Ministry of Economic Development Manatū Ōhanga | IPONZ - Intellectual Property Office of New Zealand

Patent opposition and revocation

Contents

1. Opposition proceedings (section 21)
Notice of opposition
Grounds of opposition
Priority dates
Statement of case
Regulation 49: Counterstatement
Evidence
Overview of the opposition process
Extensions of time
Costs
2. Refusal of a patent without opposition (section 22)
Regulation 57: Notice to applicant
Regulation 58: Hearing
3. Revocation
Regulation 104: Application for revocation
Regulation 105: Procedure for opposing revocation

1. Opposition proceedings (section 21)

When a patent application is accepted by the Intellectual Property Office (IPONZ), the applicant receives a notice of acceptance and the details of the patent application are published in the monthly Patent Office Journal (available from the IPONZ web site). The date of issue of the Journal becomes the publication date of the patent application. The details of the patent application including a copy of its complete specification are also available on the IPONZ web site from the publication date.

A three-month opposition period begins from the publication date of the patent application and “any person interested” can file a notice of opposition under section 21. This opposition period of three months can be extended by one month by filing a patents form 16 which must be filed before the end of the 3 month period. If no notice of opposition is filed within this opposition period then the patent application is automatically granted and sealed. An opposition cannot be filed after the expiration of the opposition period.

Notice of opposition

If you wish to oppose the granting of a patent application then you need file a notice of opposition using a patents form 15. The notice of opposition must identify the grounds under which you oppose the patent application (regulation 48). A fee of $NZ 300 must also be filed. GST is payable on this fee by any party resident in New Zealand. The notice of opposition is not considered to have been filed if this fee is not paid. No other fees are payable to IPONZ until a case is ready for hearing, and a hearing is requested.

Grounds of opposition

These are defined in section 21(1) of the Act:

- Obtaining: the applicant obtained the patent from the person who had the actual right to apply, without the permission of that person.
- Prior publication: The invention claimed in the patent application has been published:
  - in a New Zealand patent specification published within 50 years of the date of filing of the patent application; and/or
  - in any other prior published document not excluded by section 59(1) (section 2 defines “published” as being “made available to the public”).
- Prior claiming: The invention claimed in the patent application has been claimed in a prior New Zealand patent application published on or after the priority date of the patent application.

- Prior use: The invention claimed in the patent application has been used (not including secret use) before the priority date of the patent application.
- Obviousness: The invention claimed in the patent application is obvious i.e. “clearly doesn’t involve an inventive step” with regard to prior publication and/or prior use. Both prior publication and prior use can be used as a basis for obviousness.
- Not an invention: The complete specification of the patent application does not include an invention, i.e. the patent does not claim a manner of new manufacture as defined in section 2.
- Insufficiency: The complete specification of the patent application doesn’t sufficiently describe the invention or the method of performing the invention.
- Not a proper convention application: If the patent application is a convention application (i.e. relies on an overseas priority date under section 7(2)) and the application was not filed within 12 months of the first application for protection.
- In relation to an application for restoration of a patent, where the failure to meet the time requirements of sections 19 and 93 (time to have an application in order for acceptance) was intentional.
- In relation to an application for restoration of a patent, where the application to restore was made with undue delay.
- Extension of time under section 93A (granted by the Commissioner) was unwarranted.

-

Priority dates

The priority date of a patent application is the date the patent application is first filed. This can be the filing date of a convention application in another country or the filing date of a provisional specification in New Zealand or the filing date of a complete specification in New Zealand if no provisional specification has been filed. The date of filing is the date the patent application is filed in New Zealand. To contest the priority date of the patent application you must provide evidence to show that the priority date of the patent application is not valid.

-

Statement of case

The notice of opposition should be accompanied by a statement of case, which must explain fully:

(i) the nature of the opponent’s interest in opposing the patent application. This interest must not be frivolous, vexatious, or blackmailing but should be both commercial and genuine;

(ii) the basis that the opponent relies on for the grounds identified in the notice of opposition; and

(iii) the relief that the opponent seeks e.g. costs.

The basis for the grounds of opposition must explain fully the grounds upon which the opponent is contesting the patent application. For example, for the ground of obtaining, the statement of case must set out in detail how, when and where the obtaining took place, and for the ground of prior publication the statement of case should specify how a prior document or documents prior publishes the patent application.

The notice of opposition and the statement of case should be filed in duplicate so that a copy can be sent to the applicant (regulation 48).

Once the notice of opposition is filed, the opponent can request an extension of time for filing the statement of case – see “Extensions of time”.

After the notice of opposition has been filed the Commissioner will inform the applicant that opposition proceedings have commenced.

