

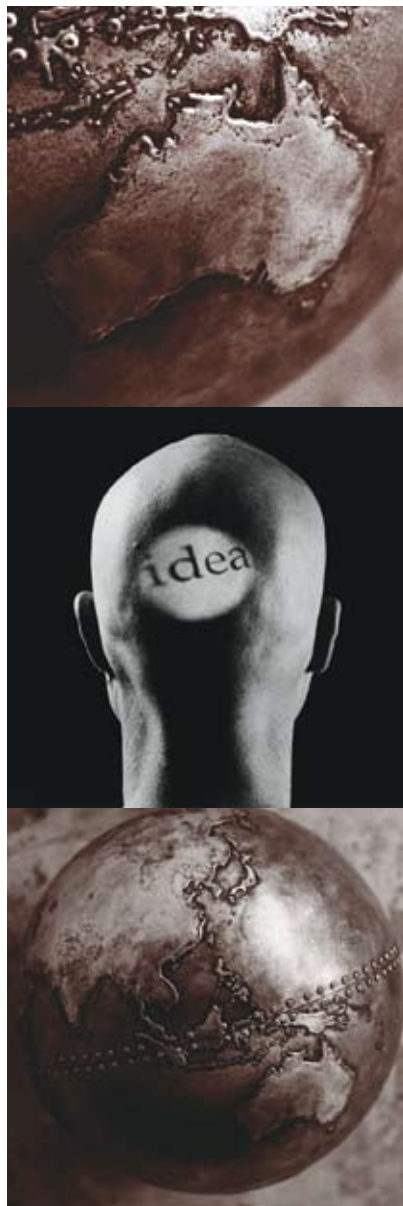


Australian Government

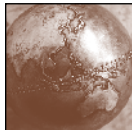
IP Australia

INTERNATIONAL PATENT APPLICATION KIT

Using the Patent Cooperation Treaty (PCT) system



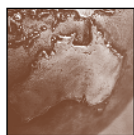
[www.**ipa**ustralia.gov.au](http://www.ipaustralia.gov.au)



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This application kit aims to provide a simple introduction to the Patent Cooperation Treaty (PCT) system for gaining patent protection. It complements IP Australia's other publications such as *The Patents Guide* and *The Patent Application Kit* and we encourage you to read these publications. This kit is designed to help you prepare and file an international patent application under the PCT. It does not cover every issue that may come up and you should not regard this kit as an authoritative statement on the relevant law and procedure. You should also note that the requirements may change from time to time and while we make every effort to ensure the information presented is accurate, you should check the World Intellectual Property Organization's (WIPO) PCT Applicant's Guide before making your application. You can view this guide at www.wipo.int/pct/en or at IP Australia's state offices.



I have an invention and I want the world to know about it!

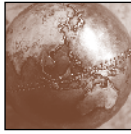
If you are considering making an international application you need to be aware that there is no such thing as a 'world patent'.

An Australian patent provides protection only within Australia. To obtain similar protection in other countries you generally have two choices:

- ▶ to file separate patent applications in each country. This can be cost effective when you file in only a few countries; or
- ▶ to file a single international application under the Patent Cooperation Treaty (PCT) which is administered by the World Intellectual Property Organization (WIPO). This path gives your application automatic effect in over 100 countries and allows you further time to decide whether you want to pursue patent protection and in which countries.

Whichever option you choose, you will still end up with separate patent applications in each country. The Patent Cooperation Treaty (PCT) is simply a method of facilitating the **filing** of a patent application in a number of countries simultaneously and all patent rights are granted by national or regional patent systems. This application kit outlines the process of applying for international patents through the PCT. It is a matter of balancing the cost of patent protection in particular markets with your business strategies for those markets.

When you make a PCT application your application will automatically designate all the countries that are signatory to the treaty on the date of your application. You still need to meet the national requirements in each country where you want patent protection but the costs of registration can be deferred for a significant period. You may be able to defer your national filing costs for up to 30 months for most countries and 31 months for Australia. This gives you extra time to assess the value of your invention and its export potential before committing to the high costs involved. This is a substantial, tangible benefit if you are just starting out with a new piece of technology and a new business.



What is the Patent Cooperation Treaty?

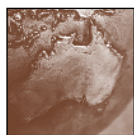
The Patent Cooperation Treaty (PCT) is an international treaty administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO), with headquarters in Geneva, Switzerland. The main purpose of the PCT system is to provide a unified, simple patent application procedure for filing in multiple countries.

The PCT enables you to file a single international application that has the same effect as a separate filing in all of the PCT member countries. The international application is filed with a Receiving Office (RO), which checks and processes your application according to the Treaty and Regulations.

Who is eligible to file a PCT application?

To file an international application at least one applicant or inventor must be a national or resident of a PCT contracting State. Australia is a PCT contracting State and IP Australia is the RO for international applications made by Australian nationals or residents. For an up-to-date list of contracting States please see www.wipo.int/pct/en/index.html

After the international application is processed under the PCT system, the IB sends a copy of the application to all of the PCT countries. Eventually, if you choose to continue your application for separate patents, your application will be examined according to the national patent laws of each country.



Why should I choose the *PCT system*?

Filing an international application under the PCT has the following advantages:

- ▶ a single application is filed which has effect in all the member countries of the PCT;
- ▶ you only need to comply with one set of formalities;
- ▶ you do not initially need to provide a translation of your application into the languages of the countries you select for patent protection;
- ▶ after filing a PCT application you receive an International Search Report (ISR) and an examination report called a Written Opinion of the International Searching Authority (ISO)* which should give you an indication as to the strength of your patent application before you decide whether you want to pursue patent protection;
- ▶ the option for an International Preliminary Examination (IPE) is available to you to further evaluate the chances of getting a patent before incurring the expenses involved in obtaining separate patents in different countries;
- ▶ the PCT system gives you extra time to reassess the value of the invention and its export potential before committing to high costs; and
- ▶ as there is no requirement for you to request an IPE or to enter the national phase for any country, you may stop the process of the international application at any time to avoid incurring further expense.

