

Retaining the Dam Wall: Does a Recent Case Suggest a Review of Australia's Pre-Grant Patent Oppositions?

Vanessa Farago-Diener¹ and John Lee²

Introduction

A recent decision by Justice Beach of the Federal Court of Australia (“Federal Court”) in *SNF (Australia) Pty Ltd v BASF Australia Ltd* (2019) 140 IPR 276 (“*SNF v BASF* proceeding”)³ highlights the potential for patent applicants to face significant costs and delay in obtaining grant when pre-grant oppositions spill over into appeals from the Australian Patent Office (“Patent Office”) to the Federal Court.

The decision of Beach J concerned two appeals (heard and determined together) from decisions of a delegate of the Commissioner of Patents in *SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatments Ltd* [2016] APO 8 and [2016] APO 72 which concerned the patentability of BASF’s Australian Standard Patent Application Nos. 2004203785 (“785 Patent”) and 2013204568 (“568 Patent”).

At the conclusion of a 392-page judgment, Beach J’s ultimate finding was:⁴

[1783] SNF has made out none of its grounds [of opposition] on the present appeals, namely, its grounds concerning lack of inventive step, secret use and lack of novelty. Accordingly, its appeals in each case will be dismissed with costs.

However, in the concluding paragraph of the decision, Beach J made a final observation regarding the length, complexity and delays encountered in the proceedings and posed a number of questions for reflection:⁵

[1784] Let me conclude with one final observation. The hearing of these appeals has not proceeded smoothly. The three weeks initially set aside for the hearing turned out to be inadequate. The hearing had to be adjourned over for a further week of evidence months later, and then further adjourned for several days of closing addresses. The substantial adjournments were necessary to accommodate the other significant commitments of counsel, witnesses and the Court. I make no criticism. It is what it is. But the sheer length, complexity and delays involved in these appeals does give cause to reflect on the following questions. Should appeals of this type be permitted to proceed as rehearings de novo allowing the parties to run any ground they like, whether raised before the delegate or not, and upon any evidence they choose, whether adduced or available to be adduced before the delegate or not? Or should they be permitted to proceed only upon the grounds and evidence led before the delegate with truly fresh evidence only being permitted in exceptional circumstances? Or should there be no appeal at all from the decision of the delegate, but only judicial review permitted demonstrating jurisdictional error? Or should there be an appeal for error of law only, and perhaps only with leave? Now these are policy questions, and legislative

amendment would be necessary. But on any view it is not sufficient to tinker with the problem by fiddling with the standard of proof, which provided no real solution to deal with the length and complexity of what unfolded before me, notwithstanding the case management techniques available. But perhaps a more robust approach can be taken.

His Honour concluded that:⁶

One solution may be to put the parties on a chess clock to limit a hearing of the present type to 5 days rather than 5 weeks. And instead of 20 volumes of double-sided material as the standard length of a court book, this could be severely confined. Further, perhaps it is time for appellate courts to show some guidance in permitting short form reasons.

The concluding comments of Beach J raise the issue of whether it is time for further substantive changes to be made to the pre-grant opposition procedure in Australia, not only in respect of appeals to the Federal Court but the opposition process itself before the Patent Office.

Background to the *SNF v BASF* proceeding

The patent dispute between SNF and BASF had been ongoing for more than a decade.

BASF is a German chemical company providing solutions across a range of industries, relevantly including mining. SNF is a French chemical company which competes with BASF. Both companies have global operations.

The relevant BASF patent family is directed to processes for treatment of mine tailings. Tailings, are the residual waste material left over from a mining operation after extraction of the relevant value, such as gold, zinc, iron ore, coal or alumina. The tailings are traditionally transported as a slurry and deposited into a tailings dam. Given the scale of mining operations, tailings dams can be very significant in terms of size (several square kilometres) and volume, sometimes constituting millions of cubic metres.

