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*Practice Group(s):
IP Procurement and
Portfolio
Management*

Major Changes to Australian Patent Law – Act Now to Benefit From Current Law

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Summary

On 15 April 2013, the bulk of 'Raising the Bar' amendments to the *Australian Patents Act* come into effect. These amendments will change Australian patent law significantly by raising patentability and specification description requirements.

All patent applications filed after 15 April 2013, plus all pending applications where examination is not requested before that date, will be examined against higher, more stringent validity standards.

There is a window for patent applicants to enable the current law to apply to new or pending patent applications. This can be taken advantage of if applicants request examination on pending Australian patent applications, or file any new applications together with an examination request, before 15 April 2013.

Key changes

The amendments make the following key changes:

- broadening the knowledge base for obviousness by removing the geographical limitation that only common general knowledge 'in Australia' can be used when assessing inventive step
- removing the requirement that prior art documents for inventive step be limited to only those that would have been 'ascertained, understood and regarded as relevant' by the skilled person
- simplifying the test for obviousness by allowing common general knowledge to be combined with one prior art document, or two or more prior art documents that the skilled person could be reasonably expected to have combined
- raising the threshold for written description and enablement by requiring that specifications must describe inventions 'in a manner that is clear and complete enough' for them to be performed by the skilled person
- replacing the requirement that the claims be 'fairly based' on the specification with the requirement that they be 'supported by' the description
- raising the threshold for usefulness (or utility) by requiring that specifications must describe a 'specific, substantial and credible use' for inventions
- expanding the grounds of refusal considered during examination and re-examination to include usefulness and prior use (previously only available during opposition and court revocation proceedings)
- applying the 'balance of probabilities' standard of proof to all grounds of invalidity during examination, thereby replacing the lower 'benefit of the doubt' standard that previously applied to specification and patentable subject matter requirements

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- preventing amendments of specifications to insert matter that extends beyond what was described at the time of filing
- shortening the time to obtain acceptance of an application from 21 to 12 months from the date of the first examination report.

Many of these changes will be familiar to overseas applicants because they are intended to align Australian patent law with other key jurisdictions, such as the US, UK and Europe.

Recommendations

To avoid the application of these significant patent law changes under the 'Raising the Bar' amendments, applicants should consider taking the following steps well in advance of 15 April 2013:

- request examination on pending applications
- file planned or unfiled applications together with an examination request
- for PCT applications due for national phase later in 2013, enter national phase early and request examination at entry
- if PCT applications have not been filed, file Convention applications and request examination at filing
- if provisional applications are due for completion later in 2013, file complete applications early and request examination at filing
- for pending applications describing multiple inventions, file divisional applications and request examination at filing
- for pending applications that would be improved by including additional examples or description, file amendments adding such extra subject matter.

Please contact us in advance of 15 April 2013 to discuss options for your particular Australian patent portfolio.

The above outline covers only a selection of key changes in Australian patent law and practice that will be introduced by the 'Raising the Bar' amendments. We will continue to keep you informed of further developments and considerations under these amendments.

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