

CHANGES DOWN UNDER

Australia's "Raising the Bar Act" to become effective April 15, 2013

Change is coming not just to patent laws in the US this spring, but to Australia too. On April 15, 2013 Australia will implement the "Raising the Bar Act". The act, intended to increase harmony between the Australian patent system and those of other jurisdictions will eliminate some of the idiosyncratic aspects of the Australian Patent Laws which favored applicants. The act will apply to all applications for which a request for examination is filed on or after April 15, 2013.

Here are the steps you should consider taking:

- If you have a "standard" patent application pending in Australia, you should consider requesting examination now.
- If you have a pending PCT application and you wish to enter Australian national phase, or you have a non-Australian application filed less than one year ago and wish to file a Paris Convention application directly in Australia, you should do so now, and request examination now.
- If you have an "innovation patent" in Australia, you should consider requesting examination now. An Australian innovation patent has no direct equivalent in US patent law, but is similar in some regards to invention "registrations" offered in some other countries. It is quickly issued without an examination, but can be examined upon request by the applicant or by a third party. An Australian

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innovation patent is not enforceable until it is examined and certified by the Australian Patent Office as meeting the requirements for a patent.

- If you have a pending Australian patent application that discloses multiple inventions, you should consider filing divisional applications for the unclaimed inventions and requesting examination now.

The good news is that patent applications drafted in compliance with US practice will generally meet the new Australian requirements. However, if you wait until after April 15 to request examination for an Australian application, you will not be able to take advantage of the current laws and rules that arguably make obtaining a patent easier in Australia than in the US or many other countries.

Here is a quick summary of the most significant changes:

- Acceptance will need to be achieved within 12 months from the date of the first examination report. This includes overcoming all initial objections and all maintained or new objections raised in subsequent office actions. Currently, the initial 12 month period is extendable up to nine months.
- Modified examination will no longer be available. Currently, an Australian specification can be amended to conform exactly with a granted patent in another country, leading in most cases to allowance by the Australian Patent office. No such procedure exists in the US, although the patent prosecution highway is somewhat similar.
- A "search fee" of AU \$1,400 will be applied if a "full" search is required in Australia, i.e. if the application has not already been searched by the PCT or another jurisdiction. (The AU dollar is comparable in value to the US dollar). US search fees are much less, and do not depend on what has been done in other jurisdictions.
- The application will be required to disclose a "specific, substantial and credible use" for the invention, similar to the US "utility" requirement.

- The specification will need to be sufficiently clear and complete for someone skilled in the art to make and use the invention. This is similar to the US “enablement” and “description” requirements.
- Common, general knowledge in any country (not just in Australia) will be considered prior art. This is similar to US practice under the new AIA rules.
- If an Examiner believes that there is a greater than 50% chance that a court would find that a claim lacks inventive step, then the Examiner will reject the claim (currently, the Applicant is given the “benefit of the doubt”). This is similar to current practice in the USPTO and most other jurisdictions.
- It will no longer be possible to amend a specification during prosecution to include matter that was previously only disclosed “in substance.” This arguably is more strict than current US practice.
- Postponement of acceptance will no longer be automatically available. Currently, this practice allows time after the application is allowed to review and make changes before the official allowance, e.g. cancelling claims to reduce excess claim fees.
- Divisionals will be barred beginning three months after acceptance of the application is advertised. In Australia, once an application is accepted there is an opposition period during which a third party can oppose the patent. This change will limit the options for responding to such an opposition.

If you have any questions, please feel free to contact our office and we will be happy to provide more details.