In the latter part of last century, there were significant environmental and commercial pressures on mining operators to minimise land use for disposal of waste materials,

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to consume significantly less water in mining operations and to rehabilitate the land more effectively. Further, there have been significant safety issues arising out of poorly managed tailings disposal, with a number of high profile cases where tailings dams have collapsed, with devastating effects including loss of life.

The commercial embodiment of the invention the subject of BASF's patents is known as Rheomax® Enhanced Tailings Disposal or "ETD".⁷ The technology involves the addition of a chemical flocculant to a tailings stream using a particular methodology in order to ensure that upon deposition there is rapid release of clean water and the enhanced rigidification of the solid material. This results in significant improvement in water management and enhancement of land rehabilitation.

Procedural history

It is important to understand the lengthy and complex procedural history of the present case.

- BASF's 785 Patent was opposed by SNF in October 2007. The opposition was subsequently stayed after SNF commenced revocation proceedings in the Federal Court in respect of the validity of five innovation patents which were filed as divisional applications from the 785 Patent. BASF cross-claimed for infringement. BASF's innovation patents were held to be valid by Kenny J and BASF succeeded in its cross-claim for infringement.⁸
- SNF appealed the decision of Kenny J to the Full Federal Court of Australia ("Full Federal Court"), where a majority dismissed the appeal.⁹ SNF then sought special leave to appeal to the High Court, which was refused.¹⁰
- Subsequently, in April 2014, SNF filed an interlocutory application seeking to re-open the decision of Kenny J. The application was dismissed by Davies J.¹¹ SNF then sought leave to appeal the decision of Davies J, which was refused by the Full Federal Court.¹²
- The innovation patent case then moved to the quantum phase but was settled on the basis that SNF paid BASF compensation for infringement and legal costs. SNF then returned to its oppositions to the 785 and 568 standard patents.
- In both its oppositions before the Patent Office and its appeals to the Federal Court, SNF contended that the 785 Patent and 568 Patent were invalid for lack of novelty, lack of inventive step and that BASF had secretly used the invention before the priority date. As set out above, Beach J dismissed SNF's appeals finding that none of the grounds of opposition were made out.
- The 785 and 568 Patents were granted in May 2019, some 16 years after their priority date.

Overview of pre-grant patent opposition procedure in Australia

Since the enactment of the first federal *Patents Act* in Australia in 1903, Australia has had in place a federal pre-grant patent opposition procedure.

During examination, the Patent Office reviews an application to assess that it meets the various criteria for grant of a patent including, novelty, inventive step, manner of manufacture and that the specification complies with s.40.¹³ In examining a patent application, the Patent Office will search for and consider relevant prior art. However, the Patent Office has finite resources, is under time constraints and does not have ready access to independent experts, in some cases making it difficult for the Patent Office to assess what would be common general knowledge. Consequently, the extent of scrutiny of an application during examination in the Patent Office is necessarily more limited than it would face during an inter partes opposition.

Once a patent application has been examined, if any objections to patentability raised during the examination process have been overcome by submission or amendment, the Patent Office will advertise that the patent application has been accepted. Within a three-month period, any third party can then oppose the patent application proceeding to grant on one or more of the grounds set out in s.59 of the *Patents Act* 1990 (Cth) ("1990 Act"). The purpose of pre-grant patent oppositions, as observed by Black CJ, Merkel and Goldberg JJ in *Genetics Institute Inc v Kirin-Amgen Inc* (1999) 92 FCR 106 is:

*... to provide a swift and economical means of settling disputes that would otherwise need to be dealt with by the courts in more expensive and time consuming post-grant litigation; that is, to decrease the occasion for costly revocation proceedings by ensuring that bad patents do not proceed to grant.*¹⁴

Decisions from patent oppositions can be appealed to the Federal Court under s.60 of the 1990 Act. The appeal is a hearing de novo in which the Federal Court exercises its original jurisdiction.¹⁵ Nevertheless, the findings made by a Delegate may "be given significant weight by the court because of the considerable experience and expertise that would have been brought to bear in making the decision".¹⁶ Importantly, as was significant in these proceedings, the Court is not limited to considering the evidence which was before the Patent Office and may, and usually does, admit further evidence.¹⁷ The Court can also consider additional grounds under s.59 of the 1990 Act, which were not raised in the opposition before the Patent Office,¹⁸ as well as new prior art/acts. For example, in the present case, SNF relied on a new prior act not considered by the Patent Office in its contention that BASF's 785 and 568 Patents lacked novelty.

