



Guidelines for Hearings Decisions

Revision History

Date	Changes
31 May 2016	Controlled template applied
08 August 2019	Document reviewed. Update information on Hearing Template, removing information not directly related to final decision, Remove formatting requirement for double space between paragraphs. Delete reference to signing the last page – just include your name.
07 October 2021	References to section has been updated to reflect PPBRG restructure

GUIDELINES FOR HEARINGS DECISIONS

THE HEARINGS TEMPLATE

To create a new document based on the decision template, launch "Hearing Decision Patent Template – Intelledox" or "Hearing Decision Patent Template – Word Document" from the Oppositions and Examination Practice Workbench. The Intelledox form for the decision template may also be accessed by launching Intelledox – Patent Examination, typing "Patent Hearing Decision" in the "Form" search box under "Begin a New Form" and clicking on the "Patent Hearing Decision" link that appears below the search box.

If launching "Hearing Decision Patent Template – Word Document" (not using the Intelledox form), ensure that you delete the header and footer from the first page before you start authoring the decision. DO NOT delete the header from any subsequent page, as this is the automatic page numbering.

SAVING THE DECISION

All decisions are to be saved to the G:\P&PBR\Secure\PMOG\POH\Documents & drafts\DRAFTS directory. When saving the document use the patent application number for the name. If dealing with a pre-PAMS case, use the 6-figure number (if one was allocated) or use the minus (-) sign as a year separator. For example

2002253713
583667
45921-91

All data not directly related to the final decision text (e.g. hidden text, comments and revisions, macros) is to be removed from documents saved in the G:\P&PBR\Secure\PMOG\POH\Documents & drafts\DRAFTS directory. This can be performed within Microsoft Word by clicking on File → "Check for Issues" dropdown box → selecting "Inspect Document". In the "Document Inspector" pop-up box that appears, select all boxes that relate to the information that should be deleted (it is recommended to select all fields except for "Headers, Footers and Watermarks") and click "Inspect". Click "remove all" on any areas where the "remove all" button appears.

If the choice is made to exclude any areas other than the "Headers, Footers and Watermarks" from the Document Inspector, please consider the risks of retaining this data.

Care is to be taken that any person identified as the author in the "Properties" of a saved decision really is the author. This applies in particular where the decision contains passages which have been imported electronically from other documents.

FINISHING THE DECISION

It is important for decisions to issue within time. Hearing Officers need to allow sufficient time for their decision to be reviewed before it issues. All decisions must be reviewed by two reviewers, one of whom must be a HOSP member.

PRINTING THE DECISION

The final decision is to be printed **SINGLE SIDED**, with your name on the last page. OHL will reprint the cover sheet and first page once the sequential number and date of issue have been inserted.

COVER SHEET

Citation: ***Opponent v Applicant***. This order is retained for all actions within an opposition (i.e. retain even for extensions of time that are objected by the applicant).

Opponent: In section 32 matters, alter to "Requestor", etc

Hearing Date: enter the date and location of hearing, eg 1 June 2010, in Canberra. If the hearing is on the written record, use "Written submissions filed on 17 August 2010 and 24 August 2010"

Catchwords: Catchwords are a precis of the decisive issues in the decision. They must include the ultimate outcome. Catchwords always begin with **PATENTS** – followed by your text. The following are some examples.

- extension of time to serve evidence –
 - nature and significance of evidence – evidence of common general knowledge –
 - explanation of delay – expert unavailable due to illness –
 - interests of parties –
- extension of time to gain acceptance –
 - whether failure to remember is an error or omission –
- application to serve further evidence –
 - nature and significance of evidence –
 - whether evidence found incidental to preparation of case –
- opposition to the grant of a patent –
 - novelty and inventive step –
 - novelty – whether feature inherent in citation –
 - inventive step – whether routine to try xx –
- opposition to an innovation patent –
- opposition to an amendment –
- examiner's objection –
 - manner of manufacture – whether a method doing X is patentable
 - inventive step – whether it would be a matter of routine to xx

Concluding catchwords

- opposition succeeds on ground of lack of novelty
- opposition fails on all grounds
- extension allowed
- extension refused

DECISION

A **short** statement of the overall decision (not findings on points along the way). Some examples:

Application to serve further evidence is granted. Costs according to Schedule 8 awarded against ABC.

Extension of time until 2 September 2010 allowed. The time period under regulation 5.8(4) runs from the date of this decision. Costs according to Schedule 8 awarded against DEF.

Opposition succeeds. Applicant has 28 days to propose amendments. Costs according to Schedule 8 awarded against ABC.

REASONS FOR DECISION

Character format - font (12 point/10 characters per inch) Times New Roman 12 is the standard setting in the template.

Text to be in single spacing (ie. typing without pressing enter unless you want to deliberately begin a new line).

Two spaces after sentences.

The default tab width should be set at 0.5" (1.27cm).

Text is written in block style (ie. text is flush left, no indenting for first line of paragraphs; signature block is also flush left)

Page numbers are to appear at the top of every page except the first page. This is already formatted in the decision template.

Paragraphs are numbered by applying the format "1. List Number". This is best done after the text of the decision has been finalised.