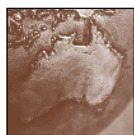
*Note: This is published by the International Bureau (IB) at 30 months after the earliest priority date as an International Preliminary Report of Patentability (Chapter 1) (IPRPI), which is communicated to all designated offices unless you opt for International Preliminary Examination (IPE).

How does a PCT application differ from other patent applications made overseas?

There are two ways of filing for an application overseas:

- ▶ you can apply directly to the Office of each country, or
- ▶ you can file an application using the Patent Cooperation Treaty (PCT).

Filing directly to the national office of each country requires you to...	Filing a PCT application to the Receiving Office requires you to...
▶ fill in the form(s) required by that Office	▶ fill in a PCT Request form or lodge your application electronically using PCT-SAFE.
▶ pay the fees for each application in foreign currencies	▶ pay the relevant PCT fees in Australian dollars
▶ meet the formality standards set by each country	▶ meet the formality standards of the PCT
▶ provide an address for service in each country	
▶ if required, provide a translation into the local language	
▶ provide a description — including drawings, if necessary	▶ provide a description — including drawings, if necessary
▶ provide a claim or claims	▶ provide a claim or claims
▶ provide a certified copy of your Australian application if claiming priority	▶ provide a certified copy of your Australian application if claiming priority



First in, *best dressed*

Priority dates

All patent applications (including international applications) have a priority date. Priority dates are extremely important when considering whether an invention claimed in a patent application is new (the technical term is novel). If two applicants file two patent applications (on separate occasions) claiming the same invention, the patent will be given to the application with the earlier priority date, all other matters being equal. Note that in the US the patent will be given to the applicant able to prove the earliest date of invention, not the earliest filing date.

The Paris Convention and how it protects you

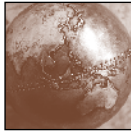
There is an international agreement called the Paris Convention, which allows patent applicants to use the date of their first patent application in one country as the priority date for their applications in other countries. This situation applies only if the applicants make their subsequent applications within 12 months of the date of the first patent application.

An international application can claim priority from:

- an earlier overseas application in a country which is party to the Paris Convention;
- a provisional application;
- a standard application;
- an earlier PCT application; or
- an innovation patent.

Priority may be claimed on more than one patent application.

Care should be taken to check the national requirements of those countries in which you wish your PCT application to proceed. You may be able to proceed in a limited number of countries even if the invention has been published but a patent has not been granted. In these circumstances it would be wise to seek professional assistance. See the Yellow Pages for a listing of patent attorneys and IP professionals in your area.



How does the PCT work?

The PCT system has two distinct phases (stages) of patent procedure — the international phase followed by the national phase.

The international phase provides you with:

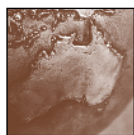
- ▶ recognition of the priority date in all member countries of the PCT;
- ▶ access to an International Search Report (ISR), and an examination report called an International Preliminary Report on Patentability (IPRP) which allows you to assess the patentability of your invention;
- ▶ a WIPO publication number and PCT application number. These numbers are useful when commercialising your invention because they prove you have applied for a patent; and
- ▶ the opportunity to amend your application — taking into account any reports or searches.

The national phase:

- ▶ allows you to pursue your patent application in separate countries that you select, either directly or through a regional patent office such as the European Patent Office (EPO); and
- ▶ may be quicker because any barriers to patentability have been identified in the international phase.

An international application consists of the request form and the same documents (a description, claims, drawings, where required, and an abstract) as a standard patent application. The same documents are required because upon entry into the national phase your application is considered in the same way as a standard patent application. For more information on the criteria for patents please see our free publications *The Patents Guide* and *The Patent Application Kit* or visit our website www.ipaustralia.gov.au.

The provisions of the PCT and the drafting and prosecution of patent applications are all complex matters. You are strongly advised to obtain professional advice from patent attorneys or IP professionals before filing an international application.



