

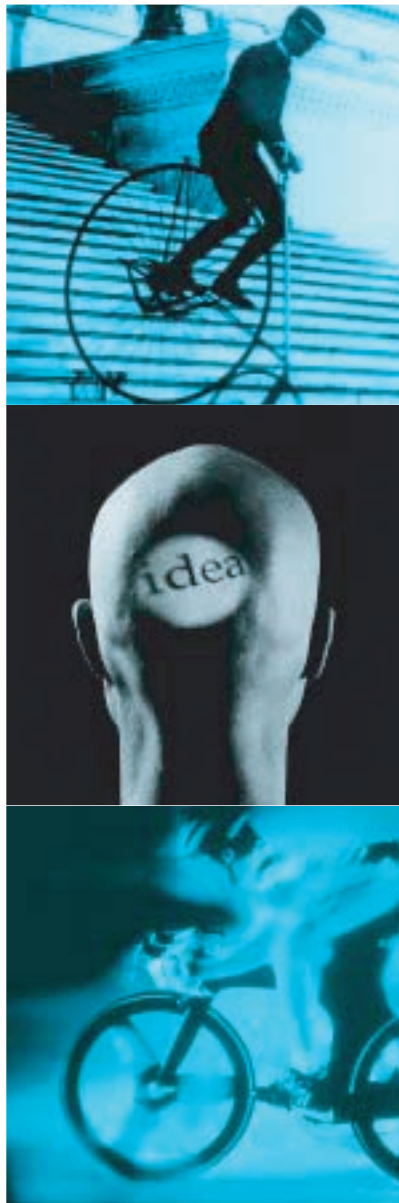


Australian Government

IP Australia

THE PATENT APPLICATION KIT

How to prepare and file your patent application in Australia



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



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This kit is designed to help you prepare and file a provisional application and a complete patent application in Australia. It complements IP Australia's other publications such as *The Patents Guide* and the *International Patent Application Kit*. This kit does not cover every issue that may be relevant 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 with IP Australia before relying on the information. Although our staff cannot give you advice about your particular circumstances, we can answer general questions that you may have about the Australian patent system. We recommend that you seek professional assistance before applying for a patent.

IP Australia has a series of fact sheets which are referenced throughout this kit. These fact sheets can be downloaded from the IP Australia website www.ipaustralia.gov.au



The first steps in seeking **Patent Protection**

The following information is designed to help you prepare and file a provisional application, and a complete application for either a standard or an innovation patent in Australia. For information about applying for an international application, you should obtain a copy of our publication the *International Patent Application Kit*.

If you want to seek patent protection for your invention, one option, as explained in our publication *The Patents Guide*, is to begin by filing a *provisional* application. However you may wish to skip the provisional stage if you want to bring your invention to market quickly.

We recommend you explore all available options with the assistance of a patent attorney.

A provisional application does not give you patent protection on its own. The real value of a provisional application is that it can be used at an early stage to establish a priority date for your invention. This gives you up to 12 months, before committing to further expense, to assess the commercial potential of your invention and decide whether you want to continue. If you choose to pursue patent protection then, some time before the 12 months is up, you can file:

- ▶ a *complete* standard patent application or *complete* innovation patent application claiming priority from your provisional application;
- ▶ an *international* patent application under the PCT claiming priority from your provisional application; and/or
- ▶ separate *convention* patent applications in one or more overseas countries claiming priority from your provisional application.

If you do not file one of these types of application within 12 months, you will lose any right to a priority date that the provisional application may have provided. However in these circumstances the contents of the provisional application will not be published. This leaves open the option of filing another provisional application later for the same invention, assuming you have kept details of your invention confidential.



If you intend making an application overseas based on the later filed provisional application, to avoid any potential problem we advise you to formally withdraw the original provisional application before it is due to lapse, and then file the later provisional application.

Choose carefully

Some options may limit your ability to obtain foreign patent protection unless you act quickly. For example, if you apply for an innovation patent in Australia based on a provisional application, and intend to patent your invention in other countries, it is extremely important that you file an international application or a convention application within 12 months of filing the *provisional* application. If you do not file overseas in this period, you will lose the priority date established by the provisional application and not be able to patent your invention in other countries due to the publication of your innovation patent at grant.

Protecting improvements

If you make improvements to your invention after filing a provisional application (but before filing a complete application, international application or convention application), you should consider filing another provisional application which describes your invention including the improvements. This allows you to establish a new priority date for the improved invention. A complete application, international application or convention application can then be associated with both provisional applications, but if you want to keep your earliest priority date you should file the former application(s) within 12 months of filing the first provisional application.

Before going further

If you have filed a provisional application, you can, for a fee, get a patentability search carried out by IP Australia on your invention before you pursue patent protection here and/or overseas. This is called an *international-type search* or an *Article 15(5) search*, and must be requested within ten months of filing your provisional application. The results of the search are not made public and will assist you to decide at an early stage whether to continue before the major costs of patenting are encountered.



Provisional *applications*

Filing a provisional application in Australia

How do I file a provisional application?

There are several ways you can file:

- ▶ You can use the services of a patent attorney. Patent attorney's fees will apply;
- ▶ You can deliver your application to one of our state offices. Please see our contact details at the end of this publication;
- ▶ You can mail your application to The Commissioner of Patents, IP Australia, PO Box 200, Woden ACT 2606; or
- ▶ You can fax your application to our secure Business Transactions Fax (02) 6283 7999.

