Mob/Western Australia/Westland Gold NL; ABC*)
3.14.1 Appeals to the Federal Court

Applying these principles in Pfizer [2005] APO 38 the Deputy Commissioner decided to stay a potential decision to rectify the Register pending the appeal period and, if an appeal was filed, until an application for a stay had been considered by the Court.

In that case the Court ordered the Commissioner not to amend the Register on Pfizer giving an undertaking as to damages.

Amendments

Where a decision is made allowing time for proposed amendments to be made overcoming grounds of opposition and the decision is appealed, sec 112A operates so that any proposed amendments can only be pursued under sec 105 until the appeal is finally determined, withdrawn or otherwise deposed of – see 3.14.5 Section 105 Amendments.

Once the appeal is filed, any request to amend filed with the Commissioner will be refused under reg 10.4. See Suntory Holdings v Commissioner of Patents [2013] FCA 999.

Role of the Commissioner

Section 159 provides that the Commissioner may appear and be heard at the hearing of an appeal to the Federal Court against a decision or direction of the Commissioner even if the Commissioner is not a party to the appeal. Under Federal Court Rule 34.23, the Commissioner is not a party to a proceeding other than an appeal:

a. from a decision of the Commissioner; and

b. in which there is no party in opposition to the party bringing the appeal.

Whether or not the Commissioner appears in an appeal, the role the Commissioner takes is highly dependent on the circumstances, including whether there is a contradictor to the party bringing the appeal or whether there are significant issues relating to the integrity of the patent system.
In relation to the role of the Commissioner in proceedings in Merck & Co Inc. v Sankyo Co Ltd [1992] FCA 198 Lockhart J stated at [7]:

"[t]he rule gives the commissioner a right of appearance and the right to be heard; but it does not define the issues on which or the extent to which he may be heard. This is a matter for the court in each case and will vary according to the nature of the issues and the role played by the true adversaries to the litigation".

and at [18]:

“The commissioner should be heard fully on questions concerning his powers and procedures. His role should be limited when the parties to the proceeding are before the court and each pursues an active role. His role would then be akin to an amicus curiae. But if a party does not appear or does not argue his case before the court, the commissioner should, speaking generally, be allowed more latitude by the court with respect to the issues which he wishes to address and the extent to which he seeks to present a case. Ultimately it is for the court to control the proceeding before it. There is one important qualification, and that is that (as r 3 provides) where there is an appeal to the court from a decision, direction or determination of the commissioner in proceedings in which there was no party in opposition to the party who is the applicant in the court. In such a case the commissioner is deemed to be a party, with the full rights of a party; otherwise there will be no-one to present a view contrary to that of the applicant in the court."

Where the Commissioner is properly a party to an appeal (for example, an appeal against an ex parte decision), the Commissioner is usually subject to an award of costs, and may seek an award of costs, according to the normal rules of court.

**3.14.2 AAT Review**

In this topic:

**What decisions are reviewable by the AAT**

Section 224 and reg 22.26 list the decisions under the Act and Regulations that are reviewable by the Administrative Appeals Tribunal (AAT).
These include decisions under:

Section 223 - Extensions of time
Section 32 - Disputes between applicants
Section 74 - Refusal under s74(3) of an application for an extension of term

Where a decision is issued that is reviewable by the AAT, the statement of reasons, or more usually the covering letter, should indicate that fact.

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**Procedure**

The procedure for seeking review is set by the *Administrative Appeals Tribunal Act 1975* and associated Regulations. Information is available from the AAT.

The right to seek review is not limited to the parties who were involved in the particular matter leading to the decision concerned. The AAT Act specifically gives a right of review to persons whose interests are affected by the decision (see sec 27 of the AAT Act). It also provides for other affected parties to be joined in the proceedings, such as where the matter before the Commissioner was an opposition or dispute between applicants.

The time limits for filing an appeal to the AAT are set out in sec 29 of the AAT Act. In general, the time is 28 days commencing on the date of receipt of the document setting out the decision. However, the Tribunal may upon application in writing extend the time for applying for a review of a decision (sec 29(7)), and even though that time has expired (sec 29(8)).

