

Proposed amendments to Australian patent law: Obviousness

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In brief

- A Bill to amend Australia's patent law is currently being considered, and is intended for implementation in early to mid 2012.
- The Bill proposes a number of changes to Australian patent law, including changes to inventive step (obviousness).

Overview of proposed changes to obviousness

The intention of the legislature is to raise the obviousness standard of Australian patents to be more consistent with the standards of other major jurisdictions. This is to be realised through legislative changes that will effectively expand the prior art base and common general knowledge relevant to testing obviousness.

Expanded prior art base

Under the current law, obviousness prior art is limited to documents or acts that the skilled person could be reasonably expected to have **ascertained, understood** and **regarded as relevant**. Where the evidence shows that prior art does not meet each of these criteria, the art cannot be used for testing obviousness.

The proposed legislation expands obviousness prior art base to remove the explicit language of 'ascertain', 'understand' and 'regard as relevant' from the statute. According to the Explanatory Memorandum, however, this is not intended to result in all prior art information being axiomatically available for obviousness. While a skilled person will be deemed to be **aware** of all publicly available prior art information, such information may still be excluded from obviousness considerations if it can be shown that the skilled person could not have appreciated its relevance.

Expanded common general knowledge

Under the current law, obviousness is assessed in light of the common general knowledge (a subset of public knowledge) of the skilled person **as it existed in Australia** at the priority date.

The proposed legislation expands the common general knowledge to include knowledge of the skilled worker as it existed anywhere in the world at the priority date.

Inclusion of prior use information during examination

The prior art base in Australia includes information made publicly available through doing an act (prior use) or publication anywhere in the world. During examination, however, the Commissioner has been statutorily barred from taking account of prior use information when assessing obviousness (and novelty).

Under the proposed amendments this bar is to be removed, and the Commissioner will be able to consider all prior art information during examination.

Application of proposed amendments

Once the amendments come in to force, it is expected that the amendments relating to obviousness will apply to complete patents and applications:

- having an Australian filing date on or after the date of commencement, or
- on which no examiner's report has issued prior to the date commencement.

Practical implications

With the proposed changes to the prior art base and common general knowledge, it seems reasonable to expect that Australian applicants will find obviousness more challenging. In many cases, however, the Australian Patent Office's practice of relying on the prosecution of corresponding US/European patent applications may result in there being limited real change in this regard.

Further, the requirement to assess the claimed invention in light of the common general knowledge is to remain. Even with the expanded prior art base, therefore, obviousness is unlikely to be found where it can be shown that the common general knowledge teaches away from the teaching of the prior art.

For further information on these developments, the Exposure Draft of the Explanatory Memorandum for the Bill can be found on the IP Australia website.¹

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Endnotes

1. Exposure Draft of the Explanatory Memorandum for the Bill

More information

For information regarding possible implications for your business, contact



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