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Patent Information Kit *Australia*

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Obtaining a patent in Australia

A patent is the statutory right to the exclusive use of an invention. Thus, the owner has the right to prevent others from making, selling, using or importing the patented invention for as long as the patent remains in force.

Patents can be obtained in respect of products and processes that are new and useful. In general, in order to be patentable, the invention should be of an industrial, commercial or trading character, as opposed to a purely artistic or intellectual exercise.

The invention must be new and involve some ingenuity or exercise of inventive skill, but it is not necessary that the invention be complex or a major breakthrough. Even simple or small improvements can be patented, provided that such improvements result in significant advantages.

Whilst in general it is necessary for an invention to be new at the time of the first filing, Australia provides a grace period of twelve months from a disclosure by the applicant within which to file a complete patent application. However, where reliance is made on the grace period, the rights granted upon issue of a patent may be limited.

Furthermore, a disclosure in the grace period, before the filing of an application, may invalidate overseas applications in the majority of countries which do not have an equivalent grace period.

Filing a patent application in Australia

When applying for a patent in Australia, it is necessary to submit a description of the invention (called the "specification") to the Patent Office to obtain a priority date. The invention should be described in sufficient detail in the specification to enable "a person skilled in the art" to put the invention into effect, without the need to exercise further inventive skill or ingenuity.

Any public disclosure or commercial use of a patented invention after the priority date will not prejudice the validity of that patent. Therefore, once a patent application has been filed, the invention as described in the specification (filed with the application) may be advertised, sold or otherwise disclosed to the public without prejudice to the validity of the patent to issue on that application.

A patent application may be either a "provisional" application or a "complete" application.

Provisional patent applications

A provisional application is useful if the invention is in its infancy and changes and modifications are envisaged in the 12 month period following the filing of the provisional application. Filing a provisional application with the Australian Patent Office establishes a "priority date" for the invention as described in the provisional specification. If the applicant wishes to obtain a patent, the applicant must file a complete application within 12 months of filing the provisional application. Filing the provisional application effectively gives the applicant a 12 month window in which to proceed with patenting and enables development of a market-ready prototype. However, if no further development of the invention is envisaged, or if the applicant wishes to obtain a patent as soon as possible, it may be more appropriate to file a complete application in the first instance.



Standard patent applications

The term of a standard patent is 20 years, commencing on the date of filing of the complete application.

After the application is filed, it must be examined by a Patent Examiner before it can be accepted for grant. Examination must be requested (i.e. it does not occur automatically) and an examination fee must be paid (it may also be necessary to pay an additional search fee if no earlier reliable search report for the same invention is available). Usually, a "reliable" search report will be a report issued by any one of a list of recognised Patent Offices around the world.

Examination must be requested within five years of the filing of the complete application, or within two months of a direction from the Patent Office to do so, whichever is the earlier, otherwise the application will lapse.

During examination, the Patent Examiner will examine the application for compliance with the Patents Act and Regulations (including conducting novelty searches (at additional cost) if no earlier search report is available). If objections are raised by the Examiner, the applicant is allowed a period of 12 months to overcome all objections raised and place the application in a condition for acceptance. If and when the application is accepted by the Patent Office, the acceptance is advertised in the Official Journal of Patents.

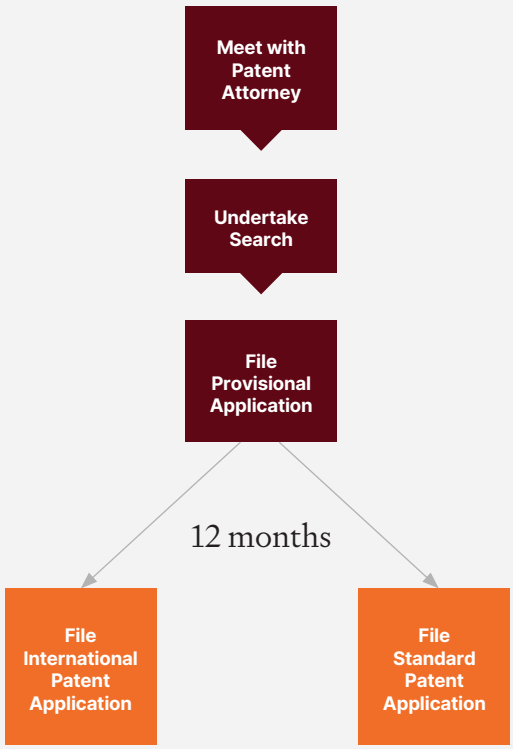
Any person may oppose the grant of a patent on an application by filing a Notice of Opposition within three months of the advertisement of acceptance. If an opposition is filed, both the applicant and the opponent are given an opportunity to lodge evidence, and the matter is then heard by a Delegate of the Commissioner of Patents. The majority of patent applications proceed to grant unopposed.