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It is important to note that if the outcome of an appeal to the Federal Court is that the patent should proceed to grant, that is not the final word on validity from an opponent's perspective. Any party wishing to challenge the patent still has the opportunity of commencing post-grant revocation proceedings in the original jurisdiction of the Federal Court.

Reviews of the pre-grant opposition regime

Over the life of Australia's pre-grant opposition process, there have been numerous reviews and calls to amend or abolish the regime.

In 1984, following consultation with industry, the Industrial Property and Advisory Committee ("IPAC") recommended that pre-grant patent oppositions in Australia be abolished¹⁹ ("1984 Report"). The 1984 Report also recommended that an ex-parte re-examination procedure on questions only of novelty and obviousness should be available after acceptance and grant of a patent.²⁰

The 1984 Report noted that the rationale advanced for pre-grant patent oppositions was to ensure granted patents were as robust as possible, and that a hearing before the Patent Office is *"an inexpensive and effective adjunct to examination and search in ensuring that weak patents are not granted"*.²¹

However, the 1984 Report made the following observations:

- Oppositions can be used as a means for a competitor to delay the grant of a patent, with it not being unusual for oppositions to take five to eight years.²²
- Cost implications of oppositions may be significant for a small inventor who has limited resources.²³
- Opposition proceedings may have the effect of enabling competitors to "pirate" the invention and to compete with the inventor directly for the whole of the commercially useful life of the invention.²⁴

The 1984 Report concluded that:²⁵

We can see no sufficient reason for retaining the present pre-grant opposition procedure if other effective means of challenging patents can be made available. We note that most other patent systems, including those of the US and EEC countries, do not permit pre-grant opposition.

Having regard to the recommendation in the 1984 Report that ex-parte re-examination should be introduced, the proposal put forward by the authors of the 1984 Report was to extend the time period in which a third party could notify the Patent Office of matters affecting novelty and obviousness to up to three months after acceptance and at any time after grant.

Nevertheless, IPAC's recommendation was not adopted with the introduction of the 1990 Act which maintained the pre-grant opposition process.

In 1999, the issue of abolishment of pre-grant patent oppositions in Australia was again raised by the Advisory Council on Intellectual Property ("ACIP"). In looking at difficulties faced by Australian patent owners in being able to effectively enforce their rights, ACIP considered the issue of pre-grant versus post-grant opposition procedures ("1999 Report").

The 1999 Report identified a number of key factors as contributing to the uncertainty Australian patentees face in enforcing their patent rights, including that better resourced stake holders could abuse the system resulting in unfair outcomes for smaller parties.²⁶ While ACIP formed the opinion that opposition procedures needed to be streamlined²⁷ and supported replacing the pre-grant patent opposition procedure with a post-grant procedure,²⁸ with little industry support, the recommendation did not proceed.²⁹

A decade later, after another consultation process, ACIP released a further report in January 2010 ("2010 Report")³⁰ which again addressed the pre-grant opposition procedure.

ACIP had obtained feedback on the following two key questions: whether a post-grant opposition system would offer greater benefits over the existing system; and whether such a system would help patent owners better enforce their patent rights.³¹ Responses were divided.³²

Ultimately, the 2010 Report found that there was insufficient justification for Australia to change to a post-grant opposition system.³³ The 2010 Report recommended that IP Australia continue to monitor and review the opposition processes both locally and abroad to identify whether there is any convincing reason for change from the pre-grant opposition process (recommendation 9).