What documents do I need to file?

Your provisional application should include:

- ▶ A completed *Patent Request: Provisional Application* form;
- ▶ A provisional specification; and
- ▶ The filing fee.

If you file a provisional application and do not pay the filing fee at that time, we will send you a notice ("Invitation to Pay") advising you of the fee and that you have two months from the date of our notice to pay in full, or your application will lapse.

You do not need to pay any maintenance fees for a provisional application.

Preparing your provisional application

Patent Request form

A blank copy of the patent request form for provisional applications together with instructions for filling it in are included at the back of this publication, or the form can be downloaded from our website www.ipaustralia.gov.au. Please read the instructions carefully before filling in the patent request form, and **keep a copy of the completed form for your own records**.



Provisional specification

A provisional specification should be typed in English. It is important that you provide as much detail as possible about your invention in the provisional specification, especially if you intend to use it to establish a priority date. **Keep a copy of the provisional specification for your records.**

An example provisional specification is shown in this publication beginning on page 7.

Title

Start the specification with the same invention title you used in the *Patent Request* form.

Description

After the title you should identify the technical field of your invention. If your invention was made as a result of problems that you are aware of with other products, you should briefly note those problems.

The next part is a statement of those technical features you consider are essential to the way your invention works (see page 1 lines 10 to 13 of the “shaker can” example). After this statement, list the various preferred or optional features of your invention (see page 1 line 23 to page 2 line 4 of the example).

The remainder of the description sets out the best way or ways you know of putting your invention into effect. This must be described in sufficient detail so that someone with knowledge of the technology could reproduce your invention from the information given. You may include examples and drawings to help describe your invention, but it is not necessary to include manufacturing details such as dimensions if they are not critical to the way your invention works. It is optional whether the provisional specification also includes claims that define your invention.

The example specification describes in detail an improved shaker can with reference to Figures 1–4. The figures are listed and a few words are given against each figure in the list to explain what it illustrates. The features of the shaker can illustrated in the figures have been given their own reference numeral which is used when referring to those features in the description. Only one example of a shaker can

according to the invention is described, but where an invention can take different forms it may be desirable to describe several examples of the invention.

Note how the specification describes the material to be used in the shaker can. It makes it clear that a range of materials could be used to make the invention work. Obviously some materials would be more suitable than others, and certain specific examples are given on page 2 lines 1–4 of the sample specification.

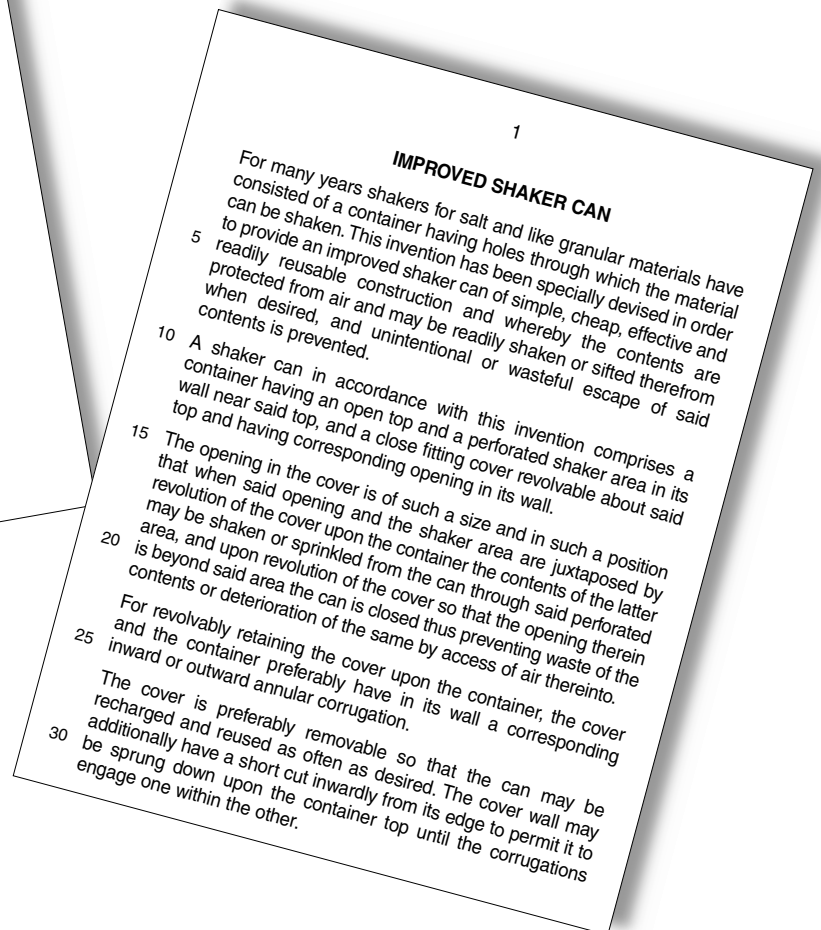
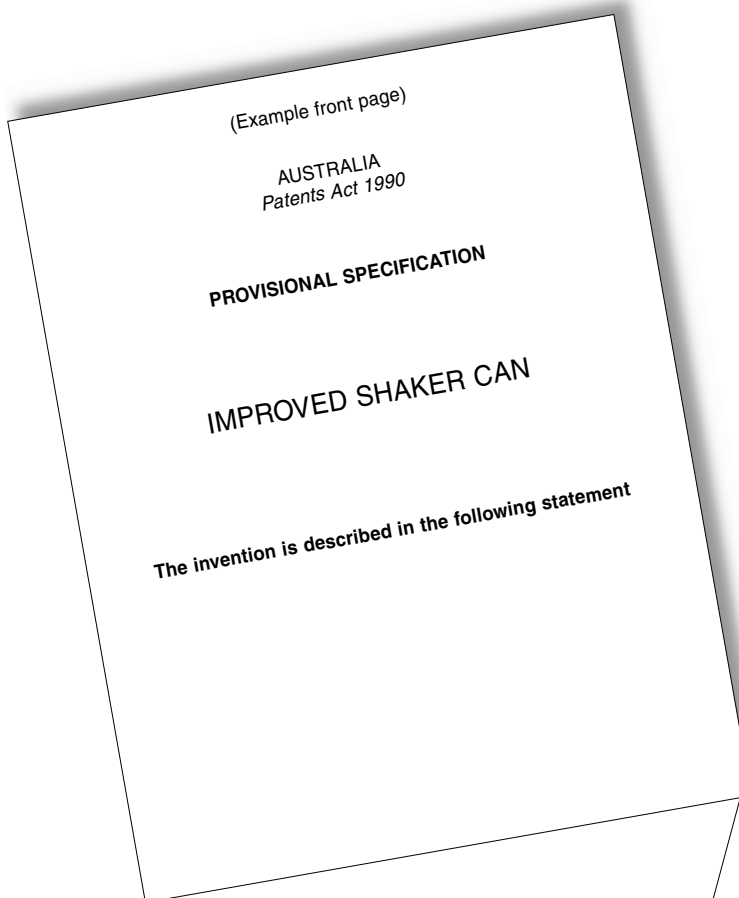
The feature of a “container” is an essential feature of the invention as the invention would not work without it, while the use of sheet metal, for example, for the container is a preferred choice of material.

