

Proposed amendments to Australian patent law: patent re-examination

08 November 2011

In brief

- | Australia, like the US, has had patent re-examination proceedings for some time. And much like has happened in the US, there is now a proposal to change Australian patent re-examination so as to introduce new grounds of invalidity and to change the relevant standard of proof required for validity.
- | As the Australian Patent Office must initiate re-examination if requested to do so (even where there is no substantial new question of validity), these changes are expected to transform Australian patent re-examination proceedings into a powerful weapon for post grant attack.

Law at present

Presently, the Australian legislation limits the grounds of invalidity upon which re-examination can be based to lack of novelty and /or lack of inventive step on the basis of documents published before the priority date of the patent claims in question. Accordingly, the grounds of invalidity available in re-examination are narrower than those available in revocation proceedings in the Federal Court. This disparity may lead to a patent being found to be valid when re-examined by the Patent Office, but subsequently found to be invalid by the Court when the expanded grounds of invalidity available for revocation are considered, potentially making re-examination proceedings less attractive.

On the other hand, the notions of substantial new question of patentability; likelihood of at least one claim being unpatentable; or likelihood that a petitioner would prevail on at least one claim are irrelevant as to whether re-examination may proceed. Simply put, the Commissioner of Patents must re-examine a patent if requested to do so, and it is irrelevant whether, on request, the Commissioner forms the view that an adverse re-examination report would not issue.

Impact of the proposed amendment

The proposed changes to the re-examination provisions, together with the changes proposed to the provisions relating to examination, mean that the grounds of invalidity considered in the re-examination of a standard patent will accord with the grounds considered during substantive examination. Specifically, additional grounds will be able to be considered in re-examination including whether the claimed invention:

- | is a manner of manufacture (i.e. patentable subject matter)
- | is useful (i.e. having specific, substantial and credible utility, and meeting the promise of the invention)
- | has been prior used
- | is adequately described in and supported by the specification, and
- | relates to human beings and/or processes for the generation of human beings.

In addition, it is proposed that the standard of proof in re-examination will be raised to the civil standard of balance of probabilities, (i.e. whether the Commissioner is satisfied that it is more likely than not that the relevant patent is valid on the relevant ground) which brings the standard of proof into line with that applied by the court.

We expect that these proposed changes to re-examination, together with the current obligation on the Commissioner to initiate proceedings when requested to do so, should make re-examination a far more attractive option for attacking patents before the Australian Patent Office. This is particularly the case given that a petitioner who has been unsuccessful in re-examination proceedings will not later be estopped from attacking the patent in revocation proceedings before the court.

For further information on these developments, the Exposure Draft of the Explanatory Memorandum for the Bill can be found on the IP Australia website¹.

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Endnotes

1. Exposure Draft of the Explanatory Memorandum for the Bill

More information

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