
CHAMBERS GLOBAL PRACTICE GUIDES

Patent Litigation 2026

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Australia: Law and Practice

Katrina Crooks, Duncan Longstaff
and Andrew Rankine
Spruson & Ferguson Lawyers



AUSTRALIA



Law and Practice

Contributed by:

Katrina Crooks, Duncan Longstaff and Andrew Rankine
Spruson & Ferguson Lawyers

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Spruson & Ferguson Lawyers was Australia's first law firm to specialise exclusively in intellectual property law. With decades of experience, the team is consistently recognised for its deep expertise in patents, trade marks, designs and copyright law – and for its role in shaping landmark IP cases across the country. The team advises on all aspects of IP disputes and litigation, commercialisation strategy,

technology transactions, privacy laws and data protection. Whether defending rights or unlocking new opportunities, it is client-focused and delivers practical, strategic legal solutions tailored to client needs. Spruson & Ferguson Lawyers has over 500 employees, including over 200 professionals, servicing clients from across the globe – offering true regional capability, knowledge and experience.

Authors



Katrina Crooks heads the Spruson & Ferguson Lawyers team and practises in IP litigation. Recognised by numerous leading legal ranking publications, Katrina has over 25 years' experience obtaining

successful outcomes for clients, across diverse industries and on all aspects of IP. Dual qualified as a lawyer and patent attorney, Katrina has a particular interest in the life sciences sector, acting for numerous global leaders in pharmaceuticals, animal health, agrifood tech, nutraceuticals, medical devices and biotechnology, including in substantial and complex Federal Court patent litigation and advising on related therapeutic goods and medical device regulatory issues.



Andrew Rankine is a specialist in intellectual property disputes and acts on complex IP disputes for multinationals in the pharma, biotechnology, medical device, electronics, ICT, engineering and

resources sectors, including Samsung, Siemens, BASF, Cochlear, Sanofi and Wyeth. He also acted for Hytera in the Australian limb of its global dispute with Motorola relating to communications technology. A majority of Andrew's cases represent the Australian limb of multi-national disputes. He is accustomed to working closely with overseas legal teams to develop effective multi-jurisdictional strategies.



Duncan Longstaff has 19 years' experience as a specialist IP lawyer. His practice focuses on patent disputes, including in the mining/energy, pharmaceutical, biotechnology, agrifood tech, medical

device, information technology, financial services and consumer goods sectors. He is an expert litigator, conducting major complex IP litigation in the Federal Court of Australia and High Court of Australia for many major Australian and foreign clients, including Dyno Nobel (explosives), Otsuka and Lundbeck (pharmaceuticals), Zoetis (animal health), Ecolab/Nalco (industrial chemicals), InfoTrack (ICT) and Fuchs (industrial lubricants). Duncan has also established a significant practice in conducting oppositions in the Australian Patent Office.

Spruson & Ferguson Lawyers

Level 24
Tower 2, Darling Park
201 Sussex Street
Sydney NSW 2000
Australia

Tel: +61 2 9393 0100
Fax: +61 2 9261 5486
Web: www.spruson.com

SPRUSON & FERGUSON

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1. Intellectual Property Rights and Granting Procedure

1.1 Types of Intellectual Property Rights

Australia provides two principal types of patent protection for inventions: the standard patent and the innovation patent. Standard patents are the primary form of patent protection and are subject to the full range of validity requirements, including novelty, inventive step, utility, sufficiency of disclosure, best method, support and clarity. Innovation patents constitute a second-tier system conferring the same enforcement rights as standard patents but with a lower threshold for patentability – in particular, there is no inventive step requirement, only an “innovative step” requirement, which is a less demanding standard. The innovation patent system is currently being phased out; it has not been possible to file new applications for innovation patents since 26 August 2021. Innovation patents can still, however, be pursued via divisional applications based on standard patent applications filed before that date, or by converting a pending standard patent application to an innovation patent application where the standard application has a filing date on or before 25 August 2021. Existing innovation patents remain in force subject to payment of renewal fees.

Both types of patent are creatures of statute, being governed by the Patents Act 1990 (Cth). However, Australia is a common law jurisdiction, and the interpretation and application of the statutory provisions is significantly influenced by case law, including persuasive decisions from other common law jurisdictions. Since 2013, decisions of the European Patent Office and UK courts on sufficiency and support

have become particularly influential following legislative reforms that aligned Australian patent law more closely with European standards in these areas.

In addition to the statutory patent system, the equitable doctrine of breach of confidence provides an alternative means of protecting inventions under Australian law. Unlike patent protection, an action for breach of confidence does not require any formal application for the grant or registration of rights.

Pursuing patent protection and relying on trade secrets (protected through the equitable doctrine of breach of confidence) are, in practice, alternative choices. A standard patent application will be published in due course and will disclose the invention to the public regardless of whether the application proceeds to grant. A decision regarding which avenue to pursue can, however, be deferred to some extent as a patent application is not required to be published until 18 months after its earliest claimed priority date. It can be withdrawn before that time, keeping its contents unpublished.

1.2 Grant Procedure Australian Standard Patents

Australian standard patents are governed by the Patents Act 1990 (Cth) and administered by IP Australia. An applicant may first file an optional provisional application, which secures a right of priority and provides 12 months to file a complete application containing a full description of the invention, disclosure of the best method to use it, and at least one claim. A complete application is published approximately 18 months after the priority date. The applicant must

then request substantive examination within five years of filing. However, the Commissioner of Patents may direct an earlier request, in which case the applicant must comply within two months. During examination, an examiner assesses the invention for novelty, inventive steps, usefulness, and the patent eligibility of the claimed subject matter (ie, “manner of manufacture”), as well as sufficiency of the disclosure and support for, and clarity of, the claims. Assuming that any objections are overcome, the application is then accepted and advertised. Third parties then have three months to oppose the grant. If unopposed, or if any opposition is unsuccessful, the patent is sealed and granted. An innovation patent requires a complete specification with a maximum of five claims but is granted without substantive examination, typically within one to two months of filing. However, an innovation patent cannot be enforced until it undergoes substantive examination and is certified. Examination can be requested by the patentee or a third party at any time during the innovation patent’s lifespan. A granted innovation patent has a maximum term of eight years.