If there is no opposition, or if the opposition is unsuccessful, a patent will be granted on the application upon payment of an acceptance fee.

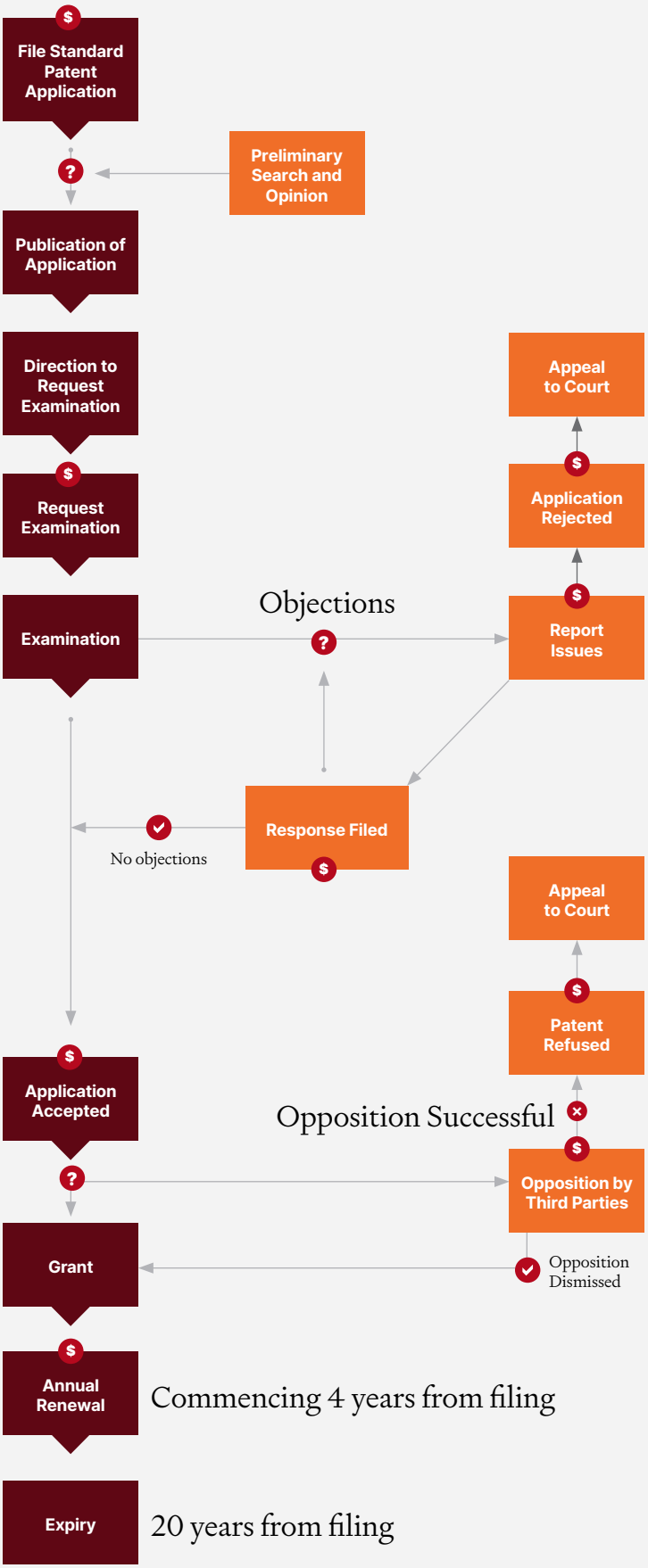
To maintain the patent or patent application in force, it is necessary to pay annual fees. These fees are called "continuation fees" during the application phase, and "renewal fees" after the patent has been granted. No continuation fees are payable for the first four years after the filing of the complete application.

