2. National

2.1 General Approach to Examination

Modified Date: 01 June 2018

2.1 General Approach to Examination

National examination is based on the following four principles:

1. Produce clear and informative reports which provide detail at the most effective stage.
2. Provide transparency of decision making to reinforce confidence in examination.
3. Conduct high quality and cost effective searches.
4. Use foreign examination reports (FERs) and search results effectively.

The following sections provide further information regarding these principles.

Examination of an application must be conducted efficiently to facilitate clear and informative reporting which provides detail at the most effective stage of the examination process. Each report must be as comprehensive as possible in the circumstances of each individual case. At each stage examiners should focus on the key issues of invalidity, i.e. sec 40 and sec 18 issues, which affect the prosecution of the case. This has been determined to be the most effective way to facilitate progress of an application.

The most effective stage is the earliest point during the prosecution of an application when examiners are able to identify these key issues. Most often this will be the point at which the scope of the monopoly sought, or the alleged inventive concept, can be reasonably identified. In complex cases, it is often difficult to determine where the actual invention resides at first report and it is only at further reports that the key issues of invalidity can be properly understood. Factors which determine the most effective stage and the level of detail required in a report include the number of claims, very broad or divergent claims, or multiply dependent claims. Other factors which need to be considered are the complexity and number of citations and/or foreign examination reports (FERs), and where the technology is particularly difficult.
2.1.2 Searching and Use of IPRPI/IPRPIIs and Other Foreign Examination Reports (FERs)

This approach allows higher levels of detail to be invested in issues and in claims that are in dispute, or critical to progressing the application. It also recognises that once these major issues are addressed, minor or peripheral issues will often be overcome at the same time.

At each stage of examination, the key issues of invalidity will primarily require a detailed consideration of the independent claims, with a more generalised approach for the dependent claims. The level of attention paid to dependent claims is a matter of judgement on the part of examiners.

While this approach allows flexibility in dealing with complex cases and those where it is difficult to clearly determine what the claimed invention is likely to be after amendment, or what is the inventive concept disclosed, examiners are still required to consider all key invalidity issues and report on those that may reasonably be determined from the application.

The same general approach also applies to further reports. Ideally, amendments and/or submissions will resolve the issues but this is not always the case. If the issues raised in the previous report have not been resolved by amendments or submissions, or new issues have arisen as a result of either, then a further report addressing the new or continuing issues will be required. At later report stages issues generally become narrower and require deeper analysis and examiners will often need to provide further detail in their reports to cover issues in dispute. However, it will generally not be necessary to provide extra detail for issues raised at an earlier report which have not been challenged or overcome in the applicant’s response.

In both complex cases and at further report stages, more detailed argument is frequently required and clarity of reasoning is particularly important. These considerations are also crucial when engaging in discussions with the applicant via phone.

Where such complexities arise and the examiner is having difficulty determining a suitable approach, or where, at later report stage, progress of the remaining matters stalls, examiners should, in the first instance, refer the case to a senior examiner for advice. Depending on the nature of the issue and whether the problem persists, the matter should be escalated to the supervising examiner (see also 2.1.3 Flexible Approach for Complex
Cases).

Modified Date: 14 June 2016

2.1.2 Searching and Use of IPRPI/IPRPIIs and Other Foreign Examination Reports (FERs)
2.1.3 Flexible Approach for Complex Cases

Guidelines for search procedures and the use of IPRPI/IPRPIIs and other FERs are provided in:

- 4.1.3.2 Earlier Search Results; and
- 2.1.9 Guidelines for Using IPRPI/IPRPIIs and Other Foreign Examination Reports (FERs) in Examination.

Modified Date: 14 June 2016

2.1.3 Flexible Approach for Complex Cases

In this topic:

There is no single best practice for examining and reporting on complex cases. The most important attribute is retaining flexibility in examining such cases on their individual merits and recognising that different approaches may achieve similar outcomes. Consultation with senior examiners and supervising examiners is also recommended in these situations.

Cases With Large Numbers of Claims, Very Broad or Divergent Claims, or Multiply Dependent Claims

For large numbers of claims, examiners should consider each independent claim and broadly object to their dependent claims as appropriate. Multiple independent claims can be grouped where possible and considered together.

Where there are many independent claims with different combinations of features, it is often not clear which features define the actual invention. If the applicant is likely to amend the claims to clarify the invention, substantial examination may be reserved for further report stages. Additional searching may also be required at further report once the claims and/or description have been amended or reassessed in view of applicant submissions; see 4.1.3.3 Additional Searching.

In extreme cases, examiners can reserve examination and report on all issues until the applicant has clarified the invention. This should be a “last resort” approach (for example, in the situation where there are many independent claims as discussed above) and should be taken in consultation with a senior examiner or supervising examiner. Where the report is restricted in some manner, a note to this effect must be included in the report. The note...
2.1.3 Flexible Approach for Complex Cases

should include the reasons for restricting the report, together with the advice that opinion in respect of those matters not covered by the report is reserved.

Examiners should note that the report may also be restricted in other circumstances; see 2.1.4 Restriction of the Extent of the Report.

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### Multiple Citations

Where multiple citations are available (e.g. from one or more FERs), examiners should concentrate on the “best citation(s)” or, if all citations are of close or equivalent disclosure and there is no “best citation”, on one of the citations, and can refer to a representative selection of the other relevant citations in a more general way. See also:

- 2.1.7.1 Discussion of Citations
- 2.1.7.4 Citing Many Citations
- 2.1.9.4.2 Identifying Citations, Multiple Citations

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### Multiple FERs

Examiners should make appropriate use of FERs and select the most relevant FER at each report stage, but will need to reconsider other FERs (including updates) at later report stages when the invention is clarified and/or amendments are made. Where there are many potentially relevant FERs, examiners should concentrate on any FER that is valid, highly relevant and deals with all key issues. In such cases it will generally not be necessary to consider other FERs in detail. However, examiners should remember to consider other FERs when their understanding of the claims changes, either as a result of amendments or in response to submissions from the applicant or attorney. See also:

- 2.1.9.3 FER Validation
- 2.1.9.4 FERs and Report Formulation
2.1.4 Restriction of the Extent of the Report

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.4A Restriction of the Extent of the Report.

In this topic:

Examiners may find it necessary to restrict their report, and reserve opinion on certain aspects, where deficiencies in the specification make it impractical to issue a comprehensive report.

Situations where restriction of the report may be justified are given below. This list is not exhaustive and there may be other circumstances where it is impractical to issue a comprehensive report due to deficiencies in the specification.

Note: Where the extent of the report is restricted in some manner, a statement to this effect must be included in the report. The statement should include the reasons for restricting the report, together with the advice that opinion in respect of those matters not covered by the report is reserved.

Inventive Concept Cannot be Determined From the Specification

Where the specification is drafted in such a way that it is impossible to determine from the specification as a whole what the inventive concept is, an objection should be taken that the specification does not fully describe the invention, because it is not possible to determine the features of the invention from the specification as a whole. Examiners may reserve opinion with regard to the requirements that the claims define the invention and are fairly based.
Claims of Indeterminate Scope

Where the claims are drafted in such a way that it is not possible to determine their scope in any meaningful way, and it is also not possible to determine the inventive concept from the description, examiners may defer the search and reserve their opinion (see 4.1.4.2.4 Reserving the Search). However, where the inventive concept can be determined from the description, the search should be conducted in respect of that subject matter, with a note included in the report indicating the subject matter searched.

Lack of Unity

Where the claims define more than one invention requiring additional searches, examiners should follow the procedures outlined in 2.1.6.2.4 Lack of Unity and 4.1.4.2.4 Reserving the Search.

Manner of Manufacture Issues

When the claimed invention is clearly not in respect of a manner of manufacture and it is not readily apparent what subject matter might reasonably be expected to be claimed, taking into account the contents of the description and drawings and the common general knowledge in the relevant technical field, the procedures outlined in 4.1.4.2.4 Reserving the Search should be followed.

Incorporation of New Matter

Where there has been new matter incorporated, such that the claims claim matter not in substance disclosed in the specification as filed, examiners should refer to 2.13.6 Matters of Form and 2.23.8.2 Section 102(1) Examination Practice, Reporting on Amendments Not Allowable Under Section 102(1).

Innovation Patent With More Than Five Claims
2.1.4A Restriction of the Extent of the Report

Where an innovation patent has more than 5 claims, and not all claims can be examined with negligible additional effort, examiners should object that the innovation patent does not comply with sec 40(2)(c) and reserve opinion on all other examination issues (see 2.31.4.4 Ground (1): Section 40).

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.4 Restriction of the Extent of the Report.

In this topic:

Examiners may find it necessary to restrict their report, and reserve opinion on certain aspects, where deficiencies in the specification make it impractical to issue a comprehensive report.

Situations where restriction of the report may be justified are given below. This list is not exhaustive and there may be other circumstances where it is impractical to issue a comprehensive report due to deficiencies in the specification.

Note: Where the extent of the report is restricted in some manner, a statement to this effect must be included in the report. The statement should include the reasons for restricting the report, together with the advice that opinion in respect of those matters not covered by the report is reserved.
2.1.4A Restriction of the Extent of the Report

Invention Cannot be Determined From the Specification

Where the specification is drafted in such a way that it is impossible to determine from the specification as a whole what the invention is, an objection should be taken that the specification does not disclose the invention in a clear enough and complete enough manner, because it is not possible to determine the features of the invention from the specification as a whole. Examiners may reserve opinion with regard to the requirements that the claims define the invention and are supported by the matter disclosed.

Claims of Indeterminate Scope

Where the claims are drafted in such a way that it is not possible to determine their scope in any meaningful way, and it is also not possible to determine what the invention is, examiners may defer the search and reserve their opinion (see 4.1.4.2.4 Reserving the Search). However, where the invention can be determined from the description, the search should be conducted in respect of that subject matter, with a note included in the report indicating the subject matter searched.

Lack of Unity

Where the claims define more than one invention requiring additional searches, examiners should follow the procedures outlined in 2.1.6.2.4 Lack of Unity and 4.1.4.2.4 Reserving the Search.

Manner of Manufacture Issues

When the invention claimed is clearly not in respect of a manner of manufacture and it is not readily apparent what subject matter might reasonably be expected to be claimed, taking into account the contents of the description, drawings, graphics and photographs and the common general knowledge in the relevant technical field, the procedures outlined in 4.1.4.2.4 Reserving the Search should be followed.

Incorporation of New Matter
2.1.5 Inconsistent or Piecemeal Examination

Where there has been new matter incorporated, such that amended specification claims or discloses matter that extends beyond that disclosed in the specification as filed, examiners should refer to 2.13.6 Matters of Form and 2.23.8.2A Section 102(1) Examination Practice, Reporting on Amendments Not Allowable Under Section 102(1).

Innovation Patent With More Than Five Claims

Where an innovation patent has more than 5 claims, and not all claims can be examined with negligible additional effort, examiners should object that the innovation patent does not comply with sec 40(2)(c) and reserve opinion on all other examination issues (see 2.31.4.4 Ground (1): Section 40).

Modified Date: 01 June 2018

2.1.5 Inconsistent or Piecemeal Examination

Examiners should ensure that all important objections are raised at each report stage, regardless of whether a particular objection was raised in a previous report. Whilst it is desirable that reports are comprehensive and identify all significant issues, thereby avoiding ‘piecemeal’ examination,* where examiners become aware that an objection should have been raised previously but was not, the appropriate course of action is to issue a further report that includes the objection. The report should also include an apology as appropriate. Whilst the raising of new objections may cause inconvenience, it is important that the applicant is informed of all significant issues and that these are identified prior to grant.

In circumstances, where it would appear to an applicant or attorney that the view of the Office has changed on a matter likely to be of some importance, the report should acknowledge, and apologise for, the situation, and provide an explanation.

*Note: It is not considered to be piecemeal examination if:

• not all significant issues are identified, but there are grounds for restricting the extent of the report and this restriction has been communicated to the applicant or attorney;

• new objections are raised in later reports on the basis of new search results or examination reports that have come to light since the issuance of the previous report;

• new objections are raised as a result of amendments or submissions from the applicant or attorney.
2.1.6 Examination and Report Requirements

Modified Date: 01 March 2013

2.1.6.1 Overview

Examination must be conducted efficiently by focusing on the key issues that affect prosecution of the case. Examiners should make appropriate use of FERs and other search results available at each stage of examination (see 2.1.9 Guidelines for Using IPRPI/IPRPIIs and FERs in Examination). Reports must be clear, accurate, informative and comprehensive to the extent indicated by applying the principle of providing detail at the most effective stage as discussed in 2.1.1 The General Approach to Examination.

Reports should include sufficient detail to ensure that major problems can be understood. At each stage reports should emphasise and detail the serious issues affecting progression of the application. In this regard, examiners should particularly focus on the key issues of invalidity, especially novelty, inventive step and patentable subject matter.

Examiners should report in detail on the independent claims and may generally report more broadly on the dependent claims. However, more detail should be provided for the dependent claims where examiners are readily able to determine that a particular feature or combination of features in those claims relates to the inventive concept and therefore likely to be promoted to an independent claim at a subsequent stage. Multiple independent claims, e.g. those with similar features, can be grouped where possible and discussed under the one objection.

All objections must have a statutory basis and should be succinct. They should commence by identifying the statutory basis of the objection, and follow with sufficient explanation, including details of any premise upon which the examiner relies (such as interpretation of a term) and relevant passages of citations, for the applicant to understand the nature of the issue sufficiently to address it. Different grounds of objection should not be mixed together, except for novelty and inventive step, which may be combined where appropriate (see 2.1.6.2.6 Novelty and Inventive Step). In most cases it can be assumed that claims which are not novel also lack inventive step and these issues need not be reported on separately.

Note: For:

- standard patent applications with an examination request filed on or after 15 April 2013;
- innovation patents with an examination request filed on or after 15 April 2013; and
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent;

objections under the grounds of lack of support and lack of clear enough and complete
2.1.6.2 Examination and Level of Report Detail

Modified Date: 01 May 2018

2.1.6.2.1 Clarity

While all claims must be clear and definite in scope, the dependent claims do not merit the same careful analysis and criticism as the independent claim(s). The level of attention paid to dependent claims is a matter of judgement on the part of examiners. As a general rule, dependent claims adding core features or characteristics, but not claimed in the independent claim(s), should be looked at more closely than those dependent claims adding clearly preferred features or characteristics.

Where a claim is considered to lack clarity, it is not sufficient to merely object that the claim is not clear. The objection will generally need to explain the problems with the meaning of words or phrases, or with determining the scope of the claim.

See also 2.11.5 Claims are Clear.

2.1.6.2.2 Full Description

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.6.2.2A Clear Enough and Complete Enough Disclosure.
In assessing whether a specification fully describes the invention, examiners should only spend enough time as is necessary to gain an understanding of the nature of the invention from the specification as a whole.

An objection on the grounds that the specification does not fully describe the invention should focus on the disclosure of the specification as a whole, including references to parts therein, to make the issue clear.

See also 2.11.3 Full Description: Best Method.

### 2.1.6.2.2A Clear Enough and Complete Enough Disclosure

**Note:** The information in this part **only** applies to:

- standard patent applications with an examination request filed **on or after** 15 April 2013.
- innovation patents with an examination request filed **on or after** 15 April 2013.
- innovation patents where the Commissioner **had not decided before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.6.2 Full Description.

In assessing whether a specification discloses the invention in a clear enough and complete enough manner, examiners should only spend enough time as is necessary to gain an understanding of whether the complete specification provides an enabling disclosure of the claimed invention.

An objection on the grounds that the specification does not disclose the invention in a clear enough and complete enough manner should focus on the disclosure of the specification as a whole, including references to parts therein, to make the issue clear.

See also 2.11.3A Clear Enough and Complete Enough Disclosure.

Modified Date: 01 February 2013
2.1.6.2.3 Fair Basis

**Note:** The information in this part *only* applies to:

- standard patent applications with an examination request filed **before** 15 April 2013.
- innovation patents with an examination request filed **before** 15 April 2013.
- innovation patents where the Commissioner **decided before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.6.2.3A Support.

Examiners should assess whether the claims are consistent with what the specification as a whole describes as the invention.

A fair basis objection should clearly identify the relevant claims and those features which give rise to the objection. It should also refer to those parts of the specification, which when read in context, demonstrate where there is inconsistency between the description and the claim(s). Where an independent claim is considered to lack fair basis, it will usually be sufficient to merely include a general statement referring to dependent claims which also lack fair basis.

See also 2.11.7 Claims are Fairly Based

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2.1.6.2.3A Support

**Note:** The information in this part *only* applies to:

- standard patent applications with an examination request filed **on or after** 15 April 2013.
- innovation patents with an examination request filed **on or after** 15 April 2013.
- innovation patents where the Commissioner **had not decided before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.6.2.3 Fair Basis.

Examiners should assess whether the claims are properly supported by the matter disclosed in the body of the specification.

An objection that the claims are not supported should clearly identify the relevant claims and those features which give rise to the objection. Where an independent claim is considered
to lack support, it will usually be sufficient to merely include a general statement referring to
dependent claims which also lack support.

See also 2.11.7A Support for the Claims

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**Modified Date: 14 June 2016**

**2.1.6.2.4 Lack of Unity**

This section is directed to the level of detail required when taking a lack of unity objection.
Direction on the basis of lack of unity objections is provided at 2.11.8 Claims Relate to One
Invention Only – Lack of Unity. Considerations for the use of FERs and reserving search and
examination is given at:

- 2.1.9.5 FERs and Lack of Unity; and
- 4.1.4.2.4 Reserving the Search.

An objection that the claim or claims of a complete specification do not "relate to one
invention only" should only be taken where there are claimed inventions that are clearly not
so linked as to form a single inventive concept. The objection is applicable only when more
than one invention is claimed. It is not relevant for the purposes of sec 40 that the complete
specification describes, but does not claim, more than one invention. Examiners are
expected to exercise their judgement and take a pragmatic approach when deciding how to
proceed in view of a lack of unity.

The report should include a fully reasoned explanation of the consideration behind the
finding of lack of unity - it is not sufficient to merely list the different inventions claimed. For
example, if lack of unity is raised *a posteriori*, the explanation must include reference to the
relevant citations. The level of detail required is shown in 1.1.19 Annex E – Completed
Invitation to Pay Additional Fees.

**Note:** Where a claim contains embodiments directed to different identified inventions, the
lack of unity objection should reflect this, for example:

Invention 1. Claims 1-20 and 21 (in part) relate to compounds of formula 1, a process for
their preparation, pharmaceutical compositions containing them and
methods for their use as antibiotics.

Invention 2. Claims 21 (in part) and 22-29 relate to compounds of formula 2,
pharmaceutical compositions containing them and methods for their use as
anti-inflammatories.
In some cases, where inventions are closely related, even though there is a technical lack of unity, it will require only negligible additional effort to carry out examination on the additional inventions. This may occur where, for example, the prior art to be considered for each invention is similar, or where earlier search results or FERs are available and at least some of the additional inventions have been searched or examined. In assessing whether or not the effort required to examine the additional invention(s) is “negligible”, examiners should have regard to the time likely to be required to draft and perform any additional search, consider documents found, assess any other issues (e.g. sec 40) relating to the claims in question and the estimated time to complete any further reports. This is to be weighed against the time required to formulate and maintain as appropriate the corresponding objection to lack of unity.

Having weighed these factors, where expeditious to do so, examination is to be carried out in relation to those inventions that can be accommodated with negligible additional effort.

Where there is lack of unity and the examiner becomes aware of prior art related to inventions upon which examination is not being carried out (whether or not as a result of a "partial" search or examination), this information may be included in the report, depending on its level of relevance. (Refer to 4.1.4.2.4 Reserving the Search for discussion of the issues associated with conducting a partial search and the citation of documents arising from such a search).

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**Reserving Opinion**

Where, as a result of a lack of unity objection, only certain inventions are examined, this must be clearly indicated in the report, together with a statement that opinion in respect of those inventions not examined is reserved.

Furthermore, where a claim encompasses embodiments directed to more than one of the identified inventions and opinion has been reserved in respect of at least one of these, the lack of unity objection should indicate that part of the claim concerned has been examined, while part has been reserved. For example:

“I have limited the search and report to Invention 1 as defined by Claims 1-20, 21 (in part).

When I receive a response to my objections I may extend the search area and expand the report on the basis of my findings.”

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Modified Date: 10 November 2014
Sufficient detail should be provided to support an objection relating to patentability issues. In the case of manner of manufacture (patentable subject matter), examiners should be mindful that certain words, such as system or combination, often require careful analysis and, if given a particular interpretation, this should be explained in the objection. For business methods and computer software related applications, issues such as incidental use or post-solution activity using computers etc. need to be clearly explained.

See also:

- 2.9.2 Patentable Subject Matter (Manner of Manufacture);
- 2.9.3.5 Human Beings and Biological Processes for Their Generation; and
- 2.31.4.6 Ground (3): Subsections 18(2) and (3).

**General Principles**

**Novelty**

Where a novelty objection is taken, examiners need not consider lack of inventive step separately against that claim, since in most cases it can be assumed that claims which are not novel also lack inventive step. However, the novelty objection should also include a statement that the claims are not inventive (see, for example, PERP codes [F1] to [F3]).

**Discussion of Independent and Dependent Claims**
Sufficient discussion of independent claims should be provided to support the grounds of objection for such claims. Where there are multiple independent claims with similar or slightly different features, and where similar amendments to all the independent claims will overcome objection(s) raised, examiners may discuss the issues broadly, e.g. in a single objection. It is acceptable for dependent claims to be grouped with their corresponding independent claims and generalised statements made about those claims.

However, discussion of dependent claim features that are not related to the inventive concept and are therefore unlikely to be promoted to the independent claims should be minimised. Where dependent claims add features that are *prima facie* trivial or generally well known in that art, they can be logically grouped under the relevant independent claims and dealt with in a more general manner. When objecting in a general manner to dependent claims, examiners must identify at least some of the features defined in those claims and indicate whether these features lack novelty, or lack an inventive step using, for example, arguments of design choice and common general knowledge. It is also not sufficient to simply state that the features added by the dependent claims are either disclosed or not inventive and in this regard, the text of PERP code [F750A] is acceptable. Further examples of suitable wording are provided in PERP codes [F750B] and [F751] – [F755].

More detailed discussion on dependent claims should be provided if examiners are able to determine that a particular feature or combination of features in those claims is related to the inventive concept and therefore likely to be promoted to an independent claim at a subsequent stage.

Additional discussion on the interpretation of terms should be provided where there is doubt as to the correspondence between features in a claim and a citation. These differences should be discussed to the extent required to impart clarity to the objection. The objection needs to clearly explain how the claims are being interpreted for the purposes of the report.

**Note:** In determining those documents to cite for novelty/inventive step objections, and the discussion of those documents, the principles outlined in 2.1.7.1 Discussion of Citations, 2.1.7.4 Citing Many Citations and 1.3.8.6 Box V Reasoned Statement Regarding Novelty, Inventive Step & Industrial Applicability (Discussion of Citations Against the Criteria) should be considered.

For complex cases it may not be practical to provide an opinion on every claim (see also 2.1.3 Flexible Approach for Complex Cases).

**‘Whole of Contents’ Novelty**

In the case of ‘whole of contents’ novelty objections based on P, X or E documents, examiners are to identify in the report those claims that are not novel (both independent and
dependent). Claims lacking novelty should be discussed as outlined above, i.e. independent claims should be discussed in detail, however detailed discussion of dependent claim features that are not related to the inventive concept should be minimised.

Combining Novelty and Inventive Step Objections

Novelty and inventive step objections do not necessarily have to be raised as separately numbered objections in a report. There are many instances where combining objections is more logical and provides a better focus on the key deficiencies in an application. In general, where a citation is used for both novelty and inventive step purposes, it is logical to combine the two objections. In this situation a single objection will generally allow the applicant to focus on the key issues of invalidity. Another example is where the features of dependent claims are not related to the inventive concept, as discussed above.

However, there are also cases where distinct issues of novelty and inventive step in an independent claim may be better addressed separately. An example would be where there are different options within the one claim – one option being not novel and the other not inventive. In such cases, it may be more logical to separate the issues of novelty and inventive step.

2.1.7 Citations

Note:

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to check, alter or update either the citation details or format of the citation details as downloaded.

2. Citation details downloaded through OPS will automatically populate the source of the citation.
When selecting documents for citation, examiners should attempt to cover as much of the scope of the claims (including any alternatives within the claims and amendments that can be anticipated) as reasonable/practicable. However, examiners should not cite more documents than necessary. Generally speaking, less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation.

Where there are one or more “best citations” available, examiners should provide a comprehensive discussion of the “best citation(s)” against the independent claims. Depending on the circumstances, the “best citation(s) may be sourced from a single FER or may need to be sourced from multiple FERs (see also 2.1.9.4.1 Objections Based on FER). If other citations of close or equivalent disclosure are also available and, where this would assist the applicant, examiners may also refer to a representative selection of these citations in a more general manner.

Where all citations are of close or equivalent disclosure and there is no “best citation”, examiners should provide a comprehensive discussion of one citation and can refer to the remaining citations in a more general manner.

In either instance, the other citations may be grouped as appropriate (e.g. “A similar objection applies to citations X, Y and Z”).

Examiners should concentrate on providing citation references for core features of the independent claims. Extensive lists of references to features in citations are not desirable. Examiners should, however, provide appropriate detail where features are not readily apparent from the citation (e.g. due to interpretation/construction issues, inherency or features hidden in a lengthy specification). No undue effort should be invested in analysing the cited documents for prima facie trivial or well known features defined in dependent claims.

Where an objection is based on a particular passage, claim, or figure in the document cited, examiners are to draw attention to that relevant passage, claim or figure. Objections should identify passages in citations which disclose the core features of the independent claims. It is not necessary to provide a specific individual reference for every feature, especially those that are disclosed in combination or in a relatively concise passage(s) in the citation (e.g. “See paragraph 5 that discloses features A, B and C”). Additional passages may be cited relating to non-trivial features of dependent claims. Non-trivial features are those which relate to the inventive concept described or able to be determined by comparison with the prior art. Referring to figures, structures, tables etc. in a citation is encouraged where
applicable and a detailed explanation in words will not always be necessary, especially when referring to features that are clearly disclosed.

**Note:** When identifying cited documents, those errors that reflect a misapprehension of the facts rather than a simple miskeying are regarded as serious mistakes. Such errors are those whose routine correction is not obvious to a reader in the light of other citation information and are misleading in that they would reasonably lead the reader to an incorrect conclusion. Examples of such errors include: a typographical error that results in an incorrect applicant name which is the name of a known competitor firm in the art concerned, or a citation publication date that erroneously indicates that the citation cannot be used to establish want of novelty.

In general, any citation may be identified according to the practice outlined in 1.1.12.5.3 Citation of Prior Art Documents.

Nevertheless, in relation to national examination, the following points are highlighted:

1. Where:
   a. citations (relevant prior art documents) are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER);
   b. the cited documents are downloaded relying on the citation details provided in the FSR/FER; and
   c. the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS);
there is no requirement for examiners to routinely check, alter or update either the citation details or format of the citation details as downloaded. These citation details may be used "as is".

See also 2.1.9.2 FER Retrieval, 2.1 Annex A - Open Patent Services (OPS) FER Process and 5.19 Citation Manager.

Note: Although there is no requirement to routinely check or modify citation details or formats downloaded through OPS, examiners who become aware of a serious error in the data (e.g. transposed numbers, spelling errors in a name) may correct such errors when identified.

2. Where either:
   a. national examination does not rely on a Foreign Search or Examination Report (FSR or FER) to identify citations (relevant prior art documents) (e.g. no FSR/FER is available and a search has been conducted by IP Australia); or
   b. the citation details provided using OPS do not enable one or more document(s) to be downloaded that is/are identified in the FSR or FER;

examiners must manually enter the details of identified relevant citation(s) into PAMS/DocGen.

In such circumstances, the detail required as a minimum to meet the IP Australia Quality Standards must be as specified below under Patent Literature and Non-Patent Literature.

3. Where a search has identified patent and non-patent literature documents disclosing the same subject matter of particular relevance, preference should be given to citing patent documents in the examination report.

4. Documents must be cited in full by completing all of the mandatory fields in the Intelledox (DocGen) ‘Citations’ section, i.e. fields marked with a red asterisk (*). Where documents have been located via OPS, this information will in most cases be populated automatically. In the event that any fields are not populated, they will be marked with a red asterisk. In this circumstance, examiners must manually enter the missing data in order to correctly populate the Intelledox (DocGen) ‘Citations’ section.

5. The source of all documents (whether discussed comprehensively or referred to more generally in the examination report) must also be indicated. The source is identified as a footnote to the citation details and includes, as appropriate, the report type, publication/application number and date as indicated below.

<table>
<thead>
<tr>
<th>Source of Document</th>
<th>Footnote Details</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td></td>
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<tr>
<td></td>
<td></td>
</tr>
</tbody>
</table>
### 2.1.7.2 Identifying Citations

- International Reports including ISRs, IPRPI/IPRPIIs, Supplementary International Search Reports.
- Foreign national search and examination reports prepared by the International Authorities and other foreign offices.
- National search and examination reports prepared by IP Australia, including reports on parent or other ancestor (e.g. grandparent) applications.

<table>
<thead>
<tr>
<th>Information</th>
<th>Example</th>
</tr>
</thead>
<tbody>
<tr>
<td>The document source should be identified by its publication/application number, for example:</td>
<td>'Cited in WO 2010/123456'</td>
</tr>
<tr>
<td>'Cited in EP 01 234 567'</td>
<td>'Cited in US 20100123456'</td>
</tr>
<tr>
<td>'Cited in AU 2001234567'</td>
<td>'Cited in the search/examination report of WO 2010/123456'</td>
</tr>
<tr>
<td>'Cited in the search/examination report of EP 01 234 567'</td>
<td>'Cited in the search/examination report of US 20100123456'</td>
</tr>
<tr>
<td>'Cited in the search/examination report of AU 2001234567'.</td>
<td></td>
</tr>
<tr>
<td>PCT Third Party Observations.</td>
<td>'Cited in PCT Third Party Observation submitted [Date]'</td>
</tr>
</tbody>
</table>

### Patent Literature

**Note:**

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to routinely check, alter or **update** either the citation details or format of the citation details as downloaded. These citation details may be used “as is”. However, where examiners become aware of serious errors in the data (e.g. transposed numbers, spelling errors in a name etc), they may correct such errors when identified.

2. Citation details downloaded through OPS will automatically populate the source of the citation.

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This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.1.7.2 Identifying Citations

See also 2.1.9.2 FER Retrieval; 2.1 Annex A - Open Patent Services (OPS) FER Process and 5.19 Citation Manager.

Where OPS functionality is not relied upon, for any particular patent literature citation the detail required as a minimum to meet the IP Australia Quality Standards must include, if available, the:

- country code;
- publication number (noting dashes (-) and slashes (/) for example are not required);
- publication kind code;
- applicant name; and
- date of publication.

With regard to these details, a citation is correctly identified when the document number, including any leading zeroes, and the convention country as cited, are identical to these descriptors as they appear on the document viewed and cited. (Where a copy of the document cited has been placed on the V: drive, the details of the citation written in the report should mirror this information; see 1.1.12.5.3 Citation of Prior Art Documents).

For further information on use of the V: Drive in examination, see 5.7.4 Guidelines for Using the V: Drive in Examination.

**Note:** When manually entering data in relation to patent documents, care should be taken to identify the correct publication level. That is, while examiners are not precluded from viewing and citing B level publication documents, they should remain alert to the fact that a B level document is published later than, and may also omit subject matter originally disclosed in, the corresponding A level document.

Notwithstanding the foregoing, patent documents may be identified according to the practice outlined in 1.1.12.5.3 Citation of Prior Art Documents.

**Kind Codes for Australian Patent Documents**

Some older Australian patent documents do not have an indication of kind code on the document itself. However, the distinction between pre- and post-grant publications may be determined on the basis of the published number and an appropriate kind code must be ascribed in DocGen as follows:

<table>
<thead>
<tr>
<th>Publication</th>
<th>Form of Number</th>
<th>Appropriate Kind Code</th>
</tr>
</thead>
</table>

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.1.7.2 Identifying Citations

<table>
<thead>
<tr>
<th>pre-grant</th>
<th>NNNNN/YY</th>
<th>A</th>
</tr>
</thead>
<tbody>
<tr>
<td>post-grant</td>
<td>NNNNNN</td>
<td>B</td>
</tr>
</tbody>
</table>

However, when such a document is retrieved from a source which does indicate a kind code for the document (e.g. Espace), inclusion of the kind code, as indicated in the source, is preferred.

Citing Family Members

In certain circumstances, it may be necessary to rely on a family member of a patent document sourced from an ISR or FER. This could be, for example, because:

- the document sourced from the ISR/FER is not in English and a later family member is an English language equivalent; or
- the document sourced from the ISR/FER is published after the priority date of the claims under examination and an earlier family member is located.

These additional family member documents should be included in the report, together with the source document, by using the ‘&’ category in DocGen. For example:

- Where the document identified in the ISR/FER was published after the priority date, e.g. CA 1149815 A1, and a corresponding family member was published before, e.g. US 4282353 A:
  

- Where a non-English language document identified in the ISR/FER was published before the priority date, e.g. JP 2006-505796 A, and a corresponding English language family member was published after, e.g. US 7108775 B2:
  

Non-Patent Literature

Note:
2.1.7.2 Identifying Citations

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to check, alter or update either the citation details or format of the citation details as downloaded. These citation details may be used “as is”. However, where examiners become aware of serious errors in the data (e.g. transposed numbers, spelling errors in a name etc), they may correct such errors when identified.

2. Citation details downloaded through OPS will automatically populate the source of the citation.

See also 2.1.9.2 FER Retrieval; 2.1 Annex A - Open Patent Services (OPS) FER Process; and 5.19 Citation Manager.

Journal and Book References

Where OPS functionality is not relied upon, for any particular non-patent literature citation the detail required as a minimum to meet the IP Australia Quality Standards must include, if available, the:

- author;
- name by which the journal or reference work is known;
- publication year;
- volume number; and
- one or more of page numbers, document identifier or chapter number/title of the article (as appropriate).

1. The order in which the above minimum detail is listed when a document is cited is not critical, although in most cases the author should be listed first.

2. When citing non-patent literature documents, internationally recognised abbreviations are permitted.

3. With regard to the specific content of each these details, a citation is correctly identified only when the form used either:

- is the same as that recited on the document actually viewed and considered to be relevant.

(Note that where a copy of the document cited has been placed on the V: drive, the details of the citation written in the report may mirror this information (see also 5.7.4 Guidelines for Using the V: Drive in Examination); or
2.1.7.2 Identifying Citations

- accords with the practice outlined in 1.1.12.5.3 Citation of Prior Art Documents; see also 1.1.12.5.5 Citation Examples for a non-limiting list of citation formats.

Other Non-Patent Literature References

Where OPS functionality is not relied upon for any other type of non-patent literature citation (e.g. catalogues, website addresses etc), the guidance in 1.1.12.5.5 Citation Examples should be followed (see also 4.1.4.3.3 Non-Patent Literature and 4.1 Annex L - Establishing Publication Dates and Capturing Internet Citations).

Raising and Maintaining Citations

In the course of examination, reports should identify relevant prior art documents, raising as appropriate those documents that deprive the invention claimed of novelty and/or inventive step. These documents should be listed in the “Documents Cited or Considered Relevant” section of the examination report and, where appropriate, the related novelty or inventive step objection in the body of the report should refer to the listed document(s) using the document identifier (D1, D2, D3, etc).

Thus all raised documents that deprive a claim or claims of novelty and/or inventive step, whether located through a search conducted by the examiner or via a foreign search report (FSR), must be listed and a Citation Category of “X” or “Y” as appropriate, applied. When first cited, whether at first or further report stage, each such document is to be listed with the Citation Status of “Raised”.

Where the examiner has conducted a search and no documents can be identified that deprive any of the claim(s) of novelty and/or inventive step, the report should list the closest related art document(s), and to each such document a Citation Category of “A”, and the Citation Status of “Raised”, is to be applied. Once such documents have been listed for the first time, whether at first or further report stage, they need not be re-listed in subsequent reports. If a foreign search or examination report identifies only “A” category documents and no Australian search has been conducted, the documents identified in the FSR/FER need not be listed.

If, at further report, as a result of amendment or argument, a document previously cited as an “X” or “Y” citation, no longer deprives any of the claim(s) of novelty and/or inventive step, it is not necessary to re-list the document with a Citation Category of “A” in the next report.
In such circumstances, examiners may update the citations list in PAMS with regard to the documents concerned, changing the Citation Category to “A” and the Citation Status to “overcome by amendment” or “overcome by argument”.

If the response is not sufficient to overcome the previously raised novelty and/or inventive step objection, the objection should be maintained and the cited document re-listed with a Citation Category of an “X” or “Y” as appropriate, and the Citation Status “maintained” is applied.

Examiners should note that when re-listing previously raised citations, they may either re-enter the citation details manually, or select the ‘pre-populate’ option in DocGen which will automatically enter the information. Regardless of the mode of entry, the Citation Status (“maintained”, “overcome by amendment”, or “overcome by argument”) and Citation Category fields must be appropriately updated.

However, if at further report opinion is reserved with respect to all of the claims, then any document previously cited as “X” or “Y” category need not be re-listed in the report. Where examiners are unsure whether a document should be re-listed, they should consult a senior examiner.

Note: Where a document has simultaneous “X”, “P, X” and/or “E” citation categories, for example “X” against some claims, but “P, X” against others, examiners should enter this information in the report following the procedure outlined in 4.11.2.11 DocGen Frequently Asked Questions. Note that in accordance with the PCT Guidelines, “E” is a standalone category and is not accompanied by “X”, “Y” or “A”.

Modified Date: 01 July 2014

2.1.7.3 Assertion of Common General Knowledge and Mosaicing

Where differences between the claimed features and those disclosed in the citation are standard or trivial, examiners need only provide broad reasoning to support an assertion of common general knowledge (e.g. the feature relates merely to well known laboratory methods) without documentary evidence. Documents to support an assertion of common general knowledge are not required until further report stage and, generally, only when an applicant has challenged the assertion; see also 2.4.5.2.3 Use of Common General Knowledge and 2.5.2.1.7 Considerations at Further Reports.

Combining documents should be considered for independent claims if there is a non-trivial difference, e.g. one which relates to the inventive concept, between the claim and the main
2.1.7.4 Citing Many Citations

Where multiple citations are available, examiners need only provide a comprehensive discussion of the "best citation(s)", or one citation where all citations are of close or equivalent disclosure and there is no "best citation", and can refer to a representative selection of the other relevant citations in a more general manner.

Examiners may use grouping of either the claims or the citations or both to provide the applicant with enough information to understand the issues with the claims. The report should include a statement that the citations are typical of many which anticipate the invention (see for example PERP codes [F3] and [F5]). In making the selection, examiners should ensure that an amendment that would overcome the objections based on the cited documents would equally address the documents which have not been cited.

In any instance where a single objection refers to more than one citation, the objection must clearly indicate that each citation is being considered individually and thus avoid any inference of mosaicing.

**Note:**

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to check, alter or update either the citation details or format of the citation details as downloaded. However, where examiners become aware of an error in the data (e.g. transposed numbers, spelling errors in a name etc), they should correct such errors when identified.

2. Citation details downloaded through OPS will automatically populate the source of the citation.

See also 2.1.9.2 FER Retrieval; 2.1 Annex A - Open Patent Services (OPS) FER Process, 5.19 Citation Manager and 2.1.7.2 Identifying Citations.
Note:

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to check, alter or update either the citation details or format of the citation details as downloaded. Where examiners become aware of an error in the data (e.g. transposed numbers, spelling errors in a name etc), they should correct such errors when identified.

2. Citation details downloaded through OPS will automatically populate the source of the citation.

See also 2.1.9.2 FER Retrieval; 2.1 Annex A - Open Patent Services (OPS) FER Process; 5.19 Citation Manager and 2.1.7.2 Identifying Citations.

Publication Date

When non-patent literature is cited for the first time as the result of an original or an additional search, the date on which the document was published must be included in the report. This date, which is the date that the material was first published anywhere in the world, will be either on the document itself or may be obtained through Research and Information Services (email to IPAustraliaLibrary@ipaustralia.gov.au).

However, where it is not possible to establish the publication date for a document that would otherwise be a citation and which the examiner has reason to believe was published before the priority date of the claim(s) under examination, a note should be included in the report drawing the applicant's attention to the document. It must be made explicit that firstly, no publication date is available for the document, and secondly, no formal objection applies in relation to the document.

When examiners cite a document held by them personally, it is also necessary to establish the publication date. In the absence of a clear indication of this date, examiners may
eventually be required to make a declaration stating where and when the material came into their possession. Such a declaration should be added to the case file and a copy forwarded to the applicant. A similar procedure applies when examiners cite a document which is in the private possession of another examiner.

Copyright Restrictions

There are copyright restrictions on the types of documents that the Commissioner can provide to an applicant (see 2.13.14 Copying of Material and Copyright Implications). Thus, when non-patent literature documents sourced from an original search, an additional search or a FER are cited in the report, copies of these documents are to be saved to the V: drive (not PAMS) and must not be provided with the report.

Where non-patent literature documents are cited in an examination report (regardless of the source of the documents), the following statement is to be included in the report:

"Note that this report has cited non-patent literature document/s. Copies of non-patent literature document/s can be requested for a fee (see Patent Regulations, schedule 7, fee item 234) through IP Australia’s eServices. Please provide the citation details and associated patent application number with your request. Note that because of copyright restrictions we can only provide copies of hard copy books, journals and newspapers (see the Australian Patent Office Manual of Practice and Procedure at part 2.13.14 Copying of Material and Copyright Implications). However copies of any remaining documents should be readily obtainable from known electronic database sources."

This text will be automatically included in the report when the Citation Type ‘NPL’ is selected in the ‘Citations’ section in Intelledox (DocGen) (see also PERP code [F112]).

Note: For guidance on how to deal with NPL if encountered in a PAMS case file during examination, see 5.16.4.3.16 What Do I Do if I Encounter Copyright Material or Non-Patent Literature (NPL) in the PAMS eCase?

For further information on use of the V: Drive in examination, see 5.7.4 Guidelines for Using the V: Drive in Examination.
2.1.7.6 Providing Copies of Patent Documents

In general, requests by attorneys or applicants for copies of cited patent specifications should be handled by ERA. However, if examiners consider that the circumstances are such that requiring the applicant to obtain copies of cited patent specifications would impose an unreasonable hardship, they may provide copies of those specifications with their report. These circumstances may arise due to the geographical location of the applicant, or in the case of a private applicant; see 2.2.2 "Private Applicant" Cases.

Note: Copies of patent documents should be attached to the report using the ‘Attach File’ function in PAMS (see 5.6.1.2 Examiner Correspondence Screen).

2.1.7.7 Unavailable or Untranslatable Citations

Occasionally a relevant citation (for example a document cited in the ISR or other FER) may be unavailable at the time of examination. Similarly, a citation may be in a language for which there are no qualified translators available in the Office (see 1.10.5 Examiners with Foreign Language Capabilities), or a machine based translation is either unavailable or insufficient. In these situations examiners should include a note in their report drawing the applicant's attention to the existence of the particular citation. The note should indicate that the cited material is relevant to the present claims, however the document could not be obtained, or an English version could not be obtained, at the time of examination. PERP codes [F111] and [F120] provide examples of text for such notes.

2.1.8 Furthers

Further reports must be comprehensive. If a statement of proposed amendments has been filed in response to an examination report, examiners are to report upon the specification as proposed to be amended and report whether those amendments are not allowable.
2.1.8 Further

**Note:** Where proposed amendments are not allowable, examiners should refer to Section 102(1) Examination Practice, Reporting on Amendments Not Allowable Under Section 102(1).

Examiners should ensure that the further report includes:

- objections raised in the previous report which have not been fully overcome by the proposed amendments and/or submissions. This may be done by reference to an earlier report provided the outstanding issues are made clear.

- new objections which have arisen as a result of the amendments made to the specification.

At further report stage, more detail may be required in the report to specifically address arguments or issues raised by the applicant. Where an objection is maintained in the face of meaningful submissions, the wording of the report must be such that the applicant is in no doubt that a legitimate point made in the submissions has been taken into account.

Where a response indicates that the applicant's understanding of any issue, such as the scope of the claims or of a particular term, differs from that of the examiner, it will be necessary to discuss these issues in greater depth when maintaining an objection.

Examiners are not expected to reassess previous objections that have not been addressed in the applicant's response. Therefore, dependent claims that were dealt with in a general manner in an earlier report, and which have not been addressed in the applicant's response, do not have to be investigated further, i.e. a general objection may still apply to those dependent claims.

Where amendments are not proposed in response to an objection, an argument in rebuttal may have the effect of making examiners doubtful of the applicability of the objection where previously they had no doubts. In such circumstances, whether or not to maintain the objection should be considered carefully using the relevant test (see 2.13.5 Stringency of Tests During Examination). An examiner unsure of the correct course of action should refer the matter to a senior examiner in the first instance (see also 2.1.1 Introduction).

Additional searching may also be required at further report stage depending on the proposed amendments; see 4.1.3.3 Additional Searching.

**Note:** Refer to 2.1.7.2 Identifying Citations for discussion of best practice in identifying citations in further reports.
Third and Subsequent Adverse Reports; Withdrawing Objections After Two Adverse Reports

It is important that objections are raised and maintained appropriately. To this end:

- All third and subsequent adverse reports (including reports on voluntary requests to amend under sec 104) are reviewed by a supervising examiner. A statement to this effect must be included in each third and subsequent adverse report (see PERP code [P90]).

  This function can be delegated to senior examiners where the supervising examiner considers it appropriate.

- Where an issue remains after three adverse reports and without substantial amendments being proposed, Patent Oppositions should be consulted on the further progress of the case, including whether to set the matter for hearing with the intent to refuse the application.

- Where an objection has been raised and maintained for 2 reports and the examiner believes, on the basis of the applicant’s submissions alone, or submissions with insubstantial amendments, that the objection should be abandoned, then a supervising examiner or delegated senior examiner will need to be consulted before the objection can be withdrawn. This is intended to ensure that objections are not withdrawn without sufficient justification. However, where the examiner considers that the proposed amendments fully address the grounds of objection, no further consultation is required.

2.1.9 Guidelines for Using IPRPI/IPRPPIIs and Other Foreign Examination Reports (FERs) in Examination

National examination often has regard to work previously performed by IP Australia and other IP offices on related family members. Where this work can be used during examination, this can provide a higher level of quality, as well as considerable efficiencies for both IP Australia and the applicant. Examiners should have due regard to relevant issues and citations raised in FERs and search results at all stages during examination. They should also be mindful that relevant art may become available at further report stage and...
that earlier citations may later become relevant, particularly where substantial amendments have occurred during prosecution.

The following guidelines outline the procedures for examining national applications where there is a corresponding FER available. In general, examiners should utilise previous search and examination results as far as possible to reduce the amount of rework. In order to do this, examiners will need to form a judgement on a case by case basis as to what reliance can reasonably be placed upon the FERs.

**Note:** Unless otherwise indicated, FERs include IPRPI/IPRPIIs, Supplementary International Search Reports, PCT Third Party Observations, national search and examination reports prepared by IP Australia (e.g. reports on (grand)parent applications), and foreign national search and examination reports prepared by the International Authorities and other foreign offices. During examination, consideration should also be given to any granted forms of the claims that are available, e.g. EP or US granted patents.

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Modified Date: 01 August 2019

### 2.1.9.2 FER Retrieval

In this topic:

**Note:**

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to check, alter or update either the citation details or format of the citation details as downloaded. Where examiners become aware of an error in the data (e.g. transposed numbers, spelling errors in a name etc), they should correct such errors when identified.

2. Citation details downloaded through OPS will automatically populate the source of the citation.

See also 2.1 Annex A - Open Patent Services (OPS) FER Process; 5.19 Citation Manager and 2.1.7.2 Identifying Citations.
2.1.9.2 FER Retrieval

General

At first report stage, COG will normally have retrieved the IPRPI/IPRPII, Supplementary International Search Report (SISR) (where applicable) and any available FERs from at least the US and EP. However, it is the responsibility of examiners to ensure that the FERs being considered are up to date and relevant (e.g. closest family member) at both first and further report stages. Examiners should be mindful that better citations may become available at further report stage and that earlier citations may later become relevant, especially in the situation where the claims have been substantially amended. Examiners should also remember that notification of PCT third party observations may be received after 28 months from the priority date.

The process to be used for downloading the FER and its content is either using Open Patent Services (OPS) or the Manual Procedure as discussed below.

Where examiners have a useful FER and believe that they are unlikely to find better citations in additional FERs (i.e. FERs from countries other than the EP and US), they may use their discretion when deciding whether or not to look for additional FERs. A citation is “better” if it would invalidate claimed subject matter not anticipated by the citations already raised in the retrieved FERs and/or is more closely related to the inventive concept. Disclosure of a small number of trivial features does not necessarily imply a citation is better. However, examiners should be mindful of any other factors in particular technologies that may require checking for additional FERs, such as FERs from Asian countries (where English translations are available).

Note: FERs that give rise to citations used in an examination report must be added to the case file, unless the FER is a national or international search/examination report prepared by IP Australia and already available in PAMS or INTESS. In this situation, examiners are not required to add the FER to the case file. (Note also the procedures outlined in 2.20.7 National Examination Where the ISR is Missing regarding reports that are not OPI and 2.20.10.1.2 and 2.20.10.1.2A Determining Whether Article 19 and Article 34 Amendments are Considered During Examination regarding adding Article 34 amendments to PAMS case files from INTESS if not available elsewhere).

All relevant FERs considered/viewed during examination (i.e. FERs from family members with the same or similar claims) should preferably also be added to the case file.

FER Retrieval Using Open Patent Services (OPS)
2.1.9.2 FER Retrieval

Open Patent Services (OPS) is a system which operates in conjunction with PAMS and DocGen to streamline the identification, downloading and modification of citation details from Foreign Search Reports (FSRs) and FERs.

Full details of OPS operation are provided in 5.19 Citation Manager (see also 2.1.7.2 Identifying Citations). A broad outline of the OPS FER retrieval process is provided in 2.1 Annex A - Open Patent Services (OPS) FER Process.

OPS permits the download of citation lists directly from FSRs and FERs into the PAMS citation database for upload to and insertion into adverse examination reports via DocGen, and clear reports via acceptance processing within PAMS.

As the formats used in citing documents in FSRs and FERs generally adhere either to international standards for patent documents or the standards found in Google Scholar or similar sources of non-patent literature, the data downloaded by OPS represents a well-respected and generally consistent standard for the generation of citation lists for national reports.

Consequently, where citations are identified from a FSR or FER and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), IP Australia will generally accept and utilise these citation lists as is. Where there are substantial departures from this standard (such as, for example, the use of internal EP or JP non-patent literature codes), corrective scripts will automatically remove these codes to return an internationally recognised format.

Therefore, in general, there is no requirement for examiners to check, alter or update either the citation details or format of the citation details as downloaded.

Note:

a) Where examiners become aware of an error in the data (e.g. transposed numbers, spelling errors in a name etc), they should correct such errors when identified.

b) Citation details downloaded through OPS will automatically populate the source of the citation.

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Procedure for Retrieving FERs

The following manual procedure for FER retrieval should be used where Open Patent Services (OPS) is not available.
2.1.9.2 FER Retrieval

As a first step in the process examiners should check the case for an IPRPI/IPRPII. If the IPRPI/IPRPII is not on file, examiners should check whether the document is available from Patentscope, and if so, download a copy and add it to the case file. Where the IPRPI/IPRPII is not available, examiners should follow the procedures outlined in 2.20.10.1.2A Determining Whether Article 19 and Article 34 Amendments are Considered During Examination. Examiners should also check Patentscope for a SISR and where available, download a copy and add it to the case file.

Examiners should then check for FERs from at least the US and EP, if these have not already been added to the file by COG as part of the document preparation task. If FERs are already present in the file examiners are responsible for ensuring that these are up to date, as further prosecution may have occurred between the time of their initial retrieval and the commencement of examination. Examiners should use their discretion in determining if the date of document preparation done by COG is recent enough. Where examiners decide that the document preparation requires updating, they should check for additional FERs. Alternatively, examiners may reassign the Exam Request task back to COG with an appropriate comment to update the document preparation. COG will then update the documents within one working day.

The potential sources of FERs and procedures for their retrieval are outlined on the Patent Examination Workbench.

When adding an IPRPI/IPRPII or other FER to the case file, the document type should be 'Search Results' and the document name meaningful, for example 'IPRPII', 'US FER YYYY123456' or 'EP FER 1234567'.

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PCT Third Party Observations

Where national phase entry occurs after 31 months from the priority date, any PCT third party observations and citations will be automatically added to the file by COG with the document type ‘Search Results’ and the document name ‘PCT Third Party Observations submitted [Date]’.

Where national phase entry occurs earlier, COG will check Patentscope and retrieve any third party observations and citations during the document preparation task.

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2.1.9.3 FER Validation
2.1.9.3 FER Validation

Examiners should confirm any positive or negative novelty/inventive step findings in a FER or earlier search (see 2.1.9.3.3 Validation of Novelty and Inventive Step Findings). In doing so, examiners should check that the reasoning in the FER is both accurate with regard to the citation and relevant to the claims under consideration. Any findings on other examination issues such as sufficiency or clarity should also be considered and assessed for relevance and correspondence to Australian law.

2.1.9.3.1 Claim Comparison

Once the FERs have been sourced, examiners should check the respective claim sets to ensure that the claims under consideration in the AU application and the FER are the same or similar. Amendments are frequently made to the various family members before and during prosecution and therefore it is important that the claims which are the subject of the FER are the same as or similar to the Australian claims under consideration. Examiners should be mindful of subsequent FERs/applicant’s arguments available in the foreign office proceedings that may render the documents cited in an earlier FER redundant.

Where some claims have not been previously searched and/or examined these will need to be considered separately - see 2.1.9.3.2 Not All Claims Previously Searched and/or Examined.

If any differences in wording exist between the claim sets, consideration should be given to the nature of the differences and resultant scope of the claims, in order to determine the extent to which the FER can be relied upon. Claim numbering and dependency should also be checked to ensure there is a clear correlation between what is being addressed in the FER and the claims under consideration.

2.1.9.3.2 Not All Claims Previously Searched and/or Examined

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 26 September 2019
2.1.9.3.2 Not All Claims Previously Searched and/or Examined

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.9.3.2A Not All Claims Previously Searched and/or Examined.

Examiners should review the FER to check whether the Australian independent claims, and any non-trivial features relating to the inventive concept in the dependent claims, have been searched. The following issues may arise and may result in the need for an additional search:

- Where the FER indicates that claims have not been examined because they are too broad/not supported/not limited to technical features of the invention, and this reasoning is prima facie reasonable in light of the claims, examiners should consider whether a fair basis and/or full description objections are applicable. In these cases, examiners should also assess to what extent the search/examination conducted by the ISA or foreign office has covered the claims.

- Where a FER states that certain claims are novel and inventive, examiners should validate this finding to confirm an appropriate search has been done; see 2.1.9.3.3 Validation of Novelty and Inventive Step Findings.

- Where claims have not been examined because of a lack of unity, and this is prima facie reasonable, examiners should refer to the FER for any relevant lack of unity explanation. Where the only FERs available are directed to later inventions rather than the first claimed invention, examiners should follow the procedures outlined in 2.1.9.5 FERs and Lack of Unity.

- Where claims have not been examined because of excluded subject matter, an appropriate search may not have been conducted and examiners should check for this.

- Where, for any other reason, there are still claims remaining that have not been adequately searched or examined, or that differ substantially in scope from those previously searched or examined, examiners should check whether there is another FER (e.g. US or EP) that discusses these claims and use this if appropriate.

If any of the above issues arise and substantial additional searching is likely to be required, examiners should convene a three person team and consider whether, and to what extent, an additional search is warranted in accordance with the practice outlined in 4.1.3.3 Additional Searching.
2.1.9.3.2A Not All Claims Previously Searched and/or Examined

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.1.9.3.2 Not All Claims Previously Searched and/or Examined.

Examiners should review the FER to check whether the Australian independent claims, and any non-trivial features relating to the inventive concept in the dependent claims, have been searched. The following issues may arise and may result in the need for an additional search:

- Where the FER indicates that claims have not been examined because they are too broad/not supported/not limited to technical features of the invention, and this reasoning is prima facie reasonable in light of the claims, examiners should consider whether a lack of clear enough and complete enough disclosure and/or lack of support objections are applicable. In these cases, examiners should also assess to what extent the search/examination conducted by the ISA or foreign office has covered the claims.

- Where a FER states that certain claims are novel and inventive, examiners should validate this finding to confirm an appropriate search has been done; see 2.1.9.3.3 Validation of Novelty and Inventive Step Findings.

- Where claims have not been examined because of a lack of unity, and this is prima facie reasonable, examiners should refer to the FER for any relevant lack of unity explanation. Where the only FERs available are directed to later inventions rather than the first claimed invention, examiners should follow the procedures outlined in 2.1.9.5 FERs and Lack of Unity.

- Where claims have not been examined because of excluded subject matter, an appropriate search may not have been conducted and examiners should check for this.
2.1.9.3.3 Validation of Novelty and Inventive Step Findings

- Where, for any other reason, there are still claims remaining that have not been adequately searched or examined, or that differ substantially in scope from those previously searched or examined, examiners should check whether there is another FER (e.g. US or EP) that discusses these claims and use this if appropriate.

If any of the above issues arise and substantial additional searching is likely to be required, examiners should convene a three person team and consider whether, and to what extent, an additional search is warranted in accordance with the practice outlined in 4.1.3.3 Additional Searching.

Note: Examiners should use their knowledge and judgement on a case by case basis to determine what reliance can be reasonably placed upon a FER. Examiners should be particularly mindful that where both novelty and inventive step findings are confirmed as positive for claims, such claims will likely form the basis for any future grant.

Initially examiners should confirm any positive or negative novelty/inventive step findings in a FER for the independent claims. The check should confirm that the reasoning in the FER is both accurate with regard to the citation and relevant to the claims under consideration in accordance with Australian law. Where a foreign granted claim set is available, then the novelty and inventiveness is to be confirmed by the comparison of the granted claims against the most relevant prior art identified during prosecution of the foreign application.

When any positive novelty and/or inventive step findings for independent claims are confirmed, examiners may accept as correct any corresponding positive novel and/or inventive step findings for dependent claims that fall within the scope of the independent claims.

Where negative novelty and/or inventive step findings for independent claims are confirmed, examiners may:

- accept any corresponding negative novelty and/or inventive step findings for the dependent claims. Note, however, that negative inventive step findings for the dependent claims could be based on a combination of documents, which may not be applicable under Australian law. In these situations examiners will need to determine whether a separate objection is warranted following the principles in 2.1.6.2 Novelty and Inventive Step for dealing with dependent claims.
2.1.9.3.4 Law and Practice Differences

- ensure, by diligent consideration of the relevant claims and citations, and a review of the search carried out by the foreign office, that any findings where both novelty and inventive step are positive for the dependent claims are correct. It is not necessary to confirm any findings where only one of novelty or inventive step is positive for dependent claims.

Where the FER is a “fast track” EP IPER/IPRPI/IPRPII that refers only to the X and Y documents cited in the ISR, examiners should use the ISR to identify the location of features of the invention within the indicated citation(s). A clear distinction between claims that have prior art cited against them and those that do not may assist in the identification of novel and/or inventive features where explanations are lacking.

Modified Date: 01 February 2013

2.1.9.3.4 Law and Practice Differences

**Note:** The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For all other standard patent applications, see 2.1.9.3.4A Law and Practice Differences.

In some situations, an objection raised in a FER has an equivalent under Australian law, however the reasoning provided to support that objection is inconsistent with Australian law. In these circumstances, examiners will need to draft their objection independently for the Australian context.

Law and practice differences that examiners should be aware of include:

- Under Australian law, the prior art information against which inventive step is assessed is restricted to information that the skilled person could be reasonably expected to have ascertained, understood and regarded as relevant. This restriction does not apply in other countries.

- Certain claims may not have been examined because of excluded subject matter, however the subject matter concerned may be considered patentable under Australian law. For example, EPO practice in relation to stem cells and embryos may differ from that applicable in Australia.

- Where a lack of support objection is raised in a FER this may, but does not necessarily, correspond to fair basis or full description problems under Australian law.
2.1.9.3.4A Law and Practice Differences

- Examiners should always check the publication date of any document cited in a US FER as it may not be citable under Australian law.

- Non-patent literature which is published after the relevant priority date of the Australian application is not applicable under Australian law and therefore should not be cited. However, in the case of patent documents, examiners should check for the existence of a corresponding family member or AU family equivalent (including WO documents that designate AU) with an earlier publication date.

- For US FERs, documents cited in the 'Double Patenting' section of the report may be relevant prior art under Australian law.

- The FER may raise issues that are not sustainable or relevant under Australian law, such as claim formatting issues specific to the EPO.

- Some issues regarding the scope of the claims in a FER are applicable under Australian law and in these situations the FER may be directly referenced. However, where claim construction practices differ, for example product by process claims, additional explanation will be required.

- If the FER reasoning is based on a particular interpretation of terms which is not clear from the report, examiners should expand the reasoning in their objection to clarify the issue.

- Where a FER has findings based on common general knowledge, examiners should assume in their first report that the assertion as to what is common general knowledge in the foreign jurisdiction is also applicable to Australia. If this is subsequently refuted by the applicant or attorney, then the practice outlined in 2.5.2.1.7 Considerations at Further Reports applies.

- In confirming positive findings for means plus function claims in US FERs, examiners should be mindful of the requirement in the US for the scope of such claims to be limited to the embodiments described.

Note: The information in this part only applies to standard patent applications with an examination request filed on or after 15 April 2013. For all other standard patent applications, see 2.1.9.3.4 Law and Practice Differences.
In some situations, an objection raised in a FER has an equivalent under Australian law, however the reasoning provided to support that objection is inconsistent with Australian law. In these circumstances, examiners will need to draft their objection independently for the Australian context.

Law and practice differences that examiners should be aware of include:

- Certain claims may not have been examined because of excluded subject matter, however the subject matter concerned may be considered patentable under Australian law. For example, EPO practice in relation to stem cells and embryos may differ from that applicable in Australia.

- Examiners should always check the publication date of any document cited in a US FER as it may not be citable under Australian law.

- Non-patent literature which is published after the relevant priority date of the Australian application is not applicable under Australian law and therefore should not be cited. However, in the case of patent documents, examiners should check for the existence of a corresponding family member or AU family equivalent (including WO documents that designate AU) with an earlier publication date.

- For US FERs, documents cited in the 'Double Patenting' section of the report may be relevant prior art under Australian law.

- The FER may raise issues that are not sustainable or relevant under Australian law, such as claim formatting issues specific to the EPO.

- Some issues regarding the scope of the claims in a FER are applicable under Australian law and in these situations the FER may be directly referenced. However, where claim construction practices differ, for example product by process claims, additional explanation will be required.

- If the FER reasoning is based on a particular interpretation of terms which is not clear from the report, examiners should expand the reasoning in their objection to clarify the issue.

- In confirming positive findings for means plus function claims in US FERs, examiners should be mindful of the requirement in the US for the scope of such claims to be limited to the embodiments described.
Additional matters that need to be considered under Australian law regardless of the quality of the FER include:

- Contrary to law, sec 50(1)(a)
- Mere mixture/admixture, sec 50(1)(b)
- Multiple applications, sec 64
- Manner of manufacture – in particular kit claims, claims to nucleic acid sequences and where peptides etc are not claimed in isolated/recombinant etc form.
- Notice of Entitlement
- Budapest Treaty issues
- Reach through claims (however there is generally comment on these types of claims in the FER).
- "For Use" limitation – EP, US and JP may construe this as limiting.
- Interpretation of “contains”, “consists” and “comprises”.
- Section 18(2) (human beings) and sec 18(3)
- Omnibus claims
- “Whole of Contents” issues
- Where the search report lists E or P, X citations, and there is no discussion of these in the FER, examiners should be aware that these documents may be relevant to examination if there are AU family equivalents (including WO documents that designate AU). Where the FER discusses E or P, X citations, and there are AU family equivalents, examiners should refer to the FER discussion in their report if appropriate, following the guidelines in 2.1.9.4 FERs and Report Formulation.

2.1.9.4 FERs and Report Formulation

Modified Date: 01 August 2019

2.1.9.4.1 Objections Based on FER

Note:

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign
Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to check, alter or update either the citation details or format of the citation details as downloaded. These citation details may be used “as is”. However, where examiners become aware of an error in the data (e.g. transposed numbers, spelling errors in a name etc), they should correct such errors when identified.

2. Citation details downloaded through OPS will automatically populate the source of the citation.

See also 2.1.9.2 FER Retrieval; 5.19 Citation Manager and 2.1.7.2 Identifying Citations.

Objections must only be based on a FER to the extent that the FER reasoning is clearly applicable under Australian law. If the FER reasoning is not applicable under Australian law, it should not be used or referred to and examiners will need to draft their objection independently for the Australian context.

The report should identify the relevant claim numbers, give the statutory basis for the objection and refer to the FER for explanation (see also 2.1.9.2 Identifying Citations, Multiple Citations). The location of the relevant passage(s) within the FER must also be provided if the FER is excessively long (e.g. greater than 5 pages) and/or the location is not readily evident. Where any of the citations raised in the FER are relied upon, examiners are to list these documents in the report.

When drafting objections relying on the reasoning in a FER, examiners must not simply reference the text of a FER. It is not sufficient to merely indicate that the objection of the FER is equally applicable under Australian law.

Thus in practice examiners should:

- rely on the FER reasoning to the extent that it is clearly applicable under Australian law and, where appropriate, modify the FER reasoning so that it is consistent with Australian law; OR

- if the FER is consistent with Australian law, add additional information to the objection to demonstrate that they have identified important aspects of the invention (see examples below).

**Note:** When drafting objections relying on the reasoning in a FER, particular care should be taken to ensure the clarity of such reasoning when it is extended from an independent claim to the corresponding dependent claims.
Where appropriate, referring to the FER is more efficient than rewriting essentially identical objections. Examiners should not do a full cut and paste of text from the FER. Where parts of the text are transcribed from a FER into an examiner’s report, these should be included in quotation marks. Where the FER lacks sufficient detail it will generally be necessary to include additional explanation.

Where there are slight differences between the FER claims and those under consideration, examiners may find that the differences are not significant enough to warrant redrafting of the text of the FER. However, where the validity and/or relevance of the report referred to is not immediately evident, further explanation may be required. In this case, additional explanation should be provided in the objection to clearly indicate the nature and extent of the differences between the respective claim sets. Specific examples where additional information can be provided to an objection include, but are not limited to:

- Specific discussion in the report of a key feature.
- Identification of a better citation reference for a key feature.
- Further explanation of an aspect of claim construction.
- Discussing a difference between the foreign and Australian claims and why this difference is immaterial or explaining claim concordances.
- Discussing a key difference between the foreign and Australian law and how Australian law applies.
- A statement as to why a particular claim may be novel and inventive.

See also 6.8.5 Based on FERs (Novelty and Inventive Step) for examples.

**Note:** Where a FER has objected in a general manner to dependent claims, examiners must identify at least some of the features defined in those claims and indicate whether these features lack novelty, or lack an inventive step using, for example, arguments of design choice and common general knowledge, as outlined in 2.1.6.2.6 Novelty and Inventive Step (Discussion of Independent and Dependent Claims). See also PERP codes [F750A], [F750B] and [F751] – [F755].

### Same Citation Discussed by Multiple FERs

Where more than one FER discusses the same citation, in relation to the same claims, examiners may decide which FER they consider to contain the most convincing reasoning and make reference to only that FER. If it is found that the different FERs discuss the same document, but in relation to differing claims within the same claim set, then examiners should confirm the findings of novelty and inventive step (see 2.1.9.3.3 Validation of Novelty and Inventive Step Findings) to determine if one or more of the FERs should be separately referred to within the objections, or an original opinion be formulated.
Note:

1. Where citations are identified from a Foreign Search Report (FSR) or Foreign Examination Report (FER) and the citation details are downloaded to PAMS/DocGen using Open Patent Services (OPS), there is no requirement to check, alter or update either the citation details or format of the citation details as downloaded. However, where examiners become aware of an error in the data (e.g. transposed numbers, spelling errors in a name etc), they should correct such errors when identified.

2. Citation details downloaded through OPS will automatically populate the source of the citation.

See also 2.1.9.2 FER Retrieval; 2.1 Annex A - Open Patent Services (OPS) FER Process; 5.19 Citation Manager and 2.1.7.2 Identifying Citations.

The procedures for identifying citations and their source outlined in 2.1.7.2 Identifying Citations should be followed. In addition, any document previously cited in a FER may be referred to in shortened form, provided that reference is unambiguous.

Where multiple citations are available, examiners need only provide a comprehensive discussion of the “best citation(s)”, or one citation where all citations are of close or equivalent disclosure and there is no “best citation”, and can refer to a representative selection of the other relevant citations in a more general manner (see also 2.1.7.1 Discussion of Citations).

Where there are multiple FERs from which multiple relevant prior art documents have been sourced, and it is considered necessary to cite each of these documents independently due to their differing disclosure and/or relevance to the claims, all of these sources, including relevant passages, should be clearly referenced in the report so that their association with the respective prior art which they discuss is clearly evident.
2.1.9.4.3 New Citations at Further Report

New citations from new FERs should only be raised at further report stage where they are better than existing or previous citations with respect to the claims under consideration. A citation is “better” if it would invalidate claimed subject matter not anticipated by the citations raised in previous reports and/or is more closely related to the inventive concept as opposed to disclosing additional trivial features. Consequently, such a citation would lead to the claims being restricted further than would otherwise be the case. (Note that the raising of new citations in this situation is not considered to be piecemeal examination; see 2.1.5 Inconsistent or Piecemeal Examination.)

2.1.9.5 FERs and Lack of Unity

Examiners should assess the unity of the Australian claims at each stage of examination. Examiners should not merely rely on the approach taken within the FERs, but are expected to independently assess unity in relation to Australian law and practice. Examiners should use their judgement and take a pragmatic approach to assessing unity raised (or not raised) in the FERs.

For example, examiners may consider that unity raised in a FER is based on an overly narrow, literal or technical approach. In this instance, examiners may consider not relying on this approach to unity, or may consider raising lack of unity with an alternative grouping of inventions. Examiners may need to assess whether further searching is required in light of any changes in approach to unity compared to the FERs.

However, if the objection raised in the FER is prima facie reasonable, such an objection may be relied upon and referred to in the examiner’s report.

In general, examiners are expected to conduct a search (if necessary) and examination in respect of the first claimed invention only, unless the only FERs available are directed to a later invention. In this case examination should normally be carried out in respect of this later invention, and no search and examination should be done in respect of the first claimed invention. The applicant must be advised that the search and examination of the other inventions is reserved.

However, there may be cases where this general approach is not followed and search or examination of all inventions is reserved to avoid wasted effort. For example, where the examination history of the equivalent US or EP application indicates that the applicant has
asked for a later invention to be examined (in preference to the first claimed invention) and then abandoned the claims related to this later invention, this suggests that the applicant is not interested in examination of either invention. Therefore there is the possibility that any effort spent in examination of either invention by the Australian examiner could be wasted. It is reasonable in these circumstances to object to the lack of unity, reserve any further opinion and invite the applicant to indicate (possibly via appropriate amendments) which invention is to be examined.

Where a lack of unity exists, it may require only negligible additional effort to carry out examination on additional inventions. This can occur where, for example, the prior art to be considered for each invention is similar, or where earlier search results or FERs are available and at least some of the additional inventions have been searched or examined. In these circumstances, examination is to be carried out in relation to those inventions that can be accommodated with negligible additional effort. See 2.1.6.2.4 Lack of Unity for a discussion of the factors that must be considered in making this determination.

Modified Date: 15 August 2011

2.1.9.6 FERs and Complex Cases

Complex cases include those that have a large number of inventions or a large number of claims, or where there are multiple FERs directed to different inventions. The general procedures outlined in 2.1.3 Flexible Approach for Complex Cases should be followed when dealing with complex cases for which FERs are available.

2.2 Other Examination Considerations

Modified Date: 25 February 2019

2.2.1 Abbreviations Used in this Volume

Some of the abbreviations found throughout this volume are listed below.

<table>
<thead>
<tr>
<th>Abbreviation</th>
<th>Full Form</th>
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<tbody>
<tr>
<td>&quot;the Act&quot;</td>
<td>Patents Act 1990</td>
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<tr>
<td>&quot;the Regulations&quot;</td>
<td>Patents Regulations</td>
</tr>
<tr>
<td>“the Formalities Determination”</td>
<td>Patents (Formalities Requirements for Patent Documents) Determination 2019</td>
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</table>
### 2.2.1 Abbreviations Used in this Volume

<table>
<thead>
<tr>
<th>Abbreviation</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>&quot;the Office&quot;</td>
<td>Australian Patent Office</td>
</tr>
<tr>
<td>&quot;the Official Journal&quot;</td>
<td>Australian Official Journal of Patents</td>
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<tr>
<td>AOJP</td>
<td>Australian Official Journal of Patents</td>
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<td>APO</td>
<td>Australian Patent Office</td>
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<tr>
<td>AU</td>
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</tr>
<tr>
<td>AU-A</td>
<td>Australia - Abstract of a patent application</td>
</tr>
<tr>
<td>AU-B</td>
<td>Australia - Abridgement of a patent application</td>
</tr>
<tr>
<td>COG</td>
<td>Customer Operations Group (formerly known as ERA)</td>
</tr>
<tr>
<td>EP</td>
<td>European Patent Office, in two letter code</td>
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<tr>
<td>EPC</td>
<td>European Patent Convention</td>
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<td>EPO</td>
<td>European Patent Office</td>
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<td>Electronic Records Administration (now COG)</td>
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<td>Foreign Examination Report</td>
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<td>Fleet Street Reports</td>
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<td>IB</td>
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<td>INID</td>
<td>Internationally Agreed Numbers for Identification of Data</td>
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<td>IPE</td>
<td>International Preliminary Examination</td>
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This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
<table>
<thead>
<tr>
<th>Abbreviation</th>
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<tr>
<td>IPER</td>
<td>International Preliminary Examination Report</td>
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<td>ISR</td>
<td>International Search Report</td>
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<td>Japan, in two letter code</td>
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<td>NPL</td>
<td>Non-Patent Literature</td>
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<td>OEP</td>
<td>Oppositions and Examination Practice</td>
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<td>APO Patent Administration database</td>
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<td>US</td>
<td>United States of America, in two letter code</td>
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<td>USPTO</td>
<td>United States Patent and Trademark Office</td>
</tr>
<tr>
<td>WIPO</td>
<td>World Intellectual Property Organisation</td>
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<tr>
<td>WO</td>
<td>WIPO, in two letter code</td>
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</table>
2.2.2 "Private Applicant" Cases

In this topic:

General

When a private applicant files a provisional application, it is Office practice to forward explanatory information detailing formal requirements. Examiners should also include with their first report appropriate additional information as required.

Private applicants are to be advised that if they wish to seek personal help in processing their application, they should contact a patent attorney. The Office does not prepare lists of patent attorneys. Accordingly, it should be suggested to private applicants that they consult the Yellow Pages or contact the Institute of Patent Attorneys of Australia. Under no circumstances should examiners recommend or nominate a particular attorney or firm of attorneys.

Reasons why private applicants do not use the services of a patent attorney may include ignorance of the existence of the profession and cost. Some applicants are capable of obtaining a patent without using the services of a patent attorney. Examiners must therefore avoid any suggestion, expressed or implied, that applicants must seek the services of a patent attorney in order to prosecute their application.

Note: Any additional information to be sent to a private applicant, e.g. copies of patent documents, should be attached to the examination report using the ‘Attach File’ function in PAMS (see 5.6.1.2 Examiner Correspondence Screen).

Types of Private Applicant and Examination Approach

Private applicants fall roughly into three categories and therefore the approach to examination should be varied accordingly.

1. Private Applicants With Previous Experience

There are relatively few private applicants who have had previous experience in prosecuting applications. The specification will usually contain fairly well drafted claims and description,
and prior applications by that applicant will often be noted in the particular area of technology. For this category of applicant, no additional information need be provided with the report. The usual type of report should be written, although with slightly more explanation than if the report was being written for a patent attorney.

2. Private Applicants With Little Experience

These applicants have little to no prior experience in prosecuting patent applications, but have obviously obtained sufficient information to have made a good attempt. The claims of the specification may have significant defects, but are nevertheless reasonable attempts at defining the invention. For this category of applicant, the usual type of report should be written, although particular care must be taken to ensure that each objection is expressed fully and clearly in terms that the inexperienced applicant might be expected to understand.

The information provided in "Responding to an Examination Report", which is available from the IP Australia website, should be included with the report.


This category of applicant is invariably identified by the claims which, if they exist, do not define anything, or else claim each element of a combination separately. For this category of applicant the following approach should be adopted:

- where there are no claims present, an objection to this effect should be included in the report (see for example PERP code [R37]).
- where any of the claims present are unsearchable, examiners should carefully ascertain from the description what the alleged invention is. A search should then be conducted to determine whether or not the invention is novel and patentable and a note included in the report to indicate the field that has been searched. A search must not be reserved simply because the claims are unsatisfactory; it must also be impossible to determine the inventive concept from the description (see also 4.1 Searching).
- where, after conducting the search, it is concluded that it would not be possible to draft proper claims that define a novel and patentable invention, then this should be the primary substance of the first report, supported by clear and detailed reasoning.
- where it is concluded that there is a novel and patentable invention, then the aim of the report is to provide guidance to the applicant. In doing so, examiners must avoid drafting claims for the applicant.
Examiners should ensure that the report includes sufficient detail and is written in a clear manner such that it is readily understood by the applicant. Where examiners have any concerns or doubts regarding the content of the report, they should consult a senior examiner.

Examiners should not write lengthy essays to explain relevant examination aspects. Instead, the report should be accompanied by at least the information provided in “Responding to an Examination Report”. Any explanations given in the report should then be restricted to cross-references to parts of this information or “The Patents Guide”, which is also available from the IP Australia website.

Examiners should include copies of any cited patent documents with their report. Where non-patent literature has been cited, the procedures outlined in 2.1.7.5 Non-Patent Literature should be followed. If there are no citations, or none of the citations are accepted or granted patent specifications, examiners should also provide a copy of at least one accepted/granted patent specification from the relevant technology. This will provide the applicant with examples of the manner in which inventions in the particular field have been described and claimed.

Where it is evident that the applicant has a poor knowledge of English, particular care should be taken to ensure that the language used in the report is clear and readily understood.

Depending on the nature of the invention, it is sometimes unavoidable that serious objections will arise at further report stage. Where this situation seems likely, appropriate explanations of the relevant law should if possible be included in the first report in order to assist the applicant.

---

**Report Requirements re Fee Payments**

Many private applicants are unaware of the need to pay continuation or renewal fees. Therefore examiners must include the following text at the end of any adverse examination report:

**In the case of a patent application:**

“You must pay continuation fees by when they are due or your patent application will lapse. Please note that you will not be notified by the Office of any due dates for the payment of fees. You will need to keep track of this yourself. Information about the fees that you will need to pay and when they will be due may be obtained by phoning 1300 651010.”

**In the case of a patent:**
“You must pay annual renewal fees by when they are due or your patent will cease. Please note that you will not be notified by the Office of any due dates for the payment of fees. You will need to keep track of this yourself. For innovation patents, the first of these fees is usually due two years from the filing date, however depending on the circumstances of your application, another date may apply. Information about the fees that you will need to pay and when they will be due may be obtained by phoning 1300 651010.”

(see PERP code [R71])

Where a further report cannot be issued before the application goes into a state of lapse, a note should be included at the end of the report that the unpaid fee can be paid within 6 months after the due date, provided it is accompanied by the appropriate late payment fee. The note should also state that the late payment fee is (the current fee) per month, or part thereof that the continuation fee is overdue.

**2.2.3 Poor Translations**

Where the translation of a specification is so poor that the scope of the claims cannot be properly determined, and the nature of the invention cannot be ascertained, examiners should raise an objection of lack of clarity (see also 2.11.5 Claims are Clear). For those cases where there are no earlier search results available, examiners should conduct a search to the extent possible as per 4.1 Searching.

Where it is necessary to restrict the extent of the search and/or report as a result of a poor translation, a note to this effect must be included in the report. The note should indicate that opinion is reserved with respect to those matters not covered by the report.

**Note:** For translations filed after 25 September 2019, where examiners have any doubts about the accuracy of the translation, they should follow the procedures in 2.15.7.3 Request for Corrected Translation or Certificate of Verification.

**2.2.4 Communication of Report**

**Modified Date: 01 June 2017**
2.2.4.1 Emailing Reports to Applicants or Attorneys; Sending Urgent Reports

If an examination report is emailed to an attorney or applicant, a copy of the report should also be dispatched via the outbound correspondence system in the usual manner (see 5.10.10.1.2 Examiner’s Adverse Report). Examiners are to ensure that a copy of the email is added to the case file (see 5.6.2.1 Add an Email to the Ecase).

Where a report is urgent and requires immediate dispatch, examiners should follow the procedures outlined in 5.6.1.2 Examiner Correspondence Screen and 5.10.10.1.3.1 Dispatch Management.

**Note:** Email is not an official means for filing a response to an examiner’s report. Thus, any documents required to be filed (e.g. substitute pages, notice of entitlement, request to amend) or applicant/attorney submissions must be filed in paper or via eServices. They cannot be filed by email. If a response to a report is received via email, examiners should contact the applicant or attorney and advise that the response must be filed in paper or via eServices.

Modified Date: 25 February 2019

2.2.4.2 Delayed or Non-Receipt of the Report by the Applicant or Attorney

In this topic:

**Overview**

The period for gaining acceptance runs from ‘the date of the first report’ (reg 13.4), i.e. the date that appears on the report. The report is taken to have been given to the applicant on that date (reg 1.3(4)). There is no provision in either the Act or Regulations to withdraw a report and replace it with another report, or for the date of a report to be changed after issue.

Consequently, a report issues when it is placed in the PAMS Ecase as a completed document, i.e. with the document status of ‘FILED’. This occurs on pressing the ‘SEND’ button in PAMS. Reports in PAMS will be uploaded into AusPat overnight and become visible on eDossier the following day.

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.2.4.2 Delayed or Non-Receipt of the Report by the Applicant or Attorney

Where there has been a delay in the receipt of the report by the applicant or attorney, it may be possible to extend the time for acceptance. Any request for an extension of time should be referred to the supervising examiner, who will consult with Patent Oppositions. In general, an extension of time is not allowed until it is needed, i.e. an extension is not needed until the normal period for gaining acceptance is about to expire. An extension of time can also be allowed (without a formal request being made) where an application lapses due to expiry of the period for acceptance and there is clear evidence of Office error (see the scenarios discussed below). In these circumstances, a case note should be added to the file and the supervising examiner informed of the situation. If the supervising examiner agrees that sec 223(1) is applicable, the form at 3.11 Annex A - Section 223(1) Extension of Time for Acceptance File Note should be completed and the case referred to the Assistant General Manager (OEP). Further guidance on the treatment of extensions of time in accordance with sec 223 is provided in 3.11 Extensions of Time and Restoration of the Right of Priority.

Some specific scenarios in relation to issuing reports are discussed below. See also 2.2.4.3 Correction of Reports for the situation where a completed report contains errors.

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Report not Received

Examiners should be careful to ensure that all reports are addressed correctly. If for any reason a report does not arrive at its correct address, the report must stand (as there is no power to replace the report).

In the situation where a report has gone missing, COG will forward a copy of the report to the correct address, together with a covering letter explaining the circumstances and advising the applicant or attorney that, if needed, an extension of time under sec 223(2) to the period prescribed in reg 13.4 for acceptance of the request and specification will be allowed, commensurate with the delay.

If the report was correctly addressed, and prima facie it appears that the report was mailed by the Office, then the most likely explanation for it not being received is that it was lost in the mail. In these circumstances, the applicant or attorney is to be advised that an extension of time to gain acceptance may be sought under sec 223(2)(b) (circumstances beyond control), with a statutory declaration being required to establish that the report was not received at the correct address.
2.2.4.3 Correction of Reports

Report Sent to Wrong Address

If it is apparent that a report has been sent to the wrong address, then the report will stand, but the grounds to invoke the provisions of sec 223(1) will be regarded as established. In these circumstances the applicant or attorney is NOT to be asked to supply a statutory declaration to corroborate that the report was not received. The applicant or attorney should be advised that an extension of time under sec 223(1) will be allowed if it is not possible to gain acceptance in time.

Report not Despatched

Where it is clear that a report was entered into PAMS, but not despatched, the report is regarded as issued on the date that it was dated. A copy of the report should be despatched to the applicant or attorney (if they have not already obtained a copy from eDossier), together with a covering letter explaining the circumstances. The grounds to invoke the provisions of sec 223(1) will be regarded as established. The applicant or attorney should be advised that an extension of time under sec 223(1) will be allowed if it is not possible to gain acceptance in time.

Warning: Examination reports with the document status of ‘FILED’ MUST NOT be deleted from the PAMS Ecase. However, reports with the status of ‘DRAFT’ may be deleted, as these are working documents that have not been issued.

Consequently, where examiners become aware that a completed report with the document status of ‘FILED’ contains an error, for example an objection has been overlooked, or an objection is recognised as wrongly taken, the appropriate corrective action is to immediately issue a further report (i.e. second, third etc).* The report should also include an apology as appropriate (as per 2.1.5 Inconsistent or Piecemeal Examination).
2.2.5 Work Priorities and Case Allocation

Where examiners are aware of other inconsistencies or omissions in a completed report, they should consult a senior examiner as to whether it is necessary to issue a further report, or if a phone call to the applicant or attorney will suffice.

See also PERP codes [A80] and [A81] for cases where correction of a report is required as a result of quality review. Further information on issuing corrective actions as a result of a quality review Finding can be found in the Quality System and Security Manual.

*Note: When issuing the further report, examiners should ensure that the report is correctly numbered. Where the report number is incorrect and requires editing, examiners should follow the procedure outlined in 5.6.1.11 Exam Correspondence Default Names, Editing the Further Report Number.

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2.2.6 Responsibility for Furthers, Voluntary Section 104 Amendments

Furthers

Examiners are responsible for their own furthers, provided they remain employed as an examiner of patents (including senior examiners and supervising examiners).
2.2.7.1 Introduction

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019

examiner is unable to complete a further within the Customer Service Charter timeframe due to leave, the further is to be assigned to the section that is currently responsible for the primary sub-class (primary IPC mark) allocated to the application. Similarly, where an examiner has ceased to be employed as an examiner, any further is to be assigned to the section that is currently responsible for the primary IPC mark allocated to the application.

Voluntary Section 104 Amendments

All voluntary sec 104 amendments will be assigned by ERA to the section that is currently responsible for the primary IPC mark allocated to the application. Notwithstanding this, in the case of post-acceptance sec 104 amendments, it is the responsibility of the examiner who originally examined the application to examine the sec 104 request, even if that examiner is now located in another section.

If the original examiner is not available, and the application was accepted by another examiner, then responsibility for examining the sec 104 request falls to the acceptance examiner. If neither the original examiner nor the acceptance examiner is available, then the sec 104 request is to be assigned to the section that is currently responsible for the primary IPC mark allocated to the application.

Note: As a general principle, sections should cooperate with one another to facilitate the processing of further and sec 104 requests. For example, where a primary IPC mark has recently been transferred from one section to another, the sections involved may come to some arrangement for the handling of further or sec 104 requests.

2.2.7 Communication with Applicants and Attorneys Outside the Reporting Process and Recording of Case Notes

Modified Date: 15 August 2011

2.2.7.1 Introduction

Examiners should use means of communication other than the formal reporting process to clarify issues and resolve minor problems with applicants and attorneys if:

- this is likely to result in overall efficiencies for the office and the applicant or attorney is willing to use the means of communication contemplated; or
• an applicant or attorney indicates a preference for other means of communication and this can be accommodated without compromising efficiency to any substantial extent.

Records of conversations and copies of emails should be added to the case file as appropriate. Case notes are also an important means for communicating information on a particular patent or application. Examiners should be aware that once a patent or application becomes OPI, all documents on that case file also become OPI pursuant to sec 55 (see also 2.17.5 Published Documents). Therefore it is important that all documents prepared by examiners, such as case notes, are done so in a consistent, accurate and professional manner.

Where communication outside the reporting process has occurred, it is good practice to diary further action dates to check whether an issue has been resolved or a response has been received. Examiners should establish with the attorney or applicant a time frame within which they expect the attorney/applicant to complete the action agreed on. They should advise the attorney or applicant that if the agreed action is not completed within the agreed time frame a further report will issue or the application will be accepted.
Records of Conversation

As a general rule, a record of all phone conversations with applicants or attorneys must be added to every case file to which the conversation is relevant. This applies whether it is the examiner or the applicant/attorney who has initiated the conversation. The record should include the date and time, the name of the person with whom the conversation took place, a brief summary of the discussion and any follow-up action to be taken. Examples of such action include the issue of a further report or written confirmation of proposed amendments. Conversations should be recorded following the procedures outlined in 5.10.20 Recording Conversations as a File Note.

Examiners should advise the applicant/attorney that a record of the conversation will be made and placed on file. Where the applicant/attorney expresses any concerns, they should be referred to IP Australia’s Privacy Policy which explains in greater detail the Office’s procedures for handling personal information.

Records of conversation should include anything relevant to an official decision, however examiners should ensure that this is the only information that is recorded. In this regard examiners should follow the principles outlined below:

- Discretion should be used in determining what should be included in the record of conversation, bearing in mind that this may be read by the general public.
- Unrelated and irrelevant matters should not be recorded; records should be succinct and factual.
- Any third parties mentioned in the conversation, or any information that could identify a third party such as a patent or application number that is unrelated to the matter at hand, should not be recorded for privacy reasons.

Modified Date: 26 May 2014

2.2.7.3 Communication with Applicants or Attorneys by Email

Email may be utilised under similar circumstances as the phone in order to resolve issues of a minor nature (see 2.2.7.2 Communication with Applicants or Attorneys by Phone).
2.2.7.4 Dealing with Applicants or Attorneys in Person

Furthermore, if examiners experience difficulties contacting the applicant or attorney by phone but have their email address, they should use email as a means of establishing contact or communicating the issues. As these emails are an official form of correspondence, examiners must maintain a professional manner when using this form of communication.

A copy of every email communication between an examiner and an applicant or attorney must be added to every case file to which the email is relevant, unless the information in the email merely duplicates information already on file. This applies whether it is the examiner who is the sender or the recipient of the email. Copies of emails should be added to the file using the procedures outlined in 5.6.2.1 Add an Email to the Ecase.

Any report that is emailed to an applicant or attorney should also be dispatched in the usual manner (see 2.2.4.1 Emailing Reports to Applicants or Attorneys; Sending Urgent Reports).

Note: Email is not an official means for filing a response to an examiner's report. Thus, any documents required to be filed (e.g. substitute pages, notice of entitlement, request to amend) or applicant/attorney submissions must be filed in paper or via eServices. They cannot be filed by email. If a response to a report is received via email, examiners should contact the applicant or attorney and advise that the response must be filed in paper or via eServices.

Modified Date: 01 November 2012

2.2.7.4 Dealing with Applicants or Attorneys in Person

The supervising examiner must be informed of any proposed meeting with an applicant or attorney in the first instance. If the meeting is with a private applicant, then a supervising examiner or an Assistant General Manager should also be present. If the meeting is with an attorney, then, depending on the matter being discussed, the supervising examiner should either be personally present or depute a senior examiner to attend.

Where applicants raise questions concerning the commercialisation of their invention, they should be advised to seek professional advice, such as from a patent attorney.

A record of the conversation should be added to every case file to which the conversation is relevant using the principles outlined in 2.2.7.2 Communication with Applicants or Attorneys by Phone.
2.2.7.5 Recording of Case Notes

In this topic:

Case notes are an important means of recording and communicating information on a file. Improper use of case notes (or a lack thereof) can cause confusion and errors. A case note **must** be added when something of significance occurs that is not recorded elsewhere on the file. For any situation not already explicitly recorded, the default presumption is that a case note should be made. Where information is merely being relayed to the applicant or attorney, for example re-sending a document, then a case note can be made but it is not necessary. If examiners are in any doubt about whether to add a case note, they should consult a senior examiner or supervising examiner.

**When to Add a Case Note**

A case note should be added when:

- a change is made to the data on the case for reasons that are not immediately obvious from the documents already on file.

- information needs to be conveyed to someone else who will subsequently deal with the case.

**When Not to Add a Case Note**

A case note should not:

- be used as an addendum to a reported decision, e.g. additional comments made about the acceptance of an application.

- be used to foreshadow a decision that is intended to be made at a later stage.
Case Note Content

Case notes should convey all relevant information clearly and succinctly and include:

- the relevant background details;
- the situation that prompted the case note; and
- how the situation was dealt with.

Case notes should be added to the file using the procedures outlined in 5.6.1.10 Add a File Note to the Ecase.

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The Intellectual Property Laws Amendment (Raising the Bar) Act 2012 came into force on 15 April 2013. The following provides a summary of the main changes to examination.

<table>
<thead>
<tr>
<th>Topic</th>
<th>Application</th>
<th>Manual Reference</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Acceptance Period</strong></td>
<td>Acceptance period reduced from 21 months to 12 months. Response fees no longer</td>
<td>Applies to standard patent applications with an examination request filed</td>
</tr>
</tbody>
</table>

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Effective Date: 25 September 2019
## Amendments

Amendment of a complete specification is not allowable if the amended specification claims or discloses matter extending beyond that disclosed in the complete specification as filed and other prescribed documents.

<table>
<thead>
<tr>
<th>on or after 15 April 2013</th>
<th>Acceptance</th>
</tr>
</thead>
<tbody>
<tr>
<td>Applies to:</td>
<td></td>
</tr>
<tr>
<td>- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.</td>
<td>2.23.7A Allowability of Amendments to Complete Specifications</td>
</tr>
<tr>
<td>- requests to amend filed on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent.</td>
<td>2.23.8A Allowability Under Section 102(1)</td>
</tr>
</tbody>
</table>

Amendment of an abstract is not allowable. Amendment of a patent request to convert an application to a divisional is not allowable after the application.

2.8.3A Amendment of Abstract

2.10.10A Amendment of Patent Request – Conversion of Application to a Divisional
### 2.2.8 Summary of IP Reform Changes

<table>
<thead>
<tr>
<th>Section</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Balance of Probabilities</strong></td>
<td>Test applies to all grounds of examination. Applies to standard patent applications and innovation patents with an examination request filed on or after 15 April 2013.</td>
</tr>
<tr>
<td><strong>Clear Enough and Complete Enough Disclosure</strong></td>
<td>Complete specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art. Applies to standard patent applications and innovation patents with an examination request filed on or after 15 April 2013.</td>
</tr>
<tr>
<td><strong>Direction to Request Examination</strong></td>
<td>Period for requesting examination following direction reduced from 6 months to 2 months. Applies to directions issued on or after 15 April 2013.</td>
</tr>
<tr>
<td><strong>Divisionals</strong></td>
<td></td>
</tr>
</tbody>
</table>

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
### 2.2.8 Summary of IP Reform Changes

<table>
<thead>
<tr>
<th>Divisional application under sec 79B must be filed no later than 3 months from the date of advertisement of acceptance of the parent application. (See also Amendments for amendment of a patent request to convert an application to a divisional).</th>
<th>Applies to divisional applications filed <strong>on or after</strong> 15 April 2013.</th>
<th>2.10.3A Time Limits for Filing Applications</th>
</tr>
</thead>
</table>

### Grace Period

<table>
<thead>
<tr>
<th>Grace period applies to any information made publicly available. Provisions of sec 24(1) only apply where a complete application is filed in the prescribed period.</th>
<th>Applies to information made publicly available <strong>on or after</strong> 15 April 2013.</th>
<th>2.4.4.6A Exclusions 2.4.4.6.3A Grace Period</th>
</tr>
</thead>
</table>

### Inventive/Innovative Step

<table>
<thead>
<tr>
<th>Common general knowledge no longer restricted to that in Australia. Inventive step: removal of the requirement that prior art documents be ‘ascertained, understood and regarded as relevant.’</th>
<th>Applies to standard patent applications and innovation patents with an examination request filed <strong>on or after</strong> 15 April 2013.</th>
<th>2.5.2.1.5A Common General Knowledge not Limited to Being in Australia 2.31.4.5.4A Innovative Step 2.5.1.2A The Statutory Basis for Inventive Step 2.5.1.6A Assessing Inventive Step in Examination 2.5.2.3.1A</th>
</tr>
</thead>
</table>
### 2.2.8 Summary of IP Reform Changes

<table>
<thead>
<tr>
<th><strong>Modified Examination</strong></th>
<th>Requests for modified examination cannot be filed <strong>on or after</strong> 15 April 2013.</th>
</tr>
</thead>
</table>
| Repeal of provisions allowing for modified examination and deferment of examination. Requests for modified examination made before 15 April 2013 proceed under the 'old' modified examination provisions. | 2.14 Modified Examination  
2.28.2 Provisions of the Patents Act 1990 (as in Force Immediately Before 15 April 2013) |

<table>
<thead>
<tr>
<th><strong>National Phase Applications</strong></th>
<th>Applies to PCT applications that enter the national phase <strong>on or after</strong> 15 April 2013.</th>
</tr>
</thead>
<tbody>
<tr>
<td>PCT application must meet the requirements of a formalities check otherwise it may lapse.</td>
<td>2.20.1.4A Formalities Check</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th><strong>Notice of Entitlement</strong></th>
<th>Applies to requests for examination for standard patents filed <strong>on or after</strong> 15 April 2013.</th>
</tr>
</thead>
</table>
| Notice of entitlement to grant and to claim priority must be included as part of the request for examination. Where there is a change of applicant, a new notice of entitlement is required, unless the change is supported by evidence, e.g. sec 113. | 2.6.3.1 Notices of Entitlement  
2.6.4.1 General Considerations |

<table>
<thead>
<tr>
<th><strong>Omnibus Claims</strong></th>
<th></th>
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<tbody>
<tr>
<td></td>
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</table>

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.  
Effective Date: 25 September 2019
### 2.2.8 Summary of IP Reform Changes

<table>
<thead>
<tr>
<th>Topic</th>
<th>Description</th>
<th>Applies to</th>
<th>References</th>
</tr>
</thead>
<tbody>
<tr>
<td>Claims must not rely on references to the description or drawings unless absolutely necessary to define the invention.</td>
<td>Applies to standard patent applications and innovation patents with an examination request filed <strong>on or after</strong> 15 April 2013.</td>
<td>2.11.2.3.9A Omnibus Claims</td>
<td></td>
</tr>
<tr>
<td><strong>Postponement of Acceptance</strong></td>
<td>Commissioner may postpone acceptance even if the applicant has not requested it.</td>
<td>Applies to requests for postponement filed <strong>on or after</strong> 15 April 2013.</td>
<td>2.15.8 Postponement of Acceptance</td>
</tr>
<tr>
<td><strong>Preliminary Search and Opinion (PSO)</strong></td>
<td>PSO may be conducted on a complete application for a standard patent.</td>
<td>Applies to complete applications for standard patents filed <strong>on or after</strong> 15 April 2013.</td>
<td>2.13.15 Preliminary Search and Opinion (PSO)</td>
</tr>
<tr>
<td><strong>Prior Use</strong></td>
<td>Prior use (doing of an act) may be considered for novelty and inventive/innovative step purposes.</td>
<td>Applies to standard patent applications and innovation patents with an examination request filed <strong>on or after</strong> 15 April 2013.</td>
<td>2.4.4.1A Prior Art Information, 2.5.2.5A Prior Art Information, 2.13.5.2A Balance of Probabilities, 2.31.4.5.4A Innovative Step</td>
</tr>
<tr>
<td><strong>Priority Dates</strong></td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td>Section</td>
<td>Summary of IP Reform Changes</td>
<td></td>
<td></td>
</tr>
<tr>
<td>---------</td>
<td>-----------------------------</td>
<td></td>
<td></td>
</tr>
</tbody>
</table>
| **2.2.8** | In order to secure a priority date, a priority document must disclose the claimed invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art. Applies to standard patent applications and innovation patents with an examination request filed on or after 15 April 2013.  

**Re-Examination**  
Expanded grounds are available for consideration. Prior use (doing of an act) may be considered for novelty and inventive/innovative step purposes. Applies to re-examination reports issued on or after 15 April 2013.  

**Revocation of Acceptance**  
Acceptance of a standard patent application may be revoked in exceptional circumstances. Applies to standard patent applications accepted on or after 15 April 2013.  

**Revocation of Certification**  
Certification of an innovation patent may be revoked in exceptional circumstances. Applies to innovation patents certified on or after 15 April 2013.  

**Revocation of Leave to Amend**  
Leave to amend may be revoked in exceptional circumstances. Applies to standard patent applications accepted, and  

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This document is controlled. Its accuracy can only be guaranteed when viewed electronically.  
Effective Date: 25 September 2019
## 2.2.8 Summary of IP Reform Changes

<table>
<thead>
<tr>
<th>Section 112A</th>
<th></th>
</tr>
</thead>
<tbody>
<tr>
<td>Amendments to a patent application cannot be allowed where there are relevant proceedings pending.</td>
<td>Applies to all amendment requests that have not been dealt with by the Commissioner before 15 April 2013.</td>
</tr>
<tr>
<td></td>
<td></td>
</tr>
</tbody>
</table>

### Support

Claims must be supported by matter disclosed in the specification.

|  | Applies to standard patent applications and innovation patents with an examination request filed on or after 15 April 2013. |
|  |  |

### Usefulness

Specification must describe a use that is specific, substantial and credible.

|  | Applies to standard patent applications and innovation patents with an examination request filed on or after 15 April 2013. |
|  |  |

### Whole of Contents

Whole of contents citations include documents published on the priority date of the claims under consideration.

|  | Applies to standard patent applications and innovation patents with an examination request filed on or after 15 April 2013. |
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Effective Date: 25 September 2019
2.3 Definitions

Modified Date: 01 November 2012

2.3.1 Definitions in the Patents Act

Section 3 (and schedule 1) provides definitions for certain terms used throughout the Act. Although the application of any such definition is subject to the absence of a contrary intended meaning for a term, the inclusion of a definition in sec 3 indicates that such a contrary intention will generally be the exception. Therefore the definition given in sec 3 should be applied, unless it is evident that the definition is inapplicable in the context in which the term is used. Definitions which are of particular significance in examination are found in the relevant parts of this volume. The following definitions are relevant to examination generally:

"Patent" is intended to mean an Australian standard patent or an innovation patent (schedule 1). The contrary intention however is clearly apparent in various parts of the Act, e.g. in sec 201A(2)(a). In these circumstances the definition given in schedule 1 does not apply.

"Patentee" is defined not by actual ownership of a patent, but by an appropriate entry in the Register. Legal proof of transfer of ownership is not, by itself, sufficient to change the identity of a patentee, unless and until the Register is appropriately amended.

The definition of the "Commissioner" relates only to the exercise of powers of functions under the Act and Regulations. For the purpose of the chief control of the Office, there is only one Commissioner. The organisation of the Office as such, within the Public Service generally, and the related aspects of individual positions, duties and responsibilities, are not affected by the fact that various persons may from time to time and in relation to specific matters, fall within the definition of the "Commissioner".

2.3.2 Effect of the Acts Interpretation Act

Modified Date: 01 November 2012
2.3.3 Some Examples of Intended Ambits

Definition of the terminology used in the Patents Act is not confined to the examples given in sec 3 and elsewhere, since the interpretation of this Act is also subject to the general rules of interpretation specified in the Acts Interpretation Act 1901. This Act defines a number of words used in the Patents Act, but not defined therein, e.g. "person" and "document". It also specifies a number of rules applicable to words used generally, e.g. that words used in the singular shall include the plural and vice versa, unless the contrary intention appears.

2.3.3 Some Examples of Intended Ambits

In applying the definitions given in the Patents Act and Acts Interpretation Act 1901, consideration of whether the definition is comprehensive or merely inclusive may be required. In the former case, to which most examples in the Patents Act belong, the definition determines the ambit of the term defined; in the latter case, the definition merely specifies individual inclusions (or exclusions).

Examples of intended ambits from the Patents Act and Regulations include:

- across the regulations, unless the contrary intention appears - see reg 1.3(1)
- limited to:
  - a chapter - see reg 5.2;
  - a part - see sec 124;
  - a section - see sec 38(2);
- excluded from:
  - a regulation - see reg 22.16(1);
- by specific reference to the Acts Interpretation Act 1901 - see sec 7 footnote and schedule 1 "prior art base" footnote, or another Act - see sec 224(4).

2.3.4 Reckoning of Time
2.3.4 Reckoning of Time

The Act specifies time periods for many actions required by applicants. In some circumstances, the action can be done after the last day and still be regarded as done in time. The specific provisions governing the reckoning of time are sec 222A of the Patents Act and sec 36 of the Acts Interpretation Act 1901.

The general principle is that if an action is to be done on or by a day on which the Office is not open for business, then the action can be done on the next day that the Office is open for business. This applies to weekends, public holidays and the Christmas shutdown.

The Director General or other prescribed person may declare that the Office is not open for business on a particular day. Under reg 22.10AB(2), the Director General and Deputy Director General are both able to declare such days autonomously. Other Senior Executive Service (SES) employees of IP Australia may also declare such days, however only with the agreement of the Director General, Deputy Director General or another SES employee. A declaration can be made before or after the particular day, and is published in the Official Journal and on the News and Official Notices pages of the IP Australia website.

This must be distinguished from an extension of time, which generally requires a request and the payment of a fee.

**Note:** See 2.15.6 Time for Acceptance for considerations applying to the action of acceptance by the Commissioner.

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**Situations Where Section 222A Not Applicable**

Section 222A of the Act does not apply to the following actions:

1. an act in relation to proceedings in a court or a tribunal; and

However, the Acts Interpretation Act 1901 still applies to these matters.