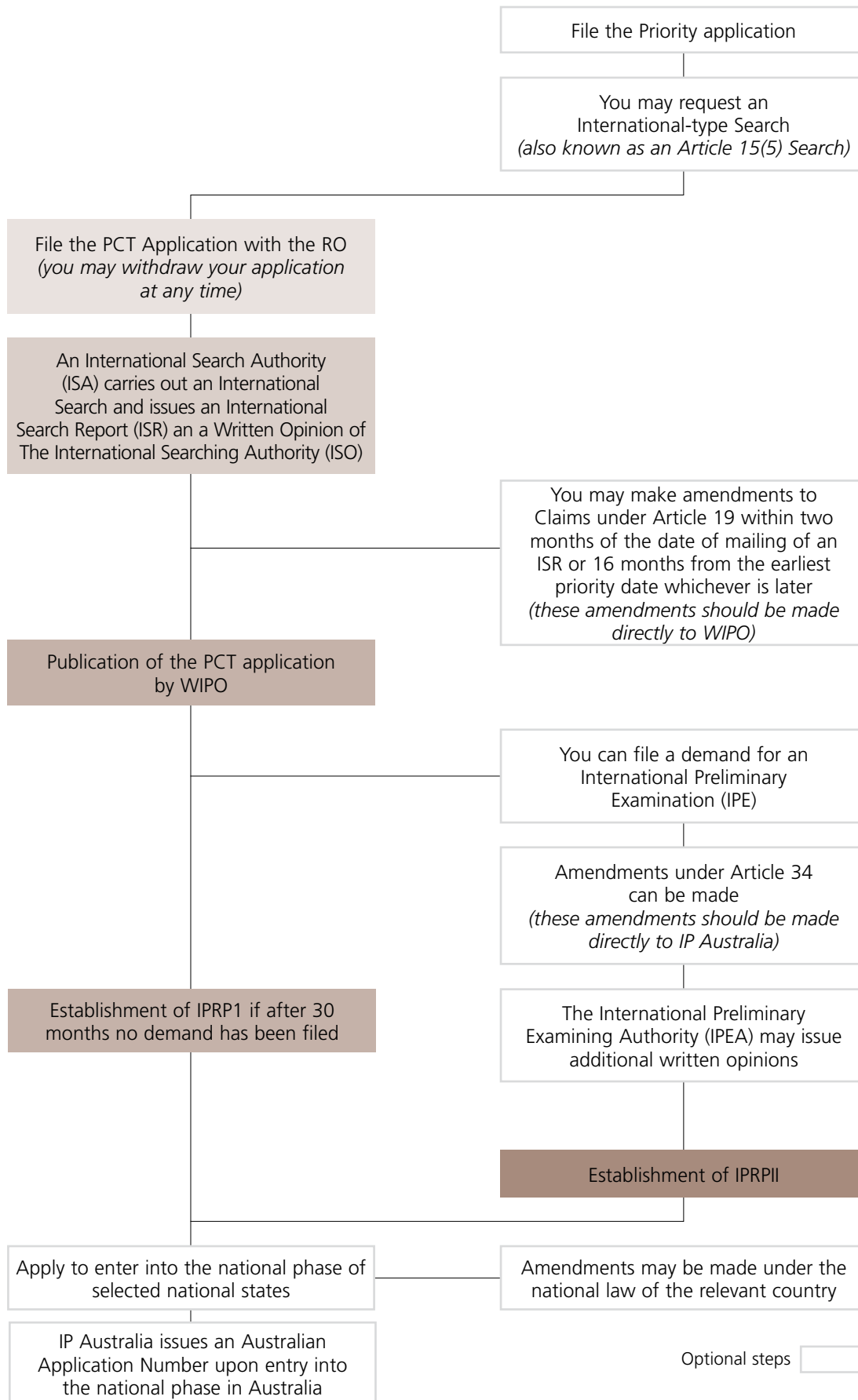
The *international* phase

In Australia, IP Australia acts as a Receiving Office (RO), International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the PCT.

Mind the steps

The international phase consists of four main steps.

<p>Stage One The PCT application is filed</p>	<ul style="list-style-type: none"> • The Receiving Office (RO) checks the application for mistakes. • The RO then assigns the application a filing number. • This part of the process usually takes six to eight weeks.
<p>Stage Two An International Search is carried out</p>	<ul style="list-style-type: none"> • An international search is carried out by the International Search Authority (ISA) to look for any relevant documents describing similar inventions related to the one you have described in your PCT application. • The findings of the search are compiled in a search report called an International Search Report (ISR). An examination report called a Written Opinion of the International Searching Authority (ISO) is also produced. • These reports are sent to your agent and the IB. • You can amend your claims (under Article 19 — see <i>In more depth</i>) based on the findings of your ISR and ISO – amendments must be made within two months of receiving the ISR and ISO or within 16 months of the earliest priority date. • As a PCT requirement, the ISR and ISO must be issued within three months of the application's lodgment date, or nine months of the earliest priority date, whichever is later.
<p>Stage Three The application is published by the IB</p>	<ul style="list-style-type: none"> • 18 months from the earliest priority date, the IB publishes the application and the ISR. • There is no provision for delay in publishing the application — it can be published without the completed ISR if necessary. • At this point, if the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the IB before the completion of the technical preparations for international publication — this must be done no later than 15 working days before it is due to be published. • At 30 months from the earliest priority date the IB uses the ISO to establish the IPRP1 which is communicated to all designated offices.
<p>Stage Four — Optional An International Preliminary Examination is requested</p>	<ul style="list-style-type: none"> • You can request an optional International Preliminary Examination (IPE) of the application — this request is called a demand. • The IPE is based on the ISO and any amendments you file and helps you refine your application before you decide to proceed with the national phase. • If you have requested an IPE, and the international preliminary examiner considers that there are still deficiencies in your application, you will be given a written Opinion (IPEO) otherwise the examiner will establish an International Preliminary Report on Patentability (Chapter II) (IPRP1). • The IPEO, like the ISO, explains why documents have been cited and alerts you to any problems your application may have in relation to novelty, inventiveness, and industrial applicability, as well as to any problems of clarity in your specification. • You can then file amendments to your application (under Article 34 — see <i>In more depth</i>) at the time of filing the demand or in response to a IPEO any time up to the establishment of the IPRP1. • The examiner must in any event establish the IPRP1 by 28 months after the earliest priority date. This will be an adverse report if you have not overcome all deficiencies. • Please note – the decision on granting a patent remains the task of the national or region offices where you enter the national phase — the IPRP1 is authoritative but it is not binding in these offices.



Please note that from 1 April 2002 changes to the PCT rules extended the time for national phase entry to 30 months from the priority date (31 months for Australia and some other countries) irrespective of whether a demand has been filed. However, not all countries have the change in place and you should seek advice about the countries where you request patent protection. For further information please visit the WIPO website www.wipo.int/pct/en

Amending your PCT specification during the international phase

You are able to amend your PCT specification at three points during the international phase of the process.

Requests to correct application errors

Requests for obvious errors in the specification can be requested at any stage up until entry into the national phase. This means that both the error and the correction should be obvious on the face of the documents.

Article 19 amendments

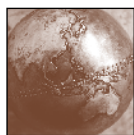
You have two months from the date of mailing of the ISR or 16 months from the earliest priority date in which to lodge amendments to the **claims** under Article 19. Article 19 amendments **MUST** be sent directly to the IB.

Article 34 amendments

As part of the IPE process you can also request an amendment under Article 34 of the PCT. The amendment can be to any part of the PCT specification. These amendments should be sent to IP Australia. An examiner will consider the amendments and will decide whether the amendments are allowable.

Under the PCT system, once the IPRPII is issued, no further amendment of the international specification is allowed. Thus, any further amendments to the specification must occur after the specification has entered the national phase with each of the relevant national offices.

Changes of name or assignments of the application or changes to the address for service can be made during the International process provided the request is received by the IB within 30 months from the earliest priority date.



The *national* phase

Usually by the end of 30 months from the priority date, you will have to ask for the international application to proceed separately as a standard patent application in the countries that have been selected by you for patent protection. As the applicant, you need to take certain actions in order for the application to enter the national phase and these actions must be completed before the relevant deadline. Most countries allow 30 months from the priority date in which to enter the national phase, although some, like Australia, allow 31 months. A small number of countries still require you to request entry to the national phase before 20 months from the priority date unless you have filed a demand (request) for an IPE that was lodged within 19 months of your priority date.

