

## Re-examination systems

### Australia

Chapter 9 of the Patents Act 1990 provides for re-examination of applications for standard patents and granted standard patents under certain circumstances. Re-examination of certified innovation patents is also provided for in Chapter 9A, under Section 101G.

The grounds for re-examination are novelty, inventive (innovative) step, usefulness, manner of manufacture, disclosure, clarity, support and patentable inventions. The procedure is *ex parte*, i.e. between the Commissioner and the patentee or applicant. The person who requests re-examination has limited opportunity to submit evidence and be heard during the process.

The options for initiating re-examination depend on the stage of the patent cycle. At any time between acceptance of a standard patent application and grant of the corresponding patent, only the Commissioner can initiate re-examination. This may happen due to an adverse finding of an internal quality review, the emergence of new prior art (whether as a result of a Section 27 notice, or from other sources), or in response to a withdrawn opposition. At any time after grant of a standard patent or certification of an innovation patent, the patentee, any third party, or a court may request re-examination. The Commissioner can also initiate re-examination without an external request.

The Commissioner will instigate re-examination voluntarily only if intending to issue an adverse re-examination report. In contrast, the Commissioner must re-examine where a patentee or third party requests re-examination, regardless of whether the report is adverse or not. The applicant or patentee has the opportunity to respond to any adverse report through amendments and/or submissions and if the adverse findings are not resolved, the Commissioner has the power to refuse an application or revoke a patent.

The applicant or patentee may appeal to the Federal Court against a decision of the Commissioner, according to Subsections 100A(3), and 101(4) and 101J(5), respectively.