**Note:** Section 222A does not apply to an act done under the PCT. Note, however, that Rule 80.5(iii) does apply and has a similar effect where public holidays are concerned.

2.4 Novelty

Modified Date: 02 April 2013

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Effective Date: 25 September 2019
2.4.1 Introduction

The decisions of the full bench of the Federal Court in Werner v Bailey Aluminium 13 IPR 513, and Nicaro Holdings v Martin Engineering 16 IPR 545, review the historical development of the law of novelty in Australia. These decisions clearly suggest that the ruling of the High Court in Griffin v Isaacs (1938) 12 ALJ 169; 12 AOJP 739, effectively lost its relevance upon the commencement of the 1952 Act in 1954.

Consequently, examiners should apply the "reverse infringement test" when assessing novelty. The test for novelty expounded in Griffin v Isaacs supra, is not to be used.

2.4.2 Test for Novelty

The test for determining whether an invention lacks novelty is the "reverse infringement test" as set out in Meyers Taylor Pty Ltd v Vicarr Industries Ltd (1977) CLR 228 at page 235; 13 ALR 605 at page 611, where Aickin J stated:

"The basic test for anticipation or want of novelty is the same as that for infringement and generally one can properly ask oneself whether the alleged anticipation would, if the patent were valid, constitute an infringement."

Note that the term "anticipation" used here and in the following parts of this chapter is synonymous with "lack of novelty".

Infringement of a claim occurs where "each and every one of the essential integers" of that claim have been taken.


2.4.3 Applying the Test for Novelty

It follows from the reverse infringement test that:

- if a citation discloses all the features of a claim, the claim will lack novelty;
2.4.3.2 Testing a Claim Against a Citation

- if the citation does not disclose all the features of the claim, the claim will still lack novelty provided the citation discloses all the essential features of the claim;
- if an essential feature is not disclosed in the citation, the claim is novel.

See:
- *Nicaro Holdings v Martin Engineering* 16 IPR 545;
- *Catnic Components Ltd v Hill and Smith Ltd* (1982) RPC 183; and

In order to determine whether a claim is novel in view of a citation, examiners must:

- establish that the citation is a relevant prior art document that can be considered for the purpose of a novelty objection (see 2.4.4 Relevant Prior Art and 2.4.11 “Whole of Contents”);
- interpret the citation to determine what it disclosed to an addressee at its date of publication (see 2.4.5 Construing the Citation);
- determine whether the citation discloses all the features of the claim (if so, the claim is not novel);
- if there are any differences between the features of the claimed invention and the disclosure of the citation, construe the specification and claim and identify whether those features are essential (or inessential) features of the invention (see 2.4.8 Not All Features of Claim Disclosed in Citation); and
- determine whether the citation discloses all the essential features of the claimed invention (if so, the claim is not novel).

If not all the essential features are disclosed in the citation, the claim is novel. Examiners should then proceed to consider whether the claimed invention involves an inventive step.
2.4.4.1 Prior Art Information

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.4.4.1A Prior Art Information.

When considering the novelty of a claim of a standard patent application or an innovation patent, the relevant prior art information is defined in schedule 1. For the purposes of examination, the prior art is restricted to the following:

- information in a document that is publicly available before the priority date, whether in or out of the "patent area" (i.e. Australia, Australian continental shelf, etc - see schedule 1); and
- information contained in certain Australian patent specifications published after the priority date of the claim under consideration (see 2.4.11 "Whole of Contents").

There is no time limit operating to exclude a document from consideration because it is 'too old'. This is in contrast to the '50 year rule' formerly provided by sec 158 of the 1952 Act.

**Note:** During the examination of an application for a standard patent, or examination of an innovation patent, information made publicly available only through doing an act is to be disregarded (sec 45(1A), sec 48(1A) and sec101B(3)). "Doing an act" includes making an oral disclosure.

Modified Date: 01 February 2013

2.4.4.1A Prior Art Information

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
2.4.4.2 Meaning of "Document"

- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.4.4.1 Prior Art Information.

When considering the novelty of a claim of a standard patent application or an innovation patent, the relevant prior art information is defined in schedule 1. For the purposes of examination, the prior art is restricted to the following:

- information in a document that is publicly available before the priority date, whether in or out of the "patent area" (i.e. Australia, Australian continental shelf, etc - see schedule 1);

- information made publicly available before the priority date through doing an act, whether in or out of the patent area; and

- information contained in certain Australian patent specifications published on or after the priority date of the claim under consideration (see 2.4.11 "Whole of Contents").

There is no time limit operating to exclude a document from consideration because it is 'too old'. This is in contrast to the '50 year rule' formerly provided by sec 158 of the 1952 Act.

Note: "Doing an act" includes making an oral disclosure.
Information that is "publicly available" is information that the public has or can acquire by consulting a source open to it, i.e. material that can be inspected "as of right" by the public. It is sufficient that the information is available to a single person, provided that person is able to use the information freely without an obligation of confidence.

See:

- *Gadd v Mayor of Manchester* (1892) 9 RPC 516 at page 527;
- *Fomento v Mentmore* (1956) RPC 87 at page 105; and

If a person seeks to find a document on the basis of certain information, and the document is not located, it is nevertheless still publicly available (see *Nicator AB's Applications* 7 IPR 504; [1986] APO 33).

A document is publicly available provided it is publicly available somewhere in the world. Thus, for patent specifications of other countries, examiners can take the publication date in the country of origin (as shown on the published specification) as the date of becoming publicly available.
Subsection 7(1)(b) provides that for novelty (other than for "whole of contents"), prior art information made publicly available in 2 or more related documents, or through doing 2 or more related acts, can be used, if the relationship between the documents or acts is such that a person skilled in the relevant art would treat them as a single source of that information.

Some guidance on when 2 or more documents constitute a single source of information is provided in Nicaro Holdings Pty Ltd v Martin Engineering Co 16 IPR 545 at page 570 where Gummow J stated:

"What degree of lack of connection between two or more documents will make them 'independent' and so forbid the making of a mosaic to destroy novelty, will be very much a question in the particular case. Much will depend upon the nature of the art in which the skilled addressee is to be treated as versed at the priority date; this appears to have been important in the Sharpe & Dohme case*. Plainly, the degree of connection which is stated to exist in the documents themselves will be important. It is difficult to see how mere identification of prior patents as related or prior art would bring them sufficiently closely together for the purpose under consideration here. Again, even where there is a further description of the prior publication, it may nevertheless be that the purpose of the reference is to direct the reader away from it, as disclosing something outmoded or defective. On the other end of the scale, the terms of the specification of the patent in suit in the Sharpe & Dohme case* indicated that the patentees themselves had been relying upon the prior publications in question; and the publications themselves formed what Astbury J called 'one consistent whole'."

* (1927) 44 RPC 367; (1928) 45 RPC 153.

A single document may incorporate several distinct embodiments or disclosures. The above principles apply when deciding whether or not the features of one embodiment can be considered with the features of another embodiment as a single source of information.

Thus, the fact that an earlier patent describes some of the integers of a combination, and refers to other patents which describe the remainder of the integers, does not destroy the novelty of the combination, unless there is a real link between the various earlier patents, as opposed to a mere reference (see Martin Engineering Co v Trison Holdings (1989) 14 IPR 330).

When considering inventive step, examiners must determine whether a claim contains an "inventive step" in relation to the prior art base. For applications filed from 1 April 2002, it is appropriate to "mosaic" two or more pieces of information together if the person skilled in the
2.4.4.5 Resiling from Acknowledged Prior Art

Where acknowledged prior art would render a claim or claims of a specification invalid, mere deletion of that art will, in general, be insufficient to overcome the problem, unless evidence is provided to establish the fact that there was an error. This was discussed in *Chapman and Cook, and Lectro Linx Ltd v Deltavis Ltd* (1930) 47 RPC 163 at page 173:

"If a patentee, though entirely erroneously, does state by way of what I may call recital in his specification that a particular form of thing is common and then by some oversight or some mistake claims a monopoly in that particular form of thing he will have, so to speak, recited himself out of Court and I venture to doubt whether he could possibly maintain any claim to a monopoly in a thing which he has recognised to be something which existed."

This approach (which was obiter) was moderated somewhat in *Gerber Garment Technology v Lectra Systems* [1995] FSR 492, where it was stated:

"In *Sonotone Corporation v Multitone Electric Co Ltd* (1955) 72 RPC 131, at 140 however, Sir Raymond Evershed M.R., speaking obiter, expressed the view that such a recital constituted an admission which must necessarily carry great weight, but that it did not estop the patentee or debar him from leading evidence to contradict it.

In my judgement this is a correct statement of the law."

See also *Mobil Oil Corporation's Application* (1975) AOJP 2323 at the paragraph bridging pages 2324 and 2325.

Examiners should note that it is permissible for an applicant to delete a reference to acknowledged prior art from the specification during examination. However, such a deletion may not in itself overcome a novelty objection taken in light of the acknowledged prior art, if that prior art was available before the relevant priority date.

2.4.4.6 Exclusions

Examiners should note that it is permissible for an applicant to delete a reference to acknowledged prior art from the specification during examination. However, such a deletion may not in itself overcome a novelty objection taken in light of the acknowledged prior art, if that prior art was available before the relevant priority date.
2.4.4.6 Exclusions

**Note:** This part only applies to information made publicly available before 15 April 2013.

For information made publicly available on or after 15 April 2013, see [2.4.4.6A Exclusions](#).

When deciding whether an invention is novel or involves an inventive/innovative step, sec 24(1), reg 2.2 and reg 2.3 provide that certain information made publicly available, through any publication or use of the invention, is to be disregarded. Information to be disregarded includes:

- the publication of the invention at a recognised exhibition;
- the publication of the invention in relation to a learned society;
- the working in public of the invention for the purposes of a reasonable trial; and
- any publication or use of the invention within 12 months before the filing date of the complete application ("grace period").

**Modified Date:** 02 April 2013

2.4.4.6A Exclusions

**Note:** This part only applies to information made publicly available on or after 15 April 2013.

For information made publicly available before 15 April 2013, see [2.4.4.6 Exclusions](#).

When deciding whether an invention is novel or involves an inventive/innovative step, sec 24(1), reg 2.2 and reg 2.2A to reg 2.2C provide that certain information made publicly available is to be disregarded. Information to be disregarded includes:

- the publication of the invention at a recognised exhibition;
- the publication of the invention in relation to a learned society;
- the working in public of the invention for the purposes of a reasonable trial; and
- any information made publicly available within 12 months before the filing date of the complete application ("grace period").

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*Effective Date:* 25 September 2019
2.4.4.6.1 Exhibitions

In this topic:

There are two types of "recognised exhibition" where inventors may exhibit their inventions without invalidating their subsequent patent application. Under reg 2.2, these are:

- an official or officially recognised international exhibition; and
- an international exhibition recognised by the Commissioner.

Official or Officially Recognised International Exhibition

An official or officially recognised international exhibition is one within the meaning of Article 11 of the Paris Convention, or Article 1 of the Convention Relating to International Exhibitions done at Paris on 22 November 1928.

Article 11 of the Paris Convention states:

"(1) The countries of the Union shall, in conformity with their domestic legislation, grant temporary protection to patentable inventions, utility models, industrial designs, and trademarks, in respect of goods exhibited at official or officially recognized international exhibitions held in the territory of any of them."

An exhibition will be official if it is organised by a State or other public authority, and be officially recognised if it has been recognised by such a State or authority. Moreover, the exhibition has to be international, i.e. it must include the exhibition of goods from another country.

Article 1 of the Convention Relating to International Exhibitions states:

"(1) An exhibition is a display which, whatever its title, has as its principal purpose the education of the public: it may exhibit the means at man's disposal for meeting the needs of civilisation, or demonstrate the progress achieved in one or more branches of human endeavour, or show prospects for the future.

(2) An exhibition is international when more than one State is invited to take part in it."
The convention also provides, in Article 6, for the registration of the exhibition.

Such exhibitions are organised on a Government-to-Government basis. The protection afforded to inventors for the display of their inventions is generally recognised internationally. The exhibition must be international, i.e. it must include the exhibition of goods from another country. Expo 88, which was held in Brisbane, is an example of an exhibition that was officially recognised under the corresponding provisions of the 1952 Act (see (1986) 56 AOJP 1022).

Case Law

The scope of the phrase ‘official or officially recognised international exhibition’ is discussed in <i>Chiropedic Bedding Pty Ltd v Radburg Pty Ltd</i> [2007] FCA 1869; 74 IPR 398. Although the legislation relevant to this case was the Designs Act 1906, the decision is applicable to interpretation of the Patents Act.

Finkelstein J was of the opinion that use of the word “official” was designed to draw a distinction between public and privately organised exhibitions. Thus, it was determined that the term ‘official’ exhibition implies that it must have been organised by a government authority.

Finkelstein J found that, in this case, the exhibition was “officially recognized” as it was funded by a grant from the Victorian government, and was opened by the Minister for Small Businesses.

Although Finkelstein J found that the exhibition was not “international”, as it did not have a significant foreign presence, this was ruling was overturned on appeal to the full Federal Court (<i>Chiropedic Bedding Pty Ltd v Radburg Pty Ltd</i> [2008] FCAFC 142; 79 IPR 1). Thus, an exhibition with even a small foreign presence of exhibitors can be considered an international exhibition.

International Exhibition Recognised by the Commissioner

International exhibitions recognised by the Commissioner are recognised by means of a notice published in the Official Journal before the beginning of the event. An exhibition may, for example, be officially recognised upon an application being made to the Commissioner by the organiser of the exhibition.
However, unlike the officially recognised international exhibitions, the protection afforded in Australia by the Commissioner recognising the exhibition will not necessarily be recognised in other countries. Thus, while inventors may be able to obtain a valid Australian patent after exhibiting their invention, exhibition of their invention at the exhibition may invalidate a patent in most other countries.

The procedures for obtaining recognition of an exhibition are provided on the IP Australia website (Patents Displayed at International Exhibitions).

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**Application of Section 24**

In order to receive the benefit of sec 24, the following requirements must be met:

**Exhibition Before 15 April 2013**

**Filing of Application**

The application referred to in sec 24(1) may be either a provisional or complete application and must be filed within a certain period.

Where the application claims priority from a basic application, it must be filed within 12 months of the basic application, which in turn must be filed within 6 months of the first showing or use of the invention at the recognised exhibition.

In all other cases, the application must be filed within 6 months of the first showing or use of the invention.

**Exhibition Details**

- At the time of filing the application, the applicant must file a notice stating that the invention has been exhibited.

- Prior to the complete specification in respect of a standard patent application becoming open to public inspection, or within 6 months of the filing date of the complete specification of an innovation patent application, the applicant must file a statement issued by the authority responsible for the exhibition in which:
  - the invention and the exhibition are identified; and
  - the date of the opening of the exhibition is given; and
• where the first disclosure of the invention during the exhibition did not take place on that date - the date of that disclosure.

Exhibition On or After 15 April 2013

The application referred to in sec 24(1) must be a complete application and must be filed within a certain period.

Where the application claims priority from a basic application, it must be filed within 12 months of the basic application, which in turn must be filed within 6 months of the showing, use or publication of the invention at the recognised exhibition.

Where the application is associated with a provisional application, it must be filed within 12 months of the provisional application, which in turn must be filed within 6 months of the showing, use or publication of the invention at the recognised exhibition.

In all other cases, the application must be filed within 12 months of the showing, use or publication of the invention.

Publication of Invention

The publication of the invention must have occurred during the exhibition at which the invention was shown or used. However, the publication does not need to occur at the exhibition, i.e. an advertisement of the invention in a newspaper (for example) would be considered an appropriate publication for the purposes of reg 2.2, provided that publication was made during the recognised exhibition. However, brochures disclosing the invention and publicly distributed before the exhibition even though they may be in connection with the exhibition, would not fall within this requirement (see Steel & Co Ltd's Application [1958] RPC 411).

Modified Date: 02 April 2013

2.4.4.6.2 Learned Societies

In this topic:
2.4.4.6.2 Learned Societies

Overview

If the publication of an invention occurs because a paper was:

- read before a learned society; or
- published by, or on behalf of, a learned society;

that information is to be disregarded during examination when considering novelty or inventive/innovative step.

If the paper has been published, it should be "under the auspices of and finally be the responsibility" of the learned society (*Ralph M. Parsons Co. (Beavon's) Application (1978) FSR 226*). Thus, if the publication occurs through the medium of outsiders, such as journalists, who were present at the meeting at which the paper was read, this will not be regarded as publication by the society. However, in these circumstances, if it can be demonstrated that publication occurred without consent, then sec 24(1)(b) may apply (see 2.4.4.6.4 Unauthorised Disclosures). Note that publication by a society of an abstract of a paper is considered to be a publication of a paper (see *Ethyl Corporation's Patent [1963] RPC 155*).

Definition of Learned Society

There is no complete definition of what constitutes a "learned society". However, the judgement in *Parsons supra*, provides some guidance. This suggested that "learned society" is apt to describe any non-commercial body of persons seeking to promote and organise the development of specific subjects, by the provision of a forum for the exchange and discussion of ideas and the dissemination of information, usually through the publication of its proceedings.

A government department or university would not be considered to be a learned society, even if it organises seminars or conferences, etc. for disseminating technical information. In addition, while the attendees at a seminar or conference could conceivably form a learned society, merely forming for the duration of a single conference does not establish it as such. Furthermore, from *Parsons supra*, a society can have other objectives such as social and sporting pursuits.

In *Western Mining Corp Ltd v Western Minerals Technology Ltd [2001] APO 32*, the hearing officer mentioned the cases of *Work Cover Authority of New South Wales v Bitupave Limited [2000] NSWIRComm 50* and *David McNicol v Australian Capital Territory Health Authority S.C. No. 945 of 1986 Defamation [1988] ACTSC 55*, which referred to learned societies.
These cases indicated the following established bodies fall into the category of learned societies:

- Royal Society of Chemists;
- Combustion Institute;
- International Association for Fire Safety Science;
- Research Committee for the Fire Code Reform Centre (Building Code of Australia);
- Royal Australian College of Surgeons;
- Australian Orthopaedic Association;
- Orthopaedic Research Society;
- Connective Tissue Society of Australia and New Zealand;
- Australian Society of Orthopaedic Surgeons; and
- Australian Medical Association.

In *Kozo Miyake v Caterpillar Inc* [2000] APO 3, the hearing officer found that the Institute of Electrical and Electronics Engineers (IEEE) was a learned society, and that publication of a paper that had been presented at the IEEE/RSJ International Workshop on Intelligent Robots was not to be taken into account when assessing the novelty or inventive step of the application.

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**Application of Section 24**

In order to receive the benefit of sec 24, the following requirements must be met:

**Reading or Publication Before 15 April 2013**

The paper must be written by the inventor and, in the case of publication by or on behalf of a learned society, published with the inventor’s consent.

The application referred to in sec 24(1) may be either a provisional or complete application and must be filed within a certain period.
Where the application claims priority from a basic application, it must be filed within 12 months of the basic application, which in turn must be filed within 6 months of the first reading or publication.

In all other cases, the application must be filed within 6 months of the first reading or publication.

Reading or Publication On or After 15 April 2013

The application referred to in sec 24(1) must be a complete application and must be filed within a certain period.

Where the application claims priority from a basic application, it must be filed within 12 months of the basic application, which in turn must be filed within 6 months of the reading or publication.

Where the application is associated with a provisional application, it must be filed within 12 months of the provisional application, which in turn must be filed within 6 months of the reading or publication.

In all other cases, the application must be filed within 12 months of the reading or publication.

Note: This part only applies to information made publicly available before 15 April 2013.

For information made publicly available on or after 15 April 2013, see 2.4.4.6.3A Grace Period.

In this topic:

Overview

Section 24(1) provides that for the purposes of deciding whether an invention is novel or involves an inventive/innovative step, any information made publicly available by, with or
2.4.4.6.3 Grace Period

without the consent of the nominated person or the patentee, or their predecessor in title (in particular including the inventor), by publication or use of the invention within 12 months before the filing date of a complete application, must be disregarded (see also reg 2.2(1A) and reg 2.3(1A)). This 12 month period is referred to as the "grace period”.

However, this exclusion only applies to information made publicly available on or after 1 April 2002. Therefore, any document published prior to this date can be used for the purpose of deciding whether an invention is novel or involves an inventive/innovative step, even if the filing date of a complete application was within 12 months from this publication date.

Note: Under the provisions of sec 24(1), the information made publicly available includes information published in a “whole of contents” citation irrespective of whether the citation was published before or after the filing date of the application (i.e. it applies to both P, X and E category citations) (see Biogen Idec MA Inc. [2014] APO 25 and Rozenberg & Co Pty Ltd. v Velin-Pharma A/S [2017] APO 61).

Examination Practice

Examiners should not rely on the grace period in the first instance to disregard a publication for novelty or inventive/innovative step purposes, as they will not be aware of all the facts relevant to the case. However, they should be aware that it may be invoked in rebuttal of such an objection. In the unusual situation of a private applicant, examiners may draw the applicant’s attention to the existence of sec 24(1), reg 2.2(1A) and reg 2.3(1A) in the form of a note in the report.

For divisional applications, where information in the divisional was disclosed in the original (parent, etc) application, for the purposes of sec 24(1) the filing date of the divisional application is taken to be the filing date of the original application (see Mont Adventure Equipment Pty Ltd v Phoenix Leisure Group Pty Ltd [2009] FCAFC 84; 81 IPR 505).

In Mack Innovations (Australia) Pty Limited & Anor v Rotorco Pty Limited & Anor [2010] QSC 138; (2010) 239 FLR 79 McMurdo J stated that the meaning of a ‘patent application’ in sec 24(1)(b) is not limited to a complete application, but includes a provisional application. This was significant in that case, which dealt with a public working of the invention under reg 2.2(2)(d). However, for the purposes of reg 2.2(1A), the publication or use of the invention must be within 12 months before the filing date of the complete application.

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Effective Date: 25 September 2019
2.4.4.3A Grace Period

Note: This part only applies to information made publicly available on or after 15 April 2013.

For information made publicly available before 15 April 2013, see 2.4.4.3 Grace Period.

In this topic:

Overview

Section 24(1) provides that for the purposes of deciding whether an invention is novel or involves an inventive/innovative step, any information made publicly available by, with or without the consent of the nominated person or the patentee, or their predecessor in title (in particular including the inventor), within 12 months before the filing date of a complete application, must be disregarded (see also reg 2.2C). This 12 month period is referred to as the "grace period".

Note: Under the provisions of sec 24(1), the information made publicly available:

- is not limited to the publication or use of the invention; and

- includes information published in a “whole of contents” citation irrespective of whether the citation was published before or after the filing date of the application (i.e. it applies to both P, X and E category citations) (see Biogen Idec MA Inc. [2014] APO 25 and Rozenberg & Co Pty Ltd. v Velin-Pharma A/S [2017] APO 61).

Examination Practice

With the possible exception noted below in relation to divisional applications, examiners should not rely on the grace period in the first instance to disregard a publication for novelty or inventive/innovative step purposes, as they will not be aware of all the facts relevant to the
2.4.4.6.4 Unauthorised Disclosures

Under sec 24(1)(b), any information made publicly available without the consent of the nominated person or patentee is to be disregarded, provided an application* is filed within 12 months from the day the information became publicly available. Note that there are no special provisions for Convention applications.

Any applications which seek to invoke the provisions of sec 24(1)(b) are to be referred to the Assistant General Manager (OEP) via a supervising examiner.

*Note:

For information made publicly available **before** 15 April 2013, the application must be a provisional or complete.

For information made publicly available **on or after** 15 April 2013, the application must be a complete.
2.4.4.6.5 Reasonable Trial

Note: Where the issue of reasonable trial of an invention is encountered during examination, the matter should be referred to Patent Oppositions.

In this topic:

Where an invention has been worked in public:

- for the purposes of a reasonable trial of the invention; and
- because of the nature of the invention, it was reasonably necessary for the working to be in public;

that information is to be disregarded during examination when considering novelty or inventive/innovative step.

Application of Section 24

In order to receive the benefits of sec 24, the following requirements must be met:

Working Before 15 April 2013

The working of the invention must take place within the period 12 months before the priority date of a claim for the invention.

However, the application referred to in sec 24(1) may be either a provisional or complete application and must be filed within 12 months from the start of the first public working of the invention.

Working On or After 15 April 2013

The application referred to in sec 24(1) must be a complete application and must be filed within a certain period.
Where the application claims priority from a basic application, it must be filed within 12 months of the basic application, which in turn must be filed within 12 months of the start of the public working of the invention.

Where the application is associated with a provisional application, it must be filed within 12 months of the provisional application, which in turn must be filed within 12 months of the start of the public working of the invention.

In all other cases, the application must be filed within 12 months from the start of the public working of the invention.

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**Case Law**

In *Austoft Industries Ltd v Cameco Industries Inc.* [1995] APO 65; 33 IPR 251; (1995) AIPC 91-306, the Deputy Commissioner found that the working of the invention was not for the purpose of a reasonable trial.

Austoft’s invention related to machines for harvesting sugar cane. The machine was used to harvest sugar cane on a farm in the presence of a number of people, including employees of Austoft. On the basis of evidence, including:

- the perception of certain witnesses that the use of the machine was not part of any trial;
- the apparent failure of Austoft to communicate to anyone that the use of the machine was part of a trial; and
- the use to which the machine was put;

the Deputy Commissioner concluded that the trial was for the purpose of assessing the commercial acceptability of a new base cutter assembly for the machine. This ‘trial’ was outside the scope of a reasonable trial within the context of the Regulations.

The issue of reasonable trial was also considered (in the context of secret use) in *DSI Australia (Holdings) Pty Ltd v Garford Pty Ltd* [2013] FCA 132; 100 IPR 19. In this case, the patentee’s (Garford) claims were directed to an apparatus and method for manufacturing multi-strand rock bolts having spaced-apart bulbs.

Garford commenced manufacture of continuous bulbed cable for rock bolts using a ‘prototype’ version of the apparatus. It was subsequently found that the apparatus produced continuous bulbed cable in which a bulb was sometimes missing.
2.4.5.1 Introduction

Yates J concluded that the apparatus was only being used for reasonable trial to see whether it could satisfactorily produce continuous bulbed cable and for no other purpose. There was no evidence that, at the time of producing the (faulty) bulbed cable, Garford was engaged in manufacture for sale.

2.4.5 Construing the Citation

A citation can only be used for novelty purposes if it clearly discloses each of the essential features of a claim.

To assess whether a citation discloses each of the essential features of a claim, it must:

"be interpreted as at the date of its publication, having regard to the relevant surrounding circumstances which then existed, and without regard to subsequent events. The patentee's claim must similarly be construed as at its own date of publication having regard to the relevant surrounding circumstances then existing. If the earlier publication, so construed, discloses the same device as the device which the patentee by his claim, so construed, asserts that he has invented, the patentee's claim has been anticipated but not otherwise."


Note: "Date of publication" in this context should be taken to mean the date of disclosure by filing of the subject matter claimed (see Ramset Fasteners (Aust) Pty Ltd v Advanced Building Systems Pty Ltd (1996) AIPC 91-226 at 37, 322; 34 (1996) IPR 256 at 267).

2.4.5.2 Principles for Construing the Citation

2.4.5.2.1 Construe As For Any Other Document
2.4.5.2.2 Date for Construing Citation

The rules of construction for citations are the same as those that apply to the construction of patent specifications. These are outlined in 2.4.8.2 Features of a Claim _prima facie Essential_ and 2.11.2.2 Rules of Construction.

Examiners must determine the teaching of a citation by reading and interpreting the document as though they are the skilled addressee, using the common general knowledge in the art at the date of publication. Thus, examiners must endeavour to stand in the shoes of the addressee.

The citation should be construed "not as a matter of abstract uninformed construction", but by making "a common-sense assessment" of what it would convey to the skilled reader in the context of the then-existing published knowledge (_Populin v HB Nominees Pty Ltd_ (1982) 41 ALR 471). Thus, the citation should be given a purposive construction:

"A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge."

See _Catnic Components Ltd v Hill and Smith Ltd_ (1982) RPC 183 at page 243.

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2.4.5.2.2 Date for Construing Citation

In interpreting an alleged anticipation, the question to be considered is how the prior document would strike an instructed reader and not what was in the mind of the author (_Bloch and Ilford Ltd's Patent_ (1936) 53 RPC 92 at page 98, lines 14 to 16). The earlier document must moreover be construed as by a notional instructed reader at its date of publication, to the exclusion of information subsequently discovered.

See also:

- _Ore Concentration Company (1905) Ltd v Sulphide Corporation Ltd_ (1914) 31 RPC 206 at page 224; and

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2.4.5.2.3 Use of Common General Knowledge

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2.4.5.2.3 Use of Common General Knowledge

It is legitimate to read a citation in the light of common general knowledge. Thus:

"a given specification is not to be read in a vacuum. The reader must be regarded as having at least the common knowledge of the art."

*Acme Bedstead v Newlands* (1937) 58 CLR 689 at page 704.

Following from 2.4.5.2.2 Date for Construing Citation, the relevant common general knowledge is that known at the date of publication of the citation. (In contrast, for an objection of lack of inventive step, the relevant common general knowledge is that known at the priority date of the claim in question).

Common general knowledge is that knowledge which every worker in the art may be expected to have as part of his or her technical equipment (*Automatic Coil Winder Co Ltd v Taylor Electrical Instruments Ltd* (1944) 61 RPC 41 at page 43). It is compounded of training, experience, observation and reading. While in a court situation the common general knowledge may be established by the direct evidence of a person skilled in the art, such advice is usually unavailable during examination.

Consequently, while in general examiners are not persons skilled in the art, during examination their knowledge of common general knowledge, can, in the first instance, be relied upon, when determining novelty or inventive step (see also 2.5.2.6 Evidentiary Requirements).

Note, however, that when responding at further report stage, depending on the evidence and argument supplied by the applicant, it may be appropriate to support further arguments on the nature of the common general knowledge, by reference to written material.

Reading "in the light of common general knowledge" is a process whereby the words and phrases used in a document are given the meaning that they would have had to a person skilled in the art at the relevant date. For example, "adhesive means" would be read in the light of the common general knowledge to be a reference to any adhesive that the person skilled in the art would have understood as appropriate.

This is not a process of using the common general knowledge to read mechanical, chemical, or other technical features into the citation which are not implicitly present. That process is one of adding common general knowledge. Examiners must not add common general knowledge to a citation to establish lack of novelty.

"It is contended, however, that there is no justification for, to put it shortly, adding common general knowledge to an alleged paper anticipation and thus depriving a patent of subject matter."

*Acme Bedstead v Newlands* supra.

Further information on common general knowledge is provided in 2.5.2.1 Common General Knowledge.
2.4.5.2.4 Errors in the Citation

Where there is an error in a citation, that error is not to be given a literal interpretation. In particular:

- if the skilled addressee would have recognised the error, but knew how to correct it, the corrected version is disclosed, but the original version is not;
- if the skilled addressee would have recognised the error, but not known how to rectify it, the matters relating to that error and its correction have not been disclosed; and
- if the skilled addressee would not have recognised the error, the matters relating to that error have not been disclosed.

Thus, where the product of a method has been incorrectly identified:

- a later claim to the incorrectly identified substance is novel; and
- a later claim to the substance actually produced by the method is novel, unless there is evidence that the method has actually been used (see 2.4.6.4 Mere Paper Anticipations).

2.4.5.2.5 Claims as a Disclosure

Where a citation is a patent specification, the claims of that specification may provide a relevant disclosure, particularly if a claim includes matter that is not in the description.

However, where the claim is in conflict or inconsistent with the description, the claim does not constitute a disclosure of that conflicting subject matter (see Monsanto Co’s Application (1965) AOJP 3362).

Furthermore, when considering the claims of a citation, examiners must be careful to distinguish between the scope of those claims, and the disclosure of the citation. In particular, the fact that something falls within the scope of a claim of a citation does not in itself mean that matter has been disclosed in the citation.
Thus, when considering patent specifications as citations, examiners should rely upon the claims of the citation only as an indication of the disclosures in the citation. A proper determination of the disclosure of the citation requires consideration of the specification as a whole (see Pugh v Riley Cycle Company Ltd. (1914) 31 RPC 266 at 277).

Examiners may be required to consider a photograph as an alleged anticipation, most likely as a result of a notice under sec 27.

The issue of a photograph being used as an anticipation was considered in Van der Lely NV v Bamfords Ltd [1963] RPC 61, where it was stated:

"If the photograph is to be held to prove anticipation it must be possible for that man to work from the photograph, and, without himself adding a scintilla of invention, to prepare the necessary drawings and ultimately by a process of trial and error to produce a workable machine which incorporates all the integers in the appellant's claim 1."

Examiners must carefully consider the nature of the photograph, i.e. is it the photograph itself that constitutes the alleged disclosure, or (most commonly) is it the subject that has been photographed that is the alleged anticipation? In the former case, examiners must establish the publication date of the photograph. In the latter case, the likely objection is based on prior use.

Note: Prior use can only be considered during examination of:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, prior use cannot be considered during examination (see 2.4.4.1 Prior Art Information).
2.4.6.1 Practical Utility

In general, the information in a citation must be, for the purposes of "practical utility", equivalent to that provided in the complete specification under examination. There must be sufficient directions in the prior art for a skilled addressee to identify the claimed invention and to put it into practice:

"Whatever, therefore is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication ... the prior knowledge of an invention to avoid a patent must be knowledge equal to that required to be given by a specification, namely, such knowledge as will enable the public to perceive the very discovery and to carry the invention into practical use."

See Hill v Evans (1862) 6 LT 90.

2.4.6.2 Non-Literal Disclosure

In Hill v Evans (1862) 6 LT 90, Lord Westbury elaborated on the issue of disclosure:

"the antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand and be able to apply the discovery without the necessity for further experiments."

Later courts have interpreted this to mean that something less than a literal disclosure can act as an anticipation. Thus, Lord Reid in Van der Lely NV v Bamfords Ltd [1963] RPC 61, stated:

"Lord Westbury must have meant experiments with a view to discovering something not disclosed. He cannot have meant to refer to the ordinary methods of trial and error which involve no inventive step and are generally necessary in applying any discovery to produce a practical result."

The full Federal Court ruled in WR Grace and Co v Asahi Kasei Kogyo Kabushiki Kaisha (1993) AIPC 90-974, that a "clear recommendation" could be a sufficient disclosure.

However, each of these later cases found that a disclosure will not be an anticipation if the skilled addressee has to be inventive in applying the teaching of the earlier disclosure (a non-enabling disclosure; see 2.4.6.5 Enabling Disclosures) or in arriving at the essential integers of the claim:

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"It follows from the English authorities as they have been applied in Australia that, whilst *Hill v Evans (supra)* does not require a literal disclosure and something less may suffice and whilst an alleged paper anticipation is to be treated as read by a skilled addressee, a disclosure will fall short of an anticipation by description of an effective means by which a combination claimed in the patent in suit might be produced, if what is required of the skilled addressee is the exercise of any inventive ingenuity..."

*Nicaro Holdings v Martin Engineering* [16 IPR 545] at page 563.

Examiners must give consideration to the teachings of the prior art, i.e. what would the skilled addressee have done on reading the citation?

"If carrying out the directions contained in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent were valid, would constitute an infringement of the patentee's claim, this circumstance demonstrates that the patentee's claim has in fact been anticipated."


Thus:

"To anticipate the patentee's claim, the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented ... A signpost, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee."

*General Tire & Rubber Co (supra at page 486).*

It therefore follows that a prior disclosure will only invalidate a claim if, after having read it, the skilled addressee would, rather than could, have produced all the essential features of the claim:

"Any information as to the alleged invention given by any prior publication must be for the purpose of practical utility, equal to that given by the subsequent patent. The latter invention must be described in the earlier publication that is held to anticipate it, in order to sustain the defences of anticipation. Where the question is solely one of prior publication, it is not enough to prove that an apparatus described in an earlier specification could have been used to produce this or that result. It must also be
shown that the specifications contain clear and unmistakable directions so to use it. It must be shown that the public have been so presented with the invention that it is out of the power of any subsequent person to claim the invention as his own."

*Canadian General Electric Co., Ltd v Fada Radio Ltd* (1930) 47 RPC 69 at page 90.

Furthermore:

"If ... the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentee's claim, but would be at least be as likely to be carried out in a way that would not do so, the patentee's claim will not be anticipated."

*General Tire & Rubber Co* (supra at page 486).

2.4.6.4 Mere Paper Anticipations

It is sometimes stated that an anticipation based solely on a document is a 'mere paper anticipation' and that an especially strict interpretation is required.

The concept of 'mere paper anticipation' arose from *Metropolitan-Vickers v B.T.H. Co Ltd* (1926) 43 RPC 76 at page 93, where, inter alia, it was stated:

"In *Otto v Linford*, (1881) 46 LT at page 35 it was held that the later invention must be described in the earlier publication that is held to anticipate it; it is not sufficient that, if a machine had been made according to such description, it would have produced a result, not to be gathered from the description, which would have disclosed such invention."

Thus the concept of 'mere paper anticipation' operates to exclude suggestions that if the citation had been used, something different or additional would have resulted and the something is therefore disclosed. Examiners should note that such suggestions implicitly require evidence of actual use of the citation before the priority date.

**Note:** Prior use can only be considered during examination of:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.
2.4.6.5 Enabling Disclosures

For all other standard patent applications/innovation patents, prior use cannot be considered during examination (see 2.4.4.1 Prior Art Information).

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2.4.6.5 Enabling Disclosures

Even if a skilled addressee is "clearly and unmistakably" directed to an invention from the prior art, there must still be sufficient disclosure in that art to enable the skilled addressee to put the invention into practice, i.e. the disclosure must be an 'enabling' disclosure.

"The prior art must enable the notional skilled addressee at once to perceive and understand and be able practically to apply the discovery without the necessity of making further experiments. Whatever is essential to the invention must be read out of or gleaned from the prior publication."

Nicaro Holdings Pty Ltd v Martin Engineering Co [16 IPR 545] at page 549.

Similarly, in Acme Bedstead Co Ltd v Newlands Bros Ltd (1937) 58 CLR 689, Dixon J referred to the:

"well-settled rule that a prior publication, giving information that does not become part of the common knowledge, does not invalidate a subsequent patent unless it supplies enough information to enable a person of proper skill in the art to produce the same mechanical device or appliance or carry out the process claimed in the later specification."

Nicaro Holdings Pty Ltd v Martin Engineering Co [16 IPR 545] at page 549


"to constitute an anticipation of a claim to a new chemical compound by a prior document, the disclosure in that prior document must be an enabling disclosure."

Where a citation indicates the substance in question was made, there is an increased presumption that the disclosure is enabling.

Examiners should assume in the first instance that a citation is an enabling disclosure, unless this is manifestly not so. If the applicant argues against a novelty objection on the basis that the disclosure was not enabling, the onus is on the applicant to demonstrate this is the case.

2.4.6.6 General Disclosures, Selections
The question arises as to whether a broad generic disclosure can anticipate a narrow claim (General Tire & Rubber Co v Firestone Tyre [1972] RPC 457). If that generic disclosure is broad, vague and/or speculative, then it will not deprive a claim of its novelty.

"Apparent generality or a proposition not true to its full extent will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application .... the prior knowledge of an invention to avoid a patent must be knowledge equal to that required to be given by a patent, namely such knowledge as will enable the public to perceive the very discovery, and to carry the invention into practical use."

Hill v Evans (1862) 6 LT 90.

Thus, a generic formula which describes:

"countless permutations and combinations of chemical formulae which could have been produced by a gorilla mindlessly producing chemical formulae with no knowledge of what they mean, nor whether any suggested formula was capable of manufacture"

does not constitute a disclosure of any particular chemical within the generic formula ("the gorilla test" of Beecham Group Ltd. v Bristol Myers Co. 1 NZLR 192 at page 218).

There are many situations where the disclosure of a citation is broad, particularly in the chemical field, where a large number of molecular combinations can be claimed by altering substituent groups. The court in E.I. Du Pont de Nemours (Witsiepe's) Application [1982] FSR 303, considered this issue and concluded that the earlier citation could be a disclosure for a later narrower claim:

"When a researcher is able to discover that a particular combination produces advantageous results he may well be able to assert, and will assert in the specification of his invention, that the same qualities will be produced by a number of variants or homologues described by a formula, or formulae. Moreover, having described how to produce the particular combination, he may well be able to assert, with truth, that production of any of the combinations can be made by any skilled chemist, following the indications he has given."

and:

"... the fact that the product has not been made or tested may well be irrelevant, but different considerations arise when the issue is as to the field left open for subsequent researchers."
2.4.6.6.1 Selection Criteria

Thus:

a. where a specification provides instructions on making a compound, together with an indication that it has been made (e.g. a melting temperature), there is a high presumption that the disclosure of the compound is an enabling disclosure which can deprive a later claim to that compound of novelty; and

b. the disclosure of a named chemical compound with no indication of it having been made, is nevertheless an enabling disclosure which can deprive a later claim to that compound of novelty, if it can be said that the production of that compound can be effected by any skilled chemist following the indications given; but

c. if the disclosure of a named chemical compound is not an enabling disclosure, it cannot deprive a later claim to that compound of novelty.

However, the court in *E.I. Du Pont de Nemours (Witsiepe's) Application* supra, also recognised the problem that some of the broadly claimed chemicals might have unexpected properties which a later researcher discovers and wants to patent. The court suggested that the law regarding selection patents has been developed to deal with that problem:

"It has done so in the direction of recognising two objectives, first to protect the original inventor, as regards the invention which he has made, but secondly, to encourage other researchers in the field to use their inventive powers so as to discover fresh advantages and to treat the discovery of such advantages as inherent in selected members of the group or class as a patentable invention."

**Note:** Submissions based on *Beecham Group Ltd (New Zealand/Amoxycillin) Application [1982] FSR 181*, to the effect that a novelty objection citing a compound can only be taken if it can be shown that the substance was actually made, are to be rejected. This case was in the context of selection patents and refers to the requirement from *I.G. Farbenindustrie* that none of the members of the selection were previously made (see the discussion in *Genentech Inc's (Human Growth Hormone) Patent [1989] RPC 613* at pages 629 to 633 and *E.I. Du Pont de Nemours & Co (Witsiepe's) Application* supra).
"As is illustrated by the discussion of the English authorities by Falconer J in Genentech Inc's (Human Growth Hormone) Patent [1989] RPC 613 at pages 629 to 633, selection patents may require special attention, ..."

Gummow J raised the question of whether a different level of disclosure was required to anticipate a selection patent, but did not elaborate on the issue. However, this has been considered by the English courts, as discussed below.

The question of "selection" arises when the invention claimed lies within a known field. Before an invention may be regarded as a selection, there must exist a single prior disclosure against which the claimed invention is compared. It is not necessary for the prior disclosure to encompass the entire claim under consideration. Only that portion of the claim which falls within the prior disclosure can have the selection test applied to it. Any portion of the claim which falls outside the prior disclosure is subject to the normal tests for lack of novelty and inventive step.

The matter of "selection" patents was considered in the case of I.G. Farbenindustrie A.G.'s Patents (1930) 47 RPC 289 and the following criteria for a valid "selection" patent were stated at pages 322 to 323:

a. the selection must be based on some substantial advantage gained or some substantial disadvantage avoided;

b. the whole of the selected members must possess the advantage in question; and

c. the selection must be in respect of a quality of a special character which may fairly be said to be peculiar to the selected group.

A selection can arise irrespective of the breadth of the earlier disclosure of a parent class, or the manner of describing that class. In E.I. Du Pont de Nemours & Co (Witsiepe's) Application [1982] FSR 303, it was stated:

"In the first place, in order to leave open a field for selection by a subsequent inventor, it does not matter whether the original field is described by formula or by enumeration. A skilled chemist could, in most cases, quite easily transform the one into the other and the rights of the subsequent inventor cannot depend upon the notation used. ...

Secondly, the size of the initial group or class is not in itself decisive as to a question of prior publication of an invention related to a selected member or members. A selection patent might be claimed for one or several out of a class of 10 million ... or for one out of two."
2.4.6.6.2 Selection Specification Must Describe Advantage

The specification must describe the advantage possessed by the selected members and upon which the selection is based.

"A mere selection among possible alternatives is not subject matter. A selection to be patentable must be a selection in order to secure some advantage or avoid some disadvantage. It must be an adaptation of means to ends impossible without exercise of the inventive faculty. It follows that in describing and ascertaining the nature of an invention consisting in the selection between possible alternatives, the advantages to be gained, or the disadvantages to be avoided, ought to be referred to."

_Clyde Nail Company Ltd v Russell_ (1916) 33 RPC 291 at page 306.

Similar views were expressed in the case of _I.G. Farbenindustrie A.G.'s Patents_ (1930) 47 RPC 289 at page 323:

"I must add a word on the subject of the drafting of the specification of such a patent. It should be obvious, after what I have said as to the essence of the inventive step, that it is necessary for the patentee to define in clear terms the nature of the characteristic which he alleges to be possessed by the selection for which he claims a monopoly. He has in truth disclosed no invention whatever if he merely says that the selected group possesses advantages. Apart altogether from the questions of what is called sufficiency, he must disclose an invention; he fails to do this in the case of a selection for special characteristics, if he does not adequately define them."

Although specifications which are drafted in the first instance as a selection will usually have a clear statement of the advantages of the selection, this may not be the case where the draftsman drafted the specification without knowledge of the parent class. This is particularly likely where a "whole of contents" objection is being considered. In certain circumstances, an amendment of the specification to describe the advantages may not be allowable under sec 102 (see _2.23.8.1A The Section 102(1) Provisions Explained, Meaning of "claim or disclose matter that extends beyond"_). See also _Ethyl Corporation (Cook's) Patent_ [1970] RPC 227.

Modified Date: 02 April 2013

2.4.6.6.3 Mere Choice Does Not Make a Selection

While it is immaterial whether a selection has been made consciously or not (_Carpmael's Application_ (1929) 46 RPC 321), examiners must be careful to distinguish between a
2.4.6.6.4 Level of Disclosure in a Citation to Anticipate a Selection

patentable selection and a mere choice between alternatives. Whenever a range is specified, it is likely that some values will have better results than others. Finding the optimum values does not constitute a selection. A selection has the quality of being unexpected (see *The Carlton Tyre Saving Co's Application (1973) AOJP 1404*).

2.4.6.6.4 Level of Disclosure in a Citation to Anticipate a Selection

The basic level of disclosure required to anticipate a claim to a selection is the same as for any other claim. The law of selection operates to exclude an objection of lack of novelty in those circumstances where classes of compounds or items disclosed in a citation have not been made and consequently their properties are not known.

Thus:

- if the citation does not provide an enabling disclosure, there is no anticipation; and

- if any of the selected compounds have actually been made previously, a claim to that selection lacks novelty (*I.G. Farbenindustrie AG's Patents (1930) 47 RPC 289*).

If a claim is a valid selection, it will be novel over the relevant prior art. However, the mere fact that it is a selection does not render the claim inventive. Examiners must still consider whether there is an inventive step in making the selection (see 2.5 Inventive Step).

2.4.6.6.5 Mechanical or Electrical Selection

Although most of the cases referred to in this part relate to chemical inventions, the issue of selection is not confined to this technology.

See, for example:

- *Clyde Nail Co Ld v Russell (1916) 33 RPC 291* (mechanical); and

- *Bosch's Application (1909) 26 RPC 710* (electrical).
2.4.7 All Features Disclosed in Citation

Where, having properly construed a citation, examiners determine that all the features of a claim have been disclosed, a novelty objection is to be taken. In these circumstances, examiners need not consider lack of inventive step separately against that claim, since in most cases it can be assumed that claims which are not novel also lack inventive step. However, the novelty objection should also include a statement that the claims are not inventive (see, for example, PERP codes [F1] to [F3]).

2.4.8 Not All Features of Claim Disclosed in Citation

2.4.8.1 Introduction

Where there is a relevant prior art document which discloses most, but not all, of the features of a claim, examiners must determine whether the differences are in respect of essential features of the claim.

The issue of determining essential features was discussed in *Catnic Components v Hill and Smith Ltd* *(1982) RPC 183* at page 228:

"... I think that one can venture upon the following generalisations on the question of essentiality. (1) If that feature of the claim which is under consideration is in fact essential to the working of the claimed invention, then it must be an essential feature of the claim. (2) If the feature is not in fact essential to the working of the claimed invention, the applicant for a patent may nevertheless have made it an essential feature of the claim, that is to say, he may by the terms of the claim as properly construed have clearly limited his claim to a subject matter having that particular feature. If so, that feature will be an essential feature of the claim and anyone who makes a product or carries out a process which has all the features of the claim except that particular feature will not infringe the claim. But (3), all claims are not perfectly framed. Sometimes a draftsman may include some feature in a claim, either explicitly or by implication, which is not in fact essential to the working of the claimed invention and which the applicant has not by the terms of his specification and claim clearly indicated as a feature which he regards as an essential feature of his monopoly. In such a case an alleged infringer may be held to have infringed the claim notwithstanding that his product or process does not incorporate the feature in
question or substitutes some equivalent for it. (4) The fact that a claim incorporates a particular feature does not alone suffice to make that feature an essential one. If this were not so, no feature of a claim could ever be inessential, but the speeches in *Rodi and Wienenberger* all assume that a claim may include an inessential feature."


In order to determine the essential features of a claim, examiners must construe the specification using the general rules outlined in 2.11.2.2 Rules of Construction. In particular, it is necessary to:

- construe the specification as a whole;
- construe the specification as a skilled addressee;
- read in the light of the common general knowledge;
- construe as at the priority date of the relevant claim;
- purposively construe the specification; and
- determine the true ambit of the claim, including proper consideration of words of purpose.

Examiners should initially assume that all features of the independent claims are essential.

"An applicant for a patent will want his leading claim to be as wide as is possible consistently with its validity. He will wish to avoid any unnecessary restriction of it. So he will want to avoid claiming any feature which would unnecessarily restrict the scope of the claim. A well drawn leading claim will accordingly specify only those features which are essential to the invention claimed. It follows, in my opinion, that the applicant probably regards all the features of his leading claim as essential features of the invention."


However, examiners should also note 2.4.8.3 Mere Presence in Claim Does Not Ensure Essential.
2.4.8.3 Mere Presence in Claim Does Not Ensure Essential

Although examiners should initially assume that all features of the independent claims are essential (see 2.4.8.2 Features of a Claim *prima facie* Essential), the mere presence of a feature in an independent claim is not conclusive proof that it is essential.

In *Catnic Components v Hill & Smith Ltd* (1982) RPC 183 at page 228 it was stated:

"the fact that a claim incorporates a particular feature does not alone suffice to make that feature an essential one. If this were not so, no feature of a claim could ever be inessential, but the speeches in *Rodi and Wienenberger* all assume that a claim may include an inessential feature."

* *Rodi and Wienenberger v Henry Showell Ltd* (1969) RPC 367.

2.4.8.4 Materially Affects the Way the Invention Works

If it is evident from a reading of the specification, either explicitly or implicitly, that a particular feature materially affects the way the invention works, the feature is essential.

In *Catnic Components v Hill & Smith Ltd* (1982) RPC 183 at 243 it was stated:

"The question in each case is: whether persons with practical knowledge … would understand … a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention …

The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked."

Thus, a feature can only be considered non-essential if it does not materially affect the way the invention works.

Conversely, examiners should note that unless it is readily apparent that a feature would not materially affect the way the invention works, then the feature must be considered to be essential. In *Ryan v Lum* (1989) 14 IPR 513, which concerned a method of cleaning silver involving a sheet of aluminium with a regular pattern of holes, the court observed:
"Neither in the specification nor anywhere else is it claimed that it is the holes themselves which are important in the process. Indeed, the fact that the specification is so general about the number and types of holes that are needed negates to my mind the view that the holes are of great significance to this invention."

See also *Rodi and Wienenberger AG v Henry Showell Ltd (1969) RPC 367.*

If there is no working interrelationship, nor potential working interrelationship, between the feature and the other features of the claim, it will usually be the case that the feature does not materially affect the way the invention works, i.e. it cannot be an essential feature of the invention, unless it is clear from the specification that the feature is intended to be essential (see 2.4.8.1 Introduction).

**2.4.8.5 Collocations, Kits**

Where a claim defines a number of integers with no working interrelationship, the claim is said to be for a collocation of integers. Typically, the apparent novelty of such a claim resides in one of those integers and examiners should base their search strategy on that integer.

**Note:** A claim to a collocation of integers is novel if any integer of that collocation is itself novel.

Where a claim is directed to a collocation of known integers, such as a kit of parts, the claim is not in respect of a manner of manufacture (see 2.9.2.16.1 Collocations).

**2.4.8.6 Objects of the Invention, Statements of Prior Art**

If the specification under consideration contains statements of prior art and/or the problem to be overcome, these may be of assistance when ascertaining the essential features.

In *Sebel Properties v Fagaleo Pty Ltd (1989) 14 IPR 524*, claim 1 defined a writing tablet for a chair or other furniture which comprised a support bracket, a pivot on the support bracket making an angle of about 45° with the vertical, and a writing tablet pivoted on the pivot and
making an angle of about 45° with the pivot. In use, the support bracket could be secured to a chair, or to the floor adjacent the chair, allowing the tablet to be rotated about the pivot from a horizontal (writing) position. The prior art disclosed a rotating writing tablet which operated in the same way, but which in use was secured directly to the chair without using a support bracket.

The court decided that the support bracket was an "immaterial variant" of the prior art device and was therefore inessential. However, the significance of this feature could also be deduced from the stated object of the invention, which was to simply provide a tablet which could be rotated in a single movement from a horizontal or writing position. No emphasis was placed on the means by which the writing tablet was secured to the chair or other furniture. On the basis of this statement it could be logically argued that the inclined pivot arrangement, and not the support bracket, was essential to the invention.

2.4.8.7 Words and Phrases

It is appropriate to use the consistory statement and words such as "must include", "necessarily", "preferably" and "for example", as indicators that a feature may be essential or inessential. However, examiners must not rely on random phrases and must have regard to the specification as a whole.

See, for example:

- Populin v HB Nominees Pty Ltd (1982) 41 ALR 471 and;
- Rhone-Poulenc Agrochimie SA v UIM Chemical Services (1985) AIPC 90–251.

The specification must be read and interpreted as it would be read and interpreted by the notional addressee. Consequently, examiners should consider not only whether a feature need be present at all in the broadest claim (i.e. is essential to the invention), but also whether the feature needs to be precisely as the claim specifies.

As stated in Catnic Components Ltd v Hill and Smith (1982) RPC 183 at page 243:

"A patent specification should be given a purposive construction rather than a purely literal one .... The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked."
2.4.8.8 Conflicting Statements

If, as a result of conflicting statements in a specification, examiners are unable to determine whether a particular feature is essential or inessential, it should be assumed in the first instance that the feature is inessential.

If, as a consequence, a claim is not novel:

- a novelty objection is to be taken on the basis of this interpretation; and
- the conflict in the specification over whether the feature is essential should be clearly stated in the objection.

An objection of lack of novelty in these circumstances may be overcome by amending the description rather than the claims, provided the requirements of sec 102 are satisfied.

2.4.8.9 Consideration of Independent and Dependent Claims

Where an independent claim lacks novelty, examiners will also have to consider the novelty of the dependent claims, as in all likelihood the applicant will promote a feature in a dependent claim into the independent claim, in order to overcome the novelty objection.

Where a dependent claim adds a trivial feature that does not materially affect the working of the invention, it is unlikely that the feature will constitute an essential feature of the claim. In such situations, an objection of lack of novelty taken against an independent claim should also be taken against the relevant dependent claims.

Where a dependent claim adds a feature which materially affects the working of the invention, it is likely that the feature is an essential feature of that claim, i.e. if that feature is not in the citation, the claim will be novel and the novelty objection should not be raised against that claim, or claims dependent thereon. Moreover, it should be noted that features may be present in the dependent claim which, while conferring novelty on the claim may not establish its inventiveness. When formulating objections in such circumstances, examiners should bear in mind the principles at 2.1.6.2 Novelty and Inventive Step.
Where the statement of claims involves a complex set of dependencies, it may be that:

- the novelty of a particular claim depends upon to which claim it is appended; and
- there may be more than one claim potentially containing a novelty-conferring feature to which that claim is appended.

In this situation, examiners should make a judicious assessment of which features of the claim are essential and assess novelty on that basis.

In General Tire & Rubber Co v The Firestone Tyre & Rubber Co Ltd (1972) RPC 457 at page 485 it was stated:

"To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim ... The construction of these documents is a function of the court, being a matter of law, but, since documents of this nature are almost certain to contain technical material, the court must, by evidence, be put into the position of a person of a kind to whom the document is addressed ...."

In the course of dealing with an objection to the grant of a patent on the grounds of lack of novelty, the courts have had regard to the doctrine of mechanical equivalents, i.e. whether, on the evidence before the court, the difference between the claimed invention and the alleged anticipation represents no more than the substitution of an inessential feature with an obvious equivalent.


It should be noted that the courts appear to have taken the view that if a feature of the claim has a mechanical (i.e. functional) equivalent in the alleged anticipation, then *ipso facto* the feature must be inessential. Furthermore, the existence of mechanical equivalents has been determined from evidentiary material (which in general is not available to examiners), and not as a matter of construction.

However, during examination, the issue to determine is whether a prior art document contains a clear description of, or clear instructions to make, something that possesses all the **essential** features of a claim. For this reason, examiners should not concern themselves
whether an inessential feature of a claim replaces a feature of the prior art with a mechanical equivalent.

Modified Date: 02 April 2013

2.4.10 All Essential Features Disclosed in Citation

Where, having properly construed a citation, examiners determine that all the essential features of a claim have been disclosed, a novelty objection is to be taken.

Where there is doubt as to whether a feature is essential that arises through inconsistencies in the specification, examiners should assume that feature is inessential until the inconsistency in the specification is removed (see 2.4.8.8 Conflicting Statements).

Where a novelty objection is taken in these circumstances, examiners need not consider lack of inventive step separately against that claim, since in most cases it can be assumed that claims which are not novel also lack inventive step. However, the novelty objection should also include a statement that the claims are not inventive (see, for example, PERP codes [F1] to [F3]).

2.4.11 "Whole of Contents"

Modified Date: 02 April 2013

2.4.11.1 Introduction

The normal requirement for a novelty objection to apply is for a citation to be open to public inspection (OPI) before the relevant priority date. However, where the citation is an Australian patent application, including a PCT application which has designated Australia, a novelty objection can in certain circumstances be raised, even though the citation was not OPI before the relevant priority date. This situation is colloquially referred to as "Whole of Contents".

Modified Date: 02 May 2016

2.4.11.2 Basis of the "Whole of Contents" Objection

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Effective Date: 25 September 2019
2.4.11.2 Basis of the "Whole of Contents" Objection

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.4.11.2A Basis of the "Whole of Contents" Objection.

In this topic:

The basis of the "whole of contents" objection exists in the definition of the "prior art base" in schedule 1. Thus, for the purpose of assessing novelty, the prior art base includes:

"information contained in a published specification filed in respect of a complete application where:

a. if the information is, or were to be, the subject of a claim of the specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and

b. the specification was published after the priority date of the claim under consideration; and

c. the information was contained in the specification on its filing date and when it was published."

‘P’ and ‘E’ category patent documents can therefore be considered for “whole of contents” novelty purposes (see PCT/GL/ISPE/2 paragraphs 16.65 and 16.67 for information on citation categories).

 Examination Practice

Provided a document satisfies the three criteria above, it can be considered for the purpose of lack of novelty. The considerations for such a novelty objection are otherwise exactly the same as for documents published before the priority date of the claim under examination. Where a "whole of contents" objection is taken, it should explain why the cited document is relevant for novelty purposes (see, for example, PERP code [F25]).
Where the issue of "whole of contents" novelty arises in relation to a "selection" case, examiners should refer to **2.4.6.6 General Disclosures, Selections**.

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**Relevant Case Law**

The Federal Court considered "whole of contents" novelty in *El du Pont de Nemours Co v ICI Chemicals & Polymers Ltd* [2005] FCA 892, *66 IPR 462* and *Danisco A/S v Novozymes A/S (No 2)* [2011] FCA 282; *91 IPR 209*. In both cases the court asked two questions:

i. was there any information in the citation that anticipated the application; and

ii. whether that information was the subject of a claim, or could be the subject of a valid notional claim.

It is not necessary to formulate a notional claim in order to raise a "whole of contents" novelty objection. Any information that is sufficiently disclosed to support a lack of novelty is sufficiently disclosed to serve as the basis of a valid claim.

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**2.4.11.2A Basis of the "Whole of Contents" Objection**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see **2.4.11.2 Basis of the "Whole of Contents" Objection**.

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Effective Date: 25 September 2019
The basis of the "whole of contents" objection exists in the definition of the "prior art base" in schedule 1. Thus, for the purpose of assessing novelty, the prior art base includes:

"information contained in a published specification filed in respect of a complete application where:

a. if the information is, or were to be, the subject of a claim of the specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and
b. the specification was published on or after the priority date of the claim under consideration; and
c. the information was contained in the specification on its filing date."

‘P’ and ‘E’ category patent documents can therefore be considered for “whole of contents” novelty purposes (see PCT/GL/ISPE/2 paragraphs 16.65 and 16.67 for information on citation categories).

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**Examination Practice**

Provided a document satisfies the three criteria above, it can be considered for the purpose of lack of novelty. The considerations for such a novelty objection are otherwise exactly the same as for documents published before the priority date of the claim under examination. Where a “whole of contents” objection is taken, it should explain why the cited document is relevant for novelty purposes (see, for example, PERP code [F25A]).

Where the issue of "whole of contents" novelty arises in relation to a "selection" case, examiners should refer to 2.4.6.6 General Disclosures, Selections.

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**Relevant Case Law**

The Federal Court considered "whole of contents" novelty in *El du Pont de Nemours Co v ICI Chemicals & Polymers Ltd* [2005] FCA 892, 66 IPR 462 and *Danisco A/S v Novozymes A/S*(No 2) [2011] FCA 282; 91 IPR 209. In both cases the court asked two questions:

i. was there any information in the citation that anticipated the application; and
ii. whether that information was the subject of a claim, or could be the subject of a valid notional claim.

It is not necessary to formulate a notional claim in order to raise a "whole of contents" novelty objection. Any information that is sufficiently disclosed to support a lack of novelty is sufficiently disclosed to serve as the basis of a valid claim.

 Modified Date: 02 April 2013

2.4.11.3 Priority Date Considerations

To raise a “whole of contents” objection, examiners must be satisfied that if the relevant information in a citation is, or was to be, the subject of a claim of the citation, that claim has, or would have, a priority date earlier than that of the claim under consideration.

Where the citation does not claim priority from another application, examiners will only need to be satisfied that the filing date of the citation is earlier than the relevant priority date.

Where the citation claims priority, and the filing date of the citation is later than the relevant priority date, examiners will in principle have to establish that all the essential features of the claim under consideration are disclosed in the citation (see 2.4.11.2. Basis of the "Whole of Contents" Objection) and disclosed in the relevant priority document. However, where the determination of priority dates is difficult or time consuming, it is not unreasonable to assume that the citation is entitled to its earliest priority date, with the onus of rebuttal being placed upon the applicant or attorney.

 Modified Date: 02 March 2015

2.4.11.4 Publication Considerations

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.4.11.4A Publication Considerations.
For an objection based on "whole of contents" to apply, examiners must be satisfied that:

- the citation is a published (i.e. OPI) Australian complete specification, including a PCT application which has designated Australia, at the time it is being considered (see 2.4.11.7 Citation Not OPI and 2.4.11.6 Citation an International Application under the PCT);

- publication must have occurred after the priority date of the claim under consideration;

- the relevant information referred to must have been contained in the specification on its date of publication; and

- the relevant information referred to must have been contained in the specification when it was filed.

All of these conditions must be satisfied before an objection based on "whole of contents" can be taken.

If the above conditions are satisfied, the ongoing status of the citation is not relevant, i.e. the objection applies even if the citation has lapsed, or the relevant material in the citation has been amended.

There is also no requirement in the Act that the cited application be in force at the date of publication. Thus, if an application is published, despite being lapsed, refused or withdrawn before the publication date, it may still constitute prior art for the purpose of "whole of contents". In this regard, the UK decision in Woolard's Application [2002] RPC 39 and the official practice expressed in Guidelines for Examination in the EPO, Part C, Chapter IV are not considered determinative of the position in Australia.
For an objection based on "whole of contents" to apply, examiners must be satisfied that:

- the citation is a published (i.e. OPI) Australian complete specification, including a PCT application which has designated Australia, at the time it is being considered (see 2.4.11.7 Citation Not OPI and 2.4.11.6 Citation an International Application under the PCT);

- publication must have occurred on or after the priority date of the claim under consideration; and

- the relevant information referred to must have been contained in the specification when it was filed.

All of these conditions must be satisfied before an objection based on "whole of contents" can be taken.

If the above conditions are satisfied, the ongoing status of the citation is not relevant, i.e. the objection applies even if the citation has lapsed, or the relevant material in the citation has been amended.

There is also no requirement in the Act that the cited application be in force at the date of publication. Thus, if an application is published, despite being lapsed, refused or withdrawn before the publication date, it may still constitute prior art for the purpose of "whole of contents". In this regard, the UK decision in Woolard's Application [2002] RPC 39 and the official practice expressed in Guidelines for Examination in the EPO, Part C, Chapter IV are not considered determinative of the position in Australia.

Modified Date: 02 April 2013

2.4.11.5 Citation Must be a Single Document

Section 7 makes explicit provision for 2 or more related documents to be treated as a single disclosure. However, there is no such provision for documents being cited for a "whole of contents" objection. Thus, when considering a citation for "whole of contents" purposes, it must stand on its own, without reliance on any documents referred to therein.

Modified Date: 01 March 2013

2.4.11.6 Citation an International Application under the PCT

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Effective Date: 25 September 2019
An International Application under the PCT which has designated Australia is treated as an application under the Act filed on its International Filing Date. (Designation of all countries is automatic upon the filing of a PCT application. Although a designation may subsequently be withdrawn, this happens very rarely, if it all, in the case of Australia). Thus, a "whole of contents" objection can be based on such an application if the criteria of 2.4.11.2 Basis of the "Whole of Contents" Objection and 2.4.11.3 Priority Date Considerations have been met, even if the citation has not entered the national phase. In this situation, the citation should be referred to by its WO publication number.

If a potential citation is not published at the time of examination, but it is likely that publication will take place (e.g. the citation is not lapsed or withdrawn), then the report should include a note indicating a potential "whole of contents" objection.

If the nominated person of the application being examined is the same as that of the citation, the note should also identify the potential citation and indicate that it is not yet OPI.

If the nominated persons are different, examiners should not identify the potential citation. The note should simply indicate that an application exists which, when published, would provide the basis for a "whole of contents" novelty objection and when this citation is due to become OPI.

The time for acceptance of an application subjected to a "whole of contents" objection may be extended, where necessary, until 3 months after the date of publication, lapsing, refusal or withdrawal of the "whole of contents" citation (whichever is the earliest). In these circumstances, examiners should follow the procedures outlined in 2.15.7.1 Objections Based on "Whole of Contents" for extending the time for acceptance.

However, acceptance should not be delayed if the publication date or the fact of publication is uncertain.
Sections 152 and 173 include provisions prohibiting the publication of certain applications ("secret cases"). An application of this type cannot be used as the basis of a "whole of contents" objection because it is not published. However, if the prohibition order is revoked a novelty objection may then apply.

In the unlikely event that examiners become aware of a "whole of contents" objection based on a "secret case", they:

- must not notify the applicant of a potential "whole of contents" objection since it is uncertain whether the application will be published;
- must not identify the citation to the applicant, as this would be an effective disclosure of the contents of the citation and contrary to the prohibition order; and
- should refer the case to the Security Officer for consideration of security issues for both the application and the citation; see 2.13.13 Examining Cases Subject to a Prohibition Order.

The definition of the prior art base restricts the information on which a "whole of contents" objection can be based to that contained in a published specification filed in respect of a complete application. Thus, a provisional specification cannot be used as a citation for a "whole of contents" objection.

The disclosure needed to support a whole of contents novelty objection is the same as that for any novelty objection. Consequently, generic disclosures can only be relied upon if there is sufficient indication of the relevant members of the class (see 2.4.6.6 General Disclosures, Selections and 2.4.12.1.4 Generic Disclosures as Citations). Where the requisite level of disclosure is present, the citation will satisfy the notional claims requirement of E I Du Pont de Nemours & Co v ICI Chemicals & Polymers Ltd [2005] FCA 892; 66 IPR 462.
2.4.12 Novelty - Some Specific Examples

2.4.12.1 Chemical Compounds

2.4.12.1.1 Construction - Implicit Degree of Purity

Where a claim is directed to a compound without an explicit degree of purity, the degree of purity is implied by considering the context of the specification. If the whole context of the specification, and the nature of the problem with the prior art, is directed to the degree of purity, then that is implicitly a feature of the claim. If there is no such context in the specification, then the degree of purity is not a feature of the claim.

See *Biochem Pharma v Emory University* [1999] APO 50.

2.4.12.1.2 Essential Features of Compound Inventions

When a claim is directed to a compound having a specific structural formula, the structure is an essential feature. Whilst it is possible that there are inessential parts of the structure, this would not normally be the case. During examination, it should be presumed that all features of a structure are essential, unless there are sound arguments to the contrary.


In order to establish that a particular group in a structure is not essential to the activity of a compound, it will usually be necessary to demonstrate that the activity is present when that group is absent (i.e. replaced by hydrogen) and when the group is replaced by different groups, for example groups that are neither isosteric nor isoelectronic.

2.4.12.1.3 Enabling Disclosure

The definition of an enabling disclosure, in relation to chemical compounds, is:

"that is to say, one sufficient in the case of a claim to a chemical compound to enable those skilled in the art to make the compound"

_Pall Corp v Commercial Hydraulics (Bedford) Ltd_ [1990] FSR 329 at 347.

Older cases, such as _Gyogyszeripari Kutato Intezet's Application_ [1958] RPC 51 and _Smith Kline & French Laboratories' Application_ [1968] RPC 415, which stated that disclosure of the existence of a compound without an enabling disclosure was sufficient to establish lack of novelty, are no longer appropriate. Enabling disclosure is clearly a part of traditional English patent law (and Australian patent law) in the light of _Asahi Kasei Kogyo KK's Application_ [1991] RPC 485.

2.4.12.1.4 Generic Disclosures as Citations

In this topic:

In order to be used as a novelty citation, a generic disclosure must disclose the compounds in question and provide sufficient information for the compounds to be made. It is not essential that the compounds have actually been prepared.

**What Compounds are Clearly and Unmistakably Disclosed By a Generic Disclosure?**

A generic structural formula represents all the specific structural formulae encompassed by the generic formula. This can be described as the intellectual content of the generic formula. The question of what compounds are clearly and unmistakably disclosed goes beyond the intellectual content, and is equivalent to asking what technical information would the citation make public to the instructed reader (though not necessarily revealed in every detail).


A compound that is named in the worked examples part of a specification as a further example of the invention is disclosed in a technical sense.
2.4.12.1.5 Optical Isomers


A generic formula should always be considered in conjunction with the compounds specifically described in the citation in order to determine which combination of substituents and which substitution patterns are actually disclosed in the citation.


The preferred compounds do not disclose all the structural formulae that could be produced using different combinations of the variables as exemplified.

PPG Industries Inc v Stauffer Chemical Co (1985) 5 IPR 496, especially pages 509-511.

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Does the Disclosure Enable the Production of the Compounds Whose Structures Have Been Disclosed?

An enabling disclosure is provided if a generic preparative method is given in the citation or is self-evident, and this method would have been considered to be technically credible by a person skilled in the art at the date of publication of the citation.


Where there is prima facie an enabling disclosure, then the objection should be taken and the onus placed on the applicant to show that the disclosure is not enabling.

This practice (which is used in the UK Patent Office) has received judicial approval in Toyama Chemical Co Ltd’s Application [1990] RPC 555 at 564.

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Effective Date: 25 September 2019
2.4.12.1.6 Constitutional and Geometric Isomers

- If the other isomer, and the racemate, have not been previously disclosed, then the isomer is novel.

- If the racemate is previously known, it can be argued that the single isomer has been generically disclosed, since a person skilled in the art would appreciate that a compound having a chiral centre exists in two optically active forms. However, without anything further, it is doubtful whether the single isomer has been disclosed in a technical sense, or whether there is an enabling disclosure (see Imperial Chemical Industries Ltd (Howe's) Application [1977] RPC 121).

Examiners may also have to consider whether there is a valid selection.

- If the other isomer is previously known, but the racemate is not known, the problem appears somewhat different. This situation can arise in cases of naturally occurring compounds, such as steroids. It is unlikely there has been even a generic disclosure of the other isomer and consequently novelty is not an issue.

2.4.12.1.7 Tautomers

Tautomers are isomers that are in equilibrium (e.g. keto-enol tautomerism). Where a single tautomeric form is claimed (explicitly or implicitly free of the other tautomer), disclosure of a different tautomer would not provide an enabling disclosure of the claimed tautomer. In the context of processes utilising a tautomer, an objection of lack of novelty must establish that the compound is in fact in equilibrium with the known compound, and that it was common general knowledge in the particular art that the forms would be in equilibrium.
2.4.12.1.8 Derivatives

The novelty of a derivative depends on whether the derivatised portion of the structure is an essential feature. The Hetacillin case (Beecham Group Ltd v Bristol Laboratories Ltd [1978] RPC 153) provides an example of a derivative of a known compound in which the derivatised portion of the compound was effectively found to be a non-essential feature.

2.4.12.1.9 Purposive Construction of Compound Claims

It would be uncommon for examiners to have sufficient evidence to take a purposive construction of compound claims.

An example of the use of purposive construction related to the compound rapamycin. The term "rapamycin" was construed as including derivatives. The judge asked three questions:

- does the variant have a material effect on the way that the invention works;
- would it have been obvious that the variant would not have a material effect on the way the invention works; and
- would a reader have understood from the claim that strict compliance with the primary meaning was an essential requirement of the invention.

2.4.12.1.10 Reach-Through Claims

Where "reach-through" claims recite compounds that interact with, or modulate the activity of, a specific peptide or nucleic acid, it is important to understand the types of compounds that may fall within the scope of the claims. Often the compounds include known compounds, for example known drugs or peptides, where the drug or peptide is a member of a standard chemical library whose members have been tested for their ability to interact with the peptide or nucleic acid. In this situation, the claims will necessarily lack novelty.

Often the candidate compounds will be claimed as compounds identified, or selected, by screening. Although, as a matter of literal construction, such claims are directed to the compounds after, not prior to, screening, the compounds are the same regardless of whether or not they were identified in a screening process. Thus, examiners should construe such claims as directed to compounds per se (see also 2.11.7.7 Reach Through Claims).

2.4.12.2 Range of Variables

2.4.12.2.1 Examples Needed for Clear and Unmistakable Directions

A prior art document disclosing a particular range of variables will not anticipate a claim to a narrower range of variables, or a single variable either falling within the previously disclosed range of variables or overlapping the previous range, unless that document also discloses an example of a variable falling within the claimed range. This applies whether or not the claimed invention is allegedly a selection. This is because there are no clear and unmistakable directions for a skilled addressee to select the particular claimed range of variables from the broader range disclosed earlier (see also 2.4.6.3 Clear and Unmistakable Directions).

2.5 Inventive Step

2.5.1 Overview

2.5.1.1 Introduction
During examination of an application for a standard patent, examiners must consider whether a claim contains an "inventive step" in relation to the prior art base.

An objection of lack of inventive step occurs where the essential features of a claim have not been previously disclosed, but the claimed features would naturally suggest themselves (be obvious) to the person skilled in the relevant art.

Examiners must consider the issue of inventive step in the context of the person skilled in the relevant art, in the light of the common general knowledge, trying to solve a predetermined problem. Thus wherever the phrase "in the context of the problem" is used in this part, it should be related to the person skilled in the art.

For an inventive step objection to apply, it must be established that the prior art information (if any) would be relied upon by a person seeking a solution to the problem, and that any consideration of the common general knowledge with that prior art information would be obvious to that person.

The objection also arises where there is no difference between the claimed invention and the prior art information, however in such circumstances a novelty objection will always apply.

Section 7 provides that:

"(2) .... an invention is taken to involve an inventive step when compared with the prior art base unless the invention would have been obvious to a person skilled in the relevant art in the light of the common general knowledge as it existed in the patent area before the priority date of the relevant claim, whether that knowledge is considered separately or together with the information mentioned in subsection (3).

(3) The information for the purposes of subsection (2) is:

(a) any single piece of prior art information; or

(b) a combination of any 2 or more pieces of prior art information;

being information that the skilled person mentioned in subsection (2) could, before the priority date of the relevant claim, be reasonably expected to have ascertained,
2.5.1.2A The Statutory Basis for Inventive Step

Section 7 provides that:

"(2) .... an invention is taken to involve an inventive step when compared with the prior art base unless the invention would have been obvious to a person skilled in the relevant art in the light of the common general knowledge as it existed (whether in or out of the patent area) before the priority date of the relevant claim, whether that knowledge is considered separately or together with the information mentioned in subsection (3).

(3) The information for the purposes of subsection (2) is:

(a) any single piece of prior art information; or

(b) a combination of any 2 or more pieces of prior art information that the skilled person mentioned in subsection (2) could, before the priority date of the relevant claim, be reasonably expected to have combined."

2.5.1.3 Precedent, and the Meaning of Obvious

Under the 1990 Act the question to be asked in determining whether or not the claimed invention involves an inventive step is whether the invention would have been obvious to a person skilled in the relevant art. The concept of "obviousness" was introduced by the 1952 Act, but is no longer referred to as a ground of objection. However, examiners can for practical purposes equate obviousness with lack of inventive step - see Winner & Anor v Ammar Holdings Pty Ltd 24 IPR 137 at page 140 where no distinction was drawn between

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the concepts of lack of inventive step under the 1990 Act and obviousness under the 1952 Act.

The High Court in Firebelt Pty Ltd v Brambles Ltd [2002] HCA 21; 54 IPR 449 discussed the changes in the legislation between the 1952 and 1990 Patents Acts pertaining to obviousness. The Court noted that the effect of the changes was to relax the rule in Minnesota Mining & Manufacturing Company v Beiersdorf (Australia) Ltd (1980) 144 CLR 253 forbidding the use of prior disclosures not actually proven to be part of the common general knowledge. However, while the prior art base for obviousness expanded in the 1990 Act, the actual test for determining obviousness has not changed.

As a result, precedent for inventive step under the 1990 Act is provided by relevant case law in respect of obviousness. When the term "obvious" is referred to in such precedent, the term "lacks an inventive step" may be substituted.

As to the meaning of the term "obvious":

"The word 'obvious', as Sir Lionel agreed, and as its derivation implies, means something which lies in the way, and in the context of the Act is used in its normal sense of something which is plain or open to the eye or mind, something which is perfectly evident to the person thinking on the subject."

Olin Mathieson v Biorex (1970) RPC 157 at page 188

"'Obvious' is, after all a much-used word and it does not seem to us that there is any need to go beyond the primary dictionary meaning of 'very plain'".

Australian patent documents which can only be used for an objection of lack of novelty on a "whole of contents" basis.

While the prior art base for both novelty and inventive step includes information made publicly available through doing an act (whether in or out of the patent area), examiners are precluded from using such information in their assessment of novelty and inventive step (sec 45(1A) and sec 48(1A)).

**Note:** The information in this part only applies to standard patent applications with an examination request filed on or after 15 April 2013. For all other standard patent applications, see 2.5.1.4.1 Prior Art Base.

The prior art base for inventive step is a subset of the prior art base for novelty (see 2.4.4.1A Prior Art Information). It includes all prior art forming the prior art base for novelty, except for Australian patent documents which can only be used for an objection of lack of novelty on a "whole of contents" basis.

**Note:** The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For all other standard patent applications, see 2.5.1.4.2A Operation of Section 7.

Specific differences between novelty and inventive step arising from the operation of sec 7 are:

- for inventive step a single piece of prior art information, or a combination of any 2 or more pieces of prior art information, can be considered together with the common general knowledge in Australia at the priority date of the claim in question (in contrast to novelty, where a single piece of prior art information is read in the light of common general knowledge (with no geographical limitation) at the date of publication of the prior art information) - see 2.5.2.1.1 Introduction.
• any piece of prior art information relied upon for an inventive step objection must be one which the person skilled in the relevant art would be reasonably expected to have ascertained, understood and regarded as relevant.

• for applications filed on or after 1 April 2002, for inventive step it is permissible to consider any 2 or more pieces of prior art information that the person skilled in the relevant art could be reasonably expected to have combined (in contrast to novelty, where pieces of prior art information can only be combined if the person skilled in the relevant art would treat them as a single source of information) - see 2.4.4.4 Mosaics and Related Documents and 2.5.2.5 Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Documents to Solve the Problem?

• common general knowledge alone can be considered for the purposes of inventive step.

Specific differences between novelty and inventive step arising from the operation of sec 7 are:

• for inventive step a single piece of prior art information, or a combination of any 2 or more pieces of prior art information, can be considered together with the common general knowledge at the priority date of the claim in question (in contrast to novelty, where a single piece of prior art information is read in the light of common general knowledge at the date of publication of the prior art information that is used) - see 2.5.2.1.1A Introduction.

• for applications filed on or after 1 April 2002, for inventive step it is permissible to consider any 2 or more pieces of prior art information that the person skilled in the relevant art could be reasonably expected to have combined (in contrast to novelty, where pieces of prior art information can only be combined if the person skilled in the relevant art would treat them as a single source of information) - see 2.4.4.4 Mosaics and Related Documents and 2.5.2.5A Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Prior Art Information to Solve the Problem?
2.5.1.5 Tests for Inventive Step

Unlike novelty, there are many tests applied by the courts to assess inventive step.

In Winner & Anor v Ammar Holdings Pty Ltd 25 IPR 273 at page 294, Cooper J stated:

"In order to ascertain whether or not the subject matter sought to be patented was beyond the skill of the calling, the courts have adopted a number of different approaches directed to the same end: for example, was the invention obvious or not?: does the invention solve an important problem "unsuccessfully attacked by previous inventions"? (Wood v. Gowshall (1937) 54 RPC 37 at 39)."

The following tests typify the basic approaches which the courts have used to establish obviousness:

"The test is whether the hypothetical addressee faced with the same problem would have taken as a matter of routine whatever steps might have led from the prior art to the invention, whether they be the steps of the inventor or not."


"was so obvious that it would at once occur to anyone acquainted with the subject, and desirous of accomplishing the end."

Allsop Inc & Another v Bintang Ltd & Ors 15 IPR 686 at page 701.

"Would the notional research group at the relevant date in all the circumstances ... directly be led as a matter of course to try [the invention claimed] in the expectation that it might well produce [a useful desired result]."


"In the case of a combination patent the invention will lie in the selection of integers, a process which will necessarily involve rejection of other possible integers. The prior existence of publications revealing those integers, as separate items, and other possible integers does not of itself make an alleged invention obvious. It is the
2.5.1.6 Assessing Inventive Step in Examination

The procedure of courts relies upon the evidence of expert witnesses when seeking an answer to the question "is it obvious?" Unlike courts, examiners do not have access to evidence from the person skilled in the art. Instead, they are required to put themselves "in the shoes of the skilled worker" and make their own assessment of what the notional skilled worker was likely to have done at the priority date. In doing so, they must assess "obviousness" based on their own knowledge and balance of probability considerations - see 2.13.5 Stringency of Tests During Examination.

Such assessment can be difficult. As examiners will inevitably know the claimed solution, they must set that knowledge aside in their assessment of inventive step. The initial consideration of whether a claim is obvious can be coloured by:

- *ex post facto* analysis;
- judging the merit of the invention;
- the motivation for the invention;

*Minnesota Mining & Manufacturing Co v Beiersdorf (Australia) Ltd* (1980) 144 CLR 253 at page 293.

"so easy that any fool could do it"

*Edison Bell v Smith* (1894) 11 RPC 389 at page 398.

Note: The information in this part only applies to standard patent applications with an examination request filed **before** 15 April 2013. For all other standard patent applications, see 2.5.1.6A Assessing Inventive Step in Examination.
• failing to recognise that an inventive step requires no more than a scintilla of invention;
• failing to determine the common general knowledge appropriate to the person skilled in the art; and
• failing to consider all relevant issues.

Courts have also discussed the problem of *ex post facto* dissection of the invention. In *Meyers Taylor Pty Ltd v Vicarr Industries Ltd* (1977) 137 CLR 228 at page 242, Aickin J stated:

"subsequent analysis of the invention - 'the dissection of the invention' - is not helpful in resolving the question of obviousness."

### Problem-Solution Approach

An approach used by the courts to avoid *ex post facto* analysis is the "problem-solution" approach. In *HPM Industries Pty Ltd v Gerard Industries Ltd* 98 CLR 424 at page 437, Williams J stated:

"If the invention were novel it would nevertheless fail for want of subject matter if in the light of what was common general knowledge in the particular art, it lacked inventive ingenuity because the solution would have been obvious to any person of ordinary skill in the art who set out to solve the problem."

The "problem-solution" approach is based on the question of whether the claimed invention would have been obvious to a person skilled in the relevant art when faced with a particular problem. The approach is the preferred one to apply when considering inventive step, as it reduces the risk of *ex post facto* analysis. The problem-solution approach also ensures that the examiner's consideration of whether a claim lacks an inventive step:

• is valid and sustainable; and
• identifies all the issues relevant to establishing lack of inventive step.

### Applying the Problem-Solution Approach
2.5.1.6 Assessing Inventive Step in Examination

The problem-solution approach involves the following steps:

a. construe the specification under examination and determine the problem the claimed invention solves (see 2.5.2.3 Determining the Problem).

b. identify the person skilled in the art in the field of the problem (see 2.5.2.4 Identifying the Person Skilled in the Art (PSA)).

c. determine whether, in the context of the problem, any pieces of prior art information under consideration are such that the person skilled in the art could be reasonably expected to have ascertained, understood, regarded as relevant and, where applicable, combined them (see 2.5.2.5 Could the Person Skilled in the Art be Reasonably Expected to have Ascertained, Understood, Regarded as Relevant and, Where Applicable, Combined the Prior Art Information?)

d. determine the relevant common general knowledge (see 2.5.2.1 Common General Knowledge).

e. determine whether, in the context of the problem, the claimed invention is one of:

   • a technical equivalent;
   • a workshop improvement;
   • an obvious selection or special inducement; or
   • an obvious combination of features of common general knowledge.

f. consider whether:

   • the prior art information teaches away from the solution;
   • the invention overcomes practical difficulties in seeking the solution;
   • the invention resides in identifying the "real nature" of the problem (see 2.5.3.6 Invention in Identifying the "Real Nature" of the Problem).

g. if relevant, consider whether there has been a prior perceived need using the tests of:

   • long felt need;
   • failure of others;
   • copying of invention in preference to prior art; and
   • commercial success.

h. an objection of lack of inventive step only arises where it can be shown that a person skilled in the art would, in solving the problem, have taken the necessary steps to reach the
claimed solution. In practice, this will be the case if the requirements under c. and e. are met, and those under f. and g. are not met.

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**Examination Practice**

In practical terms, examiners should not undertake a detailed analysis of every issue in each procedural step. Rather, examiners should identify all relevant issues. An inventive step objection must explain all relevant issues, but need not discuss matters that are unlikely to affect the outcome of the objection.

Thus, for example:

- a citation located in a search for novelty can usually be assumed to be ascertained, understood, and regarded as relevant, and the person skilled in the art can usually be assumed to be the addressee of the specification under examination - unless there are good reasons to believe otherwise; and

- a citation which is clearly a mere technical equivalent (in the context of the problem) of the claimed invention must presumably have fully solved the problem, i.e. the only issues apart from ascertained, understood, and regarded as relevant, are whether the difference is a technical equivalent in the context of the problem and whether the technical equivalent is common general knowledge.
Overview

The procedure of courts relies upon the evidence of expert witnesses when seeking an answer to the question "is it obvious?" Unlike courts, examiners do not have access to evidence from the person skilled in the art. Instead, they are required to put themselves "in the shoes of the skilled worker" and make their own assessment of what the notional skilled worker was likely to have done at the priority date. In doing so, they must assess "obviousness" based on their own knowledge and balance of probability considerations - see 2.13.5 Stringency of Tests During Examination.

Such assessment can be difficult. As examiners will inevitably know the claimed solution, they must set that knowledge aside in their assessment of inventive step. The initial consideration of whether a claim is obvious can be coloured by:

- **ex post facto** analysis;
- judging the merit of the invention;
- the motivation for the invention;
- failing to recognise that an inventive step requires no more than a scintilla of invention;
- failing to determine the common general knowledge appropriate to the person skilled in the art; and
- failing to consider all relevant issues.

Courts have also discussed the problem of **ex post facto** dissection of the invention. In *Meyers Taylor Pty Ltd v Vicarr Industries Ltd* (1977) 137 CLR 228 at page 242, Aickin J stated:

"subsequent analysis of the invention - 'the dissection of the invention' - is not helpful in resolving the question of obviousness".

Problem-Solution Approach

An approach used by the courts to avoid **ex post facto** analysis is the "problem-solution" approach. In *HPM Industries Pty Ltd v Gerard Industries Ltd* 98 CLR 424 at page 437, Williams J stated:

"If the invention were novel it would nevertheless fail for want of subject matter if in the light of what was common general knowledge in the particular art, it lacked inventive
2.5.1.6A Assessing Inventive Step in Examination

ingenuity because the solution would have been obvious to any person of ordinary
skill in the art who set out to solve the problem."

The "problem-solution" approach is based on the question of whether the claimed invention
would have been obvious to a person skilled in the relevant art when faced with a particular
problem. The approach is the preferred one to apply when considering inventive step, as it
reduces the risk of ex post facto analysis. The problem-solution approach also ensures that
the examiner's consideration of whether a claim lacks an inventive step:

- is valid and sustainable; and
- identifies all the issues relevant to establishing lack of inventive step.

Applying the Problem-Solution Approach

The problem-solution approach involves the following steps:

a. construe the specification under examination and determine the problem the claimed
   invention solves (see 2.5.2.3 Determining the Problem).

b. identify the person skilled in the art in the field of the problem (see 2.5.2.4A
   Identifying the Person Skilled in the Art (PSA)).

c. determine, where applicable, whether in the context of the problem, any pieces of
   prior art information under consideration are such that the person skilled in the art
   could be reasonably expected to have combined them (see 2.5.2.5.5A Could the
   Person Skilled in the Art be Reasonably Expected to Have Combined the Prior Art
   Information to Solve the Problem?)

d. determine the relevant common general knowledge (see 2.5.2.1 Common General
   Knowledge).

e. determine whether, in the context of the problem, the claimed invention is one of:
   - a technical equivalent;
   - a workshop improvement;
   - an obvious selection or special inducement; or
   - an obvious combination of features of common general knowledge.

f. consider whether:
   - the prior art information teaches away from the solution;
   - the invention overcomes practical difficulties in seeking the solution;
2.5.1.7 Ex Post Facto Analysis

- the invention resides in identifying the "real nature" of the problem (see 2.5.3.6 Invention in Identifying the "Real Nature" of the Problem).

  g. if relevant, consider whether there has been a prior perceived need using the tests of:

  - long felt need;
  - failure of others;
  - copying of invention in preference to prior art; and
  - commercial success.

  h. an objection of lack of inventive step only arises where it can be shown that a person skilled in the art would, in solving the problem, have taken the necessary steps to reach the claimed solution. In practice, this will be the case if the requirements under c. and e. are met, and those under f. and g. are not met.

Examination Practice

In practical terms, examiners should not undertake a detailed analysis of every issue in each procedural step. Rather, examiners should identify all relevant issues. An inventive step objection must explain all relevant issues, but need not discuss matters that are unlikely to affect the outcome of the objection.

For example, a citation which is clearly a mere technical equivalent (in the context of the problem) of the claimed invention must presumably have fully solved the problem, i.e. the only issues are whether the difference is a technical equivalent in the context of the problem and whether the technical equivalent is common general knowledge.
However, examiners should remember that the question of obviousness is to be answered by adopting the position of the person skilled in the art seeking to find a solution to the problem, and not by *ex post facto* reasoning which involves taking the known solution and working backwards to the problem by a succession of apparently easy steps. As stated in *Palmer v Dunlop Perdriau Rubber Co Ltd* (1937) 59 CLR 30 at page 61:

"It is frequently possible to take, as it were, a patent to pieces, and then, beginning with one piece, to show how, in order to obtain one result, step A must be taken; in order to obtain another particular result, step B must be taken - and so on until one has the whole combination for which inventive quality is claimed. If the analysis is taken into sufficient detail, every single step in the development of an invention, taken separately, can be shown to be obvious.

But, in the present case, the evidence of the expert witnesses for the defendant is really a reconstruction of an inventive process step by step, each step, when it is known that it must be taken in a certain direction, being obvious enough in itself."

Examiners should note that the inclusion of any part of the solution in the phrasing of the problem could also result in an *ex post facto* analysis of inventive step.

2.5.2 Identifying the Relevant Facts

2.5.2.1 Common General Knowledge

**Note:** The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For all other standard patent applications, see 2.5.2.1A Introduction.

For novelty, a citation is construed as at its date of publication to the exclusion of information subsequently discovered. For inventive step, the citation is construed by the person skilled in the art when trying to solve the problem, i.e. at the priority date of the claims being examined. This means that for the purposes of inventive step, the disclosure of a citation may be effectively extended by having regard to subsequent common general knowledge in Australia developed in the period between the publication date of the citation and the priority date of the claim under consideration.
2.5.2.1.1A Introduction

Note: The information in this part only applies to standard patent applications with an examination request filed on or after 15 April 2013. For all other standard patent applications, see 2.5.2.1.1 Introduction.

For novelty, a citation is construed as at its date of publication to the exclusion of information subsequently discovered. For inventive step, the citation is construed by the person skilled in the art when trying to solve the problem, i.e. at the priority date of the claims being examined. This means that for the purposes of inventive step, the disclosure of a citation may be effectively extended by having regard to subsequent common general knowledge developed in the period between the publication date of the citation and the priority date of the claim under consideration.

2.5.2.1.2 What is Common General Knowledge?

In Minnesota Mining & Manufacturing Co v Beiersdorf (Australia) Limited (1980) 144 CLR 253 at page 292, Aickin J. stated:

"The notion of common general knowledge itself involves the use of that which is known or used by those in the relevant trade. It forms the background knowledge and experience which is available to all in the trade in considering the making of new products, or the making of improvements in old, and it must be treated as being used by an individual as a general body of knowledge."

This "notion of common general knowledge" has been expanded upon by some subsequent decisions as discussed below.

ICI Chemicals & Polymers Ltd v Lubrizol Corp 45 IPR 577

Emmett J stated:

"112 The common general knowledge is the technical background to the hypothetical skilled worker in the relevant art. It is not limited to material which might be memorised and retained at the front of the skilled workers mind but also includes material in the..."
field in which he is working which he knows exists and to which he would refer as a
matter of course. It might, for example, include:

- standard texts and handbooks;
- standard English dictionaries;
- technical dictionaries relevant to the field;
- magazines and other publications specific to the field."

**Bristol-Meyers Squibb Co v F H Faulding & Co Ltd** [46 IPR 553]

Black CJ and Lehane J stated:

"If a patent application, lodged in Australia, refers to information derived from a
number of prior publications referred to in the specification or, generally, to matters
which are known, in our view the Court - or the Commissioner - would ordinarily
proceed upon the basis that the knowledge thus described is, in the language of sec
7(2) of the 1990 Act, part of "the common general knowledge as it existed in the
patent area". In other words, what is disclosed in such terms may be taken as an
admission to that effect."

**Note:** The requirement that common general knowledge be restricted to that which existed
in Australia was removed from sec 7 for standard patent applications with an examination
request filed on or after 15 April 2013. However, the principle expressed in the above
passage has not changed for such applications.

However, the occurrence of the word "ordinarily" should be noted in the above passage.
Thus, each situation must be assessed on its merits - see, for example, *Beissbarth GmbH v
Snap-on Technologies Inc.* [2001] APO 20 and *BHP Steel (JLA) Pty Ltd v Nippon Steel
Corporation* [1999] APO 69.

**Aktiebolaget Hassle and Astra Pharmaceuticals Pty Limited v Alphapharm Pty Ltd** [51
IPR 375]

Wilcox, Merkel and Emmett JJ stated:

"71 While manufacturers' literature may well play an important role in the work of a
hypothetical formulator, as Lehane J observed at para 42 [of the decision under
appeal], in the light of the authorities it would be a "bold" submission to contend that
material, which is not part of common general knowledge, can be relied upon to
determine the question of obviousness. Nevertheless, by a process that his Honour
characterised as taking the routine steps that the hypothetical formulator would take
2.5.2.1.3 Evidence of Common General Knowledge

for the purpose of formulating a drug, such documents were held to be admissible for the purpose of raising "general ideas".

72 If that process were permissible, the concept of common general knowledge would lose much of its significance. If it is shown that the particular skilled worker in the field would, as a matter of routine, read literature beyond the common general knowledge of the field, the distinction becomes quite meaningless. The question is not whether a skilled worker conducting a literature search would find pieces from which there might have been selective elements which make up a patent - *Minnesota Mining & Manufacturing Co v Beiersdorf (Australia) Ltd* (1980) 144 CLR 253 at 293. What might be found by a diligent searcher is not the same as "common general knowledge".

73 That is not to say that the whole of the content of "common general knowledge" need be within the conscious awareness of the hypothetical non-inventive skilled worker. For example, there may be publications of technical and detailed information that are habitually consulted by the hypothetical skilled worker. Notwithstanding that the hypothetical skilled worker would not have the whole of the contents of such reference material in his or her mind, such information should be regarded as part of common general knowledge.

74 Another area where it may be permissible to rely upon information that is not part of the common general knowledge is where the hypothetical addressee, faced with a problem, would resort to information that is fundamental to understanding the nature of the problem, if this were found to be a routine step that would have led from the prior art to the invention: cf *Wellcome Foundation* at 286 per Aickin J. Such information would include information about the basic characteristics of a drug for which a formulation is to be found."

This decision of the Full Federal Court was appealed to the High Court (*Aktiebolaget Hassle v Alphapharm Pty Ltd* [2002] HCA 59; *(2002) 212 CLR 411*), and in this aspect the High Court appeared to leave untouched the decision of the Federal Court. It merely stated:

"Their Honours correctly held, contrary to what had been decided by the trial judge, that it was impermissible to have regard to documents that would have been read merely for "general ideas".
therefore must formulate an opinion of what is common general knowledge on the basis of written information. Examiners may refer to the following as being indicative of the common general knowledge:

- standard texts and handbooks;
- most dictionaries of standard English;
- relevant technical dictionaries;
- concession in the patent application under examination;
- magazines or other publications specific to the art; and
- patent specifications, under certain conditions.

However, the material disclosed in such publications does not necessarily constitute common general knowledge in the art. Thus:

"In my judgement it is not sufficient to prove common general knowledge that a particular disclosure is made in an article, or a series of articles, in a scientific journal, no matter how wide the circulation of that journal may be, in the absence of any evidence that the disclosure is accepted generally by those who are engaged in the art to which the disclosure relates. A piece of particular knowledge as disclosed in a scientific paper does not become common general knowledge merely because it is widely read, and still less merely because it is widely circulated. Such a piece of knowledge only becomes common general knowledge when it is generally known and accepted without question by the bulk of those who are engaged in the particular art; in other words, when it becomes part of their common stock of knowledge relating to the art."

and

"It is certainly difficult to appreciate how the use of something which has in fact never been used in a particular art can ever be held to be common general knowledge in the art."

*British Acoustic Films Ld v Nettlefold Productions* (1936) 53 RPC 221 at page 250, and affirmed in *General Tire & Rubber Company v Firestone Tyre and Rubber Company Ltd* [1972] RPC 457, with the qualification that "without question" should read "generally regarded as a good basis for further action."
2.5.2.1.5 Common General Knowledge in Australia

Acknowledgement of prior art in a patent specification is an admission which carries great weight (Bristol-Myers Squibb Co v F H Faulding and Co Ltd 46 IPR 553 and referred to in 2.5.2.1.2 What is Common General Knowledge?). However, this does not prevent the applicant or patentee from providing evidence to contradict it (Gerber Garment Technology v Lectra Systems [1995] FSR 492).

The only common general knowledge that can be used in objections of lack of inventive step is the common general knowledge in Australia (in contrast to novelty, where there is no geographical limitation on the common general knowledge). Thus, where a publication printed overseas is relied on as indicative of the common general knowledge, examiners may also have to demonstrate that the publication was well known in the relevant art in Australia.

Likewise, what is admitted as common general knowledge in a specification prepared overseas may not be common general knowledge in Australia - see BHP Steel (JLA) Pty Ltd v Nippon Steel Corporation [1999] APO 69, in which it was held that an admission in an Australian application, with a Japanese applicant, that a Japanese patent document was well known prior art did not suffice to establish that the document was common general knowledge in Australia.

However, many arts are of an international nature and the common general knowledge in Australia is the same as that in other countries. For example, it has been recognised that genetic engineering (Genentech Inc's (Human Growth Hormone) Patent [1989] RPC 613 at 671) and organic chemistry (Biochem Pharma Inc v Emory University [1999] APO 50) are international arts. In such cases, it is not necessary to establish that a matter is separately known in Australia. See also Dyno Noble Asia Pacific Ltd v Orica Australia Pty Ltd 47 IPR 257 at 304, which recognises the global distribution of information within the mining industry.

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Effective Date: 25 September 2019
2.5.2.1.5A Common General Knowledge not Limited to Being in Australia

**Note:** The information in this part only applies to standard patent applications with an examination request filed on or after 15 April 2013. For all other standard patent applications, see 2.5.2.1.5 Common General Knowledge in Australia.

The common general knowledge that can be used in objections of lack of inventive step is not limited to just the common general knowledge in Australia, i.e. there is no geographical limitation on the common general knowledge. Thus, a publication printed overseas can be relied on as indicative of the common general knowledge.

Likewise, what is admitted as common general knowledge in a specification prepared overseas can be taken to be common general knowledge. It is the common general knowledge of the person skilled in the relevant art that is taken into consideration, not the knowledge of the person in a specific geographical location.

In the first instance, examiners should proceed on the basis that there is no difference (or no significant difference) in the common general knowledge of the persons skilled in the art in one country from that of their counterparts in another country. Arguments that a piece of knowledge known to persons skilled in the art located in a particular geographical location is not common general knowledge are, in general, not to be accepted. This argument assumes the person skilled in the art in one geographical location is unaware of what is well known to others working in the same art in another location. This would suggest that the person skilled in the art in one location is disconnected from the world at large, which is unlikely in view of modern technology.

Nevertheless, such an argument may be supported by persuasive evidence. However, care must be taken to distinguish between situations where the knowledge is known to a small number of people and where the knowledge is generated by a small number of people. While a feature that is well known to a few is not necessarily common general knowledge, it is equally true that common general knowledge is not necessarily defined by the number of people working in the art. For example, if information arises only from the research of a small number of people, that circumstance does not prohibit that information from being common general knowledge. The question is whether that information has become part of the technical background of the person skilled in the art.
2.5.2.1.6 Patent Specifications as Indicators of Common General Knowledge

In general:

"... it is clear that individual patent specifications and their contents do not normally form part of the relevant common general knowledge .."

*General Tire & Rubber Company v Firestone Tyre and Rubber Company Ltd* [1972] RPC 457 at page 482

Thus, in usual circumstances, examiners should not rely on a single patent specification as establishing the state of the common general knowledge.

However, as was stated in *Minnesota Mining & Manufacturing Co v Beiersdorf (Australia) Ltd* (1980) 144 CLR 253 at page 294:

"There may be some fields of endeavour in which those who work therein study and make themselves familiar with all patent specifications as they become available for inspection in one or in many countries so that what was contained therein becomes common general knowledge in that particular trade or field of manufacture in the country in question. Examples are provided by Vidal Dyes Syndicate Ltd v Levinstein Ltd.* and British Celanese Ltd v Courtaulds Ltd.*

** (1912) 29 RPC 245 at pages 279-280.

* (1933) 50 RPC 259 at page 280.

Where multiple specifications refer to a piece of knowledge, this may be indicative of that knowledge being common general knowledge, especially when the applications are by different applicants. However, examiners are not to conduct lengthy searches for the sole purpose of identifying common general knowledge, but instead should consider the possibility of combining documents where the person skilled in the art would be reasonably expected to have done so.

Modified Date: 03 September 2012

2.5.2.1.7 Considerations at Further Reports

In the first instance, examiners may use a single standard textbook or another similarly authoritative publication, or a number of patent specifications, published before the relevant priority date as a basis for asserting that certain information is common general knowledge.
2.5.2.2 Non-Essential Features of the Invention Claimed

Depending on the art and the issues involved, examiners may be convinced by short submissions from the applicant that a feature was not common general knowledge. Otherwise, the applicant may need to provide more substantial arguments or evidence to tip the balance in their favour. Where examiners have a reasonable basis on which to conclude that a piece of information is common general knowledge, the burden of proof shifts to the applicant to satisfy examiners otherwise.

Examiners are to consider arguments that a piece of information is not common general knowledge based on their merits and should apply balance of probability considerations (see 2.13.5.2 Balance of Probabilities).

Modified Date: 03 September 2012

2.5.2.2 Non-Essential Features of the Invention Claimed

The various tests for obviousness refer to whether "the invention" is obvious. As discussed in 2.4.8 Not All Features of Claim Disclosed in Citation, not all the features of a claim are necessarily essential features of the invention claimed.

If in novelty considerations a claimed feature is found to be inessential, that feature cannot give rise to an inventive step in the claimed invention. Thus examiners should disregard any inessential features of the invention claimed when considering inventive step.

Where an objection of lack of inventive step is taken in these circumstances, examiners will need to explain why they have considered a feature as inessential.

