



Patents (Filing Documents and Evidence – Opposition) Direction 2017

I, Victor Portelli, Commissioner of Patents, make the following direction under the *Patents Regulations 1991*.

Dated 6 November 2017

Victor Portelli
Commissioner of Patents

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Part 1—Preliminary

1 Name of direction

This direction is the *Patents (Filing Documents and Evidence – Opposition) Direction 2017*.

2 Commencement

This direction commences on 1 January 2018.

3 Authority

This direction is made under the *Patents Regulations 1991*.

4 Revocation

This direction revokes the *Patents (Filing Documents and Evidence-Opposition) Direction 2014*.

5 Definitions

In this direction:

Objective Connect means the electronic document management system known as Objective Connect.

Note: IP Australia provides access to Objective Connect.

Regulations means the *Patents Regulations 1991*.

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Part 2—Form and means for filing documents

6 Form for filing documents—electronic filing using Objective Connect

- (1) For paragraph 5.3(1)(b) of the *Regulations*, this section sets out the form in which a document is to be filed if it is filed electronically using Objective Connect.
- (2) The document is to be in one or more of the following electronic formats:
 - (a) JPEG;
 - (b) MP3;
 - (c) MPEG;
 - (d) PDF;
 - (e) PNG;
 - (f) Text;
 - (g) TIFF;
 - (h) Word;
 - (i) XML.
- (3) The document is to be given a title in the following form:
 - (a) for a statement of grounds and particulars—“Statement of Grounds and Particulars”;
 - (b) for documents mentioned in the statement of grounds and particulars—“SGP mentioned documents”;
 - (c) for evidence in support—“Evidence in support” followed by a brief description of the evidence;
 - (d) for evidence in answer—“Evidence in answer” followed by a brief description of the evidence;
 - (e) for evidence in reply—“Evidence in reply” followed by a brief description of the evidence;
 - (f) for produced evidence—“Produced evidence” followed by a brief description of the evidence;
 - (g) for a summary of submissions for oral hearing—“Summary of oral submissions” followed by a description of the party filing the summary;
 - (h) for Exhibits or Attachments to a declaration—“Evidence in” followed by the relevant stage, and then “Exhibits to the xxx declaration” inserting the name of the person;
 - (i) for covering letters—“Covering letter” followed by a brief description of the relevant stage.

Example 1: For paragraph (c)—Evidence in support—Jones declaration.

Example 2: For paragraph (g)—Summary of oral submissions—requestor.

Example 3: For paragraph (h)—Evidence in support—Exhibits to the Jones declaration.

Example 4: For paragraph (i)—Covering letter—Completion of evidence in support, or Covering letter—Part evidence in support.

- (4) Subject to subsection (5), each electronic file is to contain only one document.

Section 7 Form for filing evidence describing articles other than documents

- (5) For the purposes of subsection (4), the documents mentioned in the statement of grounds and particulars are treated as a single document.
- (6) Subject to subsection (8), the documents mentioned in the statement of grounds and particulars are to be contained in a single electronic file, separate to the statement of grounds and particulars, and each document is to be bookmarked separately in the file.
- (7) Subject to subsection (8), where a document is a declaration including Exhibits or Attachments, the Exhibits or Attachments are to be provided in a single electronic file separate to the rest of the declaration. Each Exhibit or Attachment is to be bookmarked separately in the file.
- (8) If a document exceeds 1 GB in size:
 - (a) it is to be provided in more than one file, with each file not exceeding 1 GB; and
 - (b) the title for each file is to:
 - (i) be in the form mentioned in subsection (3); and
 - (ii) briefly identify which part of the document is contained in the file.

Example 1: Evidence in answer—Jones declaration Part 1 of 2.

Example 2: SGP mentioned documents Part 1 of 3.

7 Form for filing evidence describing articles other than documents

- (1) This section applies to evidence that describes an article other than a document if the article is not being filed.
- (2) For paragraph 5.3(1)(b) of the *Regulations*, the evidence is to be in the form of a declaration that:
 - (a) describes the article; and
 - (b) attaches a photograph or video recording of the article as an exhibit to the declaration.

Note 1: A declaration must be in the approved form: see regulation 22.13 of the *Regulations*.

Note 2: Section 6 sets out additional requirements relating to the form of the evidence if it is a document filed using Objective Connect.

8 Means for filing documents and evidence

Certain documents, and evidence in the form of a document

- (1) For paragraph 5.3(1)(c) of the *Regulations*, a document mentioned in subsection (2), or evidence in the form of a document, is to be filed using:
 - (a) Objective Connect; or
 - (b) if it is not practicable to file the document or evidence using Objective Connect—a means approved in writing, for the document or evidence, by the Commissioner.
- (2) For subsection (1), the documents are the following:
 - (a) a covering letter for evidence;
 - (b) a statement of grounds and particulars;

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- (c) a covering letter for a statement of grounds and particulars;
- (d) a document mentioned in the statement of grounds and particulars;
- (e) a summary of submissions for an oral hearing;
- (f) a covering letter for a summary of submissions for an oral hearing.

Other documents

- (3) For paragraph 5.3(1)(c) of the *Regulations*, any other document may be filed by:
- (a) using the electronic system known as eServices channel maintained by IP Australia; or
 - (b) using the Alternate Lodgement Service maintained by IP Australia; or
 - (c) using IP Australia's emergency facsimile service; or
 - (b) delivering it to the Patent Office either personally or by post.

Note 1: For paragraph (a), the eServices channel could in 2017 be accessed on IP Australia's website (<http://www.ipaustralia.gov.au>).

Note 2: For paragraph (b), the Alternate Lodgement Service is a secondary eServices function accessed on IP Australia's website that can be invoked during outages of eServices.

Note 3: For paragraph (c), the IP Australia's emergency facsimile service may only be used under the conditions set out on IP Australia's website.