You are not entitled to represent that an invention is patented until the patent has been granted. Once the patent has been granted, you are entitled to mark the product with the word "patented". While the patent application is pending however, you may use the notation "patent pending" or "patent applied for" or "patent application no..."

Usual patenting procedure



Australian standard patent application



Australian innovation patent application

Innovation patent applications

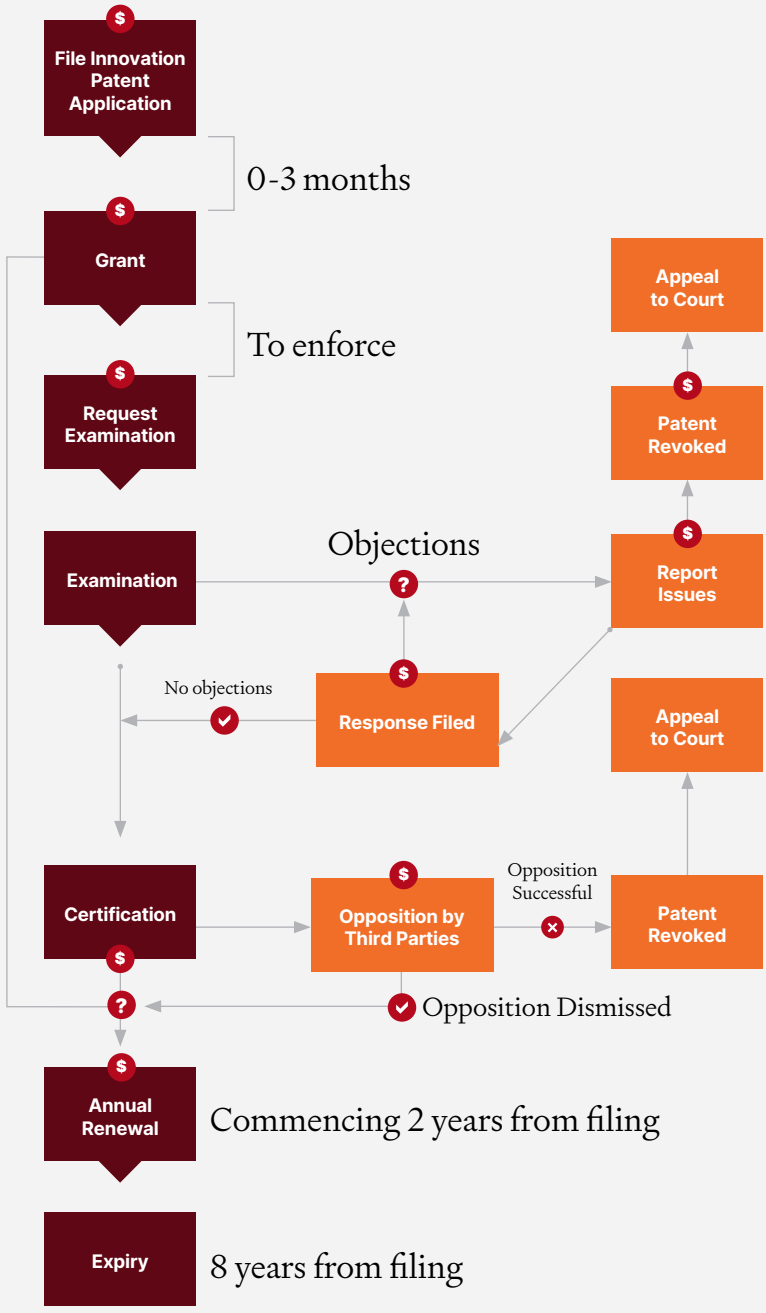
Only available for existing applications having a filing date of 25 August 2021 or earlier.

