

## Patent Opposition

Opposition to a patent is made by filing a Notice of Opposition within three months of the date on which the Patent Office advertised acceptance of the patent application.

The opponent must serve a Statement of Grounds and Particulars on the patent applicant within three months of filing a Notice of Opposition. The statement is intended to give the applicant fair notice of the case to be met and to define the issues of the opposition. It is binding on the opponent and confines the opponent's case to the issues raised in the statement, unless subsequently amended. Amendment of the Statement is possible only in very limited circumstances. It is therefore important to carry out comprehensive searches to ensure that, as far as possible, all relevant prior art is listed.

In general, the Statement of Grounds and Particulars should be in summary form and be as brief as the nature of the opposition permits. Each ground should have at least one particular, such as the documents relied upon. If more than 10 documents are relied upon, a brief explanation of their relevance should be included. A ground of opposition with no particulars will be dismissed.

The Commissioner may re-examine the complete specification on the basis of the information set out in the Statement of Grounds and Particulars.

Evidence in Support should be served on the applicant within three months of the Statement of Grounds and Particulars being served.

All the evidence must be in the form of statutory declarations. The Evidence in Support normally includes an expert analysis of the scope of the claims as accepted and a detailed submission as to how prior art documents relate to the claims. Copies of each of the prior art documents are exhibited to the Declaration. At least one Declaration by an Australian expert is usually included to attest to the state of common general knowledge in the art in Australia at the priority date. Evidence of the date of publication of each of the prior art documents is provided in a separate declaration.

Once the Evidence in Support has been served, the applicant has three months to serve Evidence in Answer to the opponent's case.

The opponent may serve Evidence in Reply within three months of Evidence in Answer being served, but must serve a notice of intent to do so within the first month. Evidence in Reply should specifically reply to the Evidence in Answer and not contain any new evidence, which may only be introduced with special leave from the Commissioner. Such leave is usually granted only if the new evidence could not have formed part of the Evidence in Support.

Extensions to deadlines to serve evidence may be granted on showing reasonable grounds. Either party may object to an extension being granted to the other party. If any extension of time is sought, it is necessary to indicate the progress that has been made towards completion of the evidence, and to show that any delay has been unintentional. The extension may be refused. For these reasons, it is crucial to begin seriously researching the case and identifying witnesses as soon as the decision has been taken to oppose.

After the evidentiary steps have been completed, the opposition is heard before a delegate of the Commissioner. Attendance at the hearing is not compulsory, but is recommended. Each party may choose to be represented by its patent attorney, or by counsel. Although it is possible to call witnesses, this is rarely done other than in cases where inventorship is in dispute.

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