Trade Secrets

Australia has no dedicated statutory regime for trade secrets. Protection arises automatically under the equitable doctrine of breach of confidence, without any registration or formality, and lasts for as long as the information remains confidential. To succeed in an action for breach of confidence, a plaintiff must:

- identify the confidential information with sufficient specificity;
- establish that the information has the necessary quality of confidence (ie, it is not public knowledge, relative secrecy suffices);
- demonstrate that the respondent received the information in circumstances importing an obligation of confidence, assessed by whether a reasonable person in the recipient’s position would have recognised the information was confidential; and
- establish actual or threatened misuse of the confidential information without consent.

Confidential information may also be protected through contractual provisions (eg, non-disclosure agreements) and statutory duties of senior employees

of Australian companies under Sections 182–183 of the Corporations Act 2001 (Cth).

1.3 Timeline for Grant Procedure

Duration of the Grant Procedure

For a standard patent, the procedure from filing to grant typically takes four to five years, though this can be shortened to two to three years with the right strategy, or to approximately four to six months from the request for examination if expedited examination is obtained.

Representation

For both standard and innovation patents, in practice the only two options are self-filing or filing through an Australian registered patent attorney. Legal practitioners (solicitors and barristers) can advise on the validity and/or infringement of a patent. However, as set out in Sections 201–204 Patents Act 1990 (Cth), only a registered patent attorney is permitted to prepare patent specifications and documents relating to amendments to patent specifications.

Average Costs to Grant

Professional fees associated with drafting, examination and prosecution of patent applications vary depending on the complexity of the technology involved, the number and complexity of objections raised by the Australian Patent Office during prosecution, and the steps required to address those objections. Where grant is opposed by a third party, additional fees will be incurred.

1.4 Term of Each Intellectual Property Right

A standard Australian patent has a term of 20 years from the filing date of the complete specification. In the case of divisional applications, the term runs from the filing date of the complete specification of the parent case in which the invention was first disclosed.

An innovation patent has a term of eight years from the date of the patent. This is the date on which the complete specification was filed, or, for divisional applications, the date of filing of the complete specification of the parent case in which the invention was first disclosed.

Australian standard patents claiming a pharmaceutical substance per se (or claiming a pharmaceutical substance when produced by a process involving the use of recombinant DNA technology) are eligible for a term extension of up to five years, provided that certain statutory conditions are fulfilled. These conditions include that the pharmaceutical substance (or a product containing or consisting of that substance) is included in the Australian Register of Therapeutic Goods and that there has been a delay of at least five years between the filing date of the patent application and the first regulatory approval of any product containing or consisting of the pharmaceutical substance.

1.5 Rights and Obligations of Owners of Intellectual Property Rights

Under Section 13 of Australia's Patents Act 1990 (Cth), a patent gives the patentee exclusive rights to "exploit" the invention, and a patent "has effect throughout the patent area" (i.e., Australia). "Exploit" is defined in Schedule 1 of the Act and differs depending on whether the claimed invention is a product or a method/process:

- Product claims – "exploit" includes making, hiring, selling, offering to sell, using, importing, or keeping the product for any of those purposes.
- Method/process claims – "exploit" includes using the method or process, or doing any of the acts identified above (making, selling, offering to sell, importing, etc) in respect of "a product resulting from such use".

Australia has only a very limited form of patent linkage, not directly comparable to the US Orange-Book system. Under Section 26B of the Therapeutic Goods Act 1989 (Cth), a person seeking regulatory marketing approval for a generic or biosimilar product must certify to Australia's Therapeutic Goods Administration (TGA) either that:

- their product will not be marketed in a manner that infringes a valid patent claim; or
- that notice has been given to the patent holder of the generic or biosimilar supplier's intention to market their product before patent expiry.

In practice, generic and biosimilar suppliers generally certify under the first option.

The TGA does not adjudicate patent disputes – it merely requires that certification has been provided. Critically, no stay of marketing approval is triggered by the filing of patent infringement proceedings, and the TGA may grant regulatory marketing approval for a generic or biosimilar product irrespective of any pending patent dispute. Applications made to the TGA for regulatory marketing approval of generic or biosimilar products remain confidential until approval. As a result, patentees typically learn of an impending generic or biosimilar launch only after the product has been granted marketing approval and entered on the Australian Register of Therapeutic Goods (ARTG), a publicly-accessible database. Another limited aspect of patent linkage is the ability to search the online Australian Register of Patents for patents that have had their term extended to account for delays in regulatory approval of a therapeutic product (see 1.6 **Further Protection After Lapse of the Maximum Term**) – although such searches do not identify other, non-extended patents related to that therapeutic product.

1.6 Further Protection After Lapse of the Maximum Term

Australian standard patents that disclose and claim a pharmaceutical substance per se, or a pharmaceutical substance when produced by processes involving recombinant DNA technology, are eligible for a term extension of up to five years. The conditions for obtaining such an extension include that the pharmaceutical substance (or a product containing or consisting of that substance) must be included in the ARTG (ie, have been granted regulatory marketing approval in Australia) and that there must have been a delay of at least five years between the filing date of the patent application and the first regulatory approval of any product containing or consisting of that pharmaceutical substance.

An application for term extension must be made during the original 20-year term of the patent and within six months after the date of patent grant or the date the relevant goods were first entered on the ARTG, whichever is later. The application must be advertised

in The Australian Official Journal of Patents, and any person may oppose the extension.

During 2026, Australia's High Court will consider the eligibility of pharmaceutical formulation patents for term extension in proceedings involving Otsuka Pharmaceutical Co and Sun Pharma ANZ.

