

**IN THE HIGH COURT OF NEW ZEALAND
WELLINGTON REGISTRY**

CIV-2008-485-002250

UNDER the Patents Act 1953
IN THE MATTER OF New Zealand Patent Application
No 534401
AND
IN THE MATTER OF an appeal from a decision of the Assistant
Commissioner of Patents dated
15 September 2008
BETWEEN STALLION PLASTICS LIMITED
Appellant
AND ROSS GORDON MCINNES
Respondent

Hearing: 20 April 2009

Counsel: P C R Verboeket and O J Dickie for appellant
No appearance for respondent

Judgment: 29 April 2009

RESERVED JUDGMENT OF DOBSON J

[1] This appeal is brought under s 97 Patents Act 1953 (the Act) against an interlocutory decision of an Assistant Commissioner of Patents dated 15 September 2008. That decision arose in the proceedings between the present appellant (the opponent) as an opponent to the present respondent's (the applicant) application for a patent. The application related to a claimed invention for a mobile animal feeder adapted to dispense liquid food such as milk by way of multiple teats.

[2] The interlocutory decision decided two points. The first point related to the appropriate scope of pleading of grounds of opposition in the opponent's statement

of case. The second point dealt with the entitlement of the opponent to have access to documents in the possession of the Intellectual Property Office of New Zealand (IPONZ), as the entity within the Ministry of Economic Development now responsible for administration of the Act is called. The documents relate to antecedent patent applications on which the presently contested application depends for entitlement to ante-dating the priority date for its contested consideration.

[3] It was not drawn to my attention until after the appeal had been called that solicitors on the record for the applicant had advised the Registry on the last working day before the appeal was to be heard that the applicant would not be represented at the hearing. Given the potential for both points to have more general application in the conduct of contested patent proceedings, I invited Mr Verboeket to reconsider the content of his submissions, given that the points would be determined in the absence of a contrary argument. I adjourned the hearing for the morning to enable him to consider a number of matters likely to be relevant to the issues raised by the appeal, and which might reflect more generally on the conduct of proceedings before the Assistant Commissioner. I am grateful to Mr Verboeket for his preparedness to do so, and was assisted by the further matters he put when the appeal was heard on the afternoon of 20 April 2009.

The strike out of references to “common general knowledge” in the opponent’s statement of case

[4] Every application for a patent is subject to preliminary examination and, if it is accepted by the Commissioner, at that point the application is advertised in the *Patent Office Journal*: s 20 of the Act. Within a three-month period after publication in which opposition may be lodged, an opponent may give notice of its opposition to the grant of patent: s 21. The taking of that step is provided for in reg 48(1) of the Patent Regulations 1954. That prescribes:

- 48** (1) A notice of opposition to the grant of a patent—
- (a) Shall be given in form 15;
 - (b) Shall state the ground or grounds on which the opponent intends to oppose the grant; and

- (c) Shall be accompanied by a copy thereof and a statement (in duplicate) setting out fully the nature of the opponent's interest, the facts upon which he relies, and the relief which he seeks.

[5] Within two months of being served with a notice of opposition and statement of case, an applicant is required to file a counterstatement setting out fully the grounds upon which the opposition is contested. After that step had been taken on behalf of the applicant in the present case in February 2008, the applicant's attorneys requested that various paragraphs in the statement of case be struck out.

[6] The grounds for opposing the grant of a patent are specified exhaustively in s 21 of the Act, and such grounds are explicitly confined to those specified in s 21(1) and no others. In the present case, the opponent specified in its statement of case four of the statutory grounds recognised in s 21(1) of the Act, namely:

- prior publication;
- prior use;
- that the claimed invention was obvious and lacking in inventive step; and
- that the application described something that was not an invention.