2.5.2.3 Determining the Problem

Modified Date: 01 October 2014

2.5.2.3.1 Introduction

Note: The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For all other standard patent applications, see 2.5.2.3.1A Introduction.
The starting point in the "problem-solution" approach to inventive step is identifying a problem that the claimed invention solves. The problem is the focal point for the analysis and provides a context for:

- identifying the person skilled in the art;
- determining the relevant common general knowledge;
- determining whether the person skilled in the art could, before the priority date of the relevant claim, be reasonably expected to have ascertained, understood, regarded as relevant and, where applicable, combined the prior art information; and
- evaluating the relevance of the prior art information and whether there is invention in solving the problem.

Examiners should objectively determine a problem that the claimed invention solves. They should identify as narrow a problem as possible, but must avoid including any part of the solution in the phrasing of the problem, to avoid an ex post facto analysis of inventive step.

Note: The information in this part only applies to standard patent applications with an examination request filed on or after 15 April 2013. For all other standard patent applications, see 2.5.2.3.1 Introduction.

The starting point in the "problem-solution" approach to inventive step is identifying a problem that the claimed invention solves. The problem is the focal point for the analysis and provides a context for:

- identifying the person skilled in the art;
- determining the relevant common general knowledge;
- determining, where applicable, whether the person skilled in the art could, before the priority date of the relevant claim, be reasonably expected to have combined the prior art information; and
- evaluating the relevance of the prior art information and whether the person skilled in the art would have considered it a worthy starting point for further investigation or development.
Examiners should objectively determine a problem that the claimed invention solves. They should identify as narrow a problem as possible, **but must avoid including any part of the solution in the phrasing of the problem**, to avoid an *ex post facto* analysis of inventive step.

In **AstraZeneca AB v Apotex Pty Ltd** [2014] FCAFC 99 at [202]–[203]; [107 IPR 177](https://www.ipraustralia.gov.au/ips/acip/ipa/2014/177/), a full bench of the Federal Court found that if the problem itself is common general knowledge, or if knowledge of the problem is part of the prior art information, then that knowledge or information may be used in assessing inventive step. However, it is not appropriate to determine the problem based on the description of the invention in the specification, and in particular any problem that the invention is explicitly or implicitly directed at solving, unless this is part of the common general knowledge or prior art.

In the first instance, examiners should have regard to the specification when determining the problem. Specifications that discuss the prior art will usually identify difficulties with that art. The specification may explicitly state the prior art difficulties that the claimed invention overcomes and thereby directly identify the problem solved by the invention. Otherwise,
examiners should be able to infer the problem solved by the invention from the stated difficulties with the prior art and the scope of the claim. A statement of an "object of the invention" may also be indicative of a problem to be solved.

If there is no specific reference to the prior art or objects of the invention, examiners may be able to deduce the problem from the specification as a whole (including the claims). In practice, this means that examiners should determine from the description what contribution is made by the essential features of the broadest independent claim, taking into consideration the common general knowledge. The problem the claimed invention was "intended" to solve can be viewed as the task of attaining that contribution.

A specification may have several well defined objects, or problems, with only some of these solved by the independent claim. In such cases, examiners should identify the problem associated with the independent claim. If that claim is found to lack an inventive step, dependent claims should be considered in the context of the further problems associated with them.

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**Considerations at Further Reports**

Examiners are to consider arguments that the problem identified is not part of the common general knowledge or prior art information on their merits and should apply balance of probability considerations (see 2.13.5.2 Balance of Probabilities).

Modified Date: 01 October 2014

**2.5.2.3.3 Claim Does Not Solve the Identified Problem**

Having determined a problem, examiners should ascertain from the specification what features are necessary to solve it. Examiners should then check that the claim under consideration defines all of those features. Where this is not the case, the problem will have to be amended to one that the claim solves.

Modified Date: 01 October 2014
2.5.2.3.4 Amendment of the Problem

In response to an examination report, the applicant may (apart from simply filing submissions rebutting the inventive step objection in the report) amend the problem, amend the claims, or delete all reference to the problem.

If the applicant amends the problem, examiners should proceed using the new problem, unless the amended problem is inconsistent with either the description or the relevant claim.

If the amended claims provide a different solution to the problem originally identified, examiners should consider whether the original problem is still applicable and if not, redetermine the problem.

In any case where the problem is amended, examiners should consider whether the amendment gives rise to no more than a "bonus effect" - see 2.5.3.3.2 Bonus Effect.

Modified Date: 01 February 2013

2.5.2.4 Identifying the Person Skilled in the Art (PSA)

Note: The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For all other standard patent applications, see 2.5.2.4A Identifying the Person Skilled in the Art (PSA).

The person skilled in the art should be identified in light of the problem that the claimed invention is directed to solving (see 2.5.2.3 Determining the Problem) and not in light of the claimed solution. The art also includes any related field of technology where the skilled person would be expected to look for a solution to the problem. As the person skilled in the art is non-inventive, it is unlikely that the person would look for a solution in arts remote from the problem.

The basic rules for determining who the person skilled in the art is are the same as those for determining the addressee of a specification. Thus, the person skilled in the art:

- is a skilled but non-inventive worker in the relevant field of technology;
- knows the common general knowledge in the art in Australia;
- could be anyone from a tradesman in some arts to a highly qualified scientist in others, depending on the nature of the problem; and
- could be a team of people.
2.5.2.4A Identifying the Person Skilled in the Art

See, for example, Root Quality Pty Ltd v Root Control Technologies Pty Ltd [49 IPR 225], American Cyanamid v Ethicon Ltd [1979] RPC 215 and Sunbeam Corp v Morphy-Richards (Aust) Pty Ltd (1961) ALJR 212.

Examiners should generally assume in the first instance that the addressee of the specification is the same person as the person skilled in the art. However, where the claimed solution to the problem is in an art remote from the problem, the addressee will likely be a different person from the person skilled in the art. In this situation, the art in which a novelty search is conducted (i.e. the art of the addressee) will be different from the art of the person skilled in the art and it may not be possible to cite a document located during the search for the purposes of inventive step (see also 2.5.2.5.1 Ascertained and 2.5.2.5.3 Regarded as Relevant).

The person skilled in the art should be identified in light of the problem that the claimed invention is directed to solving (see 2.5.2.3 Determining the Problem) and not in light of the claimed solution.

The person skilled in the art:

- is a skilled but non-inventive worker in the relevant field of technology;
- knows the common general knowledge in the art;
- could be anyone from a tradesman in some arts to a highly qualified scientist in others depending on the nature of the problem; and
- could be a team of people.

See, for example, Root Quality Pty Ltd v Root Control Technologies Pty Ltd [49 IPR 225], American Cyanamid v Ethicon Ltd [1979] RPC 215 and Sunbeam Corp v Morphy-Richards (Aust) Pty Ltd (1961) ALJR 212.

Given the dependence of identifying the person skilled in the art on the problem solved by the claimed invention, where the claimed solution is in an art remote from the identified
2.5.2.5 Could the Person Skilled in the Art be Reasonably Expected to have Ascertained, Understood, Regarded as Relevant and, Where Applicable, Combined the Prior Art Information?

problem, the art in which a novelty search is conducted will be different from the art of the person skilled in the art. In these circumstances, examiners must decide:

- whether the skilled person, while deemed to have been aware of and to have carefully read any documents located in the search, would have appreciated the relevance of those documents to the problem that the claimed invention seeks to solve; and

- whether any documents would be considered a worthy starting point for further investigation or development.

Thus, in certain situations it may not be possible to cite a document located during the novelty search for the purposes of inventive step.

Note: The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For standard patent applications with an examination request filed on or after 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply, see 2.5.2.5A Prior Art Information.

Note: The requirements for combining documents apply to all applications filed on or after 1 April 2002.

Subsection 7(3) restricts any pieces of prior art information used for an inventive step objection to those which the person skilled in the art, before the priority date of the relevant claim, could be reasonably expected to have ascertained, understood, regarded as relevant and, where applicable, to have combined them. (Note, however, that information publicly
available through doing an act is precluded from consideration during examination; see 2.5.1.4.1 Prior Art Base).

If any piece of prior art information does not satisfy these requirements, it cannot be used as the basis for an inventive step objection.

In many (if not the majority) of cases, examiners can proceed on the basis that a document located in a search could be reasonably expected to have been ascertained, understood and regarded as relevant in the patent area.

However, this is not always the case and before an objection of lack of inventive step can be raised, examiners must determine that the document satisfies these statutory requirements.

Note: The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For standard patent applications with an examination request filed on or after 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply.

In Dyno Nobel Asia Pacific Ltd v Orica Australia Pty Ltd 47 IPR 257 the word "ascertained" was interpreted by the Federal Court as meaning "discovered" or "found".

Generally speaking, it should be considered that a document dealing with the same technical issues would have been ascertained. In Rohm and Haas Company v Nippon Kayaku Kabushiki Kaisha and Sankyo Company, Limited [1997] APO 40 it was stated:

"A document would be ascertained if it was published in such a manner or form that it could reasonably have been expected to be found by a person skilled in the art. A patent document dealing with the same technical issues would prima facie have been ascertained by a person skilled in the art. The requirements of understood and regarded as relevant are not likely to be an issue where a document relates to the same art as the problem."

In the decision of Dyno Nobel Asia Pacific Ltd v Orica Australia Pty Ltd (supra, paragraphs 183-196), the court applied the "diligent searcher" test in determining whether a document was part of the prior art base for obviousness, as outlined in the UK decision of Technograph Printed Circuits Limited v Mills and Rockley (Electronics) Limited [1972] RPC 346 at 355:
"... there may be documents which, although available, would never be looked at by anyone making such a search as our hypothetical addressee is supposed to have made. Attention was drawn to the fact that both heads (e) (novelty) and (f) (obviousness) in section 32 contain the words ‘having regard to what was known or used ... in the United Kingdom’. I doubt whether they were intended to mean the same in each case. If they were there would now be little, if any, difference between novelty and obviousness. Obviousness would cover practically every case of lack of novelty. In head (e) these words are used in an artificial sense and are held to include matter which in fact no-one in the United Kingdom ever knew or was likely to know, such as the contents of some foreign specifications which no-one had ever looked at and which the most diligent searcher would probably miss. I think that in head (f) the words should have the more natural meaning of what was or ought to have been known to a diligent searcher."

The court expressed the view that this distinction between the respective prior art bases for novelty and inventive step was reflected in the words of sec 7(3).

In order to assess whether a diligent searcher could have been reasonably expected to have ascertained a particular document, it is important to have regard to the context of the problem that the diligent searcher would have been investigating.

Examiners should generally proceed on the basis that it could be reasonably expected that the person skilled in the art would conduct a search of the patent literature, including the patent specifications of major countries and that, apart from the exceptions below, any patent document located in a patentability search would reasonably be expected to be ascertained by the person skilled in the art.

In Commissioner of Patents v Emperor Sports Pty Ltd [2006] FCAFC 26; 67 IPR 488, the Full Court affirmed the general correctness of the above practice. However, it also noted that this may not be universally applicable and there may be situations where it would not be reasonable to have such an expectation.

### Exceptions

Exceptions to the general principle set out above may arise where:

- the patent document is in a location that makes it unlikely that the person skilled in the art would come across it, such as in B.C.D. Mecanique Ltee v Madness Gaming Products, Inc. [2001] APO 70 where a patent specification which was in the files of the Dominican Republic Patent Department was found to be not ascertainable;
2.5.2.5.2 Understood

- the relevant technology is one in which it could not be reasonably expected that a person skilled in the art would consult patent literature, such as in *Commissioner of Patents v Emperor Sports Pty Ltd* where it was considered that a Rugby League or Australian Rules coach, referee, umpire or administrator would not have conducted a search in the United States Patent Office; and

- the person skilled in the art could not be reasonably expected to find the information in the document. Thus, for example, an obscure statement in a large document may not be ascertained if the bulk of the document is not relevant to the problem.

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**Note:** The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For standard patent applications with an examination request filed on or after 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply.

Unless there are unusual circumstances, examiners should generally proceed on the basis that a person skilled in the art could be reasonably expected to have understood the prior art information. There should be little doubt of this when, for example, the information relates to the same art (see the passage from *Rohm and Haas Company v Nippon Kayaku Kabushiki Kaisha and Sankyo Company, Limited* [1997] APO 40 appearing in 2.5.2.5.1 Ascertained).

The question of whether the person skilled in the art could be reasonably expected to have understood particular information in a document will arise where:

- a prior document is allegedly ambiguous, such that the person skilled in the art cannot understand it; or

- the technical level of the prior art document is too high to be understood by the person skilled in the art.

The issue may also arise where the document is in a foreign language. However, in most cases this will not be a problem. For example, in *Heating Elements Ltd.* (1978) IPD 169, a Japanese utility model was not excluded because of language difficulty. In the first instance, examiners should not exclude a document on the basis of language.
The applicant may provide a well-reasoned argument of why the person skilled in the art could not be reasonably expected to be familiar with the language of the document. Such arguments should be considered on their merits (see \textit{2.13.5.2 Balance of Probabilities}).

\textbf{2.5.2.5.3 Regarded as Relevant}

\begin{itemize}
\item \textbf{Note:} The information in this part \textbf{only} applies to standard patent applications with an examination request filed \textbf{before} 15 April 2013. For standard patent applications with an examination request filed \textbf{on or after} 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply.
\end{itemize}

A general test that has been used to establish relevance is:

\begin{quote}
"The test in my judgement is whether it can be expected that the skilled man will be likely to recognize the document in question as being particularly pertinent to, though it may not specifically solve the problem before him."
\end{quote}


Where there are multiple documents that could be regarded as relevant, each must be considered individually to determine whether the invention is obvious. The fact that the skilled addressee is faced with a choice of documents, the selection of any one of which may or may not lead to the claimed invention, is not important. Provided the invention is obvious in the light of any one of the pieces of prior art information, there will be a lack of inventive step (\textit{AstraZeneca AB v Apotex Pty Ltd} [2015] HCA 30; 89 ALJR 798 at [113]-[115]).

The following sections consider issues that are pertinent to determining whether the person skilled in the art could be reasonably expected to have regarded a document as relevant to solving the problem.
2.5.2.5.3.2 Document Discusses a Different Problem

**Note:** The information in this part *only* applies to standard patent applications with an examination request filed **before** 15 April 2013. For standard patent applications with an examination request filed **on or after** 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply.

A clear reason why the person skilled in the art would consider the document relevant for solving the problem is where the document discusses the same or a similar problem.

**Modified Date: 01 October 2015**

**2.5.2.5.3.2 Document Discusses a Different Problem**

**Note:** The information in this part *only* applies to standard patent applications with an examination request filed **before** 15 April 2013. For standard patent applications with an examination request filed **on or after** 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply.

It is not essential for a document to discuss the same, or a similar, problem in order to be regarded as relevant. However, where a document lies in an art remote from that of the problem solved by the invention, its relevance is open to question:

"...there appears to be no reason why a person skilled in the nurseryman's art would have approached the rubber industry for a solution to his problem, or, if he had thought of forming coconut fibre into a mouldable mass by use of an adhesive, would have gone to persons skilled in the rubber trade to help him, when he would not have known of any product of that industry made by use of such a technique."

(*Proctor v Flo-Con*, 4 IPR 187 at page 198)

Where a document discusses a different problem, examiners will need to provide good reasons why the person skilled in the art would consider the document relevant to solving the problem. In the absence of good reasons, the document would not be regarded as relevant.

One possible reason for regarding a document which does not discuss the same, or a similar, problem as relevant is that it provides relevant technical background knowledge.

Where the problem contains two unrelated part-problems, only one of which is discussed in the document, examiners will need to consider whether a person skilled in the art would consider the document relevant to the **whole** problem.
2.5.2.5.3.3 Age of the Document

**Note:** The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For standard patent applications with an examination request filed on or after 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply.

In the first instance, examiners should not exclude a document by reason of its age. However, in some arts a person skilled in the art would not seek assistance from an old document and thus such documents cannot be used as a basis for an inventive step objection. Therefore, at further report examiners should accept persuasive arguments on their merits (see 2.13.5 Stringency of Tests During Examination).

2.5.2.5.3.4 Would the Person Skilled in the Art Have Used the Document to Solve the Problem?

**Note:** The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For standard patent applications with an examination request filed on or after 15 April 2013, the requirement that the prior art information be ascertained, understood and regarded as relevant by the person skilled in the art does not apply.

In *Tidy Tea Ltd v Unilever Australia Ltd* [32 IPR 405] at 414, the court stated:

"The new provisions [that is, sec 7(2) and 7(3)] are limited by the words 'being information that the skilled person... could, before the priority date of the relevant claim, be reasonably expected to have ascertained, understood and regarded as relevant to work in the relevant art in the patent area.' And if a prior specification passes these tests, it must still be able to be said that, if that specification had been considered by the hypothetical skilled person together with the common general knowledge at the relevant time, 'the invention would have been obvious.'"
2.5.2.5.4 Does the Document Constitute a Single Source of Information

As a result, documents cannot be considered in total isolation from the surrounding common general knowledge, nor in isolation from the teaching of other related documents. As was stated in General Tire & Rubber Company v Firestone Tyre and Rubber Company Ltd [1972] RPC 457 at page 505:

"That leaves the final question as to whether a skilled addressee ... would by reason ... have come to regard the plaintiff's solution of the problem as obvious, despite the fact that his common general knowledge would have biased him against exploring the chances of oil-extended rubber providing a solution. In this behalf we agree with the approach adopted by the trial judge ...:

"It seems to me to be very dangerous and in law not permissible to assess obviousness in the light of carefully selected pieces of prior knowledge only".

Thus, where the general art is heading in a completely different direction, an isolated document may not be considered relevant, even if that document would lead to the solution. For example, in Fichera v Flogates Limited [1984] RPC 257 at page 275, the court commented:

"The patents show that, although the problems of the stopper rod and nozzle were well appreciated, the only solution of inventors in the art was to improve the stopper rod" [and not the nozzle].

Examiners must assess whether the solution to the problem was naturally suggested by the document (possibly in combination with one or more other documents) in the light of the common general knowledge at the priority date:

"The material question to be considered in a case like this is, whether the alleged discovery lies so much out of the track of what was known before as not naturally to suggest itself to a person thinking on the subject; it must not be the obvious or natural suggestion of what was previously known."

Savage v Harris [1896] 13 RPC 364 at page 370.

Note: The information in this part only applies to applications filed before 1 April 2002.
2.5.2.5.5 Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Documents to Solve the Problem?

Under sec 7(3), any prior art information used to establish a lack of inventive step has to be made publicly available in either:

- a single document or through doing a single act; or
- two or more related documents or doing two or more related acts, if the relationship between the documents or acts is such that a person skilled in the art would treat them as a single source of that information.

Some guidance on when two or more documents constitute a single source of information is provided in *Nicaro Holdings Pty Ltd v Martin Engineering Co*, 16 IPR 545. The conditions are the same as for novelty and are discussed in 2.4.4.4. Mosaics and Related Documents.

**Note:** The information in this part only applies to standard patent applications filed from 1 April 2002 and with an examination request filed before 15 April 2013. For standard patent applications with an examination request filed on or after 15 April 2013, see 2.5.2.5.5A Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Prior Art Information to Solve the Problem?

**Note:** As an additional or alternative consideration to a lack of inventive step on the basis of two or more pieces of information, examiners should also consider whether the invention falls into any of the categories of invention that do not meet the requirements of being a manner of manufacture according to "traditional principles" (per *NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd* 32 IPR 449 and *D'Arcy v Myriad Genetics Inc* [2015] HCA 35 - see 2.9.2.1 Introduction and 2.9.2.2 Principles for Examination respectively).

The combining of documents is often referred to as "mosaicing". In *Technograph Printed Circuits Limited v Mills and Rockley (Electronics) Limited* [1972] RPC 346 it was stated:

"It is not disputed that the hypothetical addressee is a skilled technician who is well acquainted with workshop technique and who has carefully read the relevant literature. He is supposed to have an unlimited capacity to assimilate the contents of, it may be, scores of specifications but to be incapable of a scintilla of invention. When dealing with obviousness, unlike novelty, it is permissible to make a 'mosaic' out of the
2.5.2.5.5 Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Documents to Solve the Problem?

relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capacity."

**Note:** The test of whether a person skilled in the art could be reasonably expected to have combined the prior art information is part of the overall consideration of whether the claimed solution is obvious. Therefore, examiners should expect to deal with this issue as part of the overall obviousness consideration (what would the skilled worker have done given the problem at the relevant date?)

In determining whether the person skilled in the art could be reasonably expected to have combined two or more distinct documents, examiners should focus on the problem faced by the skilled worker and whether in light of that problem, there is a reasonable basis (or some motivation) for the skilled worker to combine the two disclosures. Examiners should have regard to the following:

- whether the nature and content of the documents are such as to make it likely or unlikely that the person skilled in the art would combine them – is there some suggestion or motivation either in the references themselves, or in the knowledge generally available to the person skilled in the art, to modify the reference or to combine reference teachings with a reasonable expectation of success? Is there some *expected* advantage that would have been produced by the combination?

- whether the documents come from similar, different or remote technical fields – would the problem have prompted a search in those technical fields? Would the person skilled in the art have researched that technical field since the same problem was likely to have occurred in it? For example, in Dow Chemical Company (Mildner's) Patent [1973] RPC 804, an invention residing in an electrical cable in which a plastics jacket was securely bonded to a metal shield using a specified copolymer was held to be obvious in the light of one document disclosing all the features of the cable, but not the adhesive copolymer, and other documents disclosing the copolymer. Although these latter documents did not refer to cable manufacture, they did disclose the copolymer as having high moisture resistance and being suitable for bonding plastics to metal, both essential properties for adhesives used in cables. It was therefore reasonable to expect the skilled person concerned with the problem of adhering plastics to metal in cables to have found and considered these documents.

- whether the art would have taught away from a particular solution or combination at the priority date – do the disclosed features initially seem to have an inherent incompatibility? Would the combination not have been expected from a person skilled in the art? Does one piece of information have a tendency to lead away from the mosaic? Answering yes to any one of these questions would point towards the claimed combination being inventive.

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Effective Date: 25 September 2019
2.5.2.5.5A Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Prior Art Information to Solve the Problem?

Consideration should also be given to whether the documents are such that a skilled worker could be reasonably expected to have ascertained, understood, and regarded them as relevant.

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Note: The information in this part only applies to standard patent applications filed from 1 April 2002 and with an examination request filed on or after 15 April 2013. For standard patent applications with an examination request filed before 15 April 2013, see 2.5.2.5 Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Documents to Solve the Problem?

Note: As an additional or alternative consideration to a lack of inventive step on the basis of two or more pieces of information, examiners should also consider whether the invention falls into any of the categories of invention that do not meet the requirements of being a manner of manufacture according to “traditional principles” (NV Philips Gloeilampfabrieken v Mirabella International Pty Ltd 32 IPR 449 and D'Arcy v Myriad Genetics Inc [2015] HCA 35 - see 2.9.2.1 Introduction and 2.9.2.2 Principles for Examination respectively).

The combining of prior art information (which can be documents or information made publicly available through doing an act, including a prior use) is often referred to as "mosaicing".

In Technograph Printed Circuits Limited v Mills and Rockley (Electronics) Limited [1972] RPC 346 it was stated:

"It is not disputed that the hypothetical addressee is a skilled technician who is well acquainted with workshop technique and who has carefully read the relevant literature. He is supposed to have an unlimited capacity to assimilate the contents of, it may be, scores of specifications but to be incapable of a scintilla of invention. When dealing with obviousness, unlike novelty, it is permissible to make a 'mosaic' out of the relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capacity."

Note: The test of whether a person skilled in the art could be reasonably expected to have combined the prior art information is part of the overall consideration of whether the claimed
2.5.2.5.5A Could the Person Skilled in the Art be Reasonably Expected to Have Combined the Prior Art Information to Solve the Problem?

solution is obvious. Therefore, examiners should expect to deal with this issue as part of the overall obviousness consideration (what would the skilled worker have done given the problem at the relevant date?)

In determining whether the person skilled in the art could be reasonably expected to have combined two or more distinct pieces of information, examiners should focus on the problem faced by the skilled worker and whether, in light of that problem, there is a reasonable basis (or some motivation) for the skilled worker to combine the two disclosures. Examiners should have regard to the following:

- whether the nature and content of the documents are such as to make it likely or unlikely that the person skilled in the art would combine them – is there some suggestion or motivation either in the references themselves, or in the knowledge generally available to the person skilled in the art, to modify the reference or to combine reference teachings with a reasonable expectation of success? Is there some expected advantage that would have been produced by the combination?

- whether the documents (or information) come from similar, different or remote technical fields – would the problem have prompted a search in those technical fields? Would the person skilled in the art have researched that technical field since the same problem was likely to have occurred in it? For example, in Dow Chemical Company (Mildner's) Patent [1973] RPC 804, an invention residing in an electrical cable in which a plastics jacket was securely bonded to a metal shield using a specified copolymer was held to be obvious in the light of one document disclosing all the features of the cable, but not the adhesive copolymer, and other documents disclosing the copolymer. Although these latter documents did not refer to cable manufacture, they did disclose the copolymer as having high moisture resistance and being suitable for bonding plastics to metal, both essential properties for adhesives used in cables. It was therefore reasonable to expect the skilled person concerned with the problem of adhering plastics to metal in cables to have found and considered these documents.

- whether the art would have taught away from a particular solution or combination at the priority date – do the disclosed features initially seem to have an inherent incompatibility? Would the combination not have been expected from a person skilled in the art? Does one piece of information have a tendency to lead away from the mosaic? Answering yes to any one of these questions would point towards the claimed combination being inventive.

Consideration should also be given to whether the skilled worker, while deemed to be aware of and to have carefully read all the documents, would have appreciated the relevance of the documents to the problem.
2.5.2.5.6 Inventive Step Objections Involving a Combination of Documents

In order to establish lack of an inventive step based on a combination of documents, there must be some suggestion or motivation, either in the documents themselves or in the knowledge generally available to the person skilled in the art, to combine the disclosures of the documents. Where the motivation to combine the disclosures of the documents is not immediately apparent, examiners must explain why the disclosures may be properly combined.

Generally speaking, it would be reasonable to combine a well-known text book or standard dictionary with a prior art document, since this is only a special case of the general proposition that it is permissible to add common general knowledge to a document to demonstrate a lack of inventive step. It would also be reasonable to combine the disclosures of two prior art documents, one of which contained a direct and unmistakable reference to the other.

In all other cases involving a combination of documents, examiners will need to provide reasoned argument as to why, in light of the problem faced by the person skilled in the art, the skilled person would be motivated to combine the disclosures of the documents.

Note: This approach must be followed and it is recommended that examiners use PERP codes such as [F68] and [F69], or similar wording, when formulating their reasons as to why the person skilled in the art would be motivated to combine the disclosures of multiple documents.

Further Report

At further report, examiners will have to consider whether an objection should be maintained in view of the circumstances pertaining to the combining of the documents. For example, if two or more documents have features which, from the point of view of combining the documents, would appear inherently incompatible, then the person skilled in the art would not ordinarily be expected to have combined them. In contrast, if there are features in the documents that makes their combination inherently desirable, then the converse will apply.
Other circumstances which may have a bearing on whether the person skilled in the art could be reasonably expected to combine particular documents and which may be raised in response to a report are:

- the number of documents to be combined. Very often the more documents to be combined, the less likely it is that it would be reasonable to combine them;
- the combination would be in conflict with teaching elsewhere in the art;
- the combination would involve a change to the principle of operation of any of the elements of the combination;
- the mere fact that documents can be combined does not render the resultant combination reasonable, unless the prior art suggests the desirability of the combination; or
- the disclosures of the prior art do not provide a sufficient basis for a reasonable expectation of success.

Note: These circumstances may require appropriate evidence to substantiate - see 2.13.5 Stringency of Tests During Examination.

Modified Date: 01 December 2016

2.5.2.5A Prior Art Information

Note: The information in this part only applies to standard patent applications with an examination request filed on or after 15 April 2013. For all other standard patent applications, see 2.5.2.5 Could the Person Skilled in the Art be Reasonably Expected to Have Ascertained, Understood, Regarded as Relevant and, Where Applicable, Combined the Prior Art Information?

Under sec 7(3), the prior art information used for an inventive step objection may be either:

a. any single piece of prior art information; or

b. a combination of any 2 or more pieces of prior art information that the skilled person could, before the priority date of the relevant claim, be reasonably expected to have combined.

Examiners should note that the prior art information includes not only documents, but also information publicly available through doing an act (including a prior use).
In considering inventive step, examiners should proceed on the basis that the person skilled in the art is essentially deemed to be aware of and to have carefully read the publicly available information.

Arguments that an inventive step objection should not have been taken because the information relied upon would not have been discovered by the person skilled in the art are not to be accepted. There is no requirement to establish that a skilled person would have found the information. Thus, if the information relied upon was made public anywhere in the world, in any language, at any time before the priority date, it is prima facie available for use.

As was noted by Laddie J in *Pfizer Ltd’s Patent* [2001] FSR 16:

“A real worker in the field may never look at a piece of prior art for example he may never look at the contents of a particular public library or he may be put off because it is in a language he does not know. But the notional addressee is taken to have done so. This is a reflection of part of the policy underlying the law of obviousness. Anything which is obvious over what is available to the public cannot subsequently be the subject of valid patent protection even if, in practice, few would have bothered looking through the prior art or would have found the particular items relied on.”

Where there are multiple pieces of prior art information, each must be considered individually to determine whether the invention is obvious. The fact that the skilled addressee is faced with a choice of documents, the selection of any one of which may or may not lead to the claimed invention, is not important. Provided the invention is obvious in the light of any one of the pieces of prior art information, there will be a lack of inventive step (*AstraZeneca AB v Apotex Pty Ltd* [2015] HCA 30; 89 ALJR 798 at [113]-[115]).

**2.5.2.6 Evidentiary Requirements**

In the decision of *Commissioner of Patents v Emperor Sports Pty Ltd* [2006] FCAFC 26; 67 IPR 488, the requirement for evidentiary proof as to the nature and knowledge of the person skilled in the art was considered:

“In considering who is the appropriate skilled person, and what such person might be reasonably expected to do when faced with the problem in hand, sometimes, indeed often, evidence may not be necessary. In many instances the answers will be obvious to the parties, the Commissioner and the court. In high technology areas for example it will usually be assumed that the relevant skilled person will be familiar with the major professional or academic journals and could reasonably be expected to consult them. No evidence is required.”
In situations where there may be doubt or disagreement, it was noted that:

“...it is necessary to have either evidence or, which amounts to the same thing, reliance by an administrative decision-maker of expertise appropriate to the office.”

and furthermore:

“The Commissioner is an administrative decision-maker equipped with technical expertise. ... he or she is entitled to make use of that expertise, and draw inferences that may be rationally drawn from technical knowledge, including how skilled persons of various descriptions may act in their respective occupations ....”

In these circumstances, the knowledge of the Commissioner is *prima facie* to be relied upon by the Office as evidence as to what the person skilled in the art would do.

2.5.3 Tests for Inventive Step

Modified Date: 03 September 2012

2.5.3.1 Introduction

An objection of lack of inventive step only arises where it can be shown that a person skilled in the art would, in solving the problem, have taken the necessary steps to reach the claimed invention. In practice, this means that examiners will have to demonstrate that the claimed invention is one of:

- a [technical equivalent];
- a [workshop improvement];
- a [special inducement or obvious selection]; or
- an [obvious combination of features of common general knowledge].

Examiners must also be satisfied that the claimed invention does not involve:

- the [prior art teaching away from the solution];
- [practical difficulties overcome in seeking the solution]; or
- [identifying the "real nature" of the problem].

In determining these matters, examiners must:

- consider the prior art information in the context of a person skilled in the art attempting to solve the problem; and
2.5.3.2 Technical Equivalents

If a claim is a mere technical equivalent of the prior art, it will not be inventive.

A technical equivalent occurs when integers of a claim replace one or more features of the prior art, and:

- the characteristics of the replacement are part of the common general knowledge of the person skilled in the art and provide the same functionality in the context of the problem;
- the replacement of the prior art feature would occur at once to the person skilled in the art (Allsop v Bintang 15 IPR 686, (1989) AIPC 90-615; Elconnex Pty Ltd v Gerard Industries Pty Ltd (1993) AIPC 90-984);
- the combination as a whole retains the same functionality in the context of the problem; and
- there are no problems or difficulties to be overcome in making the replacement.

Where there is a choice of technical equivalents, the choice of one over the others is irrelevant - except where there was no special inducement to choose that one and it has a surprising advantage (see 2.5.3.4 Selections and 2.5.3.4 Special Inducements; Obvious Selections).

The substitution of an integer in a combination with a technical equivalent will not give rise to an inventive step unless a new combination results. In Winner & Anor v Ammar Holdings Pty Ltd 25 IPR 273 at page 294, (1993) AIPC 90-971 at page 248 it was stated:
"Notwithstanding that the inventive step may lie in the choice and management of integers in a combination patent (Wellcome Foundation at 281) [Wellcome Foundation Ltd v VR Laboratories (Aust) Pty Ltd (1981) 148 CLR 262], where one starts with a known article or thing and merely substitutes or adds a known device or means to facilitate the better use of the thing, there is a risk of want of inventive step "unless the combination is substantially a new thing" (May v Higgins (1916) 21 CLR 119 at 121; see also Sami S. Svendsen v Independent Products Canada Ltd (1968) 119 CLR 156 at 164-165)."

This was reinforced in Elconnex Pty Ltd v Gerard Industries (1993) AIPC 90-984, at page 39,326 where it was stated:

"this is not a case of a new combination, although of old integers, but of an old combination which has been, at most, subjected to slight variations. The question must be whether those variations are other than obvious."

The test for determining whether a new combination has been made, and hence whether an inventive step exists, is whether the essential character of the device has been changed. Thus in May v Higgins (1916) 21 CLR 119 at page 123.

"It appears to me that it is a mere improvement of one previously existing integer. It is not a new integer giving a better result, nor the substitution of a totally different integer, the presence of which is such as to make the whole machine an essentially different machine, a new unit. It is, I think, at best an improvement upon a prior integer not altering the essential character of the machine."

2.5.3.3 Workshop Improvements

If a claim is a mere workshop improvement over the prior art, it will lack an inventive step.

The expression "workshop improvement" refers to an alteration to an existing device which the person skilled in the art would have come to as a matter of routine, "proceeding along previous lines of inquiry and having regard to what was known or used" (Nicaro Holdings Pty Ltd v Martin Engineering Co 16 IPR 545).

A workshop improvement can occur:

- where the prior art fully solves the identified problem - if the person skilled in the art would readily recognise a practical difficulty in that solution, and that practical
difficulty would be readily overcome by the person skilled in the art appraised of the common general knowledge (however, see 2.5.3.9.2 Practical Difficulties Overcome);

- where the prior art does not provide a solution to the identified problem - if the solution would at once suggest itself to the person skilled in the art (see Fallshaw Holdings Pty Ltd v Flexello Castors and Wheels Plc 26 IPR 565 and Winner v Ammar Holdings Pty Ltd 25 IPR 273); or

- where the prior art solves an analogous problem in a related area of technology, and the person skilled in the art would recognise the same solution could be applied to the problem with there being no practical difficulty in implementing that solution.

**Note:** For standard patent applications with an examination request filed before 15 April 2013, the prior art must be information that the person skilled in the art could be reasonably expected to have ascertained, understood, and regarded as relevant.

It may be difficult to determine when a feature is a "mere workshop improvement" and when it involves an inventive step:

"Nobody, however, has told me, and I do not suppose that anybody ever will tell me, what is the precise characteristics or quality the presence of which distinguishes invention from a workshop improvement."

*Samuel Parkes & Co Ltd v Cocker Brothers Ltd* (1929) 46 RPC 241 at page 248.

In these cases, balance of probabilities considerations apply (see 2.13.5 Stringency of Tests During Examination).

Where:

- there is only one option the person skilled in the art would consider in solving either the identified problem or any subsequent practical difficulty;

- that option would at once suggest itself to the person skilled in the art, e.g. the option is part of the common general knowledge;

- there is no practical difficulty in implementing that option; and

- neither the prior art, nor the common general knowledge, teaches away from the solution;
It may be that in following the one obvious option, a bonus and unforeseen effect is produced. However, the presence of that bonus effect does not in itself give rise to an inventive step, as the person skilled in the art would have inevitably arrived at that solution:

"That which Grace produced might have had some of the desirable qualities of a multi-layer heat shrinkable packaging in a higher degree than might have been expected, or was in fact expected. And it might have demonstrated a better combination of properties, that is to say proving some properties while at least not detracting from others. But at most the end result was a heat shrinkable bag, better not because of any inventive discovery of Grace, but because somebody else's new product, put on the market for uses which included that manufacture, produced better results than expected."

Asahi Kasei Kogyo KK v WR Grace & Co (1992) AIPC 90-847 at page 38,089

This issue will most likely arise at further report stage, where an applicant responds to an inventive step objection on the basis that the invention has a new and surprising effect. However, examiners should be cautious in applying this principle, as the existence of a bonus effect can usually only be established by evidence.

The prior art (in the light of common general knowledge) may suggest to the person skilled in the art a number of possible solutions to the problem. In this event:

"The pursuit of one of a number - perhaps many - obvious lines of research may produce a signal or particularly valuable discovery. In deciding on patentability it would seem to us regrettable, and not in accord with a primary purpose of patent law, to have to rule this out automatically in the name of obviousness."

and:

"There were alternatives which might be tried only to be discarded, but the fact that there were a number of alternatives, cannot, I think, elevate into the head of invention the step taken by Lucas."

*Lucas and Another v Gaedor Ltd and Others [1978] RPC 297* at pages 376 and 377

Where a claimed solution:

- is one of several options that the person skilled in the art would consider in solving either the identified problem or any subsequent practical difficulty;
- the options would at once suggest themselves to the person skilled in the art, e.g. the options are part of the common general knowledge, or clearly indicated in the prior art;
- there is no practical difficulty in implementing the particular solution claimed; and
- neither the prior art, nor the common general knowledge, teaches away from the particular solution;

then an inventive step objection will apply.

In this situation, the claimed solution is said to be *ob via*, or "lying in the way":

"As the latin derivation (obvius, in the way) makes plain something is obvious if it is lying in the way, so that one who takes the ordinary route will be likely to come upon it."

*Elconnex Pty Ltd v Gerard Industries Pty Ltd* 105 ALR 247 at page 262

In *Philips (Bosgra's) Application* [1974] RPC 241 at page 251, the court considered the same issue:

"Nothing ... would be more undesirable than that persons should be stopped ... from using materials which it is also established would lie readily to their hand, and would come to their mind as being likely materials to use. ... I think these (emulsifying) agents were obvious in this sense, indeed in the true sense of the word, that they were lying in the road, that they were there for the research worker to use, and it is quite wrong that he should be stopped from using them."

and noted that the road itself must be one that the research worker would naturally choose to take.
2.5.3.3.4 Selections

Where a claimed solution:

- is one of several possible solutions; and
- there is no special inducement or reason for choosing the claimed solution; and
- there is a surprising and unexpected advantage in the claimed solution

then the solution is not obvious. The person skilled in the art would not have been "directly led to the invention". "Selections" are discussed in 2.4.6.6.1 Selection Criteria (however, note 2.5.3.4 Special Inducements; Obvious Selections).

Modified Date: 01 July 2014

2.5.3.3.5 "Obvious to Try"

The High Court in Aktiebolaget Hassle v Alphapharm Pty Ltd [2002] HCA 59; (2002) 212 CLR 411 endorsed the “Cripps question” approach to obviousness:

"Would the notional research group at the relevant date, in all the circumstances, which include a knowledge of all the relevant prior art and of the facts of the nature and success of chlorpromazine, directly be led as a matter of course to try the -CF₃ substitution in the '2' position in place of the -CI atom in chlorpromazine or in any other body which, apart from the -CF₃ substitution, has the other characteristics of the formula of claim 1, in the expectation that it might well produce a useful alternative to or better drug than chlorpromazine or a body useful for any other purpose?"

This can be simplified to:

Would the person skilled in the art (in all the circumstances) directly be led as a matter of course to try the claimed invention in the expectation that it might well produce a solution to the problem?

This approach is only appropriate when there is a problem to be solved, being either a problem that is recognised in the art or a problem that is reasonably inferred from the specification. Where the invention lies in the identification of the problem, the “obvious to try” approach will not be appropriate.

It should be noted that “obvious to try” is qualified by the requirement that there is a reasonable expectation that the solution might well solve the problem.
When applying this test, examiners need to appreciate that there will often be many possible solutions to a problem. Not all solutions can be regarded as obvious. Some possible solutions will be likely to solve the problem, while others will be highly speculative. The question that needs to be considered is whether there is a reasonable expectation that the solution will solve the problem.

The reasons why there would be a reasonable expectation could be:

- the solution is known in analogous systems;  
- the art is highly predictable; or  
- the prior art teaches that the solution will work, although it has not been confirmed in an example.

The reasons should be provided in support of the objection, e.g.

“The problem relates to identifying compounds with antibacterial activity. The citation teaches that compounds of formula II will have antibacterial activity, although there are no examples confirming this prediction. In light of this disclosure, it would have been obvious to try compounds of formula II in the expectation that they would have antibacterial activity.”

Where there are a number of solutions to a problem, and the claimed solution has advantages over the other solutions, the issue arises of whether the person skilled in the art would have inevitably chosen that solution over the others.

Similarly, where the invention claimed is a selection from a known field, and there are advantages in that selection, examiners must determine whether the person skilled in the art would have inevitably chosen that selection.

Where:

- the person skilled in the art would have adopted the particular solution, or chosen the particular selection, on the basis of a special inducement; and  
- there is no practical difficulty in implementing the particular solution, or in producing the selection, claimed;

the claim lacks an inventive step.
Special inducements occur when:

- the prior art teaches towards the solution;

- when the common general knowledge teaches towards the solution, or teaches away from the other solutions; or

- when the other solutions are impractical.

**Note:** Where there is a special inducement to a single solution, the bonus effect is applicable (see 2.5.3.3.2 Bonus Effect).

Blanco White Patents for Inventions (4th Edition) 1974 at pages 168-169, summarises the general test for an obvious selection based on special inducement as:

"The test of obviousness in such a case may then, it would seem, be put in the following form: *Was it obvious to any skilled chemist, in the state of chemical knowledge existing at the date of the patent, that any substances within the claim would be likely to present a sufficient improvement over those previously made to justify the expenditure (of time and money) needed for their investigation?* If this would not be obvious, then the invention should be patentable if it can be properly claimed."

It is not necessary to establish that success is certain or "clearly predictable", provided the person skilled in the art would be directed to a particular solution and it was clear to the person skilled in the art that it might well produce a solution to the problem - see *Wellcome Foundation Ltd v VR Laboratories (Aust) Pty Ltd* (1981) 148 CLR 262 at 267.

2.5.3.4.1 Examples of Special Inducement

- If there are 2 enantiomers of a compound, the person skilled in the art will recognise that one of the enantiomers will usually have a higher activity than the other. The person skilled in the art **would** be led to test both enantiomers to determine which of the enantiomers is more active. Provided there has been no practical difficulty overcome in separating the enantiomers, an objection of lack of inventive step will apply.

- The claimed invention has a certain concentration of a particular constituent and uses this constituent to maximise an effect. The prior art discloses a lower concentration, but notes that the concentration of this constituent influences that particular effect. If the problem addressed by the claimed invention is to maximise the
Section 7 provides for an objection of lack of inventive step to be based on common general knowledge alone.

Where the claimed invention is directed to a particular combination of features, an objection of lack of inventive step applies if the combination is obvious to the person skilled in the art having regard to the common general knowledge.

The claimed combination must be considered as a whole. It is insufficient to dissect a claimed invention into component integers and establish that these integers are each pieces of common general knowledge. Examiners must also establish that the selection of those integers is obvious to the person skilled in the art in the context of solving the problem:

"The proper question is not whether it would have been obvious to the hypothetical addressee who was presented with an ex post facto selection of prior specifications that elements from them could be combined to produce a new product or process. It is rather whether it would have been obvious to a non-inventive skilled worker in the field to select from a possibly very large range of publications the particular combination subsequently chosen by the opponent in the glare of hindsight and also whether it would have been obvious to that worker to select the particular combination of integers from those selected publications. In the case of a combination patent the invention will lie in the selection of integers, a process which will necessarily involve rejection of other possible integers. The prior existence of publications revealing those integers, as separate items, and other possible integers does not of itself make an alleged invention obvious. It is the selection of the integers out of, perhaps many possibilities, which must be shown to be obvious. ... The opening of a safe is easy when the combination has been already provided."

*Minnesota Mining and Manufacturing Co v Beiersdorf (Australia) Limited (1980) 144 CLR 253* at page 293.
2.5.3.6 Invention in Identifying the "Real Nature" of the Problem

An inventive step can arise where:

- a problem was known
- the cause of that problem was unknown at the priority date; and
- the inventor has identified the cause of the problem - the "real nature" of the problem.

In this situation:

"the perception of the true nature of the problem was the inventive step which, once taken, revealed that straightforward experiments will provide the solution."


Thus, if an inventive step lies in the identification of the true nature of the problem, it is irrelevant whether there is any subsequent inventive step in providing a solution to the problem.

Where the invention lies in identifying the true nature of the problem, this must be clear from the specification, either by assertion or by clear inference:

"However, in the present case there is no suggestion in the specification itself that discovery of the problem involved an inventive step."

_Winner & Anor v Ammar Holdings Pty Ltd 24 IPR 137_ at page 141.

In response to an objection of lack of inventive step, an applicant may amend the specification to assert that the invention resides in identifying the true nature of the problem. Such amendments must meet the normal allowability requirements.

However, it cannot be said that the invention lies in identifying the real nature of the problem if the nature of the problem is obvious:

"In my view it is sufficient if the workman or user of the article would as a matter of observation and use himself or herself recognise the defect which it is alleged the invention overcomes to call in question the issue of obviousness."

_Winner & Anor v Ammar Holdings Pty Ltd 25 IPR 273_ at page 295.

**Note:** This will usually require evidence that the prior art was "used"; it cannot arise if the prior art is a mere paper anticipation.
If the prior art addresses or discusses the same problem, and identifies its true nature, any argument that an inventive step resides in identifying the true nature of the problem must fail.

If the prior art solves the problem, but has not recognised its true nature:

- the same solution will result in a novelty objection; otherwise
- a different solution will involve an inventive step.

### 2.5.3.7 Invention in the Idea

In order to be patentable, an idea, in addition to having some means of carrying it out, must involve invention. In Hickton's Patent Syndicate v Patents and Machine Improvements Co. Ltd. (1909) 26 RPC 339 it was stated:

".....invention may lie in the idea, and it may lie in the way in which it is carried out, and it may lie in the combination of the two...."

Some generalised ideas or desiderata are inherently uninventive. Examples of such ideas are automatic operation, convenient arrangement of one's work, an increase in efficiency or combining a number of items in one piece - see Pierre Treand's Application (1961) AOJP 2164.

### 2.5.3.8 Invention in the Purpose

"It is not permissible to claim an article which as an article, requires no inventive ingenuity merely because, if used in a particular way, it will be useful in achieving a particular purpose."

*Mullard Radio Valve Co. Ltd. V. British Belmont Radio Ltd. and Juveler (1939) 56 RPC 1* at page 15.

### 2.5.3.9 Sub-Tests of Inventive Step
2.5.3.9 Sub-Tests of Inventive Step

There are a number of sub-tests to assist in determining whether an inventive step objection should be taken. These sub-tests will most likely arise at further report stage when considering whether an objection should be maintained.

The sub-tests are:

- **2.5.3.9.1 Prior Art, or Common General Knowledge, Teaches Away From the Solution**
- **2.5.3.9.2 Practical Difficulties Overcome**
- **2.5.3.9.3 Enabling Disclosures**

2.5.3.9.1 Prior Art, or Common General Knowledge, Teaches Away From the Solution

Where the prior art, or the common general knowledge, teaches away from the claimed solution, the claims will have an inventive step.

However, this will not be the case where the teaching of the prior art is based on an issue which the person skilled in the art would readily:

- recognise as being erroneous; and
- be able to correct.

In such cases, examiners must consider the prior art on the basis of the "corrected" disclosure.

2.5.3.9.2 Practical Difficulties Overcome
There may be situations where the solution is an obvious path to follow, however there were practical difficulties in putting that solution into effect which required inventive ingenuity to overcome. Thus:

"If the evidence establishes that (1) anyone skilled in the relevant art would have recognised that their combination ... would be worth trying[*] and that (2) any problems of design attending their satisfactory combination ... would be easily solved by anyone skilled in the art, then, in my judgement, the combination must be held to have been obvious."

_Tetra Molectric Ltd v Japan Imports Ltd [1976] RPC 541_ at page 581

**Note:** *Following the High Court in _Aktiebolaget Hassle v Alphapharm Pty Ltd_ [2002] HCA 59; (2002) 212 CLR 411 “worth trying” is no longer a valid test for obviousness - see 2.5.3.4 Special Inducements; Obvious Selections.*

In most situations, examiners will be unable to determine whether there were any difficulties implementing the solution, unless the specification discusses them explicitly.

However, at first report examiners should assume that there were no practical difficulties in implementing the solution and raise an inventive step objection if the claimed invention is otherwise obvious. Submissions that there were practical difficulties overcome in implementing the solution are to be assessed on their merit. Examiners are to apply balance of probability considerations when this issue is raised (see 2.13.5.2 Balance of Probabilities).

For inventive step considerations, a document must be construed as at the priority date of the claim in question, i.e. in some situations it may be construed having regard to common general knowledge which was unavailable at its publication date (unlike novelty considerations). Thus a document that was non-enabling for novelty may become enabling in the light of the subsequent common general knowledge, thereby forming the basis of an inventive step objection.

The test for enablement relies on the principles of sufficiency which are summarised by McTiernan J:
"Specifications very frequently contain mistakes; they also have omissions. But if a man skilled in the art can easily rectify the mistakes and can readily supply the omissions, the patent will not be held to be invalid."

**AMP v Utilux (1971) 45 ALJR 123** at page 128:

If a document provides sufficient instructions for the person skilled in the art to produce the solution without inventive ingenuity, it will be enabling.

It may be difficult to distinguish between a disclosure which requires inventive ingenuity to put the solution into effect and one which only requires uninventive "trial and error":

"Any technician, therefore, faced with this problem would experiment, as a matter of workshop adjustment, with various settings in order to test which produced the best results. ..... It seems to me, however ... that this is simply the result of taking the obvious course of trial and error and that the taking of that course cannot properly be described as an inventive step."


and:

"... it is apparent that the demarcation of the borderline between trial and error in the ordinary course of the work of an addressee and the type of experiments which rank as being inventive is on occasion very difficult."

**General Tire & Rubber Company v Firestone Tyre and Rubber Company Ltd [1972] RPC 457** at page 504.

Examiners are to apply balance of probability considerations when this issue is raised (see 2.13.5.2 Balance of Probabilities).

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There are a number of useful tests which indicate the presence of an inventive step. All of these rely upon establishing that there was a prior perceived need for the invention:

"Unless it is apparent that there was a perceived need for a product, the fact that it was not previously produced does not belie its obviousness. Imitation is not necessarily an indication of perceived need."
These tests are relevant to identifying the existence of a prior perceived problem, which would have been previously solved if the solution was truly obvious. However the tests are not necessarily conclusive proof of a prior perceived problem, especially when taken in isolation. Thus, as was stated in *Elconnex Pty Ltd v Gerard Industries Pty Ltd* (1992) AIPC 90-848 at page 38,107:

"As Buckley L.J. said ... in *Tetra Moelectric Ltd v Japan Imports Ltd* [1976] RPC 541 at 583:

'Failure to recognise an obvious solution to a mechanical or other technical problem may result from a variety of causes. The existence of the problem may not be recognised, or there may be no pressing commercial need for a solution of it, or other solutions may be given preferential consideration. The evidence indicates that for many years flint ignition for smokers' lighters satisfied the commercial need.' [the case involved a patent substituting piezo-electricity]

It was not suggested, in the present case, that the respondent, or anyone else, was in fact researching methods [relating to the invention] at any time prior to its learning of the Elconnex connector."

Finally:

"Although those matters are of importance in the resolution of the problem, they are not conclusive of what the outcome of the case should be. In a case of doubt the existence of a long felt want and immediate imitation might well persuade a court grappling with the problem of whether there was an invention to the inventor's point of view. But in the end one has to come to the question whether or not the claimed invention is obvious."


These tests will likely only arise at further report. Examiners are to consider arguments based on these tests on their merits and should apply balance of probability considerations (see 2.13.5.2 Balance of Probabilities).
2.5.3.10.2 Failure of Others

"... the question of obviousness is probably best tested, if this be possible, by the guidance given by contemporaneous events. ... If an invention has resulted in the solution of a problem which has been troubling industry for years and achieves immediate success upon its introduction, then the suggestion after the event that the step was obvious inevitably rings a little hollow."

*Lucas and Another v Gaedor Ltd and Others* [1978] RPC 297 at page 358.

If other inventors have tried to solve a problem and were not successful, a claim will likely involve an inventive step:

"...when I find that the person who has made the invention, himself being a person skilled in the art, has had to take time and make experiments before he arrived at the solution that it is a solution which has apparently been sought for many years by various persons and has not been arrived at ... then I think in the light of that evidence the prima facie view which one might take ... and I do in this case come to the conclusion, that on the whole there is sufficient here to support the patent."

*Howaldt Ld v Condrup Ld* (1937) 54 RPC 121 at page 133.

and:

"Dozens of inventors, and no doubt others as well, had tried and failed to find a satisfactory solution. It is not credible that this should have happened if the problem only needed workshop experiments to solve it."


2.5.3.10.3 Complexity of Work

If the work undertaken by an inventor in order to produce an invention was particularly complex, and not readily carried out, this is an indication that it was not a matter of routine. In such cases the invention would not be obvious.
"The tracing of a course of action which was complex and detailed, as well as laborious, with a good deal of trial and error, with dead ends and the retracing of steps is not the taking of routine steps to which the hypothetical formulator was taken as a matter of course."


This is different to cases of "mere verification", where an inventor merely follows the teaching of the prior art (even if that teaching is complex) to achieve the expected result. In this regard, note *Sharp & Dohme Inc v Boots Pure Drug Co Ltd (1928) 45 RPC 153* at 192.

If a line of development has not been favoured by those in the art, the age of the prior art may give a distorted picture of what is obvious:

"This may act as commercial constraint which will reduce his willingness to embark on certain lines of development. Indeed the cost of retooing may be such that he will not consider the rewards which would flow from the improved product would justify the change. These purely commercial considerations are likely to affect the direction, if any, in which the established manufacturer may go. However they give a distorted picture of what, from a technical and patent point of view, is obvious. As I have said, a new entrant into the trade may well have different commercial constraints. The court has to be alert to the difference between commercial attractiveness and technical obviousness. They are not always the same."

And later, on the age of prior art:

"It is only when the answer to the question "why was this not developed earlier" is "a likely and reasonable answer is that people looking for a way around an existing problem did not see this as part of the answer" that the age of the prior art should play a part in meeting an obviousness attack. If it was likely that in the real world no one was looking for an answer the fact that none was found says nothing about whether the answer proposed in the patent under attack was obvious."

*Brugger & Ors v Medic-Aid Ltd [1996] RPC 635* at page 653-655
2.5.3.10.5 Copying of Invention in Preference to Prior Art

Copying of the invention in preference to the prior art is indicative of an inventive step:

"when once it has been found ... that the problem had waited solution for many years, and that the device is in fact novel and superior to what had gone before, and has been widely used, and used in preference to alternative devices, it is ... practically impossible to say that there is not present that scintilla of invention necessary to support the Patent .... No evidence is more cogent of the success of the invention than that the defendants simply copied it and made profits by making and selling the products."

Samuel Parkes & Co Ltd v Cocker Brothers Ltd (1929) 46 RPC 241 at page 248

and:

"The fact that some of the defendant companies purchased large quantities ... of the plaintiff's windows and subsequently manufactured themselves an article which can only be described as a copy in all material respects, demonstrates the existence of the kind of public need which is relevant to the question of obviousness."

Meyers Taylor Pty Ltd v Vicarr Industries Ltd (1977) CLR 228 at page 239

2.5.3.10.6 Commercial Success

Commercial success is indicative (but not conclusive) of an inventive step:

"Commercial success can never of itself be decisive of inventiveness but it is a material matter, the weight of which must be determined by reference to all the surrounding circumstances."

Meyers Taylor Pty Ltd v Vicarr Industries Ltd (1977) CLR 228 at page 239.

and:

"Commercial success is, of course, not of itself conclusive on an issue of obviousness, but it has been treated in case after case as a valuable weight in favour of the patent."
2.5.4.1.1 Problem in Compound per se Claims

Where a claim is directed to compounds per se, the problem addressed by the specification will usually be "to provide compounds suitable for a specific use". The "use" in question could be the biological activity of the compounds or use as intermediates in the synthesis of other compounds.


2.5.4.1.2 Anticipation by Generic Disclosures

There is no invention in mere verification of a result suggested by the prior art. For example, if the prior art indicates that certain compounds can be made by a particular reaction and suggests that other compounds could also be made by the same process, it is not inventive to verify that result (Sharp & Dohme Inc v Boots Pure Drug Co Ltd (1928) 45 RPC 153 at 192).

Where a compound is within the scope of an earlier generic disclosure in a document, the objection of lack of inventive step should be considered separately to the issue of novelty. If the compounds within the generic disclosure are alleged to solve the problem, then *prima facie* there will be a lack of inventive step.

A generic structural formula represents all the specific structural formulae encompassed by the generic formula. This can be described as the intellectual content of the generic formula. The compounds that are within the intellectual content of a document are clearly put forward as possessing the same properties as the compounds within the technical content. In the absence of selection or the lack of an enabling disclosure, it is immediately obvious that the compounds of the intellectual content would be expected to have the same properties as the
compounds within the technical content and there is no inventive step in merely preparing those compounds in the manner suggested and verifying their properties.


Where the document does not disclose the particular property or use of the compounds that is relevant to the problem, then it probably does not solve the problem.


If the particular compounds cannot be prepared by the prior art method, or there is no method of preparation given, then there will be an inventive step in preparing the compounds.

Where a racemic mixture is known for a specific use and the problem is to find a compound having that property in an enhanced level, or the same property with less side-effects, the question inevitably arises whether one of the isomers in isolation is an obvious solution. It is reasonable to presume that it is common general knowledge that one isomer is often more active than the other, although this is not invariably the case. The single isomer will be an obvious solution if it would have been a matter of routine to prepare the single isomer and test its activity.

If the isomer is prepared by routine separation techniques, the single isomer will be an obvious solution. This is true even if it was not obvious beforehand which of the isomers would be more active.

See Rhone-Poulenc Rorer S.A.’s Application [1995] APO 50.

2.6 Applicants and Nominated Persons, Patent Requests, Entitlement

Modified Date: 03 August 2015

2.6 Applicants and Nominated Persons, Patent Requests, Entitlement

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Effective Date: 25 September 2019
General Points:

- Under reg 3.1A, the applicant is taken to be the nominated person. If the applicant at filing is not an entitled person (including if another person is specified as the nominated person) then the name of the applicant must be amended before acceptance and grant.

- For standard patent applications with an examination request filed before 15 April 2013, a notice of entitlement under reg 3.1(2)(a) and reg 3.1(2)(b) is required to be filed before acceptance.

- For standard patent applications with an examination request filed on or after 15 April 2013, a statement of entitlement must be provided as part of the request for examination.

2.6.1 Applicants and Nominated Persons

Modified Date: 03 August 2015

2.6.1 Applicants and Nominated Persons

Any person may apply for a patent, wherein “person” includes a body of persons, whether incorporated or not (sec 29). The applicant is taken to be the nominated person for the grant of the patent (reg 3.1A).

2.6.1.1 Who May be Granted a Patent?

In this topic:

The applicant is taken to be the nominated person for the grant of the patent (reg 3.1A). Whilst any person, legal or otherwise, may apply for a patent, only certain persons may be granted a patent (sec 15). Consequently, at acceptance, the applicant must be a person eligible to be granted a patent.
2.6.1.1 Who May be Granted a Patent?

The word "person" in sec 15 means a legal person and includes a body politic (e.g. Commonwealth of Australia, French Republic) and a body corporate (e.g. a company incorporated under the laws of the State of Victoria), as well as a natural person (sec 2C of the Acts Interpretation Act 1901).

If an applicant dies before a patent is granted, the applicant's legal representative may proceed with the application (see 2.6.1.3 Death of Applicant).

**Note:** A patent is not invalid merely because it was granted to a person who is not entitled or not granted to a person who is entitled (sec 22A).

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### Legal Persons

An objection should not be taken that a person is not a legal person, except in the clearest of cases. A non-exhaustive list of some types of legal persons is given in 2.6 Annex A – Examples of Legal Persons.

Historically, the status of some bodies has been held to be legally uncertain. These are foreign bodies whose status under their particular domestic law is not strictly comparable with that of Australian companies, but which under the laws of the foreign country in question:

- can acquire title to land and property in their own name and that title is unaffected by changes in the membership of the foreign body;
- a judgement against them cannot be enforced against their members, nor can a judgement against a member be enforced against the foreign bodies; and
- a conveyance is required for a transfer of property from them to one of their members.

No objection should be taken in relation to the status of such bodies as legal persons. A non-exhaustive list of some types of these bodies is given in 2.6 Annex B - Examples of Organisations of Uncertain Status as Legal Persons.

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### Trusts, Firms and Partnerships
2.6.1.1 Who May be Granted a Patent?

Trusts are not a legal person and therefore cannot be granted a patent. A trust can usually be identified by a name, e.g. "The AB Family Trust". However, companies may have the word "Trust" or "Trustee" as a part of their name, e.g. Perpetual Trustee Australia Ltd. This does not detract from their status as a legal person. Where there is doubt as to whether a person is a trust, the matter should be discussed with a supervising examiner prior to taking any objection.

Where the applicant is stated to be the trustee of another person, e.g. “X as a trustee for Y”, COG will record this information without reference to the “as a trustee for Y”, as there is no provision for a person to qualify their entitlement to a patent. This will usually be done at filing or national phase entry. Where the applicant information has not been corrected, examiners should contact COG.

Firms, partnerships and business names are also not legal persons and therefore cannot be granted a patent. These bodies are usually identified by the absence of the words Co. or Pty Ltd in their name, e.g. Davies & Collison. A partnership can also be indicated by the qualification "trading as", e.g. A and B, trading as C. (In this regard, see R v The Commissioner of Patents; Ex parte Weiss 61 CLR 240 at 251).

Any uncertainties as to the status of a trust, firm or partnership as a legal person can be resolved by recording as the applicant the trustee of the trust (without reference to the trust), or the personal names of the partners of the firm or partnership (without reference to the name of the firm or partnership).

A body corporate in liquidation may be granted a patent. The liquidator is empowered to do anything required or permitted by the Act in the name of and on behalf of the body corporate, but the property still remains in the name of company until distributed to creditors.

Persons Under Regulation 22.17

An application for a patent may be made, and a patent granted, in the name of an incapable person, i.e. a person who by reason of infancy, or physical or mental disability, is incapable of doing anything required or permitted by the Act (reg 22.17).

Thus, an infant or minor (i.e. a person under the age of 18 years) may apply for and be granted a patent. Under the Act, there is no prohibition on the granting of a patent to an infant or minor, and at common law an infant or minor has always been capable of owning personal property, personal chattels and (in Australia) real property. Moreover, it appears accepted that a child can own intellectual property (see re D'Angibou, Andrews v Andrews (1880) 15 Ch D 228 and Chaplin v Lesley Frewin (publishers) Ltd (1966) Ch 71).
Furthermore, an infant or child is able to assign the rights in intellectual property, provided the assignment is not required by way of deed, as appears to be the case under the Act. If a deed is required, then the infant or child would most likely be unable to make the assignment, as the disposition is probably voidable by him or her when he or she comes of age. Although the Act provides for a scheme of registration of patents and the issue of a patent deed from the Commissioner, once registration has occurred (be it the grant of a patent or an assignment), there would be no power on the part of the Commissioner to transfer the issue back in the absence of an order of an appropriate court.

Co-Ownership

Two or more bodies corporate may be nominated jointly and be granted a patent in the same way as two or more individuals. The restrictions applicable to a firm also apply when all or some of the partners of the firm are bodies corporate.

2.6.1.2 Address of Applicant

The last filed address for the applicant will be recorded at acceptance by COG as the current address, thereby appearing in the Register and the certificate of grant.

2.6.1.3 Death of Applicant

Where an applicant dies before a patent is granted, the patent may be granted to that person's legal representative (sec 15(1)(d)). In this situation, evidence setting out the right of the legal representative to the patent must be filed. Examiners should also consider the definition of "legal representative" in schedule 1.

If the applicant dies before a patent is granted (or if a body corporate ceases to exist), the application may proceed in the original name until, or even beyond, grant. In either case, the provisions of sec 215 apply. A person with legal rights to the patent may then have his or her
2.6.2.1 The Request

name substituted for that of the deceased patentee after providing suitable evidence. The same principle applies when one of a number of applicants dies intestate.

2.6.2 Patent Requests

2.6.2.1 The Request

Mandatory elements of a patent request include the name and address of the applicant, an address for service and the names of the actual inventors. Whilst the applicant may be any person, reg 3.1A provides that the applicant is taken to be the nominated person in respect of the application (see 2.6.1.1 Who May be Granted a Patent?)

Whilst a patent request must be in the approved form, in practice this does not mean that applicants must use the forms available from the Office. Provided the relevant information can be ascertained from the correspondence, the request will be regarded as having met the necessary requirements.

For national phase applications it is usually not necessary to file a separate patent request, as the front page of the PCT pamphlet (as amended or substituted, if appropriate) provides the required information (see 2.20.3.1 Patent Request Form).

2.6.2.2 Amendment of a Request

A patent request may be amended in certain circumstances. For further information see in particular the following:

- 2.23.13.1 Amendment of Patent Request
- 2.10.10 Amendment of Patent Request – Conversion of Application to a Divisional
- 2.6.4 Changing the Applicant or Nominated Person

(amending the name of the applicant or nominated person under sec 104 or sec 113).
2.6.2.3 Name of the Applicant and Inventor

In this topic:

The name(s) of the applicant and inventor must appear on the patent request. The name of the applicant appearing on the request is the name that will ultimately appear on the certificate of grant. Transliterations from other alphabets are required.

The name of the nominated person may also appear on the patent request. However, where the name of the nominated person differs from the name of the applicant, this is of no effect as the applicant is taken to be the nominated person (reg 3.1A).

Examination Practice

Examiners are not expected to routinely check that the names of applicants and inventors are consistently stated throughout the documents on file. However, if examiners become aware of a significant difference, such that the names could not be that of the same person, an objection should be taken that it is not clear who is the applicant/inventor (as the case may be). Where there are conflicting statements, the applicant/inventor of record is that which is indicated on the patent request.

Where no inventor names are provided and the defect has not been raised by COG during formalities checking, examiners should object that the entitlement of the applicant to the grant of the patent is not clear.

Company Numbers

Australian law requires companies and other entities to quote their Australian Company Number (A.C.N.), Australian Registered Body Number (A.R.B.N.) and/or Australian Business Number (A.B.N.) on various documents. The Commissioner does not have any responsibility to check for the inclusion, authenticity or accuracy of any such numbers that may be provided on the patent request (or other documents relating to prosecuting a patent.
2.6.2.4 Address for Correspondence

Applicants must indicate an address for service (see 2.6.2.5 Address for Service) on the patent request. They may provide a different address for correspondence, however there is no legislative requirement to do so. The purpose of an address for correspondence is to provide an address to which all correspondence from the Commissioner can be sent and it need not be located in Australia. Where no address for correspondence is provided, all correspondence will be sent to the address for service.

In certain situations, an applicant may in communication indicate an address for correspondence that differs from that on record, without formally advising of any change. During examination, if it is noticed that the conflicting addresses have not been queried by COG, examiners should draw attention to the apparent inconsistency and request clarification from the applicant. The report should be sent to the address appearing in the most recent item of correspondence.

Subject to the above, examination reports are to be addressed and sent to the address provided by the applicant. All applications in PAMS will have an indication of the address listed in the ‘Agent Details’ screen.

2.6.2.5 Address for Service

Many approved forms (including the patent request) require an applicant or other person to provide an address for service (reg 22.10). The address must be:

- an address in Australia where documents under the Act or Regulations may be given to or served on the applicant/person personally, or on a person specified in the form. In the case of most foreign and many local applicants, the stated address is that of a patent attorney; or

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• another address in Australia where it is practicable and reasonable for Australia Post, or a person acting on behalf of Australia Post, to deliver mail. The address may be a post-office box, locked bag or postal delivery point to which a contractor of Australia Post routinely delivers mail; or

• an address in New Zealand where it is practicable and reasonable for a person providing mail delivery services to deliver mail.

Applicants have the option of providing a different address for correspondence, however there is no legislative requirement to do so (see 2.6.2.4 Address for Correspondence).

Failure to provide an address for service will normally be handled by COG during formalities checking. However, if during examination it is noted that an address for service in Australia or New Zealand has not been provided, examiners are to raise an objection requiring that one be provided, and noting that failure to do so will ultimately result in refusal of the application (see [PERP code B20]).

The applicant may change the address for service at any time by filing a notice under the provisions of reg 22.10(2). A request under sec 104 is not required. However, a change of address of the applicant requires a request under sec 104.

Where a notice under reg 22.10(2) is received, COG will record the new details in PAMS. However, if examiners notice during examination that this has not been actioned, COG should be informed.

2.6.2.6 Details of Related Applications

A complete application can only be associated with a provisional application(s) if the patent request identifies the provisional application and indicates that it is associated with the complete application. The filing date of the provisional application is also required.

For details of related applications required for divisional applications, patents of addition and Convention applications see:

• 2.10 Divisional Applications;

• 2.19 Patents of Addition; and

• 2.21 Convention Applications.
2.6.3 Entitlement

Modified Date: 01 August 2018

2.6.3.1 Notices of Entitlement

In this topic:

A patent may only be granted to the inventor or a person who derives entitlement to the invention from the inventor (sec 15). The applicant for a patent is taken to be a person claiming entitlement, i.e. the nominated person (reg 3.1A). Consequently, unless there is contrary evidence, the Commissioner will grant a patent to the applicant, however requires them to file an explicit statement or notice asserting their entitlement.

The Commissioner also requires a notice of entitlement to be filed in other circumstances, including claiming priority from another application.

For innovation patent applications, statements of entitlement must be included in the patent request.

Requirements

For standard patent applications, a notice (statement) of entitlement to grant and, if appropriate, to claim priority, must be included in the request for examination.

A notice of entitlement can be in a generic form. For example, the requirement is satisfied by a notice in the form:

“I/We, state that the applicant (or each joint applicant) is an actual inventor, or derives title to the invention from an actual inventor(s), or would, on the grant of the patent, be entitled to have the patent assigned to them.

The applicant (or each joint applicant) is an applicant of the application(s) (if any) listed in the patent request or in an applicable declaration under Article 8 of the PCT; or has entitlement from an applicant of the listed application(s), including entitlement to make a request under Section 113 in relation to any original or associated provisional application.”

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2.6.3.1 Notices of Entitlement

It may also be made using the entitlement form available on the IP Australia website.

Where the application is a national phase PCT application and the applicant has made the necessary declaration(s) under Rule 4.17, this meets the requirements for filing a notice of entitlement (see 2.20.3.2 Entitlement).

COG will check for compliance and take any appropriate action. This can include treating the request as not having been filed or directing that the request be rectified. COG will not object where the request indicates that a valid notice of entitlement is already on file or PCT Rule 4.17(ii) and (iii) declarations have been made.

**Note:** Prior to 15 April 2013 there was a requirement for standard patent applications to file a notice of entitlement to grant (reg 3.1(2)(a)) or to claim priority (reg 3.1(2)(b)) before acceptance. In rare circumstances an application filed before this date may have a notice of entitlement on file, in addition to a statement included with the request for examination. Under such circumstances an objection is only required if the facts recorded on the notice of entitlement and on the statement of entitlement do not agree, or are inconsistent with those derived from other documents on file.

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**No Notice on File at Examination**

Where, during examination, it is apparent that a notice of entitlement has not been provided, an objection should be taken. However, no objection applies where the applicant has made the necessary declaration(s) under Rule 4.17 for a PCT application or a statement of entitlement is implicit from the documents on file, for example, where the inventor is also the applicant.

Examiners are to object to the lack of a notice of entitlement, even if this is the only outstanding issue. An objection should also be raised where a notice of entitlement has been provided, but the facts stated in the notice are inconsistent with those derived from other documents on file.

Where a notice of entitlement is filed subsequent to issuing a first report, examiners should issue a further report even if other amendments have not yet been proposed. If the notice provides the required information and does not give rise to any objections, the further report may simply state that a notice of entitlement has now been filed, however the objections raised in the earlier report are still outstanding. If the notice gives rise to additional objections, these should be added to the objections maintained from the previous report.
2.6.3.1 Notices of Entitlement

Where there is no notice of entitlement on the file, but the applicant/attorney has indicated that one has been filed, the applicant/attorney should be requested to either provide a new notice or a copy of the original.

**Note:** Where a notice or statement of entitlement is not filed as a separate document, but is included in other correspondence, e.g. as a statement in the attorney’s correspondence, this satisfies the requirements for establishing entitlement.

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**Requirement for New Notice of Entitlement**

The applicant may provide a new or amended notice of entitlement at any time up to acceptance and must provide a new notice where facts material to the entitlement of the applicant change, for example, where a new claim to priority is added.

Where amendments involve a change of the applicant, a new notice must be provided, unless the change is supported by evidence of entitlement (e.g. a change under sec 113). For further information on changing the applicant and whether a new notice is required see 2.6.4 Changing the Applicant or Nominated Person.

The new notice is taken to correctly reflect the circumstances at the time the notice was made. If the new notice is inconsistent with facts apparent from the documents on file or otherwise known to examiners, an objection should be raised that the applicant's entitlement is not clear.

Where an application has been accepted with a notice of entitlement containing facts which are subsequently stated by the applicant or patentee to be incorrect, a notice of entitlement setting out the correct facts may be submitted. The amendment should be accompanied by evidence to establish that an error existed in the original notice, how the error was made, and what are the correct facts. In this situation, the matter is to be referred to the Assistant General Manager (OEP).

Otherwise, a notice of entitlement filed after acceptance will be placed on file and will not be examined by the Commissioner.

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**Special Considerations**

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Regulations 3.1(2)(c) to (g) provide for certain other documents to be filed before acceptance, including a notice and other documents concerning the deposit of a micro-organism, orders and declarations under sec 34 and sec 36, and authorisation to apply for a patent of addition. These requirements may be met in a further notice, e.g. provided using the entitlement form available on the IP Australia website, filed before acceptance or all required notices may be combined. A notice may also include a statement required for another provision of the Act or Regulations, for example, a statement that the applicant of a divisional application is entitled under sec 113 to apply. For further information see:

- 2.7 Micro-Organisms and Other Life Forms;
- 2.10 Divisional Applications;
- 2.19 Patents of Addition; and
- 2.21 Convention Applications.

A notice of entitlement must be clearly associated with the relevant application, for example, by the applicant including the relevant application number (if known) on the notice. However, examiners should not object merely because a notice does not include the application number, since a link between the notice and the relevant application may be otherwise apparent, such as from the notice itself, from documents filed with the notice or from other documents on file.

If the notice is filed with an application, the mere association of the notice with the application documents is sufficient to identify the notice with the application and examiners should not object to the absence of an application number in these circumstances.

The notice is made by the applicant, a person authorised by the applicant or the patent attorney of the applicant.
2.6.3.4 Statements of Devolution

In the case of joint applicants, one applicant may make the notice on behalf of the others, or the applicants may make a joint notice or separate notices.

Where the notice is made by a person authorised by the applicant, examiners should not question the validity of the authorisation.

The notice of entitlement need not be signed and dated by the person who makes the notice. The existence and proper execution of a signature on the notice is not a material particular, but is rather a matter of form, and therefore does not give rise to any objection (see 2.29.10 Signature Requirements for Received Documents). The same applies to the dating of the notice of entitlement.

2.6.3.5 Section 15(1)(b) - Service Agreements

Subsection 15(1)(b) is intended primarily to cover service agreements under which employers may be entitled to have the rights to inventions made by employees assigned to them.

The notice need not specifically mention sec 15(1)(b), nor use its precise wording. A statement to the effect that:
"the applicant would, on the grant of the patent, be entitled to have the patent assigned to them."

will suffice.

The following statements are also acceptable:

- "The inventors are employees of the nominated person and the invention was made in the course of their normal duties."

- "The nominated person is an employer of the inventors and the invention belongs to the former by virtue of sec 39 of the United Kingdom Patents Act 1977."

Note: Section 39 of the 1977 UK Act specifies the circumstances under UK law that must exist for an employer to derive entitlement to an invention made by an employee. Where such circumstances exist, they would entitle the employer to the grant of a patent in Australia.

Where the applicant specifies that entitlement is by virtue of sec 15(1)(b), examiners need not ask for any further information or require documentary evidence in support.

In applications made by the C.S.I.R.O., a reference to sec 54(1) of the Science and Industry Research Act (1949) is acceptable as evidence of an entitlement under sec 15(1)(b).

2.6.4 Changing the Applicant or Nominated Person

Modified Date: 01 August 2018

2.6.4.1 General Considerations

In this topic:

Note: Under reg 3.1A, the applicant is taken to be the nominated person. Therefore, any amendment to make the nominated person different from the applicant is of no effect, as it will not change the nominated person. Applicants should be advised of this fact. Conversely, any amendment to the applicant will result in a change to the nominated person.
2.6.4.1 General Considerations

General

The applicant is as indicated in the patent request, notwithstanding any contrary indication in
other documents on file (see 2.6.2.3 Name of the Applicant and Inventor), and may be
changed under sec 104 or sec 113.

A sec 104 amendment can only be requested by the applicant, i.e. the person currently
recorded as the applicant on the patent request. Where there are joint applicants, every
applicant must make the request for amendment. If a request under sec 104 is made by any
person other than the applicant, whether or not it is made jointly with an applicant, it has no
legal standing.

A sec 113 request can only be made by a person who has become entitled to the patent or
an interest therein, or an undivided share or an interest therein, i.e. in most circumstances, a
person other than the applicant(s) recorded on the patent request.

Where a change of applicant occurs as a result of a merger, appropriate amendment of the
applicant may be made under sec 104 or sec 113.

Divisional Applications

Where a divisional application is filed in a name other than that of the applicant of the parent
application, that name may be amended under sec 104 or sec 113 in response to an
examiner's objection.

Similarly, where an application is made by joint inventors, and the matter invented by one or
more inventors is divided out from that application and made the subject of a divisional
application, the name of the applicant in the parent application may be amended under sec
104 or sec 113 (see also 2.23.13.1 Amendment of Patent Request).

Entitlement

The notice of entitlement refers to the person recorded as the applicant at the time the notice
is filed. If the applicant is changed after the notice has been filed, a new notice of entitlement
2.6.4.2 Section 113 Amendments (Assignment, Agreement or Operation of Law)

An amendment that has the effect of changing the applicant and which is requested by the new applicant must proceed under sec 113. The request must be accompanied by documents which establish the facts alleged in the request. Note that the effect of sec 113 is to record the person making the request as the applicant (or joint applicant as the case may be). Therefore, a request under sec 113 can only proceed if the evidence demonstrates that the person making the request is an eligible person.

The general assumption is that where a request is made under sec 113, the new applicant is aware of, and accepts responsibility for, any actions initiated by the original applicant in connection with the application for a patent. Accordingly, any applications or requests made by the original applicant before the date of the Commissioner's direction under sec 113(1), will continue to be processed as if they had been made in the name of the new applicant, except where discontinuation of such action has been specifically requested.

Following a Commissioner's direction under sec 113, all future actions, requests and applications must be made in the name of the new applicant.

Rule 92bis Name Changes

An amendment of the name of the applicant which occurs under the provisions of Rule 92bis of the PCT will be recognised without any further action by the applicant. Rule 92bis name changes are processed by COG.
Joint Applicants

In the case of joint patent applicants, there is no statutory requirement under sec 113(1) for one co-applicant to obtain consent of the other co-applicant(s) when assigning their part interest in an application (in contrast to recording a part-assignment of a patent under sec 16). Therefore, the Commissioner will generally not require a co-applicant's consent to an assignment under sec 113. Any issue that arises as to the progressing of the application may be resolved if necessary under sec 32 (see Commonwealth Scientific and Industrial Research Organisation v Hazlewood et ors 31 IPR 67).

Processing of Request

Requests under sec 113 are processed by COG. If a request is received during examination, or consideration under sec 50, examiners should refer the case to COG for appropriate action. However, where the period for acceptance is about to expire, examiners should immediately contact COG to expedite outstanding requests, in order to issue a further examination report or accept the application (see also 5.16.4.2.7 Acceptance Error Message – Outstanding Amendment Service Request).

If a notice of entitlement was filed before the name change, a new notice is not required because the change under sec 113 will have been supported by documentary evidence.
A request for the amendment of the applicant under sec 104 may be accompanied by a new patent request, however it is not a formal requirement.

A new notice of entitlement will also need to be provided, unless the change is clearly supported by documents already on file, for example a change of name supported by a certificate of marriage. Where the documents on file are complex, e.g. a deed of assignment, examiners should request a new notice.

Where a request is made under sec 104 and COG have not made the necessary updates in PAMS, examiners should follow the procedures outlined in 5.5.4 Invention Details.

The following types of companies are recognised as legal persons:

<table>
<thead>
<tr>
<th>Country</th>
<th>Type of Company</th>
</tr>
</thead>
<tbody>
<tr>
<td>Australia</td>
<td>Limited (Ltd.)</td>
</tr>
<tr>
<td>Canada</td>
<td>Proprietary Limited (Pty. Ltd.)</td>
</tr>
<tr>
<td>Eire</td>
<td>Public Liability Company (PLC)</td>
</tr>
<tr>
<td>Great Britain</td>
<td>(Great Britain only)</td>
</tr>
<tr>
<td>Hong Kong</td>
<td></td>
</tr>
<tr>
<td>India</td>
<td></td>
</tr>
<tr>
<td>New Zealand</td>
<td></td>
</tr>
<tr>
<td>Pakistan</td>
<td></td>
</tr>
<tr>
<td>South Africa</td>
<td></td>
</tr>
<tr>
<td>Belgium</td>
<td>Societe Anonyme (S.A.)</td>
</tr>
<tr>
<td></td>
<td>Personenvennootschap met</td>
</tr>
<tr>
<td></td>
<td>beperkte aansprakelijkheid</td>
</tr>
<tr>
<td></td>
<td>(P.V.B.A.)</td>
</tr>
<tr>
<td></td>
<td>Naamloose Vennootschap (N.V.)</td>
</tr>
<tr>
<td>The Czech Republic</td>
<td>Narodni Podnik</td>
</tr>
</tbody>
</table>

Modified Date: 15 April 2013
<table>
<thead>
<tr>
<th>The Slovak Republic</th>
<th>Narodni Podnik</th>
</tr>
</thead>
</table>
| Denmark             | Actie (or Aktie) Selskab (A/S)  
Anpartsselskab (ApS) |
| European Union      | Societas Europaea (SE) |
| France              | Societe Anonyme (S.A.)  
Societe a responsibilite limitee (S.a.r.l.)  
Societe en Commandite par Actions |
| Finland             | Osakeyhtio (OY) |
| Germany             | Aktiengesellschaft (A.G.) |
| Austria             | Kommanditgesellschaft auf Aktien (K.G.a.A.) |
| Switzerland         | Gesellschaft mit beschraenkter Haftung (G.m.b.H.)  
Eingetragene Genossenschaft  
eingetrager Verein (e.V)  
Versicherungsverein auf Gegenseitigkeit  
Volkseigenen Betriebe (V.E.B.) (Old D.D.R.) only |
| Liechtenstein       | |
| Indonesia           | Perusahaan Terbatas (P.T.) |
| Italy               | Societa per Azioni (S.p.A.)  
Societa Anonima (S.A.)  
Societa a responsibilita limitata (S.R.L.) |
### 2.6 Annex A - Examples of Legal Persons

<table>
<thead>
<tr>
<th>Country</th>
<th>Legal Person</th>
</tr>
</thead>
<tbody>
<tr>
<td>Japan</td>
<td>Kabushiki Kaisha (K.K.)</td>
</tr>
<tr>
<td>Malaysia</td>
<td>Sendirian Berhad (SDN. BHD.)</td>
</tr>
<tr>
<td>Netherlands</td>
<td>Naamloose Vennootschap (N.V.)</td>
</tr>
<tr>
<td>Belgium</td>
<td>Vennootschap onder Firma (VOF)</td>
</tr>
<tr>
<td></td>
<td>Beslotene Vennootschap (B.V.)</td>
</tr>
<tr>
<td>Norway</td>
<td>Aktie (or Aksje) Selskab (A/S)</td>
</tr>
<tr>
<td>Portugal</td>
<td>Sociedad Anonima (S.A.)</td>
</tr>
<tr>
<td>Spain</td>
<td>Sociedad Limitada</td>
</tr>
<tr>
<td>South America</td>
<td></td>
</tr>
<tr>
<td>South Africa</td>
<td>Close Corporation</td>
</tr>
<tr>
<td>Sweden</td>
<td>Aktiebolag or Aktiebolaget (A.B.)</td>
</tr>
<tr>
<td>Switzerland</td>
<td>Aktiengesellschaft</td>
</tr>
<tr>
<td></td>
<td>Societa per Azioni (S.p.A.)</td>
</tr>
<tr>
<td></td>
<td>Societe Anonyme (S.A.)</td>
</tr>
<tr>
<td>United States</td>
<td>Corporation (Corp.)</td>
</tr>
<tr>
<td></td>
<td>Incorporated (Inc.)</td>
</tr>
<tr>
<td></td>
<td>Company (Co.)</td>
</tr>
</tbody>
</table>

The following bodies are also recognised as being legal persons:

- A Minister of the Crown;
- Australian and overseas universities;
- Scientific institutes and research organisations of former republics of the USSR and other eastern European former communist bloc countries;
- Bergrechtliche Gewerkschaft; and
- Gewerkschaft Eisenhutte Westfalia.
The following are examples of foreign organisations whose standing as legal persons is uncertain:

a. Kommanditgesellschaft (K.G.) as distinct from Kommanditgesellschaft auf Aktien (K.G.a.A.) - Austria or Germany

b. "Societe en Commandite simple" - France

c. "Societe en Nom Collectif" (S.N.C) - France

d. "Societe Commandite" - Switzerland

e. "Kommanditbolag" - Sweden

f. "Societa in Accomandita Semplice" (S.A.S.) - Italy

g. "Kibbutz" - Israel

h. "Handelsgesellschaft" - Germany

i. "offene Handels Gesellschaft" (o.H.G.)

j. "Handelsbolag" - Sweden

k. "Handelsvenootschap" - Netherlands

l. "Limited Partnership" - United States.

2.7 Micro-Organisms and Other Life Forms

In this topic:

Definitions
2.7.1 General Considerations and Definitions

**Life Forms:** Includes whole living organisms, and cells and reproductive material derived there from. Thus the term encompasses plants, animals, viruses, vectors, micro-organisms, plasmids and plant and animal cells and cell lines. Living organisms include transgenic forms, varieties and strains.

**Micro-Organism:** The term is not defined in the Act or the Budapest Treaty. The Office interprets the term "micro-organism" (as used in the Act) to include any biological materials accepted for deposit with a prescribed depository institution, for the purposes of the Budapest Treaty, in accordance with the rules relating to micro-organisms. Examples of micro-organisms include bacteria and other procaryotes, fungi including yeast, mushrooms, algae, protozoa, eucaryotic cells, cell lines, hybridomas, viruses, plant tissue cells, spores, seeds and hosts containing materials such as vectors, cell organelles, plasmids, DNA, RNA, genes and chromosomes.

---

**Exclusions Under Subsections 18(2) and 18(3)**

Human beings and biological process for their generation are excluded from patentable subject matter for standard patents and innovation patents under sec 18(2) (see 2.9.3.5 Human Beings and Biological Processes for Their Generation).

Plants and animals and biological processes for their generation are excluded from patentable subject matter for innovation patents under sec 18(3). For the purposes of innovation patents, the definition of a "plant" is taken to include fungi and algae (see 2.31.4.6 Ground (3): Subsections 18(2) and (3)).

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**Patentable Subject Matter**

For information on the patentability of living organisms, see:

- 2.9.2.5 Discoveries, Ideas, Scientific Theories, Schemes and Plans;
- 2.9.2.6 Nucleic Acids and Genetic Information; and
- 2.9.2.14 Micro-Organisms and Other Life Forms.
2.7.2 Full Written Description of a Life Form

2.7.2.1 General Requirements of the Description

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.7.2.1A General Requirements of the Description.

In this topic:

If the invention is or involves a life form, then a description of the life form is required in order to meet the requirements of sec 40(2). This can be done either by describing the life form in words, drawings and/or sequence listings in the specification, or if the life form is a microorganism, by making a deposit under the Budapest Treaty. There must be enough detail in the specification for a person skilled in the art to identify and repeat the invention.

Description in Words

If the applicant chooses to fully describe a life form in words, then the specification must include a full description of the life form itself, as well as the best method of performing the invention known to the applicant. The 'best method of performing the invention' refers to the method by which a living organism with the same traits as the organism of the invention may be reproduced (see 2.7.2.3 Best Method of Performance of an Invention Involving a Life Form).

Where the invention resides in a new bacterial strain, animal or plant variety, or other microorganism, the specification may require considerable detail. This may include, for example, a detailed description of the complete morphological, biochemical and taxonomic
2.7.2.1 General Requirements of the Description

characteristics of the life form. Further information regarding the requirements for plant varieties is provided in 2.7.2.2 Some Specific Requirements for the Written Description of Plant Varieties.

---

**Deposit Under the Budapest Treaty**

If the applicant makes a deposit under the Budapest Treaty, this can be used to satisfy the requirements of a written description, including repeatability, under sec 41(1). However, a deposit alone may not satisfy the requirements of sec 40(2)(a) and further information may be needed to fully describe the invention (see also 2.7.3 The Budapest Treaty).

---

**Nature of the Invention**

When the invention is a new living organism, in order for sec 40(2)(a) to be satisfied, it must be clear from the specification what the nature of the invention is. This applies even if the applicant has made a deposit under the Budapest Treaty. As discussed in *Ranks Hovis McDougall Ltd’s Application* (1976) AOJP 3915, a new living organism must have altered properties that are useful in some manner, and not just be morphologically different from the prior art.

The nature of the invention may not be clear from the description of the features or properties of the organism alone. Where this occurs, the nature of the invention may be identified through, for example, a discussion of the advantages the organism possesses over the prior art, an unexpected result, the prior art problem solved or the intended purpose of the invention. An intended purpose or use of a new organism must be more than a generic use which could be applied to other members of that species. If the nature of the invention is not clear from the specification, then it may not have been fully described. It may also not meet the manner of manufacture requirements (see 2.9.2.14 Micro-Organisms and Other Life Forms and 2.9.3.4 Useful (Utility)).

---

**Other Considerations**

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.7.2.1A General Requirements of the Description

The description of a plant or animal variety will usually contain the name of the new variety. Examiners should assume that where the name of a variety is derived from a person's name, permission from that person (or their legal representative) has been granted for the use of the name (sec 50(2)), unless there is some reason to doubt this.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.7.2.1 General Requirements of the Description.

In this topic:

If the invention is or involves a life form, then an enabling disclosure of the life form is required in order to meet the requirements of sec 40(2). This can be done either by describing the life form in words, drawings, graphics, photographs and/or sequence listings in the specification, or if the life form is a micro-organism, by making a deposit under the Budapest Treaty. There must be sufficient information in the specification to enable the person skilled in the art to perform the claimed invention in a repeatable manner.

Description in Words

If the applicant chooses to describe a life form in words, then the specification must include a clear enough and complete enough disclosure of the life form itself, as well as the best method of performing the invention known to the applicant. The ‘best method of performing the invention’ refers to the method by which a living organism with the same traits as the organism of the invention may be reproduced (see 2.7.2.3 Best Method of Performance of an Invention Involving a Life Form).
2.7.2.1A General Requirements of the Description

Where the invention resides in a new bacterial strain, animal or plant variety, or other life form, the specification may require considerable detail. This may include, for example, the full morphological, biochemical and taxonomic characteristics of the life form. Further information regarding the requirements for plant varieties is provided in 2.7.2.2 Some Specific Requirements for the Written Description of Plant Varieties.

Deposit Under the Budapest Treaty

If the applicant makes a deposit under the Budapest Treaty, this can be used to satisfy the requirements of a clear enough and complete enough disclosure, including repeatability, under sec 41(1). However, a deposit alone may not satisfy the requirements of sec 40(2)(a), and further information may be needed to sufficiently enable a claimed invention (see 2.7.3 The Budapest Treaty).

Section 18 Considerations

Where the claimed invention is a new living organism, the usefulness requirements of sec 18(1)(c) must also be satisfied. An intended purpose or use of a new organism needs to be more than a generic use which could be applied to other members of that species. If the intended use is only a generic use, then a lack of usefulness objection may apply (see 2.9.3.4A Useful (Utility)).

Claims to organisms may also not meet the manner of manufacture requirements (see 2.9.2.14 Micro-Organisms and Other Life Forms).

Other Considerations

The description of a plant or animal variety will usually contain the name of the new variety. Examiners should assume that where the name of a variety is derived from a person’s name, permission from that person (or their legal representative) has been granted for the use of the name (sec 50(2)), unless there is some reason to doubt this.

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.7.2.2 Some Specific Requirements for the Written Description of Plant Varieties

When describing a plant variety in words, characteristics which may be included are:

- leaf characteristics (e.g. shape and length);
- flower characteristics (e.g. colour, size, number of petals, presence or absence of sepals, pollen morphology, carpal and stamen number, etc.);
- stem characteristics (e.g. branching habits);
- root characteristics;
- fruit characteristics;
- herbicide or pest resistance (if any); and
- scientific testing characteristics (e.g. isozyme analysis, DNA fingerprinting etc.), if available.

**Note:** The description of these characteristics should not rely on subjective terms, e.g. robust, tall, bright etc.

Photographs may also be included in the specification. These should capture each of the major characteristics used to describe the plant variety. If the colour of a flower is important, then the colour should be identified with reference to a standard horticultural colour chart (see also 2.29.11 Drawings, Graphics and Photographs).

2.7.2.3 Best Method of Performance of an Invention Involving a Life Form

In order to satisfy the best method of performance requirements, the specification must disclose all steps necessary to repeatably produce the life form. These may include selective breeding, or methods involving mutation or genetic modification.
2.7.2.4 The Issue of Repeatability

In the case of a plant variety produced by standard breeding techniques, all of the breeding methods and crosses used to produce the variety must be disclosed. Furthermore, the parents of the variety must be either available to the public in Australia (for example, commercially available or in an accessible deposit) or meet the requirements of sec 40(2)(a) themselves.

**Note:** A deposit made under the Budapest Treaty meets the requirements for best method of performing the invention.

Modified Date: 01 February 2013

**2.7.2.4 The Issue of Repeatability**

The main difference between inventions involving living and non-living systems is that many processes involving living systems are not 100% repeatable. In some cases the probability of repeating the invention, even using the best method known to the applicant, can be very low.

Each art has its own standard of repeatability and this must be taken into consideration when assessing repeatability of an invention. The issue when considering repeatability is not the numerical probability of achieving the specified result, but whether the result can be reproduced to a practical level acceptable to a person skilled in the art.

The result of chance mutation is not patentable on the grounds of lack of practical repeatability. For example, in a case involving the 'Scarlet Queen Elizabeth' rose, it was held that the process of production of the plant was not sufficiently disclosed because it was a chance genetic mutation. It was estimated that the probability of repeating this mutation was 1 in 100,000,000, which was impractical, if not impossible, given the methods of reproduction available at that time.

In situations where the repeatability is doubtful, but there is no clear indication that the invention is the result of a chance mutation, it is Office practice to accept that a best method of performance is established by the presence of a description of the process and a statement in the specification such as:

"It is practical to repeat the invention using current state of the art techniques to carry out the number of trials necessary to achieve the desired result."

It should be noted that some microbiological work which is automated and/or carried out by computer involves millions of trials, and such numbers may clearly be practical in certain fields.
2.7.3.1 Introduction

Note: The requirement of repeatability may be met through a deposit under the Budapest Treaty (see 2.7.3 The Budapest Treaty).

2.7.3 The Budapest Treaty

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.7.3.1A Introduction.

Subsection 40(2) requires that the complete specification fully describe the invention, including the best method of performing the invention. These requirements cannot be easily met where it is impossible to fully describe a micro-organism in words, or where there are issues with reproducing the micro-organism.

Section 41 provides that sec 40(2)(a) can be satisfied by depositing a sample of the micro-organism in a depository. The deposit of a sample will only be recognised for the purposes of sec 41 if it has been made as prescribed by sec 6.

Australia is a signatory to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, which provides that:

"Contracting States which allow or require the deposit of microorganisms for the purposes of patent procedure shall recognize, for such purposes, the deposit of a microorganism with any international depositary authority". (Article 3)

Under the terms of the Budapest Treaty, a depository must qualify for the status of an International Depositary Authority (IDA) (Article 6 and Article 7). The Treaty also requires the deposit to have been made in accordance with Rule 6.

A list of the recognised IDAs is available from WIPO.
**Note:** The information in this part **only** applies to:

- standard patent applications with an examination request filed **on or after** 15 April 2013.
- innovation patents with an examination request filed **on or after** 15 April 2013.
- innovation patents where the Commissioner **had not decided before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.7.3.1 Introduction](#).

Subsection 40(2) requires that the complete specification disclose the invention in a clear enough and complete enough manner, including the best method of performing the invention. These requirements cannot be easily met where it is impossible to provide an enabling disclosure of a micro-organism in words, or where there are issues with reproducing the micro-organism.

Section 41 provides that sec 40(2) can be satisfied by depositing a sample of the micro-organism in a depository. The deposit of a sample of the micro-organism will only be recognised for the purposes of sec 41 if it has been made as prescribed by sec 6.

Australia is a signatory to the **Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure**, which provides that:

"Contracting States which allow or require the deposit of microorganisms for the purposes of patent procedure shall recognize, for such purposes, the deposit of a microorganism with any international depositary authority". ([Article 3](#))

Under the terms of the Budapest Treaty, a depository must qualify for the status of an International Depositary Authority (IDA) ([Article 6](#) and [Article 7](#)). The Treaty also requires the deposit to have been made in accordance with [Rule 6](#).

A list of the recognised IDAs is available from [WIPO](#).
2.7.3.2 Full Description of a Micro-Organism by Satisfying the Deposit Requirements

Note: The International Patent Organism Depositary (IPOD), National Institute of Technology and Evaluation (NITE), was formerly known as the National Institute of Bioscience and Human-Technology, Agency of Industrial Science and Technology (NIBH).

Note: The All-Russian Collection of Industrial Microorganisms (VKPM) was formerly known as the Russian National Collection of Industrial Microorganisms (VKPM).

Modified Date: 01 September 2015

2.7.3.2 Full Description of a Micro-Organism by Satisfying the Deposit Requirements

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.7.3.2A Enabling Disclosure of a Micro-Organism by Satisfying the Deposit Requirements.

Section 41(1) states that to the extent that an invention in a complete specification is a micro-organism, then the specification is taken to comply with sec 40(2)(a) where the deposit requirements specified in sec 6 have been met (see also 2.11.3.15 Biological Inventions and the Budapest Treaty).

Note: The Budapest Treaty provides a means for the applicant to fully describe the invention. Thus, if the description or claims refer to a deposited micro-organism, but the invention can be fully described without the need to rely on the deposit, then the requirements of sec 40(2)(a) are considered to be met. In these circumstances, there is no statutory basis for requesting that the applicant comply with the Budapest Treaty requirements.

For example, the mere reference to a micro-organism deposit in the specification, e.g. by accession number, does not necessarily mean that the applicant is using the deposited material to comply with the sec 40(2)(a) requirements. Examiners should consider whether access to the deposited material is a necessary requirement in order to perform the invention, as it is claimed. If examiners are satisfied from the information on file that the
2.7.3.2A Enabling Disclosure of a Micro-Organism by Satisfying the Deposit Requirements

Note: The information in this part only applies to:

• standard patent applications with an examination request filed on or after 15 April 2013.
• innovation patents with an examination request filed on or after 15 April 2013.
• innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.7.3.2 Full Description of a Micro-Organism by Satisfying the Deposit Requirements.

Section 41(1) states that to the extent than an invention in a complete specification is a micro-organism, then the specification is taken to comply with sec 40(2)(a) where the deposit requirements specified in sec 6 have been met (see also 2.11.3.15A Biological Inventions and the Budapest Treaty).

Note: The Budapest Treaty provides a means for the applicant to provide an enabling disclosure of the invention. Thus, if the description or claims refer to a deposited micro-organism, but the claimed invention can be disclosed in a clear enough and complete enough manner without the need to rely on the deposit, then the requirements of sec 40(2)(a) are considered to be met. In these circumstances, there is no statutory basis for requesting that the applicant comply with the Budapest Treaty requirements.

For example, the mere reference to a micro-organism deposit in the specification, e.g. by accession number, does not necessarily mean that the applicant is using the deposited material to comply with the sec 40(2)(a) requirements. Examiners should consider whether access to the deposited material is a necessary requirement in order to perform the invention, as it is claimed. If examiners are satisfied from the information on file that the same material is available from another source (e.g. the specification indicates it is commercially available), then they may reasonably conclude that the applicant does not
2.7.3.3 Inventions Involving the Use, Modification or Cultivation of a Micro-Organism

Section 41(2) states that where:

a. an invention involves the use, modification or cultivation of a micro-organism and not the micro-organism per se; and

b. a person skilled in the relevant art could not reasonably expect to be able to perform the invention without first having a sample of the micro-organism; and

c. the micro-organism is not reasonably available to a person skilled in the relevant art in Australia;

then the applicant can satisfy the sec 40(2)(a) requirement if and only if, the deposit requirements specified in sec 6 have been satisfied.

Office practice is to regard a micro-organism as being reasonably available, if the specification discloses a method by which the public can access a sample of the deposit. For example:

- if the applicant identifies in the specification a commercial source through which a sample of the micro-organism can be obtained;

- if a sample is freely available from any source, the applicant must name a source from which the public can obtain a sample of the micro-organism; or

- if a sample of the micro-organism was available, under Rule 11 of the Budapest Treaty, at the filing date of the complete application, the applicant must:

  - identify the published specification (including foreign specifications), which was published before the filing date of the applicant's complete application in which the deposit was used for the purpose of patent procedure;

  - disclose the accession number of the deposit; and

  - name the International Depositary Authority (IDA) from which a sample can be furnished under the Rules of the Treaty.
2.7.3.4 Deposit Requirements in Modified Examination

**Note:** A deposit is regarded as being reasonably available provided the deposit relied on has been made under the Budapest Treaty and the deposit details disclosed in a document published by the filing date of the complete application.

**Note:** A micro-organism may be taken to be reasonably available, even if it is not reasonably available from an IDA within Australia (sec 41(3)).

Examiners should note that, particularly in literature references, the mere mention of an accession number at a particular depositary may not establish that the deposit is available, as it is common to have private (total limiting), or restrictive (e.g. Budapest Treaty) deposits, as well as freely available (no limitation) deposits in an accredited IDA.

If there is any doubt about the availability, examiners should raise an objection that the invention does not meet the requirements of sec 40(2)(a), as it is not clear if the micro-organism is reasonably available.

If the uncertainty is related to the "reasonably available" aspect of the deposit, examiners should add a note to reiterate Office practice on the meaning of the term "reasonably available" (outlined above).

The procedures for accessing a sample of the deposit are provided in 2.7.6 Release of a Sample.

Modified Date: 01 September 2015

2.7.3.4 Deposit Requirements in Modified Examination

**Note:** The Act ceased to allow the filing of requests for modified examination on 15 April 2013.

During modified examination, examiners must consider if the deposit requirements specified in sec 6 are satisfied. Under reg 3.18(3), the specification is allowed to differ from the foreign patent to the extent that difference is necessary for the application to comply with the deposit requirements.

**Note:** Where a micro-organism deposit is relied upon, the applicant must file the necessary prescribed documents (see 2.7.4.3 Deposit Receipt and Notice of Entitlement to Rely on Deposit).

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Effective Date: 25 September 2019
2.7.3.5 Deposit Requirements Affecting the Priority Date of a Divisional Application

Chapter 3 of the Regulations specifies that if a divisional application relies on the deposit requirements to satisfy sec 40, then the application can only claim priority from the parent or other ancestor if the deposit requirements for that micro-organism were satisfied in the parent or other ancestor at the time the divisional application was filed.

2.7.4 The Deposit Requirements

2.7.4.1 Types of Deposits Under the Budapest Treaty

There are three types of deposits recognised under the Budapest Treaty:

**Original Deposit**

A sample of a micro-organism is deposited in an IDA for the first time *(Rule 6.1)*.

**New Deposit**

Where an IDA can no longer furnish a sample of an original deposit of a micro-organism for any reason, in particular:

- the original deposit is no longer viable; or
- export and/or import restrictions prevent the sample being sent overseas;

a new deposit of the originally deposited micro-organism can be made.

In the former situation, the deposit is made with the same IDA, whereas the latter involves two different IDAs which are usually located in different countries *(Rule 6.2)*.

**Transfer Deposit**
Where an IDA has lost its status as an accredited IDA in respect of any micro-organism concerned, samples of all such micro-organisms may be transferred to another IDA (Rule 5.1).

**Note:** Not all depositories in which a PCT applicant can deposit a micro-organism are accredited depositary institutions under the Budapest Treaty. A list of the recognised IDAs is available from WIPO.