1.7 Third-Party Rights to Participate in Grant Proceedings

Any person may submit prior art and observations to the Australian Patent Office during examination of a patent application. Typically, this involves submitting prior art with supporting submissions, but may also involve submitting sworn declarations from expert or factual witnesses. This is an *ex parte* procedure, in which the third party submitting information has no right to make further submissions. However, there are no formal limits on how many such requests can be made.

Australia has a pre-grant opposition system for standard patents, administered by the Australian Patent Office. This allows third parties to oppose the grant of a standard patent application after acceptance and prior to grant. Any natural or corporate person may oppose the grant of an Australian patent application. There is no post-grant opposition procedure for standard patents. For innovation patents, which are granted without substantive examination, opposition is only available post-grant following substantive examination and certification.

In addition, any person may request re-examination of a granted Australian patent at the Patent Office, and there is no standing requirement for such a request.

1.8 Remedies Against Refusal to Grant an Intellectual Property Right

A patent applicant unable to overcome objections through correspondence and discussions with the Australian Patent Office Examiner can request to be heard by a more senior examiner. This process involves written and oral submissions as well as a published decision. There is a right of appeal to the Federal Court of Australia against an adverse decision of the senior examiner, at which point expert evidence is commonly adduced with respect to the validity of

the invention, at least by the patent applicant. Following a decision of a single judge in such proceedings, any further appeal to the Full Federal Court is only available with leave.

1.9 Consequences of Failure to Pay Annual Fees

If a renewal fee for a standard patent is not paid by the due date, a six-month grace period applies, during which the fee may be paid together with a surcharge for each month (or part thereof) of lateness. If the fee and surcharge are not paid within the grace period, the patent lapses (ceases).

After the grace period has expired, the patentee may apply for an extension of time under Section 223 of the Patents Act 1990 (Cth). The extension is discretionary and requires the patentee to demonstrate that the failure to pay was caused by an "error or omission" of a person concerned or their agent, or by a circumstance beyond that person's control. The applicant must provide full and frank disclosure of all relevant circumstances, identifying the specific person(s) who made the error.

The extension fee is calculated at AUD100 per month of extension and the missed renewal fee must also be paid.

If the extension sought is for more than three months, the application for extension of time is advertised for two months to allow third-party opposition. Third parties who exploited (or took definite steps to exploit) a patented invention during a period of lapse may acquire limited rights, including the right to apply for a licence, which may be granted by the Patent Office. Overall, the Australian regime for restoration of lapsed patents has been described as relatively generous compared with similar regimes in other jurisdictions.

1.10 Post-Grant Proceedings Available to Owners of Intellectual Property Rights

A patentee may seek to amend a granted Australian patent.

If the patent is not the subject of current litigation, any amendment request must be made to the Australian Patent Office. The amendment request is examined

and, if deemed allowable, is published in the Official Journal with third parties having two months to file any notice of opposition.

If the patent is the subject of current litigation, any application to amend must be made to the court that has carriage of the litigation. The court applies the same substantive test as the patent office, with additional discretion as to whether to allow the amendment request in all of the prevailing circumstances.

For patents granted on applications filed before 15 April 2013 (and for which examination had been requested by that date), amendments will not be permitted if they would result in the patent claiming matter not disclosed in the specification as filed, if the amended claims would fall outside the scope of the pre-amendment claims, or if the amended specification would not comply with the internal validity requirements of the Patents Act 1990 (Cth). For later patents, an additional requirement applies: amendments must not result in the specification disclosing matter beyond that disclosed in the specification as filed (ie, no “added matter”).

Where the substantive requirements for amendment are met with respect to a patent that is the subject of existing court proceedings, the court retains a broad discretion to allow or refuse amendment, taking into account all the circumstances of the case. The exercise of this discretion is informed by several well-established principles developed by the case law.

First, the patentee must make full and frank disclosure of all matters relevant to the exercise of the court’s discretion, including the circumstances in which the need for amendment arose, the history of the patent’s prosecution (both in Australia and in respect of any foreign counterpart patents and applications), and the reasons why the amendment was not sought earlier. Mere delay is not, of itself, sufficient to refuse to exercise discretion. However, delay is relevant to whether the respondent or the public have suffered detriment as a result.

Second, the court may refuse amendment if it is satisfied that the patentee sought to take unfair advantage of the unamended patent, for example, by asserting

claims that it knew or ought to have known required amendment.

Third, the public interest is a relevant consideration. The patent system confers a statutory monopoly in exchange for public disclosure. The court will have regard to the broader public interest in ensuring that the claims of a patent accurately reflect the patentee’s entitlement, and that the amendment process is not used to maintain claims that the patentee knows to be unjustifiably broad.

Fourth, the requirement for transparency means that the question of legal professional privilege arises frequently in the context of amendment applications. While a patentee is not compelled to waive privilege over communications with its patent attorneys and lawyers, failure to do so may leave the patentee unable to satisfy the court that the discretion should be exercised in its favour.

These discretionary factors are generally applied in a somewhat more rigorous manner to granted patents than to pending patent applications.

2. Initiating a Lawsuit

2.1 Actions Available Against Infringement

The owner of an Australian patent (or its exclusive licensee) may commence infringement proceedings in the Federal Court of Australia. Available remedies include declarations of infringement, interim (interlocutory) injunctions, final injunctions and an election between damages and an account of profits. Proceedings for unjustified threats of patent infringement may also be brought by an alleged infringer.

Australian patent owners may also apply to the Federal Court for orders that a potential infringer should give preliminary (pre-action) discovery of documents required for the patent owner to decide whether to commence patent infringement proceedings. Such applications can only be pursued where the patent owner requires further information to determine whether there is likely infringement of its Australian patent rights, or to assess the extent of potential infringement and the potential value (and commercial

viability) of embarking upon infringement proceedings. Documents and information obtained through preliminary discovery in Australia may only be used for the purposes of commencing related infringement proceedings in Australia, unless the court's permission is sought and obtained, eg, to use the documents in related proceedings overseas.