[7] In pleading the third ground of opposition (that the application was obvious and lacking any inventive step), the opponent first pleaded 10 particulars alleged to have been common general knowledge at the priority date, in the following terms:

5.1.1 THAT animal feeders with wheeled trailer bases were available;

5.1.2 THAT animal feeders could include a large tank with an outlet feeding into a manifold;

5.1.3 THAT such an outlet could be a closable outlet;

5.1.4 THAT animal feeders could have a manifold feeding into a plurality of feeding teats;

5.1.5 THAT such manifolds could be open manifolds;

5.1.6 THAT animal feeders could include levelling mechanisms;

5.1.7 THAT such levelling mechanisms could include an adjustment means having an adjustable length;

5.1.8 THAT such adjustment means could be arranged between a trailer base and a support part of the liquid-carrying part of the feeder;

5.1.9 THAT animal feeders with manifolds and trailer bases could include a space in the manifold over the drawbar; and

5.1.10 THAT animal feeders could include a number of teats projecting outwardly from orifices.

[8] Thereafter, further detail of the matters that would be relied on in support of the third ground of opposition made further references to what constituted common general knowledge, such as by reference to what had been published in New Zealand in specified sources, and that a range of these specific sources in combination with common general knowledge rendered the claimed invention to be obvious.

[9] Argument on a challenge to the grant of a patent on the ground of obviousness is conventionally assessed through the eyes of a skilled reader, deemed to be imbued with the “common general knowledge” in the relevant field in which the claimed invention arises. A common formulation of this approach is that reflected in *Windsurfer International Inc v Tabur Marine* [1985] RPC 59 (CA) per Oliver LJ:

The Court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and impute to him what was, at that date, common general knowledge in the art in question.
(79)

[10] The Assistant Commissioner upheld the applicant’s objection to all these references to common general knowledge, and ordered that all of those references be struck out of the statement of case. The first aspect of the appeal is to challenge that ruling, seeking the reinstatement in the statement of case of the references to common general knowledge.

[11] On two occasions, the Hearings Office of IPONZ had rejected requests on behalf of the applicant to make these deletions, and had confirmed that the opponent’s pleadings did not need to be amended in any way. That stance appears to have depended in part on the opponent’s unqualified acknowledgement that it was

not seeking to assert common general knowledge as a ground of opposition in its own right. Instead, it was cited to reflect the state of knowledge of the skilled addressee, providing a contextual framework within which the claims were to be assessed against prior use and prior publication material to determine if what was claimed was indeed obvious.

[12] Notwithstanding that approach to the extent of reliance on the references to common general knowledge, the Assistant Commissioner conducted a hearing at the applicant's request. In part, the argument focused on the relevance of a decision of the Assistant Comptroller under the Patents Act 1949 (UK), reported as *Benz Ld.'s & Another's Application for a Patent* [1958] RPC 78. In that case, the opponents had cited in their notice of opposition that the opponents "also relied...on common general knowledge". I agree with Mr Verboeket that the tenor of the Assistant Comptroller's decision treats the reference to common general knowledge in the notice of opposition as if it were setting it up as an additional ground for opposition. Its potential relevance to other grounds of opposition were said not to:

...justify a reference in the notice to common general knowledge as an apparent ground of opposition. It would, I think, be quite wrong to try to introduce common general knowledge as an independent element of a mosaic to be used in argument that an invention is obvious. (79)

[13] In the present case, the Assistant Commissioner treated the latter sentence quoted above from the decision in *Benz* as denying the prospect that the reference to common general knowledge could be set up as an independent ground of opposition. That appears to ignore the prospect of it being a contextual aid to other, statutorily recognised, grounds of opposition. Considering the short judgment in *Benz* overall, I treat it as requiring the striking out from the notice of opposition of references to common general knowledge because of a concern that it was indeed being set up as an apparent ground of opposition, intended to stand on its own.

[14] The Assistant Commissioner saw nothing in the distinction between the references in the *Benz* case being in the notice of opposition, whereas in the present case they are in the statement of case. However, as a matter of pleading, the notice of opposition sets out only the grounds, whereas reg 48 requires that the statement of case should set out fully the facts upon which the opponent relies.

[15] The requirements of reg 48 suggest that the statement of case is to serve as a pleading, fairly informing the applicant of the detail of the grounds of opposition that are to be argued. Ironically, the *Benz* decision itself recognises, when considering a separate concern of the applicant in that case, that the statement of case should fully and fairly inform the applicant of the case it has to meet, in order to enable it to prepare its counterstatement and then its response.

[16] Certainly, if the present issue arose in the context of adequacy of pleadings in High Court proceedings, an applicant is likely to have good grounds for complaining of the inadequacy of a statement of case that failed to specify the respects in which common general knowledge would be called in aid of the statutory ground of obviousness.