**2.7.4.2 Deposit Requirements Under Section 6**

Section 6 prescribes the deposit requirements which an applicant must satisfy for the purposes of sec 41(1). Under sec 6, the deposit requirements in relation to a micro-organism are taken to be satisfied if:

a. the micro-organism was, on or before the date of filing of the specification, deposited with a prescribed depositary institution in accordance with the rules relating to micro-organisms; and

b. the specification includes, at that date, such relevant information on the characteristics of the micro-organism as is known to the applicant; and

c. at all times since the end of the prescribed period, the specification has included:

i. the name of a prescribed depositary institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and

ii. the file, accession or registration number of the deposit given by the institution; and

- at all times since the date of filing of the specification, samples of the micro-organism have been obtainable from a prescribed depositary institution as provided by those rules.

**Note:** There is no requirement that the specification includes the date on which the micro-organism deposit was made. (This was previously required by sec 6(c)(ii), since repealed.)
2.7.4.2.1 The Section 6 Provisions Explained

In this topic:

**Note:** For information on applying the sec 6 provisions, see 2.7.4.2.2 Section 6 Examination Practice.

**Meaning of “prescribed depositary institution”**

Section 6(a) requires that a micro-organism be deposited with a “prescribed depositary institution”. Under sec 6(c), the specification is required to include the name of the “prescribed depositary institution” from which samples of the micro-organism are obtainable. Section 6(d) requires that samples of the micro-organism have been obtainable from the “prescribed depositary institution” at all times since the filing date of the specification.

The term "prescribed depositary institution" includes an International Depositary Authority (IDA) under Rule 3 of the Budapest Treaty. A list of the recognised IDAs is available from WIPO.

**Note:** The International Patent Organism Depositary (IPOD), National Institute of Technology and Evaluation (NITE), was formerly known as the National Institute of Bioscience and Human-Technology, Agency of Industrial Science and Technology (NIBH).

**Meaning of “relevant information on the characteristics of the micro-organism”**

At filing, the specification is required to include “relevant information on the characteristics of the micro-organism” as is known to the applicant (sec 6(b)). In general, this is satisfied by indicating the scientific name of the deposited micro-organism(s). Full morphological, biochemical and taxonomic characteristics of the micro-organism are usually not required, or may not be known to the applicant at the date of filing of the specification.
Meaning of “the end of the prescribed period”

In sec 6(c), "the end of the prescribed period" means either:

- **where a deposited micro-organism has ceased to be reasonably available**, the end of the prescribed period is 3 months from the date specified in the declaration made by the Commissioner or a prescribed court that the specification does not comply with sec 40.

  (see sec 42(1), sec 42(2) and reg 1.5(1)(a))

**OR**

- **in any other case**, the end of the prescribed period is the end of the day immediately before the day on which the specification becomes open to public inspection (OPI), or immediately before acceptance, whichever occurs earlier.

  (see reg 1.5(1)(b))

For national phase applications, the OPI date is the day on which:

- PCT international publication occurs; or
- a notice is published in the Official Journal, if that is earlier.

Meaning of “has included”

Section 6(c) requires that the specification “has included” the name of the prescribed depositary institution from which samples of the micro-organism are obtainable and the file, accession or registration number of the deposit.

The issue of whether a specification "has included" the sec 6(c) information arises when examiners consider if the requirements of sec 40 and sec 41 have been satisfied, or when an applicant seeks to insert information under sec 104.

The specification has **not included** the information relating to the deposit if the relevant information was:
2.7.4.2.2 Section 6 Examination Practice

- absent
  i.e. no information relating to the deposit was previously disclosed in the specification;

OR

- incomplete
  i.e. information relating to the deposit was previously present, but that information was incomplete, e.g. the file, accession or registration number was omitted;

OR

- incorrect and a hindrance
  i.e. information relating to the deposit was previously present, but that information was incorrect (e.g. the deposit number was wrong), and the incorrect information would have hindered a person seeking access to the deposit.

Note: If incorrect information relating to the deposit was previously present, but the error would not have hindered a person seeking access to the deposit (e.g. if the file, accession or registration number contains an obvious mistake), then the specification “has included” the sec 6(c) information.

For national phase applications, the reference to a deposit may be disclosed on a separate sheet furnished under Rule 13bis.4, and is taken to be included in the description of the PCT application. The separate sheet can be Form PCT/RO/134 or a copy of the deposit receipt from an IDA.

If the specification does not include the required information, it cannot be inserted into the specification on or after OPI without a sec 223 extension of time (see 2.7.5 Amendments to Insert Section 6(c) Information and Extensions of Time Therefor).

An applicant can only rely on a micro-organism deposit to satisfy the requirements of sec 40(2)(a) (i.e. clear enough and complete enough disclosure or full description) if the deposit requirements of sec 6 have been met (see 2.7.4.2 Deposit Requirements Under Section 6).
Specifically, sec 6(c) requires that the specification has included, at all times since the end of the prescribed period:

- the name of the prescribed depositary institution from which samples of the micro-organism are obtainable; and
- the file, accession or registration number of the deposit.

If the requirements of sec 6(c) have not been met, an objection should be taken that the complete specification does not comply with sec 40(2)(a) (see, for example, PERP codes [E70] and [E70A]).

Where sec 6(c) information has not been included in the specification, it may be possible to insert the material under sec 104, provided a sec 223 extension of time is granted. For information on when an extension of time is required, and the processing of sec 104 amendments to include sec 6(c) information, see 2.7.5 Amendments to Insert Section 6(c) Information and Extensions of Time Therefor.

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2.7.4.3 Deposit Receipt and Notice of Entitlement to Rely on Deposit

In this topic:

Where a micro-organism is deposited with a prescribed depositary institution, the applicant is required to file:

- a copy of the deposit receipt issued by the prescribed depositary institution. If the receipt is not in English, a translation of the receipt must be provided. (For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided).

The receipt attests that the depositary received and accepted a sample of the micro-organism which has been deposited under the Budapest Treaty. It should bear the signature of the person(s) having the power to represent the authority, or an official who is duly authorised by that person.

AND
2.7.4.3.1 Contents of the Receipt

- a notice of entitlement stating the applicant's right to rely on a deposited microorganism for the purpose of patent procedure and providing support for such entitlement.

(see sec 29(1) and reg 3.1(2))

The time for filing the documents is:

- before acceptance of a patent application (reg 3.1(2)); or
- for accepted applications or patents, within 3 months of the date of receipt of the micro-organism by the depositary (reg 3.23(2)).

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Examination Practice

Examiners should review the contents of the deposit receipt and its time of filing as outlined in 2.7.4.3.1 Contents of the Receipt. The accession number and name of the institution disclosed in the specification should be consistent with those on the receipt. Where there are any inconsistencies, or information is missing from the receipt, an objection should be taken (see, for example, PERP codes [E72] – [E74]).

If a copy of the deposit receipt, a (verified) translation of the receipt (where necessary) and/or a notice of entitlement to rely on the deposit have not been provided, an objection should be taken (see, for example, PERP codes [E71] and [E75]).

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Original Deposit
Rule 7.3 requires that the receipt for an original deposit under the Budapest Treaty should contain at least the following:

- the name and address of the International Depositary Authority (IDA);
- the name and address of the depositor;
- the date of original deposit of the micro-organism;
- the identification reference given by the depositor to the micro-organism;
- the accession number given by the IDA to the deposit; and
- a reference to the fact that the deposit is or is not accompanied by a written statement which contains a scientific description and/or a proposed taxonomic designation of the micro-organism.

Deposits other than those made under the Budapest Treaty may be accepted by IDAs. Examiners should therefore ensure that the receipt explicitly indicates that the deposit was made under the Budapest Treaty.

**Note:** The date of the deposit normally means the date when the depositary receives and accepts a sample of a micro-organism which was deposited under the Budapest Treaty as shown on the official receipt. However, following an understanding reached by the Assembly of the Budapest Union (1981 and 1990), a depositor may request that a deposit made with an accredited IDA, but outside the scope of the Budapest Treaty, be converted into a Budapest Treaty deposit. In such cases, the applicable national law determines whether the earlier date can be recognised.

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**New Deposit**

Rule 7.4 requires that the receipt for a new deposit is issued by the International Depositary Authority (IDA) which holds the new deposit and should contain at least the following:

- the name and address of the IDA holding the new deposit;
- the name and address of the depositor;
- the date of the new deposit of the micro-organism;
- the identification reference given by the depositor to the micro-organism;
- the accession number given by the IDA to the new deposit;
2.7.4.3.1 Contents of the Receipt

- the accession number of the previous deposit;
- the reason for making the new deposit;
- the date on which the depositary received the information from the previous IDA stating why it cannot furnish a sample; and
- where a scientific description and/or taxonomic designation was indicated with the previous deposit, supply the most recent scientific description and/or proposed taxonomic designation of the deposit sent to the previous IDA.

The applicant must supply a copy of the receipt for the previous deposit, if the date of the new deposit is after the filing date of the patent application.

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Transfer Deposit

When an International Depositary Authority (IDA) temporarily or definitively discontinues the performance of any of the tasks of an IDA, samples of the affected micro-organisms can be transferred to another IDA.

The latter IDA should issue a receipt for the transferred deposit. The contents of a transfer receipt should:

- contain the same details as those for the original deposit, except that the IDA referred therein is the one which holds the transferred deposit, the accession number is that of the transferred deposit and the date of the transfer replaces the date of the original deposit;
- disclose the name and address of the IDA from which the transfer was effected and the old accession number given by the previous IDA; and
- indicate whether a scientific description of the deposit was sent to the previous IDA (Rule 7.5).

In addition, the applicant should disclose the date on which the latter IDA received the information from the previous IDA stating why it cannot furnish a sample.

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2.7.5 Amendments to Insert Section 6(c) Information and Extensions of Time Therefor

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Effective Date: 25 September 2019
2.7.5.1 Sections 104 and 223 - Insertion of Section 6(c) Information

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.7.5.1A Sections 104 and 223 - Insertion of Section 6(c) Information.

In this topic:

Overview

An amendment of the specification under sec 104 to include any or all of the information referred to in sec 6(c) (i.e. the name of the prescribed depositary institution and/or the file, accession or registration number of the deposit) can be made at any time before the end of the prescribed period. In general, the prescribed period ends immediately before the day on which the specification becomes open to public inspection (OPI), or immediately before acceptance, whichever is earlier (see 2.7.4.2.1 The Section 6 Provisions Explained).

Any amendment of the specification to include sec 6(c) information after the end of the prescribed period will not achieve compliance with the deposit requirements, unless the applicant also obtains an extension of time under sec 223, such that the amendment can occur within the extended time period.

Note: Section 6(c) information may also be inserted under Article 34; see 2.7.5.2 Article 34 Amendments Concerning Section 6(c) Information.
When is an Extension of Time Under Section 223 Required?

An extension of time under sec 223 to include sec 6(c) information is only required if:

- the deposit is required to satisfy the requirements of sec 40(2)(a) (i.e. full description); and
- the specification has not included that information since the end of the prescribed period.

The specification has not included the information relating to the deposit if the relevant information was:

- absent
  - i.e. no information relating to the deposit was previously disclosed in the specification;

OR

- incomplete
  - i.e. information relating to the deposit was previously present, but that information was incomplete, e.g. the file, accession or registration number was omitted;

OR

- incorrect and a hindrance
  - i.e. information relating to the deposit was previously present, but that information was incorrect (e.g. the deposit number was wrong), and the incorrect information would have hindered a person seeking access to the deposit.

Note: If incorrect information relating to the deposit was previously present, but the error would not have hindered a person seeking access to the deposit (e.g. if the file, accession or registration number contains an obvious mistake), then the specification "has included" the sec 6(c) information.

When is an Extension of Time Under Section 223 Not Required?
An extension of time under sec 223 to include sec 6(c) information is **not** required if:

- the deposit information is not required for the purposes of sec 41, i.e. the deposit is not necessary to satisfy the requirements of sec 40(2)(a);

**OR**

- the deposit information was present, and any incorrect information would not have hindered a person seeking access to the deposit;

**OR**

- the deposit information was present, and an amendment has the effect of replacing (or supplementing) that information with information relating to a different deposit of the same micro-organism, e.g. a new or transferred deposit.

**Note:** If the deposit requirements had ceased to be satisfied before filing the request to amend, the provisions of sec 41(4) and reg 3.30 apply.

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**Examination Practice**

Where a sec 104 amendment is proposed to include sec 6(c) information in the specification, examiners should process the amendment regardless of whether an application under sec 223 has been made. The allowability of the amendment is not dependent upon whether an extension of time has been granted. If the sec 223 request is refused, the applicant will not be able to rely on the deposit for the purposes of sec 40(2).

The processing of sec 104 amendments to insert sec 6(c) information differs from the processing of other sec 104 amendments. Thus:

- A sec 104 amendment to insert sec 6(c) information is processed and allowed separately from other proposed amendments, without requiring the remainder of the specification to be in order for acceptance.

- Consequently, the amendment is allowed forthwith (reg 10.6(1)) and allowance is advertised as soon as possible.

- Other amendments are allowed immediately before acceptance (reg 10.6(2)).

Examiners should therefore advise applicants that to facilitate correct processing, amendments to insert sec 6(c) information should be proposed as items separate from those proposing to amend other matters.
Applications under sec 223 are processed by Patent Oppositions. If the case file contains an application under sec 223 which has not been granted, examiners should initially consult a supervising examiner. The supervising examiner will determine whether the application has been processed and arrange for any action by Patent Oppositions that may be required.

If the sec 223 extension of time to include sec 6(c) information has not been granted, or has been refused, examiners must disregard the deposit for the purposes of sec 40 and sec 41, and consider whether the invention with respect to any micro-organism has been fully described in words.

Where the only outstanding matter is a sec 40 deficiency due to the fact that an extension of time to insert sec 6(c) information has not yet been allowed, the application cannot be accepted. A report to this effect should therefore be issued.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.7.5.1 Sections 104 and 223 - Insertion of Section 6(c) Information](#).

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In this topic:

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### Overview

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Effective Date: 25 September 2019
An amendment of the specification under sec 104 to include any or all of the information referred to in sec 6(c) (i.e. the name of the prescribed depositary institution and/or the file, accession or registration number of the deposit) can be made at any time before the end of the prescribed period. In general, the prescribed period ends immediately before the day on which the specification becomes open to public inspection (OPI), or immediately before acceptance, whichever is earlier (see 2.7.4.2.1 The Section 6 Provisions Explained and also sec 102(3)).

Any amendment of the specification to include sec 6(c) information after the end of the prescribed period will not achieve compliance with the deposit requirements, unless the applicant also obtains an extension of time under sec 223, such that the amendment can occur within the extended time period.

**Note:** Section 6(c) information may also be inserted under Article 34; see 2.7.5.2 Article 34 Amendments Concerning Section 6(c) Information.

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**When is an Extension of Time Under Section 223 Required?**

An extension of time under sec 223 to include sec 6(c) information is **only** required if:

- the deposit is required to satisfy the requirements of sec 40(2)(a) (i.e. clear enough and complete enough disclosure); and

- the specification **has not included** that information since the end of the prescribed period.

The specification has **not included** the information relating to the deposit if the relevant information was:

- **absent**
  
  i.e. **no** information relating to the deposit was previously disclosed in the specification;

  **OR**

- **incomplete**
  
  i.e. information relating to the deposit was previously present, but that information was incomplete, e.g. the file, accession or registration number was omitted;
OR

- incorrect and a hindrance

  i.e. information relating to the deposit was previously present, but that information was incorrect (e.g. the deposit number was wrong), and the incorrect information would have hindered a person seeking access to the deposit.

  **Note:** If incorrect information relating to the deposit was previously present, but the error would not have hindered a person seeking access to the deposit (e.g. if the file, accession or registration number contains an obvious mistake), then the specification “has included” the sec 6(c) information.

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**When is an Extension of Time Under Section 223 Not Required?**

An extension of time under sec 223 to include sec 6(c) information is **not** required if:

- the deposit information is not required for the purposes of sec 41, i.e. the deposit is not necessary to satisfy the requirements of sec 40(2)(a);

OR

- the deposit information was present, and any incorrect information would not have hindered a person seeking access to the deposit;

OR

- the deposit information was present, and an amendment has the effect of replacing (or supplementing) that information with information relating to a different deposit of the same micro-organism, e.g. a new or transferred deposit.

  **Note:** If the deposit requirements had ceased to be satisfied before filing the request to amend, the provisions of sec 41(4) and reg 3.30 apply.

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**Examination Practice**

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Effective Date: 25 September 2019
2.7.5.2 Article 34 Amendments Concerning Section 6(c) Information

Where a sec 104 amendment is proposed to include sec 6(c) information in the specification, examiners should process the amendment regardless of whether an application under sec 223 has been made. The allowability of the amendment is not dependent upon whether an extension of time has been granted. If the sec 223 request is refused, the applicant will not be able to rely on the deposit for the purposes of sec 40(2).

The processing of sec 104 amendments to insert sec 6(c) information differs from the processing of other sec 104 amendments. Thus:

- A sec 104 amendment to insert sec 6(c) information is processed and allowed separately from other proposed amendments, without requiring the remainder of the specification to be in order for acceptance.
- Consequently, the amendment is allowed forthwith (reg 10.6(1)) and allowance is advertised as soon as possible.
- Other amendments are allowed immediately before acceptance (reg 10.6(2)).

Examiners should therefore advise applicants that to facilitate correct processing, amendments to insert sec 6(c) information should be proposed as items separate from those proposing to amend other matters.

Applications under sec 223 are processed by Patent Oppositions. If the case file contains an application under sec 223 which has not been granted, examiners should initially consult a supervising examiner. The supervising examiner will determine whether the application has been processed and arrange for any action by Patent Oppositions that may be required.

If the sec 223 extension of time to include sec 6(c) information has not been granted, or has been refused, examiners must disregard the deposit for the purposes of sec 40 and sec 41, and consider whether the claimed matter involving a micro-organism has been otherwise disclosed in the specification in a clear enough and complete enough manner.

Where the only outstanding matter is a sec 40 deficiency due to the fact that an extension of time to insert sec 6(c) information has not yet been allowed, the application cannot be accepted. A report to this effect should therefore be issued.
been made on the date when they were filed (Rule 66.3). If this date is on or after the OPI
date of the application, examiners must report that:

- although the deposit details were inserted under Article 34, and these details are
taken to have been inserted into the specification, they were inserted outside the
period prescribed under reg 1.5; and

- the deposit details cannot be relied on for the purposes of sec 40, unless an
extension of time under sec 223 is granted.

Under **reg 3.25(1)**, a person may request that the Commissioner grant a certification
authorising the release of a sample of a micro-organism. When such a request is pending,
and the applicant or patentee files a request to amend the specification for the purpose of
inserting **sec 6(c)** information (i.e. the name of the prescribed depositary institution and/or
the file, accession or registration number of the deposit), the person who made the **reg
3.25(1)** request should be sent:

- a copy of the amendment request and the statement of proposed amendments (**reg
10.2(8)**); together with

- a covering letter advising that should the person wish to be heard on the matter, they
have 21 days from the date of the letter to notify the Commissioner.

Before allowing an amendment, examiners should bring the matter to the attention of the
Supervising Examiner CHEM 1, so that any issues affecting the request for release under
**reg 3.25(1)** can be considered.

A person other than the applicant or patentee may file a notice under **reg 3.29(1)** notifying
the Commissioner that the deposit requirements of **sec 6(c)** or **sec 6(d)** have ceased to be
satisfied. Where the applicant or patentee subsequently files a request to amend the specification for the purpose of inserting sec 6(c) information (i.e. the name of the prescribed depositary institution and/or the file, accession or registration number of the deposit), the person who filed the notice should be sent:

- a copy of the amendment request and the statement of proposed amendments (reg 10.2(9)); together with
- a covering letter advising that should the person wish to be heard on the matter, they have 21 days from the date of the letter to notify the Commissioner.

Before allowing an amendment, examiners should bring the matter to the attention of the Supervising Examiner CHEM 1, so that any issues affecting the reg 3.29(1) notification can be considered.

### 2.7.6 Release of a Sample of Deposit

Before allowing an amendment, examiners should bring the matter to the attention of the Supervising Examiner CHEM 1, so that any issues affecting the reg 3.29(1) notification can be considered.

## 2.7.6 Release of a Sample of Deposit

Under sec 6(d), it is a requirement that a sample of a micro-organism has been obtainable from a prescribed depositary institution at all times since the filing of the specification. The term "prescribed depositary institution" includes an International Depositary Authority (IDA) under Rule 3 of the Budapest Treaty.

A sample of a micro-organism deposited under the Budapest Treaty can be obtained from an IDA under Rule 11.3. The procedures for the release of a sample, including any restrictions on that release, are outlined in the following sections.

## 2.7.6.1 Request for Release

In this topic:
In order to obtain a sample of a micro-organism deposit, the person requiring the sample must firstly request a certification from the Commissioner authorising the release. The request for the release of a sample:

- must be made in the approved form;

AND

- must relate to a micro-organism:
  - that is the subject of a patent application or patent; or
  - the use, modification or cultivation of which is the subject of a patent application or patent;

AND MAY

- nominate another person as a skilled addressee. The skilled addressee is a person without an interest in the invention to whom the Commissioner’s certification may be granted.

(reg 3.25 and Rule 11.1)

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**Request Requirements**

The request must be made in the approved form (see [P/00/031 Request for Commissioner’s Certification Authorising Release of a Sample of a Micro-Organism](#)). A single request may be used for any number of micro-organisms, provided the micro-organisms are disclosed in the one application. The time for filing a request is on or after the date on which the application is open to public inspection (OPI). Note, however, that a request will not be granted in respect of a PCT application that has not entered the national phase (reg 3.25B(5)).

Where a request is made by an individual on behalf of a company, the request (and undertaking relating to the use of the micro-organism sample) should explicitly state that the requestor is acting “on behalf of” the company.

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**Undertaking by Requestor**
Note: An undertaking is not required in the case of a request relating to a patent application that has lapsed, or is refused or withdrawn, or a patent that has expired, ceased or been revoked.

The person making the request (or the person nominated as the skilled addressee; see above), must give an undertaking relating to the use of the micro-organism sample (reg 3.25C). The undertaking is that the person:

- will not make the micro-organism, or a culture derived from the micro-organism, available to another person; and

- will only use the sample for:
  - experimental purposes; or
  - in relation to opposition proceedings under Chapter 5 or sec 101M, or relevant proceedings in relation to the patent.

Examiners should assume that an undertaking is valid, unless there is reason to doubt its veracity.

Examiners should note the following:

1. The details on the undertaking should reflect the current status of the application or patent.

2. The undertaking must be clearly associated with the relevant micro-organism deposit. For example, for a paper form where the relevant micro-organism is identified on the first page and the undertaking is given on the second page, the name of the relevant micro-organism and the accession number to which the undertaking is given must be stated on the second page (Re Merck & Co Inc and Niblack (1992) AIPC 90-866).

3. A sample may be used for any of the above purposes. Therefore, it is not necessary to make a separate request if, for example, a sample was initially obtained pre-acceptance and then was subsequently required in opposition or revocation proceedings (New York University v Nissin Molecular Biology Institute Inc (1994) AIPC 91-069).

4. The term "experimental purposes" should be construed analogously to experimental uses of an invention that do not give rise to infringement of a patent (New York University v Nissin Molecular Biology Institute Inc supra). However, the term should not be interpreted as being restricted to "in Australia" and must refer to experimental purposes anywhere in the world (New York University v Nissin Molecular Biology Institute Inc supra). This condition also applies to the undertaking of not making a sample available to others.
2.7.6.2 Consideration of Request for Release

Form BP/12

The request must be accompanied by Form BP/12 - Request for the Furnishing of Samples of Deposited Microorganisms pursuant to Rule 11.3(a) (see 2.7 Annex A – Form BP/12). The first and second pages of the form are to be completed by the person making the request. The third page of the form is the certification given by the Commissioner (see 2.7.6.3 Grant of Certification Authorising Release).

Failure to Meet Requirements

Where the request does not meet the necessary requirements, the Supervising Examiner CHEM 1 should inform the person making the request of that fact (see, for example, 2.7 Annex C – Letter to Person Making Request for Certification).

Modified Date: 25 February 2019

2.7.6.2 Consideration of Request for Release

In this topic:

After receiving a request for certification authorising release of a sample, the Commissioner must invite submissions on the matter from:

- the person who made the request;
- the applicant or patentee;
- any other person who apparently has an interest in the request.

(reg 3.25(3))

Where submissions are filed within the time specified, these will be taken into consideration by the Commissioner. Notwithstanding this, the Commissioner must grant the certification where the requirements of reg 3.25B are met. However, the Commissioner may impose certain conditions on granting certification for release.
The Commissioner will notify the relevant parties of any decision regarding the request for release as soon as practicable after the date of the decision (reg 3.25H).

**Note:** A request will **not** be granted in respect of a PCT application that has not entered the national phase (reg 3.25B(5)).

**Note:** Where there is a pending decision on a request for a certification authorising release of a micro-organism, and the applicant or patentee files proposed sec 104 amendments relating to sec 6(c) information (i.e. the name of the prescribed depositary institution and/or the file, accession or registration number of the deposit), the procedures outlined in 2.7.5.3 Amendment Procedure When a Request for Certification for Release is Pending should be followed.

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**Procedure for Informing Applicant or Patentee of Request**

The applicant (or patentee) must be informed that a request for the Commissioner's certification authorising release of a sample of a micro-organism has been made.

The Supervising Examiner CHEM 1 must send the applicant a covering letter (see 2.7 Annex D – Notification to Applicant of Request for Release), together with:

- a copy of the request for certification (Form P/00/031);
- a copy of the undertaking by the requestor (Form P/00/031);
- copies of any correspondence sent to the requestor; and
- copies of any Form BP/12 (2.7 Annex A – Form BP/12).

The micro-organism requested for release must be a Budapest Treaty deposit. If there is no evidence on file that it is a Budapest Treaty deposit, a statement indicating that the Office has assumed that the deposit was made under the Rules of the Budapest Treaty must be included in the covering letter to the applicant (see 2.7 Annex D – Notification to Applicant of Request for Release).

The applicant has one month from the date of the letter to provide submissions, if any.

The Supervising Examiner CHEM 1 will handle any further correspondence that relates to formality issues. However, other matters of substance, such as security, should be referred to the Assistant General Manager (OEP) (see also Conditions on Granting the Certification for Release).
Where a request for certification authorising release of a sample is granted, the Commissioner will issue a certificate which is the third page of Form BP/12 – Request for the Furnishing of Samples of Deposited Microorganisms pursuant to Rule 11.3(a) (see 2.7 Annex A – Form BP/12).

On the certification, the Commissioner declares that the certified party has a right to a sample of the micro-organism identified in the request for certification under the law governing patent procedure of the Office, and that the Office is satisfied that the conditions prescribed by such a law have been met.

In Australia the certified party is:

- the person making the request for a certification to authorise the release of a sample;
  or
- a skilled addressee without an interest in the invention nominated by the person making the request for certification, if the restrictive access provision has been invoked (reg 3.25A).

**Procedure for Issuing Certification**

When the certification for release is ready to be issued, the Supervising Examiner CHEM 1 will forward the Form BP/12 to the Assistant Director COG, who will attach a seal to the form. The completed certification for release is then signed by the Assistant General Manager (OEP).

The certification for release, together with a covering letter, is sent to the requestor. A copy of the certification for release (together with a covering letter) is also sent to the applicant (or patentee). A further copy of the certification is placed on the case file.
Limited Use Undertaking

**Note:** An undertaking is **not** required in the case of a request relating to a patent application that has lapsed, or is refused or withdrawn, or a patent that has expired, ceased or been revoked.

Once a sample of the micro-organism has been released, it may only be used for certain purposes. Thus the requestor, or the person nominated as the skilled addressee (a person without an interest in the invention to whom certification may be granted), must give the undertaking that they:

- will not make the micro-organism, or a culture derived from the micro-organism, available to another person; **and**
- will only use the sample for:
  - experimental purposes; **or**
  - in relation to opposition proceedings under Chapter 5 or sec 101M, or relevant proceedings in relation to the patent.

The period of the undertaking is:

- **in the case of a request in respect of a patent application**, the period beginning when the request is granted and ending when:
  1. the application **lapses**, or is **refused** or **withdrawn**; **or**
  2. a patent granted on the application **expires**, **ceases** or is **revoked**.
- **in the case of a request in respect of a patent**, the period beginning when the request is granted and ending when the patent **expires**, **ceases** or is **revoked**.

Conditions on Granting Certification for Release

The Commissioner may impose conditions as are reasonable in granting the certification for release (**reg 3.25G**). These can include a security for a breach of the undertaking regarding the use of the micro-organism, or that the release is to be effected to an independent third
party and that the third party must make an undertaking regarding the use of the micro-
organism and destroy the sample once the experiments required by the requestor are
performed (see New York University v Nissin Molecular Biology Institute Inc (1994) AIPC 91-
090 and also Merck & Co Inc and Niblack Inc (1992) AIPC 90-866).

Under reg 3.25A, access to a sample of a deposited micro-organism may be restricted. The
applicant may notify the Commissioner at any time before a specification which discloses an
invention involving a micro-organism becomes open to public inspection (OPI), that a sample
of the deposited micro-organism is only to be provided to a person who is:

- a skilled addressee without an interest in the invention; and
- is nominated by the person who made the request for the certification authorising
  release of the sample.

The time period during which access to the sample is restricted begins when the
specification becomes OPI and ends when:

- a patent is granted on that application; or
- the application lapses, or is withdrawn or refused.

The Commissioner may, under the provisions of sec 223, extend the time for making the
notification. However, the Commissioner will not grant an extension of time until any
pending requests for certification authorising release of a sample have been dealt with.
Furthermore, if any request for certification is received before the grant of the sec 223
request, the sec 223 request is likely to be refused.
A PCT applicant may make use of the restrictive access provision, even though an application has not yet entered the national phase. In this situation, there will be no Ecase for the application when the restrictive access notification is received, as an Ecase is only created upon national phase entry in Australia.

When ERA receives a notification, this will be forwarded to the Supervising Examiner CHEM 1. The supervising examiner should:

1. Check that the notification has been made before OPI, is directed to the Australian Patent Office or the Commissioner and is consistent with reg 3.25A.

2. Prepare a letter to the applicant or attorney as indicated in 2.7 Annex B – Notification Regarding Release.

3. Forward the letter to COG, who will then send it to the applicant or attorney.

Under reg 3.29(1), a person other than the applicant or patentee may notify the Commissioner that the deposit requirements of sec 6(c) or sec 6(d) have ceased to be satisfied. These requirements are that:

- at all times since the end of the prescribed period, the specification has included:
  - i. the name of a prescribed depositary institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and
  - ii. the file, accession or registration number of the deposit given by the institution; and

- at all times since the date of filing of the specification, samples of the micro-organism have been obtainable from a prescribed depositary institution as provided by those rules.

The Commissioner must provide the applicant or patentee with a copy of the notice as soon as practicable (reg 3.29(2)).
If examiners have any reason to believe that a deposited micro-organism, which has been relied upon for compliance with sec 40, is no longer viable, the matter is to be referred to the Supervising Examiner CHEM 1 for the possible issuing of a notification under reg 3.29(3) to the applicant or patentee.

In order for a notification to be issued, the Commissioner need only learn of facts which may establish that a deposit requirement referred to in reg 3.29(1) has ceased to be satisfied. It is not necessary for the Commissioner to be satisfied that the deposit is not viable.

If there is a notice under reg 3.29(1) on file, and the applicant or patentee files proposed sec 104 amendments relating to sec 6(c) information (i.e. the name of the prescribed depositary institution and/or the file, accession or registration number of the deposit), the procedures outlined in 2.7.5.4 Amendment Procedure When Deposit Requirement Cease to be Satisfied should be followed.

Steps Required When Sec 6(d) Not Satisfied

Where the requirements of sec 6(c) or sec 6(d) cease to be satisfied:

- The applicant or patentee must make a new deposit of the same micro-organism with an IDA.

- The prescribed period for making the new deposit is from the date that the requirement ceases to be satisfied to:
2.7.7.2 The New Deposit

- the end of the period 3 months after the applicant, patentee or depositor of the micro-organism has received/been given certain notifications regarding the deposit requirements (reg 3.30(c)(i) to 3.30(c)(iii)); or
- the day on which the new deposit is made (reg 3.30(c)(iv)).
- A copy of the new deposit receipt must be filed before acceptance (reg 3.1(2)), or in the case of an accepted application or patent, within 3 months of the date of receipt of the micro-organism by the IDA (reg 3.23(2)).
- If a notice of entitlement is filed after the deposit requirements cease to be satisfied, it should reflect the details of the new deposit. Otherwise, the original notice will suffice.
- Where the new deposit is made outside the prescribed period specified above, the applicant or patentee must apply for an extension of time under sec 223. Once the extension has been granted, the new deposit is deemed to have been made within the prescribed period.

Steps Required When Sec 6(c) Not Satisfied

Where the requirements of sec 6(c) cease to be satisfied:
- The applicant or patentee must amend the specification to insert the details of the new deposit, i.e. the name of the prescribed depositary institution and the file, accession or registration number of the deposit.
- The prescribed period for amending the specification starts on the date that the requirement ceases to be satisfied and ends on the date of allowance of the amendment, unless:
  - the applicant, patentee or depositor of the micro-organism has received/been given certain notifications regarding the deposit requirements; and
  - the applicant or patentee has not asked for leave to amend the specification in the following 3 month period.
    (reg 3.30(d)(i) and 3.30(d)(ii); see also below)
- Where reg 3.30(d)(i) and/or reg 3.30(d)(ii) apply (see above), the applicant or patentee must apply for an extension of time under sec 223 in order to amend the specification. Once the extension has been granted, the amendment is deemed to have been allowed within the prescribed period.
2.7 Annex B - Notification Regarding Release

Dear

I acknowledge receipt of the notice under Regulation 3.25A filed 20 January 2010 with respect to application PCT/USXXXX/XXXXXX. As the notice has been received before the publication date of the application, the notice is effective with respect to the samples of materials deposited in accordance with the Budapest Treaty and disclosed in the patent application under the provision of the Regulation.

To ensure that our records are updated when this application enters the national phase in Australia, it would be appreciated if the applicant acknowledges this letter and notification under Regulation 3.25A when the request to enter the national phase is made.

Yours sincerely

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2.7 Annex C - Letter to Person Making Request for Certification

Dear

Thank you for your request under Regulation 3.25 for a certification authorising release of a sample of micro-organism ATCC CRL-12345. However, the request must be accompanied by a completed Form BP/12 - Request for the Furnishing of Samples of Deposited Microorganisms pursuant to Rule 11.3(a) of the Budapest Treaty.

Yours sincerely

---

2.7 Annex D - Notification to Applicant of Request for Release
Dear

A request under Regulation 3.25(1) for the release of a sample of micro-organism ATCC CRL-12345 has been received by the office. As there is no evidence on file that micro-organism ATCC CRL-12345 is a Budapest Treaty deposit, the office has assumed that the deposit was made under the Rules of the Budapest Treaty.

Please find enclosed copies of the request for certification, undertaking by the requestor, correspondence sent to the requestor and Form BP/12 for micro-organism ATCC CRL-12345.

In accordance with Regulation 3.25(3), before the Commissioner makes a decision, you are entitled to make submissions on the matter. You are therefore requested to, within one month of the date of this letter, provide submissions (if any) that you believe are appropriate to this matter.

Yours sincerely

2.8 Abstracts

Modified Date: 01 August 2018

2.8.1 Introduction

A complete application filed under the Act is required to include an abstract (reg 3.1(1)).

Examiners should note that an abstract is not to be taken into account for construing the nature of the invention that is the subject of the specification to which the abstract relates (reg 3.3(6)). However, an abstract filed with the complete specification may be taken into account in determining the allowability of amendments under sec 102(1).

Translation of Abstract

Although the translation of a PCT application may include a translation of the abstract, this is not part of the Australian complete specification, and its inclusion should be disregarded for all purposes pertaining to the complete specification. An abstract in this respect is to be taken to be any passage in the translation having the heading "Abstract".
2.8.2 Contents and Form

Abstract Requirements

An abstract must commence on a separate sheet and should be headed "Abstract". It is preferable that the abstract be on an unnumbered sheet that does not include line numbers.

An abstract must satisfy the requirements of reg 3.3, which are similar to the requirements of an abstract filed under the PCT. In particular, an abstract should be:

- a concise summary of the technical disclosure as contained in the description, the claims and any drawings, graphics or photographs.
- preferably in the range of 50 to 150 words. The abstract may contain chemical or mathematical formulae and tables. Wherever applicable, the chemical formula should be given which, among all the formulae contained in the specification, best characterises the invention.

In addition:

- each main technical feature mentioned in the abstract and illustrated by a drawing, graphic or photograph in the specification must be followed by a reference sign placed between parentheses.
- an abstract must not contain statements on the alleged merits or value of the invention or on its speculative application.
- an abstract may be based on a claim of the specification, provided the claim satisfies the requirements outlined above.

Drafting and Review of Abstract

In practice, examiners are required to draft an abstract when indexing an application if the applicant has failed to include an abstract. Examiners will also be required to draft an abstract if the applicant files a divisional application, but fails to file an accompanying abstract. When drafting an abstract, examiners should take into consideration the abstract requirements outlined above. The abstract should serve as an efficient scanning tool for searching purposes and, in particular, allow an assessment from the information it contains of whether there is a need to consult a full copy of the specification. The procedures for preparing an abstract are outlined in 5.6.6 Creating an Abstract.
2.8.3 Amendment of Abstract

Examiners are not required to formally review an abstract that has been provided by the applicant, in order to assess its compliance with reg 3.3. In the specific case of PCT national phase applications, reviewing and redrafting of the abstract should not be undertaken, as the abstract will have been established in the international phase.

In the case of national route applications (being applications which have been filed as a national application, rather than as a PCT international application which has then entered the national phase), examiners should only redraft the abstract if it is manifestly deficient to the extent that it is unable to fulfil its purpose.

Where an abstract is redrafted prior to becoming OPI, the requirements of reg 3.4(2) and reg 3.4(3), namely providing the applicant with a draft copy of the abstract, are met by publishing the abstract at OPI. The applicant is given a period of one month in which to provide comments for the examiner to consider. The abstract is then amended and republished if necessary. Similarly, if the abstract is redrafted between OPI and acceptance, publication of the abstract at acceptance as the abridgement affords an opportunity for the applicant to provide comments and for the abstract to be amended and republished where required.

Note: The information in this part only applies to:

• requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.

• requests to amend filed on or after 15 April 2013 for:
  • standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  • innovation patents with an examination request filed before 15 April 2013.
  • innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
  • standard patents granted, and innovation patents certified, before 15 April 2013.

For all other requests to amend, see 2.8.3A Amendment of Abstract.
The Act does not preclude the amendment of an abstract where it is a filed document. Thus, the abstract of a Convention application or other national route application may be amended under sec 104. However, the abstract of a PCT national phase application is not a filed document and therefore cannot be amended in the national phase. Where the applicant proposes to amend the abstract (or a translation thereof) of a PCT national phase application under sec 104, examiners should object that the amendment cannot be made and that the applicant propose an amendment to delete the item (see also PERP code [K20]).

Note: Where this is the only outstanding objection, examiners should accept the application, but add an “Assembly Note” to the file stating that the relevant amendment item is of no effect.

Note: Where this is the only outstanding objection, examiners should accept the application, but add an “Assembly Note” to the file stating that the relevant amendment item is of no effect.

2.8.3A Amendment of Abstract

Note: The information in this part only applies to:

- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.

- requests to amend filed on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.8.3 Amendment of Abstract.

Under reg 10.3(2), the amendment of an abstract is not allowable. Where the applicant proposes to amend the abstract (or the translation of the abstract of a PCT national phase application) under sec 104, examiners should object that the amendment cannot be made and that the applicant propose an amendment to delete the item (see also PERP code [K20A]).

Note: Where this is the only outstanding objection, examiners should accept the application, but add an “Assembly Note” to the file stating that the relevant amendment item is of no effect.
2.9 Patentability Issues

Modified Date: 01 August 2017

2.9.1 Overview

The following topics are covered in this chapter:

- 2.9.2 Patentable Subject Matter (Manner of Manufacture); and
- 2.9.3 Other Issues.

The topics ‘Patentable Subject Matter’ and ‘Other Issues’ reflect the headings used for categories of objections in examination reports.

The term ‘Patentable Subject Matter’ should be understood as being synonymous with ‘Manner of Manufacture’ and corresponds to issues that should be listed against ‘Patentable Subject Matter’ in the ‘Summary of Novelty, Inventive Step and Patentable Subject Matter’ section of the examination report.

Objections arising from patentability issues discussed in 2.9.3 Other Issues should be included in the ‘Other Issues’ section of the examination report. Such issues relate to, for example, sec 18(2) and sec 50(1) considerations.

2.9.2 Patentable Subject Matter (Manner of Manufacture)

2.9.2.1 Introduction

Note: In many situations, the circumstances which give rise to a manner of manufacture objection, or border upon doing so, will also give rise to an objection of lack of inventive step.
Thus, examiners should always consider the possibility of raising an inventive step objection in tandem with a manner of manufacture objection.

**Schedule 1** defines "invention" as:

"any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies, and includes an alleged invention".

**Subsection 18(1)(a)** states:

"an invention is a patentable invention for the purposes of a standard patent if the invention, so far as claimed in any claim is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies."

A similar provision applies for innovation patents (sec 18(1A)(a)).

The definition of "invention" in **schedule 1** therefore incorporates both the aspect of newness and the aspect of manner of manufacture, whereas sec 18(1)(a) and sec 18(1A)(a) omit reference to the aspect of newness.

Nevertheless, in the decision of the High Court in **NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd** 32 IPR 449 (which was confirmed by **Advanced Building Systems Pty Ltd and Anor v Ramset Fasteners (Aust) Pty Ltd** (1998) 152 ALR 604; (1998) AIPC 91-40; 40 IPR 243), the majority of the High Court concluded that "newness" was imported into sec 18(1)(a) to the extent that:

"the phrase “manner of manufacture within the meaning of section 6 of the Statute of Monopolies” in s 18(1)(a) should be understood as referring to a process which is a proper subject matter of letters patent according to traditional principles."

Thus, the expression "manner of manufacture" under the 1990 Act has the same meaning and involves the same concepts as the expression "manner of new manufacture" under sec 35(1)(aa) of the 1952 Act.

In **D’Arcy v Myriad Genetics Inc** [2015] HCA 35 the majority stated:

“The legislative history of the requirement for patentability imposed by s 18(1)(a) of the Act has been set out in previous decisions of this Court [40]. The question posed by the application of s 18(1)(a) may be framed as in NRDC [41]:

‘Is this a proper subject of letters patent according to the principles which have been developed for the application of s 6 of the Statute of Monopolies?’

That question is to be answered according to a common law methodology under the rubric of ‘manner of manufacture’ as developed through the cases, but consistently with ‘a widening conception of the notion [which] has been a characteristic of the growth of patent law.’ [42] That widening conception is a necessary feature of the development of patent law in the 20th and 21st centuries as scientific discoveries..."
inspire new technologies which may fall on or outside the boundaries of patentability
set by the case law which predated their emergence."

The scope of eligible subject matter, including products, methods and processes, is
therefore defined by principles established by the Courts in relation to specific cases. For a
list of some of these cases see 2.9. Annex A - History of Manner of Manufacture.

Overview

There is no simple test to determine whether or not a claimed invention is a manner of
manufacture. The principles that have been laid down in decided cases provide guidance
that must be applied on a case by case basis.

The following provides a general overview of the approach to the examination of manner of
manufacture. Examiners should also consult those parts of 2.9.2 Patentable Subject Matter
(Manner of Manufacture) dealing with specific subject matter for more detailed assistance.

Examination Practice

The assessment of whether an application defines patent eligible subject matter is
considered with respect to each claim.

In general, the principles set out in D'Arcy v Myriad Genetics Inc [2015] HCA 35 (Myriad),
Commissioner of Patents v RPL Central Pty Ltd [2015] FCAFC 177 (RPL) and other cases
suggest that examiners can approach the examination of manner of manufacture in a way
similar to that formulated by UK authority in Aerotel Ltd v Telco Holdings Ltd & Ors Rev 1
[2007] RPC 7 (Aerotel) as follows:

1. Construe the claim.
2. Identify the substance of the claim (what is the alleged or actual contribution?)

3. Ask whether the substance of the claim lies within established principles of what does not constitute a patentable invention (e.g. is it merely a scheme, plan, rules of gameplay, intellectual or genetic information?)

4. If not, consider whether the substance otherwise lies outside of existing concepts of manner of manufacture and is to be treated as a “new class” of subject matter. (This leg of the approach will only be used in rare situations; see Is the Claim for a "New Class" of Subject Matter? below).

The approach of looking at the contribution, “inventiveness or ingenuity”, for the purpose of determining whether a claimed invention is a manner of manufacture, is not the same as a determination of whether a claimed invention is lacking novelty or an inventive step under sec 18(b). Manner of manufacture is an assessment of the substance of the invention, whereas obviousness and novelty are assessed by consideration of the subject matter of the claim. An invention may not be obvious under sec 18(b) but, in substance, lie in excluded subject matter under the separate requirement for a manner of manufacture.

Put another way, manner of manufacture assesses whether the contribution of the invention is directed to the “type” or “nature” of subject matter that should attract patent protection, whereas novelty and inventive step assess whether the contribution is “significant enough” or “whether the degree of contribution sufficiently advances the art” when compared to the prior art. Similar understanding has been applied by UK authority in Lantana Limited v The Comptroller General of Patents, Design and Trade Marks [2014] EWCA Civ 1463 (Lantana), where it was noted by Kitchin L.J that:

“There is no inconsistency between an acceptance that an invention embodied in a claim is new and inventive and a finding that the contribution it makes falls solely within excluded subject matter. The former requires a consideration of the claimed invention and an assessment of whether it forms part of the state of the art or is merely an obvious step. The latter requires consideration of whether the contribution made by the invention falls solely within one or more of the exceptions to patentability.”

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**Construe the Claim**

The normal rules of construction apply when determining the scope of a claim for this purpose (see 2.11.2 Construction of Specifications). Examiners should however be very careful in considering broad or indefinite terms, or adopting constructions suggested by the
applicant that pre-empt a determination of the substance of the invention, for example, by taking an unduly broad or narrow construction of the claim.

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Identify the Substance of the Claim

In order to determine the substance, examiners must identify the central underlying invention embodied in the claim, rather than merely consider the literal form of the claim. This is the contribution the claimed invention makes to the art and is determined based on a reading of the specification as a whole and examiners’ understanding of the common general knowledge and prior art.

Relevant factors to consider when identifying the substance of the claimed invention include:

- The form of words, breadth and emphasis of the claim.
- How does the invention work?
- What problem does it address?
- What are the advantages of the invention?
- What does the invention add to the state of the art as at the priority date?

In addition to the Myriad and RPL decisions, the UK authorities following Aerotel (see for example HTC Europe Co Ltd v Apple Inc [2013] EWCA Civ 451) provide useful guidance in identifying the substance, or, in other words, identifying the alleged or actual contribution of a claimed invention for this purpose. Jacob L.J. stated in Aerotel:

“43 The second step—identify the contribution—is said to be more problematical. How do you assess the contribution? Mr Birss submits the test is workable—it is an exercise in judgment probably involving the problem said to be solved, how the invention works, what its advantages are. What has the inventor really added to human knowledge perhaps best sums up the exercise. The formulation involves looking at substance not form—which is surely what the legislator intended.

44 Mr Birss added the words ‘or alleged contribution’ in his formulation of the second step. That will do at the application stage—where the Office must generally perforce accept what the inventor says is his contribution. It cannot actually be conclusive, however. If an inventor claims a computer when programmed with his new program, it will not assist him if he alleges wrongly that he has invented the computer itself, even if he specifies all the detailed elements of a computer in his claim. In the end the test...
must be what contribution has actually been made, not what the inventor says he has made."

Consequently while examiners can take into account what the specification asserts is the contribution made by the invention, and can even make an assessment by way of consideration of the common general knowledge, the substance is to be determined on an objective rather than subjective basis. In order to do this, consideration should be given to the claimed invention and the contribution that it makes to the art. Logically this consideration may take into account the prior art at the priority date rather than merely common general knowledge. In this regard, any finding in relation to manner of manufacture is independent of the particular drafting of the specification in question, and is not affected by the failure of a specification to discuss a particular piece of art that may alter an assessment of patentability on the face of the specification alone.

While consideration can be given to individual prior art publications when assessing patentability, examiners can also simply rely on their own knowledge and are not required to do additional searching to establish the state of the art for this purpose. Such an approach was taken in RPL, where their honours took into account "well-known search and processing functions of a computer". Care must be taken not to determine the substance of the claimed invention merely on the basis of excluding known features in the claims, as the substance of the claim may lie in the particular combination of integers.

As indicated by Kitchen L.J. in Lantana:

"64 I accept Mr Beresford's submission that it is the claim as a whole which must be considered when assessing the contribution which the invention has made, and that it is not permissible simply to cut the claim into pieces and then consider those pieces separately and without regard to the way they interact with each other. Thus in Symbian Ltd v Comptroller-General of Patents [2008] EWCA Civ 1066, [2009] RPC 1, Lord Neuberger (giving the judgment of the court) said at [37] (referring to decision T0208/84 Vicom Systems Inc/Computer related invention [1987] OJ EPO 14, [1987] 2 EPOR 74 at [37]):

‘Finally at [16] the Board described “making a distinction between embodiments of the same invention carried out in hardware or in software” as “inappropriate”, as what is decisive is “the technical contribution which the invention described in the claim when considered as a whole makes to the known art”.’

A useful way of approaching this issue in the context of computer related inventions, particularly when dealing with claims involving physical system architecture, is to consider which features of the claim confer novelty over the prior art. For example, where the system architecture is known apart from the particular program that is operating, the substance of the claim will generally be the program and not the system. On the other hand, where the claim is directed to a novel architecture it is sometimes helpful to ask whether the individual integers are known in the art, and/or whether the combination of the integers gives rise to a
new physical computer system/device that does more than merely automate a process. If the system includes conventional computer hardware used in its normal way, it is unlikely that the conventional hardware forms part of the substance. In considering the substance of a claimed invention it will often not matter in what form the invention is claimed. The substance can be the same whether claimed as a product, method or system. However, each case needs to be considered on its particular facts. For example, if the substance of a claim is a mere discovery, another claim directed to an application of that discovery may be in substance a patentable invention (see 2.9.2.5 Discoveries, Ideas, Scientific Theories, Schemes and Plans).

Care should also be taken that words invoking a particular technical context do not unduly influence the assessment of the claimed invention’s substance. In other words, claims that define detailed technical features may mask the true nature of the invention.

An analysis of the substance of the invention in this way is consistent with the approach taken by the Court in RPL and its reasoning in the following paragraphs:

“110. RPL Central does not claim any invention or ingenuity in any program or operation of a computer, or implementation by a computer to operate the method. Accordingly, the ingenuity of the inventors must be in the steps of the method itself. The method does utilise the speed and processing power and ability of a computer but there is no suggestion that this is other than a standard operation of generic computers with generic software to implement a business method. This is the method of taking the information as to available criteria for Units of Competency and reframing those criteria into questions and presenting them to, and receiving the answers from, the user together with any documents that the user wishes to append. The reframing of the criteria into questions may be outside the generic use of a computer but the idea of presenting questions, by reframing the criteria, is that: an idea. It is not suggested that the implementation of this idea formed part of the invention. Indeed, no instruction as to such programming is provided in the specification other than the idea of turning the performance criteria provided by the NTIS into a question by prepending or otherwise inserting a form of words.

111. The problem may be one of confronting the ‘maze’ of available information concerning the RPL of different Units of Competency in different institutions, but the solution to that problem, to be patentable, must involve more than the utilisation of the well-known search and processing functions of a computer, for example an invention in the way in which the computer is utilised.

112 Recognising that the claims are to a method and system comprising a combination of integers, it is necessary to understand where the inventiveness or ingenuity is said to lie. Turning to the integers of the invention as set out at [36] and [38] and summarised at [37] and [39] above, it is apparent that, other than the integers providing that the computer processes the criteria to generate corresponding questions and presents those questions to the user, the method does not include any
2.9.2.2 Principles for Examination

steps that are outside the normal use of a computer. It is not suggested that the creation of the plurality of assessable criteria themselves form the basis of the claimed invention. They are present on the NTIS website from which they are retrieved. It is not suggested that the presentation of the questions or the processing of the user’s responses involve ingenuity themselves or that this constitutes the requisite manner of manufacture.”

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Is the Substance of the Claim Patentable in View of Established Principles?

In most cases where the issue arises, the substance of a claimed invention can be assessed against existing concepts of manner of manufacture that have been developed through case law. Consequently the question will normally be whether the substance of the invention falls within an established category of ineligible subject matter (for example, the fine arts, discoveries, or schemes). If so, then the invention does not relate to patent eligible subject matter. How the assessment made is dependent on the particular exclusion and specific guidance is provided in 2.9.2 (Patentable Subject Matter) Manner of Manufacture.

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Is the Claim for a “New Class” of Subject Matter?

If the substance of a claimed invention appears not to fall within established concepts of manner of manufacture and does not fall within established exceptions, it is considered to be a “new class” requiring special consideration as set out in Myriad at [28].

To decide whether a claim relates to a “new class”, the relevant consideration is whether the Courts have previously dealt with subject matter of that type and whether that subject matter has been excluded in the context of manner of manufacture.

In general, the Courts have indicated that, subject to other requirements and aside from particular exceptions, patents are available for products, methods of making and using products and methods that otherwise result in a new and useful effect. Technical subject matter that has been previously considered by Courts without rejection includes:

- Recombinant or isolated proteins.
- Pharmaceuticals and other chemical substances.
Objecting to Manner of Manufacture, Novelty and Inventive Step

Key points (see below for further explanations):

1. When there is clearly no patentable subject matter in a specification, examiners should consider reserving opinion on novelty and inventive step.

2. A manner of manufacture objection does not need to be taken merely because a claim is not novel/not inventive. These are separate considerations.

3. In exceptional circumstances, examiners can reserve opinion on manner of manufacture if discerning the substance of the claimed invention is impractical.

Where the invention claimed is clearly not in respect of a manner of manufacture and it is not readily apparent what subject matter might reasonably be expected to be claimed, examiners should consider whether it is appropriate to restrict their report, e.g. with respect to novelty and inventive step (see 2.1.4A Restriction of the Extent of the Report).

A common sense approach should apply to situations where the substance of a claimed invention clearly falls within the realm of patentable subject matter, but claim(s) are either plainly not novel or not inventive. In such a situation a manner of manufacture objection will not be relevant.

In cases where a claim is not novel or clearly not inventive, the way in which the novelty and/or inventive step objection could potentially be overcome may be important to a conclusive determination of manner of manufacture. The following approach is reasonable:

- If the body of the specification only describes technical features which, when added to the claim to distinguish it from the prior art, would result in a technical contribution
to the art, then the claim is clearly for a manner of manufacture and a manner of manufacture objection should not be taken.

- If the body of the specification only describes non-technical features which, when added to the claim to distinguish it from the prior art, would result in a non-technical contribution to the art, then a manner of manufacture objection should be taken. The substance of the claimed invention is to be determined on the basis of the non-technical alleged contribution derived from reading the specification as a whole in light of the common general knowledge.

- If the body of the specification contains both technical and non-technical features then, depending on what feature is added to the claim to distinguish it from the prior art, the contribution to the art could be either technical or non-technical. In such exceptional situations, it may be appropriate to reserve opinion on manner of manufacture where the substance is not readily discernible.

Where a novelty or inventive step objection provides more detailed information, it is acceptable for examiners to focus an objection as to a lack of manner of manufacture simply upon those features that comprise the substance of the invention without particular regard to other features of the claim that lie outside of the alleged contribution.

Examiners should not avoid a consideration of manner of manufacture simply because a novelty/inventive step objection is in place.

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**Australian Precedential Relationship with Principles of Aerotel**

The approach to assessing the substance of the invention as guided by Aerotel, whereby the substance of the invention is considered to be the alleged or actual contribution to the prior art, resonates with Virginia-Carolina Chemical Corp's Application [1958] RPC at page 37, lines 11-13, where Lloyd-Jacob J stated:

“In considering whether or not an application discloses a patentable invention, it is proper that attention should be directed to the alleged contribution to the art rather than the form of the words tentatively put forward as defining the invention.”

Assessing patentability in this way is not inconsistent with the law articulated by the High Court in NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd 32 IPR 449 which provides for a threshold requirement that an “alleged” invention must possess the necessary quality of inventiveness, i.e. be an “alleged invention”, on the face of the specification. Here, their honours in majority said that if the threshold is not met, then “one need go no further”.

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Effective Date: 25 September 2019
2.9.2.3 "Alleged Invention"

The definition of "invention" given in schedule 1 states that invention:

"includes an alleged invention".

The High Court in *Advanced Building Systems Pty Ltd and Anor v Ramset Fasteners (Aust) Pty Ltd* (1998) 152 ALR 604; (1998) AIPC 91-401; 40 IPR 243, explained this as follows:

"The phrase 'and includes an alleged invention' is directed to the inquiry at the stage of examination of an application before the decision as to acceptance."

The Court followed the earlier decision of *Commissioner of Patents v Microcell Ltd* (1959) 102 CLR 232 at page 236, in which Menzies J stated:

"... I regard the last words of the definition of "invention" (which have their origin in the Patent Design and Trade Marks Act 1883, sec 46) as intended to do no more than make clear that when an application is made it can proceed in accordance with the Act without the application having to establish as a pre-requisite to any step being taken that it is for an invention, i.e. a manner of new manufacture and that the Commissioner is not bound by the applicant's allegation that his manner of manufacture is new any more than by the allegation that what is claimed is a manner of manufacture."

(see also *Rogers v Commissioner of Patents* (1910) 10 CLR 701).

2.9.2.4 Fine Arts

Inventions which are in the realms of "the fine arts" have traditionally been considered non-patentable. "Fine arts" are usually taken to include those arts which are the product of human intellectual activity which seek expression through beautiful or significant modes, as painting, sculpture, music and other aesthetic creations.

Consequently, in assessing the patentability of an invention which appears to encompass the field of fine arts, it will be necessary to consider whether an aesthetic or artistic effect, as distinct from a technical feature, is involved. The pure aesthetic effect of an article will not be patentable, however if the article also has a technical feature, it may be patentable, for
example a tyre tread. A process or means for creating an aesthetic affect may comprise a technical innovation and thus be patentable.

Overview

The following have traditionally been regarded as non-patentable subject matter, since they do not meet the requirements of a manner of manufacture:

- discoveries with no means of putting them into effect;
- mere ideas;
- mere schemes or plans;
- scientific theories; and
- mathematical algorithms.

The critical question to consider is whether the claimed invention relates to non-patentable or patentable subject matter. This can be answered by determining whether the claimed invention lies in the intellectual or academic realm, or the technical or practical realm. Technical or practical matter is patentable.

Examiners should note that an invention where the inventive element resides solely in a discovery, idea, scientific theory or mathematical algorithm may still be patentable. Consequently, it is necessary to consider the contribution made by the invention as a whole, without regard for its individual parts and the individual contributions they may make.

Discoveries
Case Law

The High Court in National Research Development Corporation v Commissioner of Patents (1959) 102 CLR 252; (1961) RPC 134 (NRDC), citing with approval the view expressed by Lindley LJ in Lane Fox v Kensington and Knightsbridge Electric Lighting Company (1892) 3 Ch. 424, stated:

".....a man who discovers that a known machine (his Lordship might equally have said a known substance) can produce effects which no one before him knew could be produced by it has made a discovery, but has not made a patentable invention unless he so uses his knowledge and ingenuity as to produce either a new and useful thing or result, or a new and useful method of producing an old thing or result."

(see also Hayasibara Co.'s Patent (1977) FSR 582 at 590 and Reynolds v Herbert Smith (1903) 20 RPC 123 at 126).

However, no general definition can be given as to what constitutes a discovery as opposed to an invention. The Court in NRDC (supra) stated:

"The truth is that the distinction between discovery and invention is not precise enough to be other than misleading in this area of discussion. There may indeed be a discovery without invention - either because the discovery is some piece of abstract information without any suggestion of a practical application of it to a useful end, or because its application lies outside the realm of 'manufacture'."

Examples

A chemical substance or micro-organism which is discovered in nature without any practical application is a "mere chemical curiosity" and not patentable subject matter.

More commonly, a specification will provide some practical application for an isolated substance or micro-organism. Although such subject matter is potentially patentable, examiners should consider whether the claims distinguish the micro-organism or substance from those forms which already exist in nature.

Thus, a micro-organism, protein, enantiomer or antibiotic discovered in nature can be claimed in its isolated form, or as substantially free of (specified) impurities (see also 2.9.2.14 Micro-Organisms and Other Life Forms).

Where a gene is claimed in its recombinant or isolated or purified form, see 2.9.2.6 Nucleic Acids and Genetic Information.

An example of subject matter which would constitute a discovery, and not an invention, would be where a known material is found to have a hitherto unknown property. However, if the discovery leads to the conclusion that the material can be used for making a particular
article or in a particular process, then the article or process may be patentable. For example, determining that a particular known material is able to withstand mechanical shock is a discovery and therefore unpatentable. However, a claim to a railway sleeper made of the material would be regarded as patentable (see also 2.9.2.17 New Uses).

New Principle

Where a discovery is a new principle with a practical application, the inventor is entitled to claim broad patent protection. However, care is necessary to distinguish between:

- genuine new principles;
- principles of which practical applications were known although the principle was unrecognised; and
- solutions to problems.

Claims directed to a principle per se are not allowable. However, claims directed to a "principle" coupled to a general method of manufacture may be allowable, provided the principle is new and at least one mode of carrying it into effect is disclosed (see R.C.A. Photophone Ltd. v Gaumont-British Picture Corporation (1936) 53 RPC 167).

In David Kahn Inc. v Conway Stewart (1974) RPC 279, it was stated at pages 319 and 320:

"A patentee may rightly claim a monopoly wider in extent than what he has invented. If he has discovered a general principle or invented a general method and discloses one way of carrying it out, he may claim all ways of carrying it out, but 'he is not entitled to claim a monopoly more extensive than is necessary to protect what he has himself said is his invention'. He cannot claim all solutions to a problem unless invention lies in the identification of the problem."

However, a wide claim to an application of a principle must not be so extensive as to amount to any method of solving a particular problem (see British United Shoe Machinery Co. Ltd. v Simon Collier Ltd. (1909) 26 RPC 21). Often an objection that the claims are not supported by matter disclosed in the specification (sec 40(3)) will be applicable.

Ideas

A mere idea is not patentable subject matter. In Hickton's Patent Syndicate v Patents and Machine Improvements Co. Ltd. (1909) 26 RPC 339 at 348, it was stated:
"No doubt you cannot patent an idea, which you have simply conceived, and have suggested no way of carrying it out, but the invention consists in the thinking of or conceiving something and suggesting a way of doing it.....I think you can have a Patent for an idea, which is new and original and very meritorious, if you suggest a way of carrying it out. If you do not so suggest, you cannot no doubt have a patent.....".

(see also Thomas & Anor v Chappell & Anor (1991) AIPC 90-798).

Schemes and Plans

In Grant v Commissioner of Patents [2006] FCAFC 120, the Full Federal Court affirmed that “Business, commercial and financial schemes as such have never been considered patentable” and pointed out that patents have been refused for methods of calculation, theoretical schemes, including business schemes and abstract plans, such as:

- systems for arrangement of known things, such as a plan relating to the layout of houses in a row or terrace so as to prevent overlooking (Re ESP’s Application (1944) 62 RPC 87);
- an arrangement of buoys for navigational purposes (Re W’s Application (1914) 31 RPC 141);
- a system of business even though its implementation involved the use of a printed envelope with a particular arrangement of words (Re Johnson’s Application for a Patent (1901) 19 RPC 56 at 56); and
- a method of preventing the fraudulent re-use of sales book dockets and books used in that connection (Re Brown (1899) 5 ALR 81).

It further stated that it has long been accepted that "intellectual information", a mathematical algorithm, mere working directions and a scheme without effect are not patentable.

See also Research Affiliates LLC v Commissioner of Patents [2014] FCAFC 150 and Commissioner of Patents v RPL Central Pty Ltd [2015] FCAFC 177, which emphasised the need for the substance of the claimed invention to be patentable subject matter (for detailed guidance regarding determination of the substance of the invention, see also 2.9.2.2 Principles for Examination and 2.9.2.7 Computer Implemented Inventions - Schemes and Business Methods).

In considering whether the substance of the claimed invention is a scheme or plan it is necessary to go beyond the form of words used. The alleged invention is to be understood in the context of the specification as a whole and the relevant common general knowledge.
For example, the substance of an alleged invention may be a scheme even if the claims literally define or otherwise involve a physical product which is the subject of the scheme.

Limiting the claims to a technological environment may not alter the fact that what is claimed is a scheme or abstract idea. For example, a method of extracting oil from a well characterised by a scheme to maximise profit by allocating pumping resources according to customer demand is still a business scheme, even if tied to a technical activity.

A method or process that is more than a mere scheme or plan will, as a matter of substance, involve a technological aspect reflected in a material effect or advantage within the principles expressed by the High Court in *NRDC* [1959] HCA 67. Examples of such methods include producing electrical oscillations (*Rantzen’s Application* (1947) 64 RPC 63), a weed-free tract of sown land (*NRDC*), a fog-free atmosphere (*Elton and Leda Chemicals Ltd.’s Application* (1957) RPC 267) or a fire quenched subterranean formation (*Cementation Co. Ltd.’s Application* (1945) 62 RPC 151).

In cases where a dependent claim defines a scheme but incorporates patentable subject matter defined in an independent claim, for example a new and inventive method for producing a drug further characterised by a scheme for marketing the drug to medical practitioners, it is not necessary to object provided the claim is truly dependent. In that case the claim is directed to more than a mere scheme and, in any event, defines something already within the right to exploit the patentable invention (e.g. to hire, sell etc).

(see also 2.9.2.7 Computer Implemented Inventions – Schemes and Business Methods and 2.9.2.9 Games and Gaming Machines)

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### Scientific Theories and Mathematical Algorithms

Scientific theories are themselves not patentable, regardless of how radical or revolutionary their insights may be. However, if they lead to practical applications, those applications may be patentable. Similarly, mathematical algorithms are not patentable, however their application may be (see 2.9.2.10 Mathematical Algorithms).

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### Laws of Nature
The discovery of laws or principles of nature or science is not patentable subject matter. However, the application thereof to produce a particular practical and useful result may be patentable.

Where an invention appears to contravene a well-known law of nature (for example, perpetual motion machines), examiners should refer to the procedures outlined in 2.11.3.11 Contravention of Laws of Nature – e.g. Perpetual Motion Machines.

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**Section 40 Considerations**

Where the specification does not disclose any means of putting an idea/scheme/plan/discovery etc into effect, then in addition to a manner of manufacture objection, examiners should consider whether the requirements of sec 40(2) have been met. Alternatively, a specification may disclose a means of putting such an invention into effect, however the claim may not be so limited. In such situations, the claims are likely to lack support under sec 40(3) in addition to failing the manner of manufacture requirements.

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**Modified Date: 01 August 2017**

**2.9.2.6 Nucleic Acids and Genetic Information**

In this topic:

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**Overview**

In *D'Arcy v Myriad Genetics Inc* [2015] HCA 35 (*Myriad*), the High Court considered whether an isolated nucleic acid is a “manner of manufacture” within the meaning of sec 6 of the Statute of Monopolies.

The decision relates to Myriad’s patent (686004) for isolated nucleic acid sequences encoding a mutant or polymorphic BRCA1 polypeptide. The claimed sequences contained specified mutations or polymorphisms in BRCA1 that are indicative of susceptibility to cancer. The High Court was asked to determine whether claims 1 – 3, directed to the isolated BRCA1 nucleic acid and mutants and polymorphisms thereof, defined patent eligible subject matter (i.e. a manner of manufacture).
The High Court unanimously held that claims 1 – 3 did not define a manner of manufacture. The Court found that, while formulated as claims to a product (i.e. a nucleic acid molecule), the substance of the invention resides in the information embodied in the sequence of nucleotides of the molecule. The Court concluded that the information incorporated in the isolated nucleic acid sequence reproduced a relevant sequence of nucleotides existing in a human being and is therefore information that is not “made”.

The Court made clear that it was not concerned with “gene patenting” generally and did not make any finding with respect to the remaining claims of the patent directed to probes, vectors, methods of production and methods of diagnosis.

The decision does not set out a general rule that isolated natural products or their derivatives are excluded from patentability. The majority did not engage in a debate about “products of nature” versus “artificially created products”, but found that, in a case where the substance of the claimed invention was genetic information that was not “made”, the claiming of the alleged invention as an isolated product did not confer patent eligibility. The substance was therefore outside the established bounds of patentability and extending the concept of manner of manufacture to that subject matter was not justified.

Notwithstanding the other requirements of patentability (e.g. utility, novelty, inventiveness), the key principles that determine the patentability of claims directed to nucleic acids or genetic information are:

1. What is the substance of the claim?
2. Is the substance of the claim “made”?

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**What is the Substance of the Claim?**

In determining the substance of the claim, examiners should consider the claimed invention in light of the description.

In *Myriad*, the Court found that the substance of the claims was genetic information, even though the claims were drafted as product claims. In determining the substance of the claim it is important to consider the description, and how the invention works, as well as the claim itself. For a more detailed discussion on how to determine the substance of the invention, refer to [2.9.2.2 Principles for Examination](#).

In practice, as DNA and RNA are both carriers of genetic information, any claim to a sequence of nucleotides that reproduces genomic DNA is likely to be in substance directed to genetic information. This will be the case even when the nucleic acid claimed represents a
lesser part of the full length nucleic acid molecule, for example a fragment, primer or interfering molecule.

In contrast, where a claim is directed to a method or process that makes use of a nucleic acid molecule, the substance of the claim will normally reside in that process for producing a particular outcome, for example a method of diagnosis. In this situation, provided the invention as claimed has economic utility the subject matter claimed will be a manner of manufacture.

Is the Substance of the Claim "made"?

The second question considered by the Court was whether the substance of the claim had been "made" or changed by human intervention.

When examiners consider the question of whether the substance of a claim is “made”, they should compare the state of affairs before the invention and as a result of the invention. When dealing with genetic information, if the claimed nucleic acid sequence conveys the same information as a sequence of nucleotides in the genome of an organism, plant or animal, the state of affairs before and after the invention is the same, and therefore the substance of the invention cannot be considered “made”. That is, the act of isolation, purification or synthesis is not enough to confer patentability in this situation. This is the case even when the molecule is man-made (for example cDNA) if the genetic information in the man-made molecule is the same as that in the genome of an organism, because the genetic information conveyed by the claimed molecule has not been changed, and therefore cannot be considered “made” for the assessment of manner of manufacture. In Myriad, the Court found that the genetic information stored in the sequence of nucleotides coding for the mutated or polymorphic BRCA1 polypeptide is the same as that contained in the natural DNA. In addition, the existence of that information was an essential element of the invention claimed.

In contrast, where the information in a nucleic acid does not have a counterpart in the genome of an organism, plant or animal, the genetic information can be considered “made” or artificial, and therefore represents a manner of manufacture.

A nucleic acid may also provide patentable subject matter when the substance of a claim is determined to be a product and not genetic information. For example, a nucleic acid microarray is more than merely genetic information. Instead, the substance of the claim is a product which has been “made”.
Under Australian law, there are no specific exclusions for software or methods that are implemented as computer software or a related product. However, they are only patentable if what is claimed “as a matter of substance” meets the requirements for a manner of manufacture and in particular is not a mere scheme, abstract idea or mere information (see 2.9.2.5 Discoveries, Ideas, Scientific Theories, Schemes and Plans).

In Research Affiliates LLC v Commissioner of Patents [2014] FCAFC 150 (Research Affiliates) and Commissioner of Patents v RPL Central Pty Ltd [2015] FCAFC 177 (RPL) the Full Federal Court considered computer implemented business methods and found that the presence of computing hardware or processing steps within a claimed method or system was insufficient to confer patentability. The Court identified a distinction “between the employment of an abstract idea or law of nature and the idea or law itself” and “between technological innovation which is patentable and a business innovation which is not”. From those decisions and other relevant authorities, the following principles are to be applied to the examination of computer implemented subject matter:

- Each case must be considered on its merits.
- In considering whether the substance of the claimed invention is a scheme, abstract idea or mere information, it is necessary to go beyond the form of words used. The alleged invention is to be understood in the context of the specification as a whole and the relevant common general knowledge and prior art. For example, the substance of an alleged invention may be a scheme even if the claims literally define a physical product, e.g. a system or computer when programmed to carry out a scheme (see also 2.9.2.2 Principles for Examination).
- There are a number of considerations that may be relevant to whether a computer related invention is in substance a manner of manufacture. These considerations, appearing in Grant v Commissioner of Patents [2006] FCAFC 120, Research Affiliates and RPL, were summarised in Aristocrat Technologies Australia Pty Limited [2016] APO 49 at [35] and include:
  - whether the contribution of the claimed invention is technical in nature.
2.9.2.7 Computer Implemented Inventions - Schemes and Business Methods

- whether the invention solves a technical problem within the computer or outside the computer or whether it results in an improvement in the functioning of the computer, irrespective of the data being processed.

- whether the claimed method merely requires generic computer implementation.

- whether the computer is merely an intermediary or tool for performing the method while adding nothing of substance to the idea.

- whether the ingenuity in the invention is in a physical phenomenon in which an artificial effect can be observed rather than in the scheme itself.

- whether the alleged invention lies in the way the method or scheme is carried out in a computer.

- whether the alleged invention lies in more than the generation, presentation or arrangement of intellectual information.

- Simply putting a business method or scheme into a computer is not patentable unless there is an invention in the way the computer carries out the scheme or method.

- It is not determinative that the claimed method can only be implemented in a computing environment. For example, a scheme for the presentation of internet advertising is not a manner of manufacture simply because the application and utility of the scheme is limited to the internet.

- Similarly, the limitation of the claims to other technological environments may not alter the fact that what is claimed is a scheme or abstract idea. For example, a method of extracting oil from a well characterised by a computer implemented scheme to allocate pumping resources according to customer demand is still a scheme, even if notionally tied to a technical activity.

- However, when the invention in substance lies in the application of computer technology (for example a technical solution to a technical problem) or in an improvement in computer technology, it will generally be considered patent eligible, subject to other requirements. For example, a claim directed to computer processing apparatus for assembling text in Chinese language characters using a non-Chinese keyboard (CCOM v Jiejing 28 IPR 481; (1994) AIPC 91-079) and the production of an improved curve image by computer (International Business Machines Corporation v Commissioner of Patents (1991) 33 FCR 218) have been held to be patentable.

- Computer related inventions may be claimed in different forms. For example a processing apparatus characterised by its method of operation;

- software or programs in a machine readable form causing a computer to operate in a particular way;
2.9.2.7 Computer Implemented Inventions - Schemes and Business Methods

- a computer, when programmed with code (source or executable) to operate in a particular way; and
- a computer implemented method.

However it is important to remember that the invention needs to be assessed as a matter of substance and the form of the claims does not influence this assessment.

See also 2.9.2.9 - Games and Gaming Machines.

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**Example: Performing Business Interactions Using Computing Devices**

Often a claim is directed towards aspects of business interactions and transactions performed with the use of computing devices. An example of a claim is provided below. It relates to the sharing of information between a customer and a merchant essentially using mobile phone technology.

1. A method of performing financial transactions, comprising:
   - receiving, by a processor, location information of a user from a user device;
   - determining, by the processor, a location of the user based on the location information;
   - determining, by the processor, whether one or more sellers are within a predetermined distance of the location of the user; and
   - communicating payment information of a selected seller from the one or more sellers to the user device if the selected seller is within the predetermined distance of the location of the user.

The substance of the claim is the determination of whether a seller is within a predetermined distance of a user and subsequently communicating payment information to the user if the seller is within a certain distance of the user. Here, the “processor” and “user device” are merely performing their usual independent function, there being no improved operation of the relevant technology. As a result, the substance of the claim is directed to a mere scheme for information sharing. However, if the substance of the invention determined from the specification as a whole related to the way that the position was determined in that there was an improvement in the technology used to carry out the method, then a claim directed to this subject matter would likely be patentable.
2.9.2.7 Computer Implemented Inventions - Schemes and Business Methods

Early Case Law Examples

International Business Machines Corporation v Commissioner of Patents
(1991) 22 IPR 417

The use of a mathematical formula in a computer to produce an improved curve image was held to be patentable, since the production of the improved curve image is a commercially useful effect in computer graphics. Specifically Burchett J found:

“Although there was nothing new about the mathematics of the invention what was new was the application of the selected mathematical methods to computer, and, in particular, to the production of the desired curve by the computer. This involved steps which were foreign to the normal use of computers and, for that reason, were inventive. A method of producing that by computer, which is novel and inventive, is entitled to the protection of the patent laws.”

The use of floating point arithmetic was common for processing such algorithms for generating curves (having problems of lack of speed and inaccuracy). This invention however, claimed that calculations were performed without the use of floating point arithmetic. At the time of the invention it was new and non-obvious to perform such mathematical algorithms in a computer, using something other than floating point arithmetic (more specifically, integer arithmetic). This integer arithmetic, as described in the specification, comprised a particular way of performing calculations using components of a computer that changed the way a computer normally worked. It followed that the claim was directed to a process containing steps that was foreign to the normal use of computers.

CCOM Pty Ltd v Jiejing Pty Ltd [1994] FCA 1168

The described apparatus in a broad sense consisted of conventional computer equipment including a database, a visual display and a keyboard. Generally, CCOM claimed an interface with a database that contained a data structure of Chinese language characters which encoded strokes by stroke type and in an order in which the strokes are written (if writing by hand). The claim also defined software that presented the strokes on the display for the user. The interface also provided a retrieval program and graphic representation of each character that enabled the user to select the character using the keyboard. The overall outcome was an efficient way of retrieving Chinese characters. Cooper J found that:

“The NRDC Case (102 CLR at 275-277) requires a mode or manner of achieving an end result which is an artificially created state of affairs of utility in the field of economic endeavour. In the present case, a relevant field of economic endeavour is the use of word processing to assemble text in Chinese language characters. The end result achieved is the retrieval of graphic representations of desired characters, for
assembly of text. The mode or manner of obtaining this, which provides particular utility in achieving the end result, is the storage of data as to Chinese characters analysed by stroke-type categories, for search including ‘flagging’ (and ‘unflagging’) and selection by reference thereto.”

While the decision did not say it, an improved data structure that facilitates the easier or improved finding of items in a computer implemented searching device has a material advantage. It is not business administration, nor merely information.

This decision makes it apparent that software related inventions can be patentable in Australia.

Note: Where a question arises as to whether an invention relating to printed matter is a manner of manufacture, consideration should also be given to whether the invention meets the requirements for inventive step.

Any presentation of information characterised solely by the content of that information has traditionally been non-patentable. In Virginia-Carolina Chemical Corp’s Application [1958] RPC 35, it was considered that the intellectual or visual content of a paper, film or other medium related to the fine and not the useful arts. The court in Pitman’s Application [1969] RPC 646 took a similar approach, in observing that any matter having a purely intellectual, literary or artistic connotation was not patentable.

See also Research Affiliates LLC v Commissioner of Patents [2014] FCAFC 150 and Commissioner of Patents v RPL Central Pty Ltd [2015] FCAFC 177.

The mere fact that physical apparatus may be involved in the presentation of information will not be sufficient to avoid the exclusion from patentability. Thus, the exclusion applies whether a claim is directed to:

- the presentation of the information per se, for example by acoustical signals, spoken words or visual display.
- information recorded on a carrier, for example books characterised by their printed subject matter, gramophone records characterised by the musical piece recorded, an electronic medium characterised by the nucleotide or protein sequence data recorded thereon (see also 2.9.2.6 Nucleic Acids and Genetic Information) or magnetic computer tapes characterised by the data or programs recorded (note,
however, 2.9.2.7 Computer Implemented Inventions - Schemes and Business Methods).

- processes and apparatus for presenting information, for example, indicators or recorders characterised by the information indicated or recorded.

The exclusion will not apply if the effect of the presentation of information is to provide a material advantage (in the sense of a practical utility) rather than being of a purely intellectual or visual character.

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**Examples of Patentable and Non-Patentable Inventions**

In *Moore Business Forms Application* [1979] AOJP 2521, a claim to a business form having printed transverse bars was allowed, since the bars served the material advantage of allowing the form to be printed with more lines of type per inch which were still as easy to read as prior forms having the usual number of lines of type per inch.

Other examples include:

- *Cooper's Application* (1902) 19 RPC 53, in which one or more spaces was left across the printed page of a newspaper where the paper was to be folded, in order to enable the paper to be read when folded, was held to be patentable.

- *Fishburn's Application* (1938) 57 RPC 345, in which an arrangement of printing upon a ticket was found to serve a technical purpose in that information was not lost when the ticket was torn.

- *Pitman's Application* [1969] RPC 646, in which variations in the visual significance of printed characters, in order to assist in voice production by a recording machine or a human reader, were held to be patentable. In contrast, *Nelson's Application* [1980] RPC 173, relating to a medium carrying an instructional message in three parts, visual, verbal and humorous, was found to be merely intellectual in nature.

- *Rhode's Application* [1973] RPC 243, in which a vehicle speedometer adapted to show "impact speed" was found to be patentable.

- *Ciba-Geigy AG (Durr's) Applications* [1977] RPC 83, in which a claim to a conventional package containing a known product, and characterised solely by the instructions on the package for using the product, was rejected. In contrast, in *Organon Laboratories Limited's Application* [1970] RPC 574, a claim was allowed to a package containing pills which were packed in a particular order together with directions for use.
Overview

Games per se are not patentable being merely mental processes, abstract ideas or schemes.

Applying the authority of the Full Federal Court in Grant v Commissioner of Patents [2006] FCAFC 120, Research Affiliates LLC v Commissioner of Patents [2014] FCAFC 150 and Commissioner of Patents v RPL Central Pty Ltd [2015] FCAFC 177, a game does not become eligible subject matter merely because it is implemented with the assistance of cards, tokens or a games board which are characterised by intellectual information related to the rules of the game. Games apparatus may however be patentable where it has a practical utility other than merely allowing the game to be played. See, for example, 2.9.2.8 Printed Matter.

Similarly, a game does not become patentable merely because it is implemented by a computer (described as a game machine or otherwise). Rather, games are no different to other mental processes and schemes and are to be considered in the same way. See 2.9.2.7 Computer Implemented Inventions - Schemes and Business Methods.

Consequently, where in substance the claimed invention lies only in the rules of the game, such as the progress of game play or odds at different levels, it should not be considered patentable. However, if the invention lies in an improvement to the operation of the computer or in the application of the computer to the playing of a game, then it may be eligible, for example, the application of networking features to improve communication between games machines.

Example 1: Gaming Machine Interfaces

Aristocrat ‘16 deals with two applications having similar claims. A relevant claim defines the invention as follows:

A gaming machine including a controller and a touch sensitive electronic display, the controller being arranged to cause a game selection image to be displayed on the electronic display, the game selection image including a plurality of separate image elements including:

a) a name of a game that is available for play on the gaming machine; and

b) a set of different bet denominations for the game, wherein at least one of the sets of denominations of at least one of the separate image elements is different to the set of bet denominations of at least one other of the separate image elements,

the gaming machine being further arranged to allow a player to select a game and a denomination by touching the touch sensitive electronic display where a respective denomination is displayed.

In Aristocrat ‘17 the relevant claim was as follows:

A gaming machine comprising: an electronic game controller; and a touch sensitive display that is electrically coupled to the game controller, wherein:

the game controller is arranged to facilitate a play of any one of a plurality of games available on the gaming machine, each of the plurality of games being a spinning reel game of chance;

a first set of a plurality of denominations is associated with at least a first two of the plurality of games, and a second set of a plurality of denominations is associated with at least a second two of the plurality of games, the second set of a plurality of denominations being different to the first set of plurality of denominations; and

the game controller is further arranged to:

cause a simultaneous display of a plurality of separate image elements on the touch sensitive display, wherein separate image elements identify each of the at least a first two of the plurality of games and separate image elements identify each of the at least a second two of the plurality of games;

enable a player to make an initial selection of one of the at least a first two of the plurality of games or one of the at least a second two of the plurality of games by touching the touch sensitive display; and

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2.9.2.9 Games and Gaming Machines

subsequent to the player making the initial selection of one of the at least a first two of the plurality of games or one of the at least a second two of the plurality of games, enable the player to select any one of the plurality of different bet denominations associated with the selected game by touching the touch sensitive display.

The claims in *Aristocrat ‘16* were found patentable, but not in *Aristocrat ‘17*.

In *Aristocrat ‘16* the delegate found that the substance of the invention was an improved interface that presents an option for selecting both a game and denominations from respective pluralities, with one action by a player. This contribution was found to be “technical in nature, and [achieved] a practical and useful result”.

The delegate in *Aristocrat ‘17* considered the substance of the invention to include the fact that all games were spinning reel games of chance and the specific way in which the games were divided into groups with group-specific associated sets of bet denominations. The delegate did not consider this substance to produce any technical, practical or useful result, and did not see any improvement in the relevant computer technology.

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**Example 2: Gaming Machine Game Play**

An area of gaming machine function to which claims are often directed involves processes of actual game play. A first example below, directed to an invention describing three-dimensionally displayed spinning reels, is contrasted with an invention directed towards the playing of games where probability of player success is modified.

“Compound reels”

A method of gaming comprising:

- generating one or more reels in a spinning reel game, said reels configured for being displayed as three dimensional and comprising a plurality of game symbols arranged along and around said reels, said reels configured to be displayed with their game symbols provided along and around said reels;
- displaying spinning of said reels and thereby sequentially displaying at least some of said game symbols displayed as provided along said reels;
- displaying rotating of said reels and thereby sequentially displaying at least some of said game symbols displayed as provided around said reels;
stopping said spinning and said rotating of each of said reels at a respective stop position;

determining a game outcome based on at least some of said game symbols displayed when each of said reels is in its respective stop position; and

displaying some or all of said reels as compound reels, each of said compound reels comprising an inner two- or three-dimensional reel provided with game symbols and an outer at least partially transparent three-dimensional reel provided with game symbols.

“Probabilities of player success”

A method of gaming comprising:

displaying play of a wager game; triggering a first feature of the wager game in which one or more feature enhancing elements are awardable to a player;

triggering a second feature of the wager game, the second feature being randomly triggerable during play of at least one of the wager game and the first feature; and

allowing awarded feature enhancing elements to be utilised in the second feature to provide a player advantage in the second feature.

In the first claim, it may be said that the substance of the invention is the use in a spinning reel game of three-dimensional reels that spin vertically along and rotate horizontally around the reel. Here it can be argued that this provides a material advantage or technical effect of optimised/improved use of screen space.

The substance of the second claim is the presence of a second feature whereby feature enhancing elements may be utilised to provide player advantage in the second feature. Such a substance is clearly directed to rules of the game associated with probability and chance and consequently, may be considered a mere scheme.

A mathematical algorithm is a procedure for solving a given mathematical problem, commonly applied in the field of computer software related inventions.

In Grant v Commissioner of Patents [2006] FCAFC 120, the Full Court stated:
“It has long been accepted that 'intellectual information', a mathematical algorithm, mere working directions and a scheme without effect are not patentable.”

However, while a mathematical algorithm per se may not be a manner of manufacture, the presence of such an algorithm within the steps in an otherwise patentable method does not exclude a claim from patentability. For example, in *Re International Business Machines Corporation v Commissioner of Patents* [1991] FCA 625 the Court, in considering a method for producing an improved (i.e. smoother) visual representation of a curve, found (at [16]) that:

“In the present case, it seems to me that the use of the algorithm is not different conceptually from the use of the compounds involved in National Research and Development Council. Just as those compounds were previously known, so here, it is not suggested there is anything new about the mathematics of the invention. What is new is the application of the selected mathematical methods to computers, and in particular, to the production of the desired curve by computer. This is said to involve steps which are foreign to the normal use of computers ....”

The distinction to be drawn is between a claim to an algorithm (or scientific principle or natural phenomenon) in the abstract sense and the application of the formula to a process such that it produces “some advantage which is material, in the sense that the process belongs to a useful art as distinct from a fine art”.

Examples of inventions involving mathematical algorithms that would be patentable are:

- any otherwise-patentable process which uses a specific algorithm or mathematical formula, e.g. a claim to a method of annealing a tungsten alloy where:

  the heating time (seconds) = 6.78 mass of ingot/temperature (C).

- a method that generates a more accurate measurement/calculation of an amount of oil in an underground deposit using a mathematical algorithm to process measured input data. Here the invention can be classified as technical or practical.

Examples of inventions involving a mathematical algorithm that would not be patentable are:

- a method that uses an algorithm to calculate data indicative of success of aspects of commerce such as investments. Here the invention is akin to business innovation as opposed to technical innovation, being in an abstract art of organising or analysing human activity.

- a pure mathematical formula (unapplied), e.g. a claim to a method of calculating a value c, where:

  \[ c = e^x \sin(t) \]
2.9.2.11 Methods of Testing, Observation and Measurement

Methods of testing, observation and measurement may be patentable provided they go beyond a mere scheme or working directions.

(See 2.9.2.5 Discoveries, Ideas, Scientific Theories, Schemes and Plans and 2.9.2.12 Mere Working Directions).

Methods which address a technical limitation, for example, improving the accuracy of measurement or observation of a physical characteristic, will generally be permitted.

2.9.2.12 Mere Working Directions

A mere variation in the working of an existing apparatus or process to produce an identical product has traditionally not been patentable. This type of invention is commonly referred to as a "working direction". A variation will be a "mere" variation only if it involves no inventive ingenuity. A variation which may arise in the exercise of an operator's judgement, even accidentally, will be a "mere" variation. See, for example, The Commissioner of Patents v Lee 16 CLR 138, relating to a particular operation of a charcoal-burning kiln, where the specification itself admitted prior use of the kiln.

A claim to a mere working direction may also lack an inventive step and this possibility should always be considered when examining claims of this type.

In some circumstances, it may be difficult to distinguish between a process, such as an industrial process which is patentable, and mere working directions which are not. In
particular, chemical processes may sometimes specify directions for operating known machinery at certain temperatures and pressures under stipulated conditions and for determined periods of time. Where the result is new, or where an inventive selection is involved, such processes are patentable. Similarly, a process is patentable where the stipulated conditions are such that the person skilled in the art would have applied them without bothering to experiment with them.

In general, the mere optimisation of a known process to more efficiently produce an old product, or to more efficiently operate a known device to produce an old effect, amounts to no more than a working direction, provided that result could have been achieved without inventive ingenuity, i.e. by trial and error or routine experimentation.

2.9.2.13 Treatment of Human Beings

Note: Under sec 18(2), human beings, and the biological processes for their generation, are not patentable inventions (see 2.9.3.5 Human Beings and Biological Processes for Their Generation).

Therapeutic Treatments

Therapeutic treatments, i.e. processes or methods for medical treatment of the human body, having economic utility are patentable following the decision of the High Court in Apotex Pty Ltd v Sanofi-Aventis Australia Pty Ltd [2013] HCA 50, which concerned a method of preventing or treating psoriasis by administering leflunomide. It was held (at [286]) that:

“As assuming that all other requirements for patentability are met, a method (or process) for medical treatment of the human body which is capable of satisfying the NRDC Case test, namely that it is a contribution to a useful art having economic utility, can be a manner of manufacture and hence a patentable invention within the meaning of s 18(1)(a) of the 1990 Act.”

However, the Court acknowledged there is a distinction between such methods of treatment and the activities or procedures of doctors (and other medical staff) when physically treating patients, e.g. surgical procedures (Apotex v Sanofi-Aventis supra at [287]).

Cosmetic Treatments
Cosmetic treatments, i.e. processes or methods for improving or changing the appearance of the human body, or any part of it, having a commercial application are patentable (Apothex v Sanofi-Aventis supra; Bernhard Joos v Commissioner of Patents 126 CLR 611). In the latter case, the claim was for a process for improving the strength and elasticity of keratinous material, especially human nails and hair, by applying a particular composition.

Note: The approach of the PCT and some foreign jurisdictions, such as the EP, is to regard methods of treatment as non-patentable subject matter.

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2.9.2.14 Micro-Organisms and Other Life Forms

In considering whether a claimed micro-organism is patentable, examiners should determine the substance of the claim and whether that substance is “made”, following the principles outlined in 2.9.2.6 Nucleic Acids and Genetic Information. In general, where the substance of a claim is the organism, and not genetic information, the organism may be patentable if the technical intervention of man has resulted in an artificial state of affairs which does not occur in nature (i.e. the substance is “made”).

Office practice is that the isolation and cultivation of naturally occurring micro-organisms satisfy the requirements for technical intervention. A claim to a biologically pure culture of the naturally occurring micro-organism is also acceptable.

In determining whether an organism is “made”, in Ranks Hovis McDougall Ltd's Application (1976) AOJP 3915 the hearing officer decided that:

- any new variants claimed must have improved or altered useful properties and not merely have changed morphological characteristics which have no effect on the working of the organism;
- naturally occurring micro-organisms per se are not patentable as they represent a discovery and not an invention; and
- a claim to a pure culture of the micro-organism would satisfy the requirements for technical intervention.
Following *National Research Development Corporation v Commissioner of Patents* (1959) 102 CLR 252; (1961) RPC 134, agricultural and horticultural processes are patentable, provided they are not excluded by any other of the "traditional principles" (as referred to in *NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd* 32 IPR 449).

"Seeing that the promise which he offers is some new and useful effect, there must of necessity be some product whereby the validity of his promise can be tested"

(*NRDC* supra at page 145).

Thus, "a method of eradicating weeds from crop areas containing a growing crop" is patentable.

Other agricultural and horticultural processes which have been considered patentable include:

- preventing male gametes in grass from reaching maturity;
- sterilising male anthers in plants;
- the production of genetic variations by exposing plants to applied magnetic or other force fields;
- the asexual propagation of pineapple plants by tissue culture techniques; and
- the production of male sterile maize by genetic selection.

Having regard to the decision in *Ranks Hovis McDougall Ltd's Application* (1976) AOJP 3915, a new plant or animal (provided it is not one that is naturally occurring) can be regarded as a manner of manufacture if it:

- involves the technical intervention of man; and
- is useful in economic affairs.

(see also 2.9.2.14 Micro-Organisms and Other Life Forms).

Examiners should note that human beings are not patentable due to a specific exclusion under sec 18(2).

The treatment of animals is also patentable, following *NRDC* (supra). Thus, for example, an application in which a claim was directed to a method of tenderising meat products by the introduction of enzymes into the vascular system of an animal before slaughtering was considered patentable. Similarly, an example of a method of treating animals which was allowed involved the treating of cattle for anaplasmosis (see *Wellcome Foundation Limited v*...
2.9.2.16 Combinations, Collocations, Kits, Packages and Mere Admixtures

Key points:

(1) If an invention comprises a collocation in which one of the integers is new, then the invention will be a manner of manufacture.

(2) Where an invention consists of a collocation of known integers, the primary consideration in relation to manner of manufacture will be whether there is a working interrelationship or potential working interrelationship between the integers.

(3) If the integers of a combination are defined to be in a physical arrangement that in ordinary use provides for such a working interrelationship, or the claim includes a limitation as to the use, then the combination will be a manner of manufacture (see 2.9.2.16.1 Collocations).

(4) In the case of chemical combinations and the like, if the integers are in admixture, then a potential working interrelationship is provided and a manner of manufacture objection will generally not apply (see 2.9.16.2.4 Admixtures). However, there may be residual novelty and/or inventive step considerations.

(5) In the case of “kits” of separate and known integers, a manner of manufacture objection should be taken if there is no feature defined that provides for the working interrelationship (for example, the kit is not limited to when it is used in a particular method). Additional considerations of novelty and inventive step will apply and objection under these grounds taken as appropriate. If an integer is only disclosed in a P, X or E document, then a manner of manufacture objection should not be taken as the integer was not “known” at the priority date of the claim(s).

(6) An objection under sec 50(1)(b) (food or medicines being mere admixtures) should only...
2.9.2.16 Combinations, Collocations, Kits, Packages and Mere Admixtures

be taken in the case of simple recipes. Where there is a reasonable basis for an inventive step objection, then this should be taken in preference.

**Note:** Much of the judicial guidance in relation to collocations and mere admixture is old law. At that time, these concepts encompassed a variety of patentability considerations, including inventive step. With the introduction of the 1990 Act, the ground of inventive step was clearly distinguished from manner of manufacture.

As a consequence, some of the previous considerations of manner of manufacture or mere admixture are now more appropriately taken under inventive step. Certain types of collocations have been found by the courts to be unpatentable (see 2.9.2.16.1 Collocations). These are generally collocations in which each part performs its normal function, and is not functionally dependent on any other part. In such cases, manner of manufacture is an appropriate objection.

A patentable combination is a new combination of old integers having a working interrelationship or a potential working interrelationship. In *British Celanese Ltd. v Courtaulds Ltd.* 52 RPC 171 at pages 193-194, it was stated:

"It is accepted as sound law that a mere placing side by side of old integers so that each performs its own proper function independently of any of the others is not a patentable combination, but that where the old integers when placed together have some working inter-relation producing a new or improved result then there is patentable subject-matter in the idea of the working inter-relation brought about by the collocation of the integers."

In *Advanced Building Systems Pty Ltd and Anor v Ramset Fasteners (Aust) Pty Ltd* (1998) 152 ALR 604; (1998) AIPC 91-401; 40 IPR 243, the High Court referred to *Welch Perrin & Co Pty Ltd v Worrell* (1961) 106 CLR 588 on combinations as follows:

"Referring to the specification, their Honours [the court in *Welch Perrin & Co Pty Ltd v Worrell*] said:

'It was not seriously disputed that it is for a combination, in the sense that word bears in patent law. That is to say, what is described is a machine, the elements of which are all well known and simple mechanical integers, but combined so that they are not a mere collocation of separate parts, but interact to make up a new thing.'

This notion of a 'new thing' includes a new result, 'that is, a new way of achieving an old purpose or the fulfilment of a new purpose' (*Palmer v Dunlop Perdriau Rubber Co Ltd* (1937) 59 CLR 30 at 67), and 'a new combination of features to obtain an improved result' (*Meyers Taylor v Vicarr Industries Ltd* (1977) 137 CLR 228 at 249). The significance of the exclusion of a 'mere collocation of separate parts' appears from the statement by Aickin J in...
Thus, for a combination to be patentable there has to be a **working interrelationship or a potential working interrelationship** between the component integers.

**A collocation comprises a number of known integers, process steps, or the association of materials or substances in such a way that no working interrelationship or potential working interrelationship exists between its various constituent parts. That is, each part performs its normal function, and is not functionally dependent on any other part.**

A collocation is only unpatentable if all its integers are known. In this context, "known" means publicly available. This situation relies on a "collocation" of items of prior art, rather than a "mosaic" thereof in the patent law sense (see *Ramset Fasteners (Aust) Pty Ltd v Advanced Building Systems Pty Ltd and Anor* (1996) 34 IPR 256. This meaning was not challenged in the appeal to the High Court). If an integer is disclosed only in a P, X or E document, then a manner of manufacture objection should not be taken as the integer was not "known" at the priority date of the claim(s).

Where one of the integers or steps is new and otherwise patentable, the inclusion of such an integer or step in a collocation is not objectionable under sec 18(1)(a). In *B.U.S.M. v. Fussel* 25 RPC 631 at page 649, Fletcher-Moulton LJ stated:

"......if a patentee could rightly claim a general grant, but he limits that grant in any way - limits it, not extends it - no such limitation can destroy the validity of his grant. Supposing the Patentee was entitled to claim this first group by itself, i.e., generally, and he chose only to claim it when used in combination with a special operating mechanism, his so claiming it has limited, and not extended, his grant; and no such limitation which amounts to a present to the public of his invention, excepting when used under such circumstances, can possibly injure the validity of the grant, though it may prevent doubts arising as to the validity of the grant."

On this basis, a claim was allowed to a shaving kit including amongst other items a **novel razor**, even though the other components of the kit did not co-operate to form a patentable combination. The applicant was entitled to claim the razor by itself, however the fact that the **Minnesota Mining and Manufacturing Co v Beiersdorf (Australia) Ltd** (1980) 144 CLR 253 at 266 that it is 'the interaction' between the integers which is 'the essential requirement'. It is this which supplies the inventive step and denies an allegation of lack of subject-matter in the case of a valid combination patent."
claim was limited to an environment defined by the kit did not detract from his right to a patent.

Examples of cases where the alleged invention merely comprised a collocation (all of which were refused) are:

- **Williams v Nye** 7 RPC 62 (the sausage machine case. The alleged invention consisted of a well known mincing machine which fed meat to a well known filling machine, such as to include in one apparatus two machines which had formerly been used separately. The mincing part performed no more than its already well known functions and similarly with the filling part).

- **Battig's Application** 49 RPC 415 (sequence of three known steps in the treatment of coke furnace gases to maximise the yield of hydrogen).

- **Young's Application** (1966) AOJP 1028 (bottle with a spoon detachably secured thereto).

- **W.R.'s Application** 41 RPC 216 (gramophone record plus a chart for physical exercises).


- **Huntington Hartford's Application** (1975) AOJP 3869 (two tables and a net for playing a ball game).

- **Unilever Ltd.'s Application** (1976) AOJP 531 (container and contents).
A kit of tools would not normally come into the category of a combination, as there would be no potential working interrelationship between the various sized tools of the same type, and the various tools of different types. Similarly, a set of golf clubs cannot qualify as a combination, irrespective of the game which might require the use of various clubs to play adequately.

Case Law

In *National Research Development Corporation’s Application* (1988) AIPC 90-495, the hearing officer found that a claim to a kit for use in an assay, which comprised three components in separate containers, did not define an aggregation of integers having a potential working interrelationship.

In *Wellcome Foundation Ltd v Commissioner of Patents* 30 ALR 510, the High Court decided that the association of written instructions with a known chemical composition in a container was not patentable subject matter, there being no novelty in the container or the chemical composition. The principle of that decision was followed by the hearing officer in *Re Schering Aktiengesellschaft* (1990) AIPC 90–649 in concluding that claims to a kit, such as in the form of a known type of blister pack, of known components and incorporating separate dosage units, were not limited to the inventive concept. Thus, the separate items of the kit could be used according to the novel method of inducing labour or an abortion which was described in the specification, or could be used in an entirely different manner. By corollary, a kit will not lack patentable subject matter if its physical construction is such that it is only capable of normal use in such a way as to inevitably realise the concept of the invention. See also *Ciba-Geigy AG (Durr’s) Application* [1977] RPC 83 and *Organon Laboratories Limited’s Application* [1970] RPC 574, which were referred to in *Wellcome*.

In *Bristol-Myers Company v L’Oreal* (1988) AIPC 90-529, the inventive concept resided in a process for waving or straightening hair which included the *in situ* formation on the hair of an insoluble complex which had a conditioning effect. The hearing officer held that as the components of the package claims could be used in other (known) hair treatment processes, such claims were not limited to the inventive concept. The hearing officer also considered a package claim which included instructions on how to employ the contents of the container for waving or straightening hair, and found (following *Wellcome*) that mere writing cannot confer patentability.
Other Considerations

Difficulties may be experienced in relation to claims which define a package, container or the like, holding ingredients separately or in non-reactive admixture. Examples are:

- substances A and B individually are inactive, however when mixed together will produce a glue or coating; and
- substance A is for treatment of a condition in humans (or other animals) and substance B is for alteration of a side effect caused by the use of A.

In general, if A and B are both known and there is no novelty in the construction of the package, the claimed invention is a non-patentable collocation. However, there may be a potential working interrelationship where the components are to be used in a novel way and the construction of the package ensures they will be used in this way. Thus, where there is novelty in the sequential application of two compositions, a claim to a package of the two compositions so constructed as to ensure that in normal use such sequential application occurs, would constitute a true combination. Some guidance on alleged inventions of this type is provided in Unilever Ltd's Application (1976) AOJP 531 and Blendax-Werke's Application (1980) RPC 491.

Another situation in which a claim to a kit may be regarded as constrained to the inventive concept, and consequently considered to define patentable subject matter, is where one of the components is novel, or by the inclusion of words of limitation to a novel method, e.g. "when used" or "whenever used" (see 2.11.2.3.3 "For Use", "When Used", etc).

Modified Date: 01 February 2016

2.9.2.16.3 Admixtures

Where the integers of a combination are provided in a form that provides a potential working interrelationship, then a manner of manufacture objection will generally not apply. In the case of mixtures and compositions, the integers may be considered as being in a form that has a potential working interrelationship. An objection under sec 50(1)(b) (mere admixture) should only be taken where the invention is a simple recipe (see 2.9.3.2 Food or Medicines, Being Mere Admixtures).

Where the integers are in a form that provides a potential working interrelationship, there may still be a residual inventive step issue as to whether it was obvious to combine the individual integers and whether the combination is simply the "predictable use of prior art elements according to their established functions". If there is synergy, a potential working
interrelationship or some other non-obvious advantage in combining the integers, then the admixture will not be obvious.

Thus, depending on the facts of the case:

- If an integer of a mixture is novel and inventive, then the requirements of manner of manufacture and inventive step will be satisfied.

- If the claims clearly **only** define mixtures of known integers (i.e. the claims do **not** include kits), then examiners can raise inventive step as the sole objection.

**Note:** Where an inventive step objection is raised, mere assertions by the applicant of ‘synergy’ or similar advantage are unlikely to be sufficient without a credible basis. In such cases, examiners may ask for further evidence if they are not satisfied that a synergism or other advantageous effect has been demonstrated (see also **2.11.3.4.2A Section 40 Enabling Disclosures**, ‘Synergism’).

- If the claims define both mixtures of known integers **as well as** kits/collocations of known and separate integers, then an inventive step objection should be taken to the mixture claims and a manner of manufacture objection to the kits/collocation claims.