2.2 Third-Party Remedies to Remove the Effects of Intellectual Property

There are no special standing requirements for challenges to the validity of an Australian patent. Any natural or corporate person may seek revocation of a granted Australian patent in the Federal Court. Similarly, any natural or corporate person may oppose the grant of a standard patent application (pre-grant) or request re-examination of a granted patent in the Patent Office. The Patent Office may also undertake re-examination of its own initiative, such as following settlement of opposition proceedings. If litigation is under way in the Federal Court, the Patent Office cannot revoke a patent following re-examination or allow any amendment while the litigation remains pending.

2.3 Courts With Jurisdiction

Patent litigation is generally commenced in the Federal Court of Australia. First instance proceedings are conducted before a single judge of the Federal Court. The Supreme Courts in each Australian state and territory also have original jurisdiction to hear patent matters – though cases are very rarely commenced there, particularly as there is a legislative requirement that any appeal from a first-instance patent decision be heard by the Full Federal Court.

At second instance, a final first-instance decision may be appealed as of right to a full court of the Federal Court, comprising three to five judges. There are no permanent appeal judges; all Federal Court judges hear appeal cases from time to time. A full court hearing a patent appeal will typically include at least one judge, and usually multiple judges, with experience in patent cases.

A judgment of the Full Federal Court can only be appealed to the High Court of Australia with special leave, which is granted only in significant cases deal-

ing with new or disputed points of law. Only a minority of applications for special leave are successful.

2.4 Specialised Bodies/Organisations for the Resolution of Disputes

First-instance patent cases in the Federal Court are ordinarily allocated to a member of a panel of judges within the Patents and Associated Statutes practice area, each of whom has experience in patent matters, some with a technical background. In this sense, while the Federal Court is a court of general jurisdiction, it has a specialist patents list for the management and determination of patent cases.

The Australian Patent Office also plays a role in patent disputes through the pre-grant opposition system and re-examination processes, as well as its jurisdiction over patent ownership disputes. Court-ordered mediations are routinely conducted by registrars trained and accredited by the court, and parties may also engage private accredited mediators.

2.5 Prerequisites to Filing a Lawsuit

Before commencing proceedings in the Federal Court of Australia, there is a statutory obligation to attempt to resolve the dispute without recourse to litigation. At the commencement of proceedings, a “genuine steps statement” must be filed, outlining the steps that were taken to attempt to resolve the dispute without litigation, such as communicating the basis for the dispute to the opposing party, responding constructively to such communications, considering alternatives to litigation and cooperating with any such alternatives.

2.6 Legal Representation

Although parties are entitled to self-representation before the Australian Patent Office and Australia's Federal Court, in practice this does not occur in intellectual property disputes (other than in relation to small claims involving indigent litigants).

In proceedings before the Australian Patent Office, the parties are ordinarily represented by registered patent attorneys, solicitors specialising in intellectual property disputes and/or barristers with IP expertise.

In proceedings before the Federal Court of Australia, the parties are ordinarily represented by solicitors

specialising in intellectual property disputes and barristers with IP expertise. Registered patent attorneys commonly provide litigation support during such court proceedings.

2.7 Interim Injunctions

Interim injunctions are available in Australian patent litigation. Interim injunctions are most commonly sought in pharmaceutical cases where “irreparable” harm may be easier to demonstrate, although even in that area the outcomes are becoming less predictable. Outside the pharmaceutical field, interim injunctions are not commonly sought or granted in Australian patent disputes.

Applications for interim injunctions are usually dealt with *inter partes*, but in cases of special urgency, a claimant may apply *ex parte* for a temporary injunction covering the period until an *inter partes* hearing can be held. The time taken to apply for and obtain an interim injunction is typically in the range of four to eight weeks, and up to 12 weeks in less urgent matters.

To obtain an interim injunction, the patentee or exclusive licensee must establish that:

- there is a serious question to be tried on infringement;
- damages will not be an adequate remedy; and
- the balance of convenience and justice favour grant of the injunction.

Even if each of these conditions is met, the court retains discretion to grant or refuse relief. Delay is an important factor and it is critical that the claimant act as quickly as possible after learning of the threat to engage in allegedly infringing activity.

A party applying for an interim injunction must undertake to compensate the respondent and any third party adversely affected if the defendant is ultimately found not to have infringed or the patent is ultimately held invalid (known as the “usual undertaking as to damages”). In recent years, the Australian government has relied on such undertakings to seek compensation for additional expenses under the Pharmaceutical Benefits Scheme.

2.8 Protection for Potential Opponents

A potential opponent may take several protective steps. First, the respondent may seek security for costs, particularly where the applicant does not appear to have sufficient assets to meet any costs award, or has few assets located within Australia. Security typically takes the form of a bank guarantee.

Second, if there is doubt regarding the capacity of the patent owner and/or exclusive licensee to meet any award of damages, the opponent may seek orders requiring them to provide security for damages (again, typically in the form of a bank guarantee).

Third, a potential infringer may consider providing voluntary undertakings or entering settlement discussions to avoid injunction applications.

Fourth, an alleged infringer may commence proceedings for unjustified threats of patent infringement, seeking compensation for any harm it suffers by reason of such threats if infringement is ultimately not established, including where the asserted patent claims are ultimately held to be invalid.

2.9 Special Limitation Provisions

Proceedings for alleged infringement of an Australian patent must be commenced by the later of three years from patent grant or six years from the date of infringement. Subject to equitable defences including acquiescence, waiver and delay (*laches*), infringement proceedings may be commenced at any time during this limitation period. Delay and acquiescence can also potentially limit the damages or profits a patentee can recover, depending on the circumstances.

2.10 Mechanisms to Obtain Evidence and Information

Australia’s Federal Court provides several mechanisms for obtaining evidence and information, both before and during patent litigation.

