

AUSTRALIAN PATENT PRACTICE

PROSECUTION – TIPS AND STRATEGIES



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1. INTRODUCTION

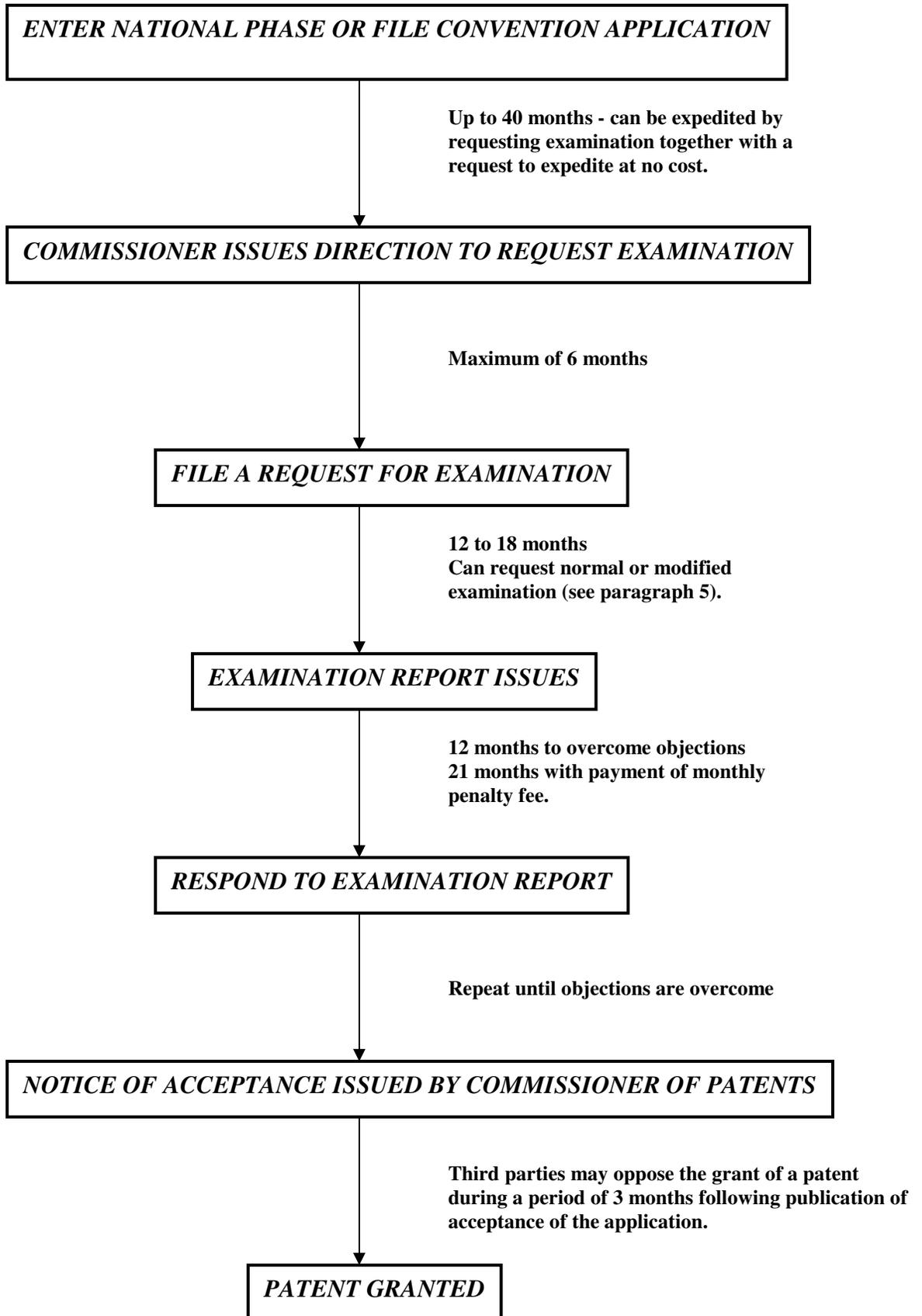
This article is based on part of a presentation that I delivered to various firms and corporations in Silicon Valley and also at a June 2006 conference hosted by the American Bar Association's Intellectual Property Section in Boston. The purpose of the presentation was to provide some tips and strategies for expediting patent grant and for obtaining early patent enforcement in Australia.

I briefly explain our prosecution procedure. I then describe our remarkable innovation patent system and how it can be used to enforce patent rights in Australia during prosecution of a parent standard patent application. We also have a "modified examination" procedure in Australia which can be used to expedite grant of a patent.

2. THE PROCESS

2.1. A flow chart

On the following page is a flowchart that sets out our national phase procedure from entry to grant of a patent.



2.2. Minimal Documentation

All we require for national phase entry is the PCT application number or the International Publication (WO) number. There are no forms to be signed by the inventor/s or assignee/s

It is necessary for a Notice of Entitlement to be lodged in support of the application. We can sign that document, but it must reflect how the applicant has obtained the right to file the application. In other words, the Notice of Entitlement must set out the chain of ownership of the invention. We require copies of any Deeds of Assignment that may have been executed so that the Notice of Entitlement can be filled in correctly. This is a very important step and the consequences of being careless or inattentive can be significant.

