IP Australia – Response to Circular 8261 of 19 April 2013.

Exceptions and limitations to patent rights

Australia has recently introduced an infringement exemption for use of a patent that is solely for the purpose of gaining regulatory approval for a product, method or process in Australia or overseas (Section 119B of the Patents Act 1990). This change effectively expands the pre-existing exemption (which was limited to pharmaceutical inventions) to all technologies; recognising that technologies other than pharmaceuticals may also suffer delays in bringing products to market as a consequence of lengthy pre-market and pre-manufacturing regulatory approval processes.

Australia has also recently introduced an infringement exemption (Section 119C of the Patents Act 1990) aimed at drawing a clear line between research and commercial activities, leaving researchers free to conduct their experiments without fear of prosecution in relation to patent infringement. The intention of this exemption is to give broad and clear protection to research and experimental activities in order to maximise the potential for research and innovation in Australia.

While this updated information is reflected in *Revised Annex II of document SCP/12/3 Rev.2: Report on the International Patent System;* the initial questionnaire at *http://www.wipo.int/scp/en/exceptions/* does not reflect the change to Australia's laws. IP Australia requests that the questionnaire also be updated.

Quality of Patents

Australia is addressing the quality of patents on a number of fronts, including through legislative reform (Intellectual Property Laws Amendment (Raising the Bar) Act 2012), quality management of patent processes, and a range of work sharing programs as outlined below.

Australia considers that effective work-sharing helps to further eliminate duplication of work among Offices, and can lead to an enhancement of both patent examination efficiency and quality.

IP Australia encourages examiners to efficiently use the work products of the international phase and the work products established by other Offices in the national phase. Examiners rely on the information only to the extent possible and as applicable under Australian law, and may perform further work as necessary.

Australia is also involved in a large number of initiatives related to work sharing, including the:

- Patent Cooperation Treaty (PCT);
- Vancouver Group Mutual Exploitation;
- WIPO CASE; and
- the Patent Prosecution Highway (PPH).

Australia considers the PCT as the cornerstone of the international patent system and provides an established framework for work sharing. Examination work conducted in the international phase has the potential to significantly reduce the effort required to process applications under national patent granting procedures. Australia further considers that the most optimal efficiencies in quality and work reduction are to be gained by improving the quality and usefulness of the search and examination reports established under the PCT.

Australia is involved in the Vancouver Group which was established in 2008 and is made up of the IP Offices of Australia, Canada and the United Kingdom. The aim of the Vancouver Group is to share information and experiences on common issues and areas relevant to managing a mid-sized national IP office, and to contribute to a more effective multilateral approach to work sharing in a manner that supports the principles of the PCT.

WIPO Centralized Access to Search and Examination (CASE) is an online platform which enables patent offices to securely share search and examination documentation related to patent applications. WIPO CASE was initially developed by the International Bureau in response to a request from the Vancouver Group offices. Since March 2013, any patent office may join the system simply by notifying the International Bureau that it is willing to participate according to the Framework Provisions of the system (http://www.wipo.int/case/en/).

Australia is currently participating in a PPH pilot arrangement with the USTPO, and has done so since 2008. Under the PPH, an applicant can request accelerated examination in an office if another office has already determined that one or more claims in a related application is allowable.

Confidentiality of communication between clients and their patent advisors.

Many patent applicants hold global patent portfolios, including a number of patents for the same invention in different jurisdictions. This means that a dispute in relation to a single invention may be prosecuted simultaneously in a number of different jurisdictions. It is not always desirable or practical for parties to such disputes to limit their requests for advice to Australian patent attorneys.

The Australian Government recognised that legislative changes were needed to afford a client of a non-lawyer patent attorney certainty in relation to confidentiality of intellectual property advice both in Australia and overseas. Furthermore, the privilege applicable to clients of non-lawyer patent attorneys should also apply to their communications with suitably accredited overseas non-lawyer patent attorneys.

New provisions in Australia (Section 200 of the Patents Act 1990) expand the definition of 'patent attorney' for the purposes of privilege to include, in addition to Australian registered patent attorneys, an individual authorised to do patents work under the law of another country or region.

Subsection 200(2) of the Patents Act has been revised as follows:

> (2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way,

and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client.

(2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.

(2B) A reference in subsection (2) or (2A) to a registered patent attorney includes a reference to an individual authorised to do patents work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided.

(2C) ***Intellectual property advice*** means advice in relation to:

(a) patents; or
(b) trade marks; or
(c) designs; or
(d) plant breeder's rights; or
(e) any related matters.

Key points:

- Patents work is defined as work in relation to patents or patent applications done, on behalf of someone else, for gain. The intention is that the privilege provision captures communications between clients and foreign intellectual property professionals who are authorised to perform work similar to the work done by their Australian counterparts. This will include not only persons authorised under the law of a nation state, but also persons registered under an international treaty, such as Article 134 of the *European Patent Convention 1973*, which authorises persons to do patents work before the European Patent Office.
- The scope of the privilege is limited to the scope of a person's authority to perform the work in their home country or region.
- The communication, record or document must be made for the 'dominant' purpose of a patent attorney providing intellectual property advice to a client in order for the communication, record or document to attract the privilege.
- The definition of 'intellectual property advice' in subsection 200(2) limits the scope of privilege to only those fields in which patent attorneys have specialist qualifications and knowledge.

Dear Sir/Madam,

Referring to note C. 8261 dated 19 April 2013, Australia proposes the following amendments to the information concerning certain aspects of national/regional patents laws, available at http://www.wipo.int/scp/en/annex_ii.html. The amendments reflect changes to Australian patent law, which commenced on 15 April 2013.

