

# Grounds of opposition to a patent application

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**CHAMPIONS  
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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 unless the opposition is decided in the applicant's favour.

For more details on the patent opposition process, see "[Challenging a patent application – opposition process](#)" information sheet. This information sheet explains the nine statutory grounds for opposing a patent application.

## 1. Obtaining

The grant of a patent can be opposed if the applicant has obtained (or stolen) the invention from another party.

Generally, obtaining requires the misuse of certain knowledge by a party. Obtaining commonly arises in joint venture and collaborative arrangements. For example companies A and B might have complimentary services and begin discussions on how they might work together. In confidence, company A tells company B about an idea it is working on which is patentable. Company B decides it is a good idea and applies for a patent for the invention in its own name. Company A can challenge company B's patent application on the grounds that company B obtained the invention from it in breach of its rights.

The burden of proof required to establish obtaining is high. However, if it can be proved during opposition and the opponent has filed, or files, an application for the same invention, the opponent's application may take the same date as the opposed application. So in the example above, assume company B's application was filed on 1 January 2011. If company A files its own application for the same invention on 1 March 2011 and successfully opposes company B's application then company B's application will be voided and company A's application given a filing date of 1 January 2011.

## 2. Prior publication

If an invention which is the subject of a patent application has been published in New Zealand before the priority date of the patent application, then that invention lacks novelty and the patent application may be successfully opposed on the ground of prior publication.

"Published" means that a document can be freely examined by members of the public, as of right, in New Zealand, with or without payment of a fee. Documents available on the internet are considered to be published in New Zealand.

Not every document can be relied upon. Only documents published in New Zealand before the priority date of the application but dated less than 50 years before the filing date of the applicant's complete specification may be used to show prior publication in an opposition.

There are two distinct requirements for assessing whether or not a document prior publishes a patent application:

- i. **Disclosure:** The document must disclose subject matter which, if performed, would result in an infringement of the patent application; and
- ii. **Enablement:** The ordinary skilled person must have been able to perform the invention given the description of the invention in the application.

In other words, the prior document must satisfy the reverse infringement test and provide a disclosure which would enable a skilled addressee to work an invention which falls within the scope of the claims of the application. For more details, see "[Patent infringement – legal overview](#)" information sheet.

### 3. Prior claiming

The grant of a patent application can be opposed on the basis that another patent application for the same invention was filed before, but published after, the priority date of the opposed patent application.

Oppositions on this ground are rarely successful because the claims of the earlier application must be virtually identical to those of the opposed application.

### 4. Prior use

An application can be successfully opposed if the invention it describes has been publicly used in New Zealand before the priority date of the patent application.

For an opponent to successfully establish prior use they must show:

- That the instance of prior use was not a secret use of the invention;

- What was used and by whom it was used;
- Where and when that use occurred; and
- Where any apparatus still in existence can be inspected.

Prior use must be in a public manner. Secret use of an invention is not a ground of opposition (although it is a ground available for revoking a granted patent, see "[Challenging a granted patent in NZ](#)" information sheet).

Use for the purposes of reasonable trial within one year before the priority date of the invention is permissible. However, what constitutes "reasonable trial" is dependent on the nature of the invention and caution should generally be exercised before relying on this exception to prior use.

### 5. Obviousness

A patent application may be successfully opposed if the invention is obvious and *clearly* does not involve an inventive step having regard to what has been published or used in New Zealand before the priority date of the application.

The standard for showing obviousness in an opposition is high. The opponent must show that the invention is *clearly* obvious and the benefit of any doubt lies with the applicant. As such, oppositions rarely succeed on this ground.

The test used to assess obviousness looks at the differences between the inventive concept and the prior art and questions whether those differences would be obvious to the person of ordinary skill in the art without any degree of invention. If the differences are obvious, an opposition will be successful.

A “person having ordinary skill in the art” is an imaginary person who is familiar with the common general knowledge in the relevant field but is not capable of any degree of invention. A team of people having the relevant skills may also constitute the person of ordinary skill in the art.

Some inventions are combinations (or collocations) of known components or features. A collocation is only regarded inventive if there is a combined effect (often described as “synergy”) between the separate parts or if the whole is greater than the sum of the parts. If each part performs the function it was intended to do independently then the combination may be obvious.

Some other factors that may be used to show that an invention is not obvious are:

- A prior publication “teaches away” from the invention, i.e. actively suggests the invention would not work or is disadvantageous;
- There was a technical prejudice against the implementation of the invention, for example the invention is contrary to a belief in the relevant field that the invention is unfeasible; and
- The invention is commercially successful.

## 6. Not an invention

A patent application can be opposed on the grounds that it is not an invention according to the definition of patentable subject matter under the Patents Act.

Some examples of non-patentable subject matter include:

- Mere discoveries and mathematical methods;
- Methods of medical treatment of humans; and
- Business methods and computer programs that do not have a commercially useful effect.

For more details on patentable subject matter, see [“Patentable subject matter”](#) information sheet.

## 7. Insufficient description

The description in a patent specification must be sufficiently detailed to enable a person reading the patent specification to put the invention into practice without further invention and without excessive trial and error. This reflects one of the fundamental justifications for the patent system: that an inventor is rewarded for innovating with 20 years of exclusive rights in an invention in return for teaching the public how to perform the invention so that they can develop it further.

A patent application can be opposed if the patent specification does not do this.

An application with broad, ambiguous or speculative claims may be vulnerable to opposition using this ground.

## 8. Convention application filed out of time

A New Zealand patent application can claim priority from an earlier foreign application if it is filed within 12 months of the filing date of the earlier foreign application. This deadline can only be extended under extenuating circumstances. If the deadline is missed but a New Zealand application is filed anyway, the application can be opposed on account of the missed deadline.

## 9. Improper restoration or extension of time

A number of deadlines must be complied with during the patent application process.

However, there are circumstances when these deadlines can be extended or, where a deadline has been missed, an application can be restored (since the application will be deemed abandoned if a deadline is missed).

It is a ground of opposition that:

- Failure to comply with a deadline was deliberate;
- There was undue delay applying for restoration of an application where a deadline has been missed; or
- A deadline extension was wrongly granted.

This ground is hardly ever pleaded but its presence ensures that procedures during the application process are complied with.

If you are concerned about the potential grant 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.