



HIGH COURT OF AUSTRALIA

5 November 2014

ALPHAPHARM PTY LTD v H LUNDBECK A/S & ORS

[2014] HCA 42

Today the High Court, by majority, held that s 223(2) of the *Patents Act* 1990 (Cth) conferred power on the Commissioner of Patents to extend the time within which the first respondent, H Lundbeck A/S ("Lundbeck"), could apply under s 70(1) of the Act for an extension of the term of its Australian patent.

Section 71(2) of the Act required that an application for an extension of the term of a standard patent be made during the term of the patent and within six months after the latest of three specified dates. Section 223(2) provided that, in certain circumstances, where a "relevant act" which was required to be done within a certain time was not done within that time, the Commissioner could extend the time for doing the act. Section 223(11) defined "relevant act" to mean an action (other than a "prescribed action") in relation to a patent. Regulation 22.11(4)(b) of the Patents Regulations 1991 (Cth) provided that "filing, during the term of a standard patent as required by subsection 71(2) of the Act, an application under subsection 70(1) of the Act for an extension of the term of the patent" was a prescribed action.

Lundbeck applied to the Commissioner for an extension of time within which to make an application under s 70(1) of the Act to extend the term of its Australian patent. The application for an extension of time was opposed by the appellant, Alphapharm Pty Ltd. Lundbeck made the application during the term of the patent but more than six months after the latest of the three dates specified in s 71(2). The Commissioner's delegate granted Lundbeck the extension of time sought. This decision was affirmed by the Administrative Appeals Tribunal, and an appeal to the Full Court of the Federal Court of Australia was dismissed. By special leave, Alphapharm appealed to the High Court.

The High Court dismissed the appeal. The Court held, by majority, that s 71(2) of the Act imposed two cumulative time requirements. The first was that an application under s 70(1) for an extension of the term of a patent be made during the term of the patent. The second was that such an application be made within six months after the latest of the three dates specified in s 71(2). Properly understood, s 223(2) permitted the Commissioner to enable an application under s 70(1) to be made during the term of the patent but more than six months after the latest of the three dates specified in s 71(2).

- *This statement is not intended to be a substitute for the reasons of the High Court or to be used in any later consideration of the Court's reasons.*