

Australian Response to circular 7992

Australia operates a pre-grant opposition system for standard patent applications, where any person may oppose the granting of a patent within three months of acceptance of the application being advertised in the Official Journal of Patents. The validity of a standard patent can be challenged after grant through re-examination proceedings or by seeking revocation in the courts.

In contrast, oppositions to innovation patents can only be initiated after the patent has been granted and then certified (i.e. examined).

Chapter 5 of the Australian Patents Act 1990 deals with opposition to grant of a standard patent. Section 59 describes who is able to oppose the grant of a patent and on what grounds. Section 60 describes the role and responsibilities of the Commissioner of Patents. The procedural aspects of the opposition system are dealt with under the Patents Regulations 1991. The relevant provisions of the Act for the pre-grant opposition system for standard patents are given below.

Section 59. Opposition to grant of standard patent

The Minister or any other person may, in accordance with the regulations, oppose the grant of a standard patent on one or more of the following grounds, but on no other ground:

- (a) that the nominated person is either:
 - (i) not entitled to a grant of a patent for the invention; or
 - (ii) entitled to a grant of a patent for the invention but only in conjunction with some other person;
- (b) that the invention is not a patentable invention;
- (c) that the specification filed in respect of the complete application does not comply with subsection 40 (2) or (3);
- (d) [repealed]

Section 60. Hearing and decision by Commissioner

- (1) Where the grant of a standard patent is opposed, the Commissioner must decide the case in accordance with the regulations.
- (2) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding a case.
- (3) The Commissioner may, in deciding a case, take into account any ground on which the grant of a standard patent may be opposed, whether relied upon by the opponent or not.
- (4) The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

Part 3 of Chapter 9A of the Act deals with oppositions to certified innovation patents. Sections 101M and 101N in this Part perform similar functions to Sections 59 and 60 respectively. As with oppositions to the grant of a standard patent, the procedural aspects of the opposition system are dealt with under the Patents Regulations 1991. The relevant provisions of the Act are given below.

Section 101M. Opposition to innovation patent

The Minister or any other person may, in accordance with the regulations, oppose an innovation patent that has been certified and seek the revocation of it, on one or more of the following grounds of invalidity, but on no other:

- (a) that the patentee is either:
 - (i) not entitled to the patent; or
 - (ii) entitled to the patent but only in conjunction with some other person;
- (b) that the invention is not a patentable invention because it does not comply with paragraph 18(1A)(a) or (b);
- (c) that the invention is not a patentable invention under subsection 18(2) or (3);
- (d) that the complete specification does not comply with subsection 40 (2) or (3)

Section 101N. Hearing and decision by Commissioner

- (1) Where an innovation patent has been opposed under section 101M, the Commissioner must decide the case in accordance with the regulations.
- (2) The Commissioner must give the opponent and the patentee a reasonable opportunity to be heard before deciding the case.
- (3) The Commissioner may, in deciding whether to revoke the patent, take into account any ground on which the grant of an innovation patent may be opposed, whether relied upon by the opponent or not.
- (4) Subject to subsection (6), if the Commissioner is satisfied that a ground exists for the revocation of an innovation patent, the Commissioner may revoke the patent in writing either wholly or so far as it relates to a particular claim.
- (5) If the Commissioner revokes the patent:
 - (a) the Commissioner must notify the patentee and the opponent of the revocation; and
 - (b) register the revocation of the patent.
- (6) The Commissioner must not revoke a patent under this section unless the Commissioner has, where appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any ground for revocation and the patentee has failed to do so.
- (7) The patentee, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

Oppositions can also arise in regard to procedural matters including:

Amendments (s104)

- under s104(4) any person may oppose the allowance of an amendment on the grounds that it is not allowable
- s102 relates to allowable amendments, basically one cannot amend a specification in order to claim matter that was not in substance disclosed in the specification as filed

Extensions of time (s223)

- under s223(6) any person may oppose the granting of an extension of time

Extension of Term for a pharmaceutical patent (s70)

- any person may oppose the grant of an extension of term under s75 but only on the grounds that s70 (defines what subject matter is available for extension of term) or s71 (relating to the form and timing of an application) are not met

Amendment of the Register or a patent (r10.7)

- under r10.7(4) any person may oppose the making of an amendment of the Register

Grant of a Licence to Exploit an Invention (r22.21)

- under s22.21(4), a person who receives a copy of an application for a licence can oppose the granting of that licence.

The Act also makes specific provision for the Commissioner to hear certain persons on a number of other matters: s17 (disputes between co-owners), s32 (disputes between applicants), s35 (following revocation by the commissioner), s36 (eligible persons and application for a declaration by the commissioner), s42 (micro-organism ceasing to be available), s50 (grant refused in certain cases), s101 (revocation after re-examination after grant), s106 (amendments directed by commissioner – granted patent after re-examination), s107 (amendments directed by commissioner – application for standard patent) and s137 (revocation on surrender of a patent), and regulation 3.24 (commissioner request samples of micro-organism), reg 3.25 (request for commissioner's certificate for release of micro-organism) and reg 10.3 (amendments relating to reg 3.25).

Re-examination

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

Re-examination is instigated at the Commissioner's discretion, upon request by the patentee or any interested person or by the direction of a prescribed court before which the validity of the patent in question is in dispute. The procedure is *ex parte*, i.e. the person who requests re-examination has limited opportunity to submit evidence and be heard in the process.

The Commissioner will instigate re-examination voluntarily only if an adverse re-examination report will issue. In contrast, the Commissioner must re-examine where the patentee or third party requests re-examination.

Third Party Observations

Australia allows third party observations under section 27 (and 28 in relation to innovation patents) of the *Patents Act 1990*. Under this provision a person may notify the Commissioner, within a certain period, that they believe that the invention is not patentable because it does not comply with the requirements for novelty and inventive (or innovative) step.

Statistics on oppositions

	2006/07	2007/08	2008/09	2009/10	2010/11
Re-examination ¹	5	11	18	15	22
Opposition ²	130	109	167	120	143
Applications Filed ³	27594	27979	26259	25443	26473

¹The re-examination number is third-party requested re-exam only. It does not include re-exams that are initiated by the Commissioner in other circumstances.

² The oppositions numbers relate to section 59 oppositions only.

³ The applications filed number does not include provisional filings, but does include both innovation and standard patent applications.