- If the claims define a mixture that is novel and inventive, but also define kits/collocations of known and separate integers, then a manner of manufacture objection can be taken as the sole objection to the kit/collocation claims.

- An objection of mere admixture under **sec 50(1)(b)** is also a consideration. However, an inventive step objection should be taken in preference, unless the invention is a simple recipe. An objection under **sec 50(1)(b)** is likely to be taken only in exceptional circumstances.

**2.9.2.16.4 Tips on Claim Construction**

In some cases, it may not be readily apparent that a claim defines or includes a non-patentable collocation or kit of known integers, or whether the claim defines a patentable combination. Care should be taken to construe the claims and determine whether there is a patentable combination.

In general, the following will be considered patentable combinations, provided there is no indication in the specification that any terms are intended to be interpreted differently:

- A composition comprising A and B.
• A formulation comprising A and B.

• A mixture comprising A and B.

• A cell culture comprising cell A and cell B.

• A cell population comprising cell A and cell B, provided the cells are derived from different sources or tissues and are unlikely to be naturally occurring in this form (see 2.9.2.14 Micro-Organisms and Other Life Forms).

However, claims such as the following define non-patentable “kits” or collocations:

• A pharmaceutical which includes combinations of known integers A and B for separate, sequential or simultaneous use. This reference may be provided as an explicit definition in the claim or as a ‘dictionary’ in the description.

In this case, the definition of separate or sequential use clearly requires that the dosage forms are separate integers and, as a consequence, the pharmaceutical is a kit. Such kits may be referred to as a “composition”, “combination” or “formulation”, however this does not change their nature and a manner of manufacture objection should be taken.

• A pharmaceutical composition comprising a solution of component A and a solution of component B.

In this case, the definition of a “composition” suggests a single admixture, however the definition of separate solutions is indicative of a kit or collocation of separate integers.

• Similarly, wording such as an “article of manufacture”, a “package”, a “system”, a “kit of parts” and a “free combination”, indicates that the individual integers are merely collocated.

**Note:** When determining whether an invention relating to a new use is a manner of manufacture, consideration should also be given to whether the invention meets the requirements for inventive step.
2.9.2.17.1 New Use of a Known Substance

A new use of a known substance is patentable, provided the use takes advantage of a previously unknown property.

In assessing whether the new use of a known substance is patentable, consideration should be given to what is known on the face of the complete specification (AstraZeneca AB v Apotex Pty Ltd [2014] FCAFC 99; 107 IPR 177), i.e. what does the specification disclose or admit was known (common general knowledge) before the priority date. In this case, the claims were directed to a pharmaceutical composition comprising rosuvastatin and an inorganic salt with a multivalent cation, the latter component preventing degradation of the former. The composition could further comprise a commercially available ferric oxide coating, such coatings being known to protect against degradation by light.

The Full Bench of the Federal Court held that the specification did not admit or disclose on its face that it was known that ferric oxide coatings could be used to address the stability issues associated with rosuvastatin, and furthermore that it was not known that rosuvastatin was sensitive to degradation. The specification itself disclosed the fact that rosuvastatin was sensitive to degradation and was not merely reporting on a prior disclosure made by others (AstraZeneca AB v Apotex Pty Ltd supra at [408]-[412]). The Full Court indicated that the position in this case was distinguished on the facts from that in Commissioner of Patents v Microcell Ltd (1959) 102 CLR 232.

In Microcell supra, the claims defined rocket projectors comprising tubes of reinforced synthetic resinous plastic material. The High Court found that the specification itself indicated that rocket projectors were well known articles of manufacture and that synthetic resinous plastics were well known materials. Furthermore, the properties of the plastic materials were known generally from matter published before the priority date. The patent application was refused as there was:

"in truth nothing but a claim for the use of a known material in the manufacture of known articles for the purpose of which its known properties make that material suitable. A claim for nothing more than that cannot be subject matter for a patent, and the position cannot be affected either by the fact that nobody thought of doing the thing before, or by the fact that, when somebody did think of doing it, it was found to be a good thing to do."

In NV Philips Gloeilampenfabrieken and Another v Mirabella International Pty Ltd 24 IPR 1, claims to low pressure mercury vapour discharge lamps having a luminescent layer
comprising phosphors were refused. In this case it was held that the luminescent qualities of phosphors had long being known in the art.

2.9.2.17.2 New Use of an Old Contrivance

The law on new use of old contrivances is set down in Gadd & Mason v The Mayor etc. of Manchester (1892) 9 RPC 516 at page 524, and was adopted by the High Court of Australia in Willmann v Petersen 2 CLR 1 at page 17. In the former case, Lindley LJ stated:

"1. A patent for the mere use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad and cannot be supported. If the new use involved no ingenuity but is in manner and purpose analogous to the old use, although not quite the same, there is no invention; no manner of new manufacture within the meaning of the Statute of James. 2. On the other hand a patent for a new use of a known contrivance is good and can be supported if the new use involves practical difficulties which the patentee has been first to see and overcome by some ingenuity of his own."

See also Schwer v Fulham & Robinson 11 CLR 249 and Lister's Application (1966) RPC 30.

2.9.2.17.3 Analogous Use

The principle underlying the doctrine of analogous use was stated in British Liquid Air Co. Ltd. v British Oxygen Co. Ltd. (1909) 26 RPC 509 at page 532:

"the application of a known device to its ordinary purpose under analogous circumstances is not good subject matter for Letters Patent, because it does not involve invention".

In Harwood v Great Northern Railway Co. 35 LJQB 27 at page 38 it was stated:

"You cannot have a patent for a well known mechanical contrivance merely because it is applied in a manner or to a purpose which is analogous to the manner, or for the purpose in or to which it has been hitherto notoriously used."

There are three prerequisites in establishing analogous use:
• the use of the device (and not a mere description thereof) must be proved or admitted;  

• the device must be used for its ordinary purpose; and  
  *Morgan v Windover* (1890) 7 RPC 131.

• the circumstances of the use must be truly analogous.  
  *British Liquid Air Co. Ltd. v British Oxygen Co. Ltd.* 26 RPC 509.

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**2.9.2.18 Ethics and Social Policy**

It is the role of Parliament to reflect community expectation in the development of legislation, for example, in exclusions from patentability. Where a claimed invention falls within an established class of patentable subject matter (as outlined in 2.9.2.2 Principles for Examination), it is not appropriate to exclude patentability on the basis of separate notions of ethics or social policy that are not reflected in the legislation (*Anaesthetic Supplies Pty Limited v Rescare Limited* (1994) AIPC 91-076; 28 IPR 383). Where the claimed subject matter relates to a “new class”, patentability is to be assessed according to the factors identified by the High Court in *D’Arcy v Myriad Genetics Inc* [2015] HCA 35 (as described in 2.9.2.2 Principles for Examination).

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**2.9.3 Other Issues**

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**2.9.3.1 Contrary to Law**

In this topic:

Under sec 50(1)(a), the Commissioner may refuse to accept a patent request and specification relating to a standard patent, or to grant a standard patent, for an invention the use of which would be contrary to law. The section is to be understood as covering broadly statute law, including regulations and ordinances, and case law. Examiners should note that...
refusal under sec 50(1)(a) is a discretionary power and should only be applied in the clearest of circumstances.

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**Case Law**

Some guidance as to the meaning of "contrary to law" is provided in *Official Rulings* 1923 C (1923) 40 RPC Appendix iv, where it was stated:

"An invention 'contrary to law' may be either (1), one the primary use of which would be a criminal act, punishable as a crime or misdemeanor, or, (2), one the use of which would be an offence by reason of its being prohibited under by-laws or regulations made for police and administrative purposes.

Inventions belonging to the former class would always be refused protection. As regards the latter class, the nature and possible uses of the invention and the exact terms of the prohibition would have to be considered in each case."

In *Pessers and Moody v Haydon & Co.* (1909) 26 RPC 58, the invention could be used both for lawful and unlawful purposes (gambling). Eve J considered whether a game was:

"so illegal in its nature as to constitute improper subject-matter for a Patent."

In the circumstances, Eve J stated:

"...I do not feel myself at liberty to say off-hand that this an illegal subject matter for a Patent."

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**Examination Practice**

Objections under sec 50(1)(a) should only be taken where an unlawful use, but no lawful use, of an invention has been disclosed.

In particular, regard must be had to whether the invention is primarily devised or intended for a lawful, or for an unlawful, use. For example, in the UK an invention which was refused on this basis was an explosive safe designed to kill or injure a burglar.
Where an objection under sec 50(1)(a) is disputed by the applicant and the examiner considers it should be maintained, the matter should be referred to a supervising examiner before a further report is issued.

Note: An objection under sec 50(1)(b) should only be raised in exceptional circumstances. In the case of pharmaceutical preparations, an objection of lack of inventive step should be taken in preference to an objection under sec 50(1)(b). Similarly, in the case of food, an objection should be taken on the basis of lack of inventive step rather than under sec 50(1)(b), unless the invention is no more than a simple recipe.

Under sec 50(1)(b), the Commissioner may refuse to accept a patent request and specification relating to a standard patent, or to grant a standard patent, on the ground that the specification claims as an invention:

- a substance which is capable of being used as a food or medicine (whether for human beings or animals and whether for internal or external use) and is a mere mixture of known ingredients; or
- a process producing such a substance by mere admixture.

By "mere mixture of known ingredients" is meant a mixture exhibiting only the aggregate of the known properties of the ingredients. Not only must the ingredients be known, but the property which makes the ingredients useful for the purpose of the invention must also be known.

"Mixtures" may encompass not only powders or granules, either loosely or in compacted form (e.g. a tablet or pill), but also mixtures of liquids or gases and includes suspensions and solutions.

A substance is not excluded from being a mere admixture merely on the basis that the physical form of an ingredient has been changed, e.g. a sweet formed from a mixture of sugar and cellulose which has been turned hard by boiling (see the obiter in Ashe Chemicals Ltd. (Deadman's) Appln. (1972) RPC 613 at page 621).
2.9.3.3 General Inconvenience

Examination Practice

The concept of "mere admixture" overlaps with inventive step. With inventive step available as a ground of objection under the 1990 Act, this is the more appropriate objection and is consistent with international approaches. Therefore, where there is a reasonable basis for an inventive step objection, this should be taken in preference. A mere admixture objection should be reserved for cases where there is a combination or collocation of very well known ingredients in a simple recipe (or process of making such by mere admixture), where it can be difficult to obtain documentary evidence to support lack of inventive step, or establish a specific motivation to combine the particular ingredients.

An example of where mere admixture may apply is a simple recipe, such as a pizza dough containing particular herbs in the base. The herbs are used in an established and predictable way to change the taste of the dough, without providing any technical advantage over previously known doughs.

Where an objection under sec 50(1)(b) is disputed by the applicant and the examiner considers it should be maintained, the matter should be referred to a supervising examiner before a further report is issued.

Modified Date: 10 November 2014

2.9.3.3 General Inconvenience

The definition of an invention in schedule 1 refers to section 6 of the Statute of Monopolies. Section 6 specifies that even where a manner of new manufacture is disclosed, a patent cannot be granted for an invention that would be contrary to law or mischievous to the state by being generally inconvenient.

The requirement to avoid conflict with the law has been specifically reiterated in sec 50(1)(a) (see 2.9.3.1 Contrary to Law).

However, the requirement that an invention not be generally inconvenient has not been relied on as the primary basis upon which to invalidate a patent in any reported cases. Consequently, there is no clear guidance as to when an invention may be regarded as "generally inconvenient" and examiners should refrain from taking this objection.

Nevertheless, some guidance as to how the consideration might be applied can be obtained from the following cases:

- *Rolls Royce Ltd's Application* (1963) RPC 251 (the invention was found not to lie in the useful arts);
- *Anaesthetic Supplies v Rescare* (1994) AIPC 91-076; 28 IPR 383 (this was a minority judgement);
2.9.3.4 Useful (Utility)

- **Bristol-Meyers Squibb Company v F H Faulding & Co Limited** FCA VG 109 of 1995 (the invention was found not to meet the threshold requirement to be a patentable invention);

- **Hillier's Application** (1969) RPC 267 (the invention was found not to lie in the useful arts);

- **N.V. Organon's Application** (1974) AOJP 4503 (the relevant claims were not novel); and

- **Amiran Ur's Application** (1974) AOJP 5882 (the relevant claims were not novel).

Where general inconvenience appears to be an issue, examiners should consider whether the appropriate objection is really one of anticipation or that the invention does not lie in the technical realm.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.9.3.4A Useful (Utility).

During examination of a standard patent application or an innovation patent, examiners are not required to consider whether a claimed invention satisfies the requirement that it be useful (sec 18(1)(c) and sec 18(1A)(c) respectively).

However, examiners are required to consider the use to which an invention is to be put. Since an application must be in respect of a manner of manufacture, it is essential that the specification indicates an area of usefulness for the invention claimed, where such use is not self evident. Where no use is described (either implicitly or explicitly), the claims may be directed to a mere scientific curiosity, discovery or idea. In these situations, examiners should object that the claims are not directed to a manner of manufacture, as well as that the specification does not fully describe the invention.
The use of many inventions is self-evident, or may be implied in the specification (e.g. a motor vehicle), and in such circumstances no formal statement of use is required. Where there is a statement of use, but the statement is so broad that it merely indicates that an invention has been made without disclosing what that invention is, an objection or objections should be taken as outlined above. For example, a class of chemical compounds may be stated to be "pharmaceutically active". This is insufficient to indicate the nature of the invention; if the compounds are active as analgesics or hypnotics, this should be specified.

Similarly, if a claim defines a DNA sequence, it is insufficient to describe the sequence as being broadly useful as a "probe". The specification must disclose a specific gene which can be probed by the DNA sequence or a specific use.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.9.3.4 Useful (Utility).

During examination of a standard patent application or an innovation patent, examiners are required to consider whether a claimed invention satisfies the requirement that it be useful under sec 18(1)(c) or sec 18(1A)(c), respectively.

Whether an invention satisfies the 'useful' requirement is considered in terms of the existing case law (broadly that the claimed invention must achieve the promised benefit) and sec 7A of the Act. Section 7A requires the complete specification to disclose a specific, substantial and credible use for the claimed invention and that the disclosure in the complete specification must be sufficient for that specific, substantial and credible use to be appreciated by a person skilled in the relevant art.

The statutory requirement for usefulness does not mean that an invention must equate to a commercial product in order to be useful, rather it must achieve the use promised by the patentee in the specification, and have a specific, substantial and credible use.
2.9.3.4.1A Assessing the Claims for Lack of Usefulness

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.9.3.4 Useful (Utility).

In this topic:

Note: For a summary of the principles underlying clear enough and complete enough disclosure, support and usefulness, see 2.11A Annex B – Summary of the Clear Enough and Complete Enough Disclosure, Support and Useful (Utility) Provisions.

Patents should not be granted for inventions that are not useful: that have no practical application or do not work (The Explanatory Memorandum).

Principles for Examination

The assessment of whether an application satisfies the requirements for usefulness is considered with respect to each claim. When considering whether a claimed invention is useful, examiners must:

i. construe the claims (see 2.11.2.3 Construction of Claims); and

ii. decide on the balance of probabilities:
2.9.3.4.1A Assessing the Claims for Lack of Usefulness

a. whether the claimed invention achieves the promised benefit (see 2.9.3.4.1A Does the Invention Achieve the Promised Benefit?); and

b. whether the complete specification discloses a specific, substantial and credible use for the claimed invention (see 2.9.3.4.1.2A Specific, Substantial and Credible Use).

Everything that falls within the scope of a claim must be useful. That is, everything within the scope of the claims must achieve the benefit the specification promises for it, and the specification must disclose a specific, substantial and credible use for the whole of the subject matter claimed.

Any objection that the claimed invention is not useful should include a reasoned explanation of why the claimed invention does not achieve the promised benefit and/or why the specification does not disclose a specific, substantial and/or credible use for the claimed invention.

At first report, an objection that a claimed invention is not useful must be prima facie reasonable. To maintain an objection, examiners should have a significant basis to doubt the statement of use, taking into account the disclosure of the specification as filed and any submissions and evidence provided by the applicant.

A mere assertion by the applicant that an invention is useful would not be sufficient to overcome an objection of lack of utility. Examiners should consider any submissions and argument on their merits and should apply the balance of probabilities standard (see 2.13.5.2A Balance of Probabilities).

Completing the Examination Report

In general, objections that the claimed invention is not useful should be included in the ‘Other Issues’ section of an examination report.

However, where an objection that the claimed invention is not useful is combined with a sec 40 objection (for example lack of support) and the sec 40 objection is the primary objection, then the combined objection should be included in the ‘Section 40’ part of the report (see also 2.11.7.10A Support Required for Pharmaceutical Inventions and Methods of Treatment, under the heading ‘Overlap Between Support and Usefulness’).

When completing the ‘Summary of Patentable Subject Matter’ section of the report, claims that lack usefulness, but meet the manner of manufacture requirements, should be included at the prompt ‘Which Claims define Patentable Subject Matter?’ Only claims which do not
2.9.3.4.1.1A Does the Invention Achieve the Promised Benefit?

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.9.3.4 Useful (Utility).

The test for determining whether a claimed invention achieves the promised benefit is to ask:

Does the invention do what it is intended by the [applicant or] patentee to do and is the end result itself useful?

“‘Useful for what?’ is a question which must always be asked, and the answer must be useful for the purposes indicated by the [applicant or] patentee.”

This does not mean that an invention must equate to a commercial product in order to be useful, rather it must achieve the use promised by the patentee in the specification. (Lane Fox v Kensington and Knightsbridge Electric Lighting Co (1892) 9 RPC 413 at 417 approved by the High Court in Advanced Building v Ramset [1998] HCA 19 at [24]). In particular, the promised benefit or useful purpose of the claimed invention will often be found in the description.

When construing the claims for the purposes of usefulness (or for any other purpose), they must be construed from the perspective of a skilled addressee in a commonsense way, and not in such a way that the skilled addressee would appreciate would lead to an absurd or unworkable result (see 2.11.5 Claims are Clear and 2.11.2.2.6 Reject the Absurd). A specification should not be construed in a way that any sensible person would appreciate would lead to unworkability when on a proper construction it could be given a more limited meaning. (Welch Perrin & Co Pty Ltd v Worrel [1961] HCA 91 at [20]; William WM Wrigley Junior Company v Cadbury Schweppes Pty Ltd [2005] FCA 1035 at [138]).
However, if a claim, properly construed, includes within its scope means that will not produce the desired result, even if a skilled addressee would recognise which means to avoid, then the claim will lack usefulness. That is, everything falling within the scope of a claim must be useful, otherwise the claim will fail for inutility (Norton and Gregory Limited v Jacobs (1937) 54 RPC 271 at 276 cited by the High Court in Welch Perrin & Co Pty Ltd v Worrel [1961] HCA 91 at [20]; and Martin Engineering Co and Another v Trison Holdings Pty Ltd and Others [1989] FCA 64 at [23]-[24]).

Any objection that the claimed invention is not useful should include a reasoned explanation of why the claimed invention does not achieve the promised benefit and/or why the specification does not disclose a specific, substantial and/or credible use for the claimed invention.

In this topic:

**Overview**

Section 7A of the Act relevantly provides that:

1. For the purposes of this Act, an invention is taken not to be useful unless a specific, substantial and credible use for the invention (so far as claimed) is disclosed in the complete specification.
(2) The disclosure in the complete specification must be sufficient for that specific, substantial and credible use to be appreciated by a person skilled in the relevant art.

The intent of the legislature is that ‘specific’, ‘substantial’ and ‘credible’ be given the same meaning as is currently given by the US Courts and the USPTO.

The specific, substantial and credible use for the claimed invention must be disclosed in the complete specification. There may be an explicit disclosure of use. Alternatively, a formal statement of use is not necessary if the person skilled in the art could appreciate the use, with their background knowledge in the art and without difficulty.

In general, deficiencies under the specific, substantial and credible use test will arise in one of two forms. The first is where it is not apparent why the invention is useful, i.e. the complete specification fails to disclose any specific and substantial utility for the invention or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. The second arises in the rare circumstance where an assertion in the specification of a specific and substantial utility is not credible.

Any objection that the claimed invention is not useful should include a reasoned explanation of why the claimed invention does not achieve the promised benefit and/or why the specification does not disclose a specific, substantial and/or credible use for the claimed invention.

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**Specific Use**

To have a specific utility, the claimed invention must be able to provide a well-defined and particular benefit to the public. (Principle derived from the US Court judgement *In re Fisher*, 421 F.3d 1365 at 1371; 76 USPQ2d at 1225, 1230 (Fed. Cir. 2005)).

In most circumstances, the specification will explicitly disclose a specific use for, i.e. an application of, the claimed invention and thus satisfy this requirement. Alternatively, a specific use for the claimed invention will be implicitly disclosed if such a use would be readily apparent to the skilled addressee reading the specification.

However, where the specification discloses a use so vague as to be meaningless, or a general use so broad that it merely indicates that an invention has been made without disclosing what that specific invention is, an objection should be taken that a specific use has not been disclosed and would not otherwise be apparent to the person skilled in the art reading the specification.
For example, a class of chemical compounds may be stated to be “pharmacologically active” or the only use disclosed for an isolated DNA sequence may be as a “molecular marker” or “gene probe”. Such uses do not represent a specific use.

Where no use is disclosed in the specification, either explicitly or implicitly, the claimed invention may be directed to a mere scientific curiosity, discovery or idea. In such cases, the specific use requirement has clearly not been met and examiners should also consider whether the claims are directed to a manner of manufacture (sec 18(1)(a)), as well as whether the specification discloses the invention in a clear enough and complete enough manner (sec 40(2)(a)).

**Note:** In general, where no specific use is disclosed for the claimed invention, there will also be no disclosure of a substantial use providing an immediately available, significant real-world benefit to the public.

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**Substantial Use**

To satisfy the substantial use requirement, the specification must disclose a use for the claimed invention that corresponds to an immediately available, significant real-world use (Principle derived from the US Court judgement *In re Fisher*, 421 F.3d at 1371, 1376; 76 USPQ2d at 1233-34 (Fed. Cir. 2005)).

The substantial use must be immediately available. Therefore, where it would require further experimentation to identify or reasonably confirm a real-world use for the claimed invention, then the substantial use requirement is not satisfied.

A significant real-world use can be viewed as providing a real-world benefit to the public, i.e. the use is a desirable outcome based upon a concrete need in the art.

**Note:** In general, where no substantial use is disclosed for the claimed invention, there will also be no disclosure of a specific use providing a well-defined and particular benefit to the public.

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**Credible Use**

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Effective Date: 25 September 2019
To determine whether the credible use requirement is satisfied, examiners should consider whether a person skilled in the art would accept that the use disclosed in the specification for the claimed invention is logical and consistent with the state of the art.

If the logic and facts provided in the complete specification, and any evidence provided by the applicant in response to an objection, would convince the person skilled in the art that the use asserted for the claimed invention is plausible or reasonably credible, then the credible use requirement will be met.

However, if based on the facts of the case, it is clear that the invention cannot work as described in the specification, then the invention will lack a credible use. For example, inventions that contravene well-established laws of nature and which as a consequence are non-operable (for example perpetual motion machines or ‘cold fusion’), will not satisfy the credible use requirement.

(Principle derived from the US Court judgements *Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968)).

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**Examples – Specific, Substantial and Credible Use**

1. The specification discloses a protein by way of its sequence (SEQ ID NO: 1) and indicates that the protein can be made by protein expression techniques known in the art. There is no disclosed use and no description of the chemical or biological properties of the protein.

   Claim 1. The isolated protein consisting of SEQ ID NO: 1.

   Claim 1 does not satisfy the specific and substantial use requirements. There is no specific use, since no use has been disclosed in the specification and insufficient information is provided about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. There is no substantial use since the specification discloses no real-world use for the claimed protein and further experimentation would be necessary to identify and attribute such a use.

2. The specification relates to the prevention or retardation of ageing by administering compound A. There are no examples in the specification that demonstrate that the compound prevents or delays ageing.

   Claim 1. A method of preventing or retarding ageing by administering compound A.
The claim meets the requirements of having a specific and substantial use, however it does not satisfy the requirement that the asserted use is credible. This is because no material has been found to date which would be expected to prevent or retard ageing and there are no examples or evidence in the specification that provide credibility to the claim.

**Note:** If the specification had provided evidence that compound A could be used to treat factors associated with ageing such as skin wrinkles, then a claim to a method of treating the symptoms of ageing would satisfy the specific, substantial and credible use requirements.

3. The specification relates to the transfer of information at speeds faster than the speed of light.

   Claim 1. A method of transferring information at greater than the speed of light.

   The claim meets the requirements of having a specific and substantial use, however it does not satisfy the requirement that the asserted use is credible. This is because the claimed invention contravenes the well-established theory of special relativity.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.9.3.4 Useful (Utility)](#).

**Dependent Claims**
In general, where the subject matter of an independent claim meets the usefulness requirements, a dependent claim, narrower in scope but to similar subject matter, will also define a useful invention.

An exception to this general rule is where the use specified for the dependent claim differs from that of the independent claim. In this situation, the usefulness of the subject matter of the dependent claim should be considered on its own merits.

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**Alternatives in a Claim**

Where there are alternatives within a claim, everything that falls within the scope of the claim must be useful. This means that each embodiment encompassed by the claim must achieve the promised benefit and the specification must disclose a specific, substantial and credible use for the whole of the subject matter claimed.

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**Numerical Ranges Within a Claim**

When assessing claims containing numerical ranges, examiners should be mindful that everything falling within the scope of a claim must be useful.

The claimed invention should be taken to satisfy this requirement, unless there is good reason for a person skilled in the art to question whether the promised benefit would be achieved across the whole of the claimed range, and/or that the specification discloses a specific, substantial and credible use for the whole of the subject matter claimed.

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**Broad Claims**

When assessing broad claims, examiners should note that everything falling within the scope of a claim must be useful. An objection should be taken where there is good reason for a person skilled in the art to question whether the claimed invention is useful across the full scope of the claim.
For example, if the claimed invention relates to a broad class of chemical compounds and the examples demonstrate that only some of the compounds will produce the desired result, then the claimed invention will not satisfy the requirement that it be useful.

For all other standard patent applications/innovation patents, see 2.9.3.4 Useful (Utility).

Inventions asserted to be useful in the treatment of human or animal disorders are subject to the same legal requirements for usefulness as inventions in other technologies (see 2.9.3.4.1A Assessing the Claims for Lack of Usefulness, 2.9.3.4.1.1A Does the Invention Achieve the Promised Benefit? and 2.9.3.4.1.2A Specific, Substantial and Credible Use).

The useful purpose of many inventions is self-evident, well-established in the art, or may be implied in the specification. If the skilled addressee, based on the disclosure of the specification in combination with the common general knowledge in the art, could appreciate without difficulty that the claimed invention is useful, the claim will satisfy the requirement for usefulness.

Where this is not the case, examiners should consider the statements in the specification, and any other evidence provided in support of an asserted therapeutic or pharmacological use, to determine if there is a reasonable correlation between the stated activity of a compound or composition and the use asserted in the specification.

An applicant can establish the existence of a reasonable correlation between an activity and the asserted use by relying on: data documenting the activity of the compound or composition; logical arguments or reasoning; documentary evidence; or any combination of these. Factors that may be considered to corroborate an asserted therapeutic or pharmacological activity include:

- Evidence of structural similarity to a compound known to have a particular therapeutic or pharmacological use.
2.9.3.4.4A Contravention of Laws of Nature

- Data from *in vitro* or *in vivo* tests or *in silico* modelling that the person skilled in the art would accept as being reasonably predictive of an asserted use.
- Human clinical data.

Note that a reasonable correlation between an activity and the asserted use is sufficient to establish usefulness. The applicant is not required to prove as a matter of statistical certainty that a correlation exists between a particular activity and an asserted therapeutic use, or to provide evidence of efficacy or success in treating particular animals/humans where such a use is asserted.

Claims directed to a method of treating or curing a disease for which there have been no previously successful treatments or cures may necessitate careful review for compliance with the usefulness requirements. The fact that there is no known cure for a disease does not necessarily lead to the conclusion that such an invention lacks usefulness. Examiners should determine if the asserted use for a claimed invention is credible based on the information disclosed in the specification. Where there is doubt that the evidence provided in the specification establishes a credible use, evidence from experts in the art indicating that there is a reasonable expectation of success, or submissions supported by sound reasoning, may be sufficient to establish that an asserted use is credible.

Any objection that the claimed invention is not useful should include a reasoned explanation of why the claimed invention does not have a specific, substantial and/or credible use and/or why it does not achieve the promised benefit.

**Note:** Where claims to methods of treatment do not meet the requirements for usefulness, examiners should also consider whether a lack of support objection applies (see 2.11.7.10A Support Required for Pharmaceutical Inventions and Methods of Treatment).

Modified Date: 10 November 2014

2.9.3.4.4A Contravention of Laws of Nature

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.
2.9.3.5 Human Beings and Biological Processes for Their Generation

For all other standard patent applications/innovation patents, see 2.11.3.11 Contravention of Laws of Nature - e.g. Perpetual Motion Machines.

The fact that an invention is apparently contrary to the laws of nature is likely to result in an invention that is not useful. In particular, if it is clear that the invention cannot work as described in the specification, then the invention will lack a credible use and prima facie will not achieve the promise of the invention.

Inventions that contravene well-established laws of nature and are therefore non-operable, for example perpetual motion machines or ‘cold fusion’, will not satisfy the credible use requirement or the requirement that the claimed invention achieves the promised benefit.

Any objection that the claimed invention is not useful should explain why the claimed invention has no specific, substantial and/or credible use and/or why it will not achieve the promised benefit.

Note: Examiners should also consider whether other grounds of objection apply, e.g. lack of clear enough and complete enough disclosure (see 2.11.3.11A Contravention of Laws of Nature – e.g. Perpetual Motion Machines).

2.9.3.5 Human Beings and Biological Processes for Their Generation

Modified Date: 10 November 2014

2.9.3.5 Human Beings and Biological Processes for Their Generation

In this topic:

Under sec 18(2), human beings and the biological processes for their generation are specifically excluded from patentability.

Case Law

An interpretation of sec 18(2) is provided in Fertiliscentrum AB and Luminis Pty Ltd [2004] APO 19 and the decision gives guidance as to which inventions would be excluded from...
2.9.3.5 Human Beings and Biological Processes for Their Generation

patentability. *Fertilitescentrum AB and Luminis Pty Ltd* addresses what constitutes a 'human being', and thereby, what constitutes 'biological processes for their generation'. In the decision, the Deputy Commissioner reasoned that:

"The correct interpretation of s.18(2) is ascertained by recognising a human being as being in the process of generation from the time of the processes that create a fertilised ovum (or other processes that give rise to an equivalent entity) up until the time of birth."

and

"The prohibition of 'human beings' is a prohibition of patenting any entity that might reasonably claim the status of a human being, including a fertilised ovum and all its subsequent manifestations."

Furthermore:

"The prohibition of ‘biological processes (for the generation of human beings)’ clearly covers all biological processes applied from fertilisation to birth-so long as the process is indeed one that directly relates to the generation of the human being."

Additional guidance as to exclusions under sec 18(2) is provided in *Woo-Suk Hwang [2004] APO 24*, which relates to patentability of an inter-species hybrid embryo. In the decision, it was deemed that activation of an ovum by non-natural means is, in principle, analogous to fertilisation by natural means, and the presence of mitochondrial DNA from a non-human donor did not override the essential 'human' characteristic of a hybrid embryo wherein the nuclear DNA was human DNA.

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**Exclusions Under Subsection 18(2)**

It therefore follows that the exclusion under sec 18(2) of human beings from patentability extends *inter alia* to:

- fertilised human ova and equivalents;
- zygotes, blastocysts, embryos and foetuses; and
- totipotent human cells, including those cells that are the products of nuclear transfer procedures.

Biological processes for generating human beings which would be excluded from patentability include *inter alia*:
• methods of in vitro fertilisation;
• processes for intracytoplasmic sperm injection;
• processes for cloning at the 4-cell stage;
• processes for cloning by replacing nuclear DNA;
• processes or methods of growing or culturing fertilised ova, zygotes or embryos etc; and
• processes or methods for introducing transgenes and donor genetic or donor cytoplasmic material into fertilised ova, zygotes or embryos etc.

Methods and processes that involve the creation of a human embryo are also excluded from patentability. For example, methods for obtaining embryonic stem cells which comprise a step(s) for making an embryo would contravene sec 18(2). The exclusion applies regardless of the manner in which the embryo is generated, i.e. the exclusion extends to methods in which an embryo is generated by fertilisation of gametes, or nuclear transfer, or activation of gametes, or parthenogenesis etc.

**Breach of Prohibition of Human Cloning for Reproduction Act**

Examiners should be aware that in some circumstances, inventions relating to human embryos and methods of using human embryos which contravene sec 18(2), may also be in breach of the *Prohibition of Human Cloning for Reproduction Act 2002* and/or the *Research Involving Human Embryos Act 2002*. For example, it is unlawful to create a human embryo by a process other than fertilisation of a human egg by human sperm and it is unlawful to create an embryo for any purpose not related to assisted reproductive technology (ART). In Australia, embryonic stem cells may only be lawfully obtained from surplus ART embryos under the provisions of a licence granted by the National Health and Medical Research Council Licensing Committee.

In situations where an invention also contravenes the Prohibition of Human Cloning for Reproduction Act and/or the Research Involving Human Embryos Act, the invention is objectionable under sec 50(1)(a) as being ‘contrary to law’ and examiners should include an objection to this effect in their report.
2.9.3.5.1 Stem Cells

Patentable Inventions

Examples of inventions considered not to contravene sec 18(2) include:

- processes for cryopreservation of gametes;
- methods for pre-implantation genetic analysis of gametes; and
- processes or methods for determining the developmental progress or viability of a fertilised ovum, blastocyst or embryo, by analysis of culture or incubation media.

**Note:** Within the above range of inventions, there will inevitably exist a 'grey area' where it is not clear whether an invention contravenes sec 18(2).

If examiners are unclear whether an invention constitutes a human being or a biological process for the generation of a human being, and whether such a being or process is also contrary to law, they **must** refer the matter to a supervising examiner. The supervising examiner should then discuss the matter with an Assistant General Manager.

2.9.3.5.1 Stem Cells

In this topic:

Stem cell technologies are to be considered and examined in the same light as other technical inventions. These guidelines essentially clarify the patentability of stem cell technologies in relation to sec 18(2) and sec 50(1)(a) and do not remove the obligation to review applications involving these technologies for compliance with all other statutory requirements.
Stem Cells

Stem cells are cells with the ability to divide indefinitely in culture and the capacity to differentiate into other cell types.

- A pluripotent stem cell is able to differentiate into any cell type in the body of the mature organism.
- A multipotent stem cell has a more restricted differentiation potential compared with a pluripotent stem cell.
- A totipotent stem cell has the ability to differentiate into any cell type of the species from which it is derived. Any human cell type, as well as a complete human being, is able to be generated from a single human totipotent cell.

Stem cells are further classified according to their tissue of origin.

Human Embryonic Stem Cells

Human embryonic stem cells are derived from the inner cell mass of the human blastocyst and are considered to be pluripotent because of their capacity to differentiate into cell types of mesodermal, ectodermal and endodermal lineages. Human embryonic stem cells are not considered totipotent because these stem cells or their differentiated derivative cells do not have the capacity to develop into an entire human being.

Given the interpretation of 'human being' set forth in Fertilitescentrum AB and Luminis Pty Ltd [2004] APO 19, it follows that human stem cells and human stem cell lines per se are patentable because these cells are not considered to be human beings or potential human beings within the meaning of sec 18(2).

Human embryos, however, are considered to be human beings within the meaning of the sec 18(2). Consequently, human embryos and processes for generating or culturing human embryos for any purpose, including the harvest of stem cells, are not patentable. The exclusion extends to all means of generating human embryos and includes generation of embryos by nuclear transfer, altered nuclear transfer, activation of gametes and parthenogenesis.

Human Adult Stem Cells

Adult stem cells are derived from various postnatal and adult tissues such as cord blood, bone marrow, adipose tissue and neural tissue. There are some reports of pluripotent adult stem cells, however the majority of adult stem cells appear to be multipotent in that they
have the capacity to develop into cells of only one or two of either the mesodermal or ectodermal or endodermal lineages. These stem cells do not have totipotent capacity to generate a human being.

As adult stem cells are derived from non-embryonic tissues, both adult stem cells *per se* and processes for their isolation from non-embryonic tissues and organs are patentable with respect to sec 18(2).

**Human Totipotent Stem Cells**

A totipotent cell can be derived from fertilised oocytes and cells of an embryo up to about the 8 cell stage, and have the inherent capacity to generate an entire human being. Consequently, these cells and methods or processes of obtaining human totipotent cells are not patentable under sec 18(2).

**Human/Non-Human Hybrid Totipotent Cells and Stem Cells**

The provisions of sec 18(2) relate only to human beings and methods of their generation. Consequently, non-human cell types and methods of their isolation from non-human animals are patentable.

A question arises however, as to the patentability of cells derived from inter-species hybrids or chimeras. In *Woo-Suk Hwang* [2004] APO 24, it was considered that the presence of human nuclear DNA in a cell is sufficient to confer 'human being' characteristics on the cell. It follows that if totipotent cells were or could be derived from inter-species hybrids with 'human being' characteristics, the cells and the methods of their generation would not be patentable.

Stem cells derived from inter-species embryos with 'human being' characteristics are considered to be human stem cells and are patentable, however all processes for the generation and culture of the inter-species embryo are not patentable under sec 18(2).

**Relevance of Subsection 50(1)(a)**

Under sec 50(1)(a), a patent may be refused if the invention is contrary to law. In some cases, inventions relating to stem cells derived from human embryos may be in breach of
the *Prohibition of Human Cloning for Reproduction Act 2002* and/or the *Research Involving Human Embryos Act 2002*. The legislation includes the provision that a human embryo may only be created by fertilisation of a human egg by a human sperm, and that it is an offence to create embryos by other means, for example by combining cells or cellular material from a human and another species or by cloning embryos. In situations where the process or method for generating human embryonic stem cells appears to contravene either the *Prohibition of Human Cloning for Reproduction Act* and/or the *Research Involving Human Embryos Act*, an objection under sec 50(1)(a) is to be taken.

2.9 Annex A - History of Manner of Manufacture

In this topic:

The following cases are among the more significant ones in the development of the "traditional principles" underlying the concept of manner of manufacture:

**Muntz v Foster (1843) 2 WPC 93**

A person who discovers a "hidden and concealed virtue" in something known that enables him to apply the known thing to some useful manufacturing purpose to which it has not been applied before, is entitled to patent the novel application.

In this case, the invention lay in the application of plates made from a particular known alloy for sheathing the bottom of ships, such alloys being found to prevent fouling.

**Harwood v Great Northern Railway Co. (1865) 35 LJQB 27**

"You cannot have a patent for a well known mechanical contrivance merely because it is applied in a manner or to a purpose which is analogous to the manner, or for the purpose in or to which it has been hitherto notoriously used."
2.9 Annex A - History of Manner of Manufacture

Gadd & Mason v The Mayor etc. of Manchester *(1892)* 9 RPC 516

The law on new use of old contrivances is set down at page 524 (and adopted by the High Court of Australia in *Willmann v Petersen* 2 CLR 1 at page 17).

"1. A patent for the mere use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad and cannot be supported. If the new use involves no ingenuity but is in manner and purpose analogous to the old use, although not quite the same, there is no invention; no manner of new manufacture within the meaning of the Statute of James. 2. On the other hand a patent for a new use of a known contrivance is good and can be supported if the new use involves practical difficulties which the patentee has been first to see and overcome by some ingenuity of his own."

British Liquid Air Co. Ltd. v British Oxygen Co. Ltd. *(1909)* 26 RPC 509

The principle underlying the doctrine of analogous use was stated at page 532:

"the application of a known device to its ordinary purpose under analogous circumstances is not good subject matter for Letters Patent, because it does not involve invention."

B.A.'s Application *(1915)* 32 RPC 348

When once a substance is known and its characteristics well defined, the mere use of the substance for purposes not previously known is not patentable. However, a substance cannot be "known" unless its characteristics are well defined; and using a substance because of a property hitherto unknown or unsuspected for a purpose to which it has not
Annex A - History of Manner of Manufacture

formerly been applied would indicate that the chemical was a "known" substance only partially and as far as the new property is concerned, it was unknown.

L. & G.'s Application (1941) 58 RPC 21

The use of a known material in the manufacture of known articles for the reason that it possesses a known property which renders it useful for that purpose is not a manner of new manufacture. Thus, an application for the manufacture of the parts of electricity meters, which are subject to wear, from oxide-coated aluminium, was rejected, since it was known that the coating of aluminium with oxide rendered it resistant to wear.

G.E.C.'s Application (1943) 60 RPC 1

A test for assessing whether a method or process is a manner of manufacture was formulated by Morton J:

"In my view a method or process is a manner of manufacture if it (a) results in the production of some vendible product or (b) improves or restores to its former condition a vendible product or (c) has the effect of preserving from deterioration some vendible product to which it is applied."

Note: It must be kept in mind that Morton's rules are only a guide to assessing whether a method or process is a manner of manufacture. The NRDC case (below) has made it clear that where these rules are used as a guide, the words "vendible" and "product" should be given a broad interpretation. Thus, a product is "vendible" if the question "Is the significance of the product of economic value to the community?" can be answered affirmatively. Moreover, a "product" need not be something in the sense of a tangible article, it may be any artificially created state of affairs.

Cementation Co. Ltd.'s Application (1945) 62 RPC 151
A fire quenched subterranean formation is a vendible product according to Morton's rules.

Rantzen's Application (1947) 64 RPC 63

A "product" under Morton's rules could well be an electrical oscillation.

Elton and Leda Chemicals Ld.'s Application (1957) RPC 267

A fog-free atmosphere is a vendible product under Morton's rules.

Commissioner of Patents v Microcell Ltd (1959) 102 CLR 232

The case related to rocket projectors comprising tubes of reinforced synthetic resinous plastic material.

The High Court held that there was:

"in truth nothing but a claim for the use of a known material in the manufacture of known articles for the purpose of which its known properties make that material suitable. A claim for nothing more than that cannot be subject-matter for a patent, and the position cannot be affected either by the fact that nobody thought of doing the thing before, or by the fact that, when somebody did think of doing it, it was found to be a good thing to do".
National Research Development Corporation v Commissioner of Patents (1959) 102 CLR 252; (1961) RPC 134; 1A IPR 63

The concept of a patentable process was considered (CLR at 275):

"The point is that a process, to fall within the limits of patentability which the context of the Statute of Monopolies has supplied, must be one that offers some advantage which is material, in the sense that the process belongs to a useful art as distinct from a fine art ... that its value to the country is in the field of economic endeavour."

and CLR at 269:

"The word "manufacture" finds a place in the present Act, not as a word intended to reduce a question of patentability to a question of verbal interpretation, but simply as the general title found in the Statute of Monopolies for the whole category under which all grants of patents which may be made in accordance with the developed principles of patent law are to be subsumed. It is therefore a mistake, and a mistake likely to lead to an incorrect conclusion, to treat the question whether a given process or product is within the definition as if that question could be restated in the form: "Is this a manner (or kind) of manufacture?" It is a mistake which tends to limit one's thinking by reference to the idea of making tangible goods by hand or by machine, because "manufacture" as a word of everyday speech generally conveys that idea. The right question is: "Is this a proper subject of letters patent according to the principles which have been developed for the application of s. 6 of the Statute of Monopolies?"

University of Sydney's Application (1970) AOJP 2438

A method of treating livestock with hormonal substances in order to regulate the ovulating period was considered to be of economic significance by aiding the control of the breeding season.

Bernhard Joos v Commissioner of Patents 126 CLR 611; (1972) AOJP 3431
Barwick CJ decided that cosmetic processes or methods for improving or changing the appearance of the human body or any part of it which have a commercial application are proper subject matter for the grant of letters patent. The claim, the subject of the decision, was for a process for improving the strength and elasticity of keratinous material, especially human nails and hair, comprising applying thereto a particular composition.

**Ranks Hovis McDougall Ltd's Application (1976) AOJP 3915**

The question of patenting living organisms was considered. The hearing officer decided that:

- no objection can be taken to a claim to a new organism on the ground that it is something living;
- any new variants claimed must have improved or altered useful properties and not merely have changed morphological characteristics which have no effect on the working of the organism;
- naturally occurring micro-organisms *per se* are not patentable as they represent a discovery and not an invention; and
- a claim to a pure culture of the micro-organism would satisfy the requirements for technical intervention.

**Wellcome Foundation Limited v The Commissioner of Patents (1980) AOJP 2759**

"The claims in dispute are package claims, i.e. claims to a container with its contents together with a set of written directions. The circumstances in which such package claims will be valid are limited. Novelty in the process for which the package may be used will not be sufficient."
International Business Machines Corporation v Commissioner of Patents (1991) 22 IPR 417

The use of a mathematical formula in a computer to produce an improved curve image was held to be patentable, since the production of the improved curve image is a commercially useful effect in computer graphics. Specifically Burchett J found:

“Although there was nothing new about the mathematics of the invention what was new was the application of the selected mathematical methods to computer, and, in particular, to the production of the desired curve by the computer. This involved steps which were foreign to the normal use of computers and, for that reason, were inventive. A method of producing that by computer, which is novel and inventive, is entitled to the protection of the patent laws.”

Anaesthetic Supplies Pty Ltd v Rescare Ltd (1994) AIPC 91-076; 28 IPR 383

The specification related to a method of treating snoring and/or obstructive sleep apnoea. The court decided that similar principles applied to methods of treatment of the human body for therapeutic purposes as for cosmetic purposes. It held that there was no justification in law or logic to distinguish a process of curative treatment of the human body from that of cosmetic treatment, and that both of these forms of treatment may constitute a manner of manufacture provided they have commercial application. In arriving at its conclusion, the court commented that Parliament, having the opportunity to exclude matters from patentability under the 1990 Act, chose to limit the exclusions to those of sec 18(2).

This decision appeared to reinforce the practice adopted by the Office following the Joos decision that no objection need be taken to methods or processes for the treatment of human beings on that basis alone.

CCOM Pty Ltd v Jiejing Pty Ltd [1994] FCA 1168

The described apparatus in a broad sense consisted of conventional computer equipment including a database, a visual display and a keyboard. Generally, CCOM claimed an interface with a database that contained a data structure of Chinese language characters
which encoded strokes by stroke type and in an order in which the strokes are written (if writing by hand). The claim also defined software that presented the strokes on the display for the user. The interface also provided a retrieval program and graphic representation of each character that enabled the user to select the character using the keyboard. The overall outcome was an efficient way of retrieving Chinese characters. Cooper J found that:

“The NRDC Case (102 CLR at 275-277) requires a mode or manner of achieving an end result which is an artificially created state of affairs of utility in the field of economic endeavour. In the present case, a relevant field of economic endeavour is the use of word processing to assemble text in Chinese language characters. The end result achieved is the retrieval of graphic representations of desired characters, for assembly of text. The mode or manner of obtaining this, which provides particular utility in achieving the end result, is the storage of data as to Chinese characters analysed by stroke-type categories, for search including ‘flagging’ (and ‘unflagging’) and selection by reference thereto.”

**NV Philips Gloeilampenfabrieken v Mirabella International Pty Ltd 32 IPR 449**

The majority of the High Court concluded that "newness" was imported into sec 18(1)(a) to the extent that:

"the phrase “manner of manufacture within the meaning of section 6 of the Statute of Monopolies” in s 18(1)(a) should be understood as referring to a process which is a proper subject matter of letters patent according to traditional principles."

This case sets a threshold requirement that an “alleged” invention must possess the necessary quality of inventiveness, i.e. be an "alleged invention", on the face of the specification. Simply put, a specification should not “self-admit” a lack of novelty or inventive step. Here, their honours in majority said that if the threshold is not met, then “one need go no further”.


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Effective Date: 25 September 2019
The High Court upheld an appeal against a decision taken by the Federal Court, in which that court held that an inventive step had to be present in a "combination" invention in order for it to be patentable under sec 18(1)(a). After commenting that:

"'[merit'] was used sometimes in reference to subject-matter, sometimes in reference to novelty. The phrase invites error through imprecision of legal analysis ..."

it concluded:

"In that respect the Full Court [of the Federal Court] was in error in considering under the ground of revocation in sec 100(1)(d) matters that could have arisen under other grounds, namely obviousness and lack of novelty, but which either did not arise or were put to one side."

This decision makes it clear that novelty and inventive step are separate grounds to manner of manufacture, and it is wrong to find that a claim lacks a manner of manufacture because it is not novel or not inventive (aside from the “threshold test” of Philips v Mirabella).

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**Grant v Commissioner of Patents [2006] FCAFC 120**

The requirements for a patentable process were considered by the Full Court at [47]:

"It is necessary that there be some "useful product", some physical phenomenon or effect resulting from the working of a method for it to be properly the subject of letters patent."

(see also 2.9.2.7 Computer Implemented Inventions – Schemes and Business Methods).

The court also held that:

“Legal advices, schemes, arguments and the like are not a manner of manufacture.”

(see also 2.9.2.5 Discoveries, Ideas, Scientific Theories, Schemes and Plans).

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**Research Affiliates LLC v Commissioner of Patents [2014] FCAFC 150**
The Full Court of the Federal Court dismissed an appeal from a decision of a single judge of the Federal Court finding that a method of generating a weighted share index was not a manner of manufacture. The Full Court found that where it is clear from the specification as a whole that an invention is truly a scheme, an abstract idea or mere intellectual information, which are not patentable themselves, then implementing that invention on a computer is not an artificially created state of affairs that can be held to be patentable.

(see also 2.9.2.7 Computer Implemented Inventions – Schemes and Business Methods)

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**D’Arcy v Myriad Genetics Inc [2015] HCA 35**

The High Court overturned the finding of the Full Court of the Federal Court that isolated nucleic acid sequences coding for mutated or polymorphic forms of the human polypeptide BRCA1 (relating to breast cancer) are patentable. The High Court found that the information stored in the nucleic acid sequences coding for the mutated or polymorphic BRCA1 polypeptide is the same as that contained in the DNA of the person from which the nucleic acid is isolated. This information (which constitutes the substance of the claimed invention) is not ‘made’ by human action and consequently the isolated nucleic acid sequences do not meet the manner of manufacture requirements.

(see also 2.9.2.6 Nucleic Acids and Genetic Information).

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**Commissioner of Patents v RPL Central Pty Ltd [2015] FCAFC 177**

The Full Court of the Federal Court upheld an appeal by the Commissioner of Patents confirming the Commissioner’s decision that an online method for collecting evidence of skills and knowledge to meet a recognised qualification standard (e.g. within the Australian Vocational Education and Training Sector) is not patentable. Extending principles from its decision in *Research Affiliates*, the Full Court found that the implementation of the method by computer and the internet was insufficient to confer patentability. The Court considered the recent decision of the High Court in *D’Arcy v Myriad Genetics Inc [2015] HCA 35*, which identified the key requirement to consider the substance of the invention, and found that the present case could be determined under existing principles applicable to computer
implemented business methods and did not involve a new class of claim involving a significant extension of the concept of manner of manufacture.

(see also 2.9.2.7 Computer Implemented Inventions – Schemes and Business Methods).

2.10 Divisional Applications (Sections 79B and 79C)

Modified Date: 01 March 2013

2.10.1 Application

Note: The information in this part only applies to divisional applications filed before 15 April 2013. For all other divisional applications, see 2.10.1A Application.

In this topic:

General

A divisional application is a further complete application made from a "parent" application, or a "parent" innovation patent, under the provisions of sec 79B or sec 79C.

The parent application:

- can be an application for a standard patent or an innovation patent.
- may itself be a divisional application.
- may be a PCT application.
- cannot be a provisional application.

It is also possible for a single divisional application to be made in respect of two or more different parent applications.

Further information on the requirements for filing a divisional application and priority date considerations is provided in:

- 2.10.2 Priority Entitlement;
- 2.10.3 Time Limits for Filing Applications; and
- 2.10.4 Status of Parent.
Applicant and Inventors

The applicant for the divisional application must be the same as the applicant of the parent application, or the patentee of the parent patent. However, examiners should note that sec 79B defines an "applicant" as having the same meaning as sec 38. Therefore, an applicant includes a person entitled to make a request under sec 113. If the applicants are different, there should be a clear entitlement under sec 113. This does not require that an actual request under sec 113 is made, but rather that the evidentiary requirements to warrant a sec 113 direction are met (see 2.6.4.2 Section 113 Amendments (Assignment, Agreement or Operation of Law)). Otherwise, an objection to the difference in applicants must be taken.

Where a parent application has joint applicants, all co-applicants need to apply for the divisional application. The one exception is where a co-applicant can provide evidence of an assignment of the other co-applicant's part interest in the parent application.

In principle, it is possible for an invention which is the subject of a divisional application to have different inventors to those associated with the invention which is the subject of the parent application. This applies even where the specifications of the parent and divisional are the same. Examiners should therefore assume that any information provided in this regard is correct.

Statement of Entitlement

Where the applicant of the divisional application is the same as the applicant of the parent application, or the patentee of the parent patent, the applicant does not need to state their entitlement to make the divisional application.

Where this is not the case, the applicant must state that the person nominated for the grant of the patent is entitled to make a request under sec 113 in relation to the parent application. In this regard, a statement provided with the request for examination will suffice.

A statement, where required, must be filed in order for the application to proceed as a divisional application.
Patent Request

The patent request must invoke the provisions of sec 79B or sec 79C by stating the number of the parent application/patent.

Where a request does not invoke sec 79B or sec 79C, but there is evidence on file to suggest that the applicant intended to invoke the provision (e.g. the applicant indicates in an accompanying letter that the application is a divisional), the application should be treated as a divisional application and an objection taken to the request.

Note: The information in this part only applies to divisional applications filed on or after 15 April 2013. For all other divisional applications, see 2.10.1 Application.

In this topic:

General

A divisional application is a further complete application made from a "parent" application, or a "parent" innovation patent, under the provisions of sec 79B or sec 79C.

The parent application:

- can be an application for a standard patent or an innovation patent.
- may itself be a divisional application.
- may be a PCT application.
- cannot be a provisional application.

It is also possible for a single divisional application to be made in respect of two or more different parent applications.
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- 2.10.2A Priority Entitlement;
- 2.10.3A Time Limits for Filing Applications; and
- 2.10.4 Status of Parent.

Applicant and Inventors

The applicant for the divisional application must be the same as the applicant of the parent application, or the patentee of the parent patent. However, examiners should note that sec 79B defines an "applicant" as having the same meaning as sec 38. Therefore, an applicant includes a person entitled to make a request under sec 113. If the applicants are different, there should be a clear entitlement under sec 113. This does not require that an actual request under sec 113 is made, but rather that the evidentiary requirements to warrant a sec 113 direction are met (see 2.6.4.2 Section 113 Amendments (Assignment, Agreement or Operation of Law)). Otherwise, an objection to the difference in applicants must be taken.

Where a parent application has joint applicants, all co-applicants need to apply for the divisional application. The one exception is where a co-applicant can provide evidence of an assignment of the other co-applicant's part interest in the parent application.

In principle, it is possible for an invention which is the subject of a divisional application to have different inventors to those associated with the invention which is the subject of the parent application. This applies even where the specifications of the parent and divisional are the same. Examiners should therefore assume that any information provided in this regard is correct.

Statement of Entitlement

Where the applicant of the divisional application is the same as the applicant of the parent application, or the patentee of the parent patent, the applicant does not need to state their entitlement to make the divisional application.
Where this is not the case, the applicant must state that the person nominated for the grant of the patent is entitled to make a request under sec 113 in relation to the parent application. In this regard, a statement provided with the request for examination will suffice.

A statement, where required, must be filed in order for the application to proceed as a divisional application.

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**Patent Request**

The patent request must invoke the provisions of sec 79B or sec 79C at the time of filing the divisional application. Thus, the patent request must indicate that the application is a divisional application under sec 79B or sec 79C and state the number of the parent application/patent.

COG will check that these requirements have been met at filing. However, where examiners become aware of any issues during examination, e.g. the parent application number is incorrect, these should be raised in the report.

Where a request does not invoke sec 79B or sec 79C, but there is evidence on file to suggest that the applicant intended to invoke the provision (e.g. the applicant indicates that the application is a divisional in an accompanying letter), the application should be treated as a divisional application and an objection taken to the request.

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**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.10.2A Priority Entitlement.
A divisional application will normally obtain its priority entitlement from the parent application(s) or patent(s) via the provisions of reg 3.12(1)(c) or reg 3.12(1)(d). For an application to proceed as a divisional application under sec 79B or sec 79C, at least one claim must be eligible to take the priority date of a parent specification. To obtain the benefit of sec 79B or sec 79C, the subject matter claimed in the divisional application must merely be disclosed in the parent. However, there is no requirement that the subject matter must be identified as being an invention in the parent. Note that any special priority present in the parent (e.g. Convention priority) is, if appropriate, carried through to the divisional application (reg 3.12(1)(c) or reg 3.12(1)(d) and reg 3.12(2)).

A claim of a divisional innovation patent application filed under sec 79C will only be entitled to obtain priority from the parent if examination of the divisional patent is requested within 2 months of the date of grant of a patent on the divisional application, and the claim is fairly based on matter disclosed in the parent (sec 43(6) and reg 3.12(1)(d)).

Priority Entitlement Where the Divisional Application is Also a Convention Application

A divisional application may claim Convention priority from a basic application that is not referred to in the parent case. In this situation, the divisional application can proceed as both a sec 79B or sec 79C application and a Convention application. This claim to Convention priority must be stated in the notice of entitlement and derives from reg 3.12(1)(b). Provided at least one claim is entitled to Convention priority, and at least one claim is entitled to the priority date of the parent, the application may proceed as both a Convention and a divisional. It is also possible for the same claim to give Convention and divisional status to the divisional application, either because the claim includes distinct alternative embodiments, or because the divisional application was filed within 12 months from the date of filing of the basic application for the parent.

Note: Similar considerations apply to a divisional application that claims priority from an associated provisional application.

Copy of Priority Document
During examination, it is not necessary for a copy of the priority document for the parent application to be on file, except under the following circumstances:

a. where third parties request a copy of the document;

b. in examination or re-examination, where there is a citation published after the priority date and before the filing date, or a whole of contents citation with a priority date after the priority date and before the filing date, of the case being examined;

c. in examination or re-examination, where there is a whole of contents citation having a priority date before the priority date of the case being examined; or

d. in opposition, when requested by the opponent.

If either of circumstances b. and c. arises, examiners should follow the procedures outlined in 2.21.3.8 Basic Specifications (where the parent application is a Convention application) or 2.20.5.2 Obtaining and Considering Priority Documents (where the parent application is a PCT application).

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.10.2 Priority Entitlement.

A divisional application will normally obtain its priority entitlement from the parent application(s) or patent(s) via the provisions of reg 3.13D or reg 3.13E. For an application to proceed as a divisional application under sec 79B or sec 79C, at least one claim must be eligible to take the priority date of a parent specification. To obtain the benefit of sec 79B or sec 79C, at least one claim of the divisional application must define an invention that is disclosed in the parent in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art. However, there is no requirement that the subject matter of the divisional must be identified as being an invention in the parent. Note that any special priority present in the parent (e.g. Convention priority) is, if
2.10.2A Priority Entitlement

appropriate, carried through to the divisional application (reg 3.13D(3) or reg 3.13E(2) and reg 3.13A, reg 3.13B and reg 3.13C).

A claim of a divisional innovation patent application filed under sec 79C will only be entitled to obtain priority from the parent if examination of the divisional patent is requested within 2 months of the date of grant of a patent on the divisional application, and the parent contains a clear enough and complete enough disclosure of the claimed invention (reg 3.13E(1)).

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Priority Entitlement Where the Divisional Application is Also a Convention Application

A divisional application may claim Convention priority from a basic application that is not referred to in the parent case. In this situation, the divisional application can proceed as both a sec 79B or sec 79C application and a Convention application. This claim to Convention priority must be stated in the notice of entitlement and derives from reg 3.13B. Provided at least one claim is entitled to Convention priority, and at least one claim is entitled to the priority date of the parent, the application may proceed as both a Convention and a divisional. It is also possible for the same claim to give Convention and divisional status to the divisional application, either because the claim includes distinct alternative embodiments, or because the divisional application was filed within 12 months from the date of filing of the basic application for the parent.

Note: Similar considerations apply to a divisional application that claims priority from an associated provisional application.

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Copy of Priority Document

During examination, it is not necessary for a copy of the priority document for the parent application to be on file, except under the following circumstances:

a. where third parties request a copy of the document;

b. in examination or re-examination, where there is a citation published after the priority date and before the filing date, or a whole of contents citation with a priority date after the priority date and before the filing date, of the case being examined;
2.10.3 Time Limits for Filing Applications

c. in examination or re-examination, where there is a whole of contents citation having a
   priority date before the priority date of the case being examined; or

d. in opposition, when requested by the opponent.

If either of circumstances b. and c. arises, examiners should follow the procedures outlined
in 2.21.3.8 Basic Specifications (where the parent application is a Convention application) or
2.20.5.2 Obtaining and Considering Priority Documents (where the parent application is a
PCT application).

Note: The information in this part only applies to divisional applications filed before 15 April
2013. For all other divisional applications, see 2.10.3A Time Limits for Filing Applications.

In this topic:

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Divisional Application Filed Prior to Grant of Parent Patent

Under sec 79B, an applicant may make a divisional application for either a standard patent
application or an innovation patent application before the grant of the parent application
(either a standard patent application or an innovation patent application).

Parent Application is for a Standard Patent

The divisional application may be filed at any time before grant of the parent, subject to the
status of the parent (see 2.10.4 Status of Parent). However, under the provisions of sec
79B(1)(b), where the divisional application is filed more than 3 months after the parent was
advertised as accepted, the divisional application must be directed to an invention falling
within the scope of the claims of the accepted parent specification (see 2.10.5 Subject
Matter).

Note: For the purposes of applying the time limit set out in sec 79B(1)(b), the date of filing of
the divisional application means the date of the application, regardless of whether there was
any reference, formal or informal, to sec 79B or sec 79C in that original application.
2.10.3 Time Limits for Filing Applications

Consequently, in certain circumstances it is possible for an application to be converted to a sec 79B or sec 79C application by amendment of the patent request, even though the first invoking of sec 79B or sec 79C occurs only after grant of the parent, or after the parent has lapsed (see 2.10.10 Amendment of Patent Request – Conversion of Application to a Divisional and 2.10.10A Amendment of Patent Request – Conversion of Application to a Divisional).

**Parent Application is for an Innovation Patent**

The divisional application may be filed at any time before grant of the parent, subject to the status of the parent (see 2.10.4 Status of Parent).

However, where the parent application is itself a divisional of an innovation patent under sec 79C (grandparent), sec 79B(1A) provides that a further divisional application (either an innovation or standard patent application) cannot be made prior to grant. This prevents a standard patent application being divided out from a granted innovation patent, either directly, or by being divided out as an application for an innovation patent and then being converted to an application for a standard patent.

**Divisional Application Filed After Grant of Parent Patent**

**Parent is a Standard Patent**

There is no provision for filing a divisional application where the parent is a granted standard patent.

**Parent is an Innovation Patent**

After grant of an innovation patent, the patentee can file a divisional application for another innovation patent (sec 79C). However, the divisional application must be filed during the period that commences on the date that examination of the parent begins, and finishes 1 month after the date of advertisement of certification of the parent patent (also referred to as the date of publication of a notice of the occurrence of examination), subject to the status of the parent (see 2.10.4 Status of Parent).
In this context, the divisional application must be for a ‘further invention’ disclosed in the parent, i.e. a different invention. The purpose of this requirement is to allow patentees to file divisional applications for further inventions during examination of the parent (or shortly thereafter), for example when lack of unity issues arise or more than one invention is disclosed but not claimed. It is not intended to provide a general post-grant divisional mechanism.

Examination Practice

If a time limit in respect of a divisional application is not met, an objection should be taken that the application is not entitled to divisional status.

Where an application purports to be a divisional application, but has not been filed within the relevant time limits, examiners should check whether the time for filing of the application has been extended. If an extension of time has been sought and granted in relation to the filing of the application, then the application will satisfy the timing aspects. If a request for an extension of time has not been processed, the matter should be immediately referred to the Assistant General Manager (OEP) via a supervising examiner.

In this topic:

Divisional Application Filed Prior to Grant of Parent Patent

Under sec 79B, an applicant may make a divisional application for either a standard patent application or an innovation patent application before the grant of a parent application (either a standard patent application or an innovation patent application).
2.10.3A Time Limits for Filing Applications

**Parent Application is for a Standard Patent**

The divisional application must be filed no later than 3 months from the date of advertisement of acceptance of the parent application (also referred to as the date of publication of a notice of acceptance of the parent application), subject to the status of the parent (see 2.10.4 Status of Parent).

**Parent Application is for an Innovation Patent**

The divisional application may be filed at any time before grant of the parent, subject to the status of the parent (see 2.10.4 Status of Parent).

However, where the parent application is itself a divisional of an innovation patent under sec 79C (grandparent), sec 79B(1) provides that a further divisional application (either an innovation or standard patent application) cannot be made prior to grant. This prevents a standard patent application being divided out from a granted innovation patent, either directly, or by being divided out as an application for an innovation patent and then being converted to an application for a standard patent.

**Divisional Application Filed After Grant of Parent Patent**

**Parent is a Standard Patent**

There is no provision for filing a divisional application where the parent is a granted standard patent.

**Parent is an Innovation Patent**

After grant of an innovation patent, the patentee can file a divisional application for another innovation patent (sec 79C). However, the divisional application must be filed during the period that commences on the date that examination of the parent begins, and finishes 1 month after the date of advertisement of certification of the parent patent (also referred to as the date of publication of a notice of the occurrence of examination), subject to the status of the parent (see 2.10.4 Status of Parent).
In this context, the divisional application must be for a ‘further invention’ disclosed in the parent, i.e. a different invention. The purpose of this requirement is to allow patentees to file divisional applications for further inventions during examination of the parent (or shortly thereafter), for example when lack of unity issues arise or more than one invention is disclosed but not claimed. It is not intended to provide a general post-grant divisional mechanism.

**Examination Practice**

If a time limit in respect of a divisional application is not met, an objection should be taken that the application is not entitled to divisional status.

Where an application purports to be a divisional application, but has not been filed within the relevant time limits, examiners should check whether the time for filing of the application has been extended. If an extension of time has been sought and granted in relation to the filing of the application, then the application will satisfy the timing aspects. If a request for an extension of time has not been processed, the matter should be immediately referred to the Assistant General Manager (OEP) via a supervising examiner.

Modified Date: 25 September 2019

**2.10.4 Status of Parent**

In this topic:

**General**

The parent application/patent must be in force at the time of filing the divisional. Thus, a divisional application invoking sec 79B or sec 79C cannot be made:

- where the parent application is for a standard patent or an innovation patent: after the parent application has lapsed, or been refused or withdrawn.
2.10.4 Status of Parent

- where the parent is an innovation patent, and the divisional application is also for an innovation patent: after the term of the parent patent has ended, or the patent has ceased or been revoked.

However lapsing, refusal, or withdrawal of the parent application, or cessation of the parent patent, after filing of the divisional application does not invalidate the filing of the divisional or its entitlement to earlier priority dates.

Note: Examiners should also check whether the time limits for filing a divisional application have been met (see 2.10.3 Time Limits for Filing Applications).

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**Lapsing of Parent**

The fact that a parent application is in a state of lapse due to the non-payment of continuation fees does not necessarily invalidate the filing of a divisional application. If the continuation fee is subsequently paid, the application can proceed as a divisional application. If the fee has not been paid before examination of the divisional application, examiners are to object that the application is not entitled to divisional status.

Where the parent application lapses on a weekend or public holiday through failure to gain acceptance in time, a divisional application may be filed on the next working day without the need to obtain an extension of time under sec 223 (see sec 222A).

Note: In certain situations, the invoking of sec 79B or sec 79C does not need to occur before lapsing of the parent. Thus, an application may be converted to a divisional application by amendment of the patent request, even though the parent has lapsed. Such an amendment is only allowable in particular circumstances (see 2.10.10 Amendment of a Patent Request – Conversion of Application to a Divisional and 2.10.10A Amendment of a Patent Request – Conversion of Application to a Divisional).

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**Parent is a PCT Application**

A PCT application which designates Australia can be a parent application for a divisional application, since a PCT application is treated as a complete application under the Act. This applies regardless of whether the PCT application enters the national phase in Australia.
However, the PCT application must not have lapsed, been refused or withdrawn at the time the divisional application is made.

Circumstances may arise where the parent PCT application is not OPI, or is not available to the Office. In this situation, examiners should object that the application cannot proceed as a divisional application before:

- WIPO communicates the PCT application pursuant to Article 20 of the PCT; or
- the applicant requests entry of the PCT application into the national phase in Australia; or
- the applicant supplies a copy of the PCT application, together with a declaration that it is a true copy of the application as filed and that it has not been either withdrawn or deemed withdrawn before the divisional application was filed.

Since the parent application is not available, examination must be conducted on the assumption that the priory date is the date of filing.

Examiners should note that regardless of the above, if the nominated PCT application was withdrawn under the PCT before the filing date of the divisional application, that application is not entitled to divisional status.

Where the applicant is unable to provide a copy of the PCT application, a new patent request that omits the request for divisional status will need to be filed before acceptance.

[see also PERP code H3]

**Note:** A parent PCT application is considered to be available if it is accessible through PAMS, Patentscope or INTESS. If the parent application has not entered the national phase, it will not be available through PAMS and will need to be retrieved from Patentscope or INTESS. For further information on this process, see 5.16.4.3.15 What do I do When the Parent of a Divisional is not Available Through PAMS.

### PCT Application is in a Foreign Language

Where the parent application is a PCT application that is in a foreign language, and there is no translation on file, examiners should request that the applicant file a translation in order to establish the divisional status of the application under examination. (For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided). However, examination should nevertheless continue, based on the assumption that the priority claim is valid. Once the translation is received, it should be placed on the file of the parent application, provided such a file exists. Where it does not, the translation...
should be placed on the file of the divisional application. If the applicant declines to file the translation, the matter should be referred to the Assistant General Manager (OEP).

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**Parent is an Application for a Patent of Addition**

Where the parent application is for a patent of addition, the date of the patent granted on the divisional application only goes back to its parent (additional) application, and not to the date of the parent of the additional application (i.e. the grandparent of the divisional application).

A similar situation applies with regard to the renewal fee date and the priority date.

Thus, while the term of the divisional application may expire after that of the grandparent, it is conceivable for the divisional application to claim matter that was disclosed in the parent, and for which an inventive step objection applies based on the grandparent. In this situation, it may be possible overcome the problem by making the divisional application an additional application to the grandparent.

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**Note:** The information in this part only applies to divisional applications filed before 15 April 2013. For all other divisional applications, see 2.10.5A Subject Matter.

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In this topic:

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**General**

Sections 79B and 79C place certain limitations upon the subject matter which can be claimed in a divisional application.

A divisional application may include and claim matter which was not disclosed in the parent where it is filed:

- before acceptance of a parent application; or
• within 3 months from the date of advertisement of acceptance of a parent application for a standard patent (also referred to as the date of publication of a notice of acceptance of a parent application).

**Note:** To determine the date of advertisement of acceptance for a parent application, see 5.10.17 Divisionals.

However, in order to derive priority from the parent (and be entitled to divisional status), certain requirements must be met.

1. Where the divisional application is:
   
   • a standard patent application/innovation patent with an examination request filed **before** 15 April 2013; or
   
   • an innovation patent where the Commissioner **decided before** 15 April 2013 to examine the patent;

   at least one claim of the divisional application must be fairly based on matter disclosed in the parent (see [2.12.1.1 Priority Date of Claims](#)). Any claim of the divisional which is not fairly based on matter disclosed in the parent is not objectionable for this reason alone, but may lack novelty or an inventive/innovative step due to its non-entitlement to an earlier priority date.* Examiners should note that in this situation the parent specification may be a potential citation.

2. Where the divisional application is:

   • a standard patent application/innovation patent with an examination request filed **on or after** 15 April 2013; or

   • an innovation patent where the Commissioner **had not decided before** 15 April 2013 to examine the patent;

   at least one claim of the divisional application must define an invention that is disclosed in the parent in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art (see [2.12.1.1A Priority Date of Claims](#)). Any claim of the divisional which is not disclosed in a clear enough and complete enough manner in the parent is not objectionable for this reason alone, but may lack novelty or an inventive/innovative step due to its non-entitlement to an earlier priority date.* Examiners should note that in this situation the parent specification may be a potential citation.

*Note: Where a claim is not entitled to an earlier priority date, examiners will need to consider whether a search of the claim is warranted. In general, the search should cover the period extending from the priority date of the parent to the filing date of the divisional. However, there may be circumstances where a search of a greater time period is required.*
Where it appears likely that the earlier priority date can be restored, for example by a straightforward amendment to the claim, it may be more appropriate to defer the search. However, if it appears unlikely that the earlier priority date can be restored, a search should be conducted. Examiners should use their judgement to determine the appropriate course of action depending on the facts of the case and consult a senior examiner where necessary.

In the unusual situation where none of the claims are entitled to an earlier priority date, for a standard patent application, an objection should be taken that the application is not entitled to divisional status. In the case of an innovation patent, examiners should refer the matter to Patent Oppositions.

Divisional Application Filed Outside Three Month Advertisement Period

A divisional application which is filed more than 3 months after the date of advertisement of acceptance of a parent application for a standard patent must be for an invention falling within the scope of the claims of the accepted parent specification. This limitation applies to all the claims of the divisional application. Where this requirement is not met, examiners must include an objection to this effect in their report.

Similarly, where amendments to a divisional application are filed in anticipation and include claims broader in scope than the accepted claims of the parent, the report must include an objection that the claims of the divisional application must fall within the scope of the claims of the accepted parent.

Other

Although a divisional application may be made only in respect of an invention disclosed in the parent specification(s), there is no requirement that the invention applied for must be excluded from the parent specification. However, the divisional application cannot claim the same invention as the parent specification (see 2.18 Multiple Applications (Sections 64(2) and 101B)).
Note: The information in this part only applies to divisional applications filed on or after 15 April 2013. For all other divisional applications, see 2.10.5 Subject Matter.

Sections 79B and 79C place certain limitations upon the subject matter which can be claimed in a divisional application.

A divisional application may include and claim matter which was not disclosed in the parent where it is filed:

- before acceptance of a parent application; or
- within 3 months from the date of advertisement of acceptance of a parent application for a standard patent (also referred to as the date of publication of a notice of acceptance of a parent application).

However, in order to derive priority from the parent (and be entitled to divisional status), at least one claim of the divisional application must define an invention that is disclosed in the parent in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art (see 2.12.1.1A Priority Date of Claims). Any claim of the divisional which is not disclosed in a clear enough and complete enough manner in the parent is not objectionable for this reason alone, but may lack novelty or an inventive/innovative step due to its non-entitlement to an earlier priority date.* Examiners should note that in this situation the parent specification may be a potential citation.

*Note: Where a claim is not entitled to an earlier priority date, examiners will need to consider whether a search of the claim is warranted. In general, the search should cover the period extending from the priority date of the parent to the filing date of the divisional. However, there may be circumstances where a search of a greater time period is required.

Where it appears likely that the earlier priority date can be restored, for example by a straightforward amendment to the claim, it may be more appropriate to defer the search. However, if it appears unlikely that the earlier priority date can be restored, a search should be conducted. Examiners should use their judgement to determine the appropriate course of action depending on the facts of the case and consult a senior examiner where necessary.

In the unusual situation where none of the claims are entitled to an earlier priority date, for a
standard patent application, an objection should be taken that the application is not entitled to divisional status. In the case of an innovation patent, examiners should refer the matter to Patent Oppositions.

Although a divisional application may be made only in respect of an invention disclosed in the parent specification(s), there is no requirement that the invention applied for must be excluded from the parent specification. However, the divisional application cannot claim the same invention as the parent specification (see 2.18 Multiple Applications (Sections 64(2) and 101B)).

**Note:** To determine the date of advertisement of acceptance for a parent application, see 5.10.17 Divisionals.

Where an application is filed under sec 79B, there is no requirement that the parent application should be examined or accepted before the divisional application is examined or accepted. They can be accepted in any order. However, examiners should bear in mind the provisions of sec 64 and the possible need for a bar-to-grant, not only in relation to the divisional under examination and the parent application, but also considering any other related divisional.

See also:

- 2.18.3.1 Application for a Standard Patent;
- 2.18.8 Additionals/Divisionals; and
- 5.10.19.3.8 Acceptance Report.
2.10.8 Dividing From a Provisional Application

Where a second divisional application is made under sec 79B or sec 79C invoking a first divisional made under sec 79B or sec 79C, then the date governing payment of continuation fees is the date of filing of the original (grandparent) specification, and so forth. The only exception to this is if the Commissioner has advised the applicant prior to 1 January 2000 that a different date applies.

For all applications made under sec 39 (repealed) and in existence on 1 January 2000, the date governing payment of continuation fees is the date of filing of the parent specification.

For a divisional application made in respect of two or more parent applications, the date governing payment of continuation fees for the common divisional is the earliest of the dates governing payment of the continuation fees of the parents.

For granted patents, the date governing the payment of renewal fees is the date of the patent recorded in the Register. Note, however, that for an innovation patent, a renewal fee that would otherwise be payable within 1 month after the grant of the patent is not required to be paid (reg 13.6(4)).

Modified Date: 01 March 2013

2.10.8 Dividing From a Provisional Application

The Act does not allow for the filing of a divisional application from a provisional application. Where a provisional specification discloses more than one invention, an applicant may file more than one complete application, each being associated with the single provisional specification.

An application which purports to be a divisional application based on a provisional application, and which is filed within 12 months of the filing of that provisional application, can proceed on the basis that it has been 'associated' with the provisional application. However, during examination examiners should object that the application cannot proceed as a divisional application.

In this situation, the applicant has the options of:

- associating the application with the provisional application. The application will then proceed as a standard application and the priority date will be the filing date of the provisional application.
- allowing the application to proceed as an independent standard application, with the priority date being the filing date of the application.

The patent request should be amended to remove the request for divisional status and include, if appropriate, a statement of association to the provisional application.
2.10.9 Considering Relative Cases During Examination

[see also PERP code H1]

Where the application is filed more than 12 months after the filing of the provisional, an objection should be taken that it is not entitled to proceed as a divisional application or as an associated application.

[see also PERP code H2]

In this topic:

General

Examiners must consider the 'parent' file and any other 'relative' files during examination. By 'relative' file is meant all files linked directly or indirectly as a result of one or more applications being made under the provisions of sec 79B and sec 79C. It includes, for example, 'grandparent' cases and 'cousin' cases.

Relative Case Under Opposition or Re-Examination, or Contains a Section 27 or Section 28 Notice

If the parent or any 'relative' case is, or has been, under opposition or re-examination, or contains a sec 27 or sec 28 notice, examiners should consider any available material or documentary evidence filed in those proceedings at each report stage. Examiners should also consider any issues raised in the material on the 'relative' file and check whether these apply to the divisional application. The fact that the 'relative' case may be subject to proceedings, e.g. opposition, and those proceedings have not concluded, does not mean that examination or acceptance of the divisional application should be delayed, provided that...
2.10.9.1 Supervision of Divisional Applications with Great Grandparent or Earlier Ancestors

Examiners avoid making comments which prejudge the outcome of the opposition. In practice this means that examiners should confine their report to the divisional application and should not make direct comments on the proceedings with regard to the ‘relative’ case. Provided this requirement is met, it is not considered to be prejudging, even in the situation where the claims in the divisional application are the same as those in the ‘relative’ case.

Where the circumstances are such that this condition cannot be met, the case must not be accepted, but instead referred to the Assistant General Manager (OEP).

It is particularly important that examiners consider the potential relevance of any decision which has issued in respect of any ‘relative’ application.

Section 32 or Section 36 Request

If an application is subject to a sec 32 or sec 36 request, and the applicant then files a divisional application in respect of the application which is subject to the sec 32 or sec 36 action, there is a risk that, if the requestor is unaware of its existence, a patent could be granted on the divisional. Accordingly, at the first opportunity, examiners are to advise the applicant in an examination report on the divisional application that:

"Prima facie the entitlement of the nominated person has been brought into question because of the section 32/36 action on the parent. Until this dispute is resolved, other examination issues notwithstanding, the Commissioner cannot permit this application to proceed to acceptance."

(See PERP code H6 and also 2.15.7.5 Entitlement Disputes During Examination).

Modified Date: 01 November 2017

2.10.9.1 Supervision of Divisional Applications with Great Grandparent or Earlier Ancestors

First reports issued on divisional applications with great grandparent or earlier ancestors are to be treated as equivalent to adverse third reports, and are therefore to be reviewed by a supervising examiner. If the supervising examiner is of the opinion that no progress is being made, the case should be discussed with the Supervising Examiner (Patent Oppositions), including whether to set the matter for hearing.

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.10.10 Amendment of Patent Request - Conversion of Application to a Divisional

**Note:** The information in this part only applies to:

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.
- requests to amend filed on or after 15 April 2013 for standard patent applications with an examination request filed before 15 April 2013.

For all other requests to amend, see 2.10.10A Amendment of Patent Request – Conversion of Application to a Divisional.

Either before or during examination, an applicant may seek to amend a patent request to convert an application to a divisional application. Such amendment can be made under sec 104 and does not require replacement of the patent request form (see 2.23.13.1 Amendment of Patent Request and 2.20.3.1 Patent Request Form). When an amendment to this effect is allowed, examiners should inform COG of the change in status to a divisional application, and any changes in priority details, as outlined in 5.5.4 Invention Details.
Either before or during examination, an applicant may seek to amend a patent request to convert an application to a divisional application. Such amendment can be made under sec 104 and does not require replacement of the patent request form (see 2.23.13.1 Amendment of Patent Request and 2.20.3.1 Patent Request Form).

However, an amendment of a patent request to convert an application to a divisional application is not allowable in certain circumstances (reg 10.2B(4), reg 10.2B(5) and reg 10.2B(6)).

Thus:

- An application cannot be converted to a divisional application after it has been accepted under sec 49 (standard) or sec 52 (innovation).

- An amendment to convert an application to a divisional application can only be allowed within the period in which the application could have been filed as a divisional application under sec 79B or sec 79C (as in force for divisional applications filed on or after 15 April 2013).

For example, where the parent application is for a standard patent, an amendment converting the application can only be allowed in the period ending when any of the following happens:

- the parent application lapses;
- the parent application is refused;
- the parent application is withdrawn; or
- the period ending 3 months from the date of advertisement of acceptance of the parent application (also referred to as the date of publication of a notice of acceptance of a parent application) expires.

Similar considerations apply for requests to convert where the parent is an innovation application or patent.

Where an amendment to the patent request is allowed, examiners should inform COG of the change in status to a divisional application, and any changes in priority details, as outlined in 5.5.4 Invention Details.

**Note:** Regulation 10.2B(5) refers explicitly to sec 79B(3) of the Act. Although sec 79B(3) applies to divisional applications filed on or after 15 April 2013, the time period for the purpose of reg 10.2B(5) applies regardless of when the application for which the amendment request is made was filed. Consequently, if:

- more than 3 months has passed from the notice of acceptance of the nominated parent application; and
2.10.11 Case Management of Divisional Applications

• the current application was filed before 15 April 2013;

the amendment is not allowable.

A proposed amendment of a patent request to convert an application to a divisional application where the application was filed before the application identified as the parent, is of no effect. Further applications under sec 79B and sec 79C can only be made within the period specified in those sections. Requests of this nature should be referred to Patent Oppositions.

**Note:** A decision has been made by the PMC to temporarily suspend case management of divisional applications.

Consequently examiners are to:

• discontinue the practice of reducing the response time frame for divisional applications on which an objection is raised in the first report for the same, or substantially the same, reason as an objection was raised in the report on the parent or other ancestor, i.e. the standard objection based on the former PERP code H40 should no longer be used for first reports. Where a first report has already been issued with a reduced response time frame, examination should proceed in accordance with the case management approach and reduced response time frames can continue to be used at further report stage where appropriate.

• discontinue the expediting of divisional applications as a matter of routine and accord them the same priority as other examination work.

The filing of divisional applications can create significant uncertainty in the scope of patent rights that may be associated with a particular innovation. For this reason, the Commissioner has adopted a case management approach to the examination of divisional applications and their related parent applications intended to ensure prompt resolution of the status of the applications, particularly where the claimed subject matter of the divisional application is the same as its parent. Consequently, the following case management practices apply generally to the examination of divisional applications for standard patents:
2.10.11 Case Management of Divisional Applications

- When examining a divisional application, examiners should check for any related unexamined applications having an examination request on file and examine these together with the divisional application, where possible.

- Special considerations apply to the examination where:
  - The parent application (or other ancestor, e.g. grandparent) was examined and an adverse report issued (whether or not the application was subsequently amended and/or accepted).
  - An objection is raised in the first report on the divisional application for the same, or substantially the same, reason as an objection was raised in the report on the parent or other ancestor. In this regard, it is the existence of the same grounds for objection that is significant, rather than the wording or statutory basis of the objection used. (This includes an objection that there is no notice of entitlement, even when that was the only objection raised in relation to the relevant ancestor application).

- In these cases, the first report is to include the statement:

  "Objection(s) \(1 \text{ and } 2>\) of my report are based on the same grounds objected to in the examination of patent application \(\ldots\). Please note that if a response overcoming those objections is not filed within two months of the date of this report the Commissioner will consider whether to direct amendment of the application under section 107 or proceed to refuse the application under section 49(2) of the Act. If intending to proceed under either of these provisions the Commissioner will notify you in writing and indicate the time and place you may be heard on the matter. In deciding the matter the Commissioner will consider all possible grounds of objection to the application not only those identified above."

  This text will automatically appear in the DocGen template when the option ‘Yes’ is selected at the ‘Is this a Divisional Application with objections repeated from the Parent application?’ prompt.

- Examiners must also advise Patent Oppositions (via email to ohl@ipaustralia.gov.au) that the report has issued and indicating the application number and date of the first report. Patent Oppositions will diary the date and call up the application for review after two months. If no response has been filed, the Supervising Examiner Patent Oppositions will determine what course of action to take, including setting the matter for hearing. Any inquiries from the applicant or attorney about the statement or a request for extension of the two month period should also be referred to the Supervising Examiner Patent Oppositions.

- If a response is received within two months, examiners should make a decision as to whether or not the response is a serious attempt to meet the objections raised in the first report.

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Effective Date: 25 September 2019
A serious attempt need not overcome all the objections raised in the first report, however it must make significant progress towards gaining acceptance. In this circumstance, examiners should issue a normal further report or, if the response overcomes all the objections, accept the application. As soon as this decision has been made, examiners should advise Patent Oppositions (via email to ohl@ipaustralia.gov.au) that they will be accepting the case, or that a normal further report will be issued and the case can be returned to the normal examination cycle.

If examiners consider that a response is a not serious attempt, then they should discuss the case with a senior examiner or supervising examiner. If, after this discussion, the joint opinion is that the response is not serious, examiners should send an email to the Supervising Examiner Patent Oppositions stating that a response has been received, but that after consultation, the joint opinion is that the response is not serious. The Supervising Examiner Patent Oppositions will then determine an appropriate course of action.

If there remains doubt about whether the response is serious or not after discussion within the examination section, examiners should consult the Supervising Examiner Patent Oppositions in person.

Any other doubts as to whether or not to adopt the case management approach should also be referred to the Supervising Examiner Patent Oppositions.

---

1. Consider all 'relative' case files (Registry Manager to supply paper cases).
   - 2.1.0.9 Considering "Relative" Cases During Examination

2. Check type of parent (e.g. not provisional).
   - 2.1.0.1 Application
   - 2.1.0.2 Priority Entitlement
   - 2.1.0.8 Dividing From a Provisional Application
<p>| | | |</p>
<table>
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<tr>
<td>3</td>
<td>Check that the parent application had not lapsed or been refused or withdrawn at the time of filing of the divisional application.</td>
<td>2.10.1 Application 2.10.4 Status of Parent</td>
</tr>
<tr>
<td>4</td>
<td>Check that the divisional application was filed within the relevant time limit.</td>
<td>2.10.3 Time Limits for Filing Applications</td>
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<tr>
<td>5</td>
<td>Check that the patent request invokes sec 79B or sec 79C by stating the number of the parent application.</td>
<td>2.10.1 Application</td>
</tr>
<tr>
<td></td>
<td>The applicant for the divisional application must be the same applicant as for the parent application, the patentee of the parent innovation patent, or a person entitled to make a request under sec 113 (&quot;Persons claiming under assignment or agreement&quot;).</td>
<td>2.10.1 Application</td>
</tr>
<tr>
<td>6</td>
<td>Check entitlement.</td>
<td>2.10.1 Application</td>
</tr>
<tr>
<td>7</td>
<td>If the patent request indicates that the application is a Convention application, check that it satisfies the Convention application requirements.</td>
<td>2.10.2 Priority Entitlement</td>
</tr>
<tr>
<td>8</td>
<td>Check that the claims of the divisional application are directed to appropriate subject matter.</td>
<td>2.10.5 Subject Matter</td>
</tr>
<tr>
<td>9</td>
<td>Check that there is no objection under sec 64(2) with respect to the parent application.</td>
<td>2.10.5 Subject Matter 2.18.2 Practice 2.18.7 Priority Dates 2.18.8 Additionals/Divisionals 2.18.9 Omnibus Claims</td>
</tr>
<tr>
<td>10</td>
<td>Check whether the grounds of objection for the divisional application are the same or substantially the same as in the parent. (Note: This practice has been temporarily suspended).</td>
<td>2.10.11 Case Management of Divisional Applications</td>
</tr>
<tr>
<td>11</td>
<td>Check all 'relative' case file(s) for any relevant material filed in relation to sec 32 or sec 36</td>
<td>2.10.9 Considering &quot;Relative&quot; Cases During</td>
</tr>
</tbody>
</table>
2.11 Section 40 - Specifications

Modified Date: 01 February 2013

2.11.1 Overview

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.1A Overview.

Section 40 provides that:

1. A provisional specification must describe the invention.

2. A complete specification must:
   a. describe the invention fully, including the best method known to the applicant of performing the invention; and
b. where it relates to an application for a standard patent - end with a claim or claims defining the invention; and

c. where it relates to an application for an innovation patent - end with at least one and no more than 5 claims defining the invention.

3. The claim or claims must be clear and succinct and fairly based on the matter described in the specification.

4. The claim or claims must relate to one invention only.

The basic procedure for dealing with sec 40 considerations is:

i. Construe the specification (including the claims) to identify the invention.

ii. Assess whether the specification fully describes the invention.

iii. Assess whether the claims define the invention (typically this only arises with private applicant cases).

iv. Assess whether the claims are clear and succinct.

v. Assess whether the claims are fairly based on the description (exclusive of the claims).

These steps are explained in the following parts of this chapter.

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**The Role of Section 40**

The High Court considered the role of sec 40 in two decisions: *Kimberly-Clark Australia Pty v Arico Trading International Pty Ltd* [2001] HCA 8 and *Lockwood v Doric* [2004] HCA 58. These decisions have in turn been consistently applied in a number of later Federal Court cases including:

- *Eli Lilly and Company v Pfizer Overseas Pharmaceuticals* [2005] FCA 67 (see paragraphs 169-199);

- *Pfizer Overseas Pharmaceuticals v Eli Lilly and Company* [2005] FCAFC 224 (see paragraphs 268-277 and 325-347); and

- *Photocure ASA v Queens University at Kingston* [2005] FCA 344 (see paragraphs 101-151).

The key general principles which arise from these cases are:
2.11.1 Overview

- Section 40 only goes to the form of the specification. Issues of whether the alleged invention is novel, inventive, or has utility are of no relevance to whether the specification complies with sec 40 (Lockwood v Doric at paragraph 44);

- Each ground of invalidity is separate and considerations of one ground should not be imported into another. The requirements of description and fair basis are therefore distinct from each other and from other grounds of invalidity (Lockwood v Doric at paragraph 49);

- The test for fair basis is simply whether the claims are consistent with what the specification as a whole describes as the invention. However, the “invention” for the purposes of sec 40 is not the inventive step or the technical contribution made by the inventor, but rather the “embodiment around which the claims are drawn” (Kimberly-Clark Australia v Arico Trading at paragraph 21); and

- The test for full description is whether the disclosure is sufficient to enable the addressee of the specification to produce something within each claim without new inventions or additions or prolonged study of matters presenting initial difficulties (see Kimberly-Clark Australia v Arico Trading at paragraph 25).

Differences with the PCT and Foreign Practice

There is a significant difference between Australian national law and the PCT guidelines in relation to the requirement for “full support”. In particular, international practice requires that a claim is enabled (or supported) over its full scope. In contrast, Australian full description law merely requires that one embodiment of the claims is enabled (Kimberly-Clark v Arico [2001] HCA 8 at paragraph 58).

The Australian test for fair basis merely requires consistency between the invention as described and as claimed. It is separate from the requirements for full description and involves no assessment of enablement. Examiners are to apply the relevant tests for national examination and the PCT guidelines continue to apply to international search and examination.

Due to this disparity, examiners should be aware of the limitations of using foreign examination reports (FERs) during national examination and in particular when considering full description and fair basis. Examiners should therefore not raise a fair basis or full description objection taken in a FER, unless they have reviewed the overseas objection to determine whether it applies under Australian law.
Further, overseas offices often restrict their search where claims are found not to be fully supported. If this objection does not apply in Australia, examiners may need to expand the original search to cover the full scope of the claims.

**2.11.1A Overview**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed **on or after** 15 April 2013.
- innovation patents with an examination request filed **on or after** 15 April 2013.
- innovation patents where the Commissioner **had not decided before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.11.1 Overview](#).

Section 40 provides that:

1. A provisional specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.

2. A complete specification must:
   
a. disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; and

   aa. disclose the best method known to the applicant of performing the invention; and

   b. where it relates to an application for a standard patent - end with a claim or claims defining the invention; and

   c. where it relates to an application for an innovation patent - end with at least one and no more than 5 claims defining the invention.

3. The claim or claims must be clear and succinct and supported by the matter disclosed in the specification.

3A. The claim or claims must not rely on references to descriptions, drawings, graphics or
2.11.2 Construction of Specifications

Photographs unless absolutely necessary to define the invention.

4. The claim or claims must relate to one invention only.

The basic procedure for dealing with sec 40 considerations is:

i. Construe the specification and the claims.

ii. Assess whether the specification provides a clear enough and complete enough disclosure of the claimed invention.

iii. Assess whether the claims define the invention disclosed in the specification as a whole (typically this only arises with private applicant cases).

iv. Assess whether the claims are clear and succinct.

v. Assess whether the claims are supported by the matter disclosed in the body of the specification (exclusive of the claims).

These steps are explained in the following parts of this chapter.

2.11.2 Construction of Specifications

Modified Date: 01 February 2013

2.11.2 Construction of Specifications

An essential prerequisite to any considerations under sec 40, or to any of the patentability issues of sec 18, is the construction of the specification (to ascertain the invention and what has been disclosed) and of the claims (to ascertain what has been claimed).

In general, a patent specification is construed like any other document. Any purely verbal or grammatical question that can be answered according to the ordinary rules for the construction of written documents is to be resolved accordingly (Welch Perrin & Co Pty Ltd v Worrel (1961-62) 106 CLR 588). In this regard:

"... few, if any, English words are unambiguous or not susceptible of more than one meaning or have a plain meaning. Until a word, phrase or sentence is understood in the light of the surrounding circumstances, it is rarely possible to know what it means."

Manufacturers' Mutual Insurance Ltd v Withers & Anor (1988) 5 ANZ Insurance Cases 60-853 at 75,343.

However, as a patent specification is a public document that defines a monopoly, there are additional considerations that apply (see 2.11.2.2 Rules of Construction).

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Effective Date: 25 September 2019
The determination of compliance with the requirements of sec 40 is done through the eyes of the addressee of the specification.

A patent specification is addressed to a person skilled in the relevant art of the specification. This person brings their understanding of the terminology and workings of the art to the construction of the specification. Lord Shaw in *B.T.H. v Corona Lamps* 39 RPC 49 stated:

"A specification must take its rank among all ordinary documents which are submitted to a reader for his guidance or instruction, and a reader ordinarily intelligent and versed in the subject matter. Such a reader must be supposed to bring his stock of intelligence and knowledge to bear upon the document, not unduly to struggle with it, but anyhow to make the best of it."

Thus, the specification is to be construed in the light of the common general knowledge in the relevant art at the priority date of the application. As stated in *Welch Perrin v Worrel* (1961-62) 106 CLR 588 at 610:

"If it is impossible to ascertain what the invention is from a fair reading of the specification as a whole, that, of course, is an end of the matter. But this objection is not established by reading the specification in the abstract. It must be construed in the light of the common general knowledge in the art before the priority date."

See also *Decor Corp v Dart Industries* 13 IPR 385 and *Melbourne v Terry Fluid Controls Pty Ltd* (1994) AIPC 91-058

A full discussion of a number of relevant decisions on this subject is given in *Valensi & Another v British Radio Corporation* (1973) RPC 337. In particular, at page 377:

"We think that the effect of these cases as a whole is to show that the hypothetical addressee is not a person of exceptional skill and knowledge, that he is not expected to exercise any invention nor any prolonged research inquiry or experiment. He must, however, be prepared to display a reasonable degree of skill and common knowledge of the art in working trials and to correct obvious errors in the specification if a means of correcting them can readily be found."

The Valensi case (supra) should be read in the light of the observation in *American Cyanamid Company v Ethicon Limited* [1979] RPC 215 at page 245, to the effect that:
"... many of those involved and taking part in the placing on the market of such a new product, which was artificial and had no previous equivalent in this respect, would be highly qualified scientists trained at least to university standard, with all that entails, and used to carrying out chemical and biological research work in research departments. That is what in fact happened in the case of both the plaintiffs' and the defendants' artificial sutures here, and it would ... be highly misleading to suggest that there was in fact, in the present case, any body of 'intermediately' skilled technicians to whom the specification could be addressed whose existence must be assumed to be 'obvious', as was assumed by the Court of Appeal in the Valensi case (1973) RPC 337. The correct view ... which is consistent with the principle which the Court of Appeal must ... be presumed to have acted upon, is to hold as matter of law ... that the answer to the question: "Who is the skilled addressee of the specification?", depends upon making an examination of the facts of each case, and in so doing regard must be paid primarily to the nature of the invention, to the nature and size of the industry concerned, and the way it is organised for the purposes of conducting research into and of producing and marketing its products."

The position in Australia is no different from that in the UK. In Universal Oil Products v Monsanto (1972) 46 ALJR 658 Gibbs J. stated:

"The specification is sufficient if the patentee makes the nature of his invention, and how to perform it, clear and intelligible to persons having a reasonably competent knowledge of what was known before on the subject to which the patent relates, and having reasonably competent skill in the practical mode of doing what was then known."

In Osram Lamp Works Ltd. v Pope's Electric Lamp Co. Ltd. (1917) 34 RPC 369 at page 391, it was stated:

"Where questions of interpretation or sufficiency arise, the court must ascertain the persons to whom the specification is addressed, and when the specification deals with technical matters, must instruct itself as to the technical knowledge which those persons may reasonably be supposed to have possessed at the date of the Patent ... These persons may be assumed to possess not only a reasonable amount of commonsense, but also a competent knowledge of the art or arts which have to be called into play in carrying the patentee's direction into effect."

and further:
"... in carrying out the directions given by the patentee it may well be necessary to call in aid more than one art. Some of the directions contained in a specification may have to be carried out by skilled mechanics, others by competent chemists. In such a case, the mechanic and the chemist must be assumed to co-operate for the purpose in view, each making good any deficiency in the other's technical equipment."

In General Tire & Rubber Co. Ltd. v Firestone Tyre & Rubber Co. Ltd. [1972] RPC 457 at page 482, it was reiterated that the addressee may in fact be a team:

"the skilled addressee is in effect a composite entity - a typical chief compounder and a typical scientific adviser ...".

See also American Cyanamid Company v Ethicon Limited (1972) RPC 215 at page 245 and Unilever Australia Ltd. v Colgate-Palmolive Co. (1982) AOJP 1355.

Examiners are not expected to be fully familiar with the language of every art. Inevitably, objections will be taken as to the lack of clarity in some of the terminology used in the specification, to which the applicant will respond that such terminology is perfectly clear to the addressee. Where the terms in question are used in relation to inconsequential features, the objection should not be maintained.

However, where the terms are material to the understanding of the invention or for the definition of its extent, a mere assertion that the terms have a clear and unambiguous meaning to persons other than the examiner need not necessarily be accepted. Thus, corroboration may be required when an assertion is made by a person who has not established that they are skilled in the art, for example the applicant's attorney. Similarly, assertions may be questioned when they are made by one person under instructions from another.

Where corroborating material is supplied or cited, for example, references in dictionaries, handbooks, or examples of usage in the trade, and there appears to be conflict between sources, the terminology used by the applicant should be reinforced by a reference to the relevant source which establishes the required meaning.

2.11.2.2 Rules of Construction
2.11.2.2 Rules of Construction

Sheppard J summarised the rules of construction for a patent specification in Décor Corp v Dart Industries 13 IPR 385 at 400. This summary has been referred to in numerous subsequent judgements and was endorsed by the Full Federal Court in Pfizer Overseas Pharmaceuticals v Eli Lilly [2005] FCAFC 224. The rules are as follows:

1. The claims define the invention which is the subject of the patent. These must be construed according to their terms upon ordinary principles. Any purely verbal or grammatical question that can be answered according to ordinary rules for the construction of written documents is to be resolved accordingly.

2. It is not legitimate to confine the scope of the claims by reference to limitations which may be found in the body of the specification but are not expressly or by proper inference reproduced in the claims themselves. To put it another way, it is not legitimate to narrow or expand the boundaries of monopoly as fixed by the words of a claim by adding to those words glosses drawn from other parts of the specification.

3. Nevertheless, in approaching the task of construction, one must read the specification as a whole.

4. In some cases the meaning of the words used in the claims may be qualified or defined by what is said in the body of the specification.

5. If a claim be clear, it is not to be made obscure because obscurities can be found in particular sentences in other parts of the document. But if an expression is not clear or is ambiguous, it is permissible to resort to the body of the specification to define or clarify the meaning of words used in the claim.

6. A patent specification should be given a purposive construction rather than a purely literal one.

7. In construing the specification, the Court is not construing a written instrument operating inter partes, but a public instrument which must define a monopoly in such a way that it is not reasonably capable of being misunderstood.

8. The body, apart from the preamble, is there to instruct those skilled in the art concerned in the carrying out of the invention; provided it is comprehensible to, and does not mislead, a skilled reader, the language used is seldom of importance.

9. Nevertheless, the claims, since they define the monopoly, will be scrutinized with as much care as is used in construing other documents defining a legal right.
10. If it is impossible to ascertain what the invention is from a fair reading of the specification as a whole, it will be invalid. But the specification must be construed in the light of the common knowledge in the art before the priority date.

See also *Flexible v Beltreco* 49 IPR 331 from paragraph 70, where Hely J expressed the rules slightly differently.

In addition to the above rules, the Full Federal Court in *Pfizer Overseas Pharmaceuticals v Eli Lilly* [2005] FCAFC 224 referred to a further three (from *Nesbit Evans Group Australia Pty Ltd v Impro Ltd* (1997) 39 IPR 56):

1. There is a danger in considering the integers of a claim individually and in isolation. This could yield a literal rather than a purposive construction – see *Catnic Components Ltd v Hill and Smith Ltd* [1982] RPC 183 at 243 (Lord Diplock).

2. The court should avoid too technical or narrow construction of claims.

3. A construction according to which the invention will work is to be preferred to one according to which it may not do so.

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Blanco White, Fifth Edition, 2-101, states:

"As with any other document, questions of construction of a patent specification, arising in legal proceedings, are for the court to decide as a matter of law; for this purpose the court must first instruct itself as to the technical matters involved, so as to place itself in the position of one acquainted with the art concerned - in the position, that is, of a person to whom the specification is addressed. The document must in particular be read with the skilled addressee's understanding of what the inventor is trying to achieve and his appreciation of what is important, what is not. Given the necessary knowledge and understanding, however, the question is (we are told) what the words of the document mean, not what information a man skilled in the art would in fact derive from them; and expert evidence as to their meaning is in general not admissible."
Examiners should take a similar approach, however their own technical background substitutes for expert evidence. Thus, it is ultimately for examiners to decide what construction to place on a specification and likewise for documents that are being cited for anticipation purposes (see also 2.4.5.Construing the Citation).

Modified Date: 01 February 2013

2.11.2.2.2 Words are Given their Plain Meaning

The words of a specification should generally be given their ordinary English meaning (Interlego AG v Toltoys Pty Ltd (1973) 130 CLR 461 at 478). The exception to this is where a word or expression has a special meaning in the relevant art, that specialised meaning should be adopted (Electric & Musical Industries Ltd v Lissen Ltd (1939) 56 RPC 23 at 41). This follows from the fact that the specification is read by a person skilled in the relevant art, as exemplified in the case of Patent Exploitation Ltd v Siemens Bros. 21 RPC 549:

"a specification like any other document should be construed by the Court according to the fair meaning of the language used after being informed by evidence of the nature of the subject-matter, the state of knowledge at the [priority] date of the patent, and the meaning of any scientific or technical terms that are in it."

Modified Date: 01 October 2013

2.11.2.2.3 Read the Specification as a Whole

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.2.3A Read the Specification as a Whole.

A complete specification must ‘describe the invention fully’ (sec 40(2)(a)). In assessing this requirement, it is necessary to take into account the whole of the complete specification, i.e. both the body of the specification and the claims (Kimberly-Clark Australia Pty Ltd v Arico...
2.11.2.2.3 Read the Specification as a Whole

Trading International Pty Ltd *(2001) 207 CLR 1* at 12-13 [14] and [16]). This differs from the requirement of fair basis, where it is necessary to separate the claims and the body of the specification, in order to determine whether the former are fairly based on the matter described in the latter *(Kimberly-Clark Australia Pty Ltd v Arico Trading International Pty Ltd supra* at 12 [15] and *Lockwood v Doric* [2004] HCA 58 at paragraph 49).

