

Patent oppositions FAQ

What is an opposition?

In New Zealand, once a patent application is accepted it is published so that interested parties can object to it proceeding to grant. The objection process is known as a patent opposition.

Can anyone oppose?

No. To oppose you need to show that you have standing. This is usually done by showing you have your own patent application/registration in the same field, or you have a genuine commercial interest that might be harmed by the grant of the patent. An intention to move into the field covered by the patent will not give you standing unless you have already acted on it.

What are the grounds of opposition?

Generally speaking, any ground on which a patent could have been refused during the examination phase is a ground of opposition.

The main grounds include:

Obtaining:

the applicant stole the invention from you.

Prior publication or prior use:

the invention is not novel because it was published or used by the inventor or applicant more than 12-months before the date the complete patent application was filed, or was published or used by others before the priority date of the patent application.

Obviousness:

the invention lacks inventive step because it was obvious to someone in the same field at the priority date based on what was published, used or generally known.

Not an invention:

the subject matter of the application is not patentable.

Insufficiency:

the patent specification doesn't tell a reader how to put the invention into practice.

How and when do I oppose a patent?

Notice of Opposition and Statement of Case

At any time within three months from the date of advertisement of a patent in the Intellectual Property Office Journal, any person with standing may oppose the grant of a patent by giving notice (called a Notice of Opposition) to the Commissioner of Patents.

Statement of Case

The Notice of Opposition must be accompanied by a Statement of case which comprehensively sets out the grounds upon which the patent is opposed and any documentation which the opponent proposes to rely on. The opposition is not deemed launched until the Statement of case and supporting documentation has been supplied to the Intellectual Property Office and to the patent applicant. Due to the complexity of this document, it is standard practice for the Intellectual Property Office to

extend the deadline for filing the Statement of case.

Counterstatement

Within two months of the date of receipt of the Notice of Opposition, the applicant must file a counterstatement with the Commissioner of Patents setting out the grounds upon which the opposition is contested. If a counterstatement is not filed within the period allowed, the applicant is deemed to have abandoned the application.

Evidence

Upon receipt of the counterstatement, the opponent is given two months to file evidence in support of the opposition.

Evidence is presented in the form of statutory declarations from the opponent and, where appropriate, other interested parties. If the opponent does not file any evidence (or advise the applicant it doesn't intend to do so) it is deemed to have abandoned its opposition.

Within two months of the date of the receipt of evidence in support of the opposition, the applicant can file evidence in support of the patent application.

Within two months of the date of receipt of the applicant's evidence, the opponent can file evidence in reply. This evidence must be confined to matters raised in the applicant's evidence.

Hearing

No further evidence can be filed by either party except with leave of the Commissioner. The opposition is usually then set down for a hearing at which each party speaks to

written submissions in support of their respective case.

Ruling

After the hearing the Commissioner of Patents makes a determination and issues a written decision. This will usually take several weeks to prepare and send to the parties.

Can I extend any of these deadlines?

In most cases yes, although to get an extension you need to show you have acted diligently to meet the previous deadline and the justice of the case warrants an extension (ie you will suffer detriment if it is not granted).

How long will the opposition take?

If all steps are completed within the specified time frames the opposition will take 10 – 11 months to be heard. If extensions are granted it will take longer, but most opposition proceedings should be concluded within 18-24 months.

Can I get costs and damages if I am successful?

The Commissioner does have the power to award costs to the successful party. However these are in accordance with a set schedule for each step completed and usually only cover a small percentage of costs actually incurred by the parties. The Commissioner has no power to award damages.

Can I appeal the decision?

Yes. Decisions can be appealed to the High Court.

Where can I find out more information on patent oppositions?

You can find out more by contacting our Patents Team or our Litigation Team.

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