You should check the timing requirements of each individual country for entering the national phase.

For further information please visit the WIPO website www.wipo.int/en.

To proceed in the national phase you must indicate to each office that you are entering the national phase in that country. You are required to pay the necessary national fees to those offices and supply any translations that may be required. The national offices will examine the application under their domestic law and grant or refuse a patent, according to their own national patent law.

You do not have to enter the national phase in all countries. You should use the time between filing and national phase entry to check the commercial importance of your application.

IP Australia cannot advise you whether you should enter the national phase in any particular country. Please be aware that most countries will require you to provide either an address for service or the name of an IP professional registered in that country on national phase entry. IP Australia requires an address for service in Australia. This must be a street address in Australia where legal documents can be served.

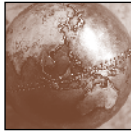
What requirements do I need to meet to enter the national phase in Australia?

To enter the national phase in Australia you should:

- ▶ write to IP Australia requesting entry of your PCT application (quoting your PCT application number) and pay the required fee;
- ▶ provide an address for service in Australia (this must be a street address in Australia for legal service); and
- ▶ if the PCT application is in a language other than English, you must provide a verified English translation of the PCT specification.

If you wish to enter the national phase before IP Australia has received the PCT published specification you will need to provide in addition to the above:

- ▶ a copy of the PCT specification as lodged with the RO; and
- ▶ a copy of the completed request form lodged with the RO.



Searches

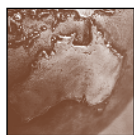
International-type searches: Article 15(5)

If you have filed an Australian provisional application you can get a patentability search carried out by IP Australia on your invention before you file a PCT application. This is called an international-type search or an Article 15(5) search. It is designed to assist you to decide at an early stage whether you should seek protection through the PCT route.

An international-type search is essentially similar to a PCT international search and similar conditions apply. The search is made on the basis of claims, the description or a search statement. If your application has no claims, the international-type search is based on the description (and drawings). This type of search is necessarily limited because the inventive concept may not be clearly defined. After having an international-type search carried out, you may decide to file either a national or a PCT application. Alternatively you may decide not to proceed and your provisional application will lapse and will not be published.

Normally, you should ask IP Australia to perform an international-type search within ten months of filing your provisional application. However, we can perform the search as early as possible to ensure you have sufficient time to consider the search results before the 12 month priority expires. You should receive your international-type search report about five weeks after you pay the fees and ask IP Australia to conduct the search. The report is prepared in a similar format to a PCT International Search Report.

When you file your PCT application you must pay the full international search fee. However if IP Australia has conducted an international-type search for you for the same invention you may request a partial refund of the international search fee. The amount of the refund will depend on how much additional searching the IP Australia examiner will need to do on your PCT application.



In more *depth*

International search report (ISR)

Soon after you pay the fees and file an international application with IP Australia it will be forwarded to an examination section in the relevant technology and allocated to an examiner for the conduct of an international search. The search examiner will carry out a comprehensive search of the PCT minimum documentation which includes national, regional and PCT patent documents published after 1920 from all major countries and certain non-patent literature. Search examiners employ a range of tools and techniques to access patent and non-patent databases to identify those documents that are most relevant to the patentability of your claims. It is therefore vitally important that your claims are focused on what you consider to be the essential features of your invention. An example of an ISR (main parts only) is shown on page 18.

Boxes A & B indicate the technology areas, databases searched and the keyword strategies that were used by the examiner in performing the search. This information is provided for users of the search report to understand the scope of the international search. It helps national offices to ascertain the relevance of the search during national examination when the claims are possibly in amended form.

Box C identifies the most relevant documents found by the search examiner and indicates their relevance to the claims in the application.

- ▶ The middle column identifies the publication details for each document, including the name of the applicant or patentee and the publication date.
- ▶ The column on the left indicates a category for the cited document by means of a letter (whose significance is explained in detail in a box underneath Box C). For example, the "X" category indicates that the document alone raises doubt about the novelty and/or inventiveness of the invention.
- ▶ The column on the right identifies claims for which the category indication is relevant.

An Annex to the ISR lists known "family members" of the citations that are identified in the search report. Family members are related applications in other countries made by the same applicant for the same or closely related inventions.

The ISR may also contain other important information depending on the circumstances. For example it may indicate that the application claims several different inventions (called lack of unity) and if so which of these inventions are covered by the search report. (If you have several inventions within your application that cannot be covered by a single search, you will be given an opportunity to have those invention(s) searched on payment of extra fees.) The search report may also show that some claims have not been searched because they are not regarded as covering patentable subject matter or where a meaningful search is not possible because it is impossible to work out what the invention is. However, a search is done when practicable.

The ISR thus identifies any relevant citations at an early stage during the patenting process, allowing you to assess the commercial worth of your invention and helping you in the process of making important decisions.

Written Opinion of the International Searching Authority (ISO)

After completing the search, the examiner will also perform an examination and produce a report (ISO) that explains why documents have been cited in the ISR and alerts you to any problems your application may have in relation to novelty, inventiveness, and industrial applicability, as well as to any problems of clarity in your invention's specification and description.

An example of ISO is shown on page 19.

Box V indicates which claims satisfy the criteria of novelty, inventive step and industrial applicability and which claims do not. It provides an explanation of the documents cited in the ISR and their relevance to the invention. An adverse observation under novelty and/or inventive step would indicate that the examiner considers that the invention as claimed is not new or is non-inventive or obvious in the light of the citations and/or the knowledge which skilled persons in the relevant technology would possess.

In the example, the examiner considers that claims 1-6, 9 and 10 are not novel and the explanation indicates where the features of the invention have been disclosed in the citations. The examiner also considers that claims 1-7 and 9-11 lack an inventive step. The report explains that all the features of those claims are either disclosed in the documents cited or are minor features, which are not enough to make the invention in those claims inventive. The report also indicates that the examiner considers that the remaining claims are novel and inventive.

