



17 April 2020

Opposition Correspondence

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Australia

Your reference	535 Opp LAA
Application number	2017210650
Applicant name	LAA Industries Pty Ltd
Opponent	Allied Pumps Pty Ltd, Taranis Power Group Pty Ltd & Stephen Anderson

Dear Sir/Madam,

I refer to the Applicant's request for an extension of time ("EOT") of three months to file evidence in answer ("EIA") for each of the three oppositions under s59 of the Act filed with regard to this application (collectively the "oppositions"), the extension of time requests being filed on 25, 27 and 28 February 2020. I note that although it was necessary to file three separate EOTs, one for each opposition, the information in support of each extension is identical, as is the period requested for the extension, from 2 March 2020 to 2 June 2020. Consequently, for convenience each EOT request is dealt with collectively in this letter and will simply be referred to as the "EOT".

I also refer to the further information provided by the Applicant in support of the EOT filed on 25 March 2020. This further information comprises declarations by Mark Keogh dated 25 March 2020 ("Keogh2"), James Waterreus dated 25 March 2020 ("Waterreus2") and Fidel Dela Paz dated 25 March 2020 ("Dela Paz2"). The declarations were also accompanied by a variety of exhibits that I will also refer to where appropriate.

Mr Keogh, Mr Waterreus and Mr Dela Paz previously provided declarations in support of the EOT, these all being dated 25 February 2020. I shall refer to these as "Keogh1", "Waterreus1" and "Dela Paz1". These were also accompanied by a variety of exhibits that I will also refer to where appropriate.

In order to grant an extension under Reg 5.9(2) the Commissioner must be satisfied that the applicant for the extension has (a) made all reasonable efforts to comply with all relevant filing requirements and, despite acting promptly and diligently at all times to ensure the appropriate evidence is filed within the period, is unable to do so or (b) there are exceptional circumstances that warrant the extension. While the information filed in support of the request does not appear to relate to an exceptional circumstance, I note that Mr Keogh and Mr Dela Paz have referred to there being exceptional circumstances, so I will consider whether this criteria is met in addition to that under Reg 5.9(2)(a).

To justify an extension of time pursuant to reg 5.9(2)(a) it is necessary for a party to provide sufficient detail for the Commissioner to form a view as to the whether a party has made all reasonable efforts

to comply with all relevant filing requirements under chapter 5 of the Regulations and of the promptness and diligence of that party at all times to ensure that the that the appropriate evidence was filed. An opinion as to the reasonableness, promptness and diligence of a party can be formed based on an explanation of what the party has done, when it was done and how long it took, with an explanation of any significant delays. An understanding of the overall strategy for evidence preparation is also of assistance.

Despite the further information provided, I still do not consider it appropriate to provide the requested extension for reasons I will discuss further below.

On considering the further information provided, several issues come to mind that suggest that the Applicant's actions or inactions regarding the EIA are not commensurate with being reasonable or prompt and diligent as understood pursuant to Reg 5.9(2)(a).

Firstly, although the Applicant could not predict with any precision the nature of the oppositions when these were filed on 28 May 2019, it remains the case that it knew from this point that it was facing three oppositions and would need to respond to three sets of evidence in support ("EIS"). Further with the filing of the statements of grounds and particulars ("SGPs") on 28 August 2019, the Applicant would have gleaned some idea of what sort of EIA it would need to compile, including the necessity for expert evidence. From this point the Applicant could reasonably anticipate that the time to file EIA would commence on or about the 1 December 2019. It is also reasonable to believe that the Applicant knew or should have known about the time constraints and responsibilities (for example leave, business trips etc, other work commitments, court actions, oppositions) accruing to Mr Keogh and Mr Waterreus within the likely period to file EIA. Despite all this there is no indication as to what the Applicant did to mitigate the known constraints on Mr Waterreus's and Mr Keogh's time so as to allow for them to be able to file the evidence on time, or what other further action it took to ensure that the EIA could be filed in time.

The only apparent action taken to mitigate the time constraints appears to be the investigation of two potentially alternative experts in January 2020. These experts were either not available or would not be able to complete the evidence on time see Keogh2 at [14]. However, Mr Keogh does not state when exactly in January these experts were contacted, nor why he waited until January to contact alternative experts when the time to file EOT began on 2 December 2019 and in view of the apparently known difficulties as discussed above.

Not taking into account delays or difficulties in obtaining evidence that could have been anticipated and acted upon is not commensurate with being reasonable or prompt and diligent.

