

Opposition Case Management

As outlined in the FICPI Australia submission of 16 October 2007, FICPI Australia generally takes the view that review of patent opposition case management should be delayed pending the recommendations of the current ACIP review. Nonetheless, having regard to the issues raised at the last PCG meeting relating to claim amendment during the course of a patent opposition, further views have been sought from the Council members of FICPI Australia. We stress, however, that FICPI Council has not as yet canvassed its broader membership and the following ideas are therefore expressed for the purposes of stimulating further discussion as opposed to positively endorsing any particular approach:

(a) Allow amendments to specifications during oppositions only during defined periods

For example, the periods in which amendments could be made could be restricted, as follows:

(i) Amendments would be permissible at any time up to the finalisation of evidence-in-answer. This would mean that opponents would have an opportunity to file any new evidence in response to amended claims with their evidence-in-reply.

(ii) The Commissioner could adopt the practice of issuing an opinion (rather than a decision) following the substantive opposition hearing and giving the applicant a defined period (say 2 months) after issuance of an opinion to make amendments to address issues raised in the opinion. Only after such amendments are proposed and considered would the Commissioner make a decision (embodying all issues raised in the opposition) that could be the subject of an appeal by either party to the Court. This would go some way in addressing the problems which arose in *Airsense Technology Limited v Vision Systems Limited* [2007] FCA 828.

(b) Allow amendment and ancillary claims up to the filing of evidence-in-answer

The period for amendment could be restricted such that amendments to the specification would be allowed only up to the time of finalising evidence-in-answer. However, to compensate applicants for this restriction upon the flexibility of making amendments applicants could be allowed to file up to two sets of ancillary or fall-back amendments at the same time, which could be considered by the Commissioner at the substantive opposition hearing. The parties would have an opportunity to make submissions at the hearing on both the allowability (or not) of the amendments as well as on the patentability (or not) of the original and subsidiary claims. Under this proposal there would be no separate opposition to amendments under section 104.

(c) Give the Court sole responsibility for consideration of amendments during opposition appeals

At the conclusion of the opposition procedure, once the Commissioner's decision has issued, amendment in the course of the appeal could only be proposed before the court. This could be achieved by amending section 112 to cover patent applications in addition to granted patents, modifying the definition of relevant proceedings and giving the court the power to amend patent applications under section 105. The last of these matters, namely the power of the court to amend under section 105 would appear to be desirable in any event.

We trust that these alternatives lead to further discussion and proposals from IP Australia that we could then take to our broader membership.

We will be pleased to discuss or expand upon these options if desired.

FICPI Australia
14 February 2008

per Greg Chambers
Secretary