The examiner will establish the ISR and ISO and will send them to you. You then have a number of options.

1. Take no further action until you need to enter the national phase. The ISO will be used by the IB to establish the International Preliminary Report on Patentability (Chapter 1)(IPRPI) and sent to all designated offices at 30 months from earliest priority date. Prior to establishing the IPRPI, the ISO will be confidential.
2. Provide written comments to the IB. These comments (including translations if required) will be sent to all designated offices unless an IPRPII has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.
3. File a Demand for Preliminary Examination. The demand must be filed within 22 months of the priority date or three months from the date of the ISR. (Note however page 11).

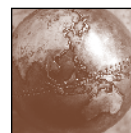
Article 19 amendments

After you have received the ISR and before the application is published, the PCT process provides you with an opportunity to amend the claims of your international application under Article 19 of the PCT.

For example, if there are X or Y category documents cited in the ISR, you may wish to amend the claims to distinguish them from the citations before proceeding with the application in the national phase. This may increase the likelihood of your application proceeding directly to grant, when your application enters the national phase.

International preliminary examination and Article 34 amendments

Before entering the national phase, you can choose to have an International Preliminary Examination (IPE) of the application done by IP Australia in its capacity as an International Preliminary Examining Authority (IPEA). This also gives you the opportunity (under Article 34 of the PCT) to amend any part of your application to overcome problems and have an examination report (IPRPII) issued on the amended application before you enter the national phase in different countries.



An IPE commences at 22 months when you file a Demand and pay the appropriate fee, within the time period indicated above, together with any submissions or amendments that you would like to make in response to the ISR and ISO. An IP Australia examiner will examine your application and may issue one or more opinions before the IPRPII report is issued. You will have the opportunity to file (within certain time limits) a response to each opinion, which may include submissions, or amendments or both.

An example of an IPRPII (significant parts only) is shown in the example on page 19.

Box V has the same meaning as box V of the ISO.

Box VIII makes other relevant observations in relation to significant issues, which may impact, on the validity of any potential patent grant. In the example, the examiner considers that claim 10 should include a feature that is necessary for the invention to function properly and that a feature defined in claim 15 does not correspond to what is described in the body of the specification.

The IPE opinion/report may also contain other information such as whether there were any restrictions on the scope of the examination or whether there are any other defects in the international application.

For more detail on the interpretation of ISRs, ISOs and IPRPIIs, please refer to the WIPO Guidelines for International Searches and the WIPO Guidelines for International Preliminary Examination, which you can download from www.wipo.int

Copies of patent citations can be purchased from IP Australia or alternatively accessed via the Internet from the relevant patent office site.

Example: International Search Report

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INTERNATIONAL SEARCH REPORT International application No. **PCT/AU 2004/123456**

A. CLASSIFICATION OF SUBJECT MATTER
 Int. Cl. ⁷: G01F 11/04, 15/14, G05D 9/00
 According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED
 Minimum documentation searched (classification system followed by classification symbols)
 Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)
 DWPI - IPC G01F 11/-, G05D 9/00 & Keywords (float, resist, sensor) and like terms; USPTO & keywords (float, resist, sensor, electrode); Espac & keywords (float, resistor, sensor)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 3207388 A (WADDINGTON) 21 September 1965 column 2 lines 30-49 column 2 line 45 to column 3 line 15	1-6 7,10,11
Y	AU 30349/77 A1 (IBM CORP) 4 November 1977 page 4 lines 5-26 page 9 line 2 to page 10 line 15	1-4 1-11
X	AU 9914/55 (202914) B1 (SIMBA AG) 22 December 1955 See page 3	1-11
Y	DE 2947734 A1 (CIBA-GEIGY AG) 12 June 1980 See Figs. 5 and 6	1-5,9,10

Further documents are listed in the continuation of Box C See patent family annex

* Special categories of cited documents: "A" document defining the general state of the art which is not considered to be of particular relevance; "E" earlier application or patent but published on or after the international filing date; "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified); "O" document referring to an oral disclosure, use, exhibition or other means; "P" document published prior to the international filing date but later than the priority date claimed.

"I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention; "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone; "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art; "G" document member of the same patent family

Date of the actual completion of the international search: 9 January 2004
 Date of mailing of the international search report: 12 January 2004

Name and mailing address of the ISA/AU AUSTRALIAN PATENT OFFICE PO BOX 200, WODEN ACT 2606, AUSTRALIA E-mail address: pct@ipaaustralia.gov.au Facsimile No. (02) 6285 1929
 Authorized officer: J. S. BACH Telephone No.: (02) 6283 1234

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INTERNATIONAL SEARCH REPORT International application No. **PCT/AU 2004/123456**

C (Continuation). DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
P,X	US 6659999 B1 (MONTGOMERY) 1 January 2004 See abstract, column 6 line 12-column 8 line 20 and fig 1	
Y	WO 1981/001617 A1 (BOLINDEN AB) 11 June 1981 See page 3 lines 7-28	1,7,10
Y	Patent Abstracts of Japan, P-136, page 150, JP 50-14535 A (NCR CORPORATION) 28 May 1985 See English abstract	7,10,11
Y		7,10,11

Note: For the Y indications, AU 30349/77 and AU 9914/55 can be combined together, and US 3207388 can be combined with any one of WO 81/01617 or JP 50-14535 with relevance to the same claims.

