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RAISING THE BAR – Changes to Australian Patent Law

Major changes to Australian patent law come into effect with passage of the Intellectual Property Laws Amendment (Raising the Bar) Act 2012. The most significant of these provisions come into force from 15 April 2013, and affect granted patents and pending patent applications for which examination has not been requested prior to that date.

Key changes include:

- Changes to the assessment of inventive step, now using the common knowledge of the skilled person in the art anywhere in the world, not just in Australia. This will also have impact whenever expert evidence is required, as overseas experts will qualify. Also removal of the current “ascertained, understood and regarded as relevant” restriction on prior art, which often meant that troublesome citations from examination in other jurisdictions were not able to be cited for inventive step purposes in Australia.
- Raising the standard of descriptive support required: the description must now disclose the invention in a manner clear enough and complete enough for the invention to be performed by a person skilled in the art. This is intended to be a higher test than that currently in place.
- The present, lenient “fair basis” test for descriptive support is replaced with the requirement that the claims are fully supported by the description.
- The full width of the claim must now be supported.
- It will not be allowed to add descriptive support by amendment adding matter that extends beyond what was disclosed at the time of filing of the application. This is currently allowable, as the present amendment provisions refer to the matter “claimed”.
- The specification must disclose a “specific, substantial and credible use for the invention”, which is intended to counter speculative applications.
- For a valid priority claim, from either an Australian provisional application or from a foreign priority application, the higher “clear enough and complete enough for the invention to be performed by a person skilled in the art” test will now also apply.
- Higher standards of proof will be applied both during examination and in oppositions.
- Modified examination, based on a corresponding patent granted in another country, will no longer be available. Similarly, deferment of examination request for the purpose of modified examination will also be repealed.
- The period for gaining acceptance of the patent application will be reduced from 21 months from the first examination report, to 12 months.
- The period for requesting examination following a direction to request examination will be reduced, from 6 months to 2 months.

• Patents

• Trade Marks

• Designs

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- Extension of evidence periods in opposition will be more difficult to obtain.
- 'Omnibus' claims, referencing the description or drawings, will no longer be allowed unless absolutely necessary to define the invention.
- A divisional application will no longer be able to be filed after 3 months from the advertisement date of the acceptance of a patent application. A consequence is that when the grant of an accepted application is opposed, it will no longer be possible to effectively continue prosecution of the accepted application by filing a divisional application with the same patent claims.

Overall, the intention of the changes is to raise the standard for patentability to be consistent with international standards, and remove the situation where broader patent claims may be obtained, and found valid, in Australia than in other jurisdictions such as USA and Europe.

Additionally

- Already in effect, new acts for the purpose of obtaining regulatory approval, or new acts for experimental purposes, are explicitly exempted from the list of infringing acts. The exemption does not cover acts which started before 15 April 2012.

Actions

The new examination and validity provisions take effect for any patent applications filed on or after 15 April 2013, or pending applications which have not had an examination request filed before that date. As 15 April 2013 falls on a Monday, any action will need to be taken by **Friday 12 April 2013**.

To take advantage of the current, more lenient, validity tests and time periods:

- Review already-filed Australian patent applications and PCT national phases and instruct examination requests for these.
- Review already-filed Australian patent applications and PCT national phases to identify any which require additional descriptive matter added, and file amendments.
- Review current PCT applications intended for Australian national phase and, if desired, request early national phase entry in Australia accompanied by examination request.
- Review any pending provisional applications or foreign priority applications for level of descriptive support. If believed necessary, bring forward filing of the Australian complete patent application, accompanied by examination request.
- Review existing and prospective oppositions for filing of divisional applications and to prepare for compliance with tighter evidence periods.

In view of the anticipated surge of examination instructions leading up to implementation of the changes, we ask for your instructions by **29 March 2013** if you wish to file an early request for examination. If you would like our assistance in review of your patent portfolio, please let us know.