The example specification illustrates the importance of including as full a description of your invention as possible before you file a provisional application.



Example *provisional specification*

You can use the example patent specification on the following pages as a general guide.



The shaker can is preferably made from sheet metal, however other materials can also be used. For example glass containers having sheet metal cover are found very suitable. The shaker can may also be made of a suitable food grade plastics material.

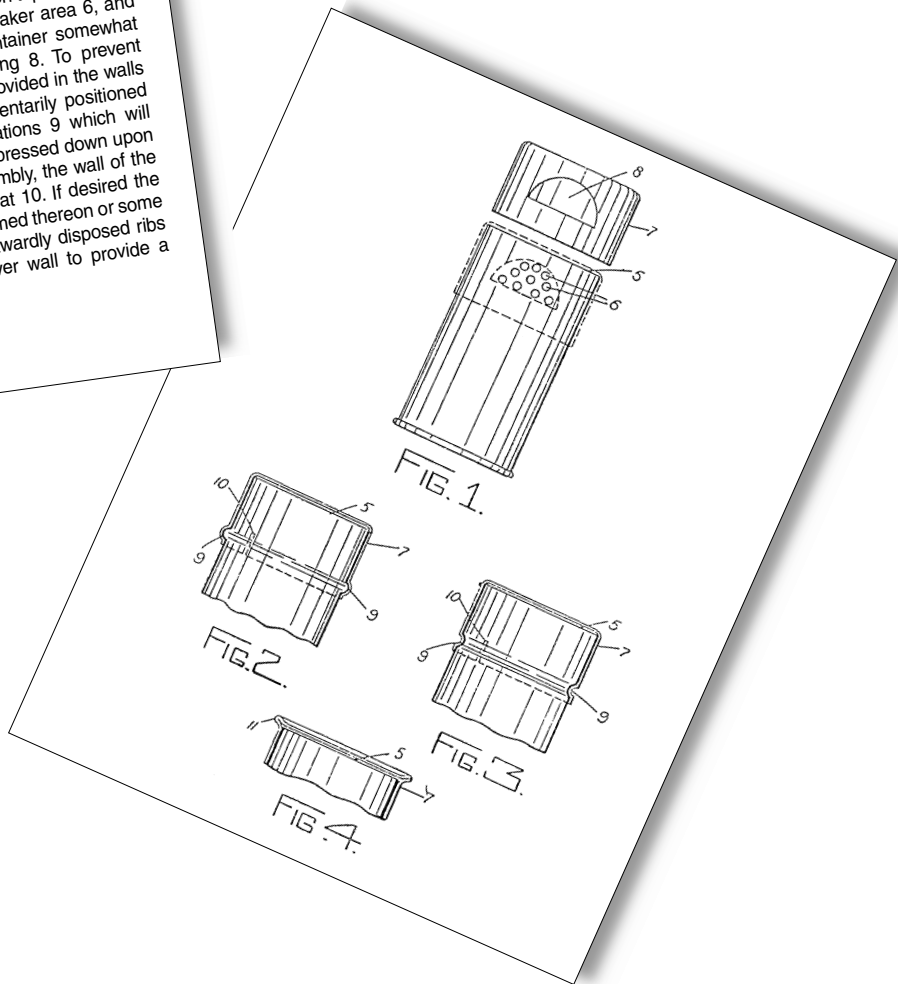
5 The invention may be better understood with reference to the illustrations of embodiments of the invention which:-

Figure 1 is an elevation of an improved shaker can with parts separated and the co-acting position of the cover dotted.

10 Figures 2 and 3 are diametrical sectional elevations of the top of a can showing the co-acting retaining means, and

15 Figure 4 is a similar view of the upper part of a cover having a flanged or beaded gripping rim.

The container shown which is cylindrical with open top 5 has in its wall near said top, perforations which form a shaker area 6, and the cover 7 which is made to fit upon the container somewhat tightly has in its wall a corresponding opening 8. To prevent unintentional removal of the cover 7 there is provided in the walls of the container and of the cover 7 complementarily positioned co-acting outward or inward annular corrugations 9 which will engage one with the other when the cover is pressed down upon the top of the container and to facilitate assembly, the wall of the cover may be cut inwardly from its edge as at 10. If desired the cover may have a gripping rim or bead 11 formed thereon or some bulbous projection of partial vertical and outwardly disposed ribs or corrugations may be formed in the cover wall to provide a secure grip when grasped by a hand.





Standard and *Innovation Patents*

Which type of patent should I choose?

There are two types of patent protection available in Australia—a **standard** patent and an **innovation** patent.

The innovation patent option aims to provide local industry with a relatively cheap form of intellectual property protection, which is quick and easy to obtain, for inventions having a short commercial life (eg. simple tools, utensils, machinery or equipment).

Because the inventive threshold has been lowered compared to a standard patent, an innovation patent is also suited to inventions demonstrating comparatively minor advances over existing technology which may not qualify for standard patent protection. This will help you to acquire rights for incremental inventions and start to recoup your investment at each stage of development.

For inventions in areas such as pharmaceuticals having a longer development and commercialisation cycle, or inventions in respect of less simple technological advances, a standard patent may be more suitable.

There is no simple rule for determining whether your invention is more likely to qualify for standard patent or innovation patent protection. This depends entirely on the nature of the advance made by your invention and what is already known in the same field of technology. Searching patent information can help you decide which option to choose. If assistance is needed in searching patent databases you can contact your local IP Australia state office, a patent attorney or a specialist search service.

An innovation patent may be granted for the same subject matter as a standard patent, except plants and animals or the biological processes for their generation, but has a shorter term of protection than a standard patent—8 years as opposed to 20 (which can be extended to 25 years for inventions relating to pharmaceutical substances).

For both forms of patent, you cannot take legal action to enforce your rights without examination. Remember, however, that examination in either case is not automatic and only happens on request. The examination process, including the requirements that *must* be satisfied before you can obtain enforceable rights, is explained later in this publication.

Filing a standard or innovation patent application in Australia

How do I apply for a standard or innovation patent?

You can apply in the same way as for a provisional application, or you can apply online through our website (which entitles you to a fee reduction).

If you apply online you can electronically attach files you have previously created to do with your application. Due to international patent standards these files **must be** in a PDF, JPEG, TIFF or TXT format. We do not accept word processing documents in a DOC format.

When should I apply?

If you file an application for either an innovation patent or a standard patent:

- ▶ within 12 months of filing a provisional application; and
- ▶ the provisional application adequately describes your invention

the priority date of your standard or innovation patent application is the date on which the provisional application was filed. If you do not file a provisional application, or the above conditions are not satisfied, the priority date of your standard or innovation patent application is its date of filing.

If you lose the earlier priority date established by your provisional application, and have to rely on the later filing date of your standard or innovation patent application, you may not be able to patent your invention if you have publicly disclosed it between these earlier and later dates. However there is a *grace period* which may help if you unintentionally disclose your invention before applying—see our publication *The Patents Guide*.

What documents do I need to file?

Applications for standard patents or innovation patents are called complete applications. For each type of patent, your complete application should include:

- ▶ A complete specification including an abstract, typed in English;
- ▶ Either a *Patent Request: Standard Patent* or a *Patent Request: Innovation Patent* form;



- ▶ A *Notice of Entitlement* form (standard patents only), although you can file this form at a later stage as part of the examination process; and
- ▶ The filing fee.

If you file a complete application and do not pay the filing fee at that time, we will send you a notice (“Invitation to Pay”) advising you of the fee and that you have two months from the date of the notice to pay in full, or your application will lapse.

How much does it cost?

To enable IP Australia to process your application, and to keep your application or patent in force, you will have to pay certain fees. Our main fees for standard and innovation patents are set out in the information sheet *Patent Fees* at the back of this publication.

Patent attorneys also have their own schedule of fees. Patent costs vary from case to case and increase significantly if you seek protection overseas. Gather this information together as soon as possible so that you know how much you can expect to pay to protect your invention initially and over time. If you choose to pursue patent protection without professional assistance, you should take extreme care to understand the fees you will be required to pay and when you are required to pay them.

Payments can be made

- ▶ Online (for the filing fee only—your personal or business credit card will be required if you make a payment this way);
- ▶ At any of our state offices (cash, cheque, money-order, debit or credit card);
- ▶ By post (cheque, money-order, ‘Payment Options’ form for credit card);
- ▶ By fax (using the ‘Payment Options’ form for credit card) to our secure business transaction fax (02) 6283 7999; or
- ▶ By Electronic Funds Transfer (EFT)—remittance advice required. To arrange please contact 1300 651 010, download the form from our website, or visit one of our state offices.

Cheques should be made payable to IP Australia.

We accept MasterCard, Visa and BankCard credit cards.

Preparing your complete application

Patent Request form—standard patent

A blank copy of the patent request form for standard patents together with instructions for filling it in are included at the back of this publication, or the form can be downloaded from our website. An electronic version is used if you apply online. Please read the instructions carefully before filling in the patent request form, and **keep a copy for your own records.**

Notice of entitlement — standard patent

The notice of entitlement must be made by each applicant, or their patent attorney, and state the entitlement of the applicant(s) to the grant of a patent. A blank copy of the notice together with instructions for filling it in can be found at the back of this publication, or the notice can be downloaded from our website. **Keep a copy of the notice of entitlement for your records.**

Patent Request form—innovation patent

A blank copy of the patent request form for innovation patents together with instructions for filling it in are included at the back of this publication, or the form can be downloaded from our website. The form is made up of three parts and, depending on the number of applicants and the nature of the invention, you will need to complete Part A and possibly Part B and/or Part C. All completed parts must be signed by the same person and filed at the same time. **Keep a copy of all completed parts for your records.**

Complete specification

A complete specification should be drafted carefully since this is the document on which a patent, if granted, is based. IP Australia cannot help you do this and we therefore recommend you consult a patent attorney. **Please keep a copy of the complete specification for your records.**

The sample complete specification beginning on page 16 is written as a complete specification for an innovation patent, although the level of detail required when describing your invention is the same for a standard patent or a provisional specification. Remember that it is important to include as full a description of your invention as possible



before you file a complete application. A complete specification must also end with at least one claim, and include an abstract.

For a standard patent you can have any number of claims.

An innovation patent can have up to five claims.

Claims—a very important concept

The claims form the focus of a complete specification since the scope of the monopoly given by a patent is legally determined by the claims, **not** the description. The claims must:

- ▶ be clear and concise;
- ▶ distinguish your invention from what is already known;
- ▶ set out all the essential technical features of your invention; and
- ▶ be consistent with the description.

Statements about attributes or advantages of your invention are **not** suitable as claims.

You should also be aware that you may lose the priority date established by an earlier provisional application if the claims include a feature which you did not describe in the provisional specification.

Page 3 of the example specification gives examples of *independent*, *dependent*, and *omnibus* claims.

Independent claims

Claim 1 of the example specification is an *independent* claim because it does not refer to any other claim. It defines only those features that are essential to the operation of the shaker can. In a complete specification, it is common to use the same words in claim 1 as in the statement of the essential features of the invention in the description (this is shown in the example). Claim 1 states that the container has an open top and perforations in its wall. The construction of the cover is not explicitly specified, other than that it must be able to revolve about the top and must have any opening in its wall corresponding to the perforations. These are the essential features of the shaker can, and the applicant would hope that those features alone would be sufficient to distinguish the claimed invention from existing shaker cans.

A complete specification for a standard or an innovation patent can include more than one independent claim but they must all relate to the same invention. For example, if your invention is a new product, you may be able to include independent claims for the product, a new process specifically adapted to make the product, and perhaps a new apparatus to carry out that process.

Dependent claims

Claims 2 to 4 of the example specification are *dependent* claims, because they make explicit reference to one or more previous claims by using such phrases as “The shaker can as claimed in claim 1”.

In the example specification, each of claims 2 to 4 add an extra feature. Claim 2 claims all the features in claim 1 combined with those specified in claim 2. Claim 4 claims as one alternative, the features of claim 1 combined with the features of claim 4. It also claims as another alternative, the features of claim 1 combined with the features of claim 2 and the features of claim 4, and so on.

The extra features specified in dependent claims would be features that you consider to be desirable or optional—such as the use of sheet metal in claim 3 of the example specification—but not essential to your invention. They are sometimes used as a safeguard just in case the invention in the *independent* claim is shown to be invalid, and may also be of value when negotiating a licence agreement with a manufacturer to make and sell your invention.

Omnibus claims

An omnibus claim is a special form of claim. Very simply, it claims the most preferred form of your invention with reference to the description and/or drawings. See claim 5 of the example.

Abstract

You should include an abstract at the back of your specification. This is a brief summary of your invention which will help the reader to quickly identify the key features. The example includes an abstract for the shaker can.



If you leave things out

It is very important that you put into the description and drawings all the necessary information about your invention before you file a complete application.

If you leave something out of a complete specification you may be able to add it later to the specification but you will usually not be able to claim it. However in some circumstances you may be able to get patent protection by filing another type of patent application. This is discussed in our fact sheets *Patents of Addition* and *Divisional Applications*.



Example *complete specification*

You can use the example patent specification on the following pages as a general guide.

(Example front page)

AUSTRALIA
Patents Act 1990

COMPLETE SPECIFICATION
INNOVATION PATENT

IMPROVED SHAKER CAN

The following statement is a full description of this invention, including the best method of performing it known to me:

1

IMPROVED SHAKER CAN

For many years shakers for salt and like granular materials have consisted of a container having holes through which the material can be shaken. This invention has been specially devised in order to provide an improved shaker can of simple, cheap, effective and readily reusable construction and whereby the contents are protected from air and may be readily shaken or sifted therefrom when desired, and unintentional or wasteful escape of said contents is prevented.

10 A shaker can in accordance with this invention comprises a container having an open top and a perforated shaker area in its wall near said top, and a close fitting cover revolvable about said top and having corresponding opening in its wall.

15 The opening in the cover is of such a size and in such a position that when said opening and the shaker area are juxtaposed by revolution of the cover upon the container the contents of the latter may be shaken or sprinkled from the can through said perforated area, and upon revolution of the cover so that the opening therein is beyond said area the can is closed thus preventing waste of the contents or deterioration of the same by access of air thereinto.

For revolvably retaining the cover upon the container, the cover and the container preferably have in its wall a corresponding inward or outward annular corrugation.

25 The cover is preferably removable so that the can may be recharged and reused as often as desired. The cover wall may additionally have a short cut inwardly from its edge to permit it to be sprung down upon the container top until the corrugations engage one within the other.

30

The shaker can is preferably made from sheet metal, however other materials can also be used. For example glass containers having sheet metal cover are found very suitable. The shaker can may also be made of a suitable food grade plastics material.

- 5 The invention may be better understood with reference to the illustrations of embodiments of the invention which:-
 10 Figure 1 is an elevation of an improved shaker can with parts separated and the co-acting position of the cover dotted,
 Figures 2 and 3 are diametrical sectional elevations of the top of a can showing the co-acting retaining means, and
 15 Figure 4 is a similar view of the upper part of a cover having a flanged or beaded gripping rim.

The container shown which is cylindrical with open top 5 has in its wall near said top, perforations which form a shaker area 6, and the cover 7 which is made to fit upon the container somewhat tightly has in its wall a corresponding opening 8. To prevent unintentional removal of the cover 7 there is provided in the walls of the container and of the cover 7 complementarily positioned co-acting outward or inward annular corrugations 9 which will engage one with the other when the cover is pressed down upon the top of the container and to facilitate assembly, the wall of the cover may be cut inwardly from its edge as at 10. If desired the cover may have a gripping rim or bead 11 formed thereon or some bulbous projection of partial vertical and outwardly disposed ribs or corrugations may be formed in the cover wall to provide a secure grip when grasped by a hand.

The claims defining the invention are as follows:

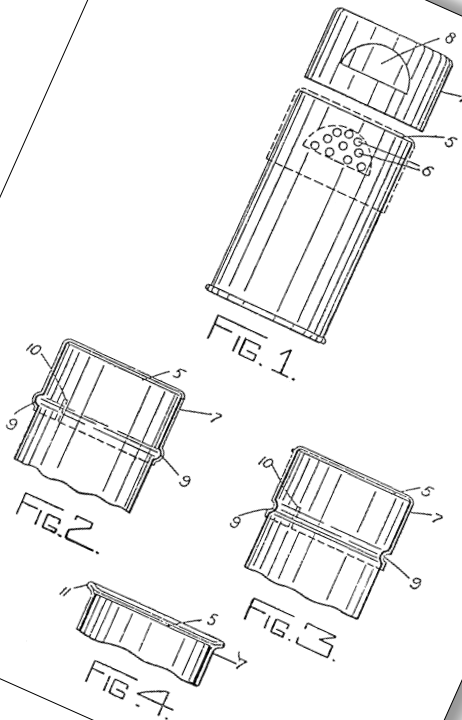
1. A shaker can comprising a container having an open top and a perforated shaker area in its wall near said top and a close fitting cover revolvable about said top and having a corresponding opening in its wall.
2. A shaker can as claimed in claim 1, wherein the container has an annular outward or inward corrugation in its wall, and the cover has a corresponding complementary outward or inward annular corrugation in its wall which allows for retaining the cover tightly and revolvably on the container.
3. A shaker can according to any claims 1 and 2 wherein the container and cover are made from sheet metal.
4. A shaker can according to any of the claims 1-3 wherein the cover has a gripping rim or bead formed thereon.
5. A shaker can substantially as herein before described with reference to figures 1-4 of the accompanying drawings.

SHAKER CONSTRUCTION INC.
 (Name of Applicant(s))

1 JUNE 2001
 (Date)

ABSTRACT

The disclosed shaker can is a cylindrical container with an open top 5 having in its wall near said top, perforations which form a shaker area 6 and a cover 7 which is made to fit upon the container somewhat tightly and having in its wall a corresponding opening 8 so that when the opening 8 and the shaker area 6 are juxtaposed by revolution of the cover 7 upon the container, the contents may be shaken or sprinkled from the can through the perforations and upon revolution of the cover so that the opening 8 therein is beyond the area 6, the can is closed. To prevent unintentional removal of the cover 7 there is provided in the walls of the container and of the cover 7 complementarily positioned co-acting outward or inward annular corrugations 9 which will engage one with the other when the cover is pressed down upon the top of the container.



Converting your complete application to a provisional application

You can convert a complete application into a provisional application. This can be useful if you originally filed a complete application rather than a provisional, and have since made some improvements to your invention. It is usually not possible to claim these improvements in the originally filed complete application.

You can ask us to treat the originally filed complete application as a provisional application if:

- We have not published your complete application;
- We have not examined and accepted your complete application; and
- It is less than 12 months since you filed the complete application.

If these conditions are met the originally filed complete application will be treated as though it has always been a provisional application. It is then possible to file another provisional application which describes the improvements to your invention, followed by a complete specification associated with both provisional applications. However it is important to remember that this complete application must be filed within 12 months of filing the original complete application. You should also be careful not to publicly disclose the improvements before filing the later complete application.



Processing your *innovation* patent application

Approving your innovation patent application

After you have filed a complete application for an innovation patent, IP Australia will conduct a simple formalities check to make sure that your application is in order.

Generally, within one month you will receive notification from IP Australia formally granting you an innovation patent, provided you have paid the filing fee. Please note that as the innovation patent is granted without substantive examination, IP Australia has not assessed whether the patent is valid which may make it more difficult to sell or license.

It is also important to note that to legally enforce your rights to your invention within the marketplace, your innovation patent must be certified following substantive examination.

Thus if your innovation patent is infringed, or you believe it is being infringed, you can take legal action against the infringing party **only** if your innovation patent is examined and certified.

Examination and certification of innovation patents

An innovation patent is not automatically examined. To request an examination, you must complete a *Request for Examination* form, and pay the required fee. **However you should appreciate that if it is examined and found invalid, your innovation patent will cease.** After examination is requested, IP Australia will assess your patent to see that it meets the requirements of the *Patents Act*, and in particular:

- ▶ Is the description sufficiently clear and complete?
It is extremely important that you put into the description (including any drawings) all the necessary information about the technical details of your invention.
- ▶ Do the claims define a **manner of manufacture**? This is a legal term used to distinguish inventions which are inherently patentable from those which are not.

A patent may be granted for a device or machine, an industrial, chemical or biochemical product or process, computer hardware and software, and in some cases even a business method—in short, almost anything commercially useful. However no matter how ingenious or unusual they may be, you cannot patent artistic creations, mathematical models, theories, ideas or purely mental processes.

- Do the claims define an invention which is **novel** (ie “new”)?

This means that the features of your invention as defined in the claims must not have been publicly disclosed before your priority date anywhere in the world.

To assess whether your invention is novel, IP Australia usually compares the claims against information contained in Australian and overseas patent specifications, but we may also look at other sources of information such as text books, technical journals and the Internet.

- Do the claims define an invention which involves an **innovative step**?

The information against which the presence of an innovative step is assessed is the same as that used to determine novelty. To be novel your invention must differ from what has been published about existing technology. The innovative step test requires this difference to be of practical significance to the way your invention works so as to make a “substantial contribution” to the working.

In most situations this test will be met if the difference between your invention and existing technology is not trivial. On the other hand the contribution to the working is unlikely to be “substantial” if the difference does not improve or even change the way your invention works.

- Are the claims and the description in respect of the same invention, that is, are the claims **fairly based**?
- Do the claims define only one invention?

You will then receive one of two possible replies to your request for examination:

- A notice that your patent has been successfully certified, in which case your rights are then legally enforceable; or



- ▶ An adverse report which will give you reasons why your innovation patent, in its present form, does not meet the requirements of the *Patents Act*.

The next step depends on the problems identified in the report. Often you can resolve these by changing your description or claims. This procedure may need to be repeated until we are satisfied that the problems identified have been overcome. **However if the problems cannot be overcome, for example because you did not fully describe your invention when you filed your complete application, or your invention is indistinguishable from existing technology, your innovation patent will cease.**

Further details about the examination procedure are in our fact sheet, *Responding to a Patent Examination Report*, which we send out with adverse examination reports.

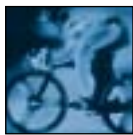
At any time after certification third parties are able to start proceedings (called an opposition) conducted before the Commissioner of Patents to show that your innovation patent is invalid—see *Acceptance, Opposition and Grant* on page 23.

Examination requests from third parties

Third parties can also request examination of your innovation patent. They pay half of the examination fee, and then you must pay the balance of this fee, because if your patent is certified, you stand to benefit from this action. If a third party requests examination and you do not pay the balance, the patent will cease. The third party is not given a copy of any notice or examination report sent to you.

Search results

Before a certificate of examination can be issued, you are required to give IP Australia within certain time limits the results of any searches conducted by overseas patent offices for the purposes of assessing the patentability of your invention.



Processing your *standard* patent application

Requesting examination of standard patent applications

You can request early examination of your complete application for a standard patent, but you should be careful about initiating this action.

Early examination and grant of a patent can have unexpected results, such as publication of your application before you have had a chance to file overseas. Remember that when granted, your patent rights can be retrospectively enforced from the publication date of your complete application, so there is usually no benefit in finalising your patent quickly unless you need to take immediate legal action against an infringer or require a granted patent for licensing or financing negotiations.

Most applicants wait until IP Australia directs them to request examination, generally around two years after the complete application is filed. After you receive the direction, you will have a further six months in which to request examination thus allowing you more time to assess the value of continuing the patenting process. If you don't request examination, your complete application will lapse.

To request examination, you must complete a *Request for Examination* form, which is supplied as part of the direction to request examination, and pay the required fee.

You are also required within certain time limits to give IP Australia the results of any searches conducted by overseas patent offices for the purposes of assessing the patentability of your invention.

Examination of standard patent applications

A complete application for a standard patent is assessed against the same substantive requirements of the *Patents Act* as an innovation patent, except that your invention must involve an **inventive step**.

The test for an inventive step requires a comparison of your invention as defined in the claims with the same information used to determine novelty in relation to innovation patents, *in addition* to standard background knowledge in the technical field of your invention (the

legal term is “common general knowledge”) which includes common work practices as well as standard texts and handbooks, technical dictionaries and other material widely consulted in the field.

The inventive level for standard patents is higher than that for innovation patents. In both cases your invention must differ in some way from existing technology. For an innovation patent this difference need only make a substantial contribution to the working of your invention. However for a standard patent the difference, though contributing to the working, must have resulted from something more than the simple application of published information and/or standard background knowledge.

Similarly to the examination procedure for innovation patents, the reply you receive to your request for examination will either be an adverse report or a notice that your standard patent application has been accepted. If adverse, you will be given the opportunity to make changes to your specification to correct the problems identified.

However if the problems cannot be overcome, your complete application will lapse.

The “Modified” Examination Procedure

If you have applied for a *standard* patent in Australia, and have applied for a patent for the same invention in either the USA, Canada, New Zealand or a country that is a signatory of the European Patent Convention, such as the United Kingdom, you may qualify for a special form of examination called modified examination. For more information see our fact sheet *Modified Examination*.

Acceptance, Opposition and Grant

IP Australia will accept your application when we consider it meets the requirements for a standard patent. Third parties then have three months to start opposition proceedings to show that your standard patent, if it is granted, would be invalid.

Very few accepted standard applications or certified innovation patents are opposed but if you become involved in an opposition you should seriously consider consulting a patent attorney. If you require more information about oppositions, see our fact sheets entitled *Patent Oppositions* and *Innovation Patent Oppositions*.

After the opposition period, if no opposition is filed, your accepted standard application is sealed and your patent deed is sent to you.



Enforcing your *patent rights*

Once you have a standard patent, or a certified innovation patent, you are responsible for protecting your rights to your invention. If you find that someone has been exploiting or copying your invention without your permission, you are urged to seek professional advice as these matters can often be settled through negotiation before taking costly legal action.

Extensions of time

You may need to apply for an extension of time to restore a patent or patent application that has lapsed because you *unintentionally* failed to pay a fee or take some other action in time. For example, perhaps you have lost your priority rights because you did not file a complete application within 12 months of your provisional application.

Before being given an extension of time you must explain in a statutory declaration the chain of events that caused the relevant fee not to be paid, or the act not done, in time even though you intended to do so, and pay any unpaid fees. For further information please see our fact sheet, *Applying for an Extension of Time*.

Other forms of intellectual property rights

If you have decided to proceed with a patent application, then you are more than likely expecting some sort of commercial benefit. Patented products are often allocated a name or logo by the owner which is then used to distinguish the product in the marketplace, or when negotiating a sale or license agreement. A registered trade mark may be a worthwhile investment as it provides you with IP rights relating to that name or logo. For more information about registering trade marks, contact IP Australia.

Similarly, if the way your invention “looks” is important to its potential success in the market, you may want to apply for a registered design through IP Australia.



Contacting *IP Australia*

IP Australia staff are happy to help you and answer your queries. However we cannot assist clients on legal matters or provide business advice. You may wish to consult a patent or trade mark attorney, a solicitor experienced in intellectual property matters, or your business advisor.

IP Australia subscribes to the **Telephone Interpreter Service**. If you need help communicating in English, you can phone the interpreter service on 131 450 for the cost of a local call from anywhere in Australia.

All written correspondence regarding patents should be directed to The Commissioner of Patents.

Postal address: PO Box 200, WODEN ACT 2606

Phone: 1300 651 010

General Enquiries — for the cost of a local call, contact our **Customer Service Network** for general information relating to patents, trade marks, designs or plant breeder's rights and for assistance with subscriptions, sale of publications and electronic communication.

Fax: (02) 6283 7999

Business Transactions Fax—for lodgement, filings and business related correspondence such as financial and confidential material. Faxes received at this secure number are receipted at Australian Eastern Standard/Daylight Saving time.

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.

State offices

Our state offices are open from 9.00am to 5.00pm weekdays (except local public holidays) and can provide assistance, resources including computers to search our databases, and published reference materials.

Canberra

Ground Floor
Discovery House
47 Bowes Street
PHILLIP ACT 2606
Fax (02) 6283 7999

Adelaide

Level 10
Origin Energy House
1 King William Street
ADELAIDE SA 5000
Fax (08) 8239 4507

Brisbane

Level 1
Grant Thornton House
102 Adelaide Street
BRISBANE QLD 4000
Fax (07) 3007 1107

Hobart

Level 4
AMP Building
27 Elizabeth Street
HOBART TAS 7000
Fax (03) 6235 6307

Melbourne

Level 6
OCBC House
565 Bourke Street
MELBOURNE VIC 3000
Fax (03) 9612 9807

Perth

Level 2
Eastpoint Plaza
233 Adelaide Terrace
PERTH WA 6000
Fax (08) 9220 8907

Sydney

Level 1
45 Clarence Street
SYDNEY NSW 2000
Fax (02) 9249 5807

We encourage you to use our business transactions fax number (02) 6283 7999 to obtain certainty of time and date for lodgement of applications and other correspondence.



Customer Service Charter

IP Australia is committed to being a customer focused organisation. To help our customers, IP Australia has a Customer Service Charter outlining the standards of service you can expect from us. To obtain a copy of the charter, simply ring **1300 651 010** or visit our website.

Communicating electronically with IP Australia

The date which you provide information to IP Australia can be critical to the certainty of your intellectual property rights.

IP Australia has implemented a set of business rules which establish that when you communicate with us electronically (eg. email, fax or online) using our preferred contact numbers and methods, the date and time of communication will be Australian Eastern Standard/Daylight Saving time.

Our preferred means of electronic communication are:

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

Communications 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.

Further details on IP Australia's electronic communication business rules can be found at **www.ipaustralia.gov.au/pdfs/general/eta.pdf**