INTERNATIONAL SEARCH REPORT International application No. **PCT/AU 2004/123456**

Information on patent family members

This Annex lists the known "A" publication level patent family members relating to the patent documents cited in the above-mentioned international search report. The Australian Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

Patent Document Cited in Search Report	Patent Family Member
US 3207388	NONE
AU 30349/77	BE 860359 CH 623685 FR 2379162 BR 7707919 DE 2752439 GB 1536618 CA 1075831 ES 464680 IT 1111367 2
AU 9914/55	JP 53-70668 US 4111719 NL 7713449 US 4137103 SE 7713736
DE 2947734	NONE
US 6659999	CA 1149815 JP 55-85576 FR 2442840 US 4282353 GB 2038803
WO 81/01617	NONE
JP 50-14535	AU 65760/80 DE 3071424 FI 812349 BR 8008935 DK 3043/81 JP 56-501661 CA 1161900 EP 30218 US 4492924

END OF ANNEX

Example: Written Opinion of the International Searching Authority

1

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	International application No. PCT/AU 2004/123456
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1. Statement:

Novelty (N)	Claims 7,8,11	
Inventive step (IS)	Claims 1-6,9,10	YES
	Claims 8	NO
Industrial applicability (IA)	Claims 1-7,9-11	YES
	Claims 1-11	NO
	Claims	YES
		NO

2. Citations and explanations:

1. US 3207388
2. AU 30349/77
3. AU 9914/55
4. DE 2947234
5. WO 1981/00161/7
6. JP 50-14535

Novelty (N) claims 1-6,9,10

Citation 1 explicitly discloses all of the features of claims 1-6. For example see:

- control processor col 2 lines 31-35, item 8 of Fig. 2
- flow sensor col 2 lines 32-39, item 6 of Fig. 2
- flow regulator col 2 lines 40-45, item 2 of Fig. 2 and Fig. 6
- pH sensor col 2 lines 42-49, item 4 of Fig. 2

Citation 2 discloses all of the features of claims 1-4. In particular, it discloses the control processor, flow sensor and flow regulator, as part of the heat exchanger, at page 4 (lines 5-26 and in figure 9 at items 7, 9 and 11).

Citation 3 discloses all of the features of claims 1-5 and 9-10. In particular, figures 5 and 6 show all of the features of the above citations, being similar disclosures, with the extra features of the bracket and exhaust pipe being found at items 52 and 59 of these figures.

The features of the remaining claim are not found in any single document published before the earliest priority date of the citations. See however the indication contained in Box VI "Certain documents cited".

Inventive Step (IS) claims 1-7, 9-11

Claims 1-6,9,10 as above.

Claims 7 and 11.

Citations 4-6 do not individually disclose all of the features of these claims, but when combined, as would be obvious to a person skilled in the art, disclose all of their features.

The features of claim 8, in particular the reenergizing reed switch and corona discharge, were not found in any other document that would be regarded, by a person skilled in the art, as being obvious to combine with any of the above citations.

Form PCT/ISA/237 (Box No. V) (January 2004)

Example: International Preliminary Report on Patentability

1

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	International application No. PCT/AU 2004/123458
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1. Statement:

Novelty (N)	Claims 1-9,11-15,21-26	YES
	Claims 10	NO
Inventive step (IS)	Claims 23-26	YES
	Claims 1-15,21,22	NO
Industrial applicability (IA)	Claims 1-15,21-26	YES
	Claims	NO

2. Citations and explanations (Rule 70.7)

Novelty (N) Claim 10

(a) AU 21113/77 (498847)

(b) AU 84276/75 (496972)

Citations (a) and (b) each (figs 3 and 4 in the case of (b)) disclose an element conforming exactly with the element defined by the claim. Further, the explicit teaching of each citation is to employ the element as instantly claimed.

The features of the remaining claims are not found in any single document published before the earliest priority date of the claims.

Inventive Step (IS) claims 1-15, 21,22

Claim 10 as above.

(c) AU 31026/63 (263908)

Claim 10 also lacks inventive step as the element of citation (c) is described in terms of use in a cross-arm assembly in accordance with the manner defined. It has a symmetrical configuration whereas the element of the claim has a body portion and an integral top portion which are not symmetrical. However, this difference is a mere variation in shape and, as such, is not seen to reflect an inventive step over either citation (a) or (c).

Claim 1-9: Restricting the element to porcelain is not considered to make an inventive step over either of citations (a) or (c).

Claims 11-15: The features added by these claims are disclosed in the citations so that these claims are anticipated by the obvious combination of the disclosures of the citations.

Claims 21,22: The minor features added by these claims to the cross-arm assembly of claim 15, to which they are appended, do not involve an inventive step.

See, however, the indication contained in Box VI "Certain documents cited".

Claims 23-26: The features of these claims were not disclosed in any obvious combination in any of the citations.

Form PCT/ISA/237 (Box No. V) (January 2004)

2

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

Box No. VIII	Certain observations on the international application	International application No. PCT/AU 2004/123458
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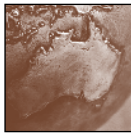
The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Certain claims are not fully supported by the description:

- a) Claim 10 is not limited to a material which would overcome the major prior art problem discussed on pages 1 and 2, thus it includes an element made of say wood, which would be prone to the problems which the invention allegedly overcomes.
- b) In claim 15 (1st occurrence), "rounded head" is not definitive of the form of head described, as illustrated in Fig. 1.

Claim 21 is not clear in its dependency to claim 10, as claim 10 does not define a pole.

Form PCT/ISA/237 (Box No. VIII) (January 2004)

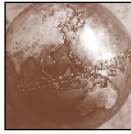


PCT Timeline

MONTHS

0	First Filing (eg Provisional) gives PRIORITY DATE and TIMELINE START		
1			
2			
3			
4		Foreign Filing decision period (12 months) Convention or PCT application	
5			
6			
7			
8			
9			
10			
11			
12	Final date for PCT Application to be filed		
13	PCT FEES TO BE PAID. An applicant has one month from filing to pay PCT fees without penalty. A second month is available but a penalty fee applies.		Time for International Search Report and written opinion of the International Searching Authority to be established (three months)
14			
15			
16	Applicant has two months from mailing date of ISR or 16 months from priority date to amend claims – to WIPO		
17			
18	International Application published by WIPO		
19			
20	*Where countries have not yet made changes to their registration to take into account the 1 April 2002 PCT rules changes, National Phase entry if no DEMAND has been filed within 19 months		
21			
22	DEMAND filed if applicant wishes International Preliminary Examination	International Preliminary Examination Process (applicant may file amendments)	
23			
24			
25			
26			
27	Final date for International Preliminary Report on Patentability (Chapter II) to issue		
28			
29			
30	National Phase* entry, 30 months. In Australia, and some other countries, the time is 31 months	IPRPI established if demand not filed	
31			

* Please note that from 1 April 2002 changes to the PCT rules extended the time for national phase entry to 30 months from the priority date (31 months for Australia and some other countries) irrespective of whether a demand has been filed. However, not all countries have the change in place and you should seek advice about the countries where you request patent protection. For further information please visit the WIPO website www.wipo.int/pct/en



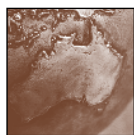
A bit of *advice*

Although our staff cannot give you advice about your particular circumstances, we can answer general questions that you may have about the Australian patent and PCT systems.