Secondly, while the Applicant has provided an extensive timeline of availability, including when Mr Keogh and Mr Waterreus worked on the EIA, there is very little information as to what they were actually doing with regard to the EIA. There is virtually no information as to what Mr Keogh was doing with regard to the EIA, while there is very little information provided on Mr Waterreus's activities. In this regard Mr Waterreus indicates that he reviewed the documents from the SGPs on 29 August 2019 and that he made some notes on the same (Waterreus2 at [2] to [6]). Mr Waterreus then indicates (at [7] of Waterreus2) that he started to prepare declarations in answer to the SGPs on 2 December 2019. However, these facts are as far as the information goes. It would be helpful to understand how far Mr Waterreus and Mr Keogh got with their evidence and when. The absence of more detailed information as to what was actually done and when it was done makes it difficult for me conclude (beyond the other issues raised in this letter) that the Applicant has acted reasonably, promptly and diligently at all times in compiling the EIA.

I also note that, while it is not necessarily determinative, there are some discrepancies between Waterreus2 and the Schedule Timeline. For example, the Schedule Timeline indicates that Mr Waterreus was not available for EIA work on 2 December 2019 while [7] of Waterreus2 seems to be to the contrary. Mr Waterreus also suggests that he had only 15 days to review the SGPs and the EIS (Waterreus2 at [13]) while the notes at the bottom of the Schedule Timeline indicates that Mr Waterreus had 20 days to work on the EIA, while counting the days Mr Waterreus actually worked on the EIA from the Schedule Timeline amounts to 21 days. As stated, these discrepancies are not determinative, however they do make it rather more difficult to understand what has actually happened thereby complicating any assessment of the reasonableness and promptness and diligence of the Applicant's actions.

Thirdly it is not clear to me why Mr Waterreus and Mr Keogh were apparently spending quite significant amounts of time on preparation for the hearing on 2017213531 which could have been used to compile EIA. The evidentiary stages for 2017213531 had finished in April 2019. Preparation for the hearing per se would normally be largely undertaken by the Applicant's legal representatives, not by the Applicant or the Applicant's witnesses. On the face of it the investment of this time by Mr Waterreus and Mr Keogh instead of compiling the EIA is not reasonable, especially in view of the time constraints Mr Waterreus and Mr Keogh were subject to as discussed above.

Finally, after considering the material that has been (or would be if the EOT was granted) as EIA, it is not clear to me why Mr Waterreus was providing detailed evidence in response to the SGPs. All of the Opponents had filed EIS, and EIA is, by definition, in answer to the EIS. In this respect I note that Reg 5.8(2) reads as follows:

"If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the evidence in support within 3 months from the day the Commissioner:

(a) gives the applicant:

(i) all the evidence in support; or

(ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and

(b) notifies the applicant that all the evidence in support has been filed."

While Reg 5.8(3) refers to EIA to the SGP, that is clearly only countenanced for situations where an Opponent does not file any EIS.

Hence it does not appear to be reasonable for the Applicant to devote significant resources to answering the SGPs where EIS has in fact been filed. This is even more apparent when the constraints on Mr Waterreus's time, as discussed above, are taken into account.

It follows from the above that I do not consider that the Applicant's EOT request meets the requirements of Reg 5.9(2)(a).

This leaves me to consider whether there are exceptional circumstances that warrant an extension pursuant to Reg 5.9(2)(b).

Regulation 5.9(5) provides an inclusive definition of what is meant by "exceptional circumstances"

- “(a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Chapter;
- (b) an error or omission by the Commissioner that prevents a party from complying with a filing requirement under this Chapter;
- (c) an order of a court, or a direction by the Commissioner, that the opposition be stayed pending the completion of a related proceeding or action under the Act.”

While there is little further guidance given in the Regulations about the nature of what might comprise “exceptional circumstances”, some guidance on the nature of an exceptional circumstance was given in *TRED Design Pty Ltd v Julie-Anne McCarthy and Bradley McCarthy* [2013] APO 57 (“**TRED**”) at [64]:

“The matters that are specified as exceptional circumstances are circumstances beyond the control of a party, an error or omission by the Commissioner, an order of a court and directions by the Commissioner. These matters give some guide to the other situations that would be regarded as exceptional circumstances: matters outside the normal evidentiary process, and outside the control of the party, where it would be unreasonable to insist on a party filing their evidence. This is consistent with the explanation in the [Statement](#) that the loss of an expert is not an exceptional circumstance.”

More recently the nature of an “exceptional circumstance” was also considered in *UON Pty Ltd v Taranis Power Group Pty Ltd* [2019] APO 6 (“**UON**”) at [26]:

“While the regulations do not provide further guidance on or examples of what could be considered to be ‘circumstance beyond the control of a party’, the [Statement](#) notes that “if a preferred expert becomes suddenly unavailable **but other experts could be called on to complete the evidence in time**, then the sudden loss of the preferred expert is not an exceptional circumstance” and “Commissioner will not be required to give a direction to extend a period solely because of delays caused ... by **difficulties in obtaining expert evidence that could have been anticipated and acted on...**” (my emphasis)”

The Applicant’s basis for claiming exceptional circumstances primarily resides in the fact that it faces three oppositions at once. This is apparent in *Keogh2* at [18], *Waterreus2* at [20] and *Dela Paz2* at [12]:

“This is an inclusive definition and not an exhaustive definition. We submit having a substantial number of multiple concurrent opponents falls under “exceptional circumstances”. This is a circumstance which is beyond the control of the applicant, the number and volume of the EIS filed which the applicant has to review and answer individually in a limited time period usually allocated to a single opponent prevents the applicant from complying with the filing of the EIA within the time period. The Delegate is requested to review the Declarations filed as EIS for the three Oppositions which will show the volume and length of the documents to be reviewed, prepared for and answered.”