[17] Making every allowance for the appropriateness of the Assistant Commissioner regulating his own procedure, a fair and adequate process ought nonetheless to provide for adequate warning of the opposing cases, to enable orderly preparation of the evidence on relevant issues. Here, the Assistant Commissioner was inclined to treat the matters of common general knowledge that might become an issue solely as matters of evidence, best left until the opponent's evidence was prepared and served on the applicant. Pleadings should not be allowed to become prolix, or stray into the provision of evidence. However, the extent of references to common general knowledge in the statement of case that have been struck out clearly falls short of pleading matters of evidence. It is a matter of pleading, in foreshadowing the nature and extent of common general knowledge upon which the opponent intends to rely.

[18] Even if the basis on which I have rationalised the approach in the *Benz* case is not correct, Mr Verboeket invited me to recognise that the approach to pleading in statements of case and counterstatements has evolved since the late 1950s, consistently with the approach generally in litigation that “trial by ambush ... has long gone out of fashion” (see Eichelbaum CJ in *Donovan v Graham* HC AK CP1908/89 22 May 1990, (4)).

[19] An example of the contemporary approach to the scope of pleadings was cited from the decision in *Ratiopharm v Napp* [2008] EWHC 3070 (Pat) per Floyd J:

[154] [...] I consider that the time has come when the matter which is said to be common general knowledge ought to receive some more formal exposition in advance of the expert evidence stage. Apart from anything else, the *Pozzoli* approach, which depends on identifying a difference between matter alleged to form part of the state of the art and the inventive concept, cannot begin to be applied without adequate particularisation of the starting point.

[20] That is certainly consistent with at least allowing (if not requiring) some outline of the way in which common general knowledge will be called in aid, as was pleaded by the opponent in the present case.

[21] A further reason for expecting the statement of case and counterstatement to represent full pleadings is against the contingency that, for whatever reason, the opponent might not ultimately contest the grant of the patent. The task of IPONZ is always to assess the entitlement to a grant from the standpoint of the public interest, rather than in a narrower inter partes sense between the applicant and any opponents. Undertaking the assessment where an opponent does not appear is likely to be improved by a statement of case that pleads fully the grounds of opposition, and the factual matters to be relied on in support of those grounds.

[22] The Assistant Commissioner's reasoning included the following observations:

However, the common general knowledge is to be determined by the evidence of experts, so its appearance at the stage of the statement of case is premature. Also, what is the common general knowledge has not been established at the stage when the statement of case is filed. Thus, statements of what is the common general knowledge must be left to the evidence stage.

[23] With great respect, that approach misconceives the purpose of pleadings. If an opponent's argument on any one or more grounds of opposition is intended to be supported by reference to common general knowledge, then as a matter of pleading the opponent should commit to an outline of the respects in which common general knowledge will be claimed to be relevant, and the applicant is entitled to know that in considering its response. As with all factual allegations in pleadings, the assertion of what constitutes the common general knowledge at a particular point in respect of

a particular device does not give that assertion any status as being the truthful or unquestionable state of the relevant knowledge: rather, it is the opponent's contention of what the Assistant Commissioner will find, on evidence to be adduced, to be the state of knowledge. It is useful for it to be signalled as a matter of pleading to enable the applicant to consider the strength of evidence available to challenge that assertion.

[24] Reflecting in this way on the purpose of pleadings, I see every reason for inclusion of the references to common general knowledge, and no countervailing justification for their being excluded.

[25] I accordingly allow this first aspect of the appeal, and direct that the opponent's statement of case is to be reinstated in its original form.

Access to documents

[26] The priority date from which the applicant claims proprietary rights in the invention will often be highly material to the relative strength of grounds of opposition such as prior use or prior publication. The earlier the point in time that an applicant for a patent can justify as the priority date, the greater the extent that other publications or other use can be excluded. A relevant procedure that applies in the present case is to treat a subsequent application for a patent as a division of an earlier application. To qualify for this 'divisional' status, the terms of a subsequent application must be identical to those of the earlier application to which the applicant seeks to link it. Mr Verboeket described a practice by which practitioners in the patent area refer to such successive patent applications in generational terms. Hence in the present case, the opposed application (No 534401) was filed on 30 July 2004, treating as 'the parent application' the immediate predecessor No 523891 filed on 30 January 2003. In turn, the parent application was filed by the applicant as a divisional from No 506087 (the "grandparent" application) originally filed on 1 August 2000 accompanied by a provisional specification and then followed up with the complete specification filed on 1 or 2 August 2001.