2.3. Conforming Amendments

National phase in Australia must be entered with the specification in the international form. However, as soon as the application has entered the national phase, we recommend amendments to bring it into conformity with Australian patent practice. The following amendments should be made:

- (a) Replace “comprise” with “include” in the claims. Our courts have given the word “comprise” a narrow dictionary definition as opposed to the broader definition it has in the United States and elsewhere. It follows that by making this amendment, we can ensure that the scope of the claims is as broad as it would be in the United States.
- (b) Add multiple dependencies. In Australia, multiple dependencies do not generate extra claims for the purpose of fees.
- (c) Paraphrase the claims in the “Summary of the Invention”. In Australia, we have a relatively strict “fair basis” requirement. That requirement is similar to the requirement in the United States that there should be basis for claim terminology in the disclosure. Our courts have held that the “Summary of the Invention” in the specification can provide the necessary “fair basis” requirement.

3. OUR REMARKABLE INNOVATION PATENT SYSTEM

3.1. Low Innovative Step Bar with Broad Scope

Our Patents Act provides for an innovation patent. The innovation patent is remarkable because it can provide protection as broad as a standard patent, without the need for compliance with an inventive step requirement. Rather, compliance with an “innovative step” is required. If the novelty-conferring feature of the innovation makes a substantial contribution to the working of the innovation, the innovative step requirement is met. This

requirement is clearly much easier to meet than the inventive step requirement of a standard patent.

3.2. Reduced Options for Defending an Infringement Action

Usually a defense to an infringement action is a counterclaim for revocation of a patent on one or more invalidity grounds. With standard patents, one of the grounds is almost always a lack of inventive step. Since the innovative step requirement is much less onerous than the inventive step requirement, the chances of success in a revocation counterclaim could be significantly reduced when enforcing an innovation patent.

3.3. Certification Required for Enforceability

When an application for an innovation patent is filed, the innovation patent is granted without substantive examination. This takes as little as a month. However, in order to be enforceable, it is necessary to request certification of the innovation patent. This can be done at any time during the life of the patent.

The process of certification includes an examination of the innovation patent. If the Examiner is satisfied that the innovation complies with the requirements of novelty and innovative step, the Examiner will issue a Certificate of Examination. Certification can take as little as three or four months and, if successful, the innovation patent will be certified and enforceable.

3.2. Early Enforcement of Patent Rights

It is possible to file a divisional application for an innovation patent from a standard patent application. This is useful if the Applicant wishes to enforce patent rights before the standard patent is granted, due to the relatively quick prosecution of the innovation patent application.

Provided the alleged infringement can be described in the specification of the parent application, the claims of the innovation patent can be crafted to capture the infringement. This is an extremely effective tool and we have used it on a number of occasions to enforce clients' patent rights during prosecution.

3.3. Overcoming Prosecution Difficulties

It is possible to convert an application for a standard patent to an application for an innovation patent. As a result, if there are difficulties with prosecuting a standard patent application, it can be converted to an innovation patent application. Upon conversion, certification should be easier to achieve than acceptance of the standard patent application.

3.4. Disadvantages of the System

An innovation patent has a life of 8 years from the date of filing the application. In the event that the patent is derived from a PCT application, the date of filing would be the date of filing the PCT application.

Only 5 claims are permitted for an innovation patent. However, these claims can be independent claims.

4. THE DUTY TO PROVIDE SEARCH RESULTS

4.1. Only Search Results of Patent Examiners

It is compulsory to provide search results in Australia. However, these are only results of searches carried out by Patent Examiners examining corresponding applications. Where a jurisdiction provides a search report that indicates the relevance of the results, such as the European Patent Office, then that search report should be submitted.

4.2. Deadlines

The deadline for providing search results is the later of 6 months from the date of requesting examination and 6 months from the date on which the search was completed.

4.3. Penalty not as Severe as United States

Unlike the situation in the United States, if the applicant neglects to provide a particular search result, revocation of the patent does not necessarily follow. Rather, if an application for revocation of the patent is made, for example in a counterclaim during an infringement action, it would not be possible for the patentee to amend the claims to avoid a ground for revocation if that ground depends on that particular search result.

5. THE MODIFIED EXAMINATION OPTION

5.1. Corresponding Patent Must be Granted

If a patent corresponding to the Australian patent application has been granted in either Canada, the countries of the European Patent Convention, New Zealand or the United States, then it is possible to request modified rather than normal examination of the patent application.

5.2. No Substantive Examination

If modified examination is requested, the application is not substantively examined. It follows that acceptance will follow relatively quickly thereby expediting prosecution.

5.3. No Need to Provide Search Results

It is not compulsory to provide search results if modified examination is requested.

5.4. Warning – Specification Must Conform to Granted Patent

It is a condition for modified examination that the specification of the Australian patent application must be amended, if necessary, to conform exactly to the specification of the granted patent. This means that it would not be possible to make the amendments described in paragraph 2.3 above to bring the specification into conformity with Australian patent practice. This may be a significant disadvantage.

As a matter of practice, we do not usually recommend that modified examination be requested because of the above disadvantages. However, there may be special cases where grant of the patent is needed as soon as possible, and modified examination can be a useful tool to speed up prosecution and ensure grant of the patent.

6. A FINAL WORD

Patent prosecution is a simple and relatively painless procedure in Australia, particularly where formalities are concerned. The Examiners are readily approachable and are always willing to have a telephone conversation without the need for setting up an appointment.

The innovation patent system is particularly useful for early enforcement of patent rights and is unique in the sense that the protection afforded by an innovation patent can be as broad as that of a standard patent.

In a recent audit of a number of our files, we found that the average cost of filing and prosecuting a national phase entry amounts to roughly A\$7000 (US\$5300), all inclusive. We believe that this represents good value considering the size and nature of the Australian economy.