Section 28(1) of the AAT Act allows a person, who has received a decision which does not set out the findings on material questions of fact referring to the evidence or other material on which those findings were based and giving reasons for the decision, to apply in writing to the decision maker to furnish such a statement. This is required to be done by the decision maker as soon as practicable, but in any case within 28 days of receipt of the request.

Notification of the application for review will be provided to the Commissioner by the AAT. On receipt of this the Commissioner will prepare and arrange filing of the documents required by sec 37 of the AAT Act (according with the relevant AAT Practice Directions).
Nature of review

The powers of the Tribunal on appeal are stated in sec 43(1) (AAT Act) to be:

"(1) For the purposes of reviewing a decision, the Tribunal may exercise all the powers and discretions that are conferred by any relevant enactment on the person who made the decision and shall make a decision in writing:

a) affirming the decision under review;

b) varying the decision under review; or

c) setting aside the decision under review and:

i) making a decision in substitution for the decision so set aside; or

ii) remitting the matter for reconsideration in accordance with any directions or recommendations of the Tribunal."

Consequently, the AAT is empowered to substitute itself for the primary decision maker and to determine the correct and preferable decision that should be made under the legislation. In this it can consider questions of both fact and law.

Effect on implementing the decision

An application to the AAT for review of a decision does not normally have the effect of staying the decision - see sec 41(1) of the AAT Act.

A party to the proceedings may seek a stay of the decision under sec 41(2) of the AAT Act, which provides:

"(2) The Tribunal or a presidential member may, on request being made, as prescribed, by a party to a proceeding before the Tribunal (in this section referred to as the "relevant proceeding"), if the Tribunal or presidential member is of the opinion that it is desirable to do so after taking into account the interests of any persons who may be affected by the review, make such order or orders staying or otherwise affecting the operation or implementation of the decision to which the relevant proceeding relates or a part of that decision as the Tribunal or presidential member considers appropriate for the purpose of securing the effectiveness of the hearing and determination of the application for review."

The effect of a stay is governed by sec 41(6) of the AAT Act, which provides:
"(6) An order in force under subsection (2) (including an order that has previously been varied on one or more occasions under subsection (3)):

(a) is subject to such conditions as are specified in the order; and

(b) has effect until:

(i) where a period for the operation of the order is specified in the order - the expiration of that period or, if the application for review is decided by the Tribunal before the expiration of that period, the decision of the Tribunal on the application for review comes into operation; or

(ii) if no period is so specified - the decision of the Tribunal on the application for review comes into operation."

As a result, a stay is usually effective until the date of the decision of the AAT.

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**Role of the Commissioner**

The Commissioner is automatically a party to any application for review filed with the AAT. However, the role taken by the Commissioner is dependent on the circumstances including whether another party has been joined. Similar considerations apply to the Commissioner’s role in appeals - see 3.14.1 Appeals to the Federal Court.

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**What decisions are subject to Judicial Review**

Review under the *Administrative Decisions (Judicial Review) Act 1977* is available for decisions of an administrative character made or proposed to be made under the Patents Act.
Act or otherwise by the Commissioner as an officer of the Commonwealth, including a failure to make a decision.

Procedure

The procedure for seeking review is set by sec 11 of the AD(JR) Act and the Federal Court Rules – see Rule 31.1

Generally, a person aggrieved by a decision may file an application for review with the Court within 28 days after the decision and statement of reasons is issued. If not provided when making the decision, that person may request a “statement in writing setting out the findings on material questions of fact, referring to the evidence or other material on which those findings were based and giving the reasons for the decision”. The Commissioner must either provide that statement of reasons within 28 days or apply for an order of the Court that the person is not entitled to make the request. However, the Commissioner may refuse to prepare and furnish the statement if the request was not made within 28 days after receipt of a written document setting out the decision, or in any other case "within a reasonable time after the decision was made".