[27] Neither the grandparent nor the parent applications progressed to the stage of being accepted for publication, with the opposed application being the first to be published after acceptance on 31 August 2007. IPONZ had accepted the applicant's proposal that it be treated as a divisional of the parent, with the parent being treated as a divisional of the grandparent application, thereby entitling the present opposed application to be ante-dated back to 1 August 2000 as the priority date.

[28] In the case of a 'first generation' patent application, the justification for the priority date allocated to it on its publication will be apparent from the details published at the time, as both a provisional specification and the complete specification will be publicised. In contrast, in the present case, IPONZ has published only the opposed application, providing no details of the parent and grandparent applications in Nos 523891 and 506087. Potential opponents can reconstruct the timing of filings in respect of the parent and grandparent applications, but cannot undertake any analysis to verify for themselves whether IPONZ has correctly relied on grounds for the extent of backdating accepted when the current application is finally published.

[29] Mr Verboeket identified three possible alternatives for the priority date to be allocated to No 534401, each depending on a somewhat lesser degree of compliance with the strict time limits that would have applied to steps taken by the applicant to progress the respective applications.

[30] One example of a potential issue that Mr Verboeket could point to on the details of the patents that are available on the IPONZ database shows, in respect of No 506087, that the complete specification was filed on 2 August 2001. However, (so Mr Verboeket informed me) after enquiry on behalf of the opponent in November 2007 IPONZ amended the date from 2 August to 1 August 2001. That change is of material importance, as a filing completed on 2 August 2001 would be more than a year after the provisional filing of the original patent on 1 August 2001, which would lose it the benefit of the earlier as the priority date.

[31] Since the published details did not enable the opponent's advisers to analyse the justification for the extent of ante-dating, they pursued access to the documents

filed with IPONZ that would enable them to do so. Initially, the opponent's attorneys wrote to the applicant's attorneys asking that the applicant authorise the release of the various documents sought. After exchanges of correspondence in March 2008, the opponent's attorneys wrote to the Hearings Office of IPONZ on 16 May 2008 seeking release of the documents from IPONZ records. That was opposed by the applicant's attorneys, leading eventually to argument on the entitlement of the opponent to have access to these documents at the same hearing in August 2008 as dealt with the pleading issue.

[32] The request for copies of the documents was advanced on the basis that IPONZ is subject to the Official Information Act 1982, that IPONZ as a part of the Ministry of Economic Development is subject to that Act, and that the information held by it constituted official information for the purposes of the Official Information Act. It appears to have been accepted by the Assistant Commissioner that the opponent would be entitled to access to the documents requested, unless there was a specific restriction on disclosure in the Act. The Assistant Commissioner's reasoning also analysed the possible utility for the opponent, where the apparent purpose in seeking the documents was to challenge the decision of IPONZ on the priority date allocated to the opposed application.

[33] On this discovery issue, the Assistant Commissioner accepted the argument for the applicant to the effect that the opponent could not challenge the priority date allocated as an aspect of its argument on opposition to the application. The Assistant Commissioner treated the decision to accord divisional status to an application, and the consequent backdating of the priority date, as the exercise of a discretion that an opponent who later appears cannot question. It appears that that approach reflects adoption of a narrow argument advanced on behalf of the applicant, to the effect that challenge to the priority date allocated on acceptance of an application is not a ground for opposition to registration of a patent under s 21 of the Act. Accordingly, challenge to the priority date can not be relevantly argued in opposition proceedings, and the documents that might be sought to challenge the allocation of the priority date are therefore irrelevant to any valid grounds of opposition.

[34] With respect, that is an incorrect approach to the scope of grounds of opposition. In circumstances such as the present, an opponent seeking to challenge the priority date allocated by IPONZ is not doing so as a ground of opposition. Rather, it is a contextual fact that is extremely important to the strength of arguments open to the opponent on some, at least, of the statutory grounds of opposition recognised in s 21. The present circumstances are a good example of how the strength of arguments on prior use and prior publication are influenced fundamentally by the priority date from which those matters are measured.