Before proceedings are commenced, preliminary (pre-action) discovery may be sought to determine whether a cause of action exists and to assess the potential value of a claim. A party seeking preliminary discovery must satisfy a number of statutory criteria, including demonstrating a reasonable belief that

it may be entitled to final relief. The procedures for obtaining access to relevant information and evidence which apply at trial must now be understood in the context of the Federal Court of Australia's Intellectual Property Practice Notes IP-1 and IP-2. These Practice Notes include a standard form of directions for patent litigation, from which the court will not lightly depart. They also require the parties to exchange positions statements on infringement and require the respondent to provide a sworn product/process description in relation to any disputed integers, before applying for discovery.

If, following exchange of the parties' position statements on infringement and the respondent's product/process description, the patentee believes that discovery is necessary, then the parties are required to exchange proposed categories of documents for discovery. The scope of discovery may be determined on the papers or referred to a registrar of the court for determination.

Interrogatories (ie, requests for sworn written answers to questions) are available but used relatively infrequently in Australian patent litigation. Anton Piller orders (ex parte orders for search and seizure of documents or property to preserve evidence) and Mareva orders (ex parte orders to prevent disposal of assets) are also available in appropriate circumstances but are obtained relatively infrequently.

Confidentiality regimes, including inter partes confidentiality agreements and court-ordered suppression regimes, are routine to protect sensitive information exchanged prior to and during patent litigation.

2.11 Initial Pleading Standards

A party commencing patent litigation in the Federal Court must file an application identifying the relief sought and a statement of claim identifying each of the facts relied upon, together with particulars of infringement or invalidity as appropriate. A genuine steps statement must also be filed, detailing the steps taken in seeking to resolve the dispute prior to commencing litigation.

Each pleading filed in a proceeding must be accompanied by a certificate (provided by the filing party's

solicitor) confirming that the available factual and legal material provides a proper basis for each allegation, denial and non-admission contained in the pleading.

A party that is dissatisfied with the opposing party's pleadings may apply for further and better particulars and/or apply to have some or all of the opposing party's pleadings struck out. Where a party wishes to supplement or amend its pleadings in the course of patent litigation, it will require the consent of the opposing party and/or the court's leave.

Evidence in chief is filed by affidavit approximately five months before the pre-trial case management hearing, with evidence in answer due approximately two months before that hearing. Parties should expect that the court's leave would be required to file affidavit evidence in reply. Leave would also be required to file supplementary affidavit evidence after the completion of the standard evidentiary stages.

2.12 Representative or Collective Action

A regime for the conduct of class actions is provided in Part IVA of the Federal Court of Australia Act 1976 (Cth). In principle, that regime is available in intellectual property proceedings. To commence a representative proceeding, at least seven persons must have claims against the same person, the claims must arise out of the same, similar or related circumstances, and the claims must give rise to a substantial common issue of law or fact. In practice, class actions in patent matters are extremely rare in Australia.

2.13 Restrictions on Assertion of an Intellectual Property Right

Under Australian law, there are a limited number of patent-specific limitations or qualifications on the assertion of intellectual property rights. For example, a defence to patent infringement exists where the claimed invention is (or was at the time proceedings were commenced) the subject of a contract containing a provision inserted by the patentee. That provision must be void for impermissibly prohibiting the respondent from using or acquiring a product or process that is not the subject of the patent.

In addition, the assertion of intellectual property rights (including patent rights) is subject to the provisions of

Australian competition law including prohibitions on misuse of market power, cartel conduct and exclusive dealing.

3. Infringement

3.1 Necessary Parties to an Action for Infringement

Only a patentee and any exclusive licensee have standing to sue for infringement of an Australian patent. If infringement proceedings are commenced by an exclusive licensee, the patentee must be joined as an additional applicant (plaintiff) or, if the patentee does not consent to be joined as an applicant, as an additional respondent (defendant).

The definition of “exclusive licensee” under Australian patent law is restrictive. A licence will not be regarded as exclusive if it reserves to the patentee any right to exploit the claimed invention within Australia’s patent area (eg, a right to manufacture the patented goods) or gives the patentee a right to grant additional licences. A non-exclusive licensee does not have standing to sue for infringement and is not a proper party to infringement proceedings.

3.2 Direct and Indirect Infringement

Australian patent law distinguishes between direct and indirect (contributory) infringement.

A product claim is directly infringed by making, hiring, selling or otherwise disposing of the claimed product or offering to do so, using or importing the claimed product, or keeping the claimed product for the purpose of doing any of those things, within Australia’s “patent area”. A method or process claim is directly infringed by using the claimed method or process within Australia’s “patent area”, or by doing any of the above acts, in Australia’s “patent area”, in respect of a product resulting from use of the claimed method or process.

Indirect or contributory infringement may arise in three ways. First, a person who authorises another to engage in directly infringing conduct will be liable, pursuant to Section 13 of the Patents Act 1990 (Cth), which gives the patent owner the exclusive right to

authorise exploitation of the claimed invention. Second, under Section 117 of the Patents Act 1990 (Cth), a person who supplies a product will be liable if:

- the product is only reasonably capable of infringing use;
- the product is not a staple commercial product and the supplier had reason to believe that the recipient would put it to an infringing use; or
- the supplier gave instructions or inducement for the product to be put to an infringing use.

Third, at common law, a person who procures or induces another to infringe, or joins in a common design with another to undertake infringing conduct, will be jointly liable as joint tortfeasor.

Generally speaking, the remedies available for indirect (contributory) patent infringement are the same as those available for direct infringement and include declarations, injunctions, and an election between damages or an account of profits.

3.3 Process Patents

Several mechanisms are available for investigating infringement of process patents. Preliminary discovery, standard discovery or interrogatories may be sought with regard to an allegedly infringing process. The court may also require the respondent to file a process description under oath from a senior employee or director, detailing the steps of the allegedly infringing process.

A person who imports goods produced outside Australia by a method which is the subject of an Australian patent may be liable for direct infringement. Additionally, a person located outside Australia may be held jointly liable for infringement if they authorise, procure, induce or join in a common design with another person to engage in directly infringing conduct within Australia – for example, an overseas parent company may be held jointly liable with its Australian subsidiary.

