

Opposition systems

Australia

There are two types of patents in Australia, the ‘standard’ patent and the ‘innovation’ patent (similar to a utility model).¹ Australia operates a pre-grant opposition system for standard patent applications.² Any person may oppose the granting of a patent by filing a Notice of Opposition within three months of acceptance of the application being advertised in the Official Journal of Patents.³ Oppositions to innovation patents can only be initiated after the patent has been granted and then certified.⁴

According to Section 59 of the Patents Act 1990 (Cth) (*Patents Act*), 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:⁵

- (a) that the nominated person is either:⁶
 - (i) not entitled to the grant of a patent for the invention; or
 - (ii) entitled to the grant of a patent for the invention, but only in conjunction with some other person;
- (b) that the invention is not a patentable invention;⁷
- (c) that the specification filed in respect of the complete application does not comply with Subsection 40(2), (3) or (3A).⁸

¹ It is no longer possible to file a new application for an innovation patent. However, an applicant who has filed a patent application before 26 August 2021 (the effective date of Sch 1 Pt 2 of the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2020* (Cth)) may file an amendment to convert that application to an application for an innovation patent or use that application to file a divisional application for an innovation patent.

² There are two types of patents in Australia, the ‘standard’ patent and the ‘innovation’ patent (similar to a utility model). Oppositions to innovation patents can only be initiated after the patent has been granted and then certified. Note: although the innovation patent is being phased out, opposition to innovation patents could still occur until at least 2029. It is no longer possible to apply for an innovation patent, although existing patent applications filed prior to 26 August 2021 (the effective date of Sch 1 Pt 2 of the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2020* (Cth)) may allow the applicant to amend an existing application or file a divisional application for an innovation patent.

³ Subsection 49(1) of the *Patents Act* provides that, subject to Section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent, if the Commissioner is satisfied, on the balance of probabilities: (a) that the specification complies with subsections 40(2) to 40(4), i.e. disclosure, clarity, support and unity; (b) that the invention satisfies the criteria mentioned in paragraphs 18(1)(a), (b) and (c), i.e. manner of manufacture, novelty, inventive step and usefulness; and (c) that the invention is a patentable invention under Subsection 18(2) (human beings, and biological processes for their generation, are not patentable inventions).

⁴ Although the innovation patent is being phased out, opposition to innovation patents could still occur until at least 2029.

⁵ Section 101M of the *Patents Act* allows for opposition under analogous grounds for certified innovation patents, with an innovative step instead of an inventive step.

⁶ The applicant is taken to be the nominated person for the grant of the patent (Regulation 3.1A), and in this context the term ‘person’ means a legal person and includes a body politic (e.g. Commonwealth of Australia, French Republic) and a body corporate (e.g. a company incorporated under the laws of the State of Victoria), as well as a natural person.

⁷ Under Subsection 18(1), this includes a lack of novelty or inventive step, manner of manufacture or utility.

⁸ Subsection 40(2) of the *Patents Act* provides that a complete specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art, disclose the best method known to the applicant of performing the invention, and end with a claim or claims defining the invention. Subsection 40(3) states that the claims or claim must be clear and succinct and supported by matter disclosed in the specification. Subsection 40(3A) states The claim or claims must not rely on references to descriptions, drawings, graphics or photographs unless absolutely necessary to define the invention.

Under Section 60 of the *Patents Act*, the opposition is heard by the Commissioner who must, on the balance of probabilities, decide the case in accordance with the Regulations. The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding the case. The Commissioner may, in deciding the 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. The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this Section.

Oppositions can also arise with regard to procedural matters including:

- (a) amendments: under Subsection 104(4) of the *Patents Act*, the Minister or any other person may oppose the allowance of an amendment. Section 102 of the *Patents Act* provides that amendment of the complete specification is not allowable if, as a result of the amendment, the amended specification would claim or disclose matter that extends beyond that disclosed in the specification as filed, together with other prescribed documents (if any);
- (b) extensions of time: under Subsection 223(6) of the *Patents Act*, any person may oppose the granting of an extension of time;
- (c) extensions of term for a pharmaceutical patent: under Section 75 of the *Patents Act*, any person may oppose the grant of an extension of term under Section 70 but only on the ground that one or more of the requirements specified in Section 70 (defining what subject matter is available for extension of term) and Section 71 (relating to the form and timing of an application) are not met;
- (d) grant of a licence to exploit an invention: under Regulation 22.21(4) of the *Patents Regulations 1991* (Cth), a person who receives a copy of an application for a licence can oppose the granting of that licence.