[35] The purpose of opposition proceedings includes the appropriate testing of the entitlement to the statutory monopoly that registration of a patent ultimately affords. It is in the public interest that that testing be undertaken on a fully informed basis, to ensure that a full contest precedes the decision to recognise the statutory entitlements that follow. With respect to the expertise of those involved at IPONZ, I disagree with the notion that opponents must in all circumstances run their opposition on terms inevitably accepting the correctness of the priority date nominated by IPONZ before an application is subjected to analysis and criticism by opponents. This deprives the process of the appropriate rigour and affords applicants the opportunity for unintended advantage, where they may be able to take advantage of an error in the view adopted as to the appropriate priority date.

[36] Accordingly, I do not see that lack of relevance of these documents to an opponent constitutes a ground for resisting their disclosure.

[37] The second aspect of the Assistant Commissioner's reasoning was that the provisions of s 91 of the Act restrict publication of applications and specifications in terms that preclude the disclosure of the applications and any specifications for the parent and grandparent applications. Section 91(1) of the Act provides:

91 Restriction upon publication of specifications, etc

- (1) An application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Commissioner or be open to public inspection at any time before the date advertised in the *Journal* in pursuance of subsection (2) of section 20 of this Act:

Provided that nothing in this subsection shall preclude the Commissioner from publishing the date and number of an application and such details of the application and invention as are required to be given in the application form.

[38] The operation of that section needs to be considered in light of the positive obligation to advertise in s 20(2). That section provides:

20 Acceptance and publication of complete specification

...

- (2) On the acceptance of a complete specification the Commissioner shall give notice to the applicant, and shall advertise in the Journal the fact that the specification has been accepted, and thereupon the application and the specification or specifications filed in pursuance thereof shall be open to public inspection.

[39] The Assistant Commissioner reasoned that the documents of the parent and grandparent applications were not to be considered as part of the accepted application, but rather they were documents relating to separate applications. On that basis, publication or disclosure of them was not authorised by the terms of s 20(2), and they remain restricted from publication because, dealing with each of the parent and grandparent applications in their own terms, they had not yet reached the stage where the restriction on publication under s 91 had come to an end.

[40] Mr Verboeket submitted that the essence of his challenge to this reasoning depended on the proper scope to be attributed to the phrase “the specification or specifications filed in pursuance thereof...” in s 20(2) of the Act. He argued that in the context, all specifications that had been filed “to pursue” the present application were to be open for public inspection. In the context of the procedures under the Act, as they applied to divisional applications, he argued that acceptance of an application for the purpose of publication included the details in the specifications on which all relevant details, including the priority date, depended. In circumstances where the priority date depends on prior (parent/grandparent) applications, then the opposed application is being pursued in reliance also on those earlier specifications because it is only by virtue of them that the important matter of priority date is attained.

[41] Although not expressed in these terms, the Assistant Commissioner's rejoinder to this argument would be that the specifications filed for the parent and grandparent applications were filed just for that purpose, and not in anticipation of their being relied on in pursuance of a subsequent divisional application.

[42] As I have previously recognised, the consequence of the Assistant Commissioner's approach to the scope of documents filed "in pursuit" of the present application is that less is publicised in relation to a divisional application than is the case for an original application. Potential opponents are not in the same position. For an original application, the basis of attribution of the priority date is clear from the terms of the provisional and complete specifications. In contrast, for a divisional application, the Assistant Commissioner's approach would prevent access to the documents establishing the chain of entitlement back to whatever priority date has been accepted by IPONZ. Conceptually at least, that leads to the undesirable notion of applicants attempting to 'bury the trail' by which they seek to refer back to the earliest possible date, by insisting that there not be publication of the antecedent applications, the existence of which is critical to an entitlement to an earlier priority date than that which would be achieved if the currently opposed application had to stand on its own. That is an undesirable inconsistency.

