



Patents (Means and Form of Filing Documents and Evidence) (Opposition and Other Proceedings) Instrument 2019

I, Frances Roden, Commissioner of Patents, make the following instrument.

Dated 7/1/19

Frances Roden

Frances Roden
Commissioner of Patents

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Part 1—Preliminary

1 Name

This instrument is the *Patents (Means and Form of Filing Documents and Evidence) (Opposition and Other Proceedings) Instrument 2019*.

2 Commencement

- (1) Each provision of this instrument specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.

Commencement information		
Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
1. The whole of this instrument	At the same time as Parts 2 and 3 of Schedule 2 to the <i>Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018</i> . However, the provisions do not commence at all if those parts do not commence.	
Note 1:	This table relates only to the provisions of this instrument as originally made. It will not be amended to deal with any later amendments of this instrument.	
Note 2:	Parts 2 and 3 of Schedule 2 to the <i>Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018</i> commence at the same time as Parts 2 and 3 of Schedule 1 to that Act: see item 6 of the table in subsection 2(1) of that Act. Parts 2 and 3 of Schedule 1 to that Act commence on 24 February 2019, unless proclaimed to commence earlier: see item 3 of the table in subsection 2(1) of that Act, after that Act received the Royal Assent on 24 August 2018.	
Note 3:	On commencement, this instrument will replace the <i>Patents (Filing Documents and Evidence – Opposition) Direction 2017</i> . That Direction will cease to have effect if Part 3 of Schedule 2 to the <i>Intellectual Property Laws Amendment (Productivity Commission Part 1 and Other Measures) Regulations 2018</i> commences. The effect of section 2 of those Regulations is that Part 3 of Schedule 2 to those Regulations commences at the same time as this instrument.	

- (2) Any information in column 3 of the table is not part of this instrument. Information may be inserted in this column, or information in it may be edited, in any published version of this instrument.

3 Authority

This instrument is made under the following provisions of the Act:

- (a) subsection 214A(1), for the purposes of section 214 of the Act; and
- (b) subsection 214B(1); and
- (c) subsection 214C(1).

4 Definitions

In this instrument:

Act means the *Patents Act 1990*.

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*.

Workspace means a common repository where invited parties have access to upload, view and download documents. It is created and managed by IP Australia. Access is only provided to parties that are participating in a specific proceeding. At the completion of the proceeding, the Workspace is closed.

Note: Workspace was previously called Share.

Part 2—Means and form for filing documents and evidence

5 Approved means of filing documents (including evidence in the form of a document)

- (1) A document mentioned in subsection (3), or evidence in the form of a document, that may or must be filed under Chapter 5 of the Regulations, is to be filed with the Patent Office using:
- (a) Objective Connect; or
 - (b) if it is not practicable to file the document or evidence using Objective Connect—a means specified by the Commissioner in writing.

Note: Chapter 5 of the Regulations deals with opposition proceedings in relation to patents.

- (2) A document mentioned in subsection (4), or evidence in the form of a document, that may or must be filed under the Act or the Regulations (other than Chapter 5 of the Regulations), is to be filed with the Patent Office using:
- (a) if the Commissioner has given the person filing the document or evidence notice that a Workspace has been created for the matter in Objective Connect—Objective Connect; or
 - (b) if a notice has not been given under paragraph (a), or a notice has been given but it is not practicable to file the document or evidence using Objective Connect—a means specified by the Commissioner in writing.
- (3) For subsection (1), the documents are the following:
- (a) a statement of grounds and particulars;
 - (b) a document mentioned in a statement of grounds and particulars;
 - (c) a summary of submissions for an oral hearing;
 - (d) a covering letter for a document mentioned in paragraph (a), (b) or (c);
 - (e) a covering letter relating to evidence, where the evidence is filed using Objective Connect.

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- (4) For subsection (2), the documents are the following:
- (a) a summary of submissions for an oral hearing;
 - (b) a covering letter for a document mentioned in paragraph (a);
 - (c) a covering letter relating to evidence, where the evidence is filed using Objective Connect.
- (5) Objective Connect is not an approved means for filing a document, or evidence in the form of a document, that is not specified in subsections (3) or (4).

Note: The means for filing a document other than a document specified in subsections (3) or (4) is set out in the *Patents (Means and Forms of Filing Documents) Instrument 2019*.

6 Form for filing documents—electronic filing using Objective Connect

- (1) This section sets out the form in which a document, other than a document that is required to be in an approved form, is to be filed using Objective Connect.

Note: The *Patents (Formalities Requirements for Patent Documents) Determination 2019* sets out requirements for patent documents that apply in addition to the requirements of this section.

- (2) The document is to be in one or more of the following electronic file formats:
- (a) Portable Document Format (PDF) (.pdf);
 - (b) Text (.txt);
 - (c) Word (.doc, .docx);
 - (d) XML (.xml);
 - (e) TIFF (.tif);
 - (f) PNG (.png);
 - (g) JPEG (.jpeg, .jpg);
 - (h) MP3 (.mp3);
 - (i) MPEG (.mpg, .mpeg).
- (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 a hearing—“Summary of submissions” followed by a description of the party filing the summary;

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- (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 submissions—opponent".

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) Each electronic file is to contain only one evidence document or other document.
- (5) For the purposes of subsection (4), the following are treated as a single document:
 - (a) the documents mentioned in a statement of grounds and particulars;
 - (b) the Exhibits and Attachments to a declaration.
- (6) Subject to subsection (8), all 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 that includes Exhibits or Attachments, those 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 an electronic file 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 1: "SGP mentioned documents Part 1 of 3".

Note: The form for filing a documents other than a document specified in subsections 5(3) or (4) of this instrument is set out in the *Patents (Means and Forms of Filing Documents) Instrument 2019*.

7 Form for filing evidence describing physical articles

- (1) This section applies to evidence that describes a physical article where that article cannot be filed in the form specified in section 6 of this instrument.
- (2) The evidence is to be in the form of a declaration that:
 - (a) describes the article; and
 - (b) includes a photograph or video recording of the article as an exhibit to the declaration.

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- 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.