While I agree with the Applicant that the definition of “exceptional circumstances” as given in Reg 5.9(5) is by no means exhaustive, I am not convinced that exceptional circumstances apply to the present matter. In line with discussion from *TRED* and *UON*, both of which refer to the explanatory memorandum (or statement) I consider that the notion of “exceptional circumstances” as understood under Reg 5.9 is commensurate with circumstances which deprive a party of agency, in terms of compiling their evidence, to such a degree that they are simply unable to file the evidence on time or it would be unreasonable to expect them to do so.

I do not consider that that is the case here. While the Applicant clearly has no control over there being three concurrent oppositions to its application, it clearly does have control over what it could do to ensure that it could file its evidence on time once appraised of this fact on 28 May 2019, would have a further understanding of what it would need to do after filing of the SGPs on 28 August 2019 and would clearly have understood the nature of the task before it on receipt of the EIS on 2 December 2019. Hence, while having three oppositions at once would clearly present difficulties, it is clearly within the Applicant's power to respond to these difficulties to help ensure that the EIA is filed on time, and some points in this regard have been discussed above in connection with Reg 5.9(2)(a). Consequently, these difficulties really are considerations to factor in with respect to assessing whether the Applicant has been reasonable and prompt and diligent pursuant to Reg 5.9(2)(a), rather than amounting to exceptional circumstances under Reg 5.9(2)(b).

It follows that I do not consider that there are any exceptional circumstances that warrant an extension of time.

Although I indicated in the Commissioner's letter of 11 March 2020 that I would now provide an intention to grant or refuse, I now consider it appropriate to allow the Applicant a further opportunity to provide more information in support of the EOT before doing so. Therefore, the Applicant has **two (2) weeks** from the date of this letter to provide any additional information to support its EOT, in particular addressing the issues outlined in this letter, after which time I will further assess the EOT and issue an intention to grant or refuse.

Finally, the comments by the Opponents regarding the EOT are noted, however I do not propose to answer those comments in detail in view of the fact that I am presently not satisfied that the EOT should be granted for the reasons given in this letter.

I apologise for the delay in considering this matter.

Yours sincerely,

William Guinea
Senior Examiner of Patents
Oppositions and Hearings
Phone: 02 6283 2234

5 March 2020

IP Australia

Discovery House
47 Bowes Street
Phillip
ACT 2606

Via eServices only

Dear Commissioner,

Opponent's response to Extension of Time Request

Patent Application No. **2017210650**

Applicant: **LAA Industries Pty Ltd**

Opponent: **Taranis Power Group Pty Ltd**

O/R: **AU2017210650OP**

We refer to the notice of 27 February 2020 acknowledging the request by the Applicant for an Extension of Time ('EOT') of a further 3 months in which to file its Evidence in Answer. In the interests of time, we request consideration of the below points when considering this EOT request.

The Commissioner has a limited discretion to allow an extension of time, and an extension *cannot* be allowed Under reg 5.9(2) unless the Commissioner is satisfied that:

- a. the party who intended to file the evidence in the period:
 - i. has made all reasonable efforts to comply with all relevant filing requirements under Chapter 5; **and**
 - ii. despite acting promptly and diligently at all times to ensure the appropriate evidence is filed within the period, is unable to do so; **or**
- b. there are exceptional circumstances that warrant the extension.

Firstly addressing sub-section b) relating to exceptional circumstances, **Section 3.11.2.2 of the Patent Manual of Practice & Procedure - Application of the Law** states that exceptional circumstances are defined as the following:

- a. a circumstance beyond the control of a party that prevents the party from complying with a filing requirement
- b. an error or omission by the Commissioner that prevents a party from complying with a filing requirement
- c. an order of a court, or a direction by the Commissioner, that the opposition be stayed pending the completion of a related proceeding or action

Specifically, Section 3.11.2.2 states that “*circumstances that normally arise during the preparation of evidence cannot be regarded as exceptional. For instance, unavailability of experts for periods of time due to leave, work commitments, personal commitments or even short periods of illness are not exceptional*”.

Moving on to sub-section a), without any exceptional circumstances, an extension of time is only available if the party has made all reasonable efforts to meet the time period AND, despite acting promptly and diligently at all times, is unable to do so.