[43] A broader reading of the scope of what will be the specifications filed "in pursuance" of a particular application draws some support from the terms of some of the provisions in the sections preceding s 91. The prospect that errors will occur in the Register, in any patent or any other document issued under the Act, is reflected in s 88 of the Act. That gives the Commissioner the power to correct any mistake and for that purpose to require the production of the patent or other document. The process for correction of error recognises the entitlement of persons who appear to the Commissioner to be concerned in respect of any correction to be afforded the opportunity to be heard. Any such opportunity to be heard is not a meaningful one unless those interested are armed with adequate information to make submissions on the need for, and terms of, any correction.

[44] More broadly, the preceding s 87 creates a power for the Court on the application of any person aggrieved to order the Register of Patents to be rectified,

inter alia by varying the terms of entries in the Register. The prospect of action under that section is not necessarily analogous to the scope of proceedings to oppose the registration of a patent, particularly in light of the somewhat broader grounds for revocation of a patent under s 41 compared with the grounds available under s 21 to oppose initial registration. There is nonetheless a measure of support for the notion that, once an application is advertised, those interested ought to be entitled to access to all information bearing on the validity of all aspects of the rights proposed to be created, if registration were to ensue.

[45] Section 90 of the Act creates a form of presumption of entitlement to access to information held by IPONZ that relates to any patent or application for patent. Section 91 then operates as a partial restriction on that principle of entitlement to access to information. Mr Verboeket did not address any particular rationale for the restriction. However, given the scheme of the Act and the nature of the statutory monopoly sought, it is entirely justifiable that applicants for patents should be entitled to strict confidentiality of their communications with IPONZ, until the application has been accepted. If an inventor elects to, in effect, subsume an earlier application in a later one, then the residual advantage from the earlier filing, namely the prospect of an earlier priority date must surely be balanced by the recognition that, once the later application is accepted and published, its ‘origins’ equally become available for public consideration.

[46] In the group of sections shortly after s 91, under the heading “Proceedings before Commissioner”, s 96(2) gives the Commissioner powers to administer oaths to any witness, to require the attendance of any witness and discovery and production of documents. This is consistent with an expectation that all proceedings before the Commissioner will be on a fully informed basis, with any interested parties not being inhibited by an inability to access potentially relevant documents.

[47] Going beyond the Act itself, reg 129(e) of the Patent Regulations 1954 tends to confirm that s 91(1) is an exception to the general proposition of public availability of records held by IPONZ. That regulation provides:

129 There shall be open for inspection without fee at any convenient time,

...

- (e) Except as otherwise provided in the Act or these regulations, all applications, specifications, drawings, requests, notices, and other documents filed, made, or given under the Act or these regulations in respect of any patent, any application for patent, or in any proceedings relating to any such matters.

[48] In circumstances such as the present, it is difficult to conceive any material prejudice to an applicant for a patent arising from publication of the parent and grandparent applications on which a divisional application depends for backdating of the priority date. The entitlement to reach back in that way depends on the subsequent applications being in the same terms as the preceding ones. The practice on this was confirmed in Patent Office Practice Note No 8, which appears to date from November 1974 and presently appears in a collation of Practice Notes published in April 2003. That included the following:

Divisional applications and specifications

...

If it is desired to have the divisional application ante-dated to the date of the parent application which was accompanied by a provisional specification, it is necessary to file a *provisional specification* with the divisional application, and the application form should incorporate a request under reg 23 for ante-dating of the application and the provisional specification. The provisional specification accompanying the divisional application should be identical to the provisional specification which was filed with the parent application.

[49] It follows that, if indeed the latest application being pursued is entitled to the ante-dating contemplated, the contents of the prior applications will not reveal anything that is not inevitably publicised on publication of the current application currently being pursued.

[50] The Assistant Commissioner took the view that the preceding applications had become “void”. However, they do have ongoing relevance for the important issue of entitling an applicant to an extent of ante-dating. Once their relevance for that purpose is acknowledged, it is inconsistent to dismiss them as “void” for the purpose of rendering them irrelevant.