As indicated in *Rosedale Associated Manufacturers Ltd v Carlton Tyre Saving Co Ltd* [1960] RPC 59 at 69:

"It is clearly ... legitimate and appropriate in approaching the construction of claims to read the specification as a whole. Thereby the necessary background is obtained and in some cases the meaning of the words used in the claims may be affected or defined by what is said in the body of the specification."

As a consequence:

a. The specification may set up a dictionary to define terms – see 2.11.2.2.5 Dictionary Principle.

b. If an expression in a claim is ambiguous, it is permissible to resort to the body of the specification to define or clarify the meaning of words used in the claim *(Interlego AG v Toltoys Pty Ltd (1973) 130 CLR 461* at 479).

c. If a claim is clear, it is not to be made obscure because obscurities can be found in particular sentences in other parts of the specification. In addition:

"if the claims have a plain meaning in themselves, then advantage cannot be taken of the language used in the body of the specification to make them mean something different."

*EMI v Lissen* (1939) 56 RPC 23 at 39.

d. It is not legitimate to confine the scope of the claims by reference to limitations which may be found in the body of the specification but are not expressly or by proper inference reproduced in the claims themselves. To put it another way it is not legitimate to narrow or expand the boundaries of monopoly as fixed by the words of a claim by adding to those words glosses drawn from other parts of the specification *(Decor Corp v Dart Industries 13 IPR 385)*.

e. The context of the specification may imply a limitation on the scope of the claims. In *International Business Machines Corp v Commissioner of Patents* (1991) 22 IPR 417 the specification related to computer graphics, but the claim made no specific reference to a computer environment. Burchett J found that:

"When the present specification is read, the whole of the context rises up to insist that claim one is talking about the operation of computers. Almost the first words of the specification inform the reader that the invention 'relates to
computer graphics and more specifically to a method and apparatus for generating curves on computer graphic displays'. The recital of the prior art reinforces the clear impression thus conveyed from the beginning of the document."

f. Similarly, in Synthetic Turf Development v Sports Technology International [2005] FCA 69 (affirmed in [2005] FCAFC 270), the specification described a process where artificial turf was laid and packed with sand, with subsequent rolling to ‘crimp’ the ends of the fibres. An alleged infringing product crimped the fibre before the turf was laid. The claim merely referred to ‘crimp’ and the specification did not contain a ‘dictionary definition’ of ‘crimp’. Nevertheless the court construed ‘crimp’ in the context of the specification as being crimped after laying.

g. Where the specification indicates an aim or intent, this may require consideration when construing the claims. In Apotex Pty Ltd v Sanofi-Aventis Australia Pty Ltd (No 2) [2012] FCAFC 102, the Full Court found that the:

“description shows that the object or end in view of the claimed method is the prevention or treatment of psoriasis by the administration of leflunomide”;

i.e. the purpose of the administration was relevant in construing the claim.

h. It is possible to use the claims to resolve any ambiguities in the description (Kauzal v Lee (1936) 58 CLR 670 at 687). This differs from giving the claims a gloss from the description, which is not legitimate (Welch Perrin & Co Pty Ltd v Worrel (1961-62) 106 CLR 588 at 610), since the limitation arises from the whole thrust of the specification as against mere comments in the description.

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Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
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- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.2.3 Read the Specification as a Whole.
A complete specification must ‘disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art’ (sec 40(2)(a)). In assessing this requirement, it is necessary to take into account the whole of the complete specification, i.e. both the body of the specification and the claims. This differs from the requirement for support, where it is necessary to separate the claims and the body of the specification, in order to determine whether the former are supported by the matter disclosed in the latter.

As indicated in *Rosedale Associated Manufacturers Ltd v Carlton Tyre Saving Co Ltd* [1960] RPC 59 at 69:

"It is clearly ... legitimate and appropriate in approaching the construction of claims to read the specification as a whole. Thereby the necessary background is obtained and in some cases the meaning of the words used in the claims may be affected or defined by what is said in the body of the specification."

As a consequence:

a. The specification may set up a dictionary to define terms – see 2.11.2.2.5 Dictionary Principle.

b. If an expression in a claim is ambiguous, it is permissible to resort to the body of the specification to define or clarify the meaning of words used in the claim (*Interlego AG v Toltoys Pty Ltd* (1973) 130 CLR 461 at 479).

c. If a claim is clear, it is not to be made obscure because obscurities can be found in particular sentences in other parts of the specification. In addition:

"if the claims have a plain meaning in themselves, then advantage cannot be taken of the language used in the body of the specification to make them mean something different."

*EMI v Lissen* (1939) 56 RPC 23 at 39.

d. It is not legitimate to confine the scope of the claims by reference to limitations which may be found in the body of the specification but are not expressly or by proper inference reproduced in the claims themselves. To put it another way it is not legitimate to narrow or expand the boundaries of monopoly as fixed by the words of a claim by adding to those words glosses drawn from other parts of the specification (*Decor Corp v Dart Industries* 13 IPR 385).

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### 2.11.2.2.4 Purposive Construction

A patent specification should be given a purposive construction rather than a purely literal one. The "purposive" approach requires that allowance be made for inherent difficulties in, or unforeseen implications of, drafting, which have resulted in the literal construction not being the one the drafter has obviously intended. A fair exchange to inventors for the contribution made by their inventions is the underlying rationale for this approach.

In *Catnic Components Limited v Hill and Smith Limited* (1981) FSR 60, Lord Diplock stated:

"A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall..."
outside the monopoly claimed, even though it could have no material effect upon the
way the invention worked.

The question, of course, does not arise where the variant would in fact have a material
effect upon the way the invention worked. Nor does it arise unless at the date of
publication of the specification it would be obvious to the informed reader that this was
so. Where it is not obvious, in the light of then-existing knowledge, the reader is
entitled to assume that the patentee thought at the time of the specification that he
had good reason for limiting his monopoly so strictly and had intended to do so, even
though subsequent work by him or others in the field of the invention might show the
limitation to have been unnecessary. It is to be answered in the negative only when it
would be apparent to any reader skilled in the art that a particular descriptive word or
phrase used in a claim cannot have been intended by a patentee, who was also
skilled in the art, to exclude minor variants which, to the knowledge of both him and
the readers to whom the patent was addressed, could have no material effect upon
the way in which the invention worked."

The specification may indicate that a special meaning is to apply. A special meaning may
only prevail over the plain and unambiguous meaning if the special meaning is clearly
expressed. This is known as the dictionary principle.

The nature of the dictionary principle is reflected in British Thomson-Houston Company Ld. v
Corona Lamp Works Ld. (1922) 39 RPC 49 at page 67, where Viscount Haldane stated:

"We have to scan the Specification with the closeness which is required in the case of
any instrument conferring a monopoly, but, subject to this, all we can legitimately do is
apply the ordinary rules for the construction of written instruments. One of these,
which is relevant in the case before us, is that the instrument must be read as a whole.
The Claiming Clauses, for example, are not to be taken as standing in complete
isolation. For if the Patentee has used in these clauses expressions which he has
already adequately interpreted in the body of his Specification, he is entitled to refer to
the Specification as a dictionary in which the meaning of the words he uses has been
defined."

It must be clear that the specification is setting up a dictionary. Thus, in Minerals Separation
North America Corporation v Noranda Mines Ltd. (1952) 69 RPC 81 at page 93, Lord Reid
stated:
"The Appellants contend that there is in the earlier part of the specification a definition of the word "xanthate" as used by the Patentee which is in effect a "dictionary" and that, as the Patentee has shown that he intends the word to be understood in a limited sense throughout, that limited sense ought to be attached to the word when it occurs in claim 9. Their Lordships do not doubt that it is possible for a patentee to make his own dictionary in this way. If he has put something in the earlier part of the specification which plainly tells the reader that for the purpose of the specification he is using a particular word with a meaning which he sets out, then the reader knows that when he comes to the claims he must read that word as having that meaning. But this is an awkward method of drafting ... and it is in all cases incumbent on a patentee who chooses to adopt this method to make his intention plain to those who read the specification."

Lord Russell in *EMI v Lissen* 56 RPC 23 stated:

"if possible, a specification should be construed so as not to lead to a foolish result or one which the patentee could not have contemplated."

During examination, no objection should be taken when an alternative is clearly absurd. However, circumstances can arise where the alternative is superficially absurd yet has an element of plausibility. In these situations an objection should be raised in the first instance.

In *Decor Corp v Dart Industries* 13 IPR 385 it was stated:

"The body [of the specification], apart from the preamble, is there to instruct those skilled in the art concerned in the carrying out of the invention; provided it is
The description is more particularly a technical disclosure and is construed with regard to the person skilled in the art:

"But the body of the specification is a document giving working instructions to working men - highly skilled working men with high technical qualifications, no doubt, in the case of many modern fields of industry. It is to such persons and not to grammarians or lawyers or even expert witnesses that specifications are considered to be addressed, and they ought not, I think, to be construed as if they were Acts of Parliament or conveyances or wills or instruments of that description. The working man in whose hands the specification is assumed to have been placed must also, I think, be assumed to be a man who is going to try to achieve success and not one who is looking for difficulties or seeking failure."

*Unifloc Reagents Ltd v Newstead Colliery Ltd* 60 RPC 165.

However, reference may be made to the claims to resolve an ambiguity in the body of the specification (*United Shoe Machinery Corp's Application* (1939) 57 RPC 71).

The description must be construed in accordance with the general principles applying to patent specifications.

In general, if examiners are capable of construing a specification despite some mistakes or omissions, they may assume that the proper addressee, and the courts before which the specification may be brought, will also be capable of doing so.

In *AMP v Utilux* (1971) 45 ALJR 123, at page 128, McTiernan J stated that:

"Specifications very frequently contain mistakes; they also have omissions. But if a man skilled in the art can easily rectify the mistakes and can readily supply the omissions, the patent will not be held to be invalid. The test to be applied for the purpose of ascertaining whether a man skilled in the art can readily correct the mistakes or readily supply the omissions, has been stated to be this: Can he rectify the mistakes and supply the omissions without the exercise of any inventive faculty? If he can, then the description of the specification is sufficient. If he cannot, the patent will be void for insufficiency."
Similarly, examiners should not expect, nor insist, that an invention be described with a degree of precision which is not required by those skilled in the art.

2.11.2.3 Construction of Claims

2.11.2.3.1 The Claims are Construed as a Legal Document

The claims have a special function in the patent specification, as they alone define the monopoly. Consequently, the claims will be scrutinised with as much care as any other document defining a legal right (Decor Corp v Dart Industries 13 IPR 385).

The addressee of the specification is the person skilled in the art, whereas claims are frequently the province of persons trained in law. Thus, a standard of clarity which may be adequate for the body of the specification is not necessarily adequate for the claims. The description has the practical purpose of instructing the person in the art how to perform the invention when able to do so, i.e. after the patent has expired, whereas the claims define the monopoly, i.e. what must not be infringed during the term of the patent (British United Shoe Machinery Co. Ltd. v A. Fussell and Sons Ltd. (1908) 25 RPC 631). In the body of the specification, the words used may be adequate to enable the invention to be performed, whereas the same words used in the claims may leave competitors uncertain as to the overall scope of the monopoly. In AMP v Utilux (1971) 45 ALJR 123 McTiernan J stated:

"... the degree of particularity of the language required in the claims should not be expected in the body [of the specification]."

Thus, general terms of uncertain ambit may be objectionable in the claims, even when they are terms which the addressee might be expected to be able to interpret for purposes of performing the invention. In British Celanese Ltd.’s Application (1934) 51 RPC 192 at page 195, it was stated:

"It is certainly dangerous for a patentee to seek to obtain a monopoly by reference to such general terms as "known methods" or "general methods", or equivalent phrases of that kind. I think that puts a burden on the public which should not be put upon them; it must necessarily lead to ambiguity and doubt ... ."

Note also the comments in Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd [2010] RPC 8 at page 200 where it was stated:
“So the skilled reader is taken to suppose that the patentee knew some patent law –
that his claim is for the purpose of defining the monopoly and that it should be for
something new. Knowledge of that may well affect how the claim is read – for
instance one would not expect the patentee to have used language which covered
what he expressly acknowledged was old.”

2.11.2.3.2 A Presumption is Made Against Redundancy

Appended claims affect the construction of the claims to which they refer. In order to give
proper effect to a statement of claim, the presumption is that each claim is of differing scope
and, where possible, claims should be construed accordingly (Parkinson v Simon (1894) 11
RPC 493). In The Electric Construction Co. Ld. v The Imperial Tramways Co. Ld., and The
British Thomson-Houston Co. Ld. (1900) 17 RPC 537 at page 550, it was stated:

"Claim 2 in effect, differs only from claim 1 by the addition to it of the words
'(supported) partly or wholly by springs from the car body, or carriage body or truck'.
The words of claim 1 are afterwards repeated verbatim and you do not need anything
more to show that the differentiation of meaning is involved in those words 'supported
partly or wholly by springs'. That is the only difference."

Thus while claim 1 may include "springs", it must also encompass matter that makes it differ
in scope from claim 2. Therefore, it must include "without springs", a meaning which would
not necessarily have been placed upon claim 1 in the absence of claim 2.

In Pierre Treand's Application (1961) AOJP 2164, the above principle was referred to as
follows:

"... it is significant to note that the material for the bathroom element is specifically
referred to only in claim 7, thus making it clear that claims 1 to 6 generally envisage a
bathroom constructed of any material whatsoever. It is also noteworthy that claim 5
introduces as a feature of the invention an opening for a door, thus indicating that the
constructions claimed in claims 1 to 4 do not necessarily possess such an opening."

However, the rule against redundancy is not absolute and invariable, and can bend to other
considerations if they are weighty enough (David Kahn Inc v Conway Stewart & Co Ld
2.11.2.3.3 "For Use", "When Used", etc

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.3.3A "For Use, "When Used", etc.

In this topic:

The phrases "for use" or "when used" (and similar phrases) inherently impart an element of conditionality, such that the true scope of the claim is likely to be different from a superficial reading of the words. In all cases, it should be remembered that words in a claim must always be construed in the context of that claim and the specification.

“For”, “For Use”, “Used To”, “Used For”

In general, in claims directed to a product or apparatus, the words "for", "for use in", "used to", "used for" and the like place a limitation on what is claimed only to the extent that it must be suitable for the specified purpose. For example, if a claim refers to a "hook for a crane", this implies that the hook is of a particular structural character which makes it quite distinct from a fish hook. However, examiners should appreciate that the words "for", "for use in", "used to", "used for" and the like in claims of the form "Apparatus for ..." are merely indicative of the environment in which it is intended to use the apparatus, and do not limit the apparatus to use solely in that environment (Thurston Catton's Application (1978) AOJP 3666). As a consequence, a claim of this form is to be construed as a per se claim to the apparatus, albeit having a functional capability in the specified environment. Similarly, a claim to a substance or composition for a particular use would normally be construed as relating to the substance or composition per se (Farbwerke Hoechst Aktiengesellschaft vormals Meister Lucius & Bruning's Application (1964) AOJP 1483).
While the above sets out the usual interpretation, it may be possible that the context of the claim clearly mandates a different interpretation. This is particularly the case with Swiss claims, where the formulaic structure of the claim exists for a particular purpose (see 2.11.2.3.10 Swiss Claims and also point iii below). Therefore, an argument that a claim containing these terms is to be interpreted differently from the ‘typical’ interpretation needs to be supported by persuasive reasoning.

In general, method or process claims using words of purpose are construed as being restricted to that purpose as a result of process steps in the method imparting that restriction. For example, a claim defining “A method of producing X…” or “A method for producing X…” is limited to a method that would result in the production of X. Note, however, that there may be exceptions (see CSL Limited v Pharmacia & Upjohn AB [2000] APO 58) and that construction of method or process claims may vary depending upon the facts of the case.

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### “When Used”, “Whenever Used”

The words "when used" or "whenever used" have the effect of limiting the scope of a claim to a particular application, environment or timing. Thus, a claim to something "when used" in a process is normally construed as a disguised process claim. This construction was accepted in the obiter of the High Court in Wellcome v Commissioner of Patents 1A IPR 261 at 266:

"there is no distinction between the claim to the process and the claim to the substance when the substance claim is limited to its use in the process".

Similarly, a claim of the form “Use of X for…”, or “Use of X to…” is normally construed as a process claim.

There may be circumstances where a "when used" or "use of" claim defines something per se (rather than a process) due to the specific facts of the case, although departure from the normal interpretation should only be adopted when this is clearly required by the wording of the claim. Examples are:

a. A claim to "A combination of compounds A and B whereby the said combination produces a synergistic effect when used in the treatment of tumours" defines a composition of A and B capable of producing a synergistic effect;

b. A claim to "Compound X when used to stabilise compound Y" is equivalent to a composition of X and Y.
A claim to an apparatus "for carrying out" a process was held to be equivalent to a claim to the apparatus per se (L'Aire Liquide Societe Anonyme pour L'Etude et L'Exploitation des Precedes George Claude (1932) 49 RPC 428). However, amendment of the claim to "An apparatus when used for carrying out the process" restricted the claim to the apparatus when used in a particular manner.

**Note:** Where a claim is directed to a product, apparatus or substance, a described use without the phrase "when used" or "whenever used" (particularly in the claim preamble) should be taken as a suitability limitation only, unless otherwise indicated.

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### Special Considerations

Certain types of use claims raise special issues:

i. Use of compound X for combating diseases.

   If the description only discloses that compound X is useful for treating a specific disease (e.g. cardiac arrhythmia), then the claim is not fairly based on the description (see **2.11.7 Claims are Fairly Based**).

ii. Use of compound X for the treatment of cardiac arrhythmia.

   Although the claim encompasses the medical treatment of human beings, no objection is to be taken on that basis alone (see **2.9.2.13 Treatment of Human Beings**).

   However, if the invention relates to the second pharmaceutical indication of compound X (that is, another use), novelty or inventive step issues will need to be considered in the light of the use(s) disclosed in the prior art ("new use of a known substance").

iii. Use of compound X for the preparation of medicament Y for treatment of disease/condition Z.

   Such claims, and certain variations along similar lines, are colloquially known as "Swiss claims" (see **2.11.2.3.10 Swiss Claims**).
2.11.2.3.3A "For Use", "When Used", etc

Note: The information in this part only applies to:

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In this topic:

The phrases "for use" or "when used" (and similar phrases) inherently impart an element of conditionality, such that the true scope of the claim is likely to be different from a superficial reading of the words. In all cases, it should be remembered that words used in a claim must always be construed in the context of that claim and the specification.

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containing these terms is to be interpreted differently from the ‘typical’ interpretation needs to be supported by persuasive reasoning.

In general, method or process claims using words of purpose are construed as being restricted to that purpose as a result of process steps in the method imparting that restriction. For example, a claim defining “A method of producing X....” or “A method for producing X....” is limited to a method that would result in the production of X. Note, however, that there may be exceptions ([CSL Limited v Pharmacia & Upjohn AB [2000] APO 58] and that construction of method or process claims may vary depending upon the facts of the case.

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Similarly, a claim of the form “Use of X for...”, or “Use of X to...” is normally construed as a process claim.

There may be circumstances where a "when used" or "use of" claim defines something per se (rather than a process) due to the specific facts of the case, although departure from the normal interpretation should only be adopted when this is clearly required by the wording of the claim. Examples are:

a. A claim to "A combination of compounds A and B whereby the said combination produces a synergistic effect when used in the treatment of tumours" defines a composition of A and B capable of producing a synergistic effect;

b. A claim to "Compound X when used to stabilise compound Y" is equivalent to a composition of X and Y.

A claim to an apparatus "for carrying out" a process was held to be equivalent to a claim to the apparatus per se ([L'Aire Liquide Societe Anonyme pour L'Etude et L'Exploitation des Precedes George Claude (1932) 49 RPC 428]). However, amendment of the claim to "An apparatus when used for carrying out the process" restricted the claim to the apparatus when used in a particular manner.
2.11.2.3.4 "Comprises", "Includes", "Consists of" and "Contains"

**Note:** Where a claim is directed to a product, apparatus or substance, a described use without the phrase “when used” or “whenever used” (particularly in the claim preamble) should be taken as a suitability limitation only, unless otherwise indicated.

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**Special Considerations**

Certain types of use claims raise special issues:

i. Use of compound X for combating diseases.

If the description only discloses that compound X is useful for treating a specific disease (e.g. cardiac arrhythmia), then the claim will be objectionable under sec 40(2)(a) and/or sec 40(3) (see 2.11.7.10A Support Required for Pharmaceutical Inventions and Methods of Treatment and 2.9.3.4.3A Therapeutic or Pharmacological Use referred to therein).

ii. Use of compound X for the treatment of cardiac arrhythmia.

Although the claim encompasses medical treatment of human beings, no objection is to be taken on that basis alone (see 2.9.2.13 Treatment of Human Beings).

However, if the invention relates to the second pharmaceutical indication of compound X (that is, another use), novelty or inventive step issues will need to be considered in the light of the use(s) disclosed in the prior art ("new use of a known substance").

iii. Use of compound X for the preparation of medicament Y for treatment of disease/condition Z.

Such claims, and certain variations along similar lines, are colloquially known as "Swiss claims" (see 2.11.2.3.10 Swiss Claims).
The word “comprises” may be interpreted differently in overseas jurisdictions. Therefore, many specifications include a ‘definition’ of ‘comprise’ or similar words to avoid unintended interpretations. Consequently, examiners should evaluate the use of FERs accordingly.

“Comprises”, “Includes”

In Australia, the meaning of “comprise” (vis-a-vis whether or not it is exhaustive) is determined in accordance with the context of its use. Thus, in Asahi v WR Grace 22 IPR 491 it was held that in the circumstances of that case “comprise” was being used exhaustively. The decision in NV Philips Gloeilampenfabriken v Mirabella International (1993) AIPC 91-025 appears to take a similar line. In General Clutch Corp. v Sbriggs Pty Ltd (1997) 38 IPR 359, after a review of the authorities and several dictionaries, the judge concluded that the normal linguistic meaning is that comprising means made up of, composed of, or constituted by the integers listed. In Fresenius Medical Care Australia v Gambro [2005] FCAFC 220, the Court found the word had a non-exhaustive meaning, particularly noting subsequent dependant claims which added extra integers.

Accordingly, the word “comprise” must be given an interpretation appropriate to the context of its use. In some situations, the word will clearly exclude the presence of additional elements, whereas in others the presence of additional elements will clearly not be excluded.

When “comprise” is used in a non-exhaustive sense, it would be expected that:

a. the advantages of the invention would arise from the features specified (and not from unspecified features); and

b. where an integer is said to “comprise” certain elements, those elements would normally (although not necessarily always) be the predominant feature of the integer.

Where “comprises” is replaced with “includes”, care should be exercised regarding any consequential change of scope. The word “includes” would not normally suggest or require that the element is present in any significant amount, whereas “comprise” in the original context may require the element to be the primary constituent of the integer.

“Consists of”

It is often stated that “consisting of” should be interpreted exhaustively (as in, “consisting only of”). However, it is rare for an applicant to deliberately intend to confine themselves in such a manner. Also, a strictly exhaustive interpretation would exclude (for example) the presence of any impurities in a chemical substance, or the presence of optional features. If, however, the intention resides in the absence of a feature, it would be appropriate to
2.11.2.3.5 Reference Numerals in Claims

interpret this phrase as being exclusive of such features. “Consisting essentially of” should clearly be construed non-exhaustively (Atlas Powder Co. v ICI Australia Operations Pty. Ltd. (1989) AIPC 90-587).

“Contains”

The word "contains" was considered in NV Philips v Mirabella International (supra) to be susceptible of more than one meaning, in that its meaning may be exhaustive or non-exhaustive depending on the context. Accordingly, "contains" is subject to similar consideration to "comprises" as referred to above.

Note: In the case of a claim directed to a composition characterised only by a single component, the claim should be interpreted as including within its scope the component per se, regardless of whether the composition is defined as comprising, consisting, etc.

Reference numerals included in the claims and referring to what is depicted in the drawings, graphics or photographs are generally not objectionable. They do not place any limitation on the claims, unless this intention is clearly expressed. It is immaterial whether or not the numerals appear in brackets. In general, if the numerals follow a generic term it is taken as an exemplification of the matter claimed, with reference to the specific example which is illustrated in the drawing, graphic or photograph. Thus, the object of such numerals is to facilitate the understanding of the claim, without affecting the breadth of its scope. Therefore, the broad construction of the claim is not dependent upon the references and consequently examiners are not required to check or report on the accuracy of those references.

Where a claim is drafted such that the reference numeral is used to identify an express feature of the claim in a limiting manner, the claim must be construed in the light of the references.

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Effective Date: 25 September 2019
2.11.2.3.6 Appendancies

**Note:** Where a reference numeral does not place any limitation on a claim, i.e. the claim does not rely upon the reference to define the invention, then the claim will meet the requirements of sec 40(3A) (see 2.11.2.3.9A Omnibus Claims, noting that the requirements of sec 40(3A) only apply in certain cases).


Modified Date: 10 November 2014

**2.11.2.3.6 Appendancies**

In this topic:

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**Overview**

There are three types of claims – independent claims, appended claims and dependent claims. Independent claims stand on their own and do not refer to any other claim. Appended claims make explicit reference to one or more other claims. Dependent claims are a subset of appended claims where all of the features of the parent claim(s) are incorporated into the appended claim.

Examples of commonly occurring appendancies are:

- a. As claimed in any of the preceding claims;
- b. According to any of the preceding claims;
- c. As defined in any of the preceding claims;
- d. Of claim 1;
- e. According to any one or more of the preceding claims; and
- f. As claimed in claims 1-4 of the preceding claims.

Examiners should note that recent court cases on construction do not use the term “dependent” as the basis of construction. The approach of the courts is to determine the scope of the claim from the words that are used. “Dependent” is a label that can then be applied after the claims have been construed.
Scope of Appended Claims

There is no requirement under Australian law that appended claims narrow the scope of earlier claims, even though this is often the case (Austral Ships Sales Pty Ltd v Stena Rederi Aktiebolag [2008] FCAFC 121 at [47]). The usual situation is that all the features of the parent claim(s) are included in the appended claim (and thus it is truly a dependent claim), however this does not always apply. It is therefore necessary to consider what aspects of the parent claim(s) are imported into the appended claim. In particular, appropriate weight should be given to the preamble or subject clause of the claim.

Claims That Import All Aspects of Parent Claim

Examples of appended claims that import all the aspects of the parent claim (and thus are truly dependent) are:

i. Claim 1. A lifting device comprising A and B.
   Claim 2. A lifting device as claimed in claim 1, wherein A is (as further defined).
   Claim 2 imports all of the aspects of claim 1, i.e. B is present, as defined in claim 1.

ii.Claim 1. A kit comprising A and B when used in the treatment of disease Y.
   Claim 2. The kit of claim 1 further comprising C.
   Claim 2 imports all of the aspects of claim 1, i.e. the kit comprising A and B and the "when used" limitation.

iii.Claim 1. Compound of formula X prepared by process A.
   Claim 2. Compound of formula X according to claim 1 wherein R = H.
   Claim 2 imports all of the aspects of claim 1, i.e. the compound of formula X and the manner in which it was prepared.

In examples i to iii above, claim 2 has the same preamble or subject clause (i.e. lifting device, kit or compound) as the claim to which it is appended. The use of a common
preamble or subject clause is an indication that all of the aspects from the earlier claim are imported, unless a contrary indication is apparent.

Claims That Do Not Import All Aspects of Parent Claim

Conversely, a different preamble or subject clause is likely to (but not invariably) indicate a partial dependency and should be considered carefully. For example, where the claims are of the form:

iv.Claim 1. The use of compound X to treat disorder A.

Claim 2. Compound X of claim 1 wherein …;

claim 2 is considered to be a claim to the compound per se, without any use limitation. This is made clear by the different preamble or subject clause present in claim 2.

Further examples of appended claims that do not import all of the aspects of the parent claim(s), and thus are not dependent, are:

v.Claims 1 to 3 are directed to a process using a titanium catalyst and claim 4 is appended to any one of claims 1 to 3 but excludes a catalyst (i.e. "A process as claimed in any one of claims 1 to 3, wherein the catalyst is not present").

vi.The appended claim uses the words "for" or "for use" in relation to an earlier claim. For example, the notional appendancy to claim 1 in "A device for use in the apparatus claimed in claim 1" means no more than that the features of the device have a functional capability consistent with being used in the apparatus of claim 1. In particular, the dependency does not import any of the features of claim 1 as integers of the notionally dependent claim. Further information regarding the construction of “for” and “for use” claims is provided in 2.11.2.3.3 "For Use", "When Used", etc.

vii.Claim 1 consists of features A and B, and the dependent claim is directed to just one of those features per se, for example “Feature B as claimed in claim 1, wherein…..”.

viii.Where an appended claim further defines a feature (X) that is identified as optional in the corresponding parent claim, care should be taken in determining whether or not the appended claim is limited to the inclusion of X. Such determination should take into account the facts of the case and the apparent intent of the appended claim.

When determining optional features, examiners should pay special attention to terms such as "particularly" or "specifically", as these terms may indicate more specific characterisation of a feature, rather than its optional presence.
Note: Where circumstances iv to vii referred to above occur, novelty issues may also arise and examiners will need to take these into account when formulating any search strategy.

Special Considerations

A situation that is sometimes encountered, particularly in the chemical technologies, is where an appended claim includes examples that do not fall within the scope of the claims to which it is appended. This can arise where an independent claim is amended to remove some functional groups in order to avoid prior art, but the appended claim still includes specific examples having those functional groups.

In such cases, the appended claim will be taken as broadening the scope of the monopoly to include the additional examples. As with other situations described above, the novelty and inventive step of the additional examples will need to be considered.

Note: A clarity objection should not be taken in such cases, since the scope of the appended claim can be determined.

A simple example is as follows:

Claim 1 A compound of the following formula:

$$R-X$$

wherein X is hydroxyl, amino or thiol; and

R is methyl or ethyl.

Claim 4 A compound according to Claim 1 which is methanol, methanethiol or nitromethane.

In this case, nitromethane does not fall within the scope of the formula defined in parent claim 1. A clarity objection would not be taken, however it would be necessary to consider whether nitromethane is novel and inventive.
Relative terms may be used in a patent specification, in an appropriate context, provided they convey the necessary meaning - see:

*Leonardis v Sartas* [1996] 449 FCA 1; *Populin v H B Nominees Pty Ltd* (1982) 41 ALR 471 at 473 ("relatively small");

*Imperial Chemical Industries Limited (Clark's) Application* [1969] RPC 574 at 583, 584 ("a minor amount of water ... small in comparison with the total amount of other liquid constituents");

*Vax Appliances Limited v Hoover plc* [1991] FSR 307 at 309, 318 ("substantially dropwise" flow);


The word "substantially" is frequently used in claims and is permissible provided it conveys the necessary meaning (*Leonardis v Sartas* [1996] 449 FCA 1). "Substantially" merely indicates an intention that the term it qualifies should not be read too literally. As explained by Blanco White, Fifth Edition, at 2-112:

"If draftsmen and judges were perfect 'substantially' would have no effect; as it is, the indication is often a useful one. But the word can only mean 'nearly enough for the patentee's purposes', unhelpfully unless the body of the specification tells the reader what those purposes are and what sort of precision is needed to achieve them."

See also *Young v Rosenthal* 1 RPC 29.

In this topic:

**“Substantially”**

"About"
2.11.2.3.8 "Substantially" and "About"

Similarly, the word “about” is often used to qualify (in particular) numerical quantities to indicate that small variations from the specified value are envisaged. In general, all terms used in a claim permit a degree of variation consistent with what a person skilled in the art would understand from the specification. In *Catnic Components Ltd v Hill and Smith Ltd (1982) RPC 183*, the term 'extending vertically' was construed in context as meaning 'near enough to vertical to enable ...'. However, numeric values invite a construction limited to the precise value. The use of the word ‘about’ to qualify a number is merely an express indication that the number is not to be construed as a precise value.

When ‘about’ is used to indicate a variance, the extent of that variance is dependant upon what the person skilled in the art would understand is intended. In this regard, the precision of the quantity would also have a bearing. For example, “about 10” might permit a variance of several units, however “about 10.301” would only permit a variance of a small fraction of a unit.

The use of ‘about’ to qualify the extent of a range, e.g. ‘about 10 to about 20’ (or the equivalent phrase ‘about 10 to 20’) does not in itself render the scope of the claim uncertain. The extent of variation encompassed by ‘about’ is likely to be primarily dependant upon the size of the range (in addition to numerical precision). For example, a range of ‘about 10 to about 1000’ would reasonable permit variance of many units at either end of the range. However, a range of ‘about 10 to about 12’ would likely only reasonably permit a variance of a fraction of a unit at either end of the range. In all cases, the ultimate question to be asked is whether the person skilled in the art would understand the scope of the monopoly.

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"Generally"

The term "generally" raises similar issues to the term “about”. The word indicates that some degree of variation from the specific is intended. For example, a material that is "generally transparent" includes, but is not limited to, those that are totally transparent (although totally opaque would not be included). The degree of variation will depend upon what the person skilled in the art would understand is intended.

The term "generally transverse" did not give rise to any difficulties of construction in *Nicaro v Martin (1990) 16 IPR 545*.

Modified Date: 01 August 2016
2.11.2.3.9 Omnibus Claims

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.3.9A Omnibus Claims.

In this topic:

Overview

An omnibus claim defines a monopoly by reference to the whole body of the specification or to a particular part thereof, such as the drawings or the examples. The words "substantially as described" or "substantially as described with reference to the drawings" are commonly used. An omnibus claim generally contains two parts:

i. the subject matter to be protected by the claim; and

ii. words that refer back to the specification or that part thereof which is relied upon to define the monopoly.

Omnibus claims can be as important as any other claim. In Raleigh Cycle Co. Ltd. v H Miller and Co. Ltd. (1948) 65 RPC 141, all claims except the omnibus claim were found to be invalid. Consequently, the omnibus claim was all that was left to the patentee.

Claim Construction

Omnibus claims which contain words such as "substantially as described herein" are to be construed as being limited to the features of the invention identified by the subject of the claim, in their preferred form as described in the specification (GlaxoSmithKline Australia Pty
2.11.2.3.9 Omnibus Claims

Ltd v Reckitt Benckiser Healthcare (UK) Ltd [2016] FCAFC 90 at [69]-[80]). As a general rule, an omnibus claim is directed to the broadest form of the invention identified by the claim, with the various features of that invention being in their preferred form. In order to identify the features of an omnibus claim, examiners should have regard to the text of the specification, such as the consistory statement, the objects of the invention and the examples. Where there is a conflict between different parts of the specification, then the omnibus claim will have an indeterminate scope.

Where these words are followed by the text "with reference to the examples" or "with reference to the accompanying drawings" and the like, the features of the omnibus claim are to be construed as being limited to the specific form of those features described in the examples or in the drawings, as the case may be. That is, omnibus claims do not claim the entirety of what is indicated or shown in the examples or drawings, since optional features that might appear in the examples or drawings do not form part of the claim.

Where the omnibus claim refers generally to the examples or drawings, any prior art examples or drawings contained in the specification are taken to be outside the scope of the omnibus claim, on the basis that this would be an "absurd result" (see Henriksen v Tallon Ltd [1965] RPC 434). However, if the prior art examples or drawings are referred to specifically in the omnibus claim (such as by number or letter), then these are to be construed as being within the scope of the claim and a novelty objection should be taken accordingly.

The construction of an omnibus claim which does not unambiguously set forth its broad features by:

- reciting them;
- referring to another claim which recites them; or
- employing wording which invokes the essential features of the invention;

is more difficult. Where the features of the omnibus claim cannot be identified, the claim will have an indeterminate scope. However, as such claims are plainly of no consequence to the overall scope of the monopoly, no objection should be taken to them. The only exception is where there are no other claims apart from these in the specification, as in this case they will determine the overall scope of the monopoly.

Examples of this type of claim are:

- claims referring to "each novel feature"; and
- claims referring to "the features individually and collectively".
Examination Practice

An objection should only be taken to the form of words used in an omnibus claim if:

- the scope of the claim cannot be clearly determined; or
- the scope of the claim, properly construed, encompasses the prior art;

as discussed in ‘Claim Construction’ above.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.3.9 Omnibus Claims.

In this topic:

Overview

An omnibus claim defines an invention by reference to the whole or part of the specification, such as the drawings or the examples. The words ‘substantially as described’ or ‘substantially as described with reference to the drawings’ are commonly used. An omnibus claim generally contains two parts:

i. the subject matter to be protected by the claim; and
ii. words that refer back to the specification or that part thereof which is relied upon to define the monopoly.
Under sec 40(3A), the claims must not rely on references to the description, drawings, graphics or photographs unless absolutely necessary to define the invention. Consequently, omnibus claims are allowable where the invention can only be defined by reference to a specific detail in the description, drawings, graphics or photographs.

In determining whether it is absolutely necessary for a claim to refer to the description, drawings, graphics or photographs to define the invention, some factors to consider include:

- What information would need to be inserted into the claim instead of referring to the description, drawings, graphics or photographs?
- Can that information be described in words?
- How much information would need to be inserted?
- Would the inclusion of the information assist or hinder the construction of the claim?

It is acceptable to include information in a claim by reference to the description, drawings, graphics or photographs where it would be impractical to include the information directly. Thus, for example:

- where the invention is a chemical composition that can only be defined by reference to a particular spectrum, or an apparatus with a certain feature that can only be defined by reference to a drawing, that reference is acceptable.
- where the invention is nucleotide and/or amino acid sequence(s) and the nature of these makes it impractical to include them in a claim, a reference to the sequence listing part of the specification is acceptable (see also 2.11.6 Claims are Succinct).

Reference numerals in a claim that refer to features in a drawing, graphic or photograph are generally acceptable, provided they do not limit the scope of the claim (see also 2.11.2.3.5 Reference Numerals in Claims).

Where a claim states that a certain term or feature is ‘as herein defined’, and the specification uses a dictionary to indicate that the term or feature has a particular meaning, this is generally acceptable (see also 2.11.2.5 Dictionary Principle).

**Examination Practice**

Where claims rely on references to the description, drawings, graphics or photographs and this is not absolutely necessary (noting the considerations above), the report should include the following objection:
Claims X-Y do not comply with subsection 40(3A) as they rely on references to the description and/or drawings, graphics or photographs that are not absolutely necessary to define the invention.'

or words to that effect (see also PERP code [E10]).

In general, no further search and/or examination should be conducted in respect of the omnibus claims and examiners should indicate in their report that further search and/or examination of such claims is reserved.

**Note:** Where opinion on omnibus claims is reserved, such claims should not be referred to in the 'Summary of Novelty, Inventive Step and Patentable Subject Matter’ section of the examination report.

However, there may be circumstances where reservation of opinion is not warranted. A decision whether to conduct search/examination is a matter of judgement on the part of the examiner taking into account the facts of the case.

In those situations where it is absolutely necessary for the claims to rely on the description, drawings, graphics or photographs, the claims are to be searched and/or examined according to the usual procedures.

Where examiners are in doubt as to whether it is absolutely necessary for a claim to rely on references to the description, drawings, graphics or photographs, it is reasonable for an objection to be raised and for the applicant or attorney to explain why the reference is necessary.

**Claim Format**

The typical format of a Swiss claim is:

“The use of (substance X) for the manufacture of a medicament for the therapeutic and/or prophylactic treatment of (medical condition Y).”

A Swiss claim may also be worded as:

“The use of (substance X) in the manufacture of a medicament for the therapeutic and/or prophylactic treatment of (medical condition Y).”
It should be noted that although there may be minor variations in the wording, the Swiss claim format is quite specific. Whilst some minor variation in the format may be possible, the following are examples of claims that are not considered to be Swiss claims and are therefore to be construed according to the usual rules of construction:

a. (Substance X) in the manufacture of a medicament for the therapeutic and/or prophylactic treatment of (medical condition Y).

b. (Substance X) for use in the treatment of (medical condition Y).

c. The use of (substance X) in the treatment of (disease Y).

d. Commercial package containing as an active pharmaceutical agent (compound X) together with instructions for treating (condition Y).

e. A process for the manufacture of a medicament for use in the treatment of (medical condition Y) characterised by the use of substance X.

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**Claim Construction**

Claims in the Swiss format (as discussed above) are construed as defining the manufacture of a medicament, wherein the medicament is intended for a specified medical treatment. The novelty and inventiveness of Swiss claims is considered to derive from the new medical use and not from the manufacture of the medicament. Therefore, a prior art disclosure of a method of making the medicament will not in itself anticipate a Swiss claim. In order to anticipate a Swiss claim, a citation must disclose both a method of preparing the medicament and the specific treatment claimed. This approach is consistent with that followed in the Federal Court (Otsuka Pharmaceutical Co., Ltd v Generic Health Pty Ltd (No 4) [2015] FCA 634).

**Note:** The above rule of construction for Swiss claims only applies to medical use claims, wherein the medical use relates to the treatment or prevention of disease in humans or animals. It does not apply to claims wherein the intended use is non-medical, e.g. treatment of plants, weeds etc. Claims directed to a non-medical intended use should therefore be construed according to the usual rules of construction.

Modified Date: 01 February 2013
2.11.2.3.11 Product by Process Claims

A claim may be directed to an article produced by a process, for example:

- "An article A, characterised by being the product of process B."
- "An article A produced by process B."
- "An article A obtained by process B."

Such a claim is directed to the article only when obtained or produced by the process. The claim does not extend to the article regardless of the process by which it was obtained or produced.

*Kirin-Amgen Inc v Roche Diagnostics GmbH* [2002] RPC 1 at [283].

**Note:** This construction only applies to national examination. For international searching and examination the approach to be followed is outlined in 1.1.11.3 Searching Product by Process Claims.

Modified Date: 01 February 2013

2.11.2.3.12 Parametric Claims

A parametric claim is one that defines a product or feature of a process in terms of its parameters, for example:

'A composition comprising a detergent having an XYZ value of greater than 5.0.'

This style of claiming is referred to as ‘parameteritis’ or ‘parametritis’ and was discussed by Laddie J in *Raychem Corp.’s Patents* [1998] RPC 31 at page 37:

"This is the practice of seeking to repatent the prior art by limiting claims by reference to a series of parameters which were not mentioned in the prior art. Sometimes it includes reference to a series of parameters measured on test equipment which did not exist at the time of the prior art. The attraction of this to a patentee is that it may be impossible to prove now that the prior art inevitably exhibited the parameters and therefore it is impossible for an opponent to prove anticipation. Even if that is what has happened here, it does not alter the task of the court. It must decide whether the opponent has proved anticipation or some other statutory ground of invalidity. Parametritis may make the court’s task more difficult, but at the end of the day the test of invalidity must be the same, whatever the form of the claims."
At pages 46-47, Laddie J stated in relation to the parameter S/D volume ratio:

‘It is essentially arbitrary and has little technical significance. The selection of a group of compositions by reference to such a parameter does not involve any inventive step. Although it may not be obvious, in the common use of that word, to limit a claim by reference to this particular meaningless and arbitrary parameter, that has nothing to do with patentability. Patents are not given for skill in inventing technically meaningless parameters.’

**Examination Practice**

A parametric claim is not objectionable merely because it defines a product in terms of its parameters. The defining of a product by its parameters may be appropriate where the product cannot be adequately defined by other means. However, the parameters must be clearly and reliably determined, either by objective procedures known in the art or as indicated in the description. Similar considerations apply to a feature of a process that is defined in terms of its parameters.

As noted in *Euroceltique S. A. [2009] APO 21* at [112], a key consideration when construing parametric claims is whether the parameters are chosen to achieve a technical effect, or whether they are an arbitrary convenience. Where a claim defines a new or unusual parameter that is not recognised in the art, a clarity objection may be appropriate.

**Novelty Considerations**

Examiners should be aware that the use of parameters within a claim may be an attempt to disguise a lack of novelty. In *Williams Advanced Materials, Inc. v Target Technology Company LLC [2004] FCA 1405* the claims under consideration were directed to an optical storage medium comprising a silver and palladium metal alloy. At paragraph 48 Bennett J stated:

“Indeed, there is nothing in the specification that suggests that the proportions or the ranges of metals in the alloys are in any way part of the invention, other than the mere reference to them. It is a case of ‘parameteritis’.”

Certain claims were found to be not novel.

However, in *Austal Ships Pty Ltd v Stena Rederi Aktiebolag [2005] FCA 805*, claims directed to a hull with certain parameters were found to be novel. In this case Bennett J stated at paragraph 108:
"Unlike in Williams Advanced Materials, Inc. v Target Technology Company LLC [2004] FCA 1405 at [48], there is reference in the patent specification and evidence which supports the fact that the parameters have been carefully chosen, are part of the invention and are related to a claimed advantage as part of the combination of the design."

2.11.2.4 What is the Invention?

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.4A What is the Invention?

To assess the requirements of ‘describe the invention fully’ and fair basis, it is necessary to firstly construe the specification to identify what is the invention.

In Kimberly-Clark Australian Pty Ltd v Arico Trading International Pty Ltd (2001) 207 CLR 1, the High Court (at paragraph 21) discussed the various ways the term “invention” is used in patent law. The High Court noted that there were four possible meanings of the word “invention”:

"They are: 1. The embodiment which is described, and around which the claims are drawn. This is the sense used in the Act: cf. the phrase of s 32, ‘the invention so far as claimed in any claim. 2. The subject-matter of a claim - especially that of the broadest claim. 3. The inventive step taken by the inventor. 4. The advance in the art made by the inventor; as (to take Lord Justice Moulton's example) 'he applied electricity for the first time to such-and-such a purpose.' This is likely to be broader and more fundamental than would correspond with any claim."

The High Court indicated it was the first meaning that is used for the purposes of sec 40(2) (full description). This meaning also flows through to fair basis (sec 40(3)), which requires consistency between the described and claimed invention.
2.11.2.4.1 General Considerations

Note: The term "embodiment" for the purposes of defining the "invention" is the broadest form of the invention described, rather than the specific examples (which are preferred embodiments). Fair basis requires a comparison of the claims with matter described in the specification, not just with a preferred embodiment.

Examination Practice

In construing the specification for the purposes of sec 40, examiners should ascertain what the specification describes as the invention, rather than try to identify the "real" invention, the "actual inventive step" made by the inventor, or the technical contribution made by the inventor to the art.

The High Court in Lockwood v Doric [2004] HCA 58 referred with approval to Barwick J's comments in Olin Corp v Supercartridge Co. Pty Ltd & Or (1977) 180 CLR 236 (at page 240):

“...The question whether the claim is fairly based is not to be resolved in my opinion, by considering whether a monopoly in the product would be an undue reward for the disclosure. Rather the question is a narrow one, namely whether the claim to the product being new, useful, and inventive, that is to say, the claim as expressed, travels beyond the matter disclosed in the specification”.

When considering the examples of the invention, it must be kept in mind that these can be used to demonstrate failed attempts to arrive at the invention (which are not part of the invention), as well as the full range of an invention (including less than perfect examples that are still within the scope of the invention). It is necessary to see what work the examples do in the patent specification in any particular case (Nufarm Ltd v Jurox Pty Ltd [2008] FCAFC 180).

Modified Date: 01 February 2016

2.11.2.4.1 General Considerations

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the
For all other standard patent applications/innovation patents, see 2.11.2.4A What is the Invention?

To assess the requirements of ‘describe the invention fully’ and fair basis, it is necessary to first construe the specification to identify what is the invention. The following general considerations should also be taken into account:

**Invention:** The ‘invention’ is ‘the embodiment which is described, and around which the claims are drawn’, as distinct from ‘the subject-matter of a claim - especially that of the broadest claim’, or ‘the inventive step taken by the inventor’.


**Consistency statement:** As a general rule, a well drafted specification will contain fairly clear statements of the invention that are supported by the description, without contradictory statements. In such situations, the asserted statements of the invention may usually be taken at face value. However, while a consistory statement may be a strong indication of what the invention is, it is not definitive. Consideration must be given to the specification as a whole.

**'Essential' feature:** A statement that a feature is ‘essential’ is usually indicative that the feature is part of the invention. However, consideration must be given to other parts of the specification, which may indicate that the feature is not actually essential. (Note that the concept of ‘essential features’ is irrelevant to the question of compliance with sec 40. Essential features are only relevant to questions of anticipation and infringement; see 2.11.2.4.5 "Essential Features" of the Invention).

**'Preferred' feature:** While a statement that a feature is ‘preferred’ is usually indicative that the feature is not part of the broadest form of the invention, proper construction of the specification as a whole may determine that it is in fact part of the invention.

**Claimed integers:** When construing the specification to identify ‘the invention’, it is necessary to have regard to what is claimed. However, the mere fact that a set of integers is specified in a claim does not make that set of integers ‘the invention’. Regard must be had to the context in which those integers are described in the specification as a whole, and in particular whether the presence or absence of other integers is required, or whether the integers must be in a particular form or relationship.

**Effect of amendments:** At the commencement of examination, the invention may not have been properly identified. Therefore, the ‘invention' that is the subject of the claims may change over the course of examination as a result of amendment. Consequently, examiners may need to completely re-evaluate what is the invention at subsequent report stages.
Different forms of invention: Specifications will usually disclose many ‘forms’ of an invention and occasionally will disclose several inventions. When assessing the requirements for full description (and fair basis), considerations should relate to the invention that is indicated by the claims in question. For example, if a claim is directed to an object having certain features, it is necessary to construe the specification (having regard to both the description and claims) to identify the invention in so far as it relates to that object. The questions of whether the specification fully describes that invention, and whether the claims are fairly based on the description, can then be answered.

Essence of the invention: Some decisions refer to the ‘essence of the invention’. When construing a specification, the core elements of the invention (i.e. the essence of the invention) will usually be quite evident. Identification of these core elements will usually assist in identifying the invention. However, as stated by the Full Court in Fresenius Medical Care Australia v Gambro [2005] FCAFC 220:

“While it may be of assistance to identify the essence of the invention, s.18(1) of the Act makes it clear that it is the invention, so far as claimed in the claims, that is to be assessed for novelty and inventive step.”

Case Law

In Coopers Animal Health v Western Stock 11 IPR 20, the issue was whether a petty patent was fairly based on a provisional specification. A key component of a claim in the petty (a carrier called DGBE) was disclosed in the provisional specification. However, Fox J noted that:

"the two inventions described or claimed were directed at different objects, one dealing with the method, in which precise ingredients were not perhaps so essential, and the other dealing with the ingredients";

and concluded that the invention of the petty patent was a new (that is, different) invention. Spender J, in concurring, stated that:

"I share his conclusion that the integer respecting the carrier DGBE was not disclosed as part of the invention described in the provisional specification" [emphasis added].

Modified Date: 10 November 2014
2.11.2.4.2 Approach in Lockwood v Doric

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.4A What is the Invention?

The High Court in *Lockwood v Doric* [2004] HCA 58 did not explicitly construe the specification to determine the invention described in the specification. However, they agreed (at paragraphs 29 and 38) with the trial judge that the invention was that described in the broad consistory clause. In the High Court’s view (paragraph 59), this broad invention was “a new result by existing means used in combination” and hence fell within the principle stated in *Shave v H V McKay Massey Harris Pty Ltd* (1935) 52 CLR 701:

"When a combination claim states an invention which gives an old result by a new means, the monopoly is limited, at any rate prima facie, to the new means. But when by a new application of principle the inventor has obtained a new result or thing, even when it be done by a combination, he may claim all the alternative means by which the thing or result may be achieved."

The *Shave v H V McKay* principle is similar to that adopted by Lord Hoffmann in *Biogen v Medeva* [1997] RPC 1 at page 34, when he considered how to determine the nature of the invention:

"Whenever something is done for the first time it is the result of the addition of a new idea to the existing stock of knowledge. Sometimes it is the idea of using established techniques to do something which no one had previously thought of doing. In that case the inventive idea will be doing the new thing. Sometimes, it is finding a way of doing something which people had wanted to do but could not think how. The inventive idea would be the way of achieving that goal. In yet other cases, the many people may have a general idea of how they might achieve the goal but not know how to solve a particular problem which stands in their way. If someone devises a way of solving the problem, his inventive step will be that solution, but not the goal itself or the general method of achieving it."

Although *Biogen v Medeva* was criticised by the High Court in *Lockwood v Doric*, the primary criticism was related to the *Biogen v Medeva* requirement that each embodiment should be enabled (see paragraphs 66, 67 and 95 of *Lockwood v Doric*). *Biogen v Medeva* also relied on *Mullard Radio Valve Co Ltd v Philco Radio and Television Corporation of Great Britain*.
"The consideration which the patentee gives to the public disclosing his inventive idea entitles him in return to protection for an article which embodies his inventive idea but not for an article which, while capable of being used to carry his inventive idea into effect, is described in terms which cover things quite unrelated to his inventive idea, and which do not embody it at all."

However, the Lockwood v Doric criticism is in the context of the word “entitles” which the High Court found to inappropriately introduce the notion of “fair reward” for the invention described. In fact, the term has been used in a number of decisions (including Biogen v Medeva) merely to ensure consistency between the invention described and the claims. This type of approach is actually endorsed by the High Court in Lockwood v Doric. Therefore, despite their criticism of Mullard v Philco, the High Court noted that the result in that case may have been the same if sec 40(3) had applied (at paragraph 58). It came to the same finding (at paragraph 56) with respect to the Australian High Court decisions in Montecatini Edison SpA v Eastman Kodak Co (1971) 45 ALJR 593 (at 597) (the majority decision despite their acceptance of Barwick CJ’s dissenting view above) and Olin Corporation v Super Cartridge Co Pty Ltd (1977) 180 CLR 236 (at 263) which both relied on Mullard v Philco.
is not definitive, particularly where the specification as a whole indicates that the actual invention is narrower than the consistory statement suggests.

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**Case Law**

*Lockwood v Doric [2004] HCA 58*

(paragraph 87)

The High Court noted that the mere "coincidence of language" does not in itself establish fair basing. A claim based on what has been stated in the form of a consistory clause is not fairly based if other parts of the specification indicate that the invention is narrower than the consistory clause. Therefore, it is necessary to consider what the body of the specification read as a whole discloses as the invention. As further noted:

'attention (must be given) to the construction of the specification as a whole, putting aside particular parts which, although in isolation they might appear to point against the "real" disclosure, are in truth only loose or stray remarks.'

*Pfizer Overseas Pharmaceuticals v Eli Lilly and Company [2005] FCAFC 224*

(paragraphs 268-277 and 325-347)

The Federal Court found that a broad consistory clause alone was not sufficient to establish fair basis. On a proper reading of the specification, the Court found that the invention lay in the use of specified compounds of the invention. However, one of the claims defined compounds outside this range. The Court concluded that this claim "travels well beyond the range of compounds, large as it may be, which is disclosed in the body of the specification" and hence lacked fair basis.

*Atlantis Corporation Pty Ltd v Schindler (1997) 39 IPR 29*

A statement in the specification describing the invention in language similar to the first claim was not treated as a description of the invention. While the claims (and consistory statement) defined an apparatus without any limitation as to its use, the specification, read as a whole, described an apparatus limited to a particular use as a sub-soil drainage system. The Full Court held that the consistory statement:

"should not be allowed to disguise the fact that the invention disclosed in the body of the specification is truly 'a sub-soil drainage method based on a particular apparatus'"
or 'a particular apparatus in its application to sub-soil drainage'. The claims, however, are 'pure apparatus claims'. They are not subject to any limitation as to use. They travel beyond, and are not fairly based on, the matter described in the specification'.

2.11.2.4.3A Consistory Clause

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.4.3 Consistory Clause.

An opening statement of the invention or 'consistory clause' is normally included in the description. However, the consistory clause may be omitted if the description discloses the claimed invention without ambiguity.

It is not necessary for a consistory clause to be identical in wording to a corresponding independent claim, however it must not be inconsistent with such a claim. A claim that is wider in scope than a consistory clause may be open to objection on the grounds that it is not supported by the description.

**2.11.2.4.4 Requirement for Critical Analysis**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
Assessment of the invention may require critical analysis. As noted in the High Court in *Lockwood v Doric* [2004] HCA 58, the invention is not simply:

“an assertion by the inventor in a consistory clause of that of which the invention consists”; and

“The consistory clause is to be considered by the court with the rest of the specification.”

In paragraph 100 of *Lockwood v Doric*, the High Court described how a specification should be written (and therefore apparently construed) by referring to a passage from the Australian patent law text *Lahore, Patents, Trade Marks and Related Rights* (2001), vol 1 at §15,345:

"Claims found to be inconsistent with the general description of the invention may be invalid as being not fairly based on the matter described in the specification. In order to avoid this possibility a well drawn specification will usually include in the body of the specification one or more formal 'consistory statements' setting forth what the patentee considers to be the scope of the invention, such statements often quoting the exact wording of the broadest claims in the specifications. ... Such statements will generally follow an introductory portion of the specification, which may describe the technical field of the invention and the problems with the prior art which are to be addressed by the invention. It is important that the introductory part of the specification be worded so as to be consistent with the scope of the invention as defined in the claims and any formal consistory statements.

A statement implying that the invention has a limited field of application or requires as an essential feature something which is not required by the claims may result in a finding that the claims are wider than the invention disclosed in the specification, and are accordingly invalid for lack of fair basis on the matter described in the specification."

It appears from this passage that the High Court has found that concessions of the prior art in the specification, problems intended to be addressed by the invention, limitations of the field of invention and clear statements of essential features can all be considered in “truly” construing the invention described along with the common general knowledge (but only in matters of construction – see paragraph 48 of *Lockwood v Doric* [supra]).
Examination Practice

Examiners should be aware that construing a specification can be subjective. Some court decisions are only majority judgements, suggesting that it is possible to construe different inventions from the one specification. This problem was discussed in the article “Does the fair basing “problem child” escape Lockwood” (2005) 16 AIPJ 210, which concluded (at page 226):

"It must be said that the lower court decisions are somewhat of an indictment of a test which, like Aladdin’s lamp, can magically accommodate almost any approach to construction and hence almost any conclusion the decision-maker desires”.

Examiners should therefore seek advice from a supervising examiner where there are conflicting views with an applicant about what the specification describes as the invention.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

Lockwood v Doric [2004] HCA 58 at paragraph 68 states:

“The comparison which s 40(3) calls for is not analogous to that between a claim and an alleged anticipation or infringement. It is wrong to employ "an over meticulous verbal analysis". It is wrong to seek to isolate in the body of the specification "essential integers" or "essential features" of an alleged invention and to ask whether they correspond with the essential integers of the claim in question”.

The concept of "essential features" is therefore limited to the infringement environment. When considering the question of fair basis, the starting point is to determine the features of the invention that is the intended subject of the claim.

A specification may contain a clear statement that an integer is “essential” to the invention. While such statements often identify the core elements of the invention, this is not necessarily always true and consideration must be given to other parts of the specification. Examiners should therefore determine whether the word “essential” means that a specific
2.11.2.4A What is the Invention?

feature is a core element of the invention, or merely essential for the working of the preferred embodiment.

As noted in *Rehm Pty Ltd v Websters Security Systems (International) Pty Ltd* 11 IPR 289:

"The circumstance that something is a requirement for the best method of performing an invention does not make it necessarily a requirement for all claims; likewise, the circumstance that material is part of the description of the invention does not mean that it must be included as an integer of each claim. Rather, the question is whether there is a real and reasonably clear disclosure in the body of the specification of what is then claimed, so that the alleged invention as claimed is broadly, that is to say in a general sense, described in the body of the specification."

**Note:** Where an invention relates to a machine, apparatus or process, a claim need not enumerate all the required, but well established features, of that machine, apparatus or process. In this situation, examiners should not take an objection that the claim is not fairly based on the specification on the grounds that it omits required features of the invention, since the alleged omitted feature is merely a required feature of the whole machine, apparatus or process and has no direct connection with the invention.

2.11.2.4A What is the Invention?

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.4 What is the Invention?

In assessing the requirements of clear enough and complete enough disclosure and support, ‘the invention’ is the claimed invention. Further information on ‘the invention’ is provided in 2.11.3.4A Principles for Examination and 2.11.7.1A Principles for Examination.

2.11.3 Full Description, Best Method
2.11.3 Full Description; Best Method

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3A Clear Enough and Complete Enough Disclosure.

The general test for full description is outlined in *Universal Oil Products v Monsanto* (1972) 46 ALJR 658:

"The specification is sufficient if the patentee makes the nature of his invention, and how to perform it, clear and intelligible to persons having a reasonably competent knowledge of what was known before on the subject to which the patent relates, and having reasonably competent skill in the practical mode of doing what was then known."

See also *Patent Gesellschaft AG v Saudi Livestock Transport & Trading Co* (1997) 37 IPR 523 at 530.

2.11.3.1 Date for Determining Full Description

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.1A Date for Determining Clear Enough and Complete Enough Disclosure.
2.11.3.2 Can the Nature of the Invention be Ascertained?

The specification is required to fully describe the invention, including the best method of performance, at the time of filing the application. However, where these requirements are not met, they may be rectified at any time up until grant (at least), subject only to compliance with the requirements for the allowability of amendments (*Eli Lilly v Pfizer Overseas Pharmaceuticals* [2005] FCAFC 224).

**Biological Inventions, Budapest Treaty**

For inventions involving biological material, the applicant may rely upon the Budapest Treaty in order to meet the full description requirement (see 2.11.3.15 Biological Inventions and the Budapest Treaty and 2.7 Micro-Organisms and Other Life Forms). In this case, certain information must be provided either by OPI, or by acceptance (both subject to the operation of sec 223). Critically, the deposit under the Budapest Treaty must be made on or before the filing date of the application. The late deposit of a micro-organism under the Budapest Treaty cannot be rectified via an extension of time under sec 223 (as there is no relevant time period to be extended), nor overcome by filing a divisional application.

Modified Date: 01 February 2013

**2.11.3.2 Can the Nature of the Invention be Ascertained?**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.2.4A What is the Invention?

In *Welch Perrin and Co. Pty. Ltd. v Worrel* (1961-1962) 106 CLR 588 the High Court held that the requirement for a full description is satisfied if it is possible to ascertain the nature of the invention from a reading of the specification as a whole, including the claims.

An objection that the specification does not fully describe the invention, because the nature of the invention cannot be ascertained, should only be taken if the specification is drafted in such a way that it is not possible to gain any idea of what the invention actually is. In practice, this situation is unlikely to occur in professionally drafted specifications as:
2.11.3.2 Can the Nature of the Invention be Ascertained?

a. the nature of the invention is usually stated in the so-called "consistory clause".

b. the absence of a consistory clause does not, in itself, lead to an objection of lack of full description. There is no statutory requirement for a consistory clause and the High Court has held that its purpose may be met by the claims themselves.

c. where some claims are in conflict with the specification, the specification can be considered to have fully described the invention, provided it is possible to ascertain the nature of the invention having regard to the specification as a whole.

d. where some embodiments described are in conflict with the claims, an objection of lack of full description does not arise, provided it is possible to ascertain the nature of the invention from the specification as a whole (Vaw Aluminium AG v Alcan Deutschland GmbH [1994] APO 68). In such cases, an objection that the specification does not describe the best method of performance may be appropriate (see also 2.11.3.18 At Least One Method must be Disclosed).

e. it is not necessary to describe an invention as narrowly as it is claimed, provided ambiguity does not thereby result (Imperial Chemical Industries of Australia and New Zealand Ltd. v Brock [1965] AOJP 998, at page 1000).

f. conversely, there is no need to describe the embodiment of the invention as broadly as the invention may be claimed. The fact that the claims and the description are not necessarily required to be of the same ambit is particularly pertinent where prior art is cited and where, as a result, the scope of the claims is narrowed without corresponding changes in the body of the specification.

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Other Considerations

New Combination

Many inventions lie in an improvement of an existing device, combination or process. Where the invention lies in a new combination, irrespective of whether the integers are all old or some are old and some are new, the requirements of sec 40(2)(a) are satisfied by a description of the combination as such. The applicant is not required to distinguish what is old from what is new (Lockwood v Doric [2005] FCAFC at paragraph 195).

Inventive Step

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Effective Date: 25 September 2019
There is no requirement for a specification to identify the inventive step. The courts have consistently held that an applicant for a grant is not, pursuant to the statutory requirements to describe the invention, under an obligation to identify the inventive step involved. Courts have declined to order that a patentee give particulars of what is alleged to be the inventive step, on the basis that the patentee could do no more than give an opinion as to this (Arrow Pharmaceuticals Ltd v Merck & Co Inc (2003) 58 IPR 231).

**2.11.3.3 Compliance with Subsection 40(2) is a Question of Fact**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.3A Compliance with Subsection 40(2) is a Question of Fact.

In this topic:

**Full Description**

The question of whether a specification fully describes the invention is one of fact, and whether a specification discloses a method that will actually perform the invention is a matter best determined by receiving evidence from persons skilled in the art (Universal Oil Products Co. v Monsanto Co. (1972) 46 ALJR 658).

Thus, examiners should avoid arguments over whether the specification fully describes a method that will actually perform the invention (including, for example, a method that appears to be purely theoretical and not actually performed by the applicant), as rarely will they be in a position to have the necessary evidence to properly support their case. In N.V. Philips' Gloeilampenfabrieken's Application (1958) AQJP 799 (Ferroxcube case), the Commissioner was directed to accept the application, despite the specification being open to "considerable criticism" on the ground of sufficiency. However, where a specification "so
2.11.3.4 Enabling Disclosures

clearly fails to disclose a manner of carrying out the invention that no evidence is necessary to show its insufficiency", then examiners should object, pursuant to the principles set out in *Commissioner of Patents v Microcell* (1959) 102 CLR 232. This situation may arise where, for example, the conclusion is reached on the basis of admissions made in the specification.

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### Best Method of Performance

The best method requirement is assessed on the basis of the applicant's knowledge at the time of filing the complete specification (*Rescare Ltd. v Anaesthetic Supplies Pty. Ltd.* 25 IPR 119). If the applicant identifies a better method at a time subsequent to filing, there is no obligation to amend the specification to include that method. In addition, if the specification does not include the best method, it can be amended to include the best method (as known to the applicant at the time of filing), at least until the time of grant (*Pfizer Overseas Pharmaceuticals v Eli Lilly* [2005] FCAFC 224).

While a specification must include a best method of performance, the specification does not need to recite the words "the best method known to the applicant of performing the invention is ...". There is also no requirement to provide a "best method of performance" that differs in any way from that which is otherwise provided when fully describing the invention. Note that a "best method of performance" need not be a specific exemplification of an invention, simply sufficient instruction for the skilled worker to put the invention into effect.

The question of whether the applicant has provided the best method of performing the invention is necessarily one of fact and evidence, with the knowledge of relevant facts inherently lying with the applicant. The evidence to establish this is almost certainly not available during examination and the earliest an objection that the applicant has not disclosed the best method of performing the invention is likely to arise is during opposition proceedings.

Modified Date: 01 February 2013

2.11.3.4 Enabling Disclosures

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
2.11.3.4 Enabling Disclosures

- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.4A Principles for Examination.

The test for full description was expressed in *Kimberly-Clark v Arico* (2001) 207 CLR 1 (paragraph 25) as:

"... will the disclosure enable the addressee of the specification to produce something within each claim without new inventions or additions or prolonged study of matters presenting initial difficulty?"

Under this test, each claim is separately considered for the purposes of full description, however there is no requirement under Australian law that a claim has to be enabled over its full scope, nor for every possible application of the invention to work or to have been demonstrated to work (see *Photocure v Queen's University* 64 IPR 314 at paragraphs 107 and 149, *Bristol-Myers Squibb Co v F H Faulding & Co Ltd* [2000] FCA 316 at paragraph 77).

For the purposes of sec 40(2)(a), it is not necessary for the inventor to disclose all the alternative means. Provided there is disclosure in the sense of enabling the addressee of the specification to produce something within each claim without new inventions, or additions or prolonged study of matters presenting additional difficulty, the requirements will be met (*Lockwood v Doric* [2004] HCA 58 at paragraph 60). Examiners should consider the specification for the purposes of full description in the light of the common general knowledge in the relevant art at the relevant time, i.e. the date of filing.

Where a claim is extremely broad, but the specification has still enabled one specific embodiment, examiners cannot object to the claim under full description. Note, however, that each claim has to be considered for full description and while the broadest claims may be fully described, narrower claims which fall within the scope of the broadest claims, but which do not encompass the preferred embodiments, could still lack full description.

In a linear chain of dependent claims, the description will be sufficient for all claims in the chain if it is sufficient for the last claim in the chain. However, in the more general situation where the chain of dependency is branched into different sub-sets of claims, the specification will need to provide an enabling description for each of the alternative branches of dependent claims.

Modified Date: 01 February 2013

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Effective Date: 25 September 2019
2.11.3.5 Effort Required to Perform the Invention

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.4.3A Undue Burden.

As expressed in *Kimberly-Clark v Arico* (2001) 207 CLR 1, the test for full description is:

"... will the disclosure enable the addressee of the specification to produce something within each claim without new inventions or additions or prolonged study of matters presenting initial difficulty?"

Therefore, if a person skilled in the art would require a significant period of time and effort to perform the invention as defined in any of the claims, the specification may not meet the requirements for full description.

For example, in *Sabre v Amadeus Global Travel* [2004] APO 21, the issue was whether an invention involving a computer system was fully described in the face of an allegation that it would “take months if not years of design, development and implementation work involving creativity and ingenuity in the analysis and design of the system.”

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**Applying the Test**

The test for full description should be applied to each claim and it may be possible for the disclosure to produce something within the scope of broadest claim, but not a dependent (narrower) claim. In such cases, the broadest claim will be fully described but not the narrower claim.

Consideration should also be given to the normal expectation of the person skilled in the art. For example, the development time for a new pencil sharpener is likely to be much shorter than the development time for a nuclear fusion reactor. If it is apparent from the specification that performance of the invention is likely to take considerably longer than what would be typically expected in the art, an objection of lack of full description should be taken.
This aspect of full description frequently arises in biotechnology inventions, where there may be difficulties in describing the materials adequately, or sufficiently, for reproducibility.

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.4.2A Section 40 Enabling Disclosures (‘Discrete Methods or Products Must be Individually Enabled’).

Where there are several aspects to the invention that are claimed in different claims, it is necessary to fully describe each aspect, such that each claim is supported by an enabling disclosure. However, where one aspect is analogous to another aspect which has been fully described, less detail will be required. Similarly, if it is evident from the common knowledge in the art how to work an aspect of the invention, then less detail is required.

*Vidal Dyes Syndicate Ld v Levinstein Ld* *(1912) 29 RPC 245* at 265-6 provides an example of an invention where one aspect of the invention was not analogous to the other aspects, and there was no common knowledge in relation to that aspect. The Court disregarded the description of the other aspects in assessing whether the particular aspect was fully described. Consequently, the specification was not fully described in so far as it claimed the particular aspect. However, examiners should be careful in applying this approach. The fact that the aspect was not analogous was established by the evidence of experts and was not apparent from the specification.
Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.7A Inclusion of References.

A specification should provide a full description of the invention without reference to other documents. References to provide background information or prior art, or to illustrate subsidiary features, are not objectionable, provided these documents are publicly available. However, it is objectionable under sec 40(2)(a) when a document is explicitly incorporated by reference to avoid describing matter which is required in order to perform the invention in any of the forms that are claimed. For example, a description that referred to feature X, noting that X could be in any form, but preferably in the form disclosed in a cross-reference, would not be objectionable if a claim merely referred to feature X. However, if the claim specified the particular form disclosed in the reference, the absence of relevant description would be objectionable.

Although a cross-reference for the purpose of providing the whole or substantially the whole body of the specification is sufficient for an application to be accorded a filing date (reg 3.5A), an amendment is required to insert the cross-referenced material before the application can be accepted.

Consequential Amendments to the Specification

Amendments which propose to insert the relevant cross-referenced material are generally allowable, provided that if the application is OPI, the cross-referenced document was published on or before the OPI date. If the cross-referenced document is not in English, the amendments will not be allowable unless a verified translation of the cross-referenced document is provided by the applicant (see also 2.29.5 Substitute Documents).

Where another document is referred to for the purposes of a disclaimer, or exclusion of subject matter from a claim, there is no objection to an amendment to the specification to include the cross-referenced material, provided the amendment does not result in the specification claiming new subject matter (see also 2.11.5.6 Cross-References and 2.11.5.8 Disclaimers).
2.11.3.8 Trade Marks in Specifications

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.11.3.8A Trade Marks in Specifications](#).

A trade mark is used to identify the source of origin of a good, not its properties. For example, the composition of laundry detergents sold under a particular trade mark or proprietary name are likely to vary in different regions of Australia (due to differences in the ‘hardness’ of local water supplies), as well as change over time. Identification of a feature that is required in order to perform the invention in any of the forms that are claimed, by way of a trade mark or proprietary name, may not be sufficient to provide a full description of the invention. Where the use of a trade mark introduces uncertainty in relation to the performance of the invention, examiners should object that the invention has not been fully described.

See also [2.11.5.7 Trade Marks in Claims](#).

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2.11.3.9 Colour Drawings and Photographs

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

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A full description of an invention rarely requires the use of colour drawings or photographs. However, an applicant can rely on colour drawings or photographs, despite item schedule 3, item 11. The acceptability of such pages is generally a formality issue that is dealt with by COG, with there being an expectation that the applicant will file black and white drawings if it is at all possible. If colour is strictly necessary, the drawings or photographs will be stored as physical media. Any queries regarding the acceptability (from a reprographics perspective) of colour drawings or photographs should be referred to COG.

See also 2.29.11 Drawings, Graphics and Photographs.

Note: Where colour is important to an invention, use of a standard colour reference chart (such as the Royal Horticultural Society Colour Chart) may be an alternative to using colour drawings or photographs.

For all other standard patent applications/innovation patents, see 2.11.3.10A Claims as Basis of Disclosure.

For the purpose of full description, regard must be had to the claims. As noted in Kimberly-Clark v Arico (2001) 207 CLR 1 (at paragraphs 12-13), the complete specification referred to in sec 40(2)(a) is the whole document inclusive of the claims:

‘The question then is whether the invention has been fully described in the complete specification. The text speaks here of the complete specification, not any one part thereof. From the distinction drawn in s 40(2) between describing the invention in the complete specification and defining the invention in any claims with which the complete specification ends, it does not follow that the description is to be gleaned
solely from one part (the body) and that it is forbidden to obtain any assistance by regard to the remainder (the claims) of the complete specification. Rather, the text indicates that the specification must be read as a whole and that reference to the claims may dispel ambiguity or uncertainty from the body of the specification concerning the description of the invention.’

Where the only disclosure of a relevant feature occurs in the claims, it is proper to have regard to the claims to determine what the invention is, and whether it has been fully described. Note that the mere presence of the feature in a claim does not necessarily establish that the feature has been disclosed. Rather, the specification as a whole, including the claims, must be construed to establish what is disclosed.

To comply with fair basis, a specification may require amendment to incorporate the relevant disclosure into the body of the specification. However, there is no requirement for a claim to have an explicit equivalent in the specification if all the features of the claim can still be read from the specification as a whole (see Photocure v Queen’s University 64 IPR 314 at paragraphs 147-149).

Where the feature referred to in the claim is inconsistent with the disclosure as a whole, it may be that a proper construction of the specification will lead to a conclusion that the feature in the claim has not been disclosed. In such situations, a fair basis objection cannot be overcome by inserting the feature into the description, as that amendment would have the effect of the claim claiming matter not in substance disclosed in the specification as filed.

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.11A Contravention of Laws of Nature - e.g. Perpetual Motion Machines.

In this topic:
In many countries there is a statutory prohibition of inventions which contravene well-known laws of nature, e.g. perpetual motion machines. However, under Australian law there is no such prohibition.

The fact that an invention is apparently contrary to the laws of nature is likely to be manifested in a lack of utility of the invention. However, lack of utility is not a ground of objection available to examiners prior to acceptance.

Other Grounds of Objection

The following objections may be relevant when an invention contravenes the laws of nature:

Full Description

Where an invention contravenes the laws of nature, or is absurd in view of current knowledge, an objection of lack of full description may be applicable. Examiners may raise an objection that the specification does not fully describe the invention, since having regard to the known laws of nature, the invention is not capable of performing in the manner described.

Clarity

The claims may contain terms which do not have a technical meaning and there are no plain English meanings associated with those words that would provide for a credible interpretation in view of current knowledge. In this situation, it is prima facie reasonable to raise a clarity objection. An example would be where the claims are directed to a new form of matter.

Manner of Manufacture

Inventions that contravene the laws of nature may also be claimed in a form that does not fulfill the requirements of a manner of manufacture. An example is where a new law of electric induction is referenced in the claims, or if the claims are directed to mathematical...
equations for new forms of creating energy, or in fact the claims are claiming new forms of matter. An application rejected on these grounds is Milton Edgar Anderson [2008] APO 19.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.12A Relative Terms.

A specification may describe an invention by way of relative terms. This does not usually present a problem with the construction of the specification, provided the skilled addressee can determine what is encompassed by the claims.

In particular, a specification does not lack full description merely because some experimentation of a routine nature is necessary to perform the invention. In Poseidon Industri A.B. v Cerosa Limited (1982) FSR 209, the patent related to a diving suit with a "close fit", such that only a "minimum air layer" could form between the suit and the diver's body. It was held that the patent was not bad for insufficiency, even though the specification made use of a relative term which did not describe how much room there should be between the diver and the suit. In this case, "a little ordinary trial and error" would be sufficient to ascertain the satisfactory minimum layer of air.

See also Catnic Components Limited v Hill & Smith Limited (1982) RPC 183.

Modified Date: 01 February 2013

2.11.3.13 Starting Materials
The starting materials of a chemical process, or ingredients of chemical compositions, must be known compounds. Alternatively, a method of preparation of those compounds from known materials should be either disclosed in the specification or otherwise evident. A statement in the specification that a compound is obtainable, or otherwise known, should generally be accepted. Reference to a compound by a trade name or by another commercial identification, whilst possibly unsatisfactory in other respects, may be considered as a prima facie indication that the compound is known (see also 2.11.3.8 Trade Marks in Specifications).

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.14A Cyclic Inventions.

It is possible for "cyclic inventions" to sometimes occur in concurrent cases, e.g. one specification may describe the preparation of B from A; the other describes the preparation of A from B. Neither specification discloses any other means of preparation of either A or B, both of which are presumed to be new compounds or new classes of compounds, since otherwise one of the inventions may not be novel.

As a general rule, it is not permissible to use one specification to assist in the interpretation of the other, even if filed by the same applicant (Pfizer Inc v Commissioner of Patents [2005] FCA 137). The fact that one specification contradicts the other is not a basis for an objection, as each application stands on its own. Instead, examiners should raise an objection of lack of full description on both applications and seek clarification of the matter.
Specifications relating to biological material are required to satisfy the requirements of full description as for any other technology. However, particular issues can arise with adequately describing the invention in words, or describing it in a manner that it is repeatable.

The Budapest Treaty provides a mechanism whereby the requirements of full description can be met by making a deposit of reproducible biological material with a recognised International Depositary Authority (IDA). Where such a deposit is made, third parties are able to obtain samples of the biological material from the IDA with the approval of the Commissioner. In this way the invention is made available to the public, even though a written description may be inadequate to describe the invention in words and/or in a repeatable manner.

In order for an applicant to rely on the Budapest Treaty mechanism to provide a full description of the invention, the following criteria must be satisfied:

- A sample of the biological material must have been filed with an IDA on or before the filing date of the complete specification;
- The specification must include the characteristics of the biological material;
- The specification must include the name of the IDA and its deposit number by the OPI date; and
- The deposit must have been made with the IDA under the provisions of the Budapest Treaty, such that samples are available under the Rules of that Treaty.

In general, an applicant is not required to use the Budapest Treaty deposit mechanism. However, if:

- the invention relates to the use, modification or cultivation of a specific micro-organism;
2.11.3.16 Distinction Between Lack of Full Description, Inutility and False Suggestion

- performance of the invention requires having a sample of that micro-organism; and
- that micro-organism is not reasonably available to a person in Australia (even if the micro-organism itself is not located in Australia);

the applicant must rely upon the Budapest Treaty deposit mechanism in order to provide a description of the micro-organism ([sec 41(2)]).

**Note:** The Budapest Treaty relates to the deposit of micro-organisms, however the reference to 'micro-organism' is not intended to limit its application only to micro-organisms per se. Rather, it relates to a wide range of biological materials, including bacteria and other procaryotes, fungi (including yeast and mushrooms), algae, protozoa, eucaryotic cells, cell lines, hybridomas, viruses, plant tissue cells, spores, seeds and hosts containing materials such as vectors, cell organelles, plasmids, DNA, RNA, genes and chromosomes.

A full discussion of the particular issues associated with biological inventions, and the Budapest Treaty, is provided in [2.7 Micro-Organisms and Other Life Forms](#).

**Utility**

The ground of utility is only available after acceptance of an application, i.e. in opposition or revocation proceedings. The scope of utility differs significantly between jurisdictions, and some objections raised in Australia under the ground of full description are dealt with in other
jurisdictions as a lack of utility. Hence it is important to have some understanding of the nature of the ground of utility in Australia and its distinction from full description.

In Valensi & Another v British Radio Corporation Ltd. (1973) RPC 337 it was stated that to prove inutility, it is necessary to show that an invention so far as claimed, will not work as described or with any modification which the addressee can properly be expected to make. On the other hand, if a proposed modification which would make the invention work as described, is one which the addressee of the specification cannot be expected to make, then the invention is not fully described.

In Tetra Molectric Ltd.'s Application (1977) RPC 290 at page 297, the Court of Appeal distinguished inutility and lack of full description simply, by stating that:

"If you cannot achieve the promised result because of deficiencies in the information given in the specification, there is (lack of full description). But if, following that information and having achieved mechanically that which the specification promises you will achieve by so following it, the end product will not of itself achieve that promise, then that is inutility."

False Suggestion

"False Suggestion" is only available as a ground of revocation and arises if the grant of a patent occurs as a result of a representation that is false. The false representation needs to have been a material factor in the decision to grant the patent. The motives behind the false suggestion are irrelevant. In particular, an intention to make a misrepresentation is not required; the mere fact of the misrepresentation is sufficient (Décor v Dart (1988) 13 IPR 385).

Where an applicant makes representations relevant to the acceptance of an application and an examiner has serious doubts regarding those representations, but is unable to contradict them, the case should be referred to a supervising examiner. Where the supervising examiner is in agreement, the case should be referred to Patent Oppositions.
2.11.3.17 Best Method of Performing the Invention

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed **before** 15 April 2013.
- innovation patents with an examination request filed **before** 15 April 2013.
- innovation patents where the Commissioner decided **before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.17A Best Method of Performing the Invention.

The specification, in addition to fully describing the invention, must include ‘the best method of performing’ the invention. In *American Cyanamid Company v Ethicon Limited* [1979] RPC 215 at page 269, it was stated:

"The Act is intending to protect the public against a patentee who deliberately keeps to himself something novel and not previously published which he knows of or has found out gives the best results, with a view to getting the benefit of a monopoly without giving to the public the corresponding consideration of knowledge of the best method of performing the invention."

Consequently, even if a manner of performing an invention is self-evident, applicants are nevertheless required to set out the best method of performing the invention known to them. This requirement was confirmed by the Full Court of the Federal Court (*Les Laboratoires Servier v Apotex Pty Ltd* [2016] FCAFC 27).

The best method requirement is assessed on the basis of the applicant’s knowledge at the time of filing the complete specification (*Rescare Ltd. v Anaesthetic Supplies Pty. Ltd.*, 25 IPR 119). If the applicant identifies a better method at a time subsequent to filing, there is no obligation to amend the specification to include that method. In addition, if the specification does not include the best method, it can be amended to include the best method (as known to the applicant at the time of filing), at least until the time of grant (*Pfizer Overseas Pharmaceuticals v Eli Lilly* [2005] FCAFC 224).

While a specification must include a best method of performance, the specification does not need to recite the words "the best method known to the applicant of performing the invention is ...". There is also no requirement to provide a ‘best method of performance’ that differs in any way from that which is otherwise provided when fully describing the invention.

The ‘best method of performance’ need not necessarily be a specific example of the invention. Where there are sufficient instructions for the skilled worker to put the claimed invention into effect, the best method requirement will generally be met [note, however, that this is not automatic (*Les Laboratoires Servier supra*)].

The question of whether the applicant has provided the best method of performing the invention is necessarily one of fact and evidence, with the knowledge of relevant facts...
inherently lying with the applicant. The evidence to establish this is almost certainly not available during examination and the earliest that an objection that the applicant has not disclosed the best method of performance of the invention is likely to arise is during opposition proceedings.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.18A At Least One Method Must be Disclosed.

If a specification does not describe any method of putting an invention into effect, an objection of lack of full description should be taken.

In *Samuel Taylor v S.A. Brush Co.* (1950-51) 83 CLR 617, the specification was found to not fully describe the invention as the description of the device did not:

"provide, expressly or impliedly, to a skilled workman any information as to the method of carrying out the invention."

In assessing whether a method has been disclosed, it could be argued that the method of performing the invention would be self-evident to a person skilled in the art. However, sec 40(2) requires the disclosure of the best method known to the applicant. Consequently, this requirement cannot be satisfied by asserting that the method is common general knowledge and therefore need not be stated.

Modified Date: 01 February 2013

**2.11.3.19 Only One Preferred Embodiment is Required**
2.11.3A Clear Enough and Complete Enough Disclosure

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.11.3.19A Only One Preferred Embodiment is Required](#).

There is no obligation on the applicant to describe more than a single preferred embodiment (*Ethyl Corporation v California Research Corp. (1970) AOJP 562*). If more than one method of performance is provided, the better or best method need not be identified.

Furthermore, the method of performance need not include an actual example; it may be described in general terms. Therefore, where the applicant is able to "fully describe" the invention such that the method of performance is implicit, the absence of an example in the specification is not objectionable.

Subsection 40(2)(a) requires that a complete specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.
This provision reflects a fundamental principle of international patent law that, in exchange for the exclusive rights given to the patentee, the patentee must share with the public the information necessary to make and use the invention.

In order to comply with sec 40(2)(a), the complete specification must provide sufficient information to enable the skilled person to perform the invention over the whole width of the claims, without undue burden or the need for further invention. (The Explanatory Memorandum and Biogen Inc. v Medeva PLC [1997] RPC 1 at 48).

The test for a clear enough and complete enough disclosure is as follows:

“The first step is to identify the invention and decide what it claims to enable the skilled person to do. Then one can ask whether the specification enables them to do it.”

Kirin-Amgen Inc v Hoechst Marion Roussel [2004] UKHL 46; [2005] RPC 9 at [103]

Information on applying the test can be found at 2.11.3.4A Principles for Examination.

The requirements of sec 40(2)(a), that the complete specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art, must be satisfied at the time of filing the complete specification. This is the practical effect of sec 102(1), which is that an insufficient disclosure cannot be rectified by adding new matter after the filing date of the application.

Biological Inventions, Budapest Treaty
For inventions involving biological material, the applicant may rely on a deposit under the Budapest Treaty in order to meet the clear enough and complete enough disclosure requirement (see 2.11.3.15A Biological Inventions and the Budapest Treaty and 2.7 Micro-Organisms and Other Life Forms).

A deposit under the Budapest Treaty must be made on or before the filing date of the complete application. However, in order to gain the earliest possible priority date, the deposit should be made on or before the filing date of the priority document.

Late filing of a deposit under the Budapest Treaty cannot be rectified by an extension of time under sec 223 (as there is no relevant time period to be extended), nor overcome by filing a divisional application.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.3 Compliance with Subsection 40(2) is a Question of Fact.

In this topic:

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**Clear Enough and Complete Enough Disclosure**

Although decided in the context of full description, the principles derived from the decisions referred to below are also applicable to whether there has been a clear enough and complete enough disclosure.
The question of whether the complete specification discloses the invention in a manner that is sufficiently clear and complete is one of fact, and whether a specification discloses a method that will actually perform the invention is a matter which can best be determined by receiving evidence from persons skilled in the art. (Principle derived from *Universal Oil Products Co. v Monsanto Co.* (1972) 46 ALJR 658).

If, *prima facie*, the specification would appear to the skilled person to lack a clear enough and complete enough disclosure, the onus of establishing that the invention is described in sufficient detail lies with the applicant. (*The Explanatory Memorandum*).

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**Best Method of Performance**

The best method requirement is assessed on the basis of the applicant’s knowledge at the time of filing the complete specification (*Rescare Ltd. v Anaesthetic Supplies Pty. Ltd.* 25 IPR 119). While a specification must include a best method of performance, the specification does not need to recite the words “the best method known to the applicant of performing the invention is ...”. There is also no requirement to provide a “best method of performance” that differs in any way from that which is otherwise provided when disclosing the invention in a clear enough and complete enough manner. Note that a “best method of performance” need not be a specific exemplification of an invention, simply enough instruction for the skilled worker to put the claimed invention into effect.

The question of whether the applicant has provided the best method of performing the invention is necessarily one of fact and evidence, with the knowledge of relevant facts inherently lying with the applicant. The evidence to establish this is almost certainly not available during examination and the earliest that an objection is likely to arise that the applicant has not disclosed the best method of performing the invention is during opposition proceedings.
Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.4 Enabling Disclosures.

In this topic:

Note: For a summary of the principles underlying clear enough and complete enough disclosure, support and usefulness, see 2.11A Annex B – Summary of the Clear Enough and Complete Enough Disclosure, Support and Useful (Utility) Provisions.

Overview

Subsection 40(2)(a) requires that a complete specification must disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.

The Explanatory Memorandum states that in order to comply with sec 40(2)(a), the complete specification must provide sufficient information to enable the skilled person to perform the invention over the whole width of the claims, without undue burden or the need for further invention. In this context, the ‘whole width of the claims’ should be understood as any embodiment falling within the scope of a claim.

This provision reflects a fundamental principle of international patent law that, in exchange for the exclusive rights given to the patentee, the patentee must share with the public the information necessary to make and use the invention.

A specification that provides a single example of the invention may satisfy the requirements of a clear enough and complete enough disclosure, but only where the skilled person can extend the teaching of the specification to produce the invention across the full width of the claims, without undue burden, or the need for further invention. However, where the claims are broad, it is more likely that the specification will need to give a number of examples, or describe alternative embodiments or variations, extending over the whole scope of the
claims. This ensures that the monopoly extends to that which could reasonably be said to be disclosed and no further.

As noted above, sec 40(2)(a) requires the complete specification, at the filing date, to disclose enough information to enable a person skilled in the art to perform the invention across the whole width of the claims (and not merely in relation to one embodiment amongst several), without undue burden or the need for further invention.

In general, an invention should be disclosed in terms of its structure and function, unless the function of the various parts is immediately apparent. However, in some technical fields (e.g. computers), a clear enough and complete enough disclosure of function may be more appropriate than an over-detailed disclosure of structure.

For inventions involving biological material, the applicant may rely upon the Budapest Treaty in order to meet the clear enough and complete enough disclosure requirement.

It is neither necessary, nor desirable, that the complete specification disclose every minor detail, where these can be derived from the common general knowledge in the art. However, at the filing date, the complete specification must disclose any feature necessary for carrying out the invention as claimed, in enough detail to render it clear and readily apparent how to put the invention into practice.

While it is acceptable that the skilled person would need to use a reasonable amount of trial and error, there must be either adequate instructions in the specification, or basis in the common general knowledge in the art, to lead the skilled addressee towards success, through evaluation of initial failures.

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**Test for Clear Enough and Complete Enough Disclosure**

The test for a clear enough and complete enough disclosure was provided by Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel* [2004] UKHL 46; [2005] RPC 9 at [103], as follows:

“Whether the specification is sufficient or not is highly sensitive to the nature of the invention. The first step is to identify the invention and decide what it claims to enable the skilled person to do. Then one can ask whether the specification enables them to do it.”

The application of this test is summarised below, and further information provided in the sections following.
First Identify the Invention and Decide What it Claims to Enable the Skilled Person to Do

For the purposes of sec 40(2)(a) ‘the invention’ is the claimed invention.

“In order to decide whether the specification is sufficient, it is … first necessary to decide what the invention is. That must be found by reading and construing the claims, in which the inventor identifies what he claims to be his invention.” (Lord Hoffmann in *H. Lundbeck A/S v Generics (UK) Ltd* [2008] EWCA Civ 311; [2008] RPC 19 at [29])

Where a claim is to a product *per se*, the product is the invention. Where a claim is to a process, the invention is working the process. (*H. Lundbeck* [2008] at [27], [30])

In general, for a product by process claim where the product is known, the invention is the process by which the product is made or otherwise obtained (*Kirin-Amgen* [2005] at [109]).

The criteria for an enabling disclosure are the same regardless of the claim type. Where a claim defines a product, process, or product by process, either wholly or in part by the result to be achieved, on its proper construction the claim may encompass a class of products, a class of processes, or a combination of these, respectively. Once a ‘claim by result’ is construed to determine the scope of the invention, the same principles can then be applied to determine whether this type of claim satisfies the requirements of sec 40(2)(a).

Then Ask Whether the Specification Contains an Enabling Disclosure of the Claimed Invention

To constitute an enabling disclosure, the specification must provide sufficient information to enable the person skilled in the art to perform the invention to the full extent of the monopoly claimed.

Where the claim is to a product or products *per se*, this means making or otherwise obtaining the product(s) over the whole scope of the claim (*H. Lundbeck* [2008] at [27], [30], [34]). In the case of a process claim, performing the invention means working the process(es) over the whole scope of the claim (*H. Lundbeck* [2008] at [30], [34]). In general, for a product by process claim, performing the invention will be working the process(es) to make or obtain the product over the whole scope of the claim. In each case, this identifies what the specification must enable the person skilled in the art to do.

In determining whether the disclosure is clear enough and complete enough for the purposes of sec 40(2)(a), the specification must be assessed on its merits, based on a proper construction of the claims and the facts of the case.
A claim to a product that can only have one embodiment (e.g. a single chemical compound), is enabled over its whole scope if the specification provides enough information for the skilled addressee, using the common general knowledge in the art, to make or obtain the product. In this situation, the specification need only disclose one method of producing the product.

However, where the claims encompass discrete (separate) methods or products, each must be sufficiently disclosed and enabled. For example, a class of products or a class of processes will only be enabled if the disclosure teaches the person skilled in the art to make or work the invention in respect of all members of the class (H Lundbeck [2008] at [34]).

The level of disclosure required to enable a statement of claims will vary depending on the facts of the case. The test for an enabling disclosure should not come down to the number of examples provided. Rather, examiners should focus on whether the person skilled in the relevant art, based on the information provided in the specification, can perform the invention across the whole scope of the claims without undue burden, or the need for further invention.

Where the specification discloses a general principle that can be practically applied to make a class of products or to work processes, the level of disclosure required will be less than that required for claims that include a number of discrete products or methods that cannot be made or worked by applying a general principle (Biogen v Medeva [1997] RPC 1 at 48).

Enablement via a Principle of General Application

Where the specification discloses a principle of general application, the claims may be drafted in correspondingly general terms. Thus, examiners need only consider whether the specification discloses a principle of general application when a claim includes a feature drafted in broad general terms.

A ‘principle of general application’ is a general principle that can be practically applied to make a class of products or to work a process, including where the claims define the product or process either wholly or in part by the result to be achieved. Note that for claims to a product with only one embodiment, statements of general principle are for the most part irrelevant.

A feature in the claims defined in general terms will represent a ‘principle of general application’, where it is reasonable to expect (reasonable to predict) that the claimed invention will work with anything that falls within the general term. Claims containing such a feature will be sufficiently enabled if:

- the specification discloses at least one form of, or one application of, the general principle to perform the claimed invention; and
• provides sufficient information for the person skilled in the art to perform alternative applications of the principle in a way that, while not explicitly disclosed, would nevertheless be obvious to the person skilled in the art (T484/92).

Where this is the case, the specification need not exemplify every possible application of the principle.

For further information, the applicable case law and examples, see 2.11.3.4A Section 40 Enabling Disclosures and in particular ‘Principles of General Application’ and 2.11A Annex A – Examples: Subsections 40(2)(a) and 40(3).

Enablement of Discrete Methods or Products

Where the claims include a number of separate or discrete methods or products, the specification must provide sufficient information to enable the person skilled in the art to make or obtain every product, and/or to carry out every method falling within the scope of the claims.

The level of detail and number of examples required will vary depending on the area of technology and the particular invention. Where the claims encompass a broad field, an enabling disclosure may involve one or more generic method(s) of production, or a number of examples or alternative embodiments or variations, sufficient to enable the person skilled in the art to perform the invention over the whole scope of the claims, without undue burden or the need for further invention.

For further information, the applicable case law and examples, see 2.11.3.4A Section 40 Enabling Disclosures and in particular ‘Discrete Methods or Products Must be Individually Enabled’ and 2.11A Annex A – Examples: Subsections 40(2)(a) and 40(3).

Undue Burden or the Need for Further Invention

In considering whether performing the invention would constitute an undue burden, regard should be had to the nature of the invention, and the abilities of the person skilled in the art in which the invention has been made. The question can then be asked whether the specification requires the skilled addressee to carry out tests or developments that go beyond the routine.

Where it is prima facie apparent that the skilled addressee, seeking to perform the claimed invention following the directions in the complete specification, would take considerably longer than would be typically expected in the art given the nature of the invention, and/or that inventive ingenuity would be required, this would constitute an undue burden.
For further information, the applicable case law and examples, see 2.11.3.4.3A Undue Burden and 2.11A Annex A – Examples: Subsections 40(2)(a) and 40(3).

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**Objections Under Sec 40(2)(a)**

Unless examiners are reasonably satisfied, on the balance of probabilities, that the complete specification complies with sec 40(2)(a), the objection should be raised. The objection must include logically sound reasons supporting the assertion that the complete specification does not disclose the claimed invention in a manner which is clear enough and complete enough for the person skilled in the art to perform the invention over the whole width of the claims. The reasoning may, for example, be based on the examiner’s personal knowledge, statements made in the specification, the prior art or other matter on file (e.g. in third party re-examination requests or matter filed under sec 27).

An ambiguity in the claims, where it causes doubt as to the scope of the invention, may lead to an objection under sec 40(2)(a) that the invention has not been enabled over the whole width of the claims. However, in extreme cases where the scope of the claims cannot be determined, it may be preferable to object to a lack of clarity in the claims, and reserve examination under sec 40(2)(a) and/or sec 40(3) until the clarity objection has been resolved.

**Note:** Although a deficiency may lie predominantly in the clarity or the completeness of the disclosure, objections under sec 40(2)(a) should use the phrase ‘clear enough and complete enough disclosure’.

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**Considering a Response to an Objection Under Sec 40(2)(a)**

A mere assertion will not be enough to overcome a well-reasoned objection under sec 40(2)(a). However, where the applicant provides evidence or credible and plausible submissions that adequately address the examiner’s concerns by establishing that, on the balance of probabilities, the disclosure is clear enough and complete enough, the objection should be withdrawn.
2.11.3.4.1A Clarity of Disclosure

Objections under sec 40(2)(a) cannot be overcome by the addition of new matter extending beyond that disclosed by the specification as filed (together with other prescribed documents), since this is prohibited under sec 102(1) (see 2.23.8A Allowability Under Section 102(1)). However, an objection to an excessive breadth of the claims may be remedied by restricting the scope of the claims. If a proposed amendment restricting the claims is not otherwise allowable under sec 102, a standard patent application cannot be accepted and an innovation patent cannot be certified.

Where an issue is not resolved despite subsequent adverse reports, the supervising examiner should consult Patent Oppositions on the further progress of the case, including whether to set the matter for hearing with the intent to refuse the application.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.4 Enabling Disclosures.

The disclosure of a complete specification will not be clear enough if it is so fundamentally deficient that a person skilled in the art, having read the specification, could not understand how to perform the claimed invention. In these circumstances, it is also unlikely that a reasonable search could be conducted of the invention defined in the claims.

Examiners should only object to the clarity of the disclosure if they become aware of a deficiency during examination. Examiners are not expected to proof-read the specification to identify less fundamental deficiencies in the clarity of the disclosure, such as those detailed below.

No objection should be taken under sec 40(2)(a) merely because it is possible to describe an invention more clearly.

A specification should not contain superfluous or irrelevant matter. Complicated mathematical calculations and analyses are undesirable, unless they are necessary for a full
understanding of the invention. However, only in the most extreme cases should the applicant be requested to shorten an inordinately long specification.

The description should not contain passages which confuse the scope of the invention. However, phrases such as “the invention should be taken to include any modifications, whether novel or not” do not provide a meaningful disclosure of any subject matter and should be construed as such.

Where parts of the description or particular drawings, graphics or photographs do not exemplify the invention claimed, e.g. where they are included as explanation of the invention, as comparative examples, or where they relate to prior art, this should be clearly indicated.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.4 Enabling Disclosures.

In this topic:

Overview

Both sec 40(2)(a) and sec 40(3) require the specification to provide an enabling disclosure of the claimed invention. Under sec 40(2)(a), the clear enough and complete enough (enabling) disclosure must be found in the complete specification. In contrast, for sec 40(3), the enabling disclosure supporting the claims must be found in the body of the specification (the description and any drawings, graphics and photographs and sequence listing).
The enabling disclosure required for sec 40(2)(a) and sec 40(3) overlaps with, but is not exactly the same as, the enabling disclosure required in a novelty citation. For novelty purposes, the person skilled in the art has no knowledge of the claimed invention, and consequently the enabling disclosure must provide ‘clear and unmistakable directions’ to do what is claimed. In contrast, for sec 40, the person skilled in the art has read the specification, knows what is claimed and consequently, what is to be achieved. A sec 40 enabling disclosure is one that provides the person skilled in the art with sufficient information to achieve what is claimed, without undue burden or the need for further invention.

In Biogen v Medeva [1997] RPC 1 at 48 Lord Hoffmann explained the concept of an enabling disclosure:

“… the specification must enable the invention to be performed to the full extent of the monopoly claimed. If the [specification] discloses a principle capable of general application, the claims may be in correspondingly general terms. The [applicant] need not show that he has proved its application in every individual instance. On the other hand, if the claims include a number of discrete methods or products, the [applicant] must enable the invention to be performed in respect of each of them.”

For the purposes of sec 40(2)(a) and sec 40(3) ‘the invention’ that must be enabled is the invention defined by the claims (see 2.11.3.4A Principles for Examination and in particular ‘First Identify the Invention and Decide What it Claims to Enable the Skilled Person to Do’).

‘Principles of general application’ and ‘discrete methods or products’ and the need for the specification to disclose all features necessary for carrying out the invention are discussed more fully below.

Principles of General Application

Note: Statements of general principle relate mainly to inventions with many embodiments and are for the most part irrelevant to an invention which consists of a single embodiment, such as a single chemical compound (Generics (UK) Limited and others v H Lundbeck A/S [2009] UKHL 12; [2009] RPC 13 at [25]).
Where the specification discloses a principle of general application, the claims may be drafted in correspondingly general terms (Biogen v Medeva [1997] RPC 1 at 48). A ‘principle of general application’ is a general principle that can be practically applied in making a class of products, or in working a process, including where the claims define the products or process(es) in terms of the result to be achieved.

Examiners need only consider whether the specification discloses a principle of general application when a feature of a claim is broadly drafted in general terms.

A feature in the claims stated in general terms will represent a ‘principle of general application’, where it is reasonable to expect (reasonable to predict) that the claimed invention will work with anything that falls within the general term. Such a feature defined in general terms may be a major part of the claim, or it may be a humble descriptive word. In either case, a feature in the claims expressed in general terms will be sufficiently enabled if the disclosure enables at least one form of, or one application of, a general principle in respect of the feature, and the person skilled in the art would reasonably expect the invention to work with anything that falls within the general term. (Kirin-Amgen Inc. v Hoechst Marion Roussel Ltd [2005] RPC 9 at [112])

In a simple example, a reference in a claim to ‘connecting means’ will be enabled if the claimed invention can be reasonably expected to work with any means of connection; the applicant does not need to have experimented with all of them. Similarly, in the chemical arts the scope of the general terms ‘leaving group’ or ‘protecting group’ is well understood and an example of one member of the group would normally provide an enabling disclosure for a claim referring to all members.

Where the claims are more broadly drafted they may be considered enabled if, prima facie:

i. the disclosure teaches a principle that the person skilled in the art would need to follow in order to achieve each and every embodiment falling within a claim; and

ii. the specification discloses at least one application of the principle and provides sufficient information for the person skilled in the art to perform alternative applications of the principle in a way that, while not explicitly disclosed, would nevertheless be obvious to the person skilled in the art (T 484/92).

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Discrete Methods or Products Must be Individually Enabled

The disclosure of one method of making a single product with only one embodiment provides an enabling disclosure across the full scope of a claim to the single product per se. An applicant is not required to enable the person skilled in the art to make the same product
2.11.3.4.2A Section 40 Enabling Disclosures

by all possible methods. (Generics (UK) Limited and others v H Lundbeck A/S [2009] UKHL 12; [2009] RPC 13 at [80])

Where the claims include a number of discrete processes or products, the question to be asked is whether the enablement of one provides enablement of the others. Where there are different embodiments, each must be sufficiently disclosed and enabled. (Chiron Corp. and Ors v Murex Diagnostics Ltd and Ors [1996] RPC 535 at 612-613) In this situation, the disclosure of a single embodiment will not always satisfy the requirement for an enabling disclosure (Biogen Inc v Medeva PLC [1997] RPC 1 at 22).

Where the claims encompass a broad field (for example, a broad class of products), an enabling disclosure may involve a number of generic method(s) of production (each enabling different subgroups within the broad field), or a number of examples or alternative embodiments or variations, sufficient to enable the person skilled in the art to perform the invention over the whole scope of the claims, without an unreasonable amount of trial and error.

Claiming by Result

The criteria for an enabling disclosure are the same regardless of the claim type and are not stricter where a claim is limited by the result to be achieved. A claim defining an invention, either wholly or in part by the result to be achieved, should be construed to determine its scope. Properly construed, the claim may encompass, for example, a class of products having particular properties, a class of processes that achieve a particular result, or a combination of these in a product by process claim.