Section 3.11.2.3 of the Patent Manual of Practice & Procedure - Justification for the Extension clearly states that the following matters would suggest that a party had **NOT made all reasonable efforts and acted promptly and diligently** to comply with an evidentiary period:

- unexplained delays, e.g. in settling on an expert, in briefing an expert, in preparing a draft by the expert, in finalising the evidence of the expert;
- delays in obtaining expert evidence that could have been anticipated and acted on;
- unavailability of experts due to involvement in other matters, unless the party had exhausted all efforts to find alternative experts;

- the extension is being sought to obtain evidence of matters not referred to (either directly or by clear implication) in the statement of grounds and particulars;
- delays due to intervening holidays, leave, etc which were known or could have been expected.

Applicant's support for the EOT comprises declarations by Messrs. Mark Vincent Keogh ('**Keogh**'), James Waterreus ('**Waterreus**') and Fidel Dela Paz ('**Dela Paz**').

Keogh broadly declares that i) three concurrent oppositions have been made to the Application, ii) that he has been engaged with work commitments, and iii) that he has been occupied with preparation for a Hearing for Opposition to Patent Application No. 2017213531 by Taranis Power Group Pty Ltd ('**Taranis Opposition**' - the Hearing for which was held on 19 February 2020).

Similarly, **Waterreus**, as the Principal Engineer for the Applicant, also declares that i) three concurrent oppositions have been made to the Application, ii) that he has been engaged with work commitments, and iii) that he has been occupied with preparation for the Hearing on the Taranis Opposition.

Lastly, **Dela Paz** declares that he had annual leave scheduled from 23 February 2020 to 29 February 2020 (7 days), which was booked on 12 September 2019.

With regard to Keogh and Waterreus' claims that they have been engaged with preparation for the Hearing on the Taranis Opposition, we would like to note that the evidence in the Taranis Opposition was completed in April 2019. The only thing that was required for the Taranis Opposition was preparing written submissions and attending the one-day hearing in Canberra on the 19th of February 2020, both tasks that are typically handled by the legal representatives for a party, rather than by the party itself, as implied by Keogh and Waterreus. Neither Keogh nor Waterreus could

have supplied any further evidence upon the completion of the evidence rounds, which occurred in April 2019.

With regard to Keogh and Waterreus' claims that they have been engaged with work commitments, such circumstances are expressly captured under **Section 3.11.2.3 of the Patent Manual of Practice & Procedure** as failing to meet the requirements of acting promptly and diligently AND making all reasonable efforts at all times, nor of being an exceptional circumstance, as required under Reg 5.9(2). Dela Paz's 7-day annual leave is also irrelevant, as this was known and could have been appropriately managed.

With regard to the three concurrent oppositions that have been made to the Application, this is a circumstance that would normally arise during the preparation of evidence in such matters, i.e. not exceptional, and if the Applicant acted promptly and diligently at all times **and** made all reasonable efforts to comply, would not have required the EOT.

Specifically, although the Opponent's Evidence in Support was completed on 28 November 2019, the documents referred to in the accompanying declarations were listed in the Opponent's Statement of Grounds and Particulars ('SGP') submitted on 28 August 2019, as was the case with the two other opponents. There is no reason why the Applicant could not have started preparing its Evidence in Answer when it was served with the respective SGPs. The Applicant has also known since being served with the SGPs that it would have to respond to three opponents. In addition, there appears to be overlap between the grounds raised in the respective SGPs which could have been dealt with simultaneously.

We would also like to note that it is usual for parties in opposition to engage independent experts to provide evidence in these proceedings, as each of the opponents have done. However, Applicant makes no mention whether or not such

independent experts have been engaged. Further, if such an expert had been engaged promptly and diligently, any usual timing conflicts due to prior work engagements and annual leave could have been managed in a reasonable manner.

We further note that the Applicant has not only requested an additional full 3-month period within which to submit its evidence, but has also left it until the week before such evidence was due before seeking an extension when it seems that the Applicant would have been aware of any issues with meeting the deadline some time ago.

As a result, we submit that no exceptional circumstances exist, nor that the Applicant acted promptly and diligently at all times, nor made all reasonable efforts to comply.

In light hereof, we hereby request that the Applicant's EOT Request be refused.

Yours faithfully,

A handwritten signature in black ink, appearing to read 'N. Schutte', with a long horizontal flourish extending to the right.

Neal Schutte

PATENTEUR Pty Ltd

Patent Attorneys for Applicant

25 March 2020

The Commissioner of Patents
IP Australia
PO Box 200
Woden ACT 2606

via e-Services

Dear Commissioner

**Re: Standard Patent Application No. AU 2017210650 in the name of LAA Industries Pty Ltd
- and - Opposition thereto by Anderson IP
Our Ref: RJN-01**

We refer to the request for an extension of time (**EOT**) to file evidence in answer (**EIA**) made by the applicant, LAA Industries Pty Ltd (**LAA**), in the above-referenced opposition.