If an application for an innovation patent is filed (either as a divisional of, or conversion from a standard patent application having a filing date of 25 August 2021 or earlier), the application will immediately undergo a formalities check and a patent will be granted if all formal matters are in order. No examination of the subject matter, other than to ensure that it is not excluded subject matter, is made.

The patent will be granted for a term of eight years, subject to annual renewal fees being paid, but the patent cannot be enforced until the patent is examined and certified by the Patent Office. Examination may be requested by the patentee, by a third-party or upon the direction of the Commissioner. A third-party can oppose the certification after grant by the Patent Office.

Innovation patents are suitable for protecting lower level inventions, which cannot be protected by standard patents.

The innovation patent system is being progressively phased out. However, as noted above, it remains available to any standard patent application having a filing date of 25 August 2021 or earlier.



Searches

Patentability searches of worldwide (patent) literature should be carried out prior to taking steps to patent an invention. Also, freedom to operate searches should be carried out prior to commercially using an invention as it is possible that use of the invention may infringe earlier intellectual property rights granted to a third party. In this way it will be possible to identify any potential obstacle to use and patenting of the invention.

Searching is a specialist task and it is recommended that searches be carried out by a Patent Attorney.

Overseas patent applications

Patents are granted by the Patent Offices of individual countries. In order to obtain patent protection in overseas countries, it is necessary to obtain a patent in each country in which patent protection is required. The Patent Office is normally an authority of the government of a country and since there is no world government, it follows that that there is no "world patent".

Patent applications under the Paris Convention

The usual method of obtaining patents in overseas countries is to lodge a separate patent application in each country of interest. However, once the first patent application has been filed in a country which is a member of the Paris Convention (e.g. Australia), the filing of corresponding applications in other convention countries can be deferred by up to twelve months from the first filing without loss of priority. Most countries are party to the Paris Convention.

The cost of filing overseas patent applications varies from country to country, and costs in non-English speaking countries are usually greater due to the need to translate the patent specification and associated correspondence. Note that costs will also be incurred after filing the application due to the need to process the application through to the grant of a patent.

Patent Co-operation Treaty applications

Many countries of the world are also party to the Patent Co-operation Treaty ("PCT"). Under the provisions of the PCT, a single International (PCT) patent application can be filed with the International Bureau. The deadline for filing individual applications in those countries can then be deferred to 30 or 31 months (depending on the country) from the priority date of the application. During the PCT phase, an international novelty search is conducted and the applicant is provided with the results of that search. The applicant will therefore have the benefit of the search results before having to decide whether or not to proceed in any or all of the countries covered by the PCT application.

It should be noted that the PCT application does not take the place of individual "national" applications in each country, but defers the national processing of the patent application in each country. The costs for a PCT application are additional to the costs of the national processing of the patent application in each selected country.

The PCT application option allows a patent application to be filed initially in one language (no need for overseas translations), at one Patent Office (no need to file at several overseas countries) and with one set of fees. The international patent search provides an indication of the novelty or otherwise of the invention, and therefore the possibility of obtaining strong patents. The PCT application can be amended, if required, to distinguish the invention from any document located in the international search which can minimise future processing costs.



