

23 September 2021  
BRISBANE OFFICE

IP Australia (Oppositions)  
Australia

## RESPONSE TO THE COMMISSIONER'S PROPOSED DIRECTION

**CQMS Pty Ltd**

**Australian Patent No. 2018201726**

**Opposition against ESCO Group LLC**

JAWS Ref: 760026OPP

Dear Commissioner,

I refer to IP Australia's letter of 14 September 2021.

### Evidence in reply and regulation 5.23

We note the Commissioner's intention to direct that [10], [40-51], [38], [39] (other than paragraphs 32-36 and 39) and [53] of Dr Hillier's declaration dated 23 June 2021 (the **Second Hillier Declaration**) are not properly in reply.

In light of the view reached by the Commissioner, without any admission regarding the characterisation of the evidence, the Opponent no longer presses [10] of the Second Hillier Declaration, but submits that the Commissioner should consult [40]-[51], [38], the remainder of [39] (i.e., paragraphs 28-31, 37-38 and 40-41 of [39]) and [53] under Regulation 5.23.

The paragraphs of the Second Hillier Declaration referred to above go to the issues of the state of common general knowledge in the field at the priority date and inventive step, which are key issues in the opposition to the patent application. Although Dr Hillier gave evidence in relation to common general knowledge and inventive step in his first declaration made on 1 February 2021 (the **First Hillier Declaration**), particularly in [21] of the First Hillier Declaration, Dr Hillier's evidence in the above paragraphs of the Second Hillier Declaration is more detailed. The specific nature of that evidence is such that the information contained in those paragraphs is likely, if not certain, to significantly inform the decision maker's consideration regarding the state of common general knowledge in the field and the issue of whether all or any of the claims lack an inventive step. The evidence is probative and highly relevant, and the opponent submits that it is in the public interest that it be considered. If the relevant paragraphs are not taken into account, there is a risk that the opposition will not be correctly determined on its merits.

With regard to the circumstances leading up to the evidence in the relevant paragraphs not being filed earlier by way of evidence in support, I note that the opponent was represented by a different firm of patent attorneys at the time of filing evidence in support.

The opponent further submits that the balance of convenience favours the Commissioner consulting the paragraphs under Regulation 5.23. Any prejudice to the applicant can be addressed by providing the applicant with an opportunity to file evidence in reply to the relevant paragraphs. The opponent notes that the opposition has not yet been set down for hearing. In addition, the opponent notes that [38] and [39] of the Second Hillier Declaration reproduce verbatim evidence from the first declaration of Dr Hillier that was filed in the opponent's opposition to Australian Patent Application No. 2014262221 (the **221 Opposition**). The applicant's expert, Dr Holland, replied to that evidence in the 221 Opposition, so it would not be onerous for the applicant to do so in this opposition. Furthermore, Dr Hillier's evidence in [40]-[51] of the Second Hillier Declaration is nearly identical to that contained in equivalent paragraphs of Dr Hillier's declarations filed as evidence in support in oppositions by the opponent to other applications in this patent family (including 2018201735 and 2018201710) to which the applicant's expert, Dr Holland, has replied, so responding to those paragraphs would likewise be unlikely to be an onerous task.

For the above reasons, the opponent submits that the information in [40]-[51], [38], the remainder of [39] (i.e., paragraphs 28-31, 37-38 and 40-41 of [39]) and [53] of the Second Hillier Declaration should be consulted by the Commissioner under Regulation 5.23.

Yours faithfully  
**James & Wells**



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