We object to the EOT request and agree with the Delegate's reasons for refusing the request in its letter of 11 March 2020. We make the submissions given below in support of the Delegate's refusal.

Applicable law

1. Regulation 5.9 of the *Patents Regulations 1991* (Cth) governs LAA's EOT request.
2. To determine whether the EOT may be granted, the following questions must be considered¹:
 - (i) Has LAA and their patent attorney, Fidel Dela Paz of protectmyidea.com.au (**Attorney**), made all reasonable efforts to comply with all relevant filing requirements?
 - (ii) Did the failure to file the EIA in time occur despite LAA and its Attorney acting promptly and diligently at all times to ensure the EIA is filed in time?
 - (iii) Were there exceptional circumstances that warrant the extension?
3. The Commissioner can grant the EOT only if she is satisfied that the answer to each of questions (i) and (ii) is YES or if she is satisfied that the answer to question (iii) is YES. If she is satisfied, then the Commissioner must then consider whether there are any discretionary reasons why the EOT should not be granted.²

¹ *TRED Design Pty Ltd v Julie-Anne McCarthy and Bradley McCarthy* [2013] APO 57 (**TRED**), [34]; *Merial Limited v Novartis AG* [2013] APO 65 (**Merial**), [14].

² *TRED*, [35]; *Merial*, [14].

Lack of reasonable effort, promptness and diligence

Keogh

4. LAA relies on a declaration of its Managing Director, Mark Vincent Keogh, dated 25 February 2020 (**Keogh**). Keogh refers to various business activities relating to LAA and its sister company, UON Pty Ltd (**UON**), that Mr Keogh was allegedly involved in, at various times, during the three-month period for preparing and filing the EIA in full.
5. In particular, Keogh refers to work involving an investment partner, a visit by Mr Keogh to a worksite and ongoing management of LAA and UON general operations. These are all business-as-usual activities commonly carried out by commercial organisations. Mr Keogh also refers to his involvement in an opposition to Australian Patent Application 2017213531 (**Taranis**).
6. Notwithstanding his alleged prior commitments, it is evident that Mr Keogh failed to make any allowance for his involvement in the relevant business activities and made no effort to ensure that the EIA was all filed on time. There are many steps that Mr Keogh could have reasonably taken (but failed to do so) to ensure the deadline was met. For example, Mr Keogh could have delegated responsibility for managing the preparation of the EIA to one or more company employees. Mr Keogh could also have engaged additional external professional advisors to assist with this work. Instead of taking such actions, Mr Keogh elected to prioritise the business activities referred to in his declaration (including raising investment) over the EIA.
7. Keogh also refers to a period of planned company shutdown over Christmas and personal leave taken by Mr Keogh between 1 February 2020 and 16 February 2020. These leave periods were all anticipated and it would have been within LAA's control to make arrangements that would have avoided the consequences of the relevant personnel not being available (or fully available) during the relevant times.
8. Mr Keogh also seeks to rely on the number of documents filed by Anderson IP for its Evidence in Support (and by other opponents). We note that LAA received three opposition notices on 3 June 2019. LAA, therefore, knew that it was facing three opponents almost six months prior to the commencement of its three-month window for preparing its EIA. Corresponding Statements of Grounds and Particulars and Evidences in Support were also timely filed by the opponents and issued to LAA on, respectively, 29 August 2019 and 2 December 2019. LAA had the opportunity to determine the extent of the work involved in preparing its EIA and to take steps necessary to ensure that it was filed in time.

Waterreus

9. LAA also relies on a declaration of its employee, James Waterreus, dated 25 February 2020 (**Waterreus**). Mr Waterreus also refers to his involvement in ongoing LAA and UON work commitments, the Taranis opposition and the Evidence in Support filed by Anderson IP. Paragraphs 4 to 8 above are, therefore, repeated.

10. Despite Mr Waterreus's alleged busy work schedule, it is evident that LAA did not make any effort to engage alternative experts to complete its EIA by the deadline. The subject matter of the patent application under opposition relates to electromechanical engineering of average complexity and it would have been open to LAA to engage one or more alternative experts with relevant background and expertise.

Dela Paz

11. LAA also relies on a declaration of its Attorney dated 26 February 2020 (**Dela Paz**) which refers to annual leave taken by its Attorney between 23 February 2020 to 29 February 2020. All three declarations relied on by LAA confirm that this leave was known and scheduled in advance — Keogh, [10]; Waterreus [11]; Dela Paz, [2]. “Annual leave” is not a matter which can trigger the valid operation of Regulation 5.9.
12. The Attorney's leave was entirely foreseeable and it was within LAA's control to make arrangements that avoided the consequences of its Attorney not being available during the relevant time. The period of leave amounts to just five business days of the total three-month period available for preparing the EIA. Alternative arrangements could, therefore, have been made to cater for this short period without undue burden.
13. LAA's own evidence on the issue of advance notice of annual leave is sufficient alone to dispose of the EOT application.