ACIP noted the following in reaching this conclusion:³⁴

- Concern that abolition of pre-grant opposition may convey the perception to first time patent applicants that the administrative process has ended with the grant of their patent, when in fact it still may be challenged before the Patent Office after grant.
- Sympathy for the argument that unmeritorious patents should not be granted, affecting the confidence that innovators, inventors and investors have in granted patents.
- The failure to address the perceived problems with the current regime, namely that while abolishing pre-grant oppositions could result in earlier grant of patent rights and ability to enforce, any opposition procedure would still result in delay.
- The potential impact on the balance of rights and interests between potential patentees and third parties exploiting technology in the same field.

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The 2010 Report noted that:³⁵

ACIP is therefore reluctant, on the basis of the information available to it, and the limited analysis carried out to date, to recommend such a change at this time. However, there is persuasive evidence that the pre-grant opposition process in Australia would benefit from a more detailed review.

A very important reform step with wider implications for patent law in Australia commenced in 2013 with the introduction of the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012 (Cth)* (“*Raising the Bar*”). The Explanatory Memorandum³⁶ to *Raising the Bar* stated:

In order to meet its objective of supporting innovation, the patent system must strike a balance. It must provide sufficient protection to reward innovation, but not so much protection as to block future or follow-on innovation. Concerns have been raised that the thresholds set for the grant of a patent in Australia are too low, suppressing competition and discouraging follow-on innovation.

In relation to pre-grant patent oppositions, the *Raising the Bar* regime introduced amendments which were clearly aimed at reinforcing the procedure, presumably in order to prevent unmeritorious patent applications proceeding to grant. The amendments included:

- Removing the requirement in s.7(3) of the 1990 Act that the prior art in considering inventive step had to be “ascertained, understood and regarded as relevant” by a skilled person in the art.³⁷
- Lowering the standard of proof an opponent has to meet in order to succeed.
- Entrenching evidence deadlines to minimise delays in oppositions.³⁸

Therefore *Raising the Bar*, one of the more far reaching and important reviews of patent law in Australia, resulted not only in the retention, but the reinforcement, of pre-grant oppositions as a means of testing patent applications prior to grant. An analysis by one commentator conducted in 2017³⁹ shows that these changes have made a significant difference, finding that the:

- average time required for parties to prepare and file all evidence relating to the opposition reduced from 803 days to just 250 days; and
- average duration of patent oppositions had been cut by nearly 50 percent.

The position in other jurisdictions

The retention of a pre-grant patent opposition procedure in Australia diverges from the policy of a number of our important trading partners who have steadily shifted towards post-grant opposition.⁴⁰

United Kingdom (“UK”) position

Until the introduction of the 1977 Patents Act (“1977 Act”), pre-grant oppositions existed in the UK Patent Office. The 1977 Act introduced a post-grant patent opposition procedure before the UK Patent Office under which the Office could consider any ground of invalidity on which a patent application could be challenged.⁴¹

The principal effect of the 1977 Act was to draw UK patent law closer with its European trading partners, in accordance with the provisions of the *European Patent Convention* (“EPC”) which came into effect on 1 June 1978.

European Union (“EU”) position

Article 99 of the EPC allows a third party to apply to revoke a European patent by filing an opposition with the European Patent Office (“EPO”) within nine months from grant of the patent.

The EPC specifically allows third parties to bring revocation proceedings before the EPO which, if successful, will result in the revocation of the European patent in toto in all the designated states. These revocation proceedings or “opposition proceedings” are dealt with by the opposition division of the EPO. Opposition proceedings may only be brought on the following grounds:

- (a) the subject matter of the patent is not patentable under the EPC;
- (b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; and
- (c) the subject matter of the European patent extends beyond the content of the application as filed.