Section 121A of the Patents Act 1990 (Cth) provides for a shifting of the onus of proof in proceedings for infringement of a patent claim directed at a process for obtaining a product where the court is satisfied

that the respondent's product is likely to have been made by the claimed process.

3.4 Scope of Protection for an Intellectual Property Right

Patent claims are given a purposive, rather than purely literal, construction according to the principles explained by Lord Diplock in the UK's *Catnic Components* case. The claims are construed through the eyes of the hypothetical person skilled in the relevant art, having regard to the common general knowledge in their field. Experts may give evidence on the meaning of technical terms used in the claims. While claims should be construed in the context of the specification as a whole, it is not legitimate to read down unambiguous claim language by importing "glosses" found elsewhere in the specification.

Currently, the prevailing view is that there is no recognised doctrine of equivalent under Australian patent law, although this issue has not been tested in any recent case. The doctrine of prosecution history (or file wrapper) estoppel is not currently applied in Australia, although in at least one case it was suggested that this is an open question.

Markman-style claim construction hearings are very rare in Australia, and issues of claim construction are ordinarily heard and determined together with all other issues of infringement and validity.

3.5 Defences Against Infringement

Beyond arguing non-infringement and invalidity of the asserted claims, an alleged infringer may rely on a number of statutory defences, including:

- prior continuing use of the claimed invention before the priority date of the relevant claims;
- exploitation of the claimed invention solely for regulatory purposes in Australia or overseas;
- experimental use;
- use of the invention on board a foreign vessel or aircraft; and
- the defence that the claimed invention is (or was) the subject of a contract containing a void provision inserted by the patentee that impermissibly prohibits the respondent from using or acquiring

a product or process that is not the subject of the patent.

In appropriate factual scenarios, equitable defences are also available, including acquiescence, waiver, delay (laches) and promissory estoppel, although these defences have received relatively little judicial consideration in Australian patent cases. Delay is specifically relevant to the court's discretion on interim injunctions and can also potentially limit the damages or profits recoverable in patent infringement proceedings.

The doctrine of patent exhaustion provides a defence to patent infringement under Australia law as explained in the decision of the High Court of Australia in *Calidad Pty Ltd v Seiko Epson Corporation* (2020) 272 CLR 351. Australia's Patents Act 1990 (Cth) provides for the grant of compulsory licences in two circumstances. First, where demand in Australia for the patented invention is not being met on reasonable terms or where the patentee has engaged in practices which breach Australian competition law. Secondly, to enable manufacture and export of the pharmaceutical to an eligible overseas country to address a public health issue.

In a number of Australian patent cases relating to standards-essential patents (or patents alleged to be standards-essential), the respondent has relied upon Fair, Reasonable and Non-Discriminatory (FRAND) principles in support of an argument that injunctive relief should be refused and/or that damages should be limited to a court-determined FRAND rate. However, Australian courts are yet to deliver a judgment on the merits of such arguments.

3.6 Role of Experts

Expert evidence on technical matters is of primary importance in Australian patent litigation and accounts for a significant proportion of total litigation costs. Expert evidence is ordinarily given in affidavit form (a sworn written statement), and the parties' legal representatives work together with the expert witnesses to prepare the affidavit to ensure evidence is presented in admissible form. Experts may be, and usually are, cross-examined at trial.

Expert witnesses are usually retained and compensated by the parties. At the time of their engagement, experts must be provided with a copy of the Federal Court of Australia's code of conduct for expert witnesses, which details their obligations regarding independence and impartiality. Court-appointed experts are relatively uncommon in Australian patent cases.

The court can be expected to issue directions regarding the number and field of experts permitted to give evidence in patent proceedings. Joint expert evidence processes are encouraged, including pre-trial expert conclaves in the absence of lawyers, during which experts prepare a joint report setting out matters of agreement and disagreement. At trial, concurrent expert evidence ("hot tubs") is now routine.

3.7 Procedure for Construing the Terms of the Patent's Claim

There is no separate procedure for construing the terms of a patent's claims in Australia. Markman-type claim construction hearings are extremely rare, and issues of claim construction are ordinarily heard and determined together with all other issues of infringement and validity. While the Federal Court of Australia has the power to order separate determination of specific issues, this is relatively uncommon except for quantum of damages, which is frequently determined separately after liability has been resolved.

3.8 Procedure for Third-Party Opinions

In practice, amicus curiae interventions in patent cases are uncommon but not unknown. An amicus curiae does not become a party to the proceedings but may, with the leave of the court, make submissions on questions of law or matters of public interest arising in the case. The primary objective of the amicus curiae procedure is to assist the court rather than to advance the interests of the amicus. Generally speaking, amicus curiae briefs are only likely to be permitted on a final appeal to the High Court of Australia.

4. Revocation/Cancellation

4.1 Reasons and Remedies for Revocation/Cancellation

Any natural or corporate person may seek revocation of a granted Australian patent in the Federal Court of Australia; there are no special standing requirements. Similarly, any person may request re-examination of an Australian patent in the Patent Office.

The key grounds of invalidity for Australian standard patents include:

- that a claim is not directed to patent-eligible subject matter (ie, not a "manner of manufacture");
- lack of novelty;
- lack of inventive step (obviousness);
- lack of utility;
- prior secret use;
- insufficient disclosure;
- failure to disclose best method;
- lack of support for the claims (or lack of fair basis, for patents granted on applications filed before 15 April 2013 for which examination had been requested before that date);
- lack of clarity;
- lack of entitlement (which has not been rectified); and
- false suggestion.

For innovation patents, the validity requirements are the same except that there is no inventive step requirement. Instead, the claimed subject matter must possess an "innovative step".

Where infringement proceedings are brought by the patentee, the respondent may cross-claim for revocation in the same proceeding.

4.2 Partial Revocation/Cancellation

Revocation proceedings may relate to one or more claims of a patent. Where one or more claims of a patent have been found invalid, revocation of those claims will be ordered, although revocation is routinely stayed pending the determination of any appeal.