No exceptional circumstances

14. There are no exceptional circumstances that warrant an extension. The impact of the various business activities referred to in the Keogh and Waterreus declarations could all have been anticipated in advance. LAA could have taken (but failed to take) reasonable steps to ensure that these activities did not hinder the timely preparation and filing of its EIA.
15. In regard to the various periods of annual leave referred to in LAA's EOT request, the relevant periods were all known in advance to LAA. The Commissioner has previously held that prior scheduled leave of persons involved in patent opposition proceedings does not amount to exceptional circumstances that warrant an extension.³

Conclusion

16. Regulation 5.9 is onerous and requires LAA to exercise all reasonable efforts and to act with promptness and diligence at all times, unless exceptional circumstances apply. In the present case, there are no exceptional circumstances. LAA prioritised other business matters over the EIA and, in doing so, flagrantly neglected (on the face of LAA's own evidence) to commit the resources required to prepare and file its EIA on time. LAA evidently decided to file an EOT request four business days before the final deadline for filing its EIA rather than taking reasonable steps to meet this deadline during the three months available for doing so.

³ *Merial*, [24].

17. Importantly, we note that the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth) expressly seeks to remove the ability of both patent applicants and opponents to seek and obtain extensions of time for filing evidence in opposition proceedings other than for occasions when all reasonable steps have been taken to comply or exceptional circumstances. Plainly, neither limb has been satisfied here on the evidence nor, with respect and having regard to the reasons proffered to justify the extension, could they be.
18. Including for the reasons given above, LAA's EOT request should be refused. If the EOT request were to be granted, the resultant changes to the opposition timetable would be substantially to our detriment. Further, it is in the public interest that the opposition proceeds expediently and in accordance with the statutory evidentiary timeframes.
19. In the event that LAA submits further information in alleged support of its EOT request, we reserve the right to file further submissions in response.

Yours respectfully,



Stephen Anderson

MinterEllison

25 March 2020

BY ONLINE SUBMISSION

The Commissioner of Patents
IP Australia
Patent Office
PO Box 200
WODEN ACT 2606

Dear Sir

**Australian Patent Application No. 2017210650
in the name of LAA Industries Pty Ltd
and opposition thereto by Allied Pumps Pty Ltd**
Our ref: 1251237

We refer to the above Australian Patent Application ('**650 Application**) and opposition thereto by Allied Pumps Pty Ltd (**Allied Pumps**). In particular, we refer to LAA Industries Pty Ltd's (**LAA**) application for an extension of **three months** from the deadline of 2 March 2020, until 2 June 2020, to file further evidence in answer, filed on 25 February 2020 (**Extension Application**).

Our client, Allied Pumps, opposes the Extension Application and submits that it should be rejected.

Grounds in Support of LAA's Extension Application

The evidence filed by LAA in support of its Extension Application is set out in three declarations by Messrs Keogh, Waterreus and Dela Paz each dated 25 February 2020 and provides the following grounds in support:

- a) the "*number of documents to be reviewed*" in the three opposition proceedings to the '650 Application;
- b) the work commitments of "*key LAA personnel*" between October 2019 and February 2020;
- c) the "*prior scheduled*" annual leave of Mark Vincent Keogh for 16 days in February 2020, the "*prior scheduled*" annual leave of James Waterreus for UON's Christmas shutdown period and the "*prior scheduled*" annual leave of LAA's patent attorney for 7 days in February 2020; and
- d) LAA's own patent opposition proceedings against another Australian patent application,

(together, **Grounds in Support**).

Our client's position

For the reasons set out below, the Grounds in Support do not satisfy either of the conditions set out in regulation 5.9 of the *Patents Regulations 1991* (Cth) (**Regulations**). Namely, the evidence filed by LAA in support of the Extension Application does not demonstrate that:

- **all reasonable efforts** were made by LAA to comply with all relevant filing requirements **and** that LAA acted **promptly and diligently at all times** in the preparation of its evidence in answer (5.9(2)(a) of the Regulations); or
- any **exceptional circumstances** exist to warrant an extension (5.9(2)(b) of the Regulations) (emphasis added). We also refer to your letter dated 11 March 2020 that "*the information filed in support of the request does not appear to relate to an exceptional circumstance*".

Regulation 5.9(2)(a) – all reasonable efforts and acting promptly and diligently

The Commissioner **may** extend an evidentiary period under regulation 5.9(2)(a), **if satisfied** that the relevant party has made **all reasonable efforts** to comply with all relevant filing requirements **and has acted promptly and diligently at all times**. None of the Grounds in Support were "*unforeseen events*" to LAA at 28 November 2019, when each opponent filed its evidence in support. In failing to take into account the Grounds in Support, Allied Pumps submits that LAA has neither made all reasonable efforts nor acted promptly and diligently at all times.