Overseas patent



European patent applications

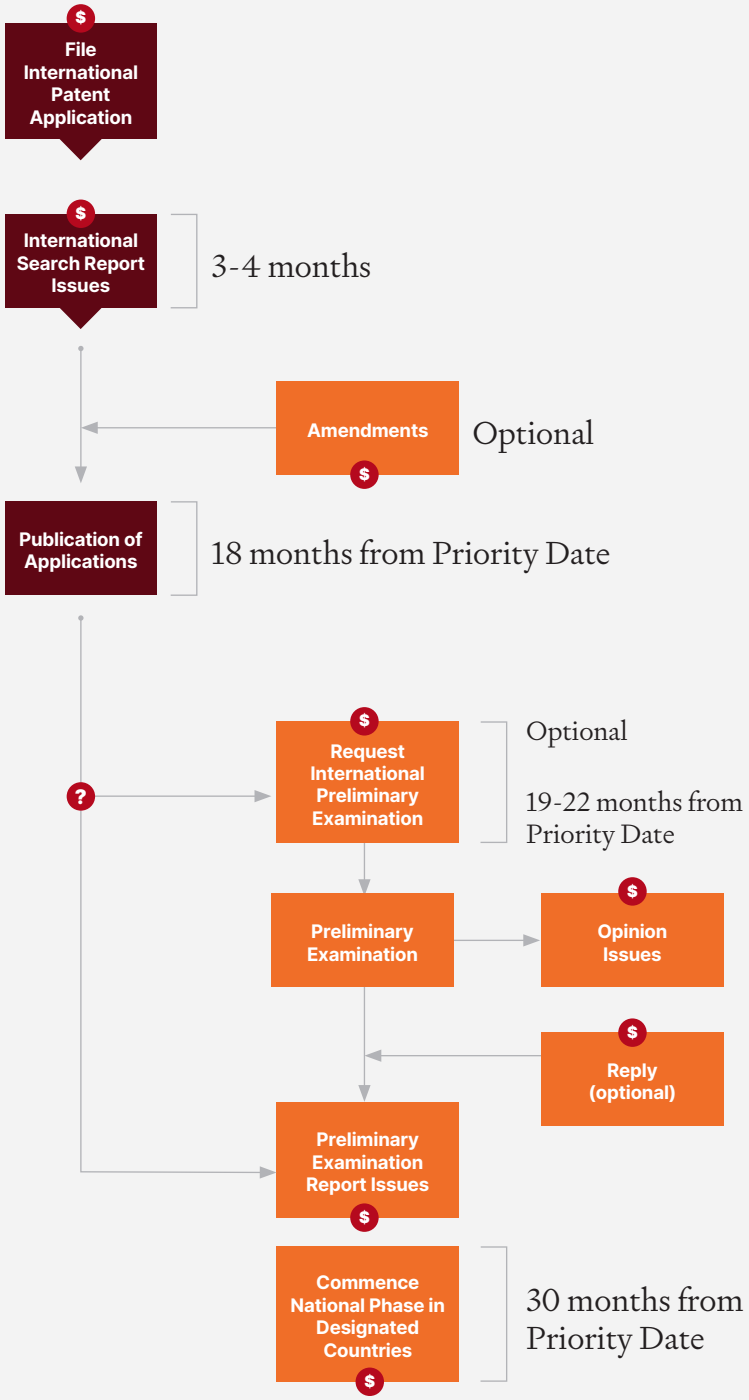
Most European countries are party to the European Patent Convention ("EPC"), which allows a single "European" patent application to be filed with the European Patent Office. The European patent application will be examined by the European Patent Office and if the application is in a condition for acceptance, a European patent will be granted. In order to obtain patent protection in any of the countries designated in the European patent application, the European patent must then be validated in the selected countries, and a translation of the European patent specification into the national language of each selected individual country may be required. Renewal fees are likely to be payable in those countries in which the patent is validated. If patent protection is required in more than three European countries, it is usually cost effective to file a European patent application.

List of countries party to the Patent Co-operation Treaty:

Albania, Algeria, Angola, Antigua and Barbuda, Armenia, Australia, Austria, Azerbaijan, Bahrain, Barbados, Belarus, Belgium, Belize, Benin, Bosnia and Herzegovina, Botswana, Brazil, Brunei Darussalam, Bulgaria, Burkina Faso, Cambodia, Cameroon, Canada, Central African Republic, Chad, Chile, China, Colombia, Comoros, Congo, Costa Rica, Côte d'Ivoire, Croatia, Cuba, Cyprus, Czech Republic, Democratic People's Republic of Korea, Denmark, Djibouti, Dominica, Dominican Republic, Ecuador, Egypt, El Salvador, Equatorial Guinea, Estonia, Finland, France, Gabon, Gambia, Georgia, Germany, Ghana, Greece, Grenada, Guatemala, Guinea, Guinea-Bissau, Honduras, Hungary, Iceland, India, Indonesia, Ireland, Iran (Islamic Republic of), Israel, Italy, Japan, Jordan, Kazakhstan, Kenya, Kuwait, Kyrgyzstan, Lao People's Democratic Republic, Latvia, Lesotho, Liberia, Libya (State of), Liechtenstein, Lithuania, Luxembourg, Madagascar, Malawi, Malaysia, Mali, Malta, Mauritania, Mexico, Monaco, Mongolia, Montenegro, Morocco, Mozambique, Namibia, Netherlands, New Zealand, Nicaragua, Niger, Nigeria, Norway, Oman, Panama, Papua New Guinea, Peru, Philippines, Poland, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Saint Kitts and Nevis, Saint Lucia, Saint Vincent & the Grenadines, San Marino, Sao Tome and Principe, Saudi Arabia, Senegal, Serbia, Seychelles, Sierra Leone, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sudan, Swaziland, Sweden, Switzerland, Syrian Arab Republic, Tajikistan, Thailand, The former Yugoslav Republic of Macedonia, Togo, Trinidad and Tobago, Tunisia, Turkey, Turkmenistan, Uganda, Ukraine, United Arab Emirates, United Kingdom, United Republic of Tanzania, United States of America, Uzbekistan, Vietnam, Zambia, Zimbabwe.

(As at date of publishing).

International patent application



Patent questionnaire

This questionnaire is intended to elicit sufficient information to enable us to prepare a patent specification for the invention. The patent specification must not only describe the invention in sufficient detail to enable a person of ordinary skill to put it into effect, but should also identify the new and advantageous features of the invention. Although you may be familiar with the invention, please bear in mind that future readers of the patent specification, such as Patent Examiners, may not have the benefit of your background knowledge and expertise. Please answer any applicable questions as fully as possible. Your cooperation in providing the required information will also assist in minimising costs.

1. What is the intended function, purpose or object of the invention?
2. What are the advantages of your invention? [Please list them in the order of importance.]
3. Please provide a written description of your invention and its operation, including drawings or sketches (if applicable). Please provide a duplicate set of drawings or sketches with parts of the invention labelled. [The description should be sufficient for a person of ordinary skill in the relevant field, not an expert, to put it into effect. Features which are already known need not be described in detail. However, you should clearly describe the features of your invention which you consider to be new and advantageous.]
4. What are the features (physical or functional) of your invention which result in the advantages mentioned in question 2?
5. Are there any possible variations or modifications of the invention, or parts thereof, which you would also like protected?
6. Are you aware of any similar apparatus or process (relevant "prior art")? If so, please provide details of the prior art known to you, and describe any disadvantages or problems associated with the prior art that your invention overcomes.
7. Please clarify in what form/s the invention is to be commercialised – e.g. product, assembly, kit of parts, or manufacturing, testing or other type of process.
8. List the countries in which you are likely to require patent protection.
9. Has the invention been disclosed publicly, e.g. by public display, sale, advertising, description in published document, etc.? (If yes, please provide details.)
10. Has the invention been used commercially? (If yes, please provide details.)
11. Please provide the full name, residential address, and citizenship of each inventor. If there are two or more co-inventors, please identify the respective contribution of each inventor (if possible).
12. In whose name will the patent application be filed? In other words, who owns the rights to the invention? (Please provide full name, address and ACN, if applicable.)
13. If the patent applicant is different from the inventor(s), how did the applicant derive the rights to the invention from the inventor(s)? For example, was the invention made for the applicant by the inventor(s) in the course of his/her/their employment with the applicant, or was the invention otherwise assigned from the inventor(s) to the applicant? If a contractor was involved, please make this known to your attorney!]
14. If the applicant is different from the inventor(s), we recommend that there be a written assignment from the inventor(s) to the applicant (even if the invention was made in the normal course of employment). Do you wish us to prepare an assignment document? [Charges apply.]
15. Regardless of whether or not your invention is patentable, its use in the marketplace may infringe the registered rights of a third party. To minimise this risk, a freedom to operate search should be conducted in each country of interest. Would you like us to conduct a freedom to operate search?
16. Is the invention to be marketed under a brand (trade mark)? If so, what is the trade mark?



480+
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190+
IP professionals

25+
Countries

10
Offices

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