[51] The Assistant Commissioner considered refusal to give access to the preceding applications was consistent with a decision of the United Kingdom Patent Appeal Tribunal that was not the subject of argument before him, but had otherwise been drawn to his attention. The decision was *Formulast Corporation's Patent* [1965] FSR 153. That involved an appeal from a decision of the Assistant Comptroller in which he had refused to allow an opponent to proceed with an objection on the ground that the applicants for the patent had obtained at least part of the invention from that opponent. In chronological terms, the applicants had filed a first application in September 1959, and then a further application in January 1963 as a divisional from the 1959 filing, with a request that the date of the earlier specification should be accorded to the divisional. IPONZ had approved the claim to the earlier date. When the opponent raised dealings between the parties in 1961 as grounds for the claim that the applicants had obtained at least part of the invention from him, this was challenged as not affording any proper basis for the allegation of obtaining. It was in this context that Lloyd-Jacob J observed:

It would of course be open to the applicants to prove that they were in possession of the opponent's invention before the communication alleged. The decision under appeal in part decides that the ante-dating already permitted to the applicants removes such entitlement. (154)

[52] The passage immediately following those observations was quoted and relied on by the Assistant Commissioner in the present case. It continued:

It states, quite accurately, that as the cases at present stand opposition proceedings cannot be used to question the attribution by the Comptroller General of a notional date of filing. It further states, again no doubt quite rightly, that the Comptroller General would not have acceded to the request for ante-dating had he not been satisfied that the whole of the matter included in the divisional application was included in the original specification at its date of filing in September, 1959, and, although the decision concedes that the Comptroller General may, at any time before grant, reopen this attribution of date with the applicants, it quite firmly refuses to permit the opponent to introduce this topic into the opposition.

[53] However, that was not the end of the material reasoning in the case. The appeal reversed the Assistant Comptroller's decision, thereby permitting the opponent to argue as an aspect of its opposition that at least part of the invention had been obtained from the opponent, notwithstanding the apparent chronological difficulties introduced by the ante-dating of the divisional application back to the

date of the earlier specification. The Judge reasoned that an allegation of the invention having been obtained from the opponent should be determined on its merits, irrespective of an apparent inconsistency in timing between the date of the original specification and the date of the alleged communication between the opponent and the applicants. It was not for the opponent to concern himself with matters of ante-dating and the Judge considered the Assistant Comptroller had gone further than was warranted in taking the view that anything which occurs after the date attributed to the filing of the specification was inevitably irrelevant to an allegation of obtaining.

[54] The essence of the *Formulast* decision is that the allegation of obtaining as a result of communications after the date attributed to the filing of the specification was not to be treated as a stand-alone challenge to the correctness of the date attributed by IPONZ. Rather, the allegation of obtaining was to be dealt with on its merits on the basis of contested evidence. If the allegation was made out, then it might confront IPONZ with further information requiring it to reconsider the appropriateness of the date that had been attributed. The Judge observed:

If, as is conceded, the decision to ante-date is not necessarily binding as between the applicants and the Comptroller General whilst the specification is still in the application stage, it would be an odd result if it were to exclude a statutory right to an opponent. (155)

[55] Once considered in these terms, the observations from the *Formulast* decision relied on by the Assistant Commissioner do not prevent the opponent in the present circumstances advancing, as part of the argument on the specific grounds of opposition under s 21 that have been relied on, matters bearing on the correctness of the priority date approved for the specification, as publicised.

[56] Accordingly, I find that the Assistant Commissioner erred as a matter of law in coming to the conclusion that IPONZ was constrained by the terms of s 91(1) or otherwise, from including within the material able to be disclosed, once No 534401 was advertised, the comparable documents in respect of preceding application Nos 506087 and 523891.

[57] I note that, since the issue was first raised, the opponent has refined somewhat the scope of the documents which it would specifically request. I record that the documents it seeks, and to which it is entitled, are as follows:

- a) Date stamped copies of Patents Form 1 filed in respect of each of NZ Patent Application Nos 506087, 523891 and 534401;
- b) Date stamped copies of the provisional specifications filed in respect of each of NZ Patent Application Nos 506087, 523891 and 534401;
- c) Date stamped copies of the complete specifications filed in respect of each of NZ Patent Application Nos 506087, 523891 and 534401;
- d) Date stamped copies of Patents Form 7 filed in respect of each of NZ Patent Application Nos 506087, 523891 and 534401, if any; and
- e) Date stamped copies of Patents Form 13 filed in respect of each of NZ Patent Application Nos 506087, 523891 and 534401, if any.

Costs

[58] The opponent has prevailed in both aspects of the appeal. It is entitled to costs on a 2B basis.

Dobson J

Solicitors:
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