Quotes from documents should be in double quotation marks. Use the style "QUOTES FROM DOCUMENTS".

"They should also be justified and indented from the left and right (select QUOTES FROM DOCUMENTS from the formatting)."

Short quotes can be simply "included as part of the text".

The decision may make use of footnotes. However, when a document is converted to internet format HTML all footnotes are placed at the end of the document with a link at the appropriate place in the document, so all footnotes should be numbered consecutively. ISYS similarly places all footnotes at the end of its version of the document.

When citing cases, the name of the case is in italics (*Ferozem Pty Ltd v Commissioner of Patents* (1994) 28 IPR 243).

To highlight within a paragraph, use either **bold** or *italics*, but not underlining as this is used for hyperlinking when documents are loaded on the internet.

Names should appear together on one line. Use a non-breaking space (Ctrl + Shift + Spacebar) to prevent a line break between names (thus Mr Smith will appear on your screen as Mr°Smith).

Pinpoints: Pinpoint references should be included where appropriate. A pinpoint should be the words 'at 267'. Where a quote runs on it should be referenced as 'at 566 – 567' (with a space between the hyphen and the page numbers). For example:

Cubillo v Commonwealth (2000) 174 ALR 97 at 267
R v Smith (1978) 151 CLR 556 at 566 - 567

When the decision contains numbered paragraphs, the pinpoint should be to the paragraph. The paragraph number appears in square brackets. If the decision is printed in paper form, the pinpoint should preferably include both the page and paragraph. For example:

Person v Company (1998) 152 ALR 34 at 52 [27]

Alternative citations: When a case is reported in more than one series of reports, it is not normally necessary to cite all the reports. Modern decisions carry a medium neutral citation that is effectively part of the title of the judgment. Citations of the judgment should be to both the medium neutral citation and the print citation. The medium neutral citation is placed first, and is separated from the print citation by a semicolon.

Person v Company [1998] HCA 25; (1998) 152 ALR 34

For a parallel pinpoint citation, the recommended form is

Person v Company [1998] HCA 25 at [27]; (1998) 152 ALR 34 at 52.

Shortening names: When a name is to be used repeatedly, it is normal to provide a shortened form for ease. This is indicated by placing the shortened form in brackets, in bold immediately after the first use of the name:

Patent application number 2004203785 (**the present application**) was filed on 7 January 2004 under the provisions of the Patent Cooperation Treaty. The applicant is Ciba Specialty Chemicals Water Treatments Limited (**Ciba**). The application was examined and accepted by the Commissioner, and subsequently opposed under section 59 of the *Patents Act 1990* (**the Act**) by SNF (Australia) Pty Ltd (**SNF**).

MAIN HEADINGS

Main headings are formatted as Heading 2, and are typed in upper case. There is no "All Caps" formatting in the headings and styles in the "Decisions" template. This is because "All Caps" formatting is ignored when text is converted to Internet format (HTML).

Sub-headings

Sub-headings are formatted as Heading 3.

The Australian Guide to Legal Citation

The Guide provides information on the mode of citation of cases and legislation which should be followed when writing decisions. The Guide should also be followed on other aspects of style, provided it is not inconsistent with this style guide. The Guide can be accessed from the OHL intranet page.

EXAMPLE**IP AUSTRALIA****AUSTRALIAN PATENT OFFICE*****Sang Bong Lee v Komipharm International Co., Ltd [2010] APO***

Patent Application: 2002253713

Title: Pharmaceutical composition comprising arsenite for the treatment of malignancy (in both instances)

Patent Applicant: Komipharm International Co., Ltd

Requestor: Sang Bong Lee

Delegate: Dr S.D. Barker

Decision Date:

Hearing Date: 1 June 2010, in Canberra

Catchwords: **PATENTS** – request under section 32 – inventive concept – whether person who provides input is an inventor – whether invention subsequently transferred by contract – request fails

Representation: Counsel for the applicant: Mr D Shavin QC with Mr P Creighton-Selvay
Patent attorney for the applicant: Ms L Govenlock of Allens Arthur Robinson.
Requestor: Dr Lee represented himself, assisted by Miss Lee.



IP AUSTRALIA

AUSTRALIAN PATENT OFFICE

Patent Application: 2002253713

Title: Pharmaceutical composition comprising arsenite for the treatment of malignancy

Patent Applicant: Komipharm International Co., Ltd

Date of Decision:

DECISION

Bernardus Rademaker is the inventor of patent application 2002253713. I direct that the inventor is to be recorded as Bernardus Rademaker.

Costs are awarded against Dr Lee.

REASONS FOR DECISION

1. Patent application 2002253713 was filed under the provisions of the Patent Cooperation Treaty (PCT) by Korea Microbiological Laboratories Ltd (KML). The inventors were listed as Sang Bong Lee and Yong Yin Yang . Pursuant to Rule 92bis of the PCT, the applicant was amended to also include Sang Bong Lee and Yong Jin Yang. After the application had entered the national phase, the applicant was changed to Komipharm International Co., Ltd (Komipharm), Sang Bong Lee and Yong Jin Yang (as a consequence of a change of name of the company).