Patent protection, particularly international protection, is expensive and you need to balance your required level of protection against the cost of that protection. It is a valuable investment as well as a significant expense and should be treated as such.

Obtaining a commercially useful patent requires a high level of expertise and therefore we recommend that you seek professional help before seeking international patent protection.

If you do proceed without professional help you should bear in mind that your patent application is a legal document, and as such should be drafted carefully so that it can be upheld against legal challenge. You will also need to ensure that competitors cannot easily work around your patent and use your ideas without you having any legal recourse.



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To receive the maximum electronic filing discount, the text of the description, claims and abstract for your application must be in a character coded format (e.g. XML) and must be lodged using IP Australia's PCT Online service. You can obtain the XML specification for PCT documents from the WIPO website. You can use WIPO's PCT-SAFE Editor to prepare your application documents in WIPO's XML format.

Filing Your Application via PCT Online

Once you have prepared your application using PCT-SAFE and saved it as a "WASP" (.zg1) file, it is ready for submission through the online services section of IP Australia's website.

Once you have uploaded your files, they will be checked for viruses and the validity of your digital signature, and you will be presented with your pre-filing number and an electronic lodgement receipt.

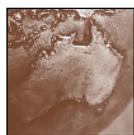
Goldtouch — No soft touch for Microsoft

A strong patent and a priority date gained under the Patent Cooperation Treaty (PCT) saved Mark and Liz Goldstein's business. The founders of Goldtouch Technologies, the Goldsteins, successfully sued IT giant Microsoft in a US court for infringing the patent of its computer mouse.

After applying for patents on the concept of an adjustable ergonomic keyboard, and having determined to license their adjustable design to the computer industry, Mark and Liz met with Microsoft in 1997 to discuss licensing possibilities. Just one year later, the Goldsteins discovered elements of their patents and technology had been incorporated into Microsoft's latest mouse. Microsoft had been aware of their patent application, which, at that point, had not been made public. Says John Swinson, their Australian lawyer, "Microsoft looked at the mouse, stated that they were not interested and then went ahead and copied the design without paying Mark and Liz Goldstein. Goldtouch Technologies had filed those patents on key aspects of the design. Once the patent was issued, Mark and Liz could make patent infringement claims against a number of competitors in the market place."

When appearing in court, Goldtouch's US lawyer, Brandon Janes highlighted the loss of sales suffered by Goldtouch, explaining that from the viewpoint of a prospective buyer of an ergonomic mouse, brand is very powerful. Many customers base purchase decisions on brand. Here there were two very similar mice, one being a well-established brand. Given this, sales plummeted when the Microsoft mouse hit the market, despite the design superiority of the Goldtouch mouse. The Goldsteins won the case and were awarded substantial damages.

Their case is a good example of the benefits of using the PCT to gain legal protection in multiple countries. Goldtouch used the PCT process for patent applications for both their keyboard and mouse. Mark Goldstein had filed for patent protection in Australia for the keyboard and then, using the PCT system, filed for patent protection in other countries. As a result of Mark's patent application for the keyboard, he was able to win the licensing agreements with Lexmark on the product while another competitor withdrew their version from the market.



Fees

PCT lodgement fees

Transmittal fee	\$AU100
International Filing Fee	\$AU1,435
plus \$AU15 for each page in excess of 30	\$AU15
Gene Sequence Listing in Machine Readable form — as part of Specification (equal to 400 times “fee per sheet”)	\$AU6,000
— as search tool only (in paper form)	This cost is included in the excess page application count

Electronic filing discounts

Electronic Filing Fee Discount (PCT-EASY)	-\$AU103
or	
Electronic Filing Fee Discount (PCT-SAFE without XML specs)	-\$AU205
or	
Electronic Filing Fee Discount (PCT-SAFE with XML specs)	-\$AU308
International Search Fee	\$AU1,200
Cost of preparing Certified copy of basic document	\$AU50 per document
Copies of specifications cited in the ISR	\$AU25 per copy

International preliminary examination fees

International Preliminary Examination Fee	\$AU550
(\$1,000 where International search report was not issued by the Australian Patent Office)	
International Preliminary Handling Fee	\$AU205
TOTAL	\$AU755

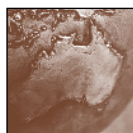
International-type search fees

Fee for IP Australia to perform an International-type search (Article 15(5))	\$AU1,000
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The fees listed are subject to change. A current listing of all patent fees is available from your nearest state office or from IP Australia's website.

Notes

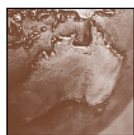
- (1) Any application filed using the "PCT-EASY" mode of WIPO's PCT-SAFE software is subject to a reduction of **\$AU103** from the total amount payable for filing the international application.
- (2) Any application filed using the "PCT-SAFE" mode of WIPO's PCT-SAFE software where the text of the description, claims and abstract is not in character coded format (XML), is subject to a reduction of **\$AU205** from the total amount payable for filing the international application.
- (3) Any application filed using the "PCT-SAFE" mode of WIPO's PCT-SAFE software where the text of the description, claims and abstract is in character coded format (XML), is subject to a reduction of **\$AU308** from the total amount payable for filing the international application.
- (4) If an examiner determines that there is more than one invention claimed in an application you may be invited to pay additional fees.
- (5) Fees are payable to the RO. For Australia, the RO is IP Australia.
- (6) Although the fees are not required to be paid at the time of filing the international application, the international search will not be performed until the fees are paid. If no fees, or insufficient fees, are paid you will be invited to pay the fees within one month of filing. If the fees are not paid within the first month, a second letter requesting payment, plus a penalty payment (50% of the unpaid fee or the whole of the transmittal fee (whichever is greater) but not more than 50% of the international filing fee) will be sent to you. If fees are not paid then the application will be withdrawn.
- (7) You will also need to pay various national fees in each country where you choose to begin the national phase. In Australia these will include filing, examination, and maintenance fees.
- (8) The Patents Act has various fees that are required to be paid during the prosecution of an application. Failure to pay a fee can have serious consequences for the protection of your rights. If you choose to pursue patent protection without professional advice you should take extreme care to understand the fees you will be required to pay and when you are required to pay them.