Ground in Support a - the need to file evidence in answer to three oppositions

LAA has failed to make all reasonable efforts and act promptly and diligently at all times by not taking into account the existence of three opposition proceedings and taking the necessary steps to prepare and file its evidence in answer on time.

LAA has been on notice of the existence of three opponents since three notices of opposition were lodged on 28 May 2019, **more than nine months ago**. Further, LAA has been on notice of the number and nature of all prior art documents to which it needed to respond, since all three statements of grounds and particulars were provided to LAA by IP Australia on 29 August 2019, **more than six months ago**. As an example of LAA both failing to take all reasonable steps and acting promptly and diligently, James Waterreus (who Mr Keogh says is one of his "*key personnel*") states in paragraph 5 of his declaration that "*I was asked on [sic] December 2019 to assist in the preparation of Evidence in Answer..*". No evidence is provided to explain why Mr Waterreus was unable to consider the cited prior art documents in the oppositions nor work on his evidence in answer prior to the unspecified date in December 2019. Relevantly, in *Fugro Airborne Surveys Corp v Geotech Airborne Limited* [2014] APO 23 Delegate Barker said that the "*presence of significant delays without a reasonable explanation is the antithesis of acting promptly and diligently*".

Ground in Support b - UON's stated work commitments

LAA has failed to make all (or indeed any) reasonable efforts to anticipate the "*prior scheduled*" work and travel commitments of LAA's key personnel and patent attorney.

Relevantly, in *Vito Mitolo And Son Pty Ltd v Mitolo Wines Aust Pty Ltd* [2018] ATMO 26 (**Vito Mitolo**), Delegate Kirov said, in reference to the corresponding (and identically worded) regulation of the *Trade Marks Regulations 1995* (Cth), that "*several decisions of the Registrar and Commissioner have indicated that business or holiday travel in particular is not considered to be an unforeseen event that ought prevent the preparation of a party's evidence*" (emphasis added).

Further, and in any event, none of the LAA witnesses have stated whether or not those business trips or holiday travel appointments were known to the individual deponents prior to the filing of evidence by the Opponent. That is, it is possible (and, indeed, the Delegate should infer in the absence of evidence to the contrary) that the deponents were aware of their various trips prior to the filing of evidence by the Opponent.

Declaration of Mark Vincent Keogh

Mr Keogh refers to his involvement in a "*major shareholder investment due diligence review by Macquarie Bank*" between "*August and December*" 2019 for UON Pty Ltd (**UON**) as supporting circumstances for the Extension Application. However, this transaction was publicly disclosed by 9 December 2019, and therefore completed before that time, that is, more than three months before LAA's evidence in answer was to be filed. Annexed to Mr Keogh's declaration at 'MK-1' is a press release by UON, which quotes Mr Keogh and which announces the completion of the Macquarie transaction on 9 December 2019. Further, no information is provided as to the nature of extent of the "*investment*".

Mr Keogh additionally refers to an eight day work trip in December 2019 and the "*Christmas period shutdown*" as further reasons for his inability to prepare evidence in answer. As the Managing Director of LAA and UON, Mr Keogh does not provide any evidence to support his inability to allocate sufficient resources to complete LAA's evidence in answer, taking into account these periods of time. Further, the work commitments referred to by Mr Keogh are for UON, which is not the applicant in this opposition. If significant barriers to the timely completion of LAA's evidence in answer arose as early as December 2019, then Allied Pumps submits that these should have been drawn to the attention of the opponents and the Delegate at that time in the form of a properly articulated extension application. Instead, these matters were raised only days before the expiration of the deadline.

Declaration of James Waterreus

Mr Waterreus states that his "*full time duties as Principal Engineer for both LAA and UON*" impacted his ability to prepare LAA's evidence in answer. Mr Waterreus provides no reasons in his evidence to explain why in a three month period, he was unable to work around his commitments to LAA and UON and adequately prepare his evidence in answer.

Mr Keogh as Managing Director of LAA (and UON), does not provide any evidence that he made any attempt to manage Mr Waterreus' "*occupation duties*" to allow Mr Waterreus to complete his evidence in answer by the stated deadline. In addition, there is no evidence in support of the Extension Application to explain why no other person, other than Mr Waterreus, could prepare expert evidence as part of LAA's evidence in answer. Mr Waterreus' declaration does not provide any detail of the amount of work yet to be completed by him, nor when he anticipates that such work will be completed, in order to justify an extension of time. Relevantly, in *TRED Design Pty Ltd v Julie-Anna McCarthy and Bradley McCarthy* [2013] APO 57 Delegate Barker said that the applicant to an extension of time request must "*provide enough information to enable a delegate of the Commissioner to form their own opinion on whether the party has acted reasonable, promptly and diligently.*" Our client submits that the absence of this information ought to be fatal to the present application.

