

# Someone is patenting my invention. How do I stop them?

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Worthwhile read for: start ups, business owners

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If you have invented something that satisfies the requirements for the grant of a patent, you are entitled to have a patent granted in your favour.

However, disputes can arise over who is the true inventor or owner of an invention. In addition, it is possible that another party may attempt to patent your invention. For instance, this may occur when another party has developed a similar invention completely independently and without knowledge of your invention, or in a situation in which another party has become aware of your (typically unprotected) invention and seeks to patent it for themselves.

However, there are ways in which you can attempt to stop someone from patenting your invention in all of these circumstances. It is important to remember that this is a complex area of law and legal advice should be sought if you are unsure about your rights to an invention.

## Ownership disputes

From time to time a situation arises in which a person, who considers themselves an inventor of a particular invention, is not named on a patent application for that invention. If the named applicant refuses to voluntarily add the missing inventor to the application, the missing inventor can apply to the Australian Patent Office for a declaration of entitlement to the patent application under section 36 of the *Patents Act 1990* (Cth).

If the Commissioner of Patents is satisfied that the person bringing the action under section 36 was in fact the inventor, a declaration of entitlement will be made and the Commissioner may direct for that the inventor's name to be added to the application.

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## Someone is patenting an invention I already have a patent for...

### What can I do?

Ideally, you won't have to do anything. If your patent or patent application has been published, then a Patent Examiner should locate it during a search and examination of the later application. If the invention disclosed in the later application is identical to your invention, the later application should never be granted. This is because the invention won't be novel or inventive in light of your own earlier patent or application.

If you would prefer to make sure that the Patent Office is aware of your patent or patent application when it is examining the later application, you can lodge your patent (and any other relevant 'prior art' documents) at the Patent Office for an Examiner to consider during examination.

### What if their patent gets accepted or granted?

From time to time, patent applications are accepted (and patents are granted) for inventions that are not novel and inventive. If this is the case, you can oppose the grant of a patent on an accepted

application, seek re-examination of a granted patent, or attempt to invalidate a granted patent in court. These options will be discussed in further detail later.

It is important to remember that having a granted patent is not a defence to infringement. Therefore, if a competitor obtains a patent for an invention that is very similar or identical to the invention described in your own patent, then you have the ability to use your patent to bring an infringement action against your competitor.

Someone is patenting my invention but a patent has not been granted yet...

### **What can I do?**

There are two options available to you.

Firstly, if the application is yet to be accepted, you may submit 'prior art material' to IP Australia that demonstrates the patent under consideration is not patentable. An invention is only patentable if it is novel and involves an inventive step (standard patent) or innovative step (innovation patent). If you have publicly disclosed the invention before the filing date of your competitor's patent application, and have the documentation to prove it, then you may be capable of demonstrating that the other person's invention is not patentable.

If the Examiner considers the submissions to be highly relevant, the patent application under consideration may not proceed to grant. However, it's important to note that you will not be involved in this process after you have submitted the prior art material.

Secondly, if the acceptance of an application was published by IP Australia less than three months ago, you may file an opposition to the grant of the patent. A pre-grant opposition is very different to filing prior art material, as more grounds of opposition are available (including the entitlement of the applicant to the patent). A patent opposition is effectively a small scale litigation proceeding before the Patent Office, involving a number of evidentiary stages followed by a hearing. Oppositions of this type are likely to take anywhere from 18 to 24 months to complete.

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## **Does it matter whether the patent application is for an innovation patent?**

Yes. While both standard patents and innovations patents can be opposed, although the timing for each is different. A standard patent can only be opposed after acceptance, but before being granted. In contrast, innovation patents may be opposed at any time after they are certified (i.e. have successfully completed the examination phase). The opposition process for an innovation patent is quite different to that for a standard patent application, but still requires the submission of relevant prior art material to IP Australia.

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## **Someone has been granted a patent over my invention...**

### **What can I do?**

One option is to seek revocation of the patent through a Court. However, this will be an expensive exercise.

As a result, a better option may be to request a re-examination of the patent. IP Australia requires you

to submit your reasons for re-examination. While you cannot request a re-examination on the grounds that you are the inventor of the invention covered by the patent, you may submit that the invention is not patentable because it is not novel and/or inventive. This is typically done by submitting the relevant prior art documents to the Patent Office for consideration by an Examiner.

### **What effect does this process have?**

If the Commissioner finds that the patent is not in fact patentable upon re-examination, the Commissioner may revoke the patent either wholly or partly.

### **Does it matter whether the patent application is for an innovation patent?**

Yes. Standard patents can only be re-examined after the granted patent has issued, whereas innovation patents can only be re-examined after certification (i.e. they have been examined).

If an innovation patent has been granted, but not examined, there are other options available. The first option is to submit relevant prior art material to the Patent Office for consideration by an Examiner during examination.

In addition to this, third parties can request examination of granted innovation patents. As a result, if you believe that another party's innovation patent is not valid, you could request that IP Australia examine the patent. Relevant prior art material could also be submitted at this time for the Examiner's consideration.

### **Request a quote**

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