-

Regulation 49: Counterstatement

If the applicant wishes to proceed with the patent application they must file a counterstatement in answer to the notice of opposition and statement of case within 2 months of receiving the notice of opposition. The counterstatement must explain fully the grounds upon which the applicant contests the opposition. The applicant must send the original counterstatement and a copy to IPONZ so that a copy can be sent to the opponent. If the applicant does not file the counterstatement within time then the patent application is considered to be abandoned.

At this stage the applicant is able to amend the claims of their application to overcome the opposition. Any amendment can be filed with the counterstatement and will be considered by IPONZ under section 40.

-

Evidence

Evidence may be filed to provide support for your case (see below). For example for the ground of obtaining the opponent should provide evidence, in the form of statutory declaration or affidavit, to support their contention that the patent application was obtained without permission.

For the ground of prior use the opponent should provide evidence to support their contention that the invention has been prior used detailing where the use occurred, when the use occurred, who was involved and what was the nature of the use (for more guidance on this please see Practice Notes entitled Patent: Oppositions: Section 21., Applications for Revocation (Belated Oppositions): Section 42 in Patent Office Journals 1287 and 1367).

For the grounds of prior publication, obviousness and prior claiming, any documents cited in a statutory declaration or affidavit should be provided along with the date of publication and evidence to show that the prior document was published on that date or was publicly available before the priority date of the patent application.

Regulation 50: Evidence by the Opponent

The opponent may file evidence in support of the opposition within 2 months of receiving the applicant's counterstatement. A copy of this evidence must be sent to the applicant also. The evidence can be affidavits and/or statutory declarations. (See Practice Note Journal 1292 for more detail).

Regulation 51: Evidence of the Applicant

After the opponent files their evidence or advises that they are not filing evidence, the applicant has two months in which to file evidence in support of their application if they wish to. This can be in response to the opponent's evidence. After the applicant files their evidence or advises that they are not filing evidence the opponent has two months to file evidence strictly in reply to the applicant's evidence if they wish to. A copy of this evidence must be sent to the applicant also.

If at the evidence stage the applicant or opponent does not wish to file evidence in support of their case then they must advise IPONZ that no evidence will be filed.

Regulation 52: Closing of Evidence

It is expected that after evidence has been filed by the opponent and applicant, and the opponent has filed any evidence in reply, no further evidence will be filed. However, Regulation 52 does allow the Commissioner to grant leave to file further evidence on specific request.

Regulation 53: Supply of Documents to the Commissioner

Copies of all documents referred in the notice of opposition or the statement of case, counterstatement and evidence must be filed in duplicate. If any of these documents are in a foreign language then a translation verified with a statutory declaration must also be filed in duplicate.

Regulation 54: Hearing

After all the evidence has been filed the Commissioner will write to both parties seeking their wishes as to the manner in which a decision is to be made which can be:

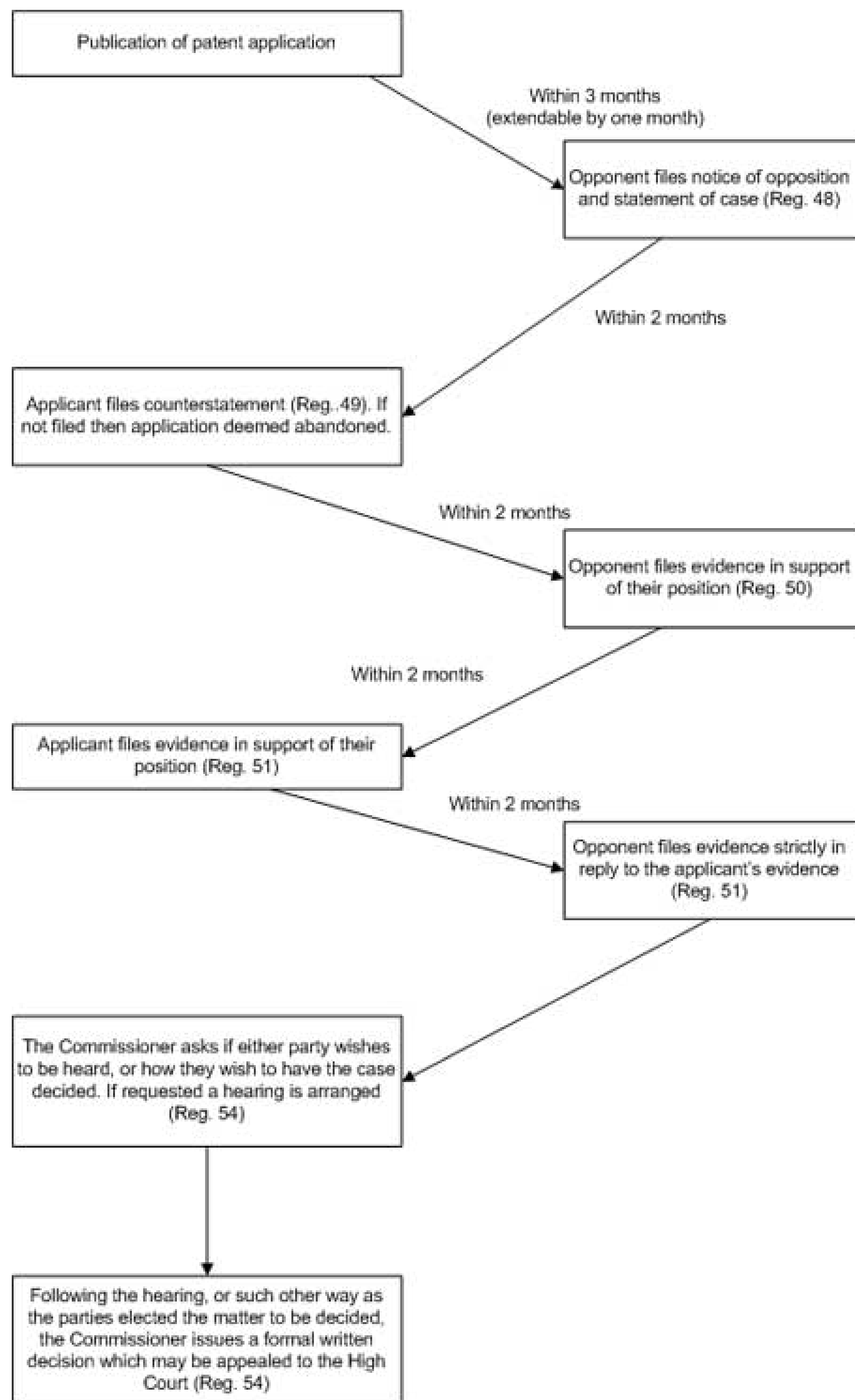
- Consideration of the material filed in proceeding (i.e. notice of opposition, counterstatement and evidence) without any submission from the parties, or
- As above, but with the addition of a hearing on the papers, involving the consideration of written submissions from any party who wishes to be heard, or
- As above, but with the addition of formal hearing in person before the Commissioner of Patents where the Commissioner listens to the submissions of any party wishing to be heard.

If any party requests to make written submissions or to attend a formal hearing they will be required to pay a hearing fee of $NZ 750 plus GST at the time they inform IPONZ of their wish to be heard. A written decision will be issued after the hearing and may include an order as

to the payment of costs. Either party may appeal this decision within 20 working days to the High Court.

-

Overview of the opposition process



-

Extensions of time

Both the opponent and applicant can apply for an extension of time for any of the above time requirements (with restrictions) under regulation 168 using a patents form 76. When you request an extension of time you must give full and detailed reasons why you need the extension and must convince the Commissioner that the extension of time is justified. In most cases the consent of the other party will be justification for the grant of an extension of time.

When determining whether the grant of an extension of time is reasonable the Commissioner will take into account the circumstances of each request. Guidelines as to what the Commissioner considers to be reasonable extensions of time at each stage of the opposition process are as follows:

- Opposing a patent – a period not exceeding one month.
- For filing a statement of case or counterstatement in patent proceedings – two months, or with consent - four months.
- For filing evidence in patent proceedings – a period not exceeding four months, unless there is evidence of exceptional circumstances.

The parties can withdraw from the proceedings at any time, and if this happens then the Commissioner may decide the case in the public interest. If a party withdraws from the proceeding without making any prior arrangement as to costs, costs may be awarded against them.

An overriding requirement of IPONZ is that any party corresponding with IPONZ in connection with an opposition proceeding should always copy that correspondence to the other party. This is so that all parties are informed of developments, and the proceedings are open and transparent. For the same reason any correspondence IPONZ has with any party will be copied to the other party as a matter of course.

In dealing with IPONZ in connection with opposition proceedings, parties should note that the Hearings Office section of IPONZ will hold the files whilst under opposition, and accordingly any correspondence in connection with the proceeding should be addressed for the attention of the Hearings Office. The E-mail address of the Hearings Office is hearings@iponz.govt.nz.

-

Costs

All parties becoming involved in an opposition proceeding will need to be aware of the provisions of section 95 of the Act, and that the Commissioner may award that an unsuccessful party to a proceeding pay at least a portion of the costs of the successful party. This means that costs may be awarded once an opposition has been formally commenced and:

- one party either:
  - withdraws from the proceeding, or
  - is deemed to have abandoned the proceeding or the application through a regulated process; or
- the proceeding is determined by a formal decision by the Commissioner without any agreement as to costs having been reached.