4.3 Amendments in Revocation/Cancellation Proceedings

A patentee may seek to amend a patent that is the subject of litigation, including revocation proceedings. Any amendment application must be made to the court that has carriage of the proceedings under Section 105 of the Patents Act 1990 (Cth). The Patent Office may not consider an amendment application in respect of a patent that is the subject of current litigation (Patents Act 1990 (Cth), Section 112). The substantive requirements regarding amendments are addressed in **1.10 Post-Grant Proceedings Available to Owners of Intellectual Property Rights**.

4.4 Revocation/Cancellation and Infringement

In Australia, issues of infringement and validity are ordinarily heard and determined concurrently, by the same Federal Court judge, in the same proceeding – that is, without bifurcation. Where a patentee commences infringement proceedings, the respondent commonly cross-claims for revocation, and vice versa. While the court has the power to order separate determination of specific issues, this is relatively uncommon, except that quantum of damages is frequently ordered to be determined separately after liability (including both infringement and validity) has been resolved.

5. Trial and Settlement

5.1 Special Procedural Provisions for Intellectual Property Rights

Australian patent cases are subject to specific case management practices within the Federal Court's Patents and Associated Statutes practice area. In August 2025, the Federal Court introduced the Intellectual Property Practice Note – Standard Directions for Australian Patent Proceedings (IP-2), which now applies to all patent proceedings (including those already under way) and sets out standardised directions designed to reduce the length and complexity of patent cases, increase procedural consistency and encourage early identification of issues.

Under the IP-2 Standard Directions, a structured timetable is set at the first case management hearing, which takes place approximately four to six weeks after commencement of proceedings. First-instance

hearings usually conclude within 12 to 24 months of commencement, with judgment delivered within approximately nine to 12 months thereafter, although longer periods may arise in complex cases.

Typical steps include pleadings, any interlocutory injunction application, filing of evidence, discovery, pre-trial steps (including expert conclaves) and trial, with possible interlocutory hearings on issues such as amendment, adequacy of pleadings and scope of discovery.

Expert evidence is given by affidavit in chief and answer, and experts are usually cross-examined at trial. Concurrent expert evidence (“hot tubs”) is now routine at trial.

The quantum of damages is routinely determined separately, after all issues of liability have been resolved.

5.2 Decision-Makers

First-instance patent proceedings are conducted before a single judge of the Federal Court. There is no jury trial in Australian patent cases. First-instance patent cases are ordinarily allocated to a member of a panel of judges within the Patents and Associated Statutes practice area, each of whom has experience in patent matters, some with a technical background.

On appeal, a Full Court comprising three to five judges hears the matter, and will typically include at least one judge, and usually multiple judges, with experience in patent cases.

5.3 Settling the Case

The Federal Court has the power to direct mediation of patent disputes. Court-ordered mediations are commonly conducted by registrars trained and accredited by the court, although parties can and often do choose to engage private accredited mediators. The use of mediation is increasing in frequency in Australian intellectual property disputes, particularly where the quantum of damages is likely to be small relative to the cost of litigation.

Formal offers of compromise compliant with the Federal Court Rules carry specific costs consequences, and less formal Calderbank letters of settlement may

be taken into account by the court as a discretionary matter relevant to any award of costs. A potential infringer may also consider voluntary undertakings or settlement to avoid interlocutory applications.

5.4 Other Court Proceedings

It is possible for one or more granted patents to be the subject of revocation proceedings before the Federal Court at the same time as one or more related divisional patent applications are the subject of opposition proceedings before the Australian Patent Office. In these circumstances, complex strategic considerations may arise concerning the timing of steps in the Federal Court and Patent Office, including the timing of evidence and any application for amendment. It cannot be assumed that the opposition proceedings will be stayed by the Patent Office pending the outcome of the court proceedings. If court proceedings are commenced, the Patent Office cannot revoke a patent following re-examination, or allow any amendment while the litigation remains under way. If court proceedings are commenced by the patentee for alleged infringement of a certified innovation patent, any opposition proceedings will be stayed by the Patent Office pending the outcome of the litigation.

Australian courts may grant anti-suit injunctions where foreign proceedings interfere with, or threaten to interfere with, ongoing domestic litigation, or where parallel proceedings are vexatious or oppressive. Such injunctions are an exercise of the court's inherent and equitable jurisdiction, designed to protect the integrity of its own processes and to prevent injustice.

6. Remedies

6.1 Remedies for the Patentee

The remedies available for infringement of an Australian patent include:

- a declaration that the relevant conduct has infringed the patentee's rights;
- a final injunction restraining the respondent from repeating the infringing conduct or engaging in any other infringing conduct; and
- either damages or an account of profits, at the election of the successful patentee.

A patentee may generally defer the election between damages and an account of profits until the quantum stage of proceedings, after discovery of the respondent's relevant books and accounts. Additional damages may be awarded where the infringer's conduct is flagrant or where compensatory damages are inadequate. The amount of additional damages is not limited by statute. Current case law suggests that additional damages will not be available if the patentee elects an account of profits.

A final injunction is a discretionary remedy but is granted in a significant majority of cases in which valid patent claims are found to have been infringed. However, in some pharmaceutical second-medical-use cases, the court has indicated it might refuse an injunction where the respondent's product is capable of substantial non-infringing use and difficulties arise in seeking to craft appropriate injunctive relief.

6.2 Rights of Prevailing Defendants

The ordinary rule in Australian patent litigation is that costs follow the event, meaning that an unsuccessful party is ordered to pay a portion of the costs incurred by the successful party. A prevailing defendant would therefore generally be entitled to an award of costs representing approximately 50–70% of the actual costs it incurred in defending the proceedings.

6.3 Types of Remedies

Innovation patents confer the same enforcement rights as standard patents.