United States of America (“US”) position

In 2011, the *Leahy-Smith America Invents Act* (“AIA”) of 16 September 2011 introduced a post-grant patent review procedure which provides for the review of the patentability of one or more claims of a patent on any ground that could be raised under § 282(b)(2) or (3), including novelty, inventive step, statutory subject matter, written description, enablement and definiteness.⁴²

The post-grant review process begins with a third party filing a petition on or prior to the date that is nine months after the grant of the patent or issuance of a reissued patent. The patent owner may file a preliminary response to the petition. If the proceeding is instituted and not dismissed, a final determination will be issued.

Is a change to the Australian regime required?

As set out above, the Australian pre-grant opposition regime has been the subject of extensive review and consideration over the past 30 plus years. None of the reviews has resulted in abolition or fundamental amendment to the regime.

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Based on analysis of the statistics, it is clear that the changes implemented over time to the pre-grant opposition procedure, particularly those implemented with *Raising the Bar*, have provided a more efficient and robust mechanism to determine the validity of patent applications prior to grant. Although the *Raising the Bar* amendments lowered the standard for an opponent to succeed in an opposition, there is no evidence that a greater number of oppositions have been implemented since its introduction.

In keeping with the retention of the pre-grant opposition regime notwithstanding numerous reviews, the authors consider on the whole it is preferable to a post-grant regime. This is because it enables third parties to challenge and either defeat entirely, or force amendments to confine the scope of, unmeritorious patent applications without facing the prospect of defending simultaneous infringement proceedings. Significantly, a large majority⁴³ of the oppositions that are implemented are either resolved between the parties or determined by the Patent Office without subsequent appeal to the Federal Court. This can be seen as compelling evidence of the success of the pre-grant regime. The ability of a patentee who succeeds in an opposition to claim compensation for infringement dating back prior to grant, mitigates to a large extent any delay in their ability to enforce their rights, particularly as interlocutory or preliminary injunctions are relatively rare.⁴⁴

To date, reviews of Australia's opposition regime have for the most part focused on the merits of pre-grant versus post-grant regimes. Reviews have not tended to focus on the second stage of opposition disputes, namely appeals from decisions of the Commissioner of Patents to the Federal Court.

As the *SNF v BASF* proceeding demonstrates, a balancing act is required. On the one hand the process must enable a patent application to be subjected to a robust review before grant. On the other hand, the process should mitigate against excessively drawn out and costly proceedings resulting in undue deferral of grant.

The concluding comments of Beach J offer a number of potential options for consideration in respect of a Federal Court appeal.

Should appeals of this type be permitted to proceed as rehearings de novo allowing the parties to run any ground they like, whether raised before the delegate or not, and upon any evidence they choose, whether adduced or available to be adduced before the delegate or not? Or should they be permitted to proceed only upon the grounds and evidence led before the delegate with truly fresh evidence only being permitted in exceptional circumstances?

Or should there be no appeal at all from the decision of the delegate, but only judicial review permitted demonstrating

jurisdictional error? Or should there be an appeal for error of law only, and perhaps only with leave?

It is apparent that in the hearing de novo that took place in the *SNF v BASF* proceeding, the current Federal Court case management tools were unable to constrain the case advanced by the opponent SNF.⁴⁵ The opponent filed 22 affidavits from 13 different witnesses,⁴⁶ including a number of experts. A number of these affidavits and witnesses overlapped with SNF's oppositions in the Patent Office but a substantial volume of additional material and additional witnesses were relied on. In addition, SNF obtained extensive discovery during the course of the appeal⁴⁷ and issued production requests to BASF and subpoenas to third parties.⁴⁸ The appeals before Beach J were heard over the course of 21 days which, based on some analysis, is one of the longest patent appeals ever in Australia.⁴⁹

Given the extensive and complex history of the suite of proceedings set out above, it was perhaps not surprising that SNF had significant leeway in relation to the way in which it prosecuted the appeals.

For a range of reasons, the authors consider that the current appeal regime should be maintained. Further, for the reasons that follow, it is considered that review by the Federal Court should not be confined to judicial review but should continue as hearings de novo, including the consideration of further evidence. These include that the opposition process before the Patent Office is necessarily limited in terms of procedural rigour. For example, there is very limited if any discovery or document production, the rules of evidence in terms of admissibility and form are not applied and there is rarely any opportunity to test evidence by way of cross-examination.