The Commissioner is not required to forward documents to the Court. The applicant is required to file relevant documents with the Court.

Note: A copy of the documents must be served on the Commissioner within 5 days of filing with the Court.

Other parties that have an interest in the matter may apply to be made a party to the proceedings pursuant to sec 12 of the AD(JR) Act.

Nature of review

The scope of Judicial Review is limited and goes more to the power of the decision maker to make the decision under the law, rather than the merits of the decision on the relevant facts. Relevant grounds for review (from sections 5, 6, and 7 of the AD(JR) Act) include that:

- a breach of the rules of natural justice occurred in the making of the decision;
• procedures required by law to be observed in the making of the decision, were not observed;

• the person purporting to make the decision did not have jurisdiction;

• the decision was not authorised by the enactment it was purported to be made under;

• the making of the decision was an improper exercise of the power of the enactment it was purported to be made under, including:
  o taking an irrelevant consideration into account;
  o failing to take a relevant consideration into account;
  o an exercise of a power for a purpose other than a purpose for which it was conferred;
  o an exercise of a discretionary power in bad faith;
  o an exercise of a personal discretionary power at the direction or behest of another person;
  o an exercise of a discretionary power in accordance with a rule or policy without regard to the merits of the particular case;
  o an exercise of a power that is so unreasonable that no reasonable person would have so exercised the power;
  o an exercise of a power in such a way that the result of the exercise of that power is uncertain; and
  o any other exercise of a power in a way that constitutes abuse of the power;

• the decision involved an error of law (whether or not apparent in the decision);

• the decision was induced or affected by fraud;

• there was no evidence or other material to justify the decision but only if:
  o the person who made the decision was required by law to reach that decision only if a particular matter was established, and there was no evidence or other material (including facts of which he or she was entitled to take notice) from which he or she could reasonably be satisfied that the matter was established; or
  o the person who made the decision based the decision on the existence of a particular fact, and that fact did not exist;

• the decision was otherwise contrary to law;
3.14.3 Judicial Review

- a person has a duty to make a decision, no law prescribes a period for the making of the decision, and there has been unreasonable delay in the making of the decision; and

- a person has a duty to make a decision, and the person has not made the decision within the time prescribed.

On an application for an order of review in respect of a decision, the Federal Court or the Federal Circuit Court may, in its discretion, make all or any of the following orders:

a. an order quashing or setting aside the decision, or a part of the decision, with effect from the date of the order or from such earlier or later date as the court specifies;

b. an order referring the matter to which the decision relates to the person who made the decision for further consideration, subject to such directions as the court thinks fit;

c. an order declaring the rights of the parties in respect of any matter to which the decision relates;

d. an order directing any of the parties to do, or to refrain from doing, any act or thing the doing, or the refraining from the doing, of which the court considers necessary to do justice between the parties.

Effect on implementing the decision

An application for Judicial Review does not normally have the effect of staying the decision - see sec 15 of the AD(JR) Act.

The Court may, however, order a stay if it sees fit.

Role of the Commissioner

The Commissioner is automatically a party to any application for Judicial Review. However the role taken by the Commissioner is dependent on the circumstances including whether another party has been joined. Similar considerations apply to the Commissioner’s role in appeals - see 3.14.1 Appeals to the Federal Court.
3.14.4 Other Court Actions Involving the Commissioner

In this topic:

Types of actions

There are a number of other proceedings that may be brought under the Patents Act where the Commissioner is not a party but has a right to be heard. Consequently, there are also obligations on parties in a number of these proceedings to serve copies of court documents on the Commissioner.