Glossary of terms

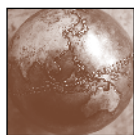
Address for Correspondence	An address in Australia where we can write to you. You should notify IP Australia if this address changes.
Address for service in Australia	An address for legal service, that is, an address in Australia where documents may be served on someone personally. You should notify IP Australia if the address changes.
Applicant	The person(s) or organisation(s) making the application
Article 19 amendment	An optional amendment that is applied to the claims of the international application. You should make these amendments directly to WIPO after the receipt of the international search report, and written opinion of the International Searching Authority.
Article 34 amendment	An optional amendment to the international application which can cover all documents of the PCT application (excluding the Request form). Article 34 amendments happen during preliminary examination and should be sent to IP Australia.
Article(s)	These are the clauses of the Patent Cooperation Treaty that govern how the Treaty will operate. They equate to sections of an Act.
Contracting State	A country that is a party to the Patent Cooperation Treaty. For an up-to-date list of contracting States please see www.wipo.int/pct/en/index.html
Demand	An application for International Preliminary Examination. This form is separate from the PCT Request (or application) form.
Digital Certificate	Digital certificates are required for ensuring the validity and security of PCT applications filed electronically. Applicants can use a digital certificate issued by WIPO (free of charge) or the ABN-DSC certificate for their business.
Elected Office	The national patent office or government body acting for the elected State.
Elected State	A country that the International Bureau sends the IPRPII to after international preliminary examination. Your demand will automatically elect all the countries that are signatory to the treaty on the date of your application.
IB	International Bureau of the World Intellectual Property Organization
Infringement	Infringement occurs when someone willingly or unwillingly uses your intellectual property without your permission.
International Search	A patentability search, not an infringement search, and accordingly should not be relied upon to identify patents which may be infringed by the claimed invention.
Inventor	Anyone whose involvement and contribution was essential to the development of a new process, appliance, machine or article.
IPEA	International Preliminary Examining Authority conducts the international preliminary examination.

IPEO	International Preliminary Examination Opinion. The International Preliminary Examiner may issue one or more written opinions before the International Preliminary Report on Patentability (Chapter II) is issued.
IPRP II	International Preliminary Report on Patentability (Chapter II). Report helps you to assess the invention and decide whether or not to enter the national phase in each of the designated countries. After receiving an International Search Report and written opinion of the International Searching Authority, you also have the opportunity to ask for a non-binding preliminary examination. This will alert you to any significant problems with your application and will further extend the time before you must enter the national phase.
ISO	Written opinion of the International Searching Authority. It is issued automatically with the International Search Report and covers all issues under international preliminary examination. WIPO refers to this as the Written Opinion of the Searching Authority (WOSA).
ISA	International Searching Authority carries out the international search and written opinion of the International Searching Authority.
ISR	International Search Report contains no comments on the value of your invention but lists citations of prior art relevant to the claims of your international patent application and gives an indication of the possible relevance of the citations to its patentability. This enables you to evaluate your chances of obtaining patents in the countries you have designated.
PCT	Patent Cooperation Treaty
PCT-EASY	Uses features of the PCT-SAFE software to help you prepare and file your PCT application. The PCT-SAFE software can be operated in PCT-EASY mode where applications are filed on paper, accompanied by request form data and abstract on diskette.
PCT-SAFE	Free software provided by WIPO to help you prepare and file your PCT application. It is designed to simplify the process, save you time and provide you with cost savings.
PCT-SAFE Editor	Free software provided by WIPO to help you prepare the specifications for your PCT application in WIPO's preferred XML format. The maximum electronic filing discount will apply to applications filed electronically with XML specifications.
PCT Online	IP Australia's electronic lodgement facility for PCT applications, which can be accessed from the online service section of the IP Australia website. To use PCT Online you will need the PCT-SAFE software from WIPO and a digital certificate.
Request	An application form for PCT
RO	The national office where the international application is filed then checked and processed is called the Receiving Office. The original of the application is sent to the IB of WIPO and a copy to the International Searching Authority who will conduct the international search.
RO/AU	The Receiving Office in Australia is IP Australia
Rule(s)	The PCT term that refers to the details of the Treaty. In Australia they equate to the Regulations.
WIPO	World Intellectual Property Organization



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Email	General PCT enquiries: information.center@wipo.int PCT-SAFE help desk: pctsafe.help@wipo.int Multilingual staff are always on hand to answer your questions via email
Website	www.wipo.int/patentscope/en/ For information and tools relating to the PCT



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Email **assist@ipaaustralia.gov.au**—for general enquiries. However filing of documents is not available through this address.

Website **www.ipaustralia.gov.au**—for information relating to intellectual property, to submit online applications, and to download forms and other documents.

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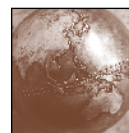
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Our preferred means of communication are:

- ▶ the IP Australia website—**www.ipaustralia.gov.au**;
- ▶ our business transactions fax number—**(02) 6283 7999**; or
- ▶ email—**assist@ipaustralia.gov.au**

Communication sent to other contact points electronically (eg state office fax numbers) will be processed in accordance with the date and time at the place of receipt. These communications will not gain the benefits provided by the *Electronic Transactions Act* such as security and certainty of receipt.

The *Electronic Transactions Act* business rules address a range of issues including:

- ▶ identifying the appropriate form of electronic communication to use for different types of correspondence;
- ▶ choosing electronic payment options;
- ▶ receiving notifications; and
- ▶ utilising supported electronic formats.

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Australian Government

IP Australia