

Substantive Patent Oppositions in Australia.

Substantive oppositions are oppositions to:

- grant of standard patents;
- certification of innovation patents; and
- extensions of term of standard patents relating to pharmaceutical substances.

The main stages of a substantive opposition are outlined below. Some of these stages may be skipped or occur simultaneously. Similarly, additional stages may be added. For simplicity, only the most common steps are discussed.

Notice of Opposition ('NO')

An opponent files a NO to initiate an opposition process.

A NO must be filed within **three months** of publication of acceptance of a standard patent application.

Statement of Grounds and Particulars ('SGP')

Within **three months** of filing the NO, an opponent must file a SGP. The SGP sets out the grounds upon which the patent application will be opposed. Usually, the SGP lists 'prior art' documents (the 'particulars') that may show the patent application lacks novelty or is obvious.

A SGP may be amended at a later stage to correct an error or omission, or change particulars relating to any of the grounds of opposition. However, these changes may not be allowed if they significantly change the case against the patent application.

Evidentiary Stages

After filing the SGP, the parties typically file evidence to support their respective cases, or rebut the other side's arguments. These evidentiary stages are as follows:

Evidence in Support

Evidence in Support is filed by the opponent within **three months** of filing the SGP.

Evidence in Answer

The patent applicant then has an opportunity to provide Evidence in Answer within **three**

months of official notification that Evidence in Support has been filed.

Evidence in Reply

The opponent may respond by filing Evidence in Reply within **two months** of receiving the Evidence in Answer from the Patent Office. Evidence in Reply may only respond to matters raised in Evidence in Answer.

Hearing

Once the evidentiary stages are complete, the parties are given the opportunity to be heard at an oral hearing.

For an oral hearing, the opponent must file a summary of submissions **at least 10 business days** before the hearing and the patent applicant must file a summary of submissions **at least five business days** before the hearing.

At the hearing, comprehensive submissions are verbally put to a Delegate of the Commissioner of Patents. The Delegate issues a written decision about three months after the hearing date.

Costs

The parties will usually apply to the Patent Office for an award of costs in the event the opposition is decided in their favour. The costs are paid by the unsuccessful party, but are invariably less than the actual costs incurred.

Appeal

Either party may appeal a decision in a substantive opposition to the Federal Court of Australia (deadline: 21 days from decision date).

Innovation Patents

To oppose an innovation patent, an opponent must file a NO, SGP, and Evidence in Support of the opposition, **at the same time**, but at any time after certification.

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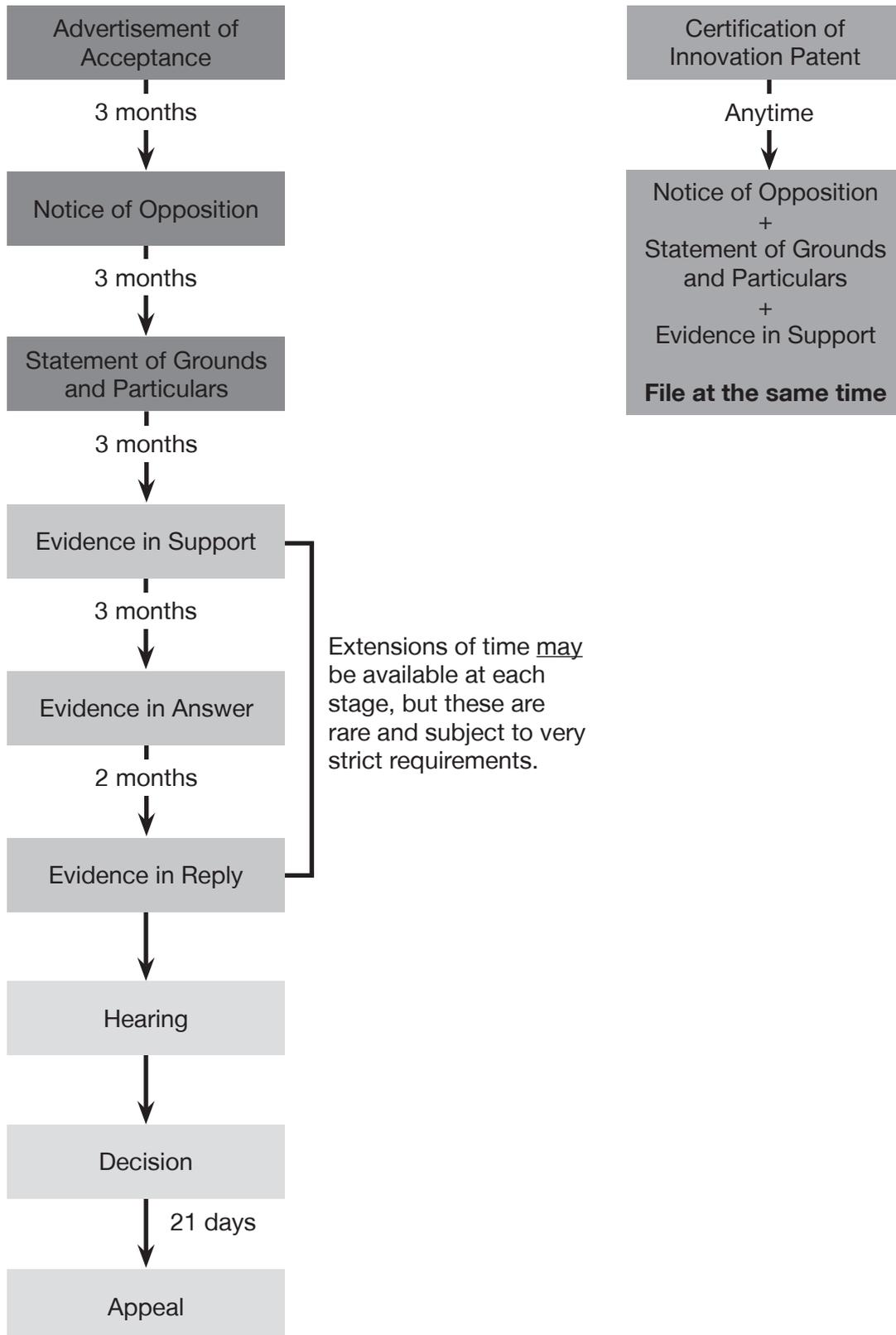
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