Relevant proceedings include:

- **Section 105** - Court ordered amendments
- **Section 120** - Infringement
- **Section 125** - Non-infringement declaration
- **Section 128** - Unjustified threats
- **Section 133** - Compulsory licenses
- **Section 134** - Revocation following a compulsory license
- **Section 138** - Revocation
- **Section 192** - Rectification of the register

Requirements to serve documents on the Commissioner

The Patents Act and Federal Court Rules require certain documents to be served on the Commissioner in relation to the court actions listed above.
3.14.4 Other Court Actions Involving the Commissioner

For actions under sections 105, 120, 125, 128, 133, 134 and 138 the Federal Court rules require the application and specified accompanying documents to be served on the Commissioner. In all cases other than for sec 105, this must be done at least 14 days before the return date fixed for the proceedings. For the special requirements of sec 105, see 3.14.5 Section 105 Amendments.

For sections 133, 134 and 138, sec 139 of the Patents Act also specifies that the applicant must serve a copy of the relevant application on the Commissioner. Copies of any orders made by the Court under these provisions must also be served on the Commissioner by the Registrar of the Court (see sec 140).

In the case of an application for rectification of the register under sec 192, sec 192(3) requires that notice of the application be given to the Commissioner.

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**Effect on proceedings in the Patent Office**

The Patents Act provides in a number of circumstances for actions in the Patent Office to be prohibited while relevant proceedings are underway. For example, under sec 101P the Commissioner must not decide an opposition under sec 101M where proceedings are pending in relation to the innovation patent without leave of the Court.

Otherwise, saving an order of the Court to that effect, proceedings in the Patent Office will not be stayed merely because Court proceedings are underway relating to the same or related patent or application. Rather, the Commissioner will consider in each case the relevant circumstances including:

- whether the court proceedings are directly relevant to the proceedings before the Commissioner; and
- whether a deferral would clearly disadvantage one of the parties or the public interest.


It should, however, be noted that the Court has been reluctant to order a stay of Patent Office proceedings. Thus, for example, in *RGC Mineral Sands Limited v Wimmera Industrial Minerals Pty Ltd* [1999] FCA 17 Justice Lindgren stated that:

> “I have no doubt that this Court should decline to grant an injunction having the effect of staying a proceeding before a specialist tribunal where the only issue to be decided by the Court is one which is properly before that tribunal and which it was given power to decide.”

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Effective Date: 25 September 2019
For considerations as to whether the Court will stay its proceedings pending actions in the Patent Office, see *Apotex Pty Ltd v Les Laboratoires Servier* (No 6) [2012] FCA 745.

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**Role of the Commissioner**

The Commissioner has a general right to appear and be heard in the proceedings listed above, see Federal Court Rule 34.23, sec 139 and sec 192, but as indicated in Rule 34.23 is not a party to those proceedings. Consequently, it is not appropriate to name the Commissioner as a respondent in those actions and the Commissioner will resist being joined as a party to such proceedings. In this regard, it should be noted that the Commissioner is subject to the orders of the Court whether a party or not.

While having the right to appear the Commissioner will only do so in very limited circumstances, including where ordered or requested by the Court, where necessary to make submissions on matters that go to the Commissioner’s powers and procedures or otherwise where there are significant issues relating to the integrity of the patent system. *Arbitron v Telecontrol Aktiengesellschaft* [2010] FCA 302 is an example of a matter where the Commissioner intervened in relation to a proposed rectification of the Register.

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**Evidence of matters before the Patent Office**

From time to time parties to proceedings under the Act request evidence of matters in the Patent Office including the practices that the Commissioner applies or may have applied previously.

Generally these matters can properly be made the subject of a signed letter or certificate pursuant to sec 197 and a sworn affidavit will generally not be provided.
Process

The procedural requirements for requests under sec 105(1) to amend a patent request or complete specification in relation to a patent or patent application) are not set out in the Patents Act or Regulations, but in Federal Court Rule 34.41 (or equivalent Supreme Court Rules). The process is essentially as follows:

1. The applicant or patentee must give the Commissioner a notice of intention to apply accompanied by an advertisement. The advertisement must state:
   - the identity of the proceedings, or pending proceedings, in which the application will be made;
   - the particulars of the amendment sought;
   - the applicant's address for service; and
   - that a person intending to oppose the application who is not a party to the proceedings or pending proceedings must, not later than 28 days after publication of the advertisement, give written notice of that intention to the Commissioner and to the persons who are parties to the proceedings.