6.4 Injunctions Pending Appeal

A judgment which has been appealed is not automatically stayed pending the outcome of the appeal. In particular, an injunction is likely to be ordered where a first instance decision upholds patent claims as valid and infringed and may not be stayed even while an appeal on infringement or validity is being pursued. However, where one or more claims of a patent have been found invalid, it is routine for revocation of those claims to be stayed pending the determination of any appeal. In appropriate cases, a party seeking a stay of a judgment pending appeal may be required to undertake to compensate the opposing party for any losses suffered during the stay if the appeal is unsuccessful.

7. Appeal

7.1 Special Provisions for Intellectual Property Proceedings

A final first-instance decision of the Federal Court of Australia on patent infringement or validity may be appealed as of right to a Full Court of the Federal Court, comprising three to five judges. An interim decision of the Federal Court may only be appealed to the Full Federal Court with leave. Leave is also required to appeal to the Full Federal Court from a decision of a single Federal Court judge in an appeal from a Patent Office decision.

A judgment of the Full Court can only be appealed to the High Court of Australia with special leave, which is granted only in significant cases dealing with new or disputed points of law of broad significance.

It is unusual for new evidence to be permitted at the appeal stage. However, the opposing party may raise additional issues on appeal via a notice of contention or cross-appeal.

7.2 Type of Review

An appeal from a first-instance decision of the Federal Court to the Full Federal Court proceeds by way of rehearing, not by way of a hearing de novo. The Full Court has the power to review both questions of law and findings of fact. For an appeal to succeed, the appellant must demonstrate that the primary judge made an error of law or that a finding of fact was not reasonably open on the evidence. It is unusual for new evidence to be permitted at the appeal stage. In the context of appeals against Patent Office opposition decisions, by contrast, the appeal is conducted as a hearing de novo, with the court able to permit new grounds and new evidence.

8. Costs

8.1 Costs Before Filing a Lawsuit

For patent owners and their exclusive licensees, costs will be incurred before the commencement of proceedings in relation to (for example) the conduct of inter partes correspondence, the identification and engagement of expert witnesses, preparation of

pleadings and preparation of evidence. Additional costs will be incurred where preliminary (pre-action) discovery is required to determine whether to commence infringement proceedings.

8.2 Calculation of Court Fees

Court filing fees for commencing patent proceedings in the Federal Court of Australia are set by regulation and published on the Federal Court's website. The fees are fixed amounts (not value-dependent, per-patent or per-defendant) and are subject to periodic revision. Exemptions or deferrals may be available in certain circumstances (although these are rarely obtained). Current fee schedules are available at the website of the Federal Court of Australia (www.fed-court.gov.au).

8.3 Responsibility for Paying the Costs of Litigation

The ordinary rule in Australian patent litigation is that costs follow the event – that is, the unsuccessful party is ordered to pay a portion of the costs incurred by the successful party. The amount awarded in costs typically represents around 50–70% of the actual costs incurred by the successful party. Increasingly, interlocutory costs are determined separately on a lump-sum basis and ordered to be paid forthwith.

9. Alternative Dispute Resolution

9.1 Type of Actions for Intellectual Property

The Federal Court has the power to direct mediation of patent disputes. Court-ordered mediations are commonly conducted by registrars trained and accredited by the court, although parties can and often do choose to engage private accredited mediators (eg, retired judicial officers). While it is possible to oppose mediation, if ordered by the court, the parties must attend. The use of mediation is increasing in frequency in Australian intellectual property disputes, particularly where the quantum of any damages is likely to be small relative to the cost of litigation.

10. Assignment and Licensing

10.1 Requirements or Restrictions for Assignment of Intellectual Property Rights

Under Section 14 (1) of the Patents Act 1990 (Cth), an assignment of an Australian patent must be in writing and signed by or on behalf of the assignor and the assignee. A patent may be assigned for a particular place in, or part of, the patent area under Section 14 (2). Where the patent is co-owned, a co-owner cannot assign an interest in the patent without the consent of the other co-owners under Section 16 (1)(c). There is no statutory requirement for the assignment to be executed as a deed. While registration of the assignment on the Register of Patents is not a precondition to the validity of the assignment between the parties, registration is important for the protection of the assignee's interest. The patentee may deal with the patent as absolute owner subject only to rights appearing on the Register (Section 189), and an unregistered assignee may be vulnerable to a later purchaser in good faith for value without notice.

10.2 Procedure for Assigning an Intellectual Property Right

The procedure for assigning an Australian patent involves:

- the execution of a written assignment document signed by or on behalf of the assignor and assignee under Section 14 (1) of the Patents Act 1990 (Cth);
- filing the assignment with IP Australia for entry on the Register of Patents, together with evidence of the assignment (such as a copy of the executed assignment document); and
- upon registration, the particulars of the new owner are recorded on the Register.

10.3 Requirements or Restrictions to License an Intellectual Property Right

The Patents Act 1990 (Cth) does not prescribe specific formalities (such as writing or registration) as preconditions to the creation of a valid licence. In practice, however, patent licences in Australia are invariably documented in writing, and the terms of the licence (including exclusivity, field of use, territory and sublicensing rights) are matters of contractual agreement between the parties. While there is no statutory requirement to register a licence with IP Australia, registration of prescribed particulars may be desirable for the protection of the licensee's interest. Notably, the definition of "exclusive licensee" under Australian patent law is restrictive. A licence will not be regarded as exclusive if it reserves to the patentee any right to exploit the claimed invention within Australia's patent area (eg, a right to manufacture the patented goods) or gives the patentee a right to grant additional licences. This has important implications for standing, as only exclusive licensees (alongside the patentee) have standing to sue for infringement.

10.4 Procedure for Licensing an Intellectual Property Right

As noted in **10.3 Requirements or Restrictions to License an Intellectual Property Right**, there is no prescribed statutory procedure for licensing an Australian patent. The creation of a patent licence is a matter of private agreement between the parties, and no approval from the Patent Office is required. The licence agreement should be documented in writing and should address key terms including exclusivity, territory, field of use, duration, royalty obligations and sublicensing rights.

While not legally required, it is advisable to register the licence (or prescribed particulars of it) on the Register of Patents maintained by IP Australia, both for the licensee's own protection and to put third parties on notice.

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