(1) Prior Art

Marked up

Country	Prior Art
Australia	1. Information from documents made publicly available or information made publicly available through doing an act before the filing date (priority date), whether in Australia or elsewhere. 2. For deciding whether an invention is novel, information contained in ~~a subsequently published~~an Australian patent application (including all international applications) published on or after the priority date with an earlier filing date (priority date), if the information was ~~also~~ contained in the application at its filing date.

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(2) Novelty

Marked up

Country	Novelty
Australia	The invention is novel when compared with the prior art. The prior art consists of information from documents or acts publicly available before the filing date (priority date), whether in Australia or elsewhere and information contained in ~~a subsequently published~~an Australian patent application (including all international applications) published on or after the priority date with an earlier filing date (priority date), if the information was ~~also~~ contained in the application at its filing date.

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Country	Novelty
Australia	The invention is novel when compared with the prior art. The prior art consists of information from documents or acts publicly available before the filing date (priority date), whether in Australia or elsewhere and information contained in an Australian patent application (including all international applications) published on or after the priority date with an earlier filing date (priority date), if the information was contained in the application at its filing date.

(3) Inventive Step (Obviousness)

Marked up

Country	Inventive Step (Obviousness)
Australia	The invention is not obvious to a person skilled in the relevant art in the light of the common general knowledge in Australia or elsewhere when compared with the prior art. The prior art consists of information from documents and acts publicly available before the filing date (priority date), whether in Australia or elsewhere~~, so long as the skilled person would have ascertained, understood and regarded it as relevant~~.

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Country	Inventive Step (Obviousness)
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(4) Grace Period

Marked up

Country	Grace Period
Australia	1. Disclosure not to be taken into consideration in determining novelty and inventive step if it occurred: (a) within six months before ~~the filing date (priority date)~~the filing of a provisional or basic application provided a complete application is filed within 12 months from filing of the provisional or basic application; or otherwise within 12 months before the filing of a complete application (i) by showing, use or publication of the invention at a recognized exhibition; (ii) in a paper written by the inventor and read before, or published with the inventor's consent by or on behalf of, a learned society; (b) within 12 months before ~~the filing date (priority date)~~the filing of a provisional or basic application provided a complete application is filed within 12 months from the filing of the provisional or basic application; or otherwise within 12 months before the filing of a complete application by working the invention in public for the purposes of reasonable trial due to the nature of the invention; (c) within 12 months before the filing ~~date~~ of a complete application in Australia with the consent of the nominated person, patentee or predecessor in title or without consent and the information disclosed was derived from the patentee or predecessor in title; (d) at any time before the filing date, if the information disclosed was given by or with the consent of the patentee or predecessor in title, to the Commonwealth or a State or Territory, an authority thereof or person authorized thereby, to investigate the invention; and anything done for the purpose of such investigation. 2. In the cases of 1.a.(i), the applicant shall: (a) when filing the application, state that the invention has been disclosed at the exhibition; (b) before the publication of the application, file a statement issued by the exhibition authority.

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Country	Grace Period
Australia	1. Disclosure not to be taken into consideration in determining novelty and

	inventive step if it occurred: (a) within six months before the filing of a provisional or basic application provided a complete application is filed within 12 months from filing of the provisional or basic application; or otherwise within 12 months before the filing of a complete application (i) by showing, use or publication of the invention at a recognized exhibition; (ii) in a paper written by the inventor and read before, or published with the inventor's consent by or on behalf of, a learned society; (b) within 12 months before the filing of a provisional or basic application provided a complete application is filed within 12 months from the filing of the provisional or basic application; or otherwise within 12 months before the filing of a complete application by working the invention in public for the purposes of reasonable trial due to the nature of the invention; (c) within 12 months before the filing of a complete application in Australia with the consent of the nominated person, patentee or predecessor in title or without consent and the information disclosed was derived from the patentee or predecessor in title; (d) at any time before the filing date, if the information disclosed was given by or with the consent of the patentee or predecessor in title, to the Commonwealth or a State or Territory, an authority thereof or person authorized thereby, to investigate the invention; and anything done for the purpose of such investigation. 2. In the cases of 1.a.(i), the applicant shall: (a) when filing the application, state that the invention has been disclosed at the exhibition; (b) before the publication of the application, file a statement issued by the exhibition authority.

(5) Sufficiency of Disclosure

Marked up

Country	Sufficiency of Disclosure
Australia	An application shall: 1. ~~describe the invention fully~~disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; 2. include the best method known to the applicant of performing the invention.

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(6) Exclusions from Patentable Matter

No change

Country	Exclusions from Patentable Matter
Australia	1. Matter that is not a "manner of manufacture". This generally includes: (a) Discoveries and abstract ideas (b) Aesthetic creations

	(c) Schemes, rules and plans 2. Humans and the biological processes for their generation.

(7) Exceptions and Limitations of the Rights

No change

Country	Exceptions and Limitation of the Rights
Australia	1. Certain uses concerning foreign vessels, aircraft and land vehicles which temporarily or accidentally enter national territory. 2. Continued prior use by person who, at the filing date (priority date), was using the invention in Australia independently of the patent owner or his predecessor in title, or was taking definite steps for that purpose. 3. Acts for obtaining regulatory approval for pharmaceuticals and non-pharmaceuticals. 4. Acts for experimental purposes. 5. Compulsory licenses where necessary to meet reasonable requirements of the public or to remedy other anti-competitive practices, subject to remuneration. 6. Exploitation or acquisition by the Commonwealth where necessary for the proper provision of services or in the interest of national security, subject to remuneration.