2. The Commissioner must publish the advertisement in the Official Journal (unless the Court otherwise orders – see Rescare v Anaesthetic Supplies [1993] AIPC 90-950; 25 IPR 119 concerning patent 560360). However, to avoid subsequent complications, the amendments will be considered by an examiner to determine whether the amendments comply with sec 102. If the examiner has concerns with the allowability of the amendments, they should advise DC OP&T of this, who will:
   - communicate any concerns with the patentee; and
   - ascertain whether the patentee desires the amendment to be advertised as requested, with the possibility that the Commissioner may later appear in Court regarding the allowability of the amendments, or whether the patentee desires to deal with the Commissioner’s concerns prior to any advertisement. If the amendments are changed after the advertisement, the Commissioner may need to advise the Court whether the amendments should be re-advertised.

3. A person intending to oppose the amendment must give written notice to the Commissioner and each party to the proceedings within 28 days after the publication of the applicant/patentee’s notice.
3.14.5 Section 105 Amendments

4. The applicant or patentee must file the sec 105 application (usually as a notice of motion) with the Court within 50 days after the publication of the advertisement and serve the application and a copy of the patent request or specification showing the proposed amendment on the Commissioner, each party to the proceedings and each person who has given notice of an intention to oppose.

5. If no notice of intention to oppose is filed and the Commissioner considers sec 102 has been complied with, the Commissioner will advise the patentee that she considers the amendments prima facie comply with sec 102, and therefore, that she does not intend to appear in the proceedings and requests that they draw the letter to the attention of the Court.

6. If a notice of intention to oppose is filed, the Commissioner provides a notice to all parties acknowledging service and indicating whether or not the Commissioner intends to appear in the proceedings.

7. If the Court makes an order under sec 105 directing an amendment, the patentee is required by sec 105(6) to file a copy of the order within 14 days (reg 10.10). The amendment specified in the order is taken to have been made on filing the order (sec 105(6)).

Note: The process for orders under sec 105(1A) is generally the same as that for orders under sec 105(1) (see Yates J in Garford Pty Ltd v Dywidag-Systems International Pty Ltd [2014] FCA 1039 at [25]-[26]).

Role of the Commissioner

If the Commissioner is of the view that the amendment sought does not comply with the requirements of the Act, the Commissioner will determine whether to appear in the proceedings. (Note that pursuant to sec 105(3), the Commissioner is entitled to appear and be heard, and must appear if the Court directs).

If not appearing, the Commissioner nevertheless will write to the Court indicating that she considers the proposed amendment not to be allowable and attach the notification of the Commissioner’s concerns that was provided to the applicant or patentee.

Cases
The Court's powers to allow an amendment under sec 105 have been considered and applied in a number of cases:

- *Rescare Ltd v Anaesthetic Supplies Pty Ltd* [1993] FCA 68
- *Wimmera Industrial Minerals Pty Ltd v RGC Mineral Sands Ltd* [1997] FCA 1063
- *Gambro v Fresenius Medical Care South East Asia Pty Ltd* [1999] FCA 1848
- *Novartis AG v Bausch & Lomb (Australia) Pty Ltd* [2004] FCA 835
- *GS Technology Pty Ltd v Elster Metering Pty Ltd* [2008] FCA 17
- *Apotex Pty Ltd v Les Laboratoires Servier (No 2)* [2009] FCA 1019
- *Bristol-Myers Squibb Company v Apotex Pty Ltd* [2010] FCA 814
- *Expo-Net Danmark A/S v Buono-Net Australia Pty Ltd* [2010] FCA 983
- *Alcon Laboratories (Australia) Pty Ltd v Trustees of Columbia University in the City of New York* [2002] FCA 1314
- *Zetco Pty Ltd v Austworld Commodities Pty Ltd* [2010] FCA 235
- *Bayer Pharma Aktiengesellschaft v Generic Health Pty Ltd* [2012] FCA 1510.

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