Given the potentially significant commercial implications of the grant of a patent in relation to a valuable area of commerce, as was clearly the case in the *SNF v BASF* proceeding, it is considered that an appeal from an opposition should be maintained as a hearing de novo with the ability to adduce new evidence. The grant of a patent obviously entitles a patentee to commence infringement proceedings against competitors and to seek potential injunctions, a right which should not be lightly conferred. Conversely, should the Patent Office refuse the grant of a patent application, following what is effectively an administrative proceeding, without the patent applicant having a right of appeal in the form of a hearing de novo, that could significantly undermine confidence in the patent regime with potential consequences for innovation in this country.

A final observation is that there is no right of appeal to the Full Federal Court from a first instance judgment on an appeal of an opposition. The unsuccessful party must obtain leave. This has the practical effect that a first instance judgment is often final, particularly if the opponent fails.

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Notwithstanding the unprecedented history of the *SNF v BASF* proceeding, it is notable SNF did not seek leave to appeal from Beach J's judgment.

As Beach J commented, in some cases there may be a place for more stringent case management and procedural restrictions to be implemented. It is considered that there are a number of procedural tools which can assist in constraining the scope and duration of appeals from oppositions in patent cases in appropriate circumstances. These include:

- the Federal Court's increasing willingness to allocate a date for final hearing at an early stage so that there is a fixed end point;
- the use of agreed statements of issue, reliance on exemplar patent claims and technology primers;
- the increasing use of expert "hot tubs" and joint expert reports to distil the key technical issues;
- the common practice of providing page limitations for written submissions, particularly in relation to interlocutory issues;
- the implementation of the *Federal Court Rules* 2011 (Cth) which revised the discovery regime such that a party must not apply for discovery unless it will "facilitate the just resolution of the proceedings as quickly, inexpensively and efficiently as possible";
- reliance on the overarching principles of sections 37M and 37N of the *Federal Court of Australia Act* 1976 (Cth) and the obligations they impose on parties and practitioners to co-operate with the Court and each other to assist in achieving the overarching purpose of civil practice and procedure and case management, by identifying the real issues in a dispute early, dealing with those issues efficiently and eliminating unnecessary "process driven" costs;⁵⁰ and
- the mechanisms outlined in the Federal Court's *Intellectual Property Practice Note (IP-1)* such as use of an agreed primer to explain the technical background to the invention claimed, use of agreed statements or tables delineating the scope of the validity dispute and that parties must only rely on prior art documents which after due consideration it considers "can properly be advanced as novelty-destroying disclosures".⁵¹

It is the authors' view that in appropriate cases, the Court could implement some of these tools quite stringently, particularly as against an opponent, as it must be kept in mind that an opponent has a further opportunity to challenge a patent by way of post-grant revocation. In keeping with the overall policy objective of pre-grant opposition, an opponent should be forced, whenever possible, to only put forward their best case.

Of course in a Federal Court appeal, there is an economic incentive for the parties to prosecute their case efficiently and without undue delay in the form of Australia's "loser pays" regime in relation to the recovery of legal costs. The usual costs order flowed in the *SNF v BASF* proceedings.

Beach J further stated:

One solution may be to put the parties on a chess clock to limit a hearing of the present type to 5 days rather than 5 weeks. And instead of 20 volumes of double-sided material as the standard length of a court book, this could be severely confined. Further, perhaps it is time for appellate courts to show some guidance in permitting short form reasons.

In relation to these additional comments by Beach J, it seems that in many cases the Federal Court case management protocols discussed above can be effectively implemented to achieve the desired outcomes. Clearly in the *SNF v BASF* proceeding, these objectives could not be achieved, not through any failure of case management, but simply because of the unique nature of the case brought by SNF. The history and context of the case put it at the extreme end of the spectrum of oppositions and the case did not lend itself readily to constrained case management.

