

Challenging a patent application

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A New Zealand patent can be challenged in the application stage before it is granted.

Challenging a patent application is referred to as a patent opposition. An opposition prevents the application being granted, meaning the applicant cannot enforce the patent until the opposition has been decided.

When can a patent application be opposed?

Once a patent application has been examined and accepted by the Intellectual Property Office of New Zealand (IPONZ), it is published for opposition purposes. The patent application can be opposed at any time up to three months from the date it is published. A one month extension to the opposition period is available as of right upon application.

Because the details of a patent application are not open for inspection until it has been accepted, many companies keep a watch on a particular field of technology or on the patent activities of their competitors.

Who can oppose a patent application?

Only those parties who have an "interest" in the subject matter of the patent application are permitted to oppose. Interested parties are those who have a commercial interest (which may be a financial, manufacturing or trading interest) that may be affected by the grant of the patent, or those who have patents or patent applications for inventions in the same field.

An opposing party must establish that it was interested in the subject matter of the application at the time of launching the opposition. An intention to do something that could be affected by the grant of the patent may not give you entitlement to oppose a patent application unless those plans have been initiated or are well documented.

On what basis can a patent application be opposed?

Generally, any ground on which a patent application could have been refused during the examination phase is a ground of opposition. The main grounds are that the invention is not new or is obvious in view of what was published or used before the filing date of the application.

The opposition process is intended to prevent manifestly untenable patents being registered. The onus of proof lies with the opponent to show that the application should not be granted and the burden of proof to be successful in an opposition is relatively high. The post-grant revocation proceeding is intended to settle truly contentious cases..

What is the opposition process?

1. Notice of Opposition and Statement of Case

Within three months of a patent application being advertised, the opposing party must file two documents at IPONZ: a Notice of Opposition (which

sets out the grounds on which the application is being opposed) and a Statement of Case (which provides more detail on the grounds of opposition). Since the Statement of Case is a detailed document, an extension of time to file the Statement of Case at a later date can usually be obtained.

2. Counterstatement

Within two months of receiving the Notice of Opposition / Statement of Case, the patent applicant must file a Counterstatement which responds to the grounds of opposition (and often contains an explanation as to why the patent applicant thinks the application is valid).

3. Evidence

Within two months of receiving the Counterstatement, the opponent must file evidence to support the opposition and is given two months to do so. Evidence is usually presented in the form of declarations from the opponent and expert witnesses.

The applicant can then file evidence in support of its application (or responding to the opponent's evidence) within two months of receiving the opponent's evidence.

Finally, the opponent is given a further two months from receiving the applicant's evidence to file reply evidence. This evidence must be strictly confined to the matters raised in the applicant's evidence.

4. Hearing

The opposition is decided in a hearing before the Commissioner of Patents or his delegate. Both parties can provide written submissions before the hearing, which are then spoken to during the hearing itself (if the party elects to appear in person). The Commissioner will issue a ruling shortly afterwards.

The successful party may be awarded costs although these are usually only a small percentage of the costs actually incurred in the opposition. The Commissioner is not able to award damages.

How long does an opposition last?

If all the steps are completed within the specified time frames the opposition process will take about a year. However, it is common for IPONZ to extend the deadlines so that parties have enough time to present their case as fully and accurately as possible (since it is considered to be in the public interest for the Commissioner to have full information before making a decision). Accordingly, most oppositions take up to two years to complete.

What happens next?

If the opposition is successful, the patent application is not granted and is deemed to have been withdrawn. Alternatively, the Commissioner may require that the applicant amends the patent application so that it is in an allowable format. Usually, such an amendment would require some narrowing of the scope of the patent.

If the opposition fails, the patent application grants as a patent.

The Commissioner's decision can be appealed to the High Court by either party.

Other outcomes

Many oppositions are concluded before the process has run its full course as a result of settlement between the opponent and applicant. Either party may propose amendments to the claims which, if acceptable to both parties and to IPONZ, may result in the opposition being discontinued.

If the Statement of Case has been filed, the Commissioner is still obliged to consider the merits of the opposition in the public interest. However, without evidence and persuasive submissions it is unusual for an opposition in the public interest to be successful.

If you are concerned about the possibility of a patent application that may affect you, you should consult James & Wells Intellectual Property for further advice.

Disclaimer

The above is provided for general information purposes only and does not take the place of specific legal advice. For more specific advice on all aspects of intellectual property law please contact us.

Patent opposition procedure review

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