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Working Group on Multiple Invention Disclosures and Complex Applications

General Comments

Australia welcomes the establishment of a working group on multiple invention disclosures and complex applications. The difficulties associated with such applications will be familiar to all searching and examining authorities and offices (IPO's) and, although the impact of those problems may vary, they are of sufficient importance to warrant the development of internationally consistent solutions both in the context of the PCT and the SPLT.

We believe that the issues should be considered from two distinct perspectives:

1. What is the requirements of unity and claim structures that satisfy the fundamental purposes of the patent system including the need of patent applicants and third parties?
2. What mechanisms or practices are necessary to ensure the efficient operation of IPO's, particularly in relation to searching and examination?

In our view the confusion of these issues has led to the development of complex rules and procedures which ultimately have not served the interests of IPO's or users of the system. For example, Australia is aware that the strict application of unity rules, so as to ensure adequate revenue recovery, often has a number of negative impacts including:

- Applicants file continuation or divisional applications which are a considerable extra expense for the applicant and an administrative burden on the system. Aside from the effort of processing and publication of additional applications, any efficiencies that may have been gained through the examiner's familiarity with the additional inventions is usually lost.
- Applicants are dissuaded from seeking patent protection on inventions that may ultimately prove economically significant.
- Examiners spend considerable time in reporting on lack of unity, and in issuing invitations for additional fees, which may be better expended on substantive search and examination. Similarly, in the PCT context, consideration of protests takes up valuable time.
- Inventions that are not searched by the ISA under the PCT often have to be searched independently in the national phase. Thus additional work may be avoided by the ISA but it is merely moved to the designated offices in a way that encourages duplication of effort. Non-examining designated offices are faced with claims that have neither been searched or examined under the PCT.

Consequently, Australia hopes the working party will take a broad view and seek innovative solutions that are beneficial to the patent system as a whole.

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Procedural Matters

Australia fully supports the use of the SCP electronic forum as a means of progressing the Working Group's agenda, particularly for sharing information between sessions of the Standing Committee.

As to the progress of its deliberations, it would seem unfortunate for the Working Group to arrive too quickly at positions either *pro* or *anti*-PCT or in favour some other existing unity practice. We believe the Working Group should focus on the nature of the problem from the perspective of both IPO's and applicants and then consider options for addressing those problems.

Issues- Unity of Invention

Australia is of the view that the fundamental (rather than administrative) needs of the patent system can be met by a simple unity of invention requirement that limits the claims of an application to a single general inventive concept or possibly even two or more closely related inventive concepts, as is apparent on the face of the application. As to what constitutes a single general inventive concept or closely related concepts still requires a somewhat subjective analysis but the objective should be a test that is simpler to apply than either the "special technical features" test or alternatives such as "independent and distinct" that are currently employed in various jurisdictions.

While under the PCT and in many national systems, including Australia, unity is determined in reference to a common advance over the prior art, we question the value of such an open ended test and in fact it is our experience that under the PCT *a posteriori* unity considerations are rarely pursued and normally only in relation to the broadest claims. We believe the unity assessment should be made *a priori* on the face of the specification with "special technical features" or other indicator of relationship being determined only with reference to the description.

It is apparent that the complexity of the existing tests for unity of invention and the rigidity of their enforcement are tied to IPO's seeking to limit the work they do or to ensure a commensurate revenue return for the work performed. A simpler requirement should be achievable if IPO's are able to addressing these issues through changed charging practices. For example, charging for search work on the basis of the resources consumed as practiced by most commercial searching agencies.

Hence detailed analysis as to whether what is claimed is a single general inventive concept becomes less critical and the question is what is the scope of the matter (within a single general inventive concept) which the applicant is prepared to pay to have searched. Procedurally, such a system could operate on the basis of the searching authority or IPO providing a notification as to the existence of a single general inventive concept (or otherwise) and a quote for the extent of searching required by the claims, including possibly the results of a quick preliminary search. In response, the applicant could either accept the quote, amend the claims or seek detailed reasons under a revised protest mechanism.

We believe it is also important to consider under this heading the effect of excluding subject matter from an international search which nevertheless remains in the application and is available for consideration in the national phase. Clearly the applicant benefits from this but subject matter that is required to be searched for the first time by designated offices raises the possibility of duplication of effort and work shifting as mentioned previously. Therefore we invite the Working Group to consider whether a problem indeed exists in this regard and, if so, how it may be addressed.

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Issues - Linking of claims; Number of claims; "clear and concise"; Complex applications

In general Australia does not support rules that seek to arbitrarily constrain the number of claim or the structure of the claims so long as the scope of the monopoly sought is clear. In particular it is incorrect in our view to interpret "clear and concise" with workload considerations in mind. A claim set may be complex and may require time and effort to appreciate fully but may, for all that, be perfectly clear to a person skilled in the field of the invention (an issue judicially considered recently in *Doric Products Pty Ltd v Lockwood Security Products Pty Ltd*. [2001] FCA 1877).

Again we believe that the issues of revenue return can be addressed by considering how IPO's charge for examination and searching services rather than by interfering with the ability of the applicant to define the scope of protection in a way that best meets its commercial interests and meets the fundamental, rather than administrative, requirements of the patent system.

In relation to complex applications generally, Australia's experience has been that dialog with applicants over the scope of the search conducted has usually proven beneficial in reducing unnecessary searching and assisting the applicant to refine their needs. For this reason we support arrangements which would give applicants greater involvement in the process.

We believe that approaches which have been developed for complex cases, such as one search fee per 10 (or a reasonable number) of nucleotide sequences, are recognition that the significant issue to address is one of consideration for work performed and not unity law *per se* and are a pointer to more flexible arrangements which the Working Group may wish to consider in future.