Conclusion

The *SNF v BASF* proceeding was unique in terms of its history, duration and scope. SNF, presumably motivated by significant commercial imperatives, implemented a very comprehensive opposition both before the Patent Office and subsequently on appeal. While the particular circumstances of the case required the Federal Court to hear very extensive evidence, sit for an extended period and issue very comprehensive and detailed reasons dealing with all SNF's arguments, we consider that the case itself does not suggest that a wholesale review of the patent opposition regime is warranted.

The significant history of review of the pre-grant opposition regime in Australia has not resulted in an alternative regime being implemented. This suggests that, although not perfect, the current system is in fact workable and meets the desired balance. In relation to appeals to the Federal Court, it appears from the data that all but the most extreme cases are being effectively case managed to avoid unnecessary blow outs in their scope, duration and cost. This is evidenced by the fact that the average length of an appeal hearing is only some six days,⁵² which in the context of often highly technical subject matter, seems relatively reasonable.

For the exceptional cases, where the commercial context may prompt the parties to engage in "mega-litigation", the Federal Court can rely on appropriate costs orders to provide an economic disincentive and signal to litigants that they should bear in mind the provisions of s 37M of the *Federal Court of Australia Act* 1976 (Cth) in prosecuting their case.

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- 1 Vanessa Farago-Diener is a lawyer at Gilbert + Tobin in Sydney.
- 2 John Lee is a partner at Gilbert + Tobin in Sydney.
- 3 The authors acted for the respondent, BASF, in the *SNF v BASF* proceeding.
- 4 *SNF (Australia) Pty Limited v BASF Australia Ltd* (2019) 140 IPR 276, 570 [1783].
- 5 *SNF (Australia) Pty Limited v BASF Australia Ltd* (2019) 140 IPR 276, 570 [1784].
- 6 *SNF (Australia) Pty Limited v BASF Australia Ltd* (2019) 140 IPR 276, 570 [1784].
- 7 *SNF (Australia) Pty Limited v BASF Australia Ltd* (2019) 140 IPR 276, 331 [356].
- 8 *SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatments Ltd* (2011) 92 IPR 46.
- 9 *SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatments Ltd* (2012) 204 FCR 325.
- 10 Transcript of Proceedings, *SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatments Ltd* [2013] HCATrans 054 (15 March 2013).
- 11 *SNF (Australia) Pty Ltd v Ciba Specialty Chemicals Water Treatment Limited* (2015) 114 IPR 231.
- 12 *SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatments Ltd* [2016] FCAFC 88 (20 June 2016).
- 13 *Patents Act 1990* (Cth), s.45(1) with s.18(1) and ss.40(2)-(4).
- 14 *Genetics Institute Inc v Kirin-Amgen Inc* (1999) 92 FCR 106 at [19].
- 15 *Imperial Chemicals Industries Pty Ltd v Commissions of Patents* (2004) 213 ALR 399 at [49].
- 16 *EI Du Pont de Nemours & Co v ICI Chamericals & Polymers Ltd* (2003) 128 FCR 392 at [28].
- 17 *EI Du Pont de Nemours & Co v ICI Chamericals & Polymers Ltd* (2003) 128 FCR 392 at [16].
- 18 *EI Du Pont de Nemours & Co v ICI Chamericals & Polymers Ltd* (2003) 128 FCR 392 at [21].
- 19 Industrial Property and Advisory Committee, Parliament of Australia, *Patents, Innovation and Competition in Australia* (1984) 70.
- 20 Industrial Property and Advisory Committee, Parliament of Australia, *Patents, Innovation and Competition in Australia* (1984) 69.
- 21 Industrial Property and Advisory Committee, Parliament of Australia, *Patents, Innovation and Competition in Australia* (1984) 69.
- 22 Industrial Property and Advisory Committee, Parliament of Australia, *Patents, Innovation and Competition in Australia* (1984) 69.