Where a claim defines the invention in terms of desirable results, if on a proper construction of the claim, it encompasses a class of products or processes, the specification will need to provide enough instruction for the skilled person to make each product and/or work all the processes that are encompassed by the claim, without undue burden or the need for further invention (see 2.11.3.4.3A Undue Burden and 2.11.7.6A Claiming by Result).

Individual Features Defined by Function

Where a feature of a claim is defined in functional terms, the person skilled in the art must understand it and be able to implement it (T 568/97).

A claim may broadly define a feature in terms of its function, where only one example of the feature has been explicitly disclosed, provided the skilled addressee would appreciate that other means could be used for the same function. Where a functional feature in a claim encompasses a vast range of possible alternatives, the claim will not be enabled unless the
person skilled in the art would reasonably expect the claimed invention to work with anything that falls within the scope of the functional definition (see ‘Principles of General Application’ above).

Where the claim defines a class of functionally-defined products and the specification teaches a process for making a vast number of products that may or may not have the function as claimed, the disclosure will not be enabling for the claimed invention, unless it teaches the person skilled in the art how to ascertain which of the products actually has the required properties (American Home Products Corp v Novartis Pharmaceuticals UK Ltd [2001] RPC 8 at [39]-[43]). Where a screening method is provided, a further consideration is whether the time required to screen every product would impose an undue burden on the person skilled in the art (see 2.11.3.4.3A Undue Burden).

**Parametric Claims**

Parametric claims are in effect, claims by result and should be examined accordingly. If the claims define the invention, either wholly or partly in terms of parameters, the specification as filed must disclose a means to achieve and/or determine the parameter values, unless a person skilled in the art would know what method to use or all methods would yield the same result.

For example, a claimed product comprises two components, each selected from separate vast lists. To perform the invention, the person skilled in the art is required to select a pair of components to achieve particular desirable characteristics in the final product. In this situation, the specification would lack an enabling disclosure where:

i. the specification contains little or no guidance on how to select a pair of components which would achieve the desired characteristics in the resulting product; and/or

ii. the specification provides no information on how the desirable characteristics could be measured or otherwise determined in a product containing any pair of components.

In such cases, it is relevant to consider whether performing the invention over the whole scope of the claims would impose an undue burden (see 2.11.3.4.3A Undue Burden and 2.11.2.3.12 Parametric Claims).

**Reach-Through Claims**

‘Reach-through’ claims define compounds in terms of specific properties identified in a screening assay. This style of claim is more prevalent in the chemical and biochemical areas, and in many cases such claims will not be enabled.
For further information, see 2.11.7.7A Reach-Through Claims and 2.11 Annex A – Examples: Subsections 40(2)(a) and 40(3).

**Synergism**

Examiners should consider whether a specification provides an enabling disclosure where it claims compositions comprising a ‘synergistic’ combination of two or more compounds.

Synergism between compounds is unpredictable in nature and not all combinations of any two or more compounds will necessarily exhibit this property. Consequently, where the specification claims a synergistic combination and the specification contains little or no guidance on, for example, appropriate concentrations or ratios of the compounds that will provide the synergistic result, it may impose an undue burden on the person skilled in the art to test all possible combinations to determine those that fall within the scope of the claims.

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**Specification Must Disclose the Features Necessary to Successfully Perform the Invention Where These do not Form Part of the Common General Knowledge in the Art**

If a feature in a claim has a limiting effect, but the specification gives no teaching of how the feature is to be achieved, or how the presence or absence of the feature can be determined, and this information does not form part of the common general knowledge in the art, the specification does not provide an enabling disclosure of the invention claimed (Minnesota Mining & Manufacturing Co’s (Suspension Aerosol Formulation) Patent [1999] RPC 135).

**Choice of Components and Starting Materials**

Where a particular component from a broad class or group is necessary to perform the invention as claimed, the specification must identify that component. If the specification merely refers to the broad class or group, the disclosure is not enabling.

The starting materials in a process, or the ingredients in a composition, must be known in the art. If they are not part of the common general knowledge in the art, a method of preparing those starting materials or ingredients from known materials should be disclosed in the specification. A statement in the specification that the starting material/ingredient is obtainable, or otherwise known, should generally be accepted. Reference to a
material/ingredient by a trade name or by another commercial identification, whilst possibly unsatisfactory in other respects, may be considered as a *prima facie* indication that the material/ingredient is known (see also 2.11.3.8A Trade Marks in Specifications).

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**Repeatability (Successful Performance of the Invention Depends on Chance)**

Successful performance of the invention is dependent on chance where the person skilled in the art, following the instructions for carrying out the invention, finds either that the alleged results are unrepeatable or that success is achieved in a totally unreliable way. In this situation, there is a fundamental insufficiency in the description of the invention, such that the complete specification cannot be considered to provide a clear enough and complete enough disclosure.

However, an invention dependent purely on chance should be distinguished from one where repeated success is assured, even though accompanied by a proportion of failures (as can arise, for example, in the manufacture of small magnetic cores or electronic components). In the latter case, provided the ‘successes’ can be readily separated from the failures by a non-destructive testing procedure, the disclosure of the invention will be sufficiently enabling.

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**Note:** The information in this part only applies to:

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- innovation patents with an examination request filed *on or after* 15 April 2013.
- innovation patents where the Commissioner *had not decided* before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.5 Effort Required to Perform the Invention.
2.11.3.4.3A Undue Burden

Overview

Subsection 40(2)(a) requires that the specification must provide sufficient information to enable the skilled person to perform the invention over the whole width of the claims, without undue burden or the need for further invention.

There is little guidance in Australian case law on what is meant by an ‘undue burden’. The following principles are derived from decisions in the UK and Europe.

The disclosure of an invention is not incomplete merely because a reasonable degree of difficulty is experienced in its performance. In seeking to perform the invention, the person skilled in the art may carry out ‘routine trials’ and ‘normal routine matters that they would seek to do and be able to do’, i.e. ordinary methods of trial and error which involve no inventive step - these are generally necessary in applying the teachings of a specification to produce a practical result. However, it would be an undue burden if the person skilled in the art had to undertake prolonged research, enquiry or experiment, or take an inventive step in order to carry out the invention as claimed. ([Eli Lilly & Co. v Human Genome Sciences, Inc. [2008] EWHC 1903(Pat); [2008] RPC 29 at [241]]

Consideration of Undue Burden

In considering undue burden, regard should be had to the nature of the invention, and the abilities of the person skilled in the art in which the invention has been made. Each of these points is discussed further below. The question can then be asked whether the specification requires the skilled addressee to carry out tests or developments that go beyond the routine. ([Eli Lilly & Co. v Human Genome Sciences, Inc. [2008] EWHC 1903 (Pat); [2008] RPC 29 at [241] and Halliburton Energy Services Inc v Smith International (North Sea) Ltd [2006] RPC 2)

Nature of the Invention and the Art in Question

In the context of undue burden, it is necessary to consider the normal expectation of a person skilled in the art wishing to perform the invention disclosed in the specification. For example, the development time for a new pencil sharpener is likely to be much shorter than the development time for a nuclear fusion reactor.

Where the specification is particularly complex, and performing the invention would be expected to be accompanied by a great amount of work, it is necessary to keep a balance
between the interests of the public and the interests of the applicant. In this regard, it is necessary to guard against imposing too high a standard of disclosure merely because the subject matter is inherently complex.

Where the invention involves a new principle of general application (see 2.11.3.4.2A Section 40 Enabling Disclosures) and the claimed technique has broad applicability, if the specification provides an enabling disclosure of one practical application of the principle, implementation of the principle for the purpose of an alternative application may not involve an undue burden. However, this will depend on the facts of the case and be influenced by the extent to which the information in the specification could be used to develop further embodiments without a major conceptual leap. (Kirin Amgen/Erythropoietin II T 636/97 at [4.5])

Abilities of the Person Skilled in the Art and the Art in Question

The person skilled in the art for the consideration of sec 40(2)(a) is the same as for assessing inventive step (see 2.11.2.1 The Addressee).

The degree of skill or knowledge to be expected of the person skilled in the relevant art will naturally depend on the complexity of the art in question. Where the art is especially complicated and difficult, it is inappropriate to consider him to be a workman on the shop floor. Nevertheless, the hypothetical addressee is not a person of exceptional skill and knowledge, he is not expected to exercise any invention nor any prolonged research, inquiry or experiment. He must, however, be prepared to display a reasonable degree of skill and common knowledge of the art in making trials and to correct obvious errors in the specification if a means of correcting them can readily be found. (Valensi & Another v British Radio Corporation, (1973) RPC 337)

If there are actual errors or omissions in the specification, the specification will not provide a clear enough and complete enough disclosure unless the person skilled in the art would recognise that there was an error, or information missing, in the specification, and could rectify this without making further invention. (Eli Lilly and Co v Human Genome Sciences, Inc [2008] RPC 29 at [241] referring to Valensi v British Radio Corporation [1973] RPC 337).

Summary

Where it is prima facie apparent from the specification or any other material on file (e.g. FERs, matter filed under sec 27 or in a re-examination request) that the person skilled in the
art, in trying to perform the claimed invention, would take considerably longer than would be typically expected in the art and/or that inventive ingenuity would be required, this would constitute an undue burden.

2.11.3.7A Inclusion of References

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.7 Inclusion of References.

In this topic:

General

The practical effect of sec 102(1) is that the requirements of sec 40(2)(a) must be satisfied at the time of filing the complete specification.

A specification should provide a clear enough and complete enough disclosure of the claimed invention without reference to other documents. An objection should be taken under sec 40(2)(a) when a document is explicitly incorporated by reference to avoid disclosing matter which is required in order to perform the invention in any of the forms that are claimed.

For example, a description that referred to feature X, noting that X could be in any form, but preferably in the form disclosed in a cross-reference, would not be objectionable if a claim merely referred to feature X. However, if the claim specified the particular form disclosed in the reference, the absence of the relevant disclosure would be objectionable under sec 40(2)(a), and an amendment would be required to insert the relevant cross-referenced material before the application could be accepted.

Cross-references to other documents merely to provide background information or prior art, or to illustrate subsidiary features, are not objectionable provided that:
2.11.3.7A Inclusion of References

- the cross-referenced document(s) contained the information at the filing date of the specification; and
- where the cross-referenced document is a patent document, it was filed on or before the filing date of the specification that refers to it; or
- where the cross-referenced document is a non-patent document, it was publicly available on or before the filing date of the specification referring to it.

Although a cross-reference for the purpose of providing the whole or substantially the whole body of the specification is sufficient for an application to be accorded a filing date (reg 3.5A), an amendment is required to insert the relevant cross-referenced material before the application can be accepted.

Consequential Amendments to the Specification

Where an explicit reference to a document was present in the specification as filed, amendments which propose to insert the relevant cross-referenced material are generally allowable under sec 102(1), provided the material was verifiably present in the referenced document at the filing date of the application under examination (see also 2.29.5 Substitute Documents). The requirements where matter is to be added from a cross-referenced patent and non-patent documents, in order that the complete specification disclose the claimed invention in a clear enough and complete enough manner, are discussed further below (see also 2.23.8A Allowability Under Section 102(1)).

Cross-Referenced Material is a Patent Document (e.g. Provisional or Complete Application, Granted Patent)

The patent document must have been filed on or before the filing date of the application that references the document, if it is to be relied upon to provide a clear enough and complete enough disclosure of the claimed invention. Provided this requirement is met, an amendment to supplement or replace an explicit incorporation by reference (by inclusion of the contents of the document) will generally be allowable.

Cross-Referenced Material is a Non-Patent Document
Incorporation by reference of matter contained in non-patent documents may be problematic, as there may be doubt as to the content of the documents at the filing date of the application under examination.

An amendment to add matter from a non-patent document explicitly incorporated by reference will generally be allowable, provided that:

- the document was publicly available on or before the filing date of the application;
- the matter sought to be added to the specification was present in the document at the filing date of the specification; and
- the content of the referenced document at the filing date can be verified.

Where the referenced material is a document not readily available to examiners, the applicant should be requested to provide a copy. The applicant should also be requested to provide a translation if the cross-referenced document is not in English. (For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided).

Where a reference to an internet page is essential for sufficient disclosure of the claimed invention, a copy of a verifiably-dated web page showing its contents at the filing date must be provided before an amendment can be allowed under sec 102 to add such matter to the complete specification. Similarly, where there is doubt as to the content of any other referenced document at the relevant date, evidence will be required to establish its disclosure at the filing date of the complete specification, before a proposed amendment to explicitly incorporate the matter can be allowed under sec 102.

**Note:** Where the content of a cross-referenced non-patent document is required in order to perform the claimed invention and there is doubt as to its disclosure at the filing date of an application, this may cast doubt on the disclosure of the application, and the allowability of any proposed amendments. In these situations, where the issue has not been resolved despite adverse reports, examiners should consult Patent Oppositions.

### Disclaimers

Where another document is referred to for the purposes of a disclaimer or exclusion of subject matter from a claim, there is no objection under sec 102(1) to an amendment to the specification to include the cross-referenced material, provided the amendment does not result in the specification disclosing or claiming new matter (see also 2.11.5.6A Cross-References and 2.11.5.8 Disclaimers).
2.11.3.8A Trade Marks in Specifications

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.8 Trade Marks in Specifications.

A trade mark is used to identify the source of origin of a good, not its properties. For example, the composition of laundry detergents sold under a particular trade mark or proprietary name are likely to vary in different regions of Australia (due to differences in the 'hardness' of local water supplies), as well as change over time. Identification of a feature that is required in order to perform the invention in any of the forms that are claimed, by way of a trade mark or proprietary name, may not be sufficient to provide a clear enough and complete enough disclosure of the invention. Where the use of a trade mark introduces uncertainty in relation to the performance of the invention, examiners should object that the invention has not been disclosed in a clear enough and complete enough manner.

See also 2.11.5.7A Trade Marks in Claims.

2.11.3.9A Colour Drawings, Graphics and Photographs

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.
A clear enough and complete enough disclosure of an invention rarely requires the use of colour drawings, graphics or photographs. However, the use of colour drawings, graphics or photographs is permitted in certain circumstances (see 2.29 Formalities and Forms and 2.29.11 Drawings, Graphics and Photographs). The acceptability of such pages is generally a formality issue that is dealt with by COG, with there being an expectation that an applicant will file black and white drawings, graphics or photographs if it is at all possible. Any queries regarding the acceptability (from a reprographics perspective) of colour drawings, graphics or photographs should be referred to COG.

**Note:** Where colour is important to an invention, use of a standard colour reference chart (such as the Royal Horticultural Society Colour Chart) may be an alternative to using colour drawings, graphics or photographs.

For all other standard patent applications/innovation patents, see 2.11.3.9 Colour Drawings and Photographs.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.10 Claims as Basis of Disclosure.

For the purposes of sec 40(2)(a), a clear enough and complete enough disclosure of the claimed invention must be found in the complete specification, including the claims. This is in contrast to the sec 40(3) requirement that the claimed invention be supported by the disclosure in the body of the specification, excluding the claims.

When assessing compliance with sec 40(2)(a), the specification must be read as a whole, and regard may be had to the claims to dispel ambiguity or uncertainty from the body of the specification concerning the description of the invention (this principle was provided by the Court in *Kimberly-Clark v Arico* (2001) 207 CLR 1 at 12-13, in the context of full description, however it would also apply to the assessment of clear enough and complete enough

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Effective Date: 25 September 2019
2.11.3.11A Contravention of Laws of Nature - e.g. Perpetual Motion Machines

disclosure; see also *Pfizer Overseas Pharmaceuticals v Eli Lilly and Company* [2005] FCAFC 224 at paragraph 325). It follows that where the only disclosure of a relevant feature occurs in the claims, it is proper to have regard to the claims to determine whether the claimed invention complies with sec 40(2)(a).

However, the mere presence of a feature in a claim does not necessarily establish an enabling disclosure of the claimed invention for the purposes of sec 40(2)(a) – it is necessary to construe the complete specification as a whole to establish what the disclosure enables the person skilled in the art to do. It may be that a proper construction of the specification will lead to a conclusion that the claimed invention has not been disclosed clearly enough and completely enough. For example, an application will not comply with sec 40(2)(a) where:

- a feature referred to only in a claim is inconsistent with the disclosure as a whole; or
- a feature referred to only in a claim does not provide sufficient information to enable the person skilled in the art to perform the invention over the whole width of the claim, without undue burden or the need for further invention (and the feature is not otherwise sufficiently enabled by the common general knowledge in the art).

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**Section 40(3) Issues (Support for the Claims)**

Where a feature appears only in a claim, in order that the claim is supported for the purposes of sec 40(3), an amendment may be required to incorporate the relevant feature into the body of the specification (see 2.11.7A Support for the Claims).

There is no requirement for a claim to have an explicit equivalent in the description or drawings, graphics or photographs if all the features of the claim can be read from the body of the specification (see also *Photocure v Queen’s University* 64 IPR 314 at paragraphs 147-149). However, if the body of the specification contains no disclosure of the feature, either explicitly or implicitly, the claim will only be supported under sec 40(3), if the specification is amended to insert the feature into the description.

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Modified Date: 19 December 2013

**2.11.3.11A Contravention of Laws of Nature - e.g. Perpetual Motion Machines**

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Effective Date: 25 September 2019
Where an invention contravenes the laws of nature, or is absurd in view of current knowledge, an objection of lack of clear enough and complete enough disclosure may be applicable. Examiners may raise an objection that the specification does not disclose the invention in a clear enough and complete enough manner, since having regard to the known laws of nature, the invention is not capable of performing in the manner described.

**Other Grounds of Objection**

Consideration should also be given to whether following objections are relevant when an invention contravenes the laws of nature:

**Usefulness**

The fact that an invention is apparently contrary to the laws of nature is likely to be manifested in a lack of use of the invention; see 2.9.3.4.4A Contravention of Laws of Nature.

**Clarity**

The claims may contain terms which do not have a technical meaning, and there are no plain English meanings associated with those words that would provide for a credible interpretation in view of current knowledge. In this situation, it is *prima facie* reasonable to raise a clarity objection. An example would be where the claims are directed to a new form of matter.
2.11.3.12A Relative Terms

Manner of Manufacture

Inventions that contravene the laws of nature may also be claimed in a form that does not fulfil the requirements of a manner of manufacture. An example is where a new law of electric induction is referenced in the claims, or if the claims are directed to mathematical equations for new forms of creating energy, or in fact the claims are claiming new forms of matter. An example of an application rejected on these grounds is Milton Edgar Anderson [2008] APO 19.

A specification may describe an invention by way of relative terms. This does not usually present a problem with the construction of the specification, provided the skilled addressee can determine what is encompassed by the claims.

In particular, a complete specification does not lack a clear enough and complete enough disclosure merely because some experimentation of a routine nature is necessary to perform the invention. In Poseidon Industri A.B. v Cerosa Limited (1982) FSR 209, the patent related to a diving suit with a "close fit", such that only a "minimum air layer" could form between the suit and the diver's body. It was held that the patent was not bad for insufficiency, even though the specification made use of a relative term which did not describe how much room there should be between the diver and the suit. In this case, "a little ordinary trial and error" would be sufficient to ascertain the satisfactory minimum layer of air.

See also Catnic Components Limited v Hill & Smith Limited (1982) RPC 183.
Although the principles in the above cases were decided under the grounds of “full description”, they apply equally to considerations of clear enough and complete enough disclosure.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.14 Cyclic Inventions.

It is possible for "cyclic inventions" to occur in concurrent cases, e.g. one specification may describe the preparation of B from A; the other describes the preparation of A from B. Neither specification discloses any other means of preparation of either A or B, both of which are presumed to be new compounds or new classes of compounds, since otherwise one of the inventions may not be novel.

As a general rule, it is not permissible to use one specification to assist in the interpretation of the other, even if filed by the same applicant (Pfizer Inc v Commissioner of Patents [2005] FCA 137). The fact that one specification contradicts the other is not a basis for an objection, as each application stands on its own. Instead, examiners should raise an objection of lack of clear enough and complete enough disclosure on both applications and seek clarification of the matter.
Note: The information in this part only applies to:

• standard patent applications with an examination request filed on or after 15 April 2013.
• innovation patents with an examination request filed on or after 15 April 2013.
• innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.15 Biological Inventions and the Budapest Treaty.

Specifications relating to biological material are required to satisfy the requirements of clear enough and complete enough disclosure as for any other technology. However, particular issues can arise with adequately describing the invention in words, or describing it in a manner that it is repeatable.

The Budapest Treaty provides a mechanism whereby the requirements of clear enough and complete enough disclosure of the invention can be met by making a deposit of reproducible biological material with a recognised International Depositary Authority (IDA). Where such a deposit is made, third parties are able to obtain samples of the biological material from the IDA with the approval of the Commissioner. In this way the invention is made available to the public, even though a written description may be inadequate to describe the invention in words and/or in a repeatable manner.

In order for an applicant to rely on the Budapest Treaty mechanism to provide a clear enough and complete enough disclosure of the invention, the following criteria must be satisfied:

• A sample of the biological material must have been filed with an IDA on or before the filing date of the complete specification;
• The specification must include the characteristics of the biological material;
• The specification must include the name of the IDA and its deposit number by the OPI date; and
• The deposit must have been made with the IDA under the provisions of the Budapest Treaty, such that samples are available under the Rules of that Treaty.

In general, an applicant is not required to use the Budapest Treaty deposit mechanism. However, if:

• the invention relates to the use, modification or cultivation of a specific micro-organism;
• performance of the invention requires having a sample of that micro-organism; and
that micro-organism is not reasonably available to a person in Australia (even if the micro-organism itself is not located in Australia);

the applicant must rely upon the Budapest Treaty deposit mechanism in order to provide a description of the micro-organism (sec 41(2)).

**Note:** The Budapest Treaty relates to the deposit of micro-organisms, however the reference to 'micro-organism' is not intended to limit its application only to micro-organisms per se. Rather, it relates to a wide range of biological materials, including bacteria and other procaryotes, fungi (including yeast and mushrooms), algae, protozoa, eucaryotic cells, cell lines, hybridomas, viruses, plant tissue cells, spores, seeds and hosts containing materials such as vectors, cell organelles, plasmids, DNA, RNA, genes and chromosomes.

A full discussion of the particular issues associated with biological inventions, and the Budapest Treaty, is provided in 2.7 Micro-Organisms and Other Life Forms.
Consequently, even if a manner of performing an invention is self-evident, applicants are nevertheless required to set out the best method of performing the invention known to them. This requirement was confirmed by the Full Court of the Federal Court (Les Laboratoires Servier v Apotex Pty Ltd [2016] FCAFC 27).

The best method requirement is assessed on the basis of the applicant’s knowledge at the time of filing the complete specification (Rescare Ltd. v Anaesthetic Supplies Pty. Ltd., 25 IPR 119). If the applicant identifies a better method at a time subsequent to filing, there is no obligation to amend the specification to include that method and such an amendment may not be allowable under sec 102(1) if it would add new matter.

While a specification must include a best method of performance, the specification does not need to recite the words "the best method known to the applicant of performing the invention is ...". There is also no requirement to provide a ‘best method of performance’ that differs in any way from that which is otherwise provided when disclosing the invention in a clear enough and complete enough manner.

The ‘best method of performance’ need not necessarily be a specific example of the invention. Where there are sufficient instructions for the skilled worker to put the claimed invention into effect, the best method requirement will generally be met [note, however, that this is not automatic (Les Laboratoires Servier supra)].

The question of whether the applicant has provided the best method of performing the invention is necessarily one of fact and evidence, with the knowledge of relevant facts inherently lying with the applicant. The evidence to establish this is almost certainly not available during examination and the earliest that an objection that the applicant has not disclosed the best method of performance of the invention is likely to arise is during opposition proceedings.
2.11.3.19A Only One Preferred Embodiment is Required

For all other standard patent applications/innovation patents, see 2.11.3.18 At Least One Method Must be Disclosed.

If a specification does not describe any method of putting an invention into effect, an objection should be taken that the complete specification does not provide the best method known to the applicant of performing the claimed invention.

In Samuel Taylor v S.A. Brush Co. (1950-51) 83 CLR 617, the specification was objectionable as the description of the device did not:

"provide, expressly or impliedly, to a skilled workman any information as to the method of carrying out the invention."

In assessing whether a method has been disclosed, it could be argued that the method of performing the invention would be self-evident to a person skilled in the art. However, sec 40(2)(aa) requires the disclosure of the best method known to the applicant. Consequently, this requirement cannot be satisfied by asserting that the method is common general knowledge and therefore need not be stated.

2.11.3.19A Only One Preferred Embodiment is Required

Note: The information in this part only applies to:

• standard patent applications with an examination request filed on or after 15 April 2013.
• innovation patents with an examination request filed on or after 15 April 2013.
• innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.3.19 Only One Preferred Embodiment is Required.

There is no obligation on the applicant to describe more than a single preferred embodiment (Ethyl Corporation v California Research Corp. (1970) AJOP 562). If more than one method of performance is provided, the better or best method need not be identified.

Furthermore, the method of performance need not include an actual example, if it can be disclosed clearly enough and completely enough in general terms. Therefore, where the applicant provides a clear enough and complete enough disclosure of the invention enabling
2.11.4 Claims Define the Invention

A method of performance, the absence of an example in the specification is not objectionable.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.4A Claims Define the Invention.

A complete specification must end with a claim or claims "defining the invention" (sec 40(2)(b) where it relates to an application for a standard patent and sec 40(2)(c) where it relates to an application an innovation patent). This requires that the claims define the monopoly for which application has been made. Thus, in *AMP v Utilux* (1971) 45 ALJR 123 at page 128, McTiernan J stated:

"The description of the invention is not the definition of it. A claim is a portion of the specification which fulfils a separate and distinct function. It, and it alone, defines the monopoly; and the patentee is under a statutory obligation to state in the claims clearly and distinctly what is the invention which he desires to protect."

Further, the full bench of the High Court indicated on appeal (*Utilux v AMP* (1974) 48 ALJR 17) that:

"the definition of any invention must be found in the claims read with the specification as a whole."

The dictionary to the Act defines ‘invention’ as including an ‘alleged invention’. Accordingly, the novelty or inventiveness of the matter defined by a claim is not a relevant consideration. Rather, it is whether the claim fulfils the statutory purpose of ‘defining the invention’, including an alleged invention.

Similarly, where there is an inconsistency between the invention claimed and the invention described, the objection is not that the claim does not define the invention. Rather, the
2.11.4A Claims Define the Invention

The objection is that the claim is not fairly based on the description (see 2.11.7 Claims are Fairly Based).

The objection of failing to define the invention will typically arise in the following ways:

- Claims of the form 'My invention is worth $1 million dollars', or 'My invention works better than X's invention'. Such claims are most commonly found in private applicant cases.
- Claims that bear no relationship to anything described in the specification.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.4 Claims Define the Invention.

A complete specification must end with a claim or claims "defining the invention" (sec 40(2)(b) where it relates to an application for a standard patent and sec 40(2)(c) where it relates to an application an innovation patent). This requires that the claims define the monopoly for which application has been made. Thus, in *AMP v Utilux* (1971) 45 ALJR 123 at page 128, McTiernan J stated:

"The description of the invention is not the definition of it. A claim is a portion of the specification which fulfils a separate and distinct function. It, and it alone, defines the monopoly; and the patentee is under a statutory obligation to state in the claims clearly and distinctly what is the invention which he desires to protect."

Further, the full bench of the High Court indicated on appeal (*Utilux v AMP* (1974) 48 ALJR 17 ) that:

"the definition of any invention must be found in the claims read with the specification as a whole."
The dictionary to the Act defines ‘invention’ as including an ‘alleged invention’. Accordingly, the novelty or inventiveness of the matter defined by a claim is not a relevant consideration. Rather, it is whether the claim fulfils the statutory purpose of ‘defining the invention’, including an alleged invention.

Similarly, where there is an inconsistency between the invention claimed and the invention described, the objection is not that the claim does not define the invention. In this situation, examiners should consider whether the claimed invention is supported by matter disclosed (see 2.11.7.3A Inconsistency Between the Invention Disclosed and the Invention Claimed).

The objection of failing to define the invention will typically arise in the following ways:

- Claims of the form ‘My invention is worth $1 million dollars’, or ‘My invention works better than X’s invention’. Such claims are most commonly found in private applicant cases.
- Claims that bear no relationship to anything described in the specification.

In order to comply with sec 40(3) the claims must be clear. This does not mandate the use of precise and absolute terms in the claims. As noted by the courts:

“Lack of precise definition in claims is not fatal to their validity, so long as they provide a workable standard suitable to their intended use. The consideration is whether, on any reasonable view, the claim has meaning. In determining this, the expression in question must be understood in a practical, common sense manner. Absurd constructions should be avoided and mere technicalities should not defeat the grant of protection.”

With regard to what constitutes “a workable standard”, consideration should be given to whether a claim provides a reasonable basis by which a third party could, without difficulty, determine whether or not what he proposes to do falls within the scope of the claim. A claim will lack clarity if the standard specified by the terms of the claim would not permit a third party to ascertain whether an act would fall within the scope of the claim (see Monsanto Co v Commissioner of Patents (1974) 48 ALJR 59 at 60).

The claims of a specification are construed according to the rules of construction (see 2.11.2.2 Rules of Construction and 2.11.2.3 Construction of Claims).

Objections of lack of clarity must be taken when it is not possible to reasonably interpret the claims in accordance with the rules of construction.

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**Examination Practice**

Examination provides an opportunity to improve the clarity of claims and thereby reduce the effort required to construe the claims ultimately granted. Thus, although it may be possible to ascribe a meaning to a claim despite the presence of ambiguities and other minor defects, it is frequently desirable, in the interests of customer service, to identify such deficiencies during examination to permit their rectification prior to grant.

In assessing the claims, examination should generally concentrate on the independent claims and those that prima facie add key or significant features and examiners should adopt a practical and common sense approach, avoiding excessive proof-reading of the claims to identify each and every clarity issue.

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**Terms and Language**

Lack of clarity, where present, is often associated with particularly broad terms or language. Where the usage of such broad terms or non-specific language gives rise to a lack of clarity with respect to the scope of the monopoly to which the claim is directed (such as ambiguities, confusion or other difficulties in determining the scope of the claim) that the examiner cannot readily resolve, an objection should be taken (see 2.11.5.9 Imprecise Terms – e.g. “About”).

Examiners should note however, that the mere presence of such terms or language in a claim does not automatically render a claim unclear and so is not objectionable as such. This is because in some cases the nature of the invention justifies a broad monopoly that can be validly and precisely expressed despite the presence of these terms and/or the claim.
2.11.5.1 Length of Claim

language. In such cases the meaning of a specific technical term or feature may be broad and encompass a range of embodiments, but the overall scope of the claim remains well defined and can be readily determined by the reader.

**Spelling, Grammar and Formatting Defects**

Similarly, clarity objections relating to such matters as spelling errors, poor English or formatting defects are only required where examiners consider that their presence hinders or prevents a reasonable determination of the scope of the claims. This may occur where, for example:

- the error becomes significant due to the text affected, such as where a spelling error confuses the nature of a critical feature (e.g. “imino” misspelled “amino”);
- the nature and/or frequency of the error(s) renders the claims difficult to construe (e.g. successive dependant claims spell the same word differently such that the appendancy is obscured); or
- the errors adversely affect the readability of the claim(s) to the extent that interpretation is hindered (e.g. misalignment of labels on diagrams included in the claim to the extent that their points of attachment are unclear).

Where examiners become aware of other defects or clarity issues, these should be raised in the interests of providing good customer service, either as an objection or can be identified in a note, as judged most appropriate by the examiner in the specific circumstances of the case.

Where clarity issues are detected that affect many of the claims within a specification (e.g. as a result of poor translation), examiners may raise an objection based on a general observation accompanied by an example.

Modified Date: 01 February 2013

**2.11.5.1 Length of Claim**

The length of a claim (in itself) is not relevant to the issue of clarity. Claims may vary in length from only one or two words to several pages. The sole question is whether the meaning and scope of the claim can be determined.

Where the length of the claim tends to obscure its meaning, the issue should be dealt with as a lack of succinctness (see **2.11.6 Claims are Succinct**).
2.11.5.2 One Sentence

A claim will usually consist of one sentence. In *Leonard's Application* (1966) RPC 269 it was stated that although one sentence claims are highly desirable, this may not be enforceable in all instances. A claim in the form of disjunctive sentences was held to be ambiguous and not allowable, however an amended claim in nine sentences was ultimately allowed.

Claims consisting of more than one sentence are allowable, provided it is clear from the wording of the claim that all the features of all the sentences must be read in combination.

Single sentence claims comprising a number of separate and distinct paragraphs, where each paragraph may be identified by a letter of the alphabet, by a numeral or by the manner in which it is set out, are not objectionable.

2.11.5.3 Redundant Claims

The fact that a claim is redundant is not in itself a matter that gives rise to a lack of clarity and therefore no objection should be taken on this basis. Examiners should, however, note the claim interpretation issue of a presumption against redundancy and ensure that the relevant claims are properly construed; see 2.11.2.3.2 A Presumption is Made Against Redundancy.

2.11.5.4 Different Combinations of Integers

Where different claims are directed to different combinations of integers, such that there is no common unifying inventive concept, the issue of clarity is limited to whether each of the claims can be properly construed. Such claims should be objected to on the basis of lack of unity (see 2.11.8 Claims Relate to One Invention Only – Lack of Unity).
2.11.5.5 Dictionary Definitions

A specification may rely upon the dictionary principle to provide a special meaning of a term or phrase for the specification and claims. Where the relevant term or phrase is used in the claims, the dictionary definition is necessarily an element of the claims. Accordingly, any lack of clarity in a dictionary definition must be objected to as a lack of clarity in the claims (see also 2.11.2.5 Dictionary Principle).

2.11.5.6 Cross-References

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.5.6A Cross-References.

Where a claim has a reference to matter contained in another specification (Australian or otherwise) or other document that may be amended over time (such as a GenBank entry or a webpage), that claim will not be clear unless the actual matter in question has been incorporated into the specification containing the claim. This is because the wording of any such reference may be subject to change by amendment at any time, without the constraints of sec 102 applying.

**Note:** Where a claim has a cross-reference to a recognised national or international standard (for example AS, ASTM, IEEE), such reference does not give rise to a lack of clarity (see also PCT International Search and Preliminary Examination Guidelines [Part II] Chapter 4, paragraph 4.24).

Special considerations apply to applications for patents of addition (see 2.19.2.1 Examination Practice, ‘Special Considerations’).
In the exceedingly rare situation where the applicant wishes to maintain a cross-reference to another specification (and the application is not for a patent of addition) or other document, relevant considerations are:

a. is the content of the cross-reference permanently fixed? If not, the scope of the claim will be unclear for being indeterminate over time.

b. is the cross-reference readily available in Australia? If not, the scope of the claim will be unclear due to an inability to ascertain the content of the cross-reference.

Note: Where claims define an invention by way of cross-reference to another document, and this definition leads to an inconsistency between the subject matter of the claims and what the specification as a whole describes as the invention, the claims will also lack fair basis.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.5.6 Cross-References.

Where a claim has a reference to matter contained in another specification (Australian or otherwise) or other document that may be amended over time (such as a GenBank entry or a webpage), that claim will not be clear unless the actual matter in question has been incorporated into the specification containing the claim. This is because the wording of any such reference may be subject to change by amendment at any time, without the constraints of sec 102 applying.

Note: Where a claim has a cross-reference to a recognised national or international standard (for example AS, ASTM, IEEE), such reference does not give rise to a lack of clarity (see also PCT International Search and Preliminary Examination Guidelines [Part II] Chapter 4, paragraph 4.24).
2.11.5.7 Trade Marks in Claims

Special considerations apply to applications for patents of addition (see 2.19.2.1 Examination Practice, ‘Special Considerations’).

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a. is the content of the cross-reference permanently fixed? If not, the scope of the claim will be unclear for being indeterminate over time.

b. is the cross-reference readily available? If not, the scope of the claim will be unclear due to an inability to ascertain the content of the cross-reference.

**Note:** Where claims define an invention by way of cross-reference to another document, and this definition leads to a lack of clarity in the claims, the specification may also lack a clear enough and complete enough disclosure of the claimed invention and the claims may lack support.

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Modified Date: 01 February 2013

**2.11.5.7 Trade Marks in Claims**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.5.7A Trade Marks in Claims.

A trade mark or proprietary name is used to identify the source of a good; see 2.11.3.8 Trade Marks in Specifications. A claim that uses a trade mark to identify an element of an invention may not be clear through an inability to establish the precise scope of the claim. Where the scope of a claim is uncertain or ambiguous as the result of the use of a trade mark, examiners should object that the claim lacks clarity.

**Note:** If a trade mark has been used in a claim, it is highly likely that the trade mark will have been similarly used in the description. In this case, an objection of lack of full description may also be relevant (see 2.11.3.8 Trade Marks in Specifications).
2.11.5.7A Trade Marks in Claims

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
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For all other standard patent applications/innovation patents, see 2.11.5.7 Trade Marks in Claims.

A trade mark or proprietary name is used to identify the source of a good; see 2.11.3.8A Trade Marks in Specifications. A claim that uses a trade mark to identify an element of an invention may not be clear through an inability to establish the precise scope of the claim. Where the scope of a claim is uncertain or ambiguous as the result of the use of a trade mark, examiners should object that the claim lacks clarity.

**Note:** If a trade mark has been used in a claim, it is highly likely that the trade mark will have been similarly used in the description. In this case, an objection of lack of clear enough and complete enough disclosure may also be relevant (see 2.11.3.8A Trade Marks in Specifications).

2.11.5.8 Disclaimers

A "disclaimer" is a statement separate from the claims (usually just before the claim pages), declaring that certain matter is to be excluded from them. The words "subject to the foregoing disclaimer" may be present in the preamble to the claims, however the absence of these words is not objectionable. This differs from a proviso, where the matter to be excluded is specified within the text of a claim.

Both disclaimers and provisos are commonly used to distinguish a generic invention from the prior publication of a particular entity that falls within the scope of the generic invention.
2.11.5.9 Imprecise Terms - e.g. "About"

The existence of a disclaimer should be clearly indicated, similar to the situation where a 'dictionary definition' of a term is being relied upon. As a disclaimer modifies the scope of the claims, any lack of clarity in a disclaimer must be reported on as a lack of clarity in the claims.

See *British Celanese Ltd. v Courtaulds Ltd.* (1933) 50 RPC 259 at pages 273 to 284.

Where a disclaimer or proviso makes reference to another patent specification or other document which may be amended over time (such as a GenBank entry or a webpage), the general considerations in relation to references apply (see 2.11.3.7 Inclusion of References and 2.11.5.6 Cross-References).

**Modified Date: 01 February 2013**

### 2.11.5.9 Imprecise Terms - e.g. "About"

Claims frequently contain terms that are imprecise. This does not give rise to an objection of lack of clarity if it is possible to ascertain whether an act would fall within the scope of the claim. This is a practical determination, rather than a strictly literal exercise, and it is acceptable if there is minor uncertainty at the edges of a claim. Thus:

"The court will give little weight to puzzles which may arise 'at the edge of the claim' if those puzzles would not, as a practical matter, cause difficulty for the skilled addressee or manufacturer wishing to satisfy himself that what he proposes to do will not infringe that patent."

*Glaverbel SA v British Coal Corp* [1994] RPC 443 at 495.

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### Examination Practice

Only clarity matters that affect the overall scope of the monopoly should be raised. In general, objections will be restricted to situations where the imprecise terms relate to the inventive concept and the terms would not be understood by the person skilled in the art. Consequently, terms such as "about", "substantially", "approximately", "essentially", "particularly", "preferably", or "for instance" should only be objected to if they cause the ambit of the claim to become uncertain. Similarly, the term "and/or" is not objectionable unless either the "and" or "or" form has uncertain scope.
2.11.5.10 Appendancy Issues

See also 2.11.2.3.8 “Substantially” and “About”.

Case Law

In *Monsanto Company v Commissioner of Patents* (1974) 48 ALJR 59, the term "substantial effect as a cooling medium" was used. It was found that although "substantial" is imprecise, in the facts of the case it did not cause any ambiguity. The judge found that those skilled in the art would have little difficulty in determining when there was a "substantial" effect.

Similarly, in *Catnic Components Ltd v Hill & Smith Ltd* [1982] RPC 183, the term ‘vertical’ in the context used in the specification did not mean exactly vertical.

By way of contrast, in *Shell Internationale Research Maatschappij N.V. v Monsanto Co* (1968) AOJP 2397 the term "predetermined" was used to qualify "amount". It was found that the specification provided no means for determining the amount and there was no evidence that it could be determined as a matter of routine. In this circumstance the claim was not clear.

2.11.5.10 Appendancy Issues

The manner of appending a claim should only be subject to an objection in regard to matters of substance, and not form. The question is whether the scope of the claim can be determined in accordance with the rules of construction. Accordingly, issues arising from the wording of dependencies should not give rise to an objection, unless they impact on the overall scope of the monopoly.

Traditionally, claims are always appended to a numerically preceding claim. While there is no legislative prohibition against a claim being drafted as appended to a subsequent claim, any such appendancy needs to be carefully examined to ensure that there are no circular loops in the chain of appendancy.

The manner in which a claim is appended will warrant an objection if:

a. the appended claim adds features which are inconsistent or contradictory with the claim it is appended to.
For example, if claim 11 is directed to "an apparatus as claimed in any one of claims 1 to 10 in which the condenser ...", and none of claims 1 to 10 are directed to apparatus which explicitly includes a condenser, claim 11 lacks clarity and an objection that there is no antecedent for “the condenser” should be taken (see also PERP codes [E50] and [E51]).

However, if claim 11 is appended to claims 1 to 10, some of which specify a condenser and some of which do not, the lack of clarity in appendancy can be resolved by construing claim 11 as appended only to those claims that explicitly include a condenser. Consequently, while claim 11 is unclear in its appendancy, and the resolution of such issues may assist third parties to understand the scope of any subsequent patent, claim 11 is nevertheless capable of sensible construction and an objection, while not inappropriate, need not be taken. A decision whether to take an objection is a matter of judgement of the examiner taking into account the facts of the case, for example whether similar objections have been raised in the corresponding international phase or in FERs.

b. a claim is dependant upon itself, or to a non-existent claim.

The appendancy in such cases is clearly in error. If the claim to which it is intended to be appended is clearly ascertainable, no objection should be taken. However, if the parent claim cannot be reasonably identified, the scope of the claim is indeterminate and an objection should be taken.

c. the appended claim extends beyond the scope of the claim it is appended to and does not include all the features of the invention of that claim.

For example, if claim 1 is directed to “Product X”, the subject of the claim is X. A subsequent claim of the form of “Machine Y which is able to produce product X according to claim 1 wherein…” has a different subject. It does not include the features of ‘Product X’ and is not truly appended to claim 1.

Note: Guidelines on the approach to adopt where an appended claim includes examples that do not fall within the scope of the claims to which it is appended are provided in 2.11.2.3.6 Appendancies.
2.11.6 Claims are Succinct

- an individual claim is considered unnecessarily lengthy; or
- the statement of claims as a whole is considered unnecessarily lengthy due to the repetitious nature of the claims.

The number of claims is irrelevant to the question of succinctness.

In considering a lack of succinctness objection, examiners should have regard to the fact that drafters will have varying drafting styles. In particular, there can be significant differences arising from the various jurisdictions in which the applicant may be seeking protection. For example, in the US, multiply-dependant claims are not allowed to be dependant upon other multiply-dependant claims, which can result in an increase in the number of claims. Objections of lack of succinctness should not be based on such issues.

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**Case Law**

The principle judicial authority on succinctness is *Bancroft's Application* (1906) 23 RPC 89. In that case there were 23 claims, all independent, claiming various combinations of features.

“We by no means desire to lay it down that the mere number of claims amounts to {lack of succinctness}, for a specification may be such that there are a great many claims, separate in their nature, which are justifiably made … . So long as the statement of each claim is in itself clear and succinct, and so long as there is an absence of repetition in the separate claims, we do not think that {a great many claims gives rise to lack of succinctness}”..

The only Australian judicial precedent on the meaning or scope of the term ‘succinct’ as used in sec 40 is in the lower court judgement in *Doric Products Pty Ltd v Lockwood Security Products Pty Ltd* [2001] FCA 1877:

“I accept that it takes patience, time and effort to unravel all of the claims of the Patent. Subject to the expenditure of that time and effort, there is no alleged ambiguity in the claims. The problem is not with prolixity, but with attempted compression, and the multitude of claims. That, however, falls short of establishing that the claim or claims are not clear and succinct.”

The issue has arisen in hearings before the Commissioner, as follows:


• “It is the right of an applicant to draft his claims so as to protect every aspect of the invention that he has disclosed. This can lead to a large number of claims, and potentially even a large number of independent claims. Whether such a drafting style results in claims that are not clear and succinct is a question of degree, that can only be decided by having regard to the specific claims and the specific description, rather than simply counting the number of claims.” *American National Can v Trigon* [1996] APO 23.

• “… it has long been accepted that claims will not be clear and succinct if their repetitious nature is such the difference in scope between two or more claims is not readily apparent, (see *Bancroft’s Application*, (1906) 23 RPC 89). This situation rarely arises in practice but I think the present application is one such case because of the large number of different combinations of features claimed and the wide variety and ambiguity of the different terminology in the claims that is said to define the same key features. … Consequently I find, in addition to the matters of clarity discussed above, that the claims as a whole are not clear and succinct.” *Sabre v Amadeus Global Travel* [2004] APO 21.

It is noteworthy that decisions almost always refer to succinctness together with clarity, indicating that succinctness may best be considered as a particular form of clarity.

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**2.11.7 Claims are Fairly Based**

Modified Date: 01 February 2013

**2.11.7 Claims are Fairly Based**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7A Support for the Claims.

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Effective Date: 25 September 2019
The statutory requirement of fair basis first occurred with the commencement of the 1952 Act. The High Court has made clear in a number of cases (Olin Corporation v Super Cartridge Co Pty Ltd (1977) 180 CLR 236 at 240, Kimberly-Clark v Arico (2001) 207 CLR 1 and Lockwood v Doric [2004] HCA 58) that authorities decided before the enactment of the 1952 Act should now be treated as being of very limited assistance in the construction of sec 40(3).

The High Court has also stated that United Kingdom decisions after the repeal of the UK 1949 Act in 1977 do not provide any precedent for the interpretation of fair basis in Australian law.

Consequently, cases like Mullard Radio Valve Co Ltd v Philco Radio and Television Corporation of Great Britain Ltd (1936) 53 RPC 323 and Biogen Inc v Medeva plc [1997] RPC 1 (HL), do not provide relevant precedent in Australia.

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.1A Principles for Examination.

In this topic:

Overview

The requirement that the claims be fairly based on the description is a requirement of consistency of the claims with the description or, more particularly, with the invention described.

As noted by the High Court in Kimberly-Clark v Arico (paragraph 12), the general principle underlying fair basis is:
‘... where the issue is one under a 40(3) of "fair basing" of a claim, what the 1990 Act requires is a comparison between the matter described in the specification and the claim which defines the scope of the monopoly.’

In order for a claim to be fairly based, the claims must be consistent with what the specification as a whole describes as the invention. As a consequence, fair basis does not require any evaluation of whether the breadth of the claims exceeds "the technical contribution to the art embodied in the invention". It also does not entail any consideration of whether it is a "patentable invention" under any of the criteria of sec 18, nor any inquiry into "inventive step" or inventive "merit".

Consequently, the test to be followed for fair basis is:

- Having regard to the specification and claims, identify the invention which is described and around which a particular claim is drawn;
- Compare the claim with that invention – as described in the body of the description; and
- Assess whether the claims are consistent with the invention described in the specification, i.e. whether there is a "real and reasonably clear disclosure" of the invention as defined by the features of the claim or whether the claims "travel beyond the subject matter of the invention".

### Applying the Test

The critical analysis for fair basis is to ensure that the specification is construed properly to determine what the specification as a whole considers the invention. Having done this, the step of comparing the invention with the claims to ensure consistency for the purposes of fair basis is straightforward (see 2.11.2 Construction of Specifications and particularly 2.11.2.4 What is the Invention?).

Having determined the invention described in the specification "as a whole", examiners should then consider the claims to determine whether they are consistent with the described invention or whether they "travel beyond the subject matter of the invention described".

Where the invention as claimed is inconsistent with some elements of the description, it is appropriate to raise an objection of lack of fair basis. Once a response has been received, examiners will be able to determine whether the benefit of the doubt should be given to the applicant.
Note that a consistory statement on its own is not sufficient to provide fair basis (see the discussion of *Lockwood* below).

**Examples**


   The title of the specification is “Drainage Cell”. The specification describes a shortcoming in known methods of draining and describes a new device for use as a drainage cell. The Court held that the invention disclosed in the specification was a drainage method (or use of the drainage cell) and not the drainage cell *per se*, despite some conflicting statements to the contrary. Claims directed to the drainage cell *per se* were thus not fairly based.

   This case illustrates the importance of construing the specification carefully. Even though the drainage cell *per se* was described in the specification, the emphasis of the description was to the use of the drainage cell for drainage. Consequently, there was only fair basis for the use of the drainage cell.


   Latch assemblies commonly have features (i)-(v). The consistory statement refers to locks with the additional feature (vi) of an outside actuator that renders the locking means inactive. The Court held that the consistory clause was supported by those parts of the specification describing features that “generally” or “preferably” existed and which, while explaining the invention in detail by reference to the drawings, stressed that they are merely illustrative of how the invention might be put into effect and were not exhaustive. Hence claim 1 in similar terms to the consistory statement was fairly based.

   It is important to note that the consistory statement on its own did not provide fair basis for the claim. However, as the consistory statement was supported by the rest of the description, there was fair basis in the specification as a whole.

3. *PhotoCure v Queen’s University* (2005) 64 IPR 314

   The patent relates to treatment of skin disorders. The consistory statement refers to a wide range of skin disorders, but the examples are limited to 5 disorders and other uses are only “contemplated”. The Court held that the detailed explanation of the further uses indicated that the treatment was directed more broadly than the 5 examples, and provided fair basis for the wide range of disorders.

   This case demonstrates the danger of focussing on one part of the specification alone (in this case the examples).
2.11.7.2 Sub-Tests for Fair Basis

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.2A Subsection 40(2)(a) ‘Clear and Complete Disclosure’ v Subsection 40(3) ‘Support’.

The two sub-tests relevant to the consideration of fair basis are:

1. Is there “a real and reasonably clear disclosure” of the invention in the specification?

   Société Des Usines Chimiques Rhône-Poulenc v Commissioner of Patents (1958) 100 CLR 5 and cited with approval in Rehm Pty Ltd v Websters Security Systems (International) Pty Ltd 11 IPR 289

2. Do the claims travel beyond the subject matter of the invention described in the specification?

   Olin v Super Cartridge (1977) 180 CLR 236

Both sub-tests require that there be consistency between the invention described and that claimed, restating the primary test for fair basis outlined in 2.11.7.1 General Principles.

All three tests preclude examiners from introducing elements of full support, enablement or speculative (“covetous”) claiming into a fair basis objection. As discussed in 2.11.2.4 What is the Invention?, the word “invention” referred to in the context of sec 40 (and referred to in both sub-tests) is the described invention and not the inventive step or the technical advance made by the inventor.

Similarly, the word “real” in “real and reasonably clear disclosure” does not mean that the specification has to provide “real” (enabling) support over the scope of the claims but merely, as noted in Société Des Usines Chimiques Rhône-Poulenc v Commissioner of Patents [supra]:

‘...that the alleged invention as claimed is broadly, that is to say in a general sense, described in the body of the specification’.
2.11.7.3 Relationship Between the Invention Described and the Invention Claimed

Likewise, the words “travelling beyond the subject matter” do not mean that the claims cannot go beyond the technical contribution made by the inventor, nor is it proper to limit the claims based on the disclosures of preferred embodiments (see Lockwood v Doric at paragraphs 69 and 77, Photocure v Queen’s University at paragraph 134).

Such an approach relates to the technical merit of the invention, which is irrelevant for the purposes of fair basis. The statutory use of the word “fair” (in fair basis) refers to consistency between the claims and description, rather than the notion of a “fair reward” for the contribution made by the inventor (McBratney (2005) 16 AIPJ 210 (at page 224)).

2.11.7.4 Only Disclosure is in a Claim

A complete specification must ‘describe the invention fully’ (sec 40(2)(a)). In assessing this requirement, it is necessary to take into account the whole of the complete specification, i.e. both the body of the specification and the claims (Kimberly-Clark Australia Pty Ltd v Arico Trading International Pty Ltd (2001) 207 CLR 1 at 12-13). In contrast, when assessing whether there is fair basis within the meaning of sec 40(3), it is necessary to separate the claims and the body of the specification, in order to determine whether the former are fairly based on the matter described in the latter (Lockwood v Doric [2004] HCA 58 at paragraph 49).
Note: The information in this part only applies to:

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- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.4A Support in View of Proposed Amendments.

Sometimes the only disclosure of a relevant feature occurs in the claims. In this situation, the description may need to refer to the feature for the claims to be fairly based. However, there is no need for an “over-meticulous” verbal analysis requiring the exact reproduction of all the claims in the description. Rather, the specification should be read as a whole to determine whether a feature has been disclosed for the purposes of fair basis (see 2.11.3.10 Claims as Basis of Disclosure).

Note: Where a fair basis objection is raised in these circumstances, it can generally be overcome by amending the specification such that the claims mirror the description. However, where the claims are inconsistent with the specification, it is unlikely that a fair basis objection can be overcome by amending the specification, as this will result in the claiming of matter not in substance disclosed.

2.11.7.5 Alternatives in a Claim

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.5A Alternatives in a Claim.

Claims containing the words "and/or" (or similar expressions giving rise to alternatives) are fairly based only if both the form of claim in which "and" is the operative word and the form of
A claim may define a product by reference to its resulting properties rather than its structure. Under Australian law, claims by result are allowable if the invention described lies in the result itself (in which case the claims can properly define all ways of achieving that result). This principle was stated in *Shave v H V McKay Massey Harris Pty Ltd* (1935) 52 CLR 701:

"When a combination claim states an invention which gives an old result by a new means, the monopoly is limited, at any rate prima facie, to the new means. But when by a new application of principle the inventor has obtained a new result or thing, even when it be done by a combination, he may claim all the alternative means by which the thing or result may be achieved."

In *Lockwood v Doric* (2004) 217 CLR 274, the invention related to a key controlled lock with a double actuating mechanism (dead lock). The court agreed with the trial judge’s findings (paragraph 29) that, on the evidence provided, the principle of releasing the inner actuator when the outer actuator was unlocked was new. The High Court therefore found that such a mechanism was a “new result” and hence claims to any means of achieving that result were fairly based.

Using those same principles, it also follows that where (on a true construction of the specification), the result is a known (or desired) goal, then the invention will not lie in the result itself, but in the means of achieving that result. Claims to “all means” in these cases travel beyond the subject matter of the invention and will not be fairly based.
Note: A claim by result cannot usually be said to lack fair basis merely because it is a claim by result. Such a claim can usually only be objected to for lack of fair basis where the invention described in the specification relates to achieving a well known objective or goal, and the specification describes a particular means of achieving that well known objective or goal.

Claims Not Fairly Based

In *Olin Corporation v Super Cartridge Co Pty Ltd* (1977) 180 CLR 236, the invention disclosed was a particular method of producing a one piece plastic shot shell case having uniform and increased strength in the side walls. The High Court found (at paragraph 47) that the shell case itself had been “recognised generally” to be a necessary or desirable development. The resulting shell case (having particular properties) was therefore not a “new principle” and claims to the shell case itself were not fairly based.

In *Montecatini Edison SpA v Eastman Kodak Co* (1971) 45 ALJR 593 (at page 646), the Court found that it was well known that new polypropylenes with new properties might be produced. The true invention was found to reside in the method of making a new polypropylene using a new catalyst rather than the new propylene itself. Claims to the new polypropylene *per se* (unlimited to the inventive method) were therefore found not to be fairly based.

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- innovation patents with an examination request filed before 15 April 2013.
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For all other standard patent applications/innovation patents, see 2.11.7.7A Reach-Through Claims.
‘Reach-through’ claims define compounds in terms of specified properties identified in a screening method or assay. This style of claim is more prevalent in the chemical and biochemical areas.

**Claims to Reach-Through Compounds per se**

Each specification should be assessed on its own merits, based on a proper construction of the specification and the facts of the case. In general, claims to unspecified ‘identified’ compounds *per se* are speculative. Such claims encompass any compounds identified as possessing the properties being screened for, regardless of whether they have been explicitly disclosed in the specification.

However, the ‘identified’ compound already existed prior to the testing process. Therefore, in the majority of cases, the invention will not reside in the compound itself, but rather in the consequential uses of the compound (based on the properties identified by the screening assay). Thus, claims to the unspecified compound *per se*, merely identified by the screening assay, will travel beyond the subject matter of the invention described in the specification and consequently lack fair basis.

A claimed compound *per se*, which is explicitly identified in the body of the specification, will be fairly based. However, a screening assay does not produce a new compound, it identifies the properties of an existing compound. An objection may be taken that *prima facie* the compounds *per se* lack novelty, because the screening assay does not produce a new compound, it identifies the properties of an existing compound. Examiners are not required to undertake a search in order to locate a novelty citation (see also 2.4.12.1.10 Reach-Through Claims for further information on novelty considerations).

**Claims to the Use of Reach-Through Compounds**

In some circumstances, claims to the downstream uses of functionally defined, but otherwise unspecified ‘identified’ compounds, may be fairly based. Where the invention relates to a new principle, a claim will be fairly based, provided it is restricted to the use of the ‘identified’ (i.e. functionally defined) compounds in a novel and inventive practical application of that principle.
For example, an applicant has discovered that inhibiting the activity of protein X leads to the effective treatment of disease Y and has developed an assay to identify compounds with the inhibitory activity that can be used to treat the disease. In this situation, a claim to all means of inhibiting protein X to treat disease Y would be fairly based, even though only a small number of compounds that inhibit protein X are disclosed.

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- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.8A Claims to Alloys.

In *Mond Nickel Co. Ltd.’s Application* (1948) 65 RPC 123, the invention was a new alloy. Alloys are a well investigated art in which slight changes of constituents or of relative proportions are often known to change the entire character of the resultant alloys. An imprecise claim which was not limited to the actual alloys disclosed in the specification was held to be not allowable on the grounds that it not only claimed the alloys disclosed in the specification, but was drafted sufficiently broadly to include hypothetical equivalent alloys which had not been investigated at all, and, in view of the state of the art, were not part of the invention.

Very small differences in the composition of an alloy can make a large difference in physical properties. Such differences cannot be predicted and hence the invention will reside in specific alloy compositions which have particular desired properties. In these cases, imprecise terms such as “about” or “including”, or including the presence of some undefined alloy components or claiming component amounts outside the described ranges, are not limited to the inventive alloys described. The claims therefore travel beyond the subject matter of the invention and are not fairly based. Note, however, that including a statement in the claim identifying the presence of unavoidable impurities within the alloy is allowed.
2.11.7A Support for the Claims

Note: The information in this part only applies to:

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- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7 Claims are Fairly Based.

General Principles

Subsection 40(3) requires that the claim or claims must be, inter alia, supported by matter disclosed in the specification.

This requirement for support is intended to ensure that there is a basis in the description for each claim, and that the scope of the claims must not be broader than is justified by the extent of the description, drawings and the contribution to the art.

There must also be consistency, or basis, for each claim in the description.

(The Explanatory Memorandum).

Note: An objection under sec 40(3) may not be overcome by adding new matter to the specification, since this is prohibited under sec 102(1). However, an objection under sec 40(3) based on an excessive breadth of the claims may be remedied by restricting the scope of the claims.

2.11.7.1A Principles for Examination
Note: The information in this part only applies to:

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- innovation patents with an examination request filed on or after 15 April 2013.
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For all other standard patent applications/innovation patents, see 2.11.7 Claims are Fairly Based.

In this topic:

Overview

Subsection 40(3) requires that the claim(s) must be supported by matter disclosed in the specification. To comply with sec 40(3), the scope of the claims must not be broader than is justified by the extent of the description, drawings, graphics, photographs, sequence listing and the contribution to the art. This means that:

“… the definitions in the claims [i.e. the claimed invention] should essentially correspond to the scope of the invention as disclosed in the description. In other words, … the claims should not extend to subject-matter which, after reading the description, would still not be at the disposal of the person skilled in the art.” (Generics (UK) Ltd v H Lundbeck A/S [2009] RPC 13 at [36], affirming T 409/01)

The mere mention in the description of features appearing in the claims is not necessarily sufficient support. The word ‘support’ means more than just coincidence of language and requires the disclosure to be the base which supports grant of a monopoly of the width claimed. (Schering Biotech Corp.’s Application [1993] RPC 249 at 252-253)

The applicant is not required to restrict the claims to the specific embodiments described, but the scope of the claims must be properly supported by the matter disclosed in the body of the specification.
Most claims are generalisations of one or more particular examples set out in the specification. The extent of generalisation permissible is a matter which must be judged in each particular case in the light of the relevant prior art. An inventive idea or step which can be practically applied to open up a new field may be claimed more broadly than one which is concerned with advances in a known technology. However, a claim will not be supported for the purposes of sec 40(3) if it is so broad that it encompasses any embodiment that the inventor has not enabled and/or which owes nothing to the teachings of the specification or any principle which it discloses.

Applicants should be allowed to cover all obvious modifications, equivalents to, and uses of, that which they have described in detail. In addition, applicants should be allowed to draft broader claims when it is reasonable to expect (reasonable to predict) that all the variants covered by the claims have the properties or uses ascribed to them in the body of the specification.

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**Consideration of Support**

The proper construction of the specification and claims is fundamental to the consideration of whether the claimed invention is supported by the matter disclosed in the specification (see 2.11.2 Construction of Specifications). Each application should be assessed on its own merits based on a proper construction of the specification and the facts of the case.

In order to determine whether the specification complies with sec 40(3), examiners should:

- construe the claims (see 2.11.2 Construction of Specifications);
- compare the claimed invention with the matter disclosed in the body of the specification (i.e. the description, together with any drawings, graphics, photographs and sequence listing); and
- determine whether, on the balance of probabilities, the specification satisfies the following criteria:
  
  1. The body of the specification must contain an enabling disclosure, i.e. it must disclose the claimed invention in a way which will enable it to be performed by a person skilled in the art without undue burden, or the need for further invention (Asahi Kasai Kogyo KK’s Application [1991] RPC 485 at 536); and
  
  2. The extent of the patent monopoly as defined in the claims must not be broader than is justified by the extent of the description, drawings, graphics, photographs, sequence listing and the contribution to the art.

The principles for examining these criteria are discussed further below.
Enabling Disclosure

Under sec 40(3), the matter in a claim of a specification must be supported by an enabling disclosure in the description and any drawings, graphics, photographs and sequence listing (i.e. the body of the specification).

The level of disclosure required under sec 40(3) is the same as that required for sec 40(2)(a) (Asahi at 536 approved by the House of Lords in Biogen Inc v Medeva Plc [1997] RPC 1 at 49). The principles to be applied in determining whether the specification provides an enabling disclosure are those discussed in 2.11.3.4.2A Section 40 Enabling Disclosures.

Note that references in that part to ‘the specification’ or ‘the complete specification’ should be read as ‘the body of the specification’.

Scope of the Claims Must Not be Broader Than is Justified by the Contribution to the Art

A contribution to the art will broadly be a product or process that is disclosed in the specification, which is novel and inventive (or innovative) and enabled by that disclosure (for further information see 2.11.7.1.1A Contribution to the Art).

The breadth of a claim may exceed the contribution to the art in two ways:

- it may claim results which are not enabled, such as the making of a wide class of products when it enables only one of those products and discloses no principle which would enable others to be made; or

- it may claim every way of achieving a result when it enables only one way and it is possible to envisage other ways of achieving that result which make no use of the invention. (Biogen at 51)

In Biogen at 50, Lord Hoffmann distinguished these two points. The first he described as being whether the disclosure “could, so to speak, deliver the goods across the full width” of the claims (i.e. whether the disclosure enabled the claimed invention). The second point for consideration was “not whether the claimed invention could deliver the goods, but whether the claims cover other ways in which they might be delivered: ways which owe nothing to the teaching of the [specification] or any principle which it disclosed.”

Thus, having considered the question of whether the body of the specification contains an enabling disclosure, examiners should view the claims more broadly and consider whether the scope of the claims encompasses:
• alternative products or processes that the disclosure has not enabled, particularly where there is no principle of general application evident or where the claim defines the invention in terms of the result to be achieved; and/or

• ways of making the product or working the process which owe nothing to the teaching of the specification or any principle it discloses.

This assessment should be made on the basis of the material on file in relation to the application and information available in any FERs. Examiners are not required to search for further information, however if they are aware of a relevant document this may be retrieved.

Objections Under Sec 40(3)

The claims should be considered to satisfy the requirements of sec 40(3) where, prima facie, there is no reason to suppose either that the invention cannot be performed over the whole scope of the claims, or that the claims encompass matter that owes nothing to the teachings or principles disclosed.

Examiners should not raise objections under sec 40(3) based on speculation that an alternative embodiment falling within the scope of the claims, which has not been enabled, may be developed at a later date.

However, unless examiners are reasonably satisfied, on the balance of probabilities, that the claims comply with sec 40(3), the objection should be raised. The objection must include logically sound reasons supporting the assertion that a claim is not supported by an enabling disclosure and/or is broader than is justified by the extent of the disclosure and the contribution to the art.

An objection under sec 40(3) cannot be overcome by adding new matter which would contravene sec 102(1). Therefore, if the applicant cannot otherwise overcome the objection, the claims must be restricted accordingly.

Where the claimed subject matter is not novel and/or does not involve an inventive step, it will be broader than is justified by the applicant’s contribution to the art and, as a consequence, will lack support. However, where the lack of support is wholly a result of the lack of novelty and/or inventive step, examiners need not raise an objection for lack of support, since overcoming the novelty and/or inventive step objection would fully address any objection under sec 40(3).
Establishing Support for the Claims

Where the applicant responds to an objection under sec 40(3) with evidence (e.g. in the form of experimental data, or a statement by a relevant person skilled in the art), or credible and plausible submissions that adequately address the examiner’s concerns, the objection should be withdrawn. However, a mere assertion that the claimed subject matter is supported is not sufficient to overcome a reasoned objection under sec 40(3) (see also 2.11.7.4A Support in View of Proposed Amendments).

Where an issue is not resolved despite subsequent adverse reports, the supervising examiner should consult Patent Oppositions on the further progress of the case, including whether to set the matter for hearing with the intent to refuse the application.

Support in View of Later Developments in the Field of the Invention

A claim may encompass products or processes which involve the use of technology unknown at the time the claim was drafted (Kirin-Amgen Inc v Hoeschst Marion Rousel Ltd [2005] RPC 9 at [80]). Such a claim may subsequently be found to lack support if it encompasses a later product or process that the specification does not enable and which makes no use of the invention it discloses. Examiners may not be aware of such developments during the course of examination, however this type of information may be introduced with third party submissions or a re-examination request.

However, where an improvement is subsequently made to a claimed method which involves an inventive step, although the use of the improvement would still provide a means of working the original invention, the specification does not become insufficient merely because it does not enable the person skilled in the art to make the inventive improvement. For example, if a further invention involving selection of a particular integer falling within a broad term in a claim improves the way the invention works, the original specification is not required to enable the selection. (Kirin-Amgen at [117]-[118], [130])

Modified Date: 01 February 2013

2.11.7.1.1A Contribution to the Art

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Effective Date: 25 September 2019
Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7 Claims are Fairly Based.

An inventor’s contribution to the art lies in what is added to the state of the art as a result of the inventive concept disclosed in the specification, i.e. how far forward has the inventive concept carried the state of the art? One way of identifying the contribution to the art is to determine what is disclosed that is new to the art and not obvious. (Generics (UK) Limited and others v H Lundbeck A/S [2009] UKHL 12; [2009] RPC 13 at [30], [95]) For innovation patents, the references in this part to ‘inventive’ and ‘obvious’ should be read as ‘innovative’.

In effect, the sec 40(3) requirement that the scope of the claims must not be broader than is justified by the inventor’s contribution to the art requires that the claims must be restricted to products and/or processes disclosed in the specification that are novel, inventive and enabled by that disclosure.

A product may be a contribution to the art, even where it is a known and desired goal and/or the only inventive step lay in the method by which it is made (Generics (UK) [2009] at [98]; H Lundbeck A/S v Generics (UK) Ltd [2008] RPC 19 at [36]-[40], [63], [98]).

Prior to acceptance, what the applicant alleges to be the contribution(s) to the art will be apparent from the claims. Where the claims are overly broad and/or define the invention by the result to be achieved, reference to the description may provide an understanding of what the inventor has contributed to the art (see also 2.11.7.6A Claiming by Result).

A discovery does not constitute a ‘contribution to the art’ for the purposes of sec 40(3). A patentable invention is a practical product or process, not information about the natural world (Kirin-Amgen Inc v Hoechst Marion Roussel Ltd [2005] RPC 9 at [77]). However, if a discovery can be practically applied to produce a useful product or process, this may result in a patentable contribution to the art. For example, finding that a length of iron treated in a certain way will always point to the north is a discovery; a practical application of the principle is to make a compass which, if it were novel and inventive, would be a contribution to the art. (Genentech Inc’s Patent [1987] RPC 553 at 566)

Modified Date: 25 February 2019
Subsections 40(2)(a) and 40(3) each require the specification to provide an enabling disclosure of the claimed invention, such that the person skilled in the art can, on the basis of the information disclosed in the application as filed and the common general knowledge in the art, perform the invention over the whole width of the claims, without undue burden or the need for further invention.

Both subsections are concerned with the relationship between the disclosure and the width of the claims. However, sec 40(2)(a) relates to the specification as a whole and the clear enough and complete enough (enabling) disclosure must be in the complete specification. Subsection 40(3) relates to the claims, which must be consistent with and supported by an enabling disclosure in the body of the specification (i.e. the description, together with any drawings, graphics, photographs and sequence listing).

Given the overlap between the enablement requirements of sec 40(2)(a) and sec 40(3), in most cases where the claims are not supported by an enabling disclosure for the purposes of sec 40(3), the specification will also lack a clear enough and complete enough disclosure under sec (40)(2)(a), and vice versa. However, in the rare cases where the only disclosure of a feature occurs in the claims, the complete specification may satisfy the requirements for a clear enough and complete enough disclosure under sec 40(2)(a), but the claims will lack support under sec 40(3) if the body of the specification does not provide an enabling disclosure of the claimed matter.
Where objections on both grounds apply, whether an objection is raised as lack of support, or lack of a clear enough and complete enough disclosure, is not important. Examiners are to use their judgement and may take either objection or both.

Where both objections are raised, examiners may take separate objections, or simply note in a fully reasoned objection under one ground (or in a separate objection) that the reasons provided would also form the basis for an objection under the other ground. Where the reasons in an objection under sec 40(2)(a) or sec 40(3) would also justify an objection under sec 18(1)(c) for lack of usefulness, the same approach may be followed. (This is consistent with the strategy used where objections on the grounds of novelty and inventive step both apply).

If an objection under sec 40(3) arises from a textual inconsistency it is not necessary to also raise or refer to an objection under sec 18(1)(c) for lack of utility. Similarly, if a serious inconsistency is addressed as a lack of utility it is not necessary to also object to a lack of support.

**Note:** An objection under either sec 40(2)(a) or sec 40(3) cannot be overcome by the addition of new matter to the specification, since this is prohibited under sec 102(1) (see 2.23.7A Allowability of Amendments to Complete Specifications). However, either objection may be remedied by restricting the scope of the claims.

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**2.11.7.3A Inconsistency Between the Invention Disclosed and the Invention Claimed**

**Note:** The information in this part only applies to:

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- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.3 Relationship Between the Invention Described and the Invention Claimed.
2.11.7.3A Inconsistency Between the Invention Disclosed and the Invention Claimed

Inconsistencies between the invention claimed and the invention described will result in a lack of support under sec 40(3) where:

1. The description and any drawings, graphics, photographs or sequence listing do not provide sufficient information to enable the person skilled in the art to carry out the claimed invention over its full scope without undue burden or the need for further invention (see 2.11.3.4.2A Section 40 Enabling Disclosures); or

2. While the claimed invention is enabled, there is otherwise a serious inconsistency between what is claimed and the description of the invention and its stated objects and benefits.

Each case must be considered on its merits, based on a proper construction of the specification, particularly the claims.

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**Enabling Disclosure**

Where the body of the specification suggests that a function is to be carried out in a particular way, with no indication that alternative means are envisaged, and a claim encompasses other means, or all means, of performing the function, examiners should consider whether the claim is supported over its full scope (see 2.11.3.4.2A Section 40 Enabling Disclosures).

A claim should be amended to include a necessary feature if, without it, the person skilled in the art could not carry out the claimed invention without undue burden or the need for further invention.

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**Serious Inconsistencies**

A serious inconsistency (other than a lack of enablement) does not arise merely because an invention is claimed more broadly than it is described, for example, because a feature not mentioned in the claims is found in a consistory statement or the described embodiments. However, where it becomes apparent from the information in the body of the specification that a particular feature is missing from the claims that is clearly essential to how the described invention works and achieves its stated benefits, then an objection will be appropriate even if the claim is enabled.
2.11.7.3A Inconsistency Between the Invention Disclosed and the Invention Claimed

For example, where an optical arrangement for an external cavity laser is claimed including an intra-cavity filter, but the invention is described in the body of the specification as achieving a reduced linewidth through the use, as the intra-cavity filter, of a diffraction grating with particular characteristics, then the absence of the particular grating from the claim is a serious inconsistency, and an objection should be raised. Similarly, where a claim is directed to the preparation of a tablet by mixing the ingredients, but the invention is described in the body of the specification as achieving a stable tablet when the ingredients are combined under moist conditions, then the absence of wet processing is a serious inconsistency.

On the other hand, if a claim is directed to a gear arrangement for a vehicle, but is described for use only in a particular application, e.g. bicycles, a lack of support arises only where it is apparent that the gear arrangement will work and achieve the stated benefits only when applied to bicycles.

A serious inconsistency can be addressed where appropriate as a lack of utility. In this case it is not necessary to object to a lack of support. Similarly, where a textual inconsistency is objected to as a lack of support, it is not necessary to object to a lack of utility that may also arise. Examiners are to use their judgment as to the most pertinent objection in the circumstances.

It may be possible to overcome a serious inconsistency by amendment. However, amendment of the description to remove a reference to a feature being essential may only be allowable under sec 102(1) where:

- an independent claim which implies (by omission) that the feature is not essential was present at the date of filing; and
- the applicant can plausibly and credibly demonstrate that it would be clear to a person skilled in the art that the description was incorrect in suggesting that the feature in question was essential in order to perform the claimed invention.

Note: A reference to a feature being one which is clearly ‘essential’ in the context of a serious inconsistency is a feature which is necessary to how the described invention works and achieves its stated benefits.

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Features Disclosed Only in the Claims

Support for the claimed invention must be found in the description and any drawings, graphics, photographs and/or sequence listing. Where a feature appears only in a claim,
with no explicit or implicit disclosure of that feature in the body of the specification, the claim will not be supported even if the claim may itself constitute an enabling disclosure for the purpose of sec 40(2)(a). In this situation, provided that the feature was disclosed in a claim of the application as filed, it is generally permissible to amend the description so that it includes the feature (see 2.23.7A Allowability of Amendments to Complete Specifications).

For example, where the description makes clear that a range of common mechanical fastening means are suitable for use in the invention, but only nuts and bolts are given as an example, a claim that specifies screws will be enabled and does not result in a serious inconsistency. A screw as a common mechanical fastening means is implicitly disclosed. On the other hand, where a claim adds the requirement for all components of the device to be coated in titanium nitride and the description is totally silent on surface treatments, then the claimed invention will not be supported.

Preferred Features or Examples Not Claimed

Where the body of the specification includes preferred features or embodiments of the invention that are not claimed (e.g. comparative examples or embodiments that are excluded from the claims by amendment to overcome objections), this is not a serious inconsistency and it is not necessary to amend the specification to remove this subject matter, unless it casts doubt upon the meaning of the claims (see 2.11.3.10A Claims as Basis of Disclosure).

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.4 Only Disclosure is in a Claim.
In this topic:

In considering amendments, each case should be assessed on its own merits. In general, even where an amendment is proposed that has the effect of narrowing a claim, consideration should be given to whether the proposed claim is supported by the disclosure of the specification as filed, or whether the amendment would add new matter contrary to sec 102(1) (see 2.23.8A Allowability Under Section 102(1)).

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**Narrowing a Numerical Range in the Claims**

**Note:** The following only applies to considerations of support for a proposed amendment to a claim, or a claim of a divisional application.

Insertion of a specific numerical sub-range into a claim, where the sub-range is not explicitly stated in the description, may result in a claim which is not supported by the description. When such amendments are proposed, examiners should consider what the specification as filed disclosed about the ranges; it is not merely a question of looking for any mention of a range, but rather assessing the disclosure in respect of the ranges.

In general, where a proposed amendment to introduce a sub-range represents a choice from a number of alternative values in a broader range disclosed, claims to the sub-range will be supported and the amendment will be allowable under sec 102(1). However, if the applicant submits that a claimed sub-range is a selection from the broader range disclosed, and the body of the specification does not teach that the sub-range has any advantageous properties that would support claims to a selection, the claim as proposed to be amended would lack support. It would also add new matter contrary to sec 102(1).
2.11.7.6A Claiming by Result

• innovation patents with an examination request filed on or after 15 April 2013.
• innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.5 Alternatives in a Claim.

Claims containing the words "and/or" (or similar expressions giving rise to alternatives) are supported by matter disclosed in the specification only if both the form of claim in which "and" is the operative word and the form of claim in which "or" is the operative word are supported by the specification. Where a claim includes multiple instances of "and/or", consideration of all the combinations of features that are possible is required, in order to determine whether the claim is supported.

Note: The information in this part only applies to:

• standard patent applications with an examination request filed on or after 15 April 2013.
• innovation patents with an examination request filed on or after 15 April 2013.
• innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.6 Claiming by Result.

In this topic:

In some circumstances, a claim may define a product in terms of its properties, or define a process in terms of the result to be achieved. Whether such claims are objectionable under sec 40(3) or sec 40(2)(a) should be considered on the basis of a proper construction of the specification and the claims and the particular facts of the case.

The principles for determining whether a claim is enabled by the disclosure of the specification for the purposes of sec 40(2)(a) and sec 40(3) are provided at 2.11.3.4.2A Section 40 Enabling Disclosures. For sec 40(3), the additional principles for determining
What is a Claim by Result?

A claim by result is a claim drafted with reference to the result achieved, rather than the technical features that produce that result, for example:

“An ash tray receptacle which, without the use of movable parts, retains the smoke arising from objects thrown into it.”

These claims are sometimes referred to as “all means claims”, as they claim all means of achieving the result.

Claims by result are directed to a class (of products or processes) that possess the specified properties or features. Difficulties can arise in understanding the full scope of such claims (see also 2.11.7.9A Broad or Speculative Claims in relation to these types of claims).

Consistent with the approach to all other claim types, once the scope of the claim has been determined, there are two questions to consider:

i. whether the specification provides enablement across the scope of the claim; and

ii. whether the claim extends beyond the contribution to the art.

Enablement for Claims by Result

Broad claims by result may be enabled across their whole scope where the result defined in the claims represents a practical application of a principle disclosed in the specification.

However, if the claim extends to subject matter that cannot be performed by application of any principle in the specification, then the claim is not enabled across its full scope. For example, where the problem was simply how to do automatically what could already be done by a skilled workman, the principle applied to solve the problem lay in the way a machine operated. In this case:

“Assuming [the] principle to be new, it might be possible for the inventor, having shown one method of applying it to the solution of the problem, to protect himself for the life of his patent from any other method of applying it for the same purpose, but I do not think
that the novelty of the principle applied would enable him to make a valid claim for all means of solving the problem whether the same or a different principle were applied to its solution.” (Biogen v Medeva Plc [1997] RPC 1 at 50)

It follows that the scope of a claim will not be enabled or supported if it extends further than alternative applications of the principle in a way that, while not explicitly disclosed, would nevertheless be apparent to the skilled addressee who had read the specification (T484/92).

Similarly, for claims comprising a combination of features:

“When a combination claim states an invention which gives an old result by a new means, the monopoly is limited, at any rate prima facie, to the new means. But when by a new application of principle the inventor has obtained a new result or thing, even when it is done by a combination, he may claim all the alternative means by which the thing or result may be achieved [by applying the principle].” (Shave v H V McKay Massey Harris Pty Ltd (1935) 52 CLR 701)

**Breadth of the Claim in View of the Contribution to the Art**

Claims by result must satisfy the same requirements as other claim types with regard to not extending beyond the contribution to the art. That is, under sec 40(3), the breadth of a claim must not be broader than is justified by the contribution to the art. In particular, a claim by result will lack support if it encompasses every way of achieving a result when it enables only one way and it is possible to envisage other ways of achieving that result which make no use of the invention, i.e. ways which owe nothing to the teaching of the specification or any principle it discloses (Biogen v Medeva [1997] RPC 1 at 50-51) (see also 2.11.7.1A Principles for Examination and in particular 'Scope of the Claims Must Not be Broader Than is Justified by the Contribution to the Art').

Claims by result may be objectionable under sec 40(3) and/or sec 40(2)(a) if the specification enables the production of only one member of a class defined by the known desirable properties of the class (H. Lundbeck A/S V Generics (UK) Ltd [2008] EWCA Civ 311; [2008] RPC 19 at [60]). However, this will depend on the particular facts of the case. For example:

“… if a man finds a particular way of making a new substance which is 10 times harder than diamond, he cannot just claim “a substance which is 10 times harder than diamond.” He can claim his particular method and he can claim the actual new substance produced by his method, either by specifying its composition and structure or … by reference to the method … but no more. The reason he cannot claim more is...
that he has not enabled more – he has claimed the entire class of products which have the known desirable properties yet he has only enabled one member of that class. … Such a case is to be contrasted with the [situation] where the desirable end is indeed fully enabled …” (H. Lundbeck at [61])

A claim by result will also be objectionable under sec 40(3) if there is an inconsistency between the invention disclosed and the invention claimed, for example if an essential feature is missing from the claim (see 2.11.7.3A Inconsistency Between the Invention Disclosed and the Invention Claimed).

A claim to all means of achieving an obviously desirable goal may be considered supported for the purposes of sec 40(3), provided that:

- the claim has been enabled over its full scope by the disclosure in the body of the specification; and

- no alternative means can be envisaged to achieve the desired goal, which owe nothing to the teaching of the specification or any principle which it disclosed. (Biogen v Medeva [1997] RPC 1 at 51-52)

Modified Date: 01 February 2013

**2.11.7.7A Reach-Through Claims**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.11.7.7 Reach-Through Claims.

In this topic:

‘Reach-through’ claims define compounds in terms of specified properties identified in a screening method or assay. This style of claim is more prevalent in the chemical and biochemical areas.
Claims to Reach-Through Compounds per se

Each application should be assessed on its own merits, based on a proper construction of the specification and the facts of the case. In general, claims to unspecified ‘identified’ compounds per se are speculative. Such claims encompass any compounds identified as possessing the properties being screened for, regardless of whether they have been explicitly disclosed in the specification.

Enablement for ‘Identified’ Compounds per se

If the relationship between the function of the compounds and their structural features is not defined, screening all compounds to identify those with the desired properties would impose an undue burden in requiring substantial experimentation by trial and error. Therefore, in most cases, claims to unspecified ‘identified’ compounds per se will not be sufficiently enabled over the whole scope of the claim and for this reason will not satisfy the requirements of sec 40(3) or sec 40(2)(a).

A claim to a specified compound per se, which is explicitly disclosed in the specification, may be enabled by that disclosure if sufficient information is provided to make or otherwise obtain the compound.

Compounds per se and the Contribution to the Art

A screening assay does not produce a new compound; it identifies the properties of an existing compound. Prima facie, any compound ‘identified’ by such an assay already existed prior to the testing process and will not be novel. Consequently, where the disclosure is directed to a method of screening known compounds, the contribution to the art will reside, not in the compound per se, but in the consequential uses of the compound (based on the properties identified by the screening assay).

Claims to pre-existing compounds, merely identified as having a particular activity, will be prima facie not novel. In these circumstances, examiners are not required to locate a citation to support the lack of novelty objection. Such claims to identified compounds per se, whether explicitly disclosed in the specification or not, will also be broader than is justified by the applicant’s contribution to the art and will lack support under sec 40(3).
Where overcoming a novelty objection will fully address any objection under sec 40(3), examiners may simply note in the novelty objection (or in a separate objection), either that an opinion under sec 40(3) is reserved, or alternatively that the reasons provided would also form the basis for an objection under sec 40(3) (see also 2.4.12.1.10 Reach-Through Claims for further information on novelty considerations).

Claims to the Use of Reach-Through Compounds

In some circumstances, claims to the downstream uses of functionally defined, but otherwise unspecified ‘identified’ compounds, may be fully enabled. Each application should be assessed on its own merits, based on a proper construction of the specification and the facts of the case.

It is reasonable and necessary under sec 40(3), to limit the subject matter of the claims to the contribution to the art. Where a specification discloses a principle of general application in respect of the use of unspecified ‘identified’ compounds, a claim will be supported, provided it is restricted to the use of the ‘identified’ (i.e. functionally defined) compounds in a practical application of the general principle.

For example, an applicant has discovered that inhibiting the activity of protein X leads to the effective treatment of disease Y. The specification includes data establishing that the treatment is a reality and not just a possibility (see 2.11.7.10A Support Required for Pharmaceutical Inventions and Methods of Treatment), and discloses a screening assay to identify compounds capable of inhibiting the activity of protein X. In this situation, the contribution to the art will lie in the screening assay itself and the method of treating disease Y by inhibition of protein X, provided both are novel and inventive.

Thus, a claim to the use of an inhibitor of protein X to treat disease Y would be enabled over its whole scope for the purposes of sec 40(2)(a) and sec 40(3), even though only a small number of the inhibitory compounds are explicitly disclosed. The reason for this is that the feature ‘inhibitor of protein X’ represents a principle of general application; given the disclosure outlined above, the person skilled in the art would reasonably expect the claimed therapeutic method to work using anything that falls within the scope of the term ‘inhibitor of protein X’.

Consequently, the method will be enabled over the whole scope of the claim where the applicant has exemplified the method of treatment using one such inhibitor. Furthermore, by providing a screening assay, alternative ways of performing the invention are at the disposal of the skilled addressee, which would be apparent upon reading the description, based on his common general knowledge (T 484/92).
Note that a specification relating to a method of treatment containing similar claims (use of an inhibitor of protein X to treat disease Y), but which contains no screening assay, will nevertheless be enabled across the whole scope of the claim where a relevant screening assay would be obvious to the skilled addressee on the basis of the common general knowledge in the art. In this situation, the specification is not required to detail such an assay.

Alloys are a well investigated art in which slight changes of constituents or of relative proportions are often known to change the entire character of the resultant alloys. An imprecise claim not limited to the actual alloys disclosed in the specification would lack support if it not only claimed the alloys disclosed in the specification, but was drafted sufficiently broadly to include hypothetical equivalent alloys which had not been investigated at all, and, in view of the state of the art, were not part of the invention.

Very small differences in the composition of an alloy can make a large difference in physical properties. Such differences cannot be predicted and hence the invention will reside in specific alloy compositions which have particular desired properties. In these cases, imprecise terms such as “about” or “including”, or including the presence of some undefined alloy components or claiming component amounts outside the described ranges, are not limited to the inventive alloys described. Such claims may not be supported by the matter in the specification. Note, however, that including a statement in the claim identifying the presence of unavoidable impurities within the alloy is allowed, provided there is similar disclosure in the body of the specification.
2.11.7.9A Broad or Speculative Claims

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

In this topic:

Each application should be assessed on its own merits, based on a proper construction of the specification and the facts of the case.

An objection for lack of support should be raised where the claims are broad and speculative, in that:

- the scope of the claims extends beyond the disclosure to encompass possibilities, the effects of which cannot readily be predetermined or assessed on the basis of what is described in the body of the specification; and

- the description gives merely an indication of the full breadth or scope of the invention, but no, or inadequate, directions of how to put it into practice across the full width of the claims.

Where a broadly drafted claim is not enabled over its full scope, or if it encompasses matter that is broader than is justified by the contribution to the art, the claim will lack support under sec 40(3).

Some common types of broad claims are as follows:

Reach-Through Claims

Reach-through claims define compounds in terms of specified properties identified in a screening method or assay and are more prevalent in the chemical and biochemical areas. For information on examining reach-through claims in the context of sec 40 see 2.11.7.7A Reach-Through Claims.
Markush Claims

Classical Markush claims provide a convenient means for defining a large number of alternative compounds by way of a generic core structure with defined substituents (see also 1.1.4.4 Markush Practice, 1.1.19 Annex AA Markush Claims and 2.11A Annex A – Examples: Subsections 40(2)(a) and 40(3)).

In order that claims defining a class of compounds in terms of a Markush structure are supported over their whole scope, the body of the specification must provide sufficient information to enable the skilled addressee to make every compound falling within the scope of the claims. Where the activity of the compound is a feature of the claim, the class of compounds must be such that the person skilled in the art would have a reasonable expectation that all of the class members will behave in the same way, in the context of the specification.

Substituents in Chemical Structures

The scope of terms such as ‘leaving group’ and ‘protecting group’ are well understood in the chemical arts. Such terms represent a principle of general application, where the person skilled in the art would reasonably expect the invention to work with anything that falls within the general term. An example of one member of the group would normally provide an enabling disclosure for a claim referring to all members.

Broader terms, such as ‘optionally substituted’ where the substituents are not defined, are unlikely to be supported over their entire scope. An undefined substituent will encompass a diverse range of possibilities which cannot represent an underlying principle of general application. An example of one substituent, or even several examples, cannot enable all others. In the majority of cases, such claims will not be enabled over their full width and the scope of the claims will exceed the contribution to the art, contrary to sec 40(2)(a) and sec 40(3).

Genetic Markers or Biochemical Markers

In the biotechnology field, claims often refer to methods for detecting (for example) physiological and pathological conditions, using two or more of any number of genetic or
biochemical markers. The claims often define a large number of potential markers and possible combinations, where only a few combinations of markers are exemplified. In the absence of relevant examples over the whole scope of the claims and/or an indication of the response of any given marker and marker combination for a specific condition in comparison to controls, the claims are unlikely to be enabled over their full scope and will consequently lack support under sec 40(3). If so, an objection under sec 40(2)(a) will also apply.

Modified Date: 02 March 2015

**2.11.7.10A Support Required for Pharmaceutical Inventions and Methods of Treatment**

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

In this topic:

**Overlap Between Support and Usefulness**

In the context of pharmaceutical inventions and methods of treatment, there is a considerable degree of overlap between the requirements of sec 40(3) and sec 18(1)(c) and sec 18(1A)(c) (useful). In some cases, where the claims are not supported for the purposes of sec 40(3), the claimed invention will not meet the usefulness requirements, and vice versa.

Where objections under both grounds apply, whether an objection is raised as lack of support or lack of usefulness, is not important. Examiners are to use their judgement and may take either objection or both.

Where both objections are raised, examiners may take separate objections, or simply note in a fully reasoned objection under one ground (or in a separate objection) that the reasons provided would also form the basis for an objection under the other ground. Where the
reasons in an objection under sec 40(3) would also support an objection under sec 40(2)(a) (clear enough and complete enough disclosure), the same approach may be followed. (This is consistent with the strategy used where objections on the grounds of novelty and inventive step both apply).

**Note:** Where the claims are not supported for the purposes of sec 40(3) as outlined below, examiners should also consider whether a lack of usefulness objection applies (see 2.9.3.4.3A Therapeutic or Pharmacological Use).

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**Support**

Claims to the use of known pharmaceutical compounds for a new therapeutic use will lack support in the absence of any evidence of the idea working for the new use (*Prendergast’s Applications* [2000] RPC 446). Similarly, even where a pharmaceutical compound *per se* is new, a claim to the therapeutic use of the compound will lack support in the absence of evidence of the therapy working over the whole scope of the use as claimed. In the absence of any such evidence, there will not be a basis in the disclosure for any reasonable expectation that the treatment will work.

Where an application claims methods of treatment, the description should not only identify a condition that may be treated, but also demonstrate by reference to tests that the treatment is a reality and not just a possibility (*Hoermann’s Application* [1996] RPC 341, *Consultant Suppliers Ltd’s Application* [1996] RPC 348). Rudimentary tests will suffice, and full, detailed, rigorous and conclusive testing of a drug for its ability to treat a condition is not necessary (*Prendergast’s Applications* [2000] RPC 446).

Where the treatment of a number of different medical conditions is claimed, the description should demonstrate by relevant *in vivo* or *in vitro* tests that the specified compounds are indeed effective against each of the claimed conditions (*Hoermann’s Application* [1996] RPC 341). Relevant *in silico* tests may also provide support in some circumstances.

The tests that must be disclosed in order to support a claim to a therapeutic method depend on the nature of the invention. The question of support in each case should be considered on its merits. However, ‘rudimentary’ tests may include *in vivo* tests, or *in silico* modelling, that credibly and plausibly demonstrate that the specified compounds possess an activity that could lead to the treatment of a given disorder.

A mere assertion in the specification that a pharmaceutical composition or medicament will treat a medical condition does not provide adequate support for claims to a method of treatment (*Prendergast’s Applications* [2000] RPC 446). Furthermore, a mere statement in
the specification that the claimed invention has been tested will not provide adequate support where no details of the tests are provided (Consultant Suppliers Ltd's Application [1996] RPC 348).

Where there is a well-established link between a physiological process (such as a molecular interaction or biochemical pathway in the body) and a particular disease, tests demonstrating a relevant activity may support claims to the use of a compound for the treatment of diseases associated with the interaction or pathway. For example, disclosure in the body of the specification of in vitro tests demonstrating that a compound restores p53 function will adequately support claims to the use of the compound to treat specified p53-mediated cancer conditions. Similarly, support for the use of a compound to treat diseases caused by harmful prions will be provided by in silico tests that credibly and plausibly demonstrate that a specified compound binds a cavity in a prion protein, thereby stabilising its normal conformation and reducing the amount of harmful prion.

Example

In Consultant Suppliers Ltd's Application [1996] RPC 348, claim 1 was to the:

“Use of a benzoic acid derivative of [a specified general formula] for the treatment of disease by inhibition of nuclear ADP-ribosyl and similar transferase enzymes.”

A dependant claim specified particular diseases to be treated.

The description referred to the medical use and provided some statements indicating that certain compounds had been tested and found to exhibit the specified enzyme inhibiting activity, but no data or details of the testing procedures were provided. In the absence of even rudimentary data regarding the testing done and the results obtained, showing that the claimed therapeutic activity was a reality for each disease falling within the scope of the claims, the claims were not supported.

As a separate issue, the description contained suggestions that not all derivatives falling within the scope of the claims had the specified enzyme-inhibiting activity. In this situation, the term ‘benzoic acid derivative’ in the claims could not represent a principle of general application, because given the statements in the description, it was not reasonable to expect that everything falling within the term had the relevant activity. Since only some of the compounds within the scope of the claims had the activity, and the specification provided no testing procedure to identify the derivatives with the relevant activity (and a procedure was not apparent from the common general knowledge in the art), the claims were not enabled over their full scope and for this reason did not comply with the requirements of sec 40(3) (or sec 40(2)(a)).
The considerations under sec 40(4) as to whether there is more than one invention claimed are the same as for lack of unity under Rule 13 of the PCT Regulations. Examiners are therefore to have regard to the following references, which contain a comprehensive guidance on assessing unity of invention:

- 1.1.4 Unity of Invention;
- PCT International Search And Preliminary Examination Guidelines [Part III] Chapter 10; and
- PCT Administrative Instructions Annex B.

Lack of unity may be directly evident "a priori", that is, before considering the claims in relation to any prior art. Alternatively, lack of unity may only become apparent "a posteriori", that is, after taking (at least some) prior art into consideration.

In considering the prior art for lack of unity a posteriori, examiners are not to take account of subject matter disclosed in any E or P category document.

In assessing whether there is more than one invention claimed, consideration needs to be given to those features ("special technical features" in the PCT guidelines) of the claimed inventions which provide an advance over the prior art. Claims which involve the same "special technical features" will embody the same inventive concept and thus relate to the same invention. Where a claim does not avoid the prior art, its features cannot constitute "special technical features" for the purpose of assessing unity of invention between claims. Examiners should note that in this context "does not avoid the prior art" relates to novelty and inventive step.

Where the claims are considered not to involve the same "special technical feature", and thus are clearly not so linked as to form a single inventive concept, an objection is warranted.

Lack of unity objections should be based on sound reasoning. Care should be taken in not raising objections based on a narrow, literal or academic approach [PCT/GL/ISPE/1 at paragraph 10.04].

Lack of unity is not to be determined with regard to the effort required to examine multiple inventions. If the claimed inventions clearly are not so linked as to form a single inventive
concept, then a lack of unity objection is warranted regardless of the ease of examining the second or subsequent inventions. The degree of additional effort that would be required to examine multiple inventions is only a determinant in whether examiners are to examine the second or subsequent inventions.

A useful starting point for determining lack of unity is to firstly consider what the problem is that the application addresses (see 1.1.4.2 Determining Lack of Unity).

For lack of unity considerations with regard to examination approach and the level of detail required in a report, see:

- 2.1.6.2.4 Lack of Unity; and
- 2.1.9.5 FERs and Lack of Unity.

2.11.9 Title of the Specification

A specification must commence with a short and precise title, however no objection is to be taken if the title is inadequate.

Applicants can amend the title of a specification, and the title indicated on the patent request, under sec 104. For national phase cases, any request to amend the title on the front page of the PCT pamphlet will be treated as a request to change the record in the PAMS bibliographic data (see 5.10.15.9 Pamphlet Title Change for the procedures to be followed).

**Title Appearing on the Certificate of Grant**

The title of the invention that is used in preparing the certificate of grant is that appearing on the patent request. In the case of national phase applications, it is the title appearing on the front page of the pamphlet. Therefore, in order to amend the title that will appear on the certificate, applicants will need to amend the title on the patent request or, for national phase cases, amend the title in the PAMS bibliographic data (as the front page of the PCT pamphlet is not a filed document).

**Note:** Examiners should be aware that when applicants request an amendment to the title, they almost certainly have an expectation that the amended title will appear on the certificate of grant. If a request to amend the title does not include amending the title on the patent...
2.11.9.1 Consistency of Title in the Documents

Historical Note: In the early 19th century, the title was extremely important as patents were frequently granted on the basis of the title of the invention alone; there was no written description. During most of the 20th century, the title had value as an aid to searching paper files. However, now the title serves little purpose beyond being broadly indicative of the subject of the invention.

Modified Date: 15 April 2013

2.11.9.1 Consistency of Title in the Documents

There should be substantial identity between the title in the complete specification and other documents in the case file, in order to establish that the documents relate to the one application. If this relationship can otherwise be clearly established, the mere fact that the title is different on different documents does not give rise to an objection. However, the title that will appear on the certificate of grant will be taken from the patent request or front page of the PCT pamphlet and not any other document (see 2.11.9 Title of the Specification).

Examiners have no authority to change the titles on any documents following a change introduced on another document under the provisions of sec 104, or reg 10.1. Corresponding amendments of other titles may be requested by the applicant under the appropriate provision of the Act. Where the original titles were in conformity with one another, there is no objection to subsequently introduced differentiations, provided the specification commences with a title.

Modified Date: 01 September 2015

2.11.10 Provisional Specifications

Note: The information in this part only applies to provisional applications filed before 15 April 2013. For all other provisional applications, see 2.11.10A Provisional Specifications.

Section 45 does not specifically require examiners to report on a provisional specification. However, reference to, or analysis of, the provisional specification may be required in connection with the following matters:
Section 45(1)(c)

The priority date provisions set out in reg 3.12 (reg 3.13C)* in relation to provisional specifications are relevant where the case under examination, or possible citations, or both, have been associated with a provisional specification. If the priority date becomes important during examination, examiners should check the patent request of the complete application to confirm that the provisional is identified and contains a statement to the effect that the applications are associated (sec 5).

*Note: Regulation 3.13C only applies where the provisional specification is associated with:

- a standard patent application with an examination request filed on or after 15 April 2013.
- an innovation patent with an examination request filed on or after 15 April 2013.
- an innovation patent where the Commissioner had not decided before 15 April 2013 to examine the patent.

Amendment of Provisional Specifications

A provisional specification may be amended, provided the amendment does not materially alter the meaning or scope of the specification (reg 10.3(1)). In general, the only allowable amendments to a provisional specification are in the category of obvious mistakes, or formatting issues (such as pagination and line numbering). Amendments to alter text, or to insert missing text or missing pages, will almost inevitably materially alter the meaning or scope of the specification. As a result, any change in textual content of a provisional specification (including, potentially, a change in punctuation) is almost certainly not allowable.

See also:

- 2.23.13.8 Amendments to a Provisional Specification; and
- 2.12.2.1 Filing Dates.

Modified Date: 01 September 2015
2.11.10A Provisional Specifications

Note: The information in this part only applies to provisional applications filed on or after 15 April 2013. For all other provisional applications, see 2.11.10 Provisional Specifications.

Section 45 does not specifically require examiners to report on a provisional specification. However, reference to, or analysis of, the provisional specification may be required in connection with the following matters:

Section 45(1)(b)

The priority date provisions set out in reg 3.13C in relation to provisional specifications are relevant where either the case under examination, or possible citations, or both, have been associated with a provisional specification. If the priority date becomes important during examination, examiners should check the patent request of the complete application to confirm that the provisional is identified and contains a statement to the effect that the applications are associated (sec 5).

Amendment of Provisional Specifications

A provisional specification may be amended, provided the amendment does not result in the specification claiming or disclosing matter that extends beyond that disclosed in the following documents taken together (reg 10.3(1)):

- the provisional specification as filed;
- an abstract that was filed with the provisional specification;
- a missing part of the specification that was incorporated into the specification under reg 3.5A.

Thus, an amendment to the specification to insert text from a document that was explicitly incorporated by reference would be allowable. Similarly, amendments that are in the category of obvious mistakes, or formatting issues (such as pagination and line numbering) are also allowable.

However, an amendment that results in the inclusion of matter that extends beyond the disclosure of the documents listed above would not be allowable. Similarly, a change in
punctuation that extended the disclosure (e.g. hose clamp compared with hose, clamp) would not be allowable.

See also:

- [2.23.13.8A Amendments to a Provisional Specification](#); and
- [2.12.2.1 Filing Dates](#).

Modified Date: 01 March 2013

### 2.11.11 Complete Applications Associated with Provisional Applications

**Note:** The information in this part **only** applies to:

- standard patent applications with an examination request filed **before** 15 April 2013.
- innovation patents with an examination request filed **before** 15 April 2013.
- innovation patents where the Commissioner **decided before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.11.11A Complete Applications Associated with Provisional Applications](#).

A complete application associated with one or more provisional applications is an independent application which is subject to examination. It must be self-contained and cannot depend on the provisional specification(s) for its sufficiency (other than cross-references; see [2.11.3.7 Inclusion of References](#)). The text of the complete specification may include new matter, over and above what was disclosed in the provisional specification(s) and conversely, not all material included in the provisional specification(s) must necessarily be repeated in the complete specification. However, pursuant to reg 3.12, in order for claims in the complete specification to derive a priority date from the provisional specification(s), the claims must be fairly based on matter disclosed in the provisional specification(s).

The priority date of a claim is always a question of fact. Where none of the claims in a complete specification are fairly based on matter disclosed in the provisional specification(s), examiners should check whether the provisional application has been correctly identified. If there is no error in the patent request regarding the provisional details, the complete application may proceed. However, any adverse report should note that none of the claims are entitled to derive their priority date from the provisional application.
**Time Limit for Association**

In general, a complete application can only be associated with a provisional application if the complete is filed within 12 months of the filing of the provisional application (sec 38 together with reg 3.10).

However, if the complete is filed outside of this period, an extension of time under sec 223 is required if the complete is to be associated with the provisional application.

**Historical Note**

The terms 'provisional' and 'complete' derive from the manner in which applications were made under the 1903 and 1952 Acts. Under those Acts, an application for a patent was initially accompanied by a provisional specification which was not required to have claims, or a best method of performance of the invention. Subsequently a ‘complete’ specification, i.e. a specification that contained a full description and claims, was filed to ‘complete’ the application. However, the application remained the same (i.e. no new request form was required), even though a new application number was assigned and a new case file created with all of the documents from the original application transferred to the new file. Prior to 1970, the application number for both the application with a provisional specification, and the completed application with a complete specification, were part of the 5-figure application series. In 1970, a number series specific to applications with provisional specifications was introduced (PXnnnn), which remained in place until 2003. As the filing of a complete specification to complete an application did not constitute a new application, the 1903 and 1952 Acts included the concepts of ‘cognates’ (for combining the disclosures of two or more applications with provisional specifications), ‘decognition’ (for separating inappropriately cognated applications) and for divisional applications derived from a provisional specification.

The 1990 Act changed the nature of provisionals, by making them applications in their own right, i.e. they became a stand-alone internal priority document. Complete applications could
claim priority from such applications in the same manner as claiming priority from a basic
application, with the one difference being that the provisional application must not have
lapsed when the complete application was filed. Concepts of cognates, and of divisionals
based on the provisional specification, ceased with the 1990 Act.

2.11.11A Complete Applications Associated with Provisional Applications

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to
  examine the patent.

For all other standard patent applications/innovation patents, see 2.11.11 Complete
Applications Associated with Provisional Applications.