This applies regardless of the stage of the proceeding that has been reached. The Commissioner does not usually award the full costs incurred, but awards costs on the basis of a fixed scale, depending on the stage reached. The usual costs awarded for various stages of a proceeding are as follows:

Schedule of Costs

Item Number	Matter	Cost (Patents) excluding GST
1	Notice of Opposition	$500
2	Counter-statement	$300
3	Evidence in support	$800
4	Receiving and perusing evidence in support	$400
5	Evidence in answer	$800
6	Receiving and perusing evidence in answer	$400
7	Evidence in Reply	$200

8	Receiving and perusing evidence in reply	$100
9	Preparation of cases for hearing	$500
10	Attendance at hearing by counsel	$180/hour or $810/day

-

2. Refusal of a patent without opposition (section 22)

Section 22 outlines refusal to grant a patent application by the Commissioner.

If it comes to the attention of the Commissioner (otherwise than as a result of opposition proceedings) that an accepted patent application has been prior published then the Commissioner may refuse to grant the patent application unless the complete specification of the patent application is amended satisfactorily.

The prior publication may either be by a New Zealand patent specification published within 50 years of the date of filing of the patent application, or in any other published document not excluded by section 59(1).

This decision to refuse to grant the patent application can be appealed to the High Court.

-

Regulation 57: Notice to applicant

The Commissioner must give notice to the applicant if he considers that an accepted patent application has been prior published. The applicant is allowed 2 months from receiving such notice to submit an amendment to their application in order to satisfy the Commissioner’s concerns. This two month period can be extended under regulation 59 using a patents form 10.

-

Regulation 58: Hearing

If the Commissioner finds that the amendments are not satisfactory then the applicant can request to have a hearing on the refusal of the amendments.

-

3. Revocation

There are two ways of applying to have a patent revoked:

- under section 42 (Revocation of a patent by the Commissioner); or
- under section 41 (revocation of a patent by the Court).

(A) Revocation by the commissioner (section 42):

Within 12 months of the granting of a patent any person interested who did not oppose the grant of the patent can apply to the Commissioner to have the patent revoked using a patents form 45. An application to the Commissioner for revocation of a patent may be made on the same grounds as are available for opposing a patent (section 21(1)), and which are outlined above. The revocation process is the same as the procedure that applies to opposition.

A revocation action before the Commissioner may not be launched if there is an action for infringement or revocation proceeding pending in any court.

No fee is payable on a revocation application. A hearing fee will be payable if a hearing is requested.

After the application to revoke the patent has been filed, the Commissioner will inform the patentee the revocation proceedings have commenced.

If the Commissioner finds that any of the grounds for revocation have been made out then either the patent will be revoked or the Commissioner may allow the complete specification to be amended to his satisfaction.

-

Regulation 104: Application for revocation

The application for revocation should be accompanied by a statement of case, which must explain fully:

(i) the nature of the applicant's interest in opposing the patent (this interest must not be frivolous, vexatious, or blackmailing but should be both commercial and genuine);

(ii) the basis that the applicant relies on for the grounds identified in the application for revocation; and

(iii) the relief that the applicant seeks, e.g. costs.

Please note that under revocation proceedings the applicant is the person applying for the patent to be revoked and the patentee is the owner of the patent.

-

Regulation 105: Procedure for opposing revocation

Once an application to revoke the patent has been made and a copy has been sent to the patentee the provisions of regulations 49 to 54 apply to the revocation proceedings with the substitution of references to the patentee for references to the applicant and of references to the applicant for references to the opponent.

Any decision on the revocation application may be appealed to the High Court.

(B) Revocation by the court (section 41):

Any person interested can apply to the High Court to have the patent revoked at any time after the patent is granted.

The grounds for revocation by the Court are:

- Prior publication: The invention claimed in the patent has been claimed in a prior granted New Zealand patent application published before the priority date of the patent.
- Applicant not entitled to apply: The patent has been granted to a patentee who is not entitled to the patent under section 7.
- Obtaining: The patentee has obtained the patent in contravention of the rights of the person who had the actual right to apply.
- Not an invention: The patent is not for an invention i.e. not a manner of new manufacture as defined in section 2.
- Not new: The invention claimed in the patent is known or has been used (not including secret use) before its priority date.
- Obviousness: The invention claimed in the patent is obvious i.e. “clearly doesn't involve an inventive step” with regard to prior publication with regard to prior use.
- Inutility: The invention claimed in the patent is not useful.
- Insufficiency: The complete specification of the patent does not sufficiently describe either the invention, the method of performing the invention, or the best method of performing the invention
- Not fairly based: The claims of the patent are not clearly defined, sufficient or are not fairly based on the description in the complete specification.
- False suggestion: The patent has been obtained on false suggestion or representation.
- Secret use: The invention of the patent has been secretly used in New Zealand before its priority date, provided the use was not
  - a trial or experimental use;
  - use by a government department (where the invention has been disclosed to them); or
  - use by someone who did not have inventor's consent.
- Contrary to law: The patent granted is contrary to law.