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- 24 Industrial Property and Advisory Committee, Parliament of Australia, *Patents, Innovation and Competition in Australia* (1984) 70.
- 25 Industrial Property and Advisory Committee, Parliament of Australia, *Patents, Innovation and Competition in Australia* (1984) 70.
- 26 Advisory Council on Industrial Property, *Review of Enforcement of Industrial Property Rights* (1999) 2.
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- 29 Advisory Council on Industrial Property, *Review of Enforcement of Industrial Property Rights* (1999) 24.
- 30 Advisory Council on Intellectual Property, *Post-Grant Patent Enforcement Strategies* (2010).
- 31 Advisory Council on Intellectual Property, *Post-Grant Patent Enforcement Strategies* (2010) 54.
- 32 Advisory Council on Intellectual Property, *Post-Grant Patent Enforcement Strategies* (2010) 54.
- 33 Advisory Council on Intellectual Property, *Post-Grant Patent Enforcement Strategies* (2010) 17.
- 34 Advisory Council on Intellectual Property, *Post-Grant Patent Enforcement Strategies* (2010) 54-55.
- 35 Advisory Council on Intellectual Property, *Post-Grant Patent Enforcement Strategies* (2010) 56.
- 36 Explanatory Memorandum, *Intellectual Property Laws Amendment (Raising the Bar) Bill 2011* (Cth).
- 37 Explanatory Memorandum, *Intellectual Property Laws Amendment (Raising the Bar) Bill 2011* (Cth), Schedule 1, Item 3.
- 38 Explanatory Statement, *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013* (No. 1) (Cth), Schedule 3.
- 39 Mark Summerfield, *Reforms Cut Average Patent Opposition Delays by Two Years, But They Still Take Too Long* (12 June 2017) patentology <<https://blog.patentology.com.au/search?q=patent+office+deadlines>>.
- 40 The UK replaced pre-grant with post-grant opposition with the introduction of the Patents Act, 1977; China in 1992; Japan in 1996; Taiwan in 2004; US in 2011.
- 41 *Patents Act 1977* (UK) c. 37, s. 72.
- 42 A petitioner can argue any ground of invalidity under *United States Code* 35 USC § 282 (except best mode), including novelty, obviousness, statutory subject matter, written description, enablement, and definiteness.
- 43 <<https://dcc.com/patents/patent-opposition-appeals-to-the-federal-court/>>.
- 44 See *Patents Act 1990* (Cth) s.120.
- 45 In the *SNF v BASF* proceeding, there was a total of 30 affidavits adduced in evidence (22 by SNF) from 19 different witnesses (13 from SNF, see endnote below), the cross-examination of 14 lay witnesses and two expert witnesses, and a court book spanning 20 volumes double-sided. This was significantly more, on all fronts, than was before the Patent Office in opposition.
- 46 *SNF (Australia) Pty Limited v BASF Australia Ltd* (2019) 140 IPR 276, 309-12 [221]-[237].
- 47 See orders 2 and 4 of the Orders of 26 October 2016 in Federal Court proceeding No. VID211 of 2016.
- 48 See generally orders dated 9 November 2016, 16 November 2016, 30 November 2016, 7 December 2016, 1 August 2017, 23 August 2017 in Federal Court proceeding No. VID211 of 2016.
- 49 Ian Pascarl and Sian Hope, *Patent Opposition Appeals to the Federal Court* (31 May 2019) Davies Collison Cave <<https://dcc.com/patents/patent-opposition-appeals-to-the-federal-court/>>.
- 50 See item 7 of the Federal Court of Australia's *Central Practice Note: National Court Framework and Case Management (CPN-1)*, issued on 25 October 2016.
- 51 Item 6.22 of the Federal Court of Australia's *Intellectual Property Practice Note (IP-1)*, issued on 25 October 2016.
- 52 Ian Pascarl and Sian Hope, *Patent Opposition Appeals to the Federal Court* (31 May 2019) Davies Collison Cave <<https://dcc.com/patents/patent-opposition-appeals-to-the-federal-court/>>.