Finally, and critically, no explanation is provided in the evidence of Mr Waterreus to explain how he is now able to prepare his evidence in answer despite his ongoing "*full time duties*" for LAA (and UON). In response to both Mr Keogh's and Mr Waterreus' declarations, we refer to Delegate Kraefft's comments in *Shelford Services Pty Limited v Baylor Research Institute* [2014] APO 20 that a "*failure to file evidence due to foreseen or foreseeable circumstances would generally not be considered favourably, and effort to address such circumstances in an application or submissions for an extension of time would generally be counter-productive*".

Ground in Support c – annual leave

Declaration of Mark Vincent Keogh

Mr Keogh refers to the LAA and UON Christmas shutdown period and his own "*prior scheduled*" two week holiday in February 2020 as reasons for his inability to prepare LAA's evidence in answer. No evidence is provided as to precisely when that "*prior scheduled*" annual leave was booked.

In any event, the decision in Vito Mitolo (see above) clearly states that: "*business or holiday travel in particular is not considered to be an unforeseen event that ought prevent the preparation of a party's evidence*".

Declaration of James Waterreus

Mr Waterreus does not refer to any prior scheduled annual leave in his declaration. Mr Keogh's declaration states that Mr Waterreus was on annual leave during the LAA and UON Christmas period shutdown. Relevantly, Mr Waterreus does not provide any evidence that he was unable to work on the preparation of his evidence nor assist Mr Keogh with the evidence in answer during this period.

Declaration of Fidel Dela Paz

The declarations of Mr Keogh and Mr Waterreus both raise the holiday leave period of LAA's patent attorney, Fidel Dela Paz, in late February 2020 as a reason for LAA's inability to prepare its evidence in answer.

Mr Dela Paz's very brief declaration states that on 12 September 2019, he booked a 7 day trip to Tasmania from 23 to 29 February 2020. As at 12 September 2019, Mr Dela Paz was already aware of three opposition proceedings and had also received the statements of grounds and particulars for each opposition. Mr Dela Paz, Mr Keogh and Mr Waterreus had **many months** to anticipate and work around Mr Dela Paz's very short period of leave. In any event, the decision in Vito Mitolo (see above) clearly states that: "*business or holiday travel in particular is not considered to be an unforeseen event that ought prevent the preparation of a party's evidence*".

Grounds in Support d – unrelated patent opposition proceeding

The declarations of Mr Keogh and Mr Waterreus both refer to UON being the opponent in another patent opposition as an additional reason for LAA's inability to prepare its evidence in answer. UON is not a party in this opposition. Further, the evidence in reply in UON's own opposition proceeding was filed in April 2019. No evidence has been provided in support of the Extension Application to explain why the preparation for UON's own opposition hearing could not be undertaken in the eight months prior to February 2020.

Regulation 5.9(2)(b) - exceptional circumstances

The Commissioner may also extend an evidentiary period under regulation 5.9(2)(b), if satisfied that there are "*exceptional circumstances*" that warrant the extension. The Regulations define exceptional circumstances as "*beyond the control*" of the party.

In *UON Pty Ltd v Taranis Power Group Pty Ltd* [2019] APO 6, a decision on an application to extend the time to file evidence by UON, where Mr Keogh states he is also the Managing Director, Delegate Subbarayan considered that "*beyond the control of a party*" means "*something that could not have been anticipated and acted upon*". Each of the Grounds in Support relied upon by LAA are entirely foreseeable and could have been "*anticipated and acted upon*" by LAA so that its evidence could have been filed by 2 March 2020. None of the Grounds in Support are "*exceptional circumstances*" that warrant an extension, as duly noted in your letter dated 11 March 2020.

The "seriousness" of the requirements of regulation 5.9

In *CSR Building Products Limited v United States Gypsum Company* [2019] APO 15, Delegate Triffett acknowledged the "*seriousness*" of the requirements of regulation 5.9 following the introduction of the *IP Laws Amendment (Raising the Bar) Act 2012* (Cth). Our client submits that the evidence supporting the Extension Application does not come close to supporting any extension of time when considering the "*seriousness*" of the requirements of regulation 5.9 and the Extension Application should be rejected.

If the Extension Application were granted, the delay to the opposition proceeding would result in detriment to our client. Finally, any delay in the resolution of our client's opposition proceeding will create uncertainty and interruption to our client's ability to conduct its business.

Even if the Commissioner was minded to grant a short extension of time of, say, two weeks, that time has now elapsed in any event.

Our client considers it important that the Patent Office is in receipt of its strong objection to the Extension Application prior to making its decision on its intention to grant or reject the Extension Application. Our client will urgently review any additional information filed by LAA on 25 March 2020 and will provide any further comments on the Extension Application within 48 hours. We would be grateful if the above mentioned decision is made after receipt of our client's further communication.

Yours faithfully
MINTER ELLISON



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