A complete application associated with one or more provisional applications is an
independent application which is subject to examination. It must be self-contained and
cannot depend on the provisional specification(s) for its sufficiency (other than cross-
references; see 2.11.3.7A Inclusion of References). The text of the complete specification
may include new matter, over and above what was disclosed in the provisional
specification(s) and conversely, not all material included in the provisional specification(s)
must necessarily be repeated in the complete specification. However, pursuant to reg
3.13C, in order for claims in the complete specification to derive a priority date from the
provisional specification(s), the provisional specification(s) must provide a sufficiently clear
enough and complete enough disclosure of the claimed invention such that it can be
performed by a person skilled in the relevant art.

The priority date of a claim is always a question of fact. Where none of the claims in a
complete specification are sufficiently enabled by matter disclosed in the provisional
specification(s), examiners should check whether the provisional application has been
correctly identified. If there is no error in the patent request regarding the provisional details,
the complete application may proceed. However, any adverse report should note that none
of the claims are entitled to derive their priority date from the provisional application.
Note: A provisional application is an internal priority document analogous to a basic application. Accordingly, a Convention application may also be associated with a provisional application.

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Time Limit for Association

In general, a complete application can only be associated with a provisional application if the complete is filed within 12 months of the filing of the provisional application (sec 38 together with reg 3.10).

However, if the complete is filed outside of this period, an extension of time under sec 223 is required if the complete is to be associated with the provisional application.

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Historical Note

The terms ‘provisional’ and ‘complete’ derive from the manner in which applications were made under the 1903 and 1952 Acts. Under those Acts, an application for a patent was initially accompanied by a provisional specification which was not required to have claims, or a best method of performance of the invention. Subsequently a ‘complete’ specification, i.e. a specification that contained a full description and claims, was filed to ‘complete’ the application. However, the application remained the same (i.e. no new request form was required), even though a new application number was assigned and a new case file created with all of the documents from the original application transferred to the new file. Prior to 1970, the application number for both the application with a provisional specification, and the completed application with a complete specification, were part of the 5-figure application series. In 1970, a number series specific to applications with provisional specifications was introduced (PXnnnn), which remained in place until 2003. As the filing of a complete specification to complete an application did not constitute a new application, the 1903 and 1952 Acts included the concepts of ‘cognates’ (for combining the disclosures of two or more applications with provisional specifications), ‘decognition’ (for separating inappropriately cognated applications) and for divisional applications derived from a provisional specification.

The 1990 Act changed the nature of provisionals, by making them applications in their own right, i.e. they became a stand-alone internal priority document. Complete applications could
claim priority from such applications in the same manner as claiming priority from a basic application, with the one difference being that the provisional application must not have lapsed when the complete application was filed. Concepts of cognates, and of divisionals based on the provisional specification, ceased with the 1990 Act.

Modified Date: 01 March 2013

2.11.12 Complete Application Treated as a Provisional

Under sec 37, an applicant may request that a complete application be treated as a provisional application. Such requests are handled by COG.

If examiners receive a case for examination containing a request under sec 37 which has not been actioned, the matter should be referred to COG.

It is not necessary for a request under sec 37 to include a sec 104 request to amend the patent request. Under sec 37(4), once the request has been processed, the complete application is to be taken for the purposes of the Act to be and to have always been a provisional application. Where the original patent request stated that the complete application was associated with a provisional, or was a divisional, an additional or a Convention application, this information will in general no longer be relevant. However, if circumstances arise in which that information could potentially be relevant, an amendment of the patent request may be required.

The question of priority dates of any claims is determined by the actual dates on which the specifications were filed and not the date on which the complete application is treated as a provisional application. Priority dates are governed by sec 43.

The originally filed complete specification which is to be treated as a provisional specification will not be examined, except where examination has been requested and an examination report issued prior to a request under sec 37.

Modified Date: 25 February 2019

2.11A Annex A - Examples: Subsections 40(2)(a) and 40(3)
Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

Note: During examination, each application should be considered on its own merits, based on a proper construction of the specification and claims and the facts of the case. These examples are provided for guidance only and are not intended to establish rules to be followed outside the principles for examination outlined in 2.11.3A Clear Enough and Complete Enough Disclosure and 2.11.7A Support for the Claims.

In this topic:

Section 40 Enabling Disclosure (Including Undue Burden)

Under sec 40(2)(a), the clear enough and complete enough (enabling) disclosure must be found in the complete specification. For sec 40(3), the enabling disclosure to support the claims must be found in the description, drawings, graphics, photographs and sequence listing. Subject to this distinction, in general where the disclosure is not enabling, objections under both sec 40(2)(a) and sec 40(3) will apply.

Chemistry

1. Where the applicant claimed a surgical suture made of a particular polymer, and the application did not indicate the need for adequately drying the polymer and freeing it from undesired monomer, the complete specification was found to provide an enabling disclosure, since these were steps which 'the instructed reader desirous of achieving success could be expected, if necessary, to take' (American Cyanamid v Ethicon [1979] RPC 265).

2. The claims defined an amphiphilic segment polyurethane in a block co-polymer in broad functional terms, i.e. the desired end effect. The application disclosed one mechanism of achieving this result. In this case, there was no suggestion that the desired end effect was a known goal. The claims were enabled because the specification disclosed a principle of general application, and alternative ways of applying the principle to perform the invention over the whole scope of the claims would have been apparent to the person skilled in the art based on the common general knowledge in the art (EPO T 484/92).
Synergism

3. Claims often define compositions comprising a ‘synergistic’ combination of two or more compounds. Synergism between compounds is unpredictable in nature and not all combinations of any two or more compounds will necessarily exhibit this property. Consequently, where the claims define a synergistic combination and the specification contains little or no guidance on, for example, appropriate concentrations or ratios of the compounds that will provide the synergistic result, it would impose an undue burden if the person skilled in the art was required to test all possible combinations to determine those falling within the scope of the claims.

Markush Claims

In order that claims defining a class of compounds in terms of a Markush structure are supported over their whole scope, the body of the specification must provide sufficient information to enable the skilled addressee to make every compound falling within the scope of the claims.

Where the activity of the class of compounds is a feature of the claim, the class of compounds must be such that the person skilled in the art would have a reasonable expectation that all of the class members will behave in the same way, in the context of the invention disclosed in the specification. If this is not the case, the specification, or the common general knowledge in the art, must provide a means by which the compounds with the relevant activity can be identified without imposing an undue burden on the skilled addressee (see 2.11.3.4.3A Undue Burden).

4. The specification teaches a Markush structure having a particular pharmacophore to which activity is attributed, and there is a reasonable prediction of activity across the whole scope of the claims. The specification only exemplifies a narrow subset of compounds and provides a generic synthetic scheme for only a subset of the claimed class.

The disclosure will not be enabling if the specification provides insufficient guidance for the person skilled in the art to make each and every compound falling within the scope of the claims, and this information cannot be derived from the common general knowledge in the art. This will be the case whether or not the activity is a feature of the claim.

5. The specification discloses a broad Markush formula and discloses schemes and/or examples for the synthesis of compounds over a sufficiently representative range, but only provides biological data for a very limited subset of compounds, such that there is considerable doubt as to whether the activity is present for the whole range claimed.

Where the compounds per se are claimed without reference to the activity, the claims will be enabled where the specification provides sufficient information for the person
skilled in the art to make the compounds over the whole scope of the claims. (In this situation, examiners may need to consider whether the claimed compounds that do not have the activity satisfy the usefulness requirements of sec 18(1)(c)).

Where the claims are directed to those compounds of the class that possess the relevant activity, and it is not reasonable to expect that all of the class will have the activity, the specification will only provide an enabling disclosure if:

- it provides sufficient information for the person skilled in the art to make all of the compounds; and
- it provides sufficient information to identify the compounds with the relevant activity without undue burden or the need for further invention. (Each case must be determined on its merits – see 2.11.3.4.3A Undue Burden and 2.11.7.9A Broad or Speculative Claims).

**Biotechnology**

6. In *Medimmune Ltd v Novartis Pharmaceuticals UK Ltd, Medical Research Council [2011] EWHC 1669 (Pat)*, broadly drafted claims encompassed methods for producing specific binding molecules, using phage display followed by recombinant production of binding molecules with the desired specificity. The invention disclosed in the specification was a principle of general application (see 2.11.3.4.2A Section 40 Enabling Disclosures). At its core was a method for selecting a binding molecule of interest from amongst a potentially large population of other binding molecules. The method did not depend on the precise identity of the binding molecule. On the contrary, the method was useful since it could be applied to a diverse range of binding molecules, fragments and derivatives. Neither did the method depend on the precise application to which it was put. The disclosure of one application of the general principle enabled the full width of the claims, since implementation of the method for the purpose of a new application did not impose an undue burden on the skilled team.

**Broad Claims**

7. In *DSM NV’s Patent [2001] RPC 19*, a specification was found to impose an undue burden in respect of broadly drafted claims to DNA sequences. The specification disclosed the gene sequence of a novel enzyme and taught that the addition of the enzyme to animal feed had beneficial effects. The nature of the invention in this case was described in the specification as the microbial production of phytase.

The specification included claims to:

1. A DNA sequence encoding a fungal phytase which catalyses the liberation of at least one inorganic phosphate from a myoinositol phosphate, said DNA sequence being selected from the group consisting of:
2.11A Annex A - Examples: Subsections 40(2)(a) and 40(3)

(a) ... (b) ...; and

(c) DNA sequences hybridising at low stringency conditions (6X SSC; 50ºC overnight; washing in 6X SSC at room temperature) with a DNA fragment corresponding to a cDNA of the nucleotide sequence depicted in Figure 6 from position 210 to 1129.

2. A DNA sequence which is related to the DNA sequence of claim 1 by the degeneration of the genetic code.

The stringency conditions in claim 1(c) were so low that the overwhelming majority of the DNA which appeared to bind in these conditions was not phytase DNA. The Court found that the person skilled in the art seeking to implement the teaching of the specification in respect of claim 1(c), would be required to depart from the express teaching of the specification, to experiment over what might be a long period of time, and even then only possibly identify and isolate all of the sequences that fell within the scope of the claims. This was found to impose an undue burden.

Claim 2 was wider than claim 1 and was not enabled, for the same reasons that claim 1(c) was not enabled.

8. In Genentech I/Polypeptide expression (T292/85) [1989] OJ EPO 275, the specification was found to contain an enabling disclosure of Genentech’s claims to a plasmid suitable for transforming a bacterial host, which included an expression control sequence to allow the expression of exogenous DNA as a recoverable polypeptide. The Court considered that the general terms ‘plasmid’, ‘bacterial host’ and ‘exogenous DNA’ were each principles of general application. Genentech had obviously not tried the invention using every plasmid, every bacterial host or every sequence of exogenous DNA. However, the broad claim was fully enabled because the invention could be reasonably expected to work with anything that fell within the scope of each of these terms.

Reach-Through Claims

9. ‘Reach-through’ claims define compounds in terms of specific properties identified in a screening assay. This style of claim is more prevalent in the chemical and biochemical areas. If the relationship between the function of the compounds and their structural features is not defined, it would impose an undue burden if the person skilled in the art is required to:

- isolate and characterise all compounds potentially falling within the scope of such claims, without any effective direction as to their identity; and/or
- test every known compound and every conceivable future compound for the activity to determine whether it falls within the scope of the claim.

The fact that the complete specification teaches how to test for the activity used to define the compounds does not necessarily mean that sufficient information is
Antibody Claims

10. The specification relates to the generation of antibodies that specifically bind to a new epitope (Epitope A).

Claim 1 to an antibody that specifically binds epitope A would be fully enabled where the applicant had disclosed the epitope and shown that antibodies can be raised against it. This is because raising antibodies to that epitope is a principle that can be generally applied to produce antibodies over the whole scope of the claim. The specification need only disclose one such antibody.

Claim 2 to an antibody defined in terms of the six CDR sequences will be sufficiently enabled by the disclosure of the CDR sequences. This is a relatively narrow claim. The CDRs can be synthesised and inserted into the various antibody frameworks as a matter of routine.

Claim 3 is to an antibody that specifically binds epitope A where the antibody comprises ‘one or more’ of six disclosed CDRs. In general (each application must be considered on its merits), performing the invention over the whole scope of the claim would represent an undue burden.

Claim 3 encompasses a subset of the antibodies of claim 1, and many more antibodies than claim 2. The disclosure of the epitope is not a principle of general application that can be applied to generate the antibodies in the claimed subset, to the exclusion of other antibodies not encompassed by the claim. The skilled addressee is required to generate all of the antibodies of claim 1 and then perform the additional step of sequencing them to determine those that fall within the claimed subset. This is more work than that required for claim 1 and would take longer than the skilled addressee would normally expect to take in raising antibodies. Consequently, performing the invention defined in this claim would impose an undue burden.

Claim 4 is to an antibody comprising ‘one or more’ of the disclosed CDRs with no associated activity.

In general, it would represent an undue burden for the person skilled in the art to determine all possible antibodies that fall within the scope of the claim and to produce them all. This claim encompasses all of the antibodies of claim 3, and in addition all possible antibodies with ‘one or more’ of the 6 disclosed CDRs that do not bind epitope A. The epitope is not a principle that can be applied to produce all of the antibodies claimed. The skilled addressee would have to determine all possible
antibody sequences that fall within the claim and make each one. This would take much longer than the person skilled in the art would normally expect to take in generating antibodies, and would impose an undue burden.

For claims 3 and 4, the skilled addressee would possess the skills to perform the invention as claimed. However, the time it would take to make every possible antibody having one or more CDRs falling within these claims, is longer than the normal expectation of the person skilled in the art given the nature of the invention disclosed in the specification, i.e. raising antibodies (see 2.11.3.4.3A Undue Burden).

Note however, that this is not prescriptive. What represents an undue burden depends on the facts of the case. For example, if the specification relates to the production of a fully defined antibody library, the skilled addressee might expect to generate a large number of antibodies and then sequence them all.

11. In *Kirin-Amgen v Hoechst Marion Roussel Ltd* [2004] UKHL 46; [2005] RPC 9, Lord Hoffmann observed obiter that the specification was insufficient. In Australia, objections under sec 40(2)(a) and sec 40(3) would apply. However, it should be noted that in this case the finding was only possible in retrospect, after Hoechst had developed their new method for recombinant production of erythropoietin.

Amgen (the patentee) had in the late 70s to early 80s sequenced the human erythropoietin gene and expressed it as an exogenous sequence in a host cell. In order to claim erythropoietin *per se*, which was known in the art, Amgen claimed recombinant erythropoietin in broadly drafted product by process claims, that were construed by the Court to encompass erythropoietin produced by any method involving recombinant DNA technology.

Based on the knowledge of the gene sequence, Hoechst later produced an identical erythropoietin product by ‘gene activation’, i.e. by introducing expression control sequences upstream of the endogenous gene in a human cell. Although their strategy was different, Hoechst’s product fell within the scope of Amgen’s product by process claims since its production involved recombinant DNA technology.

The Court noted that the facts of this case did not support a broad claim based on the application of the general principle of using recombinant DNA technology to produce the protein. Amgen’s patent only taught a method of expressing the gene by introducing the coding sequence into a host cell. It did not provide any generic disclosure that enabled Hoechst’s gene activation method. Furthermore, since it was a different method, Hoechst’s method did not constitute a version of Amgen’s process which, although untried, could reasonably be expected to work as well (*Kirin-Amgen* at [114]-[116]). The claims therefore encompassed an embodiment that was not enabled and which owed nothing to the teaching of the patent or any principle which it disclosed.
Methods of Treatment

**Note:** When examining method of treatment claims, issues of support should also be considered (see 2.11.7.10A Support Required for Pharmaceutical Inventions and Methods of Treatment. The principles provided in that part apply equally to methods of treatment of plants and any other organism).

12. A disclosure of the treatment of sugar beet seedlings, in the absence of any indication that the treatment was a principle of general application such that the skilled addressee would have a reasonable expectation that the treatment would work with any hydrated seedling, will not sufficiently enable a broad claim to:

   ‘A process for the treatment of hydrated seedlings which comprises subjecting the seedlings to cold shock at a temperature below 0°C for a period sufficiently long to affect the size of the resulting plant.’

   Similarly, where the description refers only to protecting tomatoes, cucumbers and potatoes against particular diseases, unless the specification teaches a principle of general application such that the skilled addressee would have a reasonable expectation that the treatment would work with any plant, an independent claim directed to a process for increasing the resistance of any plant to any disease or internal malfunction, by treating it with one or other of a number of specified compounds in an amount sufficient to increase the resistance, would not be enabled over its entire scope. Where no general principle exists that would enable the treatment of any plant, the description must provide a sufficient range of examples, relating to different kinds of plants, to enable the skilled addressee to deduce how the process should be applied to virtually any plant.

   Where the claims are so broad as to claim methods of treatment that have not been enabled, the claims will also exceed the applicant’s contribution to the art.

**Pharmaceutical**

13. If a claim is to a ‘slow release’ formulation of a known drug, the specification must provide sufficient information to enable the person skilled in the art to produce a product having the desired characteristics, without embarking on a research program.

14. A claim relates to the use of an inhibitor of protein X to cure cancer Y. If the specification discloses the principle that inhibition of protein X is all that is required to cure cancer Y, then it is reasonable to expect that the curative treatment will work with anything falling within the scope of the term ‘inhibitor of protein X’. In this situation, the claim defining the inhibitor in general terms will be enabled over its whole scope, even where the applicant has only exemplified the use of one such inhibitor (see also 2.11.7.7A Reach-Through Claims).
15. A claim related to the use of compound A or derivatives thereof for the preparation of a medicament for inhibiting organ or tissue transplant rejection in a mammal in need thereof. The specification contained no disclosure enabling the skilled person to determine which of the many possible derivatives of compound A would have worked. Although there was a strong possibility that some of the large number of derivatives would work in the same way as compound A, it was impossible to say which would work, unless the skilled person undertook the ‘vast and correspondingly burdensome’ research task necessary. This would impose an undue burden.

16. The applicants filed their patent application, claiming amongst other things a vaccine. It then took them several years to successfully produce a vaccine. In this situation, since the applicants themselves had to undertake significant further research in order to produce something falling within the scope of the claim, the Court found that the complete specification did not disclose the claimed vaccine in a manner which enabled the vaccine to be prepared by the person skilled in the art (Chiron Corporation v Organon Teknika Ltd [1994] FSR 202).

Mechanical

17. The disclosure of an invention is not incomplete merely because the skilled addressee is required to make routine and non-inventive variation(s) to successfully perform the invention claimed. For example, in an invention in which a switchable semi-conductor was used for switching electric circuits on and off without using contacts, residual current continued to flow in the circuit when switched off. If this residual current adversely affected the use of the switch, and the person skilled in the art could modify the semi-conductor to overcome the residual current problem by routine techniques in a reasonable time frame given the nature of the invention, performance of the invention would not impose an undue burden.

18. A claim defines a radiation filter capable of filtering light of any wavelength. The description discloses a number of wide band filters that are known in the art to only work within the visual part of the spectrum. Consequently, the disclosure does not provide sufficient information to enable the person skilled in the art to make the radiation filter over the whole scope of the claim. However, if the description teaches new methods or principles that allow the application of the radiation filter to any wavelength of light, then the claims will be enabled by the disclosure.

19. A claim refers to a photovoltaic cell with ‘means for enhancing spectral response to wavelengths in a photovoltaic cell’ and ‘means for mitigating bulk recombination losses for the photovoltaic cell’. Improving the spectral response to wavelengths and mitigating bulk recombination losses are both known problems in creating a photovoltaic cell. The description outlines particular means of achieving these that are only applicable to certain types of photovoltaic cells comprising certain particular materials.

The claims are therefore not enabled over their whole scope, as the principle disclosed in the description is specific in nature and is only applicable to a narrow class of photovoltaic cells.

20. A claim refers to a method of automatically enhancing the measurement precision of a distance measuring device, utilising a new general principle. The claims will be allowable if
it is apparent from the description, or can be demonstrated by the applicant, that the new principle can be applied by the skilled addressee to any distance measuring device, using only routine methods of experimentation. However if, on the balance of probabilities, the application of the principle to any distance measuring device would require the skilled addressee to carry out tests or developments that go beyond the routine or require additional inventions to solve problems not considered by the application, then the disclosure is not sufficiently enabling.

21. A claim comprises an equation defined in terms of a number of parameters, and defines the use of the equation in a calculation allowing optimisation of a switch mode power supply via a reduction in power dissipation. However, the equation comprises several functions and constant terms which are not defined in the description and are not standard functions or constants that are known in the art. Thus, the specification provides insufficient information to enable the skilled addressee to implement the claimed invention.

22. A claim defines a new type of closure for a nappy that ensures that the nappy cannot be undone by a baby or toddler. The claim is not restricted to any particular type of nappy or in the type of materials that comprise the nappy.

    The description indicates that for the new closure to work, the closure and the nappy to which it is attached must comprise certain compatible materials typically found in disposable nappies. Cloth multiuse nappies are well known in the art and do not comprise these materials, as they are inherently unsuitable for use in an article intended to be used multiple times. It is thus not apparent to the skilled addressee how the closure could be applied to multiuse cloth nappies.

    Since the closure is not a general principle that can be applied to all nappies and the specification does not teach alternative closures, the specification does not provide sufficient information to enable the skilled addressee to perform the invention over the whole width of the claim. In addition, in claiming a closure for any type of nappy, the claim encompasses matter that is broader than is justified by the contribution to the art.

Computer-Related Inventions

23. The claims defined a computer-based system for planning, reporting and management which provided, amongst other things, facilities for directly booking travel in a computerised reservation system and having the booking communicated to a travel agency for processing and ticketing. Evidence was filed by a third party establishing that the person skilled in the art following the teaching in the specification, would take years of design development and implementation work, and in addition, require creativity and ingenuity in the analysis and design of the system to implement the system as claimed.
Support (Broader Than is Justified by the Contribution to the Art)

Some of the examples provided above to exemplify enabling disclosure, also exceed the contribution to the art, as is indicated.

Chemistry

24. A claim relates to improved fuel oil compositions which have a desired property. The description provides support for one method for obtaining fuel oils having this property, which is by the presence of defined amounts of a certain additive. No alternative processes for obtaining fuel oils with the desired property are disclosed. Prima facie, a claim that makes no mention of the additive is broader than is justified by the contribution to the art (and will not be enabled over the whole of its breadth). Unless the applicant can provide evidence and/or credible and plausible submissions that it is not possible to envisage other ways of achieving that result which owe nothing to the teachings of the invention, the claim must be restricted.

Biotechnology

25. In Schering Biotech Corp’s Application [1993] RPC 249, the claims defined a process for producing a polypeptide with a desired activity, by expressing in a host cell either a specific deposited cDNA insert, or a nucleotide sequence capable of hybridising to said cDNA insert. The ‘hybridising’ sequence was further defined in broad homology terms and encompassed a large number of possible sequences which would not all encode a polypeptide with the desired activity. The judge observed that carrying out the claimed process with the ‘hybridising’ sequences may, or may not, produce a polypeptide with the claimed activity. Consequently, he found that the application did not provide adequate support for a claim to the process using the ‘hybridising’ sequences (see also 2.11.7.7A Reach-Through Claims).

On the facts of this case, it is apparent that the ‘hybridising’ nucleotide sequences defined in the claims in general terms did not represent a principle of general application, since it is not reasonable to expect the invention to work with anything that falls within the general term. The nature of the invention in this case was to produce a desired polypeptide by recombinant means. In relation to the ‘hybridising’ sequences, the skilled addressee would be required to identify all possible sequences ‘capable of hybridising’ to the disclosed sequence and then determine which of these would encode a polypeptide with the relevant activity. This would impose an undue burden, since it would take far longer than would normally be expected in the art to produce a recombinant polypeptide. Consequently, insofar as they referred to the hybridising
sequences, the claims were not enabled over their whole scope, and exceeded the contribution to the art disclosed in the specification.

Support (Inconsistency)

26. The description disclosed an article for conditioning fabrics in a laundry dryer, comprising a flexible woven or non-woven sheet having on it areas of fabric conditioning composition. A number of problems were identified in prior art conditioning sheets, including that they could block the air outlet causing the dryer to overheat. The applicant's solution to this problem was to use a conditioning fabric that was air-permeable. It was clear from the description that air-permeability of the sheet material was not optional. It was necessary to the working of the invention, because without this feature the dryer could overheat causing damage or a fire. Thus, a claim to a conditioning sheet suitable for use in a laundry dryer without the feature of air permeability was not enabled and was consequently not supported by the description. (Glatt's Application [1983] RPC 122 at 126-129)

27. A claim relates to a specified method of treating 'synthetic resin mouldings' to obtain certain changes in physical characteristics. All the examples in the description relate to the treatment of thermoplastic resins and the method appears inappropriate for thermosetting resins. In this situation, an objection should be taken that the specification has not provided sufficient information to enable the person skilled in the art to perform the claimed method insofar as it encompasses the treatment of thermosetting resins. Unless the applicant can provide evidence and/or credible and plausible submissions that the method is nevertheless applicable to thermosetting resins, the claim must be restricted to the treatment of thermoplastic resins.

Claims Supported Despite Apparent Inconsistencies

28. The application related to a 7-element digital display such as those used in service stations to display petrol prices, in which any required digit could be displayed using hinged flaps which covered/uncovered the elements. The example disclosed each flap attached to the baseboard by two studs, each retained in the base board by a coil spring and cotter arrangement which also retained the flap in an open or closed position by continuing to press on it.

The claims were defined partly by the result to be achieved. The claimed digital display apparatus required (among other things) each flap to be attached to the baseboard by one or more studs with means for retaining the flap in an aperture in the baseboard “wherein
spring means on the stud retains the associated flap in the first or second position”.

The Court of Appeal (UK) found that it was not necessary to limit the claims to the exemplified two-stud attachment mechanism or the flap retaining means disclosed in the body of the specification. It found that the person skilled in the art would understand that (i) one or more studs could be used to attach each flap, and (ii) that different spring means could be used other than the coil spring and cotter arrangement explicitly disclosed in the specification, and as such these variations were implicitly disclosed. ([A C Edwards Ltd v Acme Signs & Displays Ltd] [1990] RPC 621 and [1992] RPC 131)

In the circumstances described above, the broadly drafted claim would be enabled over its full scope by the disclosure of the specification and the understanding of the person skilled in the art based on their common general knowledge, and would therefore be supported by that disclosure.

2.12 Priority Dates and Filing Dates

2.12.1 Priority Dates

Modified Date: 01 November 2017

2.12.1.1 Priority Date of Claims

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.12.1.1A Priority Date of Claims.

In this topic:

General

Under sec 43(1), each claim of a specification must have a priority date. The priority date of a claim is primarily of relevance when assessing the claim against the criteria of novelty and inventive/innovative step.
2.12.1.1 Priority Date of Claims

The actual priority date of a claim is determined by the provisions of the Act and Regulations. However, during search and/or examination it should usually not be necessary in the first instance to determine the actual priority date of a claim. When conducting a search, examiners should keep in mind both the earliest priority date and the latest possible priority date (i.e. the date of filing). If, as a result of the search, a document is found which would constitute a citation against a claim only if the claim is not entitled to the earlier priority date, examiners should proceed to determine the priority date of the claim in question.

However, where the determination of priority dates is difficult or time consuming, it is not unreasonable to take the date of filing as the *prima facie* priority date, with the onus of rebuttal being placed upon the applicant or attorney.

**Note:** In certain situations, an application under examination may claim priority from a published document, such as a PCT application. That PCT application may in turn have its own priority document, which may have been filed more than 12 months before the filing date of the application being examined. Where these circumstances arise, examiners should check the priority date of the claims.

**Note:** In relation to an international application, reg 8.1(1) and Article 2(xi) of the PCT define a "priority date" for the application for the purposes of computing time limits. This has no bearing on the priority date of claims as discussed below.

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**Determination of Priority Dates**

Under sec 43(2), the priority date of a claim is:

a. the date of filing of the specification; or

b. where the Regulations provide for the determination of a different date as the priority date – the date determined by the Regulations.

A single complete application may derive priority by operation of more than one provision of the Act and Regulations, for example as a Convention application, a divisional application or by association with a provisional application. Priority dates are determined by Chapter 3, Part 1 of the Regulations.

In general, if a claim is fairly based on matter disclosed in a priority document or a "parent application" (for a complete specification filed in respect of a divisional application), then the priority date of the claim is the date of filing the priority document or "parent application".

Regulation 3.12 provides for most priority dates including:
2.12.1.1 Priority Date of Claims

- claims of a complete specification associated with one or more provisional specifications;
- claims of the specification of a Convention application, where there was more than one specification filed in connection with a basic application;
- claims of the specification of a PCT application which may have one or more earlier Australian applications, or one or more basic applications;
- claims of a complete specification filed pursuant to sec 79B (divisionals);
- claims of a complete specification filed pursuant to sec 79C (divisional applications for innovation patents); and
- claims of a divisional application where deposit requirements in relation to micro-organisms have not been satisfied.

**Note:** Special priority considerations which apply to applications made under the PCT route are discussed in [2.20.5.1 Priority Sources](#).

In certain circumstances, the Act and Regulations may also determine further priority dates different from the date of filing of the complete specification.

The provisions which cover these priority dates are:

- sec 35, sec 36 and sec 43(2)(b) and reg 3.13 – where claims of a complete specification are filed pursuant to the operation of sec 35 and sec 36; and
- sec 114 and reg 3.14 – where claims of a complete specification claim matter in substance disclosed only as a result of the amendment (see also [2.12.1.4 Priority Date Issues Relating to Amended Claims](#)).

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**Level of Disclosure Required**

The priority date of a claim is the date of filing of a specification which first discloses matter upon which the claim is fairly based and from which the claim is entitled to claim priority. The fair basis requirements in order for a claim to obtain priority are substantially the same as for the claims to be fairly based in accordance with sec 40(3) (see [2.11.7 Claims are Fairly Based](#)).

Subsection 40(3) requires that the claims of a specification shall be "fairly based on matter described" in the specification. In *The International Paint Company Limited’s Application*
(1982) RPC 247, it was held that the words "described" and "disclosed" in the UK Patents Act 1949 meant precisely the same thing in relation to a document which was being considered as a whole. In this context, examiners can assume that the words have the same meaning under the Australian Patents Act 1990.

Tests for Determining Disclosure

The fundamental requirement for a claim to be fairly based on a particular disclosure is that the disclosure must contain a "real and reasonably clear disclosure of the subject matter of the claim" (CCOM Pty Ltd v Jiejing Pty Ltd 28 IPR 481; (1994) AIPC 91-079 and Sartas No. 1 Pty Ltd v Koukourou & Partners Pty Ltd and Nicola Leonardis 30 IPR 479; (1995) AIPC 91-121).

The following tests provide guidance in determining whether a real and reasonably clear disclosure has occurred:

- If a claim meets the "Mond Nickel Rules" set down in Mond Nickel Company Ltd.'s Application (1956) RPC 189 at page 194 it will be fairly based on the priority document. In Imperial Chemical Industries Ltd.'s Appln. (1960) RPC 223, the test was further expanded:

  "the word 'broadly' was used in respect of the description and carried the meaning of 'in a general sense', such as would be exemplified by a statement in the provisional specification that reaction products were dissolved in hot water, where the complete specification introduced a specific temperature range ...."  

- Unless a prior specification discloses all the essential features of a claim, it will not constitute a fair basis for the claim (Interact Machine Tools (NSW) Pty Ltd v Yamazaki Mazak Corporation 27 IPR 83; (1993) AIPC 91-026 and Anaesthetic Supplies Pty Ltd v Rescare Ltd 28 IPR 383; (1994) AIPC 91-076).

In the latter decision, the court added a further requirement, i.e. where the priority document is a provisional specification, every essential feature disclosed in the priority document must be included in any claim for which priority is sought from the provisional specification. However, later court decisions have cast doubt on the correctness of this approach and examiners must not apply this criterion for examination purposes.

A claim may properly derive priority from a prior specification where the specific matter added to the disclosure of that specification is common general knowledge (Scherico Ltd.'s Appln. (1968) RPC 407). For example, if the prior specification does not disclose the material of which a particular part is made, but it is common general knowledge (at the relevant date) that such a part may be made of a certain material, then the specification may be regarded as disclosing the part made of that material. If examiners are unaware that

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Effective Date: 25 September 2019
certain matter is common general knowledge, it may be assumed not to be until evidence to
the contrary is provided. The extent and nature of the evidence required is the same as that
required of examiners citing common general knowledge during examination.

Selections

Where an invention resides in a selection, the claims of a complete specification will not be
fairly based on matter disclosed in a priority document, if the claims are directed toward a
selection which is not disclosed in the priority document. This should be particularly kept in
mind where, as a result of an amendment in response to a novelty and/or inventive step
objection, the invention of the complete specification becomes one of selection, or becomes
a materially different selection from that originally disclosed in the priority document (see
Cooper's Animal Health v Western Stock Distributors (1987) 11 IPR 20). However, where a
feature in a claim is merely restricted to a subset of alternatives taught in the specification
and the alternatives are taught in the priority document, the priority document will contain a
sufficient disclosure of the claimed subset.

Claims With More Than One Priority Date

A claim may possess more than one priority date. Under sec 43(3), where a claim of a
complete specification defines more than one form of an invention, then the claim must be
treated as constituting a separate claim for each form of the invention for priority date
purposes. Consequently, a claim may possess more than one priority date. Examples where
this may occur include:

- a claim directed to alternative forms first disclosed in separate documents;
- a claim appended to a number of claims having different priority dates; or
- an omnibus claim referring to drawings or examples disclosed on different dates.

In this case, the words "form of the invention" mean matter which clearly falls within the
concept of the invention, as the claiming of different inventions in one claim is precluded
under sec 40(4). Each separate "form of the invention" can, by virtue of sec 43(1), have only
one priority date.

However, as discussed in AstraZeneca AB v Apotex Pty Ltd [2014] FCAFC 99 at [251]; 107
IPR 177, not every potential variant of the defined invention can be treated as a different
form of the invention which is to be given its own priority date.
2.12.1.1 Priority Date of Claims

Whether an invention has different forms was also considered in *Nichia Corporation v Arrow Electronics Australia Pty Ltd* [2015] FCA 699 at [58] – [87]. In this case, the claims were cast in terms that envisaged and provided for different forms of the invention, in contrast to the claims considered in *AstraZeneca supra*.

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**Specifications Containing Claims With Different Priority Dates**

Under sec 43(4), the claims of a specification may have different priority dates. These different dates may result from, for example, a complete specification deriving priority from more than one priority document, or in the case of a divisional application, from more than one “parent application”.

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**Case Law**

Decisions in which the determination of priority dates was an issue include:

- *British Drug Houses Ltd.’s Appln.* (1964) RPC 237
  
  In the absence of any suggestion in the complete specification that there was invention in restricting the starting materials claimed, compared with those disclosed in the provisional specification, the claims were entitled to the earliest priority date, i.e. the filing date of the provisional.

- *Farbenfabriken Bayer A.G.’s Appln.* (1973) RPC 698
  
  A claim to a process was fairly based on the disclosure of the provisional specification, since if the apparatus there described was made and the process performed, it would in fact operate as stated in the claim.

- *Hoffmann-La Roche & Co. AG v Commissioner of Patents* (1971) 123 CLR 529
  
  Claims to compounds in a Convention application were fairly based on the first basic application, even though the process disclosed in that application would lead to the production of many other compounds and the compounds were disclosed in later basic applications.
2.12.1.1A Priority Date of Claims

- **International Playtex Inc.'s Appln.** (1979) AOJP 1188

  The claims in the specification omitted a feature described in a priority document as essential to the invention and thus lacked fair basis.

- **Dunn v Ward** 1 IPR 595

  Two features of the claims were not disclosed in the provisional specification. The claims were only entitled to the later priority date, i.e. the filing date of the complete specification.

- **Cooper's Animal Health v Western Stock Distributors** 11 IPR 20

  An essential constituent of a claimed formulation was a particular solvent in a specified quantity. This solvent was mentioned in the provisional specification only as one of a number of possible alternatives and other solvents were discussed in a more favourable light. The special advantages arising from the use of the particular solvent were not apparent from a reading of the provisional specification.

  The Court found that identification of that constituent as a key element of the claimed invention could properly be regarded as involving an inventive step, however the claim was not fairly based on the provisional specification. A relevant factor in the decision was that the claimed invention was the formulation, whereas the invention disclosed in the provisional specification was a method of treating sheep.

  It should be noted that the decision that the claim was not fairly based did not result simply from the fact that a feature which was optional in the provisional specification was included in the claim. Rather, it was based on the conclusion that the whole nature of the invention had changed between the provisional and complete specifications.
For all other standard patent applications/innovation patents, see 2.12.1.1 Priority Date of Claims.

In this topic:

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General

Under sec 43(1), each claim of a specification must have a priority date. The priority date of a claim is primarily of relevance when assessing the claim against the criteria of novelty and inventive/innovative step.

The actual priority date of a claim is determined by the provisions of the Act and Regulations. However, during search and/or examination it should not usually be necessary in the first instance to determine the actual priority date of a claim. When conducting a search, examiners should keep in mind both the earliest priority date and the latest possible priority date (i.e. the date of filing). If, as a result of the search, a document is found which would constitute a citation against a claim only if the claim is not entitled to the earlier priority date, examiners should proceed to determine the priority date of the claim in question.

However, where the determination of priority dates is difficult or time consuming, it is not unreasonable to take the date of filing as the *prima facie* priority date, with the onus of rebuttal being placed upon the applicant or attorney.

**Note:** In certain situations, an application under examination may claim priority from a published document, such as a PCT application. That PCT application may in turn have its own priority document, which may have been filed more than 12 months before the filing date of the application being examined. Where these circumstances arise, examiners should check the priority date of the claims.

**Note:** In relation to an international application, reg 3.5AE and reg 4.4, and Article 2(xi) of the PCT, define a "priority date" for the application for the purposes of computing time limits. This has no bearing on the priority date of claims as discussed below.

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Determination of Priority Dates
Under sec 43(2), the priority date of a claim is the date of the filing of the specification, unless certain circumstances apply. In these situations, the priority date is the date determined under the Regulations.

A single complete application may derive priority by operation of more than one provision of the Act and Regulations, for example as a Convention application, a divisional application or by association with a provisional application. Priority dates are determined by Chapter 3, Division 2 of Part 1 of the Regulations, comprising reg 3.12 to reg 3.13E.

In general, if a claim defines an invention that is disclosed in a priority document or a "parent application" (for a complete specification filed in respect of a divisional application) in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art, then the priority date of the claim is the date of filing the priority document or "parent application".

It must be noted that when determining priority, it is permissible to have regard to the combined disclosure of all the documents filed for a provisional, earlier or basic application that were filed on the date the application was filed. For example, if the abstract and specification that were both filed with the earlier priority application, when taken together, disclose the invention claimed in the complete specification in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art, the priority date of the claim is the filing date of the priority application. This is the case even if the abstract on its own, or the specification on its own, does not disclose the claimed invention.

Regulation 3.13 provides for most priority dates including:

- reg 3.13A - claims of the specification of a PCT application which may have one or more earlier Australian applications, or one or more basic applications;
- reg 3.13B - claims of the specification of a Convention application, where there may be one or more related basic applications;
- reg 3.13C - claims of a complete specification associated with one or more provisional specifications;
- reg 3.13 D - claims of a complete specification filed pursuant to sec 79B (divisional applications filed prior to grant); and
- reg 3.13E - claims of a complete specification filed pursuant to sec 79C (divisional applications for innovation patents).

These regulations require that the priority document(s) "clearly discloses" the invention claimed. Subregulation 3.12(4) provides that a priority document "clearly discloses" an invention if the document discloses the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.
Note: Special priority considerations which apply to applications made under the PCT route are discussed in 2.20.5.1 Priority Sources.

In certain circumstances, the Act and Regulations may also determine further priority dates different from the date of filing of the complete specification.

The provisions which cover these priority dates are:

- sec 35, sec 36 and sec 43(2)(a) and reg 3.13 – where claims of a complete specification are filed pursuant to the operation of sec 35 and sec 36; and

- sec 114 and reg 3.14 – where claims of a complete specification claim an invention disclosed in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art only as a result of the amendment (see also 2.12.1.4A Priority Date Issues Relating to Amended Claims).

Micro-Organisms

The Regulations also set out the procedure for determining priority dates when the claimed invention relates to a micro-organism. The procedure varies depending upon certain timing requirements as indicated below.

1. For:

- standard patent applications/innovation patents with an examination request filed on or after 25 August 2015; or

- innovation patents where the Commissioner had not decided before 25 August 2015 to examine the patent;

   if:

   - the specification of the priority application included such relevant information about the micro-organism as was known to the applicant at the filing date of the application;

   - the requirements of sec 6(c) are met in relation to the complete specification that contains the claim (to the micro-organism); and

   - the micro-organism was deposited with a prescribed depository institution on or before the filing date of the priority application;

then the priority application is considered to disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person.
skilled in the relevant art. In this situation the priority date is the filing date of the priority application.

The Regulations recognise (in the same way as in sec 41) that an invention involving a micro-organism may not be practically disclosed in a written specification and that a deposit under the Budapest Treaty should be taken into account for the purpose of determining priority dates.

2. For all other standard patent applications/innovation patents, if:
   - the specification of the priority application included such relevant information about the micro-organism as was known to the applicant at the filing date of the application;
   - the priority application discloses the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art, other than in relation to the description of the micro-organism;
   - the requirements of sec 6 (c) are met in relation to the complete specification; and
   - the micro-organism was deposited with a prescribed depository institution on or before the filing date of the priority application;

then the priority date may be the filing date of the priority application.

The Regulations recognise (in the same way as in sec 41) that an invention involving a micro-organism may not be practically disclosed in a written specification and that a deposit under the Budapest Treaty should be taken into account for the purpose of determining priority dates.

This is implemented on the basis that the complete specification meeting the requirements of sec 6(c) is specified as a priority document for the purpose of sec 43 and, under sec 41, is taken to provide an enabling disclosure of the invention including the micro-organism. The priority date, however, is the filing date of the priority application, provided the other conditions are met, including that the deposit is made on or before that date.

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**Level of Disclosure Required**

The priority date of a claim is the date of filing of a specification which first discloses the claimed invention in a manner that is clear enough and complete enough for the invention to
be performed by a person skilled in the art and from which the claim is entitled to claim priority. The disclosure required in a priority document is substantially the same as the enabling disclosure required for the purposes of sec 40(2)(a) (see 2.11.3.4.2A Section 40 Enabling Disclosures).

If a priority document is silent with regard to any essential element of a claim, the claim is not entitled to an earlier priority date. In particular, if a claim in a priority document is broad enough to cover a certain technical feature, it does not follow that it discloses that feature for the purpose of establishing priority. Nevertheless, implicit disclosure of a feature can be taken into account if the feature would have been derived "directly and unambiguously, using common general knowledge, from the previous application as a whole" (G 298) (see also paragraph below).

A claim may properly derive priority from a prior specification where the specific matter added to the disclosure of that specification is common general knowledge (Scherico Ltd.’s Appln. (1968) RPC 407). For example, if the prior specification does not disclose the material of which a particular part is made, but it is common general knowledge (at the relevant date) that such a part may be made of a certain material, then the specification may be regarded as disclosing the part made of that material. If examiners are unaware that certain matter is common general knowledge, it may be assumed not to be until evidence to the contrary is provided. The extent and nature of the evidence required is the same as that required of examiners citing common general knowledge during examination.

Selections

Where an invention resides in a selection, the claims of a complete specification will not be enabled by the disclosure of a priority document, if the priority document did not provide a clear enough and complete enough (enabling) disclosure of the inventive selection. This should be particularly kept in mind where, as a result of an amendment in response to a novelty and/or inventive step objection, the invention of the complete specification becomes one of selection, or becomes a materially different selection from that originally disclosed in the priority document (see Cooper’s Animal Health v Western Stock Distributors (1987) 11 IPR 20). However, where a feature in a claim is merely restricted to a subset of alternatives taught in the specification and the alternatives are taught in the priority document, the priority document will contain a sufficiently enabling disclosure of the claimed subset.

Claims With More Than One Priority Date
A claim may possess more than one priority date. Under sec 43(3), where a claim of a complete specification defines more than one form of an invention, then the claim must be treated as constituting a separate claim for each form of the invention for priority date purposes. Consequently, a claim may possess more than one priority date. Examples where this may occur include:

- a claim directed to alternative forms first disclosed in separate documents;
- a claim appended to a number of claims having different priority dates;
- an omnibus claim referring to drawings or examples disclosed on different dates.

In this case, the words "form of the invention" mean matter which clearly falls within the concept of the invention, as the claiming of different inventions in one claim is precluded under sec 40(4). Each separate "form of the invention" can, by virtue of sec 43(1), have only one priority date.

However, as discussed in *AstraZeneca AB v Apotex Pty Ltd* [2014] FCAFC 99 at [251]; 107 IPR 177, not every potential variant of the defined invention can be treated as a different form of the invention which is to be given its own priority date.

Whether an invention has different forms was also considered in *Nichia Corporation v Arrow Electronics Australia Pty Ltd* [2015] FCA 699 at [58] – [87]. In this case, the claims were cast in terms that envisaged and provided for different forms of the invention, in contrast to the claims considered in *AstraZeneca supra*.

### Specifications Containing Claims With Different Priority Dates

Under sec 43(4), the claims of a specification may have different priority dates. These different dates may result from, for example, a complete specification deriving priority from more than one priority document, or in the case of a divisional application, from more than one “parent application”.

### Case Law
The following decisions determined priority dates in the context of fair basis, however the circumstances of each case are relevant to whether the priority document provided a clear enough and complete enough (enabling) disclosure of the claimed invention:

- In the absence of any suggestion in the complete specification that there was invention in restricting the starting materials claimed, compared with those disclosed in the provisional specification, the claims were entitled to the earliest priority date, i.e. the filing date of the provisional.

*British Drug Houses Ltd.’s Appln.* (1964) RPC 237

- Where claims in a specification omit a feature described in a priority document as essential to the invention, the priority document does not provide a clear enough and complete enough (enabling) disclosure of the claimed invention.

*International Playtex Inc.’s Appln.* (1979) AOJP 1188

- Where two features of the claims were not disclosed in the provisional specification, the claims were only entitled to the later priority date, i.e. the filing date of the complete specification.

*Dunn v Ward* 1 IPR 595

- An essential constituent of a claimed formulation was a particular solvent in a specified quantity. This solvent was mentioned in the provisional specification only as one of a number of possible alternatives and other solvents were discussed in a more favourable light. The special advantages arising from the use of the particular solvent were not apparent from a reading of the provisional specification.

The Court found that identification of that constituent as a key element of the claimed invention could properly be regarded as involving an inventive step. A relevant factor in the decision was that the claimed invention was the formulation, whereas the invention disclosed in the provisional specification was a method of treating sheep.

In this situation, a conclusion that the provisional specification lacked a clear enough and complete enough (enabling) disclosure would not be because a feature which was optional in the provisional specification was included in the claim. Instead, it would be based on the conclusion that the whole nature of the invention had changed between the provisional and complete specifications.

*Cooper’s Animal Health v Western Stock Distributors* 11 IPR 20
2.12.1.2 Priority Date Issues Specific to Associated Applications (Priority Document is a Provisional)

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.12.1.2A Priority Date Issues Specific to Associated Applications (Priority Document is a Provisional).

A complete application may be associated with one or more provisional applications, including provisional applications arising from a request under sec 37 to treat a complete application as a provisional. For the purpose of determining a priority date, an associated provisional application is treated as a priority document (reg 3.12(2)).

A complete application can validly claim priority from both an associated provisional application, and from a basic application. The relevant priority date is determined in the same manner as for an application having a plurality of basic applications, or a plurality of provisional applications.

Case Law

The purpose of a provisional specification was summarised by Lockhart J in Anaesthetic Supplies Pty Ltd v Rescare Ltd 28 IPR 383 at 401:

"All that the provisional specification needs to do is to describe generally and fairly the nature of the invention, and not to enter into the minute details as to the manner in which the invention is to be carried out. It is a mode of protecting the inventor until the time of filing the final specification. It is not intended to be a complete description of the invention, but simply to disclose the invention fairly, though in rough state. The interval of time between the provisional and the final is intended to provide an opportunity for the development and precise expression of the invention foreshadowed in the provisional".

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2.12.1.2A Priority Date Issues Specific to Associated Applications (Priority Document is a Provisional)

Lockhart J also referred to the fifth edition of *Blanco White’s Patents for Inventions*, 1983, at paragraph 2-209:

"It should be noted that the question of "fair basing" upon a provisional specification is not altogether analogous to that of "fair basing" upon a complete specification....It has always been considered legitimate to develop an invention to some extent after filing a provisional specification, and the expression "fairly based" in the present context allows for such development."

In the same case, when discussing the question of fair basing on a provisional specification, Sheppard J stated:

"It is sufficient to say that a degree of latitude is afforded to the construction of provisional specifications which is not available when a complete specification is being construed."

Decisions such as *CCOM Pty Ltd v Jiejing Pty Ltd* 28 IPR 481 and *Leonardis v Sartas* (No. 1) 35 IPR 23 have dealt with fair basing on a provisional specification by determining if there has been a real and reasonably clear disclosure of the claimed features in the provisional specification.

In *Leonardis v Sartas* (supra), the court considered the "Mond Nickel Rules" when determining if there had been a real and reasonably clear disclosure.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.12.1.2 Priority Date Issues Specific to Associated Applications (Priority Document is a Provisional).

A complete application may be associated with one or more provisional applications, including provisional applications arising from a request under sec 37 to treat a complete application as a provisional.
A complete application can validly claim priority from both an associated provisional application, and from a basic application. The relevant priority date is determined in the same manner as for an application having a plurality of basic applications, or a plurality of provisional applications.

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.12.1.3A Priority Date Issues Specific to Convention Applications.

In this topic:

**Overview**

Under reg 3.12, several kinds of documents may serve as a priority document for a Convention application. These include:

- a basic application that is related to the Convention application; or
- a specification, or another document filed in respect of, and at the same time as, a basic application that is related to that Convention application.

For priority purposes, matter is deemed to have been disclosed if it was disclosed or claimed in a basic application. Only that application, or a specification or other document filed in its support and at the same time, may be considered. The requirement of simultaneous filing is important in order that a definite date of disclosure is established, i.e. the date of making the basic application. (Note, however, ‘Subregulation 3.12(2)(b)(iii)’ below).
2.12.1.3 Priority Date Issues Specific to Convention Applications

Subregulation 3.12(2)(b)(iii)

Subregulation 3.12(2)(b)(iii) provides for situations where the specification accompanying the basic application is a provisional specification and, at a date subsequent to the date of making such an application, a complete-after-provisional specification is filed. Provided the complete-after-provisional specification is filed in a Convention country before the Convention application is made in Australia, reg 3.12(2)(b)(iii) enables the date of filing of the complete-after-provisional specification to be a priority date for relevant claims of a standard patent application.

Where a complete-after-provisional specification is filed in a Convention country before the date of the Convention application in Australia, but was not relied upon for the purpose of establishing a basis for partial priorities, the matter may be subsequently remedied by the filing of an appropriate copy of the specification.

Disclosure by Way of Disclaimer or Acknowledgement of Prior Art

Matter disclosed by way of disclaimer, or acknowledgment of prior art, is not disclosed for the purposes of priority rights. Disclaimers are to be understood as actual and specific disclaimers and, therefore, will almost always occur in the descriptive portion of the basic application. The principle of law that what is not claimed is disclaimed is not applicable to determining what constitutes a disclaimer in this context. Similarly, words in the description which limit the invention to the claims are not to be construed as a disclaimer of matter which is described but not claimed.

Basic Application Outside 12 Month Convention Period

Where a claim of a Convention application is fairly based on matter disclosed in a basic application which was lodged more than 12 months before the filing date of the Convention application, its priority date is the date of filing of the Convention application. This applies regardless of whether the same matter has been disclosed in subsequently filed basic
applications made within the specified 12 month period (unless the earlier basic application is taken never to have been made under sec 43(5)).

**Note:** Prior to 15 April 2013, an earlier basic application may have been disregarded under sec 96. Any sec 96 request filed **on or after** 15 April 2013 is of no effect.

See also [2.21.3.5 Basic Application Outside 12 Month Convention Period](#).

**Modified Date: 03 August 2015**

## 2.12.1.3A Priority Date Issues Specific to Convention Applications

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed **on or after** 15 April 2013.
- innovation patents with an examination request filed **on or after** 15 April 2013.
- innovation patents where the Commissioner **had not decided before** 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see [2.12.1.3 Priority Date Issues Specific to Convention Applications](#).

In this topic:

### Overview

Regulation 3.13B indicates the type of documents that may serve as a priority document for a Convention application. This includes all the documents filed at the same time as a basic application that is related to the Convention application.

For priority purposes, matter is deemed to have been disclosed if it was disclosed or claimed in a basic application. Only that application, or a specification or other document (taken individually or together) filed in its support and at the same time, may be considered. The requirement of simultaneous filing, under sec 43AA and reg 3.14B, is important in order that...
2.12.1.4 Priority Date Issues Relating to Amended Claims

A definite date of disclosure is established, i.e. the date of making the basic application. (Note, however, ‘Subregulation 3.13B(3)’ below).

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**Subregulation 3.13B(3)**

Subregulation 3.13B(3) provides for situations where the specification accompanying the basic application is a provisional specification and, at a date subsequent to the date of making such an application, a complete-after-provisional specification is filed. Provided the complete-after-provisional specification is filed in a Convention country before the Convention application is made in Australia, reg 3.13B(3) stipulates that the complete-after-provisional application is taken to be another related basic application filed on the day the complete-after-provisional specification was filed.

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**Basic Application Outside 12 Month Convention Period**

Where a claim of a Convention application is enabled by the disclosure of a basic application which was lodged more than 12 months before the filing date of the Convention application, its priority date is the date of filing of the Convention application. This applies regardless of whether the same matter has been disclosed in subsequently filed basic applications made within the specified 12 month period (unless the earlier basic application is taken never to have been made under sec 43(5)).

See also 2.21.3.5A Basic Application Outside 12 Month Convention Period.

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**Modified Date: 03 August 2015**

2.12.1.4 Priority Date Issues Relating to Amended Claims

**Note:** The information in this part only applies to:
2.12.1.4A Priority Date Issues Relating to Amended Claims

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.

- requests to amend filed on or after 15 April 2013 for:
  - standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  - innovation patents with an examination request filed before 15 April 2013.
  - innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
  - standard patents granted, and innovation patents certified, before 15 April 2013.

For all other requests to amend, see 2.12.1.4A Priority Date Issues Relating to Amended Claims.

Section 114 provides a general mechanism for determining the priority date where a complete specification has been amended. The section applies to all amendments and can be invoked prior to acceptance.

When a previously allowed amendment results in a specification claiming matter that was in substance disclosed only as a result of amending the specification, the priority date of that claim is the date that the amendment was filed (reg 3.14).

The most common reason for invoking sec 114 is in relation to national phase applications, where the specification is deemed amended under sec 89(4) and sec 89(5). (Note that the provisions of sec 89(4) and sec 89(5) only apply to PCT applications filed before 15 April 2013).

Note: The information in this part only applies to:

- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.
2.12.2.1 Filing Dates

requests to amend filed on or after 15 April 2013 for innovation patent applications, and
innovation patents where a request for examination was not filed before 15 April 2013, or
the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other requests to amend, see 2.12.1.4 Priority Date Issues Relating to Amended
Claims.

Section 114 provides a general mechanism for determining the priority date where a
complete specification has been amended and can be invoked prior to acceptance.

When a previously allowed amendment results in a specification claiming an invention that:

- prior to the amendment was not disclosed in a sufficiently clear enough and complete
  enough manner for the invention to be performed by the person skilled in the art; but
- after the amendment, was sufficiently disclosed;

the priority date of the claim is the date that the amendment was filed (reg 3.14).

The most common reason for invoking sec 114 is in relation to national phase applications,
where the specification is deemed amended under the circumstances of sec 29A and reg
3.5AC. (Note that the provisions of sec 29A and reg 3.5AC only apply to PCT applications
filed on or after 15 April 2013).

Note: Section 114 does not apply where an amendment is allowed under sec 102(3).

2.12.2 Filing Dates

Modified Date: 25 February 2019

2.12.2.1 Filing Dates

In this topic:

Note: Where there is conflicting evidence regarding the date of filing a document, the matter
should be referred for determination to the Assistant General Manager (OEP). This may
occur, for example, where a party has a receipt for filing a document with the Office, but the
Office has no document on file and no record of receipt.

This document is controlled. Its accuracy can only be guaranteed when viewed
electronically.

Effective Date: 25 September 2019
Filing Dates – Patent Applications Other Than PCT Applications

An application is made by filing a patent request accompanied by a complete specification. Each application is given a filing date in accordance with reg 3.5 and this date is subsequently recorded in PAMS. The filing date will be the date of filing of:

a. information in English, which either explicitly or implicitly indicates that what is filed is intended to be a complete specification for a patent;

b. the name of the applicant and/or an address; and

c. information which, on the face of it, appears to be a description.

For the purposes of c., a description:

- does not have to be in English; and
- may be a drawing, graphic or photograph; and
- may be a reference, in English, to a previously filed application, which may or may not be in English.

Where any of a. to c. is not complied with, the Commissioner will notify the applicant and allow them two months in which to comply or make observations. If the applicant does not respond within the time limit, then the application will be treated as not having been filed. If the applicant responds, and as a consequence the application is now considered to satisfy requirements a. to c., the filing date will be the date of the applicant's response. If, as a consequence of observations made in a response, the application as originally filed is considered to meet requirements a. to c., the filing date will be the original filing date.

Missing Parts

Where the application complies with the requirements above, but it is noticed that parts of the application appear to be missing, the Commissioner will notify the applicant and allow them two months in which to file the missing parts. Note, however, that “notice” in reg 3.5A means in the normal process of according a filing date to the application, and does not encompass the situation where the Commissioner is made aware of a missing part by having an applicant draw the missing part to the Commissioner’s attention (see Glad Products Company’s Application [2006] APO 26).
If, after having been notified of missing parts, the applicant subsequently files the missing parts, then the filing date will be the date that those parts were filed. However, if the applicant files the missing parts and then subsequently withdraws them within one month of the Commissioner notifying the applicant of the later filing date, that date will be removed and the original filing date will stand.

Where parts of an application appear to be missing and the applicant claims priority from an earlier basic application or associated provisional application, if the applicant files a copy of the earlier application, accompanied by a translation if necessary, within two months of being notified of the existence of the missing parts and:

- the missing parts are completely contained within the earlier application;
- the location of the missing parts in the earlier application is indicated; and
- the original application contained an indication that the contents of the earlier application were incorporated in the application;

then the filing date will be the original filing date.

In any of the situations referred to above, if the applicant does not respond to a notification from the Commissioner, the filing date will be the original filing date. In this circumstance, the missing parts may only be incorporated into the application by amendment under sec 104, if allowable.

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**Filing Dates – PCT Applications**

**PCT Applications Filed On or After 15 April 2013**

The filing date of a PCT application is determined under reg 3.5AA. In general, the filing date is the international filing date as indicated on the front page of the PCT pamphlet. In rare circumstances, the Commissioner may treat another date as the international filing date (reg 3.5AA(b)), or give an international filing date to an application where no date was given by the receiving Office (reg 3.5AA(c)).

**PCT Applications Filed Before 15 April 2013**

The filing date of a PCT application is determined under sec 88. In general, the filing date is the international filing date as indicated on the front page of the PCT pamphlet. In rare circumstances, the Commissioner may treat another date as the international filing date (sec 10).
2.12.2.2 Effect of Hours of Business, Time Zones and Public Holidays

The date of filing for documents filed in the Office is the date that the Office receives the document. For paper documents, documents cannot be received outside the hours which the Office is open for business. Documents filed electronically after close of business of the Office, but before midnight (in the time zone of the Office), are entitled to that date as their filing date, provided that transmission is completed before midnight. However, documents received all or in part after midnight will have a later filing date based on the actual date that the whole document was received.

Under sec 222A, if the end of a period for filing a document occurs on a Saturday, Sunday or a day that the Office is not open for business, that period expires on the next day that the Office is open for business. However, if a document is filed on a Sunday, its filing date is Sunday's date, not the date of the previous Friday.

The Office is not open for business on Australia Day and Anzac Day (reg 22.10AB(1)), or any other day that is declared by the Director General or other prescribed person. Under reg 22.10AB(2), the Director General and Deputy Director General are both able to declare such days autonomously. Other Senior Executive Service (SES) employees of IP Australia may also declare such days, however only with the agreement of the Director General, Deputy Director General or another SES employee.

Declarations will be published in the Official Journal and on the What's New and Official Notices pages of the IP Australia website. Canberra (ACT) public holidays are covered by declarations made by the Director General or other prescribed person (as defined above). Note that only ACT public holidays are applicable to the filing of documents with the Office, i.e. public holidays in other states and territories are not relevant.

**Note:** Where there is conflicting evidence regarding the date of filing a document, the matter should be referred for determination to the Assistant General Manager (OEP). This may occur, for example, where a party has a receipt for filing a document with the Office, but the Office has no document on file and no record of receipt.

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Situations Where Section 222A Not Applicable
Section 222A of the Act does not apply to the following actions:

a. an act in relation to proceedings in a court or a tribunal; and


However, the Acts Interpretation Act 1901 still applies to these matters.

Note: Section 222A does not apply to an act done under the PCT. Note, however, that Rule 80.5(iii) does apply and has a similar effect where public holidays are concerned.

Modified Date: 01 August 2019

2.12.2.3 Effect of Errors in PAMS

Various categories of paper documents filed with the Office are converted to electronic format after filing. However, occasionally the paper documents will carry a physical date stamp which conflicts with the filing date recorded in PAMS. Thus, there is the potential for uncertainty to arise about what filing date is to be attributed to a particular document. Where there are any discrepancies in the filing date of a document, examiners should contact COG and advise them of the situation.

Note: Where there is conflicting evidence regarding the date of filing a document, the matter should be referred for determination to the Assistant General Manager (OEP). This may occur, for example, where a party has a receipt for filing a document with the Office, but the Office has no document on file and no record of receipt.

2.13 Examination

Modified Date: 01 March 2013

2.13 Examination

Note: While this part is concerned with the examination of standard patent applications in accordance with sec 45, special considerations apply when examining PCT applications in the national phase. Although many of these considerations are incorporated in this part,
2.13.1 Initial Considerations

Before commencing examination of an application, the following matters should be considered:

- Is the application in force? (see 2.13.2 Applications in a State of Lapse, or Lapsed)
- Has a request for examination been made? (see 2.13.4 Requests for Examination)
- Is there anything on file to indicate that there are other actions pending which may have some bearing on examination? For example:
  - letter of withdrawal (see 2.24.2.1 Withdrawal Opportunity and Effect);
  - sec 223 extension of time (see 2.13.3 Pending Section 223 Actions);
  - sec 104(1) voluntary amendments (see 2.13.7 Amendments and 2.23 Amendments).

In these situations, examiners should give consideration to the most logical sequence of actions to adopt.

- For divisional and additional applications, the parent file(s) must be obtained (see 2.10.9 Considering Relative Cases During Examination and 2.19.7 Considering Parent File During Examination).
- Have formalities requirements been complied with? (see 2.13.6 Matters of Form and 2.29 Formalities and Forms).
- Are all the documents required to make up the application on file?

Note: If some documents appear to be missing, examiners should ascertain from the copy of the filing receipt and the correspondence whether the missing documents were in fact filed. If any filed documents cannot be located, COG should be notified immediately. Where documents are present, but which clearly do not belong in the file, COG should also be informed.
2.13.2.1 Forms of Lapsing

- For cases where an original search is required, has the three person team considered an applicant/inventor name search to identify related or parallel applications? (see 4.1.3.6 Applicant/Inventor Name Searching)

2.13.2 Applications in a State of Lapse, or Lapsed

Modified Date: 25 February 2019

2.13.2.1 Forms of Lapsing

Non-payment of Continuation Fees

An application will lapse if a continuation fee has not been paid (sec 142(2)(d) and reg 13.3). There may be a period where the status of the application is uncertain, which occurs when a continuation fee is overdue for payment and the period provided by reg 13.3(1A) has not expired. During this period the application may be regarded as being in a "state of lapse".

An indication of whether a continuation fee due has been paid is given on the 'ECase Summary' screen under the 'In Force' date in PAMS. With the exception of divisional applications under sec 79B (see 2.10.7 Continuation Fees), the first fee is due 4 years after filing and subsequent fees are payable annually. Where there is no indication on the 'ECase Summary' screen that the fee due has been paid, the assumption should be made that the fee has not been paid, and examiners should proceed as set out in 2.13.2.2 Lapsing Prior to Issuing First Report.

Expiry of 12 Month Period

An application will lapse if an examination report has issued, but the application has not been accepted within the prescribed time. In general, the period of acceptance is 12 months from the date of the first report.

Modified Date: 01 March 2013

2.13.2.2 Lapsing Prior to Issuing First Report
Examination must not be carried out on a case which is either in a state of lapse or has lapsed (*Ferplas Industries Ltd. (No. 2) (1979) 49 AOJP 1185*). Applications that are in a state of lapse are identified by a warning message that appears when the Exam Request task is opened (see 5.4.12.1 Alerts and Warnings). Where examination has commenced, but the case lapses before the first report is issued, examiners should phone the attorney or applicant (if a letter has not already been sent by COG) advising that the application is in a state of lapse and a record of the conversation placed on file. The Exam Request task should remain in the work stream and not be reassigned to COG.

Similarly, if a response to a report is received in the Office while the application is still in force, but the application subsequently goes into a state of lapse before a report (clear or adverse) can be issued, the procedure outlined in the previous paragraph should be followed.

**Non-payment of Continuation Fees**

Applications that are in a state of lapse due to non-payment of a continuation fee are identified by a warning message that appears when the Exam Response task is opened (see 5.4.12.1 Alerts and Warnings). Examiners should phone the attorney or applicant (if a letter has not already been sent by COG) advising that the application is in a state of lapse and therefore examination cannot continue. A record of the conversation should be placed on file. The Exam Response task should remain in the work stream and not be reassigned to COG.

Similarly, if a response to a report is received in the Office while the application is still in force, but the application subsequently goes into a state of lapse before a report (clear or adverse) can be issued, the procedure outlined in the previous paragraph should be followed.

**Expiry of 12 Month Period**

Examiners should ensure that responses filed close to the 12 month period for acceptance are dealt with expeditiously, provided there is sufficient time to consider the issues. In general, a response to a first report filed on the last day would not be considered to allow
sufficient time for examiners to consider the matter, especially where substantive issues were raised.

Where there is insufficient time to consider the response, then the applicant or attorney must be contacted by phone and advised of this. A record of the conversation must also be placed on file. In this situation, examiners are not required to issue an adverse report, unless requested to do so by the applicant or attorney. The report need not be detailed and should only specify those objections that are being maintained.

**Note:** Where a response is filed, leaving insufficient time for consideration before the 12 month period for acceptance expires, and there has been no "error or omission" by the Patent Office, sec 223(1) does not apply (see 3.11.1.2.1 Extensions under Subsection 223(1) to Gain Acceptance).

**Note:** Where there is insufficient time to consider a response filed close to the 12 month period for acceptance, and the application consequently lapses, the Exam Response task in PAMS will be automatically removed by the system approximately one week after lapsing.

Where an application has a pending sec 223 request for an extension of time in relation to any examination matter, examination should not continue until the sec 223 request has been finalised. In particular, an application must not be accepted where an extension of time has been requested, but not yet granted.

The only exception to the above is the consideration of sec 104 amendments to insert micro-organism deposit details. In this case, the allowability of the amendment is not dependent on the sec 223 request being granted and therefore the amendment should be allowed forthwith (see also 2.7.5.1 Sections 104 and 223 - Insertion of Section 6(c) Information).

The fact that a sec 223 request may be pending will be apparent from the presence of an ‘Application for an Extension of Time’ on the file. Although the file may also contain an indication that the Commissioner or delegate is satisfied that the extension of time is justified, the extension of time (if for a period of more than 3 months) cannot be allowed until the request has been advertised in the Official Journal and the opposition period has elapsed (sec 223(4)).
2.13.4 Request for Examination

Modified Date: 01 February 2016

2.13.4.1 Request Procedures

The applicant must file a request for examination before examination of an application can commence (sec 44). Before commencing examination, examiners must check that a request for examination is on file, and if not, COG must be notified.

Attorneys will occasionally advise, after examination has been requested, that they have been instructed to take no further action in regard to a particular application. This advice does not amount to a withdrawal. Where such advice has been received, examiners should follow the procedures outlined in 2.24.2.4 Stated Disinterest in Proceeding with the Application.

Modified Date: 01 March 2013

2.13.4.2 Order of Examination

Applications should normally be examined in the order in which requests for examination are filed. However, exceptions to this practice include:

- where there are pending actions, e.g. sec 223. In these situations, examination cannot commence until the actions have been completed.

- where, for two or more cases with different request dates, it is more efficient to examine them together rather than separately. In these circumstances, the cases should be examined together.

- where examiners are waiting to receive non-patent literature from the library in respect of a case having an old request date. Examiners should (if practicable) wait for a response from the library before commencing examination.

There are also specific circumstances where the examination of certain cases should be given priority. These include:

- where the Commissioner is reasonably satisfied that examination should be expedited (see 2.13.4.3 Expedited Examination).

- where the request follows a direction to request examination given under sec 44(2), i.e. having regard to the examination of another case (reg 3.16(1)(c)).
2.13.4.3 Expedited Examination

- where the application is a divisional application.

Note: This practice has been temporarily suspended (see 2.10.11 Case Management of Divisional Applications).

2.13.4.3 Expedited Examination

Applicants may request that the examination of an application be expedited (reg 3.17). The request can be made in writing or by phone.

COG will consider and process any service request for expedited examination and then forward the expedited case to the relevant examination section as appropriate. Expedited cases will appear at the top of the section's in-tray and are highlighted in yellow.

Subregulation 3.17(2) provides that the Commissioner may expedite examination if:

'reasonably satisfied that:

a. it is in the public interest; or

b. there are special circumstances that make it desirable.'

Consequently, the Commissioner requires reasons to be provided with the request for expedited examination. Without limiting the circumstances that the Commissioner may consider justify expedited examination, valid reasons include that the invention is in a field of technology that is environmentally beneficial ('green' technology), that a valid request has been made under a Global Patent Prosecution Highway (GPPH) agreement (see 2.13.4.4 Expedited Examination Under the Global Patent Prosecution Highway) or IP Australia-European Patent Office Patent Prosecution Highway (IP Australia-EPO PPH) pilot program (see 2.13.4.5 Expedited Examination Under the IP Australia-European Patent Office Patent Prosecution Highway), or that there are pressing commercial reasons, such as the existence of a potential infringement.

Where examiners receive a phone call from an applicant requesting expedited examination, the matter should be referred to a supervising examiner who will determine whether examination should proceed on an expedited basis.

Note: Where a request for expedited examination has been allowed, a report (clear or adverse) should issue within 8 weeks from the date of the request.
2.13.4.4 Expedited Examination Under the Global Patent Prosecution Highway

Note: The following procedures apply to Global Patent Prosecution Highway (GPPH) applications filed after 6 January 2014.


Note: From 8 July 2019 examiners are no longer required to complete a PPH – Examiner Evaluation Form. Examiners should instead complete the questions regarding the GPPH application in DocGen when preparing the Exam Corro task in PAMS; see 5.10.24 Examination Report in DocGen for Accelerated Exam Request Under Patent Prosecution Highway for further information.

For applications that proceed directly to acceptance, there is no requirement to complete the PPH – Examiner Evaluation Form.

If an application does not satisfy the requirements for accelerated examination under the GPPH, examiners should follow the procedures in Application Does Not Meet GPPH Requirements below.

Further details regarding the requirements and procedures for filing a request for accelerated examination under the GPPH are provided on the IP Australia website.

In this topic:

Overview

The Global Patent Prosecution Highway (GPPH) is an initiative that allows applicants to expedite the examination process. Under the GPPH, where an applicant receives a ruling from one patent office that at least one claim in an application is allowable, the applicant may then request that another office expedite or accelerate examination of the corresponding claims in a corresponding application.
The initial Patent Prosecution Highway (PPH) pilot program between IP Australia and the USPTO commenced on 14 April 2008 and was for national applications only (national work products). It was later agreed to expand the pilot program to include work carried out under the PCT (PCT work products), commencing 24 January 2011. The pilot program was further expanded on 15 July 2011 to allow for a PPH request to be based on the examination of a corresponding application in the USPTO, regardless of where its priority application was filed. Thus, the US application could be based on a first filing in another office such as Canada, Norway or Australia, provided that both the Australian and US applications claimed priority under the Paris Convention from a common priority document.

With effect from 6 January 2014, the pilot PPH program between IP Australia and the USPTO has been superseded by an agreement between IP Australia and 25 other patent offices. The program is now known as the GPPH. IP Australia and the participating offices will continue to evaluate the results of the GPPH pilot program to determine if and how the program should be fully implemented.

The offices participating in the GPPH are known as Offices of Earlier Examination (OEE) and are listed in the table below:

<table>
<thead>
<tr>
<th>Offices of Earlier Examination</th>
<th>International Authority</th>
</tr>
</thead>
<tbody>
<tr>
<td>Austrian Patent Office (APO)</td>
<td>Yes</td>
</tr>
<tr>
<td>Canadian Intellectual Property Office (CIPO)</td>
<td>Yes</td>
</tr>
<tr>
<td>Danish Patent and Trademark Office (DKPTO)</td>
<td>No</td>
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<tr>
<td>Estonian Patent Office (EPA)</td>
<td>No</td>
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<tr>
<td>Finnish Patent and Registration Office (NBPR)</td>
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<td>German Patent and Trade Mark Office (DPMA)</td>
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<td>Hungarian Intellectual Property Office (HIPO)</td>
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<td>Icelandic Patent Office (IPO)</td>
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## 2.13.4.4 Expedited Examination Under the Global Patent Prosecution Highway

| National Institute for the Defense of Competition and the Protection of Intellectual Property of Peru (INDECOPI) | Yes |
| National Institute for the Defense of Competition and the Protection of Intellectual Property of Peru (INDECOPI) | No |
| Nordic Patent Institute (NPI) | Yes |
| Norwegian Industrial Property Office (NIPO) | No |
| Patent Office of the Republic of Poland (PPO) | No |
| Portuguese Institute of Industrial Property (INPI) | No |
| Russian Federal Service for Intellectual Property (ROSPATENT) | Yes |
| Spanish Patent and Trademark Office (SPTO) | Yes |
| Superintendence of Industry and Commerce – Colombia (SIC) | No |
| Swedish Patent and Registration Office (PRV) | Yes |
| United Kingdom Intellectual Property Office (UKIPO) | No |
| United States Patent and Trademark Office (USPTO) | Yes |
| Visegrad Patent Institute (VPI) | Yes |

**Note:** The European Patent Office (EPO) is not a part of the GPPH program and has an independent PPH pilot program with IP Australia. For applications expedited under the IP Australia-EPO PPH where the EPO is the OEE, examiners should follow the procedures outlined in 2.13.4.5 Expedited Examination Under the IP Australia-European Patent Office Patent Prosecution Highway.
Requirements for Accelerated Examination Under the GPPH Pilot Program

There are three requirements for accelerated examination under the GPPH:

**Requirement 1: The AU Application Must be Appropriately Associated With Either an Overseas Application (National Work Products) or a PCT Application (PCT Work Products)**

**1A. National Work Products**

The AU application must be a complete application for a standard patent and be associated with a corresponding overseas application that has been examined by one of the participating OEE and one or more claims have been deemed to be allowable/patentable.

The AU application must be associated with the overseas application in one of the following ways:

i. The AU application claims priority from the overseas application; or

ii. The AU and overseas applications are both based on the same PCT application; or

iii. The AU application and overseas application claim priority from a common priority document. The priority document can be filed in any jurisdiction; or

iv. The AU application is the basis of priority claim for the overseas application; or

v. The AU application is a divisional of an application referred to in i, ii, iii or iv above.

**1B. PCT Work Products**

The AU application must be a complete application for a standard patent and is associated with a corresponding PCT application which has one or more claims that the ISA or IPEA has indicated to be allowable/patentable in a written opinion or examination report. The ISA or IPEA must have been one of the OEE.

The AU application must be associated with the PCT application in one of the following ways:

i. The AU application is the PCT application and it has entered national phase; or

ii. The AU application claims priority from the PCT application; or

iii. The AU application is a priority document for the PCT application; or

iv. The AU application is a divisional of an application referred to in i, ii, or iii above.
The GPPH program is not a mechanism for requesting expedited examination of an AU application where IP Australia was the ISA or IPEA and the PCT application is an Australian PCT application. In this situation examiners should follow the procedures in Application Does Not Meet GPPH Requirements below.

**Requirement 2: Corresponding Australian Claims**

All claims in the AU application must sufficiently correspond or be amended to sufficiently correspond to one or more of those allowable/patentable claims of the overseas or PCT application examined by the OEE.

Claims shall be considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims are of the same, similar or narrower scope as the claims indicated as allowable/patentable. In this regard, a claim that is narrow in scope occurs when the claim is amended to be further limited by an additional feature that is disclosed in the specification (description and/or claims). A claim which introduces a new/different category of claims to those claims indicated as allowable/patentable is not considered to sufficiently correspond. However, where Australian law allows variation in the category of claims, applicants may consider adapting their claims, for example to include product by process claims.

**Requirement 3: Australian Examination Request**

To proceed under the GPPH the applicant must file a request for examination and make a request to expedite examination under the GPPH. The request to proceed under the GPPH will often be in the form of a completed PPH request form; however, other formats are acceptable provided the required details are supplied (see below).

Examination under the GPPH can only be requested if examination of the application has not commenced, i.e. a first report has not been dispatched.

Examiners should contact the PPH Contact Officer via the MDB-PPBRG-PPH mailbox where an application appears to be a GPPH application, but does not satisfy the requirements for accelerated examination under the GPPH, or does not include the required documentation as indicated below.
## Documentation Required to Support a Request for Accelerated Examination Under the GPPH Pilot Program

The following documentation is required:

1. A copy of one or more office actions issued by the OEE, or ISO/IPEO/IPER/IPRP issued by the ISA/IPEA where they are also an OEE, on the corresponding overseas or PCT application that indicates the allowability/patentability of the claims being examined.

An indication of allowable/patentable claims follows substantive examination, including consideration of novelty and inventive step, by the OEE. Acceptable office actions include the following:

<table>
<thead>
<tr>
<th>OEE</th>
<th>Office Action Indicating Allowability/Patentability of Claims</th>
</tr>
</thead>
<tbody>
<tr>
<td>APO</td>
<td>Granted Patent Publication and/or Office Action entitled: &quot;Erteilungsbeschluss&quot; (Decision to grant a patent) or &quot;(Letzter) Vorbescheid&quot; (Office Action relating to Intention to Grant).</td>
</tr>
<tr>
<td>DKPTO</td>
<td>Granted Patent Publication and/or an Office Action entitled: &quot;Godkendelse&quot; (Notice of Grant), &quot;Berigtigelse af bilag&quot; (&quot;Intention to Grant&quot; in English version letter) or &quot;Resultatet af din n. tekniske behandling af din patentansøgning&quot; (&quot;nth technical examination of your patent application&quot; in English version letter).</td>
</tr>
<tr>
<td>DPMA</td>
<td>Search Report (&quot;Recherchenbericht&quot; - Sec. 43 Patent Act in its version valid from 1 April 2014) in the case where all of the claims within the patent application are identified as patentable; Office Action (&quot;Prüfungsbescheid&quot;) where at least one of the claims is explicitly identified as patentable; Decision to Grant a Patent (&quot;Erteilungsbeschluss&quot;); Patent Specification (&quot;Patentschrift&quot;).</td>
</tr>
<tr>
<td>EPA</td>
<td>Granted Patent Publication and/or in an Office Action &quot;Patendi väljaandumise otsus&quot; (Decision to Grant); Search Report with Written Opinion.</td>
</tr>
</tbody>
</table>
| NBPR      | Granted Patent Publication and/or an Office Action ("Office
<table>
<thead>
<tr>
<th>Organization</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>HIPO</td>
<td>Written Opinion (Írásos vélemény, Letter Code “77”) where the claims are explicitly identified as patentable or allowable, Letter relating to Intention to Grant (Letter Code “SM”).</td>
</tr>
<tr>
<td>IPO</td>
<td>Granted Patent Publication and/or an Office Action entitled: &quot;Tilkynning um veitingu einkaleyfis&quot; (e. Notification of Grant) or &quot;Fyrirhuguð útgáfa einkaleyfis&quot; (e. Intention to Grant).</td>
</tr>
<tr>
<td>IPONZ</td>
<td>An Accepted Application or Granted Patent and/or in an office action of a published application. An IPONZ office action includes an &quot;Examination Report&quot;, &quot;Notice of Acceptance&quot; and a &quot;Notice of Grant&quot;</td>
</tr>
<tr>
<td>IPOS</td>
<td>Granted Patent Publication and/or Examination Reports addressing substantive issues.</td>
</tr>
<tr>
<td>ILPO</td>
<td>&quot;Notice of objection in accordance with regulation 41&quot;, &quot;Guide to submitting patent applications&quot; mentioning that claims have been allowed, &quot;Notice before acceptance of patent application&quot;.</td>
</tr>
<tr>
<td>JPO</td>
<td>Granted Patent Publication and/or an Office Action. A JPO Office Action includes a &quot;Notification of Reasons for Refusal&quot; and a &quot;Decision to Grant a Patent&quot;.</td>
</tr>
<tr>
<td>KIPO</td>
<td>Granted Patent Publication and/or an Office Action. A KIPO Office Action includes a &quot;Notification of Reason for Refusal&quot;, &quot;Decision to Refuse a Patent&quot; or &quot;Decision to Grant&quot;.</td>
</tr>
</tbody>
</table>
| INDECOPI     | (a) Decision to Grant a Patent  
(b) Notification of Reasons for Refusal  
(c) Decision of Refusal  
(d) Appeal Decision |
| NIPO         | Granted Patent Publication and/or in the office action entitled "Godkjenning til meddelelse" (Decision to Grant), "Uttalelse" or "Realitetsuttalelse" (Office action). |
| PPO          | Granted Patent Publication or Search Report and/or Written Opinion or Decision to grant a Patent or Decision to refuse a |
2.13.4.4 Expedited Examination Under the Global Patent Prosecution Highway

<table>
<thead>
<tr>
<th>Patent in part.</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>INPI</strong></td>
</tr>
<tr>
<td><strong>ROSPATENT</strong></td>
</tr>
<tr>
<td><strong>SIC</strong></td>
</tr>
<tr>
<td><strong>SPTO</strong></td>
</tr>
<tr>
<td><strong>PRV</strong></td>
</tr>
<tr>
<td><strong>UKIPO</strong></td>
</tr>
<tr>
<td><strong>USPTO</strong></td>
</tr>
</tbody>
</table>

2. A copy of the claims examined by the OEE and, where appropriate, copies of subsequent amended claims, found to be allowable/patentable.

3. An indication of the relationship between the AU claims and those of the OEE application.

The indication can be in the form of a completed claim correspondence table (in the PPH request form) showing the relationship between the claims of AU application and the claims of the corresponding overseas application considered allowable/patentable by the OEE; or

- the indication may be in the form of a statement that all the claims of the AU application correlate with the equivalent claims examined by the OEE; or

- the applicant may indicate the relationship in more general terms, for example “Claims 1 – 20 as proposed to be amended correspond to claims 63 – 83 of the US application”.

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
Sufficient correspondence of claims occurs where the claims are of the same, similar or narrower scope (see Requirement 2 above).

The applicant can either provide the office actions and copy of the claims with the request for examination under the GPPH, or request that IP Australia obtain the documents from the OEE’s Dossier Access System (DAS).

Examples of the OEE’s DAS include the USPTO’s Public PAIR system, UKIPO’s IPSUM system and WIPO’s Patentscope. Further examples are listed in the table below and links are provided on the Patent Examination Workbench.

The applicant must clearly identify the relevant information (document description and date) of the office actions and claims to be retrieved from the DAS on the PPH request form.

<table>
<thead>
<tr>
<th>Office</th>
<th>Dossier Access System</th>
</tr>
</thead>
<tbody>
<tr>
<td>CIPO</td>
<td>Canadian Patents Database</td>
</tr>
<tr>
<td>DKPTO</td>
<td>PVS Online</td>
</tr>
<tr>
<td>DPMA</td>
<td>DPMAregister</td>
</tr>
<tr>
<td>EPA</td>
<td>PATENDIAMET</td>
</tr>
<tr>
<td>HIPO</td>
<td>HIPO E-Dossier</td>
</tr>
<tr>
<td>ILPO</td>
<td>ILPATSEARCH</td>
</tr>
<tr>
<td>IPONZ</td>
<td>IPONZ Patent Search</td>
</tr>
<tr>
<td>JPO</td>
<td>AIPN</td>
</tr>
<tr>
<td>KIPO</td>
<td>K-PION</td>
</tr>
<tr>
<td>NBPR</td>
<td>PatInfo</td>
</tr>
<tr>
<td>NIPO</td>
<td>NIPO Advanced Search Patent</td>
</tr>
<tr>
<td>PPO</td>
<td>Register Plus</td>
</tr>
<tr>
<td>PRV</td>
<td>Swedish Patent Database</td>
</tr>
<tr>
<td>SIC</td>
<td>SIC Patent Search</td>
</tr>
<tr>
<td>UKIPO</td>
<td>IPSUM</td>
</tr>
</tbody>
</table>

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.
Effective Date: 25 September 2019
2.13.4.4 Expedited Examination Under the Global Patent Prosecution Highway

<table>
<thead>
<tr>
<th>USPTO</th>
<th>Public PAIR</th>
</tr>
</thead>
<tbody>
<tr>
<td>VPI</td>
<td>Patentscope</td>
</tr>
<tr>
<td>WIPO</td>
<td>Patentscope</td>
</tr>
<tr>
<td>WIPO</td>
<td>WIPO CASE</td>
</tr>
</tbody>
</table>

**Note:** Applicants may also file citations and translations of citations as part of the supporting documentation to allow for prompt consideration if they so desire.

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**Processing and Features of GPPH Applications**

- Expedited GPPH tasks will appear at the top of a section’s PAMS in-tray and will be highlighted in yellow.

- A comment in the PAMS comment field will indicate that the applicant has requested accelerated examination under the GPPH.

- GPPH applications should be examined using the same procedure as for expedited examination on an application where there are FERs on file (see 2.13.4.3 Expedited Examination).

- The process of providing FERs and citations by COG will follow the normal procedures and all available FERs will be present in the Ecase.

- Examiners will need to indicate that the application is an accelerated examination under the Patent Prosecution Highway on the ‘Basis of the Report’ screen when creating the examination report in DocGen. This will create a paragraph in the report identifying that accelerated examination has been requested under the PPH.

- GPPH applications should always have copies of at least one office action, or ISO/IPEO/IPER/IPRP issued by an OEE on file. All claims should sufficiently correspond, or be amended to sufficiently correspond, to a claim indicated as allowable or patentable. Sufficient correspondence of claims occurs where the claims are of the same, similar or narrower scope.
2.13.4.4 Expedited Examination Under the Global Patent Prosecution Highway

**Examination Practice**

Although requests for examination under the GPPH require the OEE to have found at least one claim to be allowable, examiners should consider all grounds of examination. In particular examiners should have due regard to relevant issues and citations raised in FERs and search results. Examiners are not precluded from carrying out an original search if warranted.

As indicated above, all claims being examined should sufficiently correspond to a claim examined by the OEE and at least one claim should be indicated as allowable or patentable in an office action or ISO/IPEO/IPER/IPRP issued by the OEE, or fall within the scope of such a claim. Claims are considered to sufficiently correspond where the claims are of the same, similar or narrower scope. Claims can be of the same or similar scope and also allow for differences in language and drafting style.

For example, a method of treatment claim considered allowable in the USPTO could have a corresponding Australian claim in the form of a use claim or Swiss-type claim which could be considered of the same or similar scope.

Similarly, a US claim directed to a method of using an apparatus could have a similar scope to an Australian claim directed to an apparatus when used for the same purpose.

Examiners should use their judgement in determining whether the claims are of the same or similar scope and in determining the extent to which reliance can be placed upon the conclusions of the OEE in accordance with the procedures for using FERs (see 2.1.9 Guidelines for Using IPRPI/IPRPIIs and Other Foreign Examination Reports (FERs) in Examination). Note that the specification (including the claims) of the GPPH application does not need to be the same as the corresponding application examined by the OEE in order to satisfy the requirement that all claims sufficiently correspond to claims indicated as allowable or patentable in an OEE office action.

---

**Application Does Not Meet GPPH Requirements**

1. If an AU application is filed as a GPPH application, but the claims of the AU application are found to be not allowable by an OEE or found to have a scope that is not the same or similar as allowable/accepted claims; or

2. If an AU application is filed as a GPPH application, but the claims of the AU application are examined and/or allowed by IP Australia or another patent office which is not an OEE (for example CN, as China is not a part of the GPPH); or

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This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
3. If an AU application is filed as a GPPH application, but the required documents are not provided;

examiners should contact the applicant to seek clarification and inform them that the application does not meet the GPPH requirements, or request that the applicant file the required documents.

Where it remains the case that the requirements are not met, examiners are to proceed with examination of the application as a standard expedited examination and adhere to the Customer Service Charter (see Customer Service Charter Timeliness Guidelines). Examiners should include a note under the Additional Comments section of the examination report that the GPPH requirements have not been met.

Examiners may contact the PPH Contact Officer via the MDB-PPBRG-PPH mailbox for any other issues regarding GPPH applications.

Modified Date: 01 August 2019

2.13.4.5 Expedited Examination Under the IP Australia-European Patent Office Patent Prosecution Highway

Note: The following procedures apply to IP Australia-European Patent Office Patent Prosecution Highway (IP Australia-EPO PPH) requests filed on or after 1 July 2016.

Note: From 8 July 2019 examiners are no longer required to complete a PPH - Examiner Evaluation Form. Examiners should instead complete the questions regarding the IP Australia-EPO PPH application in DocGen when preparing the Exam Corro task in PAMS; see 5.10.24 Examination Report in DocGen for Accelerated Exam Request Under Patent Prosecution Highway for further information.

For applications that proceed directly to acceptance, there is no requirement to complete the PPH – Examiner Evaluation Form.

If an application does not satisfy the requirements for accelerated examination under the IP Australia-EPO PPH, examiners should follow the procedures in Application Does Not Meet IP Australia-EPO PPH Requirements below.
2.13.4.5 Expedited Examination Under the IP Australia-European Patent Office Patent Prosecution Highway

Further details regarding the requirements and procedures for filing a request for accelerated examination under the IP Australia-EPO PPH are provided on the IP Australia website.

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Background

The European Patent Office (EPO) and IP Australia commenced a comprehensive Patent Prosecution Highway pilot program on 1 July 2016. The pilot initially ran for a period of three years ending on 30 June 2019. It was later agreed to extend the pilot program for a further three years ending on 30 June 2022.

The PPH pilot program leverages fast-track patent examination procedures already available at the offices to allow applicants to obtain corresponding patents faster and more efficiently.

The EPO and IP Australia will evaluate the results of the pilot program to determine whether and how the program should be fully implemented after the trial period. The trial period may be extended if necessary to adequately assess the feasibility of the PPH program. Either party may also terminate the PPH pilot program early if the volume of participation exceeds a manageable level, or for any other reason. Notice will be published if the PPH pilot program between the EPO and IP Australia is terminated before 30 June 2022.

---

Requirements for Requesting Participation in the IP Australia-EPO PPH Pilot Program

In order to be eligible to participate in the PPH pilot program, the following requirements must be met:

**Requirement 1: The AU Application Must Have the Same Earliest Date With the Corresponding Application, Whether this be the Priority or Filing Date of a Corresponding National Application Filed With the EPO or a Corresponding PCT Application for Which the EPO Has Been the ISA and/or IPEA.**

1A. National Work Products
The AU application must be a complete application for a standard patent and be associated with a corresponding EP application that has been examined by the EPO and one or more claims have been deemed to be allowable/patentable.

The AU application must be associated with the EP application in one of the following ways:

i. The AU application claims priority from the EP application; or
ii. The AU and EP applications are both based on the same PCT application; or
iii. The AU application and EP application claim priority from a common priority document. The priority document can be filed in any jurisdiction; or
iv. The AU application is the basis of priority claim for the EP application; or
v. The AU application is a divisional of an application referred to in i, ii, iii or iv above.

1B. PCT Work Products

The AU application must be a complete application for a standard patent and is associated with a corresponding PCT application which has one or more claims that the EPO as the ISA and/or IPEA has indicated to be allowable/patentable in a written opinion or examination report.

The AU application must be associated with the PCT application in one of the following ways:

i. The AU application is the PCT application and it has entered national phase; or
ii. The AU application claims priority from the PCT application; or
iii. The AU application is a priority document for the PCT application; or
iv. The AU application is a divisional of an application referred to in i, ii, or iii above.

The IP Australia-EPO PPH program is not a mechanism for requesting expedited examination of an AU application where IP Australia was the ISA or IPEA and the PCT application is an Australian PCT application. In this situation examiners should follow the procedures in Application Does Not Meet IP Australia-EPO PPH Requirements below.

Requirement 2: Corresponding Australian Claims

All claims in the AU application for which a request for participation in the IP Australia-EPO PPH pilot program is made must sufficiently correspond to the patentable/allowable claims in the corresponding EP application(s).

Claims are considered to sufficiently correspond where, accounting for differences due to claim format requirements, the claims are of the same or a similar scope or the claims in the
2.13.4.5 Expedited Examination Under the IP Australia-European Patent Office Patent Prosecution Highway

application are narrower in scope than the claims in the corresponding EP application(s). In this regard, a claim that is narrower in scope occurs when an EP claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). A claim which introduces a new/different category of claims to those claims indicated as allowable/patentable is generally not considered to sufficiently correspond. However, where Australian law allows variation in the category of claims, applicants may consider adapting their claims, for example to include product by process claims. The applicant is required to indicate that the claims between the AU and the EP applications sufficiently correspond.

Requirement 3: Australian Examination Request

To proceed under the IP Australia-EPO PPH the applicant must file a request for examination and make a request to expedite examination under the PPH. The request to proceed under the PPH will often be in the form of a completed PPH request form; however, other formats are acceptable provided the required details are supplied (see below).

Examination under the PPH can only be requested if examination of the application has not commenced, i.e. a first report has not been dispatched.

Documents Required for Participation in the IP Australia-EPO PPH Pilot Program

For participation in the PPH pilot program at IP Australia the applicant has to:

1. File a request for participation in the PPH pilot program. The Request Form: Patent Prosecution Highway Pilot Program (P/00/001P (0516)) is available via the IP Australia website at www.ipaustralia.gov.au.

2. Submit an indication of claims correspondence which is included in the request form.

3. Submit a copy of:
   
   - either all the office actions for the corresponding application(s) filed with the EPO containing the patentable/allowable claims that are the basis for the IP Australia-EPO PPH request and a translation thereof in English; or

   - the latest work product in the international phase of a PCT application, the WO-ISO or, where a demand under PCT Chapter II has been filed, the WO-IPRP and a translation thereof in English.
4. Submit a copy of the patentable/allowable claim(s) from the EP application(s) and a translation thereof in English.

In those instances where the request for participation in the IP Australia-EPO PPH pilot program does not meet all the requirements set forth above, the applicant may be notified of the deficiencies in the request. The applicant will be allowed to correct deficiencies identified and if not corrected, the application may be taken out of the IP Australia-EPO PPH program.

**Supporting Documents**

If any of the documents identified in points (3) and (4) above:

a. have already been filed in the AU application prior to the request for participation in the IP Australia-EPO PPH pilot program, it will not be necessary for the applicant to resubmit these documents with the IP Australia-EPO PPH request.

   The applicant may simply refer to these documents and indicate in the request for participation in the IP Australia-EPO PPH pilot program when these documents were previously filed in the AU application.

b. are available via Espacenet or PatentScope, the applicant does not need to submit a copy thereof, but has to provide a list of the documents to be retrieved. Machine translations will be admissible for the documents identified in points (3) and (4).

IP Australia may request applicants to submit a verified translation of the documents identified in points (3) and (4) above if they are insufficient. If the EP application(s) is (are) unpublished, the applicant must submit the documents identified in points (3) and (4) above upon filing the IP Australia-EPO PPH request.

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**Processing and Features of IP Australia-EPO PPH Applications**

- Expedited PPH tasks will appear at the top of a section’s PAMS in-tray and will be highlighted in yellow.

- IP Australia-EPO PPH applications should be examined using the same procedure as for expedited examination on an application where there are FERs on file (see 2.13.4.3 Expedited Examination).
2.13.4.5 Expedited Examination Under the IP Australia-European Patent Office Patent Prosecution Highway

- The process of providing FERs and citations by COG will follow the normal procedures and all available FERs will be present in the Ecase.

- Examiners will need to indicate that the application is an accelerated examination under the Patent Prosecution Highway on the ‘Basis of the Report’ screen when creating the examination report in DocGen. This will create a paragraph in the report identifying that accelerated examination has been requested under the PPH.

- IP Australia-EPO PPH applications should always have copies of at least one office action, or ISO/IPEO/IPER/IPRP issued by the EPO on file. All claims should sufficiently correspond, or be amended to sufficiently correspond, to a claim indicated as allowable or patentable. Sufficient correspondence of claims occurs where the claims are of the same, similar or narrower scope.

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**Examination Practice**

Although requests for examination under the IP Australia-EPO PPH require the EPO to have found at least one claim to be allowable, examiners should consider all grounds of examination. In particular examiners should have due regard to relevant issues and citations raised in FERs and search results. Examiners are not precluded from carrying out an original search if warranted.

As indicated above, all claims being examined should sufficiently correspond to a claim examined by the EPO and at least one claim should be indicated as allowable or patentable in an office action or ISO/IPEO/IPER/IPRP issued by the EPO, or fall within the scope of such a claim. Claims are considered to sufficiently correspond where the claims are of the same, similar or narrower scope. Claims can be of the same or similar scope and also allow for differences in language and drafting style.

Examiners should use their judgement in determining whether the claims are of the same or similar scope and in determining the extent to which reliance can be placed upon the conclusions of the EPO in accordance with the procedures for using FERs (see 2.1.9 Guidelines for Using IPRPI/IPRPPIs and Other Foreign Examination Reports (FERs) in Examination). Note that the specification (including the claims) of the PPH application does not need to be the same as the corresponding application examined by the EPO in order to satisfy the requirement that all claims sufficiently correspond to claims indicated as allowable or patentable in an EPO office action. However, where Australian law allows variation in the category of claims, applicants may consider adapting their claims, for example to include product by process claims.
Application Does Not Meet IP Australia-EPO PPH Requirements

1. If an AU application is filed as an IP Australia-EPO PPH application, but the claims of the AU application are found to be not allowable by the EPO or found to have a scope that is not the same or similar as allowable/accepted claims; or

2. If an AU application is filed as an IP Australia-EPO PPH application, but the claims of the AU application are examined and/or allowed by IP Australia; or

3. If an AU application is filed as an IP Australia-EPO PPH application, but the required documents are not provided;

Examiners should contact the applicant to seek clarification and inform them that the application does not meet the IP Australia-EPO PPH requirements, or request that the applicant file the required documents.

Where it remains the case that the requirements are not met, examiners are to proceed with examination of the application as a standard expedited examination and adhere to the Customer Service Charter (see Customer Service Charter Timeliness Guidelines). Examiners should include a note under the Additional Comments section of the examination report that the IP Australia-EPO PPH requirements have not been met.

Examiners may contact the PPH Contact Officer via the MDB-PPBRG-PPH mailbox for any other issues regarding IP Australia-EPO PPH applications.

2.13.5 Stringency of Tests During Examination

Modified Date: 01 March 2013

2.13.5.1 Introduction

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
2.13.5.1A Introduction

For all other standard patent applications/innovation patents, see 2.13.5.1A Introduction.

The Act requires that, before accepting an application for a standard patent or certifying an innovation patent, the Commissioner must be "satisfied" that the criteria for novelty and inventive step (innovative step) are met. For all other objections, the Act requires that the Commissioner "considers" that there is no lawful ground of objection. In practice, this means the threshold test for assessing novelty, inventive step and innovative step is the standard based on "balance of probabilities". For all other objections, the applicant should be given "the benefit of the doubt". The relevant test, whether it is "balance of probabilities" or "benefit of the doubt", should be applied.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.13.5.1 Introduction.

The Act requires that, before accepting a standard patent application or certifying an innovation patent, the Commissioner must be "satisfied, on the balance of probabilities" that the criteria for patentability are met. In practice, this means the threshold test for assessing all grounds of objection is the standard based on "balance of probabilities".

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.

Modified Date: 01 March 2013

2.13.5.2 Balance of Probabilities

Note: The information in this part only applies to:
The objections of novelty, inventive step and innovative step are raised, and maintained, on the balance of probabilities.

The balance of probabilities requires examiners to weigh up all the material before them and decide, on balance, whether an objection is more likely than not to be applicable. Another way of viewing the balance of probabilities is that the objection is highly plausible, more probable than not or prima facie reasonable.

At first report, examiners need only determine whether an objection is prima facie reasonable. In response to the objection, applicants can provide submissions or evidence that shifts the balance of probabilities in their favour. It is not sufficient for the applicant to merely raise doubts in the examiner’s mind; there must be a substantial doubt before an objection is withdrawn. In most cases, persuasive reasoned argument from the applicant in response would be sufficient to tip the scales in the applicant’s favour, however there may be circumstances where supporting evidence is required. For example, if a statement in the submission is improbable, substantial supporting evidence would be required to convince an examiner. Supporting evidence would not be necessary where the submission is inherently probable.

Where doubt (even substantial doubt) is raised by the applicant, examiners need to consider whether the balance could be shifted in favour of maintaining the objection by identifying further information that would support the objection. For example, evidence might be obtained that rebuts an assertion made by the applicant.

Submissions from applicants that a novelty or inventive/innovative step objection based on a foreign language document cannot be maintained, on the grounds that it has not been demonstrated that an English translation of the document (machine or otherwise) was available to the public before the priority date, should not be accepted. In this situation, it is reasonable for examiners to argue that applying the balance of probabilities, the onus falls on the applicant to demonstrate that the relevant features are not disclosed in the document.
The balance of probabilities only applies to questions of fact. Thus, during examination, examiners should apply the balance of probabilities test in weighing up factual matters that form the basis for an objection. Factual matters are most relevant in the context of novelty and inventive step. For example, what a document would disclose to a skilled person, or what would be a matter of routine for the skilled addressee, should be determined on the balance of probabilities. Having determined the facts, the relevant law can then be applied.

Questions of law, such as the proper construction of a claim, and whether a claim when properly construed defines a manner of manufacture, or novel or inventive subject matter, are not open to a balancing of probabilities or questions of doubt. Consequently, submissions along those lines should not be accepted. Any uncertainties in how the law is to be applied to the facts are to be resolved by the decision maker; during examination this is the examiner.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.13.5.2 Balance of Probabilities.

All grounds of objection are raised, and maintained, on the balance of probabilities. The balance of probabilities requires examiners to weigh up all the material before them and decide, on balance, whether an objection is more likely than not to be applicable. Another way of viewing the balance of probabilities is that the objection is highly plausible, more probable than not or prima facie reasonable.

At first report, examiners need only determine whether an objection is prima facie reasonable. In response to the objection, applicants can provide submissions or evidence that shifts the balance of probabilities in their favour. It is not sufficient for the applicant to
merely raise doubts in the examiner’s mind; there must be a substantial doubt before an objection is withdrawn. In most cases, persuasive reasoned argument from the applicant in response would be sufficient to tip the scales in the applicant’s favour, however there may be circumstances where supporting evidence is required. For example, if a statement in the submission is improbable, substantial supporting evidence would be required to convince an examiner. Supporting evidence would not be necessary where the submission is inherently probable.

Where doubt (even substantial doubt) is raised by the applicant, examiners need to consider whether the balance could be shifted in favour of maintaining the objection by identifying further information that would support the objection. For example, evidence might be obtained that rebuts an assertion made by the applicant.

Submissions from applicants that a novelty or inventive/innovative step objection based on a foreign language document cannot be maintained, on the grounds that it has not been demonstrated that an English translation of the document (machine or otherwise) was available to the public before the priority date, should not be accepted. In this situation, it is reasonable for examiners to argue that applying the balance of probabilities, the onus falls on the applicant to demonstrate that the relevant features are not disclosed in the document.

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**Consideration of Prior Use**

A novelty or inventive/innovative step objection may be raised on the basis of information made publicly available through doing an act, including a prior use. Information about the use, for example a report about the exhibiting of an invention at a machinery field day, is *prima facie* evidence that the invention was displayed and an objection should be raised in the first instance. However, evidence provided by the applicant as to the circumstances of the use (e.g. private and in confidence) and what was disclosed by the use will need to be weighed carefully. Examiners should consult Patent Oppositions if in doubt.

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**Balance of Probabilities - Questions of Law**

The balance of probabilities only applies to questions of fact. Thus, during examination, examiners should apply the balance of probabilities test in weighing up factual matters that form the basis for an objection. Factual matters are most relevant in the context of novelty
and inventive step. For example, what a document would disclose to a skilled person, or what would be a matter of routine for the skilled addressee, should be determined on the balance of probabilities. Having determined the facts, the relevant law can then be applied.

Questions of law, such as the proper construction of a claim, and whether a claim when properly construed defines a manner of manufacture, or novel or inventive subject matter, are not open to a balancing of probabilities or questions of doubt. Consequently, submissions along those lines should not be accepted. Any uncertainties in how the law is to be applied to the facts are to be resolved by the decision maker; during examination this is the examiner.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.13.5.2A Balance of Probabilities.

In the case of objections other than novelty, inventive step and innovative step, objections are assessed on the basis of the benefit of doubt. In order to raise an objection, examiners do not need to be absolutely certain that the objection should be taken. All that is necessary is that they are reasonably sure that the objection should be taken. An objection should not be taken if there is genuine doubt