



25 June 2020

## General Correspondence

### Pizeys Patent and Trade Mark Attorneys Pty Ltd

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BRISBANE QLD 4001  
Australia

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<b>Your reference</b>	61595SIG/AJD
<b>Application number</b>	2018229489
<b>Applicant name</b>	Sigma-Aldrich Co. LLC
<b>Opponent</b>	JH Corporate Services Pty Ltd

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Dear Sir/Madam,

I refer to the letter of 19 June 2020 from the opponent providing further submissions in response to our letter of 25 May in relation to the declaration of Peter Whitehead dated 11 February 2020 and accompanying annexures PW-1 to PW-3 (the impugned evidence).

As noted in our letter, the Commissioner having considered the submissions from the parties formed the preliminary view that the impugned evidence is not strictly evidence in reply. As the opponent did not request to be heard in this matter, the Commissioner has issued the direction stated in our letter. There is nothing in the latest letter from the opponent that would convince the Commissioner that the direction is not proper and that it should therefore be rescinded at this stage.

As noted by the delegate in *Merial Limited v Bayer Intellectual Property GmbH [2015] APO 16* (14 April 2015) at [7], this is a matter that should be finally determined at the substantive hearing and the opponent may raise this issue with the Hearing Officer during the substantive hearing.

Yours sincerely,

R Subbarayan  
Senior Examiner  
Oppositions and Hearings  
Phone: 02 62832637

19 June 2020

The Commissioner of Patents  
PO Box 200  
WODEN ACT 2606  
**By eservices**

Dear Commissioner

**AUSTRALIAN PATENT APPLICATION NO. 2018229489 IN THE NAME OF OF SIGMA-ALDRICH CO. LLC - AND - OPPOSITION THERETO BY: JH CORPORATE SERVICES PTY LTD**  
**Our Ref: PMW:HA:1915199**

We refer to the above opposition matter and provide the following comments in relation to the Patent Office correspondence as indicated.

### **Correspondence of 25 May 2020**

The Senior Examiner states that “the US Examiner has not been led in as an expert witness in the present proceedings and without any further information as to their qualifications and experience the Commissioner can place no probative weight on their views or rebuttal of Professor Cannon’s experience”. We respectfully disagree with the Senior Examiner and provide the following comments in rebuttal.

The Senior Examiner has rejected the relevant Evidence-in-Reply not because it fails to directly rebut the Applicant’s Evidence-in-Answer, it clearly does, but because the Senior Examiner believes that the US Examiner does not have the qualifications of a relevant expert witness. This decision denies the Opponent natural justice because many of the views expressed by the US Examiner relate to a clear lack of novelty that rebut views of Professor Cannon, which she makes in her Australian declaration. We submit that the US Examiner is eminently qualified to provide these views and that they are valid to the present Australian Opposition. With respect, the Senior Examiner has made a cursory judgement, which does not refer to precedent law, and that incorrectly categorises the views of the US Examiner.

Based on our comments above, we submit that the Declaration of Peter Whitehead and associated exhibits is properly Evidence-in-Reply because it clearly satisfies the requirements set out in the correspondence of the Patent Office dated 24 April 2020 and summarised in our submission dated 7 May 2020. Moreover, the allowability of the Declaration of Peter Whitehead and associated exhibits is consistent with the relevant case law, referred to below, and therefore should be considered during the substantive hearing.

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In support of our position, we refer the Senior Examiner to *Merial Limited v Bayer Intellectual Property GmbH [2015] APO 16* (14 April 2015) at [7], which states it has been confirmed that "[t]he only time that a final determination of whether the evidence is actually in reply is made is during the substantive hearing of the opposition". Relevantly, the Senior Examiner has made no reference to relevant case law on this issue and therefore has disadvantaged the Opponent. Accordingly, if necessary, we reserve the right to raise this issue with the Hearing Officer during the substantive hearing.

### **Correspondence of 12 February 2020**

The Applicant provides the following information in relation to the matters listed in the correspondence. The Opponent delayed responding to this correspondence until the challenge to the evidence in reply was complete.

1. Not relevant
2. The Opponent does not intend filing further evidence
3. No relevant
4. The Opponent does not intend to withdraw the opposition
5. The Opponent does intend to the amend the Statement of Grounds and Particulars
6. This Opposition should not be heard in conjunction with any other matter
7. We refer to our comments above in relation to correspondence of 25 May 2020
8. There is no reason to stay the opposition
9. No other matters need to be addressed before the hearing

### **Correspondence of 5 June 2020**

The Opponent's representatives intend to appear at the hearing by video conference. If, however, by the time the hearing is set face-to-face attendance is available that would be the Opponent's preference.

Preferable dates for the Opponent's representatives to attend a hearing are any day in the period of 12 to 31 October 2020.

We look forward to receiving confirmation that a hearing date has been set.

Yours faithfully  
**Hazan Hollander**



**Yves Hazan**

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