Australia's response to WIPO Circular C.9260 Pt 1: request for inputs for the preparation of the following documents and a new webpage

(i) A Draft Reference Document on the Exception Regarding Farmers' and/or Breeders' Use of Patented Inventions

The applicable law of Australia does not provide exceptions and limitations to farmers' and/or breeders' use of patented inventions

(ii) Study on Substantive and Procedural Requirements Regarding Voluntary Division of Patent Applications by Applicants.

Section 79B of the *Patents Act 1990* (Cth) ("Patents Act") allows an applicant to divide a standard patent application ("the parent") into two or more applications, and maintain the priority rights of the parent.[1]

To make a divisional application, the parent application for a standard divisional application:

- can be an application for a standard patent or an innovation patent
- may itself be a divisional application
- may be a PCT application
- cannot be a provisional application
- must be in force at the time of filing the divisional (it cannot have lapsed, been refused, or withdrawn).

The divisional application:

- must contain at least one claim that defines an invention that is disclosed in the parent in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art[2]
- must have the same applicant(s) as the parent application[3]
- can be made in respect of two or more different parent applications
- can have different inventors to those of the parent

[1] There are two types of patents in Australia, the 'standard' patent and the 'innovation' patent (similar to a utility model). It is no longer possible to file a new application for an innovation patent. However, an applicant who has filed a patent application before 26 August 2021 (the effective date of Sch 1 Pt 2 of the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2020* (Cth)) may file an amendment to convert that application to an application for an innovation patent or use that application to file a divisional application for an innovation patent. Requirements for a divisional application for an innovation patent may differ (for example, 5.6.10.6 Innovation Divisional Applications | IPA Manuals).

[2] Claims of the divisional not disclosed in a clear enough and complete enough manner in the parent will not be entitled to obtain priority from the parent.

[3] An applicant includes a person entitled to make a request under s 113 of the Patents Act, 'Persons claiming under assignment or agreement'. A correct Statement of Entitlement is required.

- must be filed no later than 3 months from the date of advertisement of acceptance of the parent application, subject to the status of the parent.[4]

There is no provision for filing a divisional application where the parent is already a granted standard patent.

Conversion of application to a divisional application

Before or during examination, an applicant may seek to amend a patent request to convert an application to a divisional application (under s 104 of the Patents Act). However, an amendment to convert an application to a divisional application is not allowable:

- if the parent was filed after the application to be converted to a divisional
- after it has been accepted
- after the period in which the application could have been filed as a divisional application.

The patent request must indicate that the application is a divisional application under s 79B and state the number of the parent application.

Grant of multiple applications of the same invention

Section s 64(2) of the Patents Act prevents double patenting by prohibiting grant upon a standard application where the application claims an invention that is the same as an invention that is the subject of another patent and made by the same inventor with the same priority date.

This also applies to divisional applications and their respective parent applications, as well as to unrelated applications. For innovation patents objections based on s 101B apply equally to divisional applications, as well as unrelated applications.

PCT applications

A PCT application which designates Australia can be a parent application for a divisional application, whether it enters national phase in Australia or not provided the PCT application has not lapsed, been refused, or withdrawn at the time the divisional application is made.

[4] In limited circumstances an application may be converted to a divisional application, even though the parent has lapsed. (see 5.6.10.5 Issues specific to the Examination of Divisional Applications).

(iii) Document updating Sections V and VI of Annex to document SCP/35/7 (Artificial Intelligence (AI) and Inventorship).

- Section V: National/Regional Legal Frameworks Regarding the Concept of Inventorship.
- Section VI: The "DABUS" Case. The inputs may also include information regarding new cases and decisions on AI as an inventor.

We refer to our response to c.9199 *(iii) compilation of laws and practices relating to the patentability of artificial intelligence (AI)-related inventions (update of document SCP/30/5)*:

> On the issue of AI inventorship, the court decisions on the DABUS applications have illustrated that the increasing use of artificial intelligence in innovation is bringing unique challenges to the IP system.
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> In April 2022, the Full Federal Court of Australia ruled that an AI cannot be named as an inventor on a patent application overturning a previous decision allowing an AI to be designated as an inventor of an Australian patent application. The High Court of Australia has denied further appeal, meaning the decision of the Full Court is final.
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> The DABUS decision is discussed in IP Australia's Patent Manual of Practice and Procedure 5.4.3 Artificial Intelligence - Inventorship and Entitlement | IPA Manuals (ipaustralia.gov.au), making it clear that a human inventor is required. The principles for considering human inventorship are summarised in the manual at 7.2.8.5 Relevant Law - Entitlement/Inventorship | IPA Manuals (ipaustralia.gov.au).
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> Australia continues to explore policy issues at the intersection of AI and IP (for example, Generative AI and the IP System (ipaustralia.gov.au)). Accordingly, we welcome further discussions on AI and IP issues, including inventorship within SCP, to examine emerging issues and build a common understanding of them towards adopting standard approaches where possible.

On the issue of patentability of AI-related inventions in a subject matter sense, we consider that AI-related inventions are generally a subset of computer implemented inventions. The principles for such inventions have been laid out in recent court decisions as discussed in our Patent Manual of Practice and Procedure (5.6.8.6 Computer Implemented Inventions, Mere Schemes, and Business Methods | IPA Manuals (ipaustralia.gov.au)). Australian courts have yet to consider an invention including or using AI, but patentability is generally found where there is some technical solution provided to a technical problem. Following these principles, where AI is improved in a material or technical manner or AI is used to address a technical problem, patentability may be found.

(iv) Compilation of legislative and policy measures adopted by Member States relating to Standard Essential Patents to be presented on a dedicated page of the SCP website

Australia does not have existing legislative measures in relation to Standard Essential Patents.