

PROCEDURES FOR OBTAINING PATENT PROTECTION IN AUSTRALIA

What is a Patentable Invention?

Not all ideas give rise to patentable inventions. A patentable invention must have some practical use. A scheme or plan, the discovery of a property or phenomenon already existing in nature, a working direction to use known devices, or the simple provision of information, are not patentable inventions. Also, a mere collection of known parts that do not interact together to alter the working of the whole thing will not be granted patent protection.

However, the decision as to what is patentable is often a grey area and is where the specific advice of a Patent Attorney is needed.

When is a Patentable Invention Patentable?

For a patentable invention to be capable of protection it must be new and inventive.

Types of Patents

Standard Patent

Provides protection for 20 years from the filing date of the patent application.

Applying for Patent Protection

To seek patent protection, it is necessary to lodge a patent application with the Australian Patent Office.

The filing date of the application is called the priority date of the application. The newness of the invention will be judged based on the priority date of the patent application. It is possible to file initially either a provisional application or a complete application.

A provisional application is usually lodged if the invention is in its early stages and not yet fully developed or understood. A complete application is lodged in the first instance if the invention is thought to be finalised.

If a provisional application is lodged, a complete application must be filed within 12 months from the filing date of the provisional patent application.

An advantage of filing a provisional application prior to filing the complete application is that any improvements made to the invention after filing the provisional application can be included in the complete application. This is not the case if a complete application is filed first.

Another advantage of lodging a provisional application prior to filing the complete application is the availability of an international-type novelty search which is conducted by the Australian Patent Office on request, after lodgement of the provisional application.

Publication of the Application

After lodgement of the complete application, the application will be published within 18 months of the priority date.

After publication of the application, the complete application and the provisional application (if lodged) will become open to public inspection at the Patent Office and any member of the public may obtain a copy of the application, including a copy of the specification describing the invention.

Examination of the Application

The complete patent application will have to be examined to be accepted. Examination may be requested at any time after lodgement of the complete application, and must be lodged within five years of that date. If there are grounds for objecting to the application, an examination report will be issued.

The most common grounds for objecting to the application are:

- whether the wording of the specification describing the invention is clear
- whether the invention is novel and inventive
- whether the invention is a patentable invention.

In order to place the application in a condition for acceptance, it is necessary to argue against the objections and/or to prepare amendments to the application. After this has been done, a further examination report will issue, either accepting the application or maintaining an earlier objection.

Acceptance and Grant

After all objections raised by the Patent Office have been overcome, the patent application will be accepted.

A copy of the complete specification is published approximately six weeks after it has been accepted.

Third parties have the opportunity to formally oppose the grant of the patent. On expiration of the opposition period, and where no successful opposition has occurred, the patent will be granted.

Infringement

We recommend that an owner of a patent application or a patent immediately seek the advice of a Patent Attorney if there appears to be an infringement. Legal action cannot be taken until a patent is granted, however, there are various mechanisms available for speeding up the prosecution of a patent application if necessary.

Renewals

Annual fees are payable on an application and the resulting patent from the end of the fourth year until the twentieth year.

Costs

Costs will be incurred in respect of each of the above options and the many stages in applying for, obtaining and maintaining your patent protection. We can provide detailed advice of the costs likely to be incurred in any proposed course of action should you require it.

About Wrays

Wrays is a leading IP specialist firm in Australia, bringing together the right combination of experts to protect, grow and defend our client's intellectual property assets locally and globally for more than 100 years.

And when you combine our passion for achieving the best result with our broad capability across the IP spectrum, it's our clients who enjoy the benefits. In day-to-day reality, this means bringing the right people in the room every time and working together across disciplines to deliver what's needed.

It doesn't stop there. Through our extensive local and global networks, we can connect clients with like-minded experts who deliver supporting services, such as private equity, tax advisors, corporate and employment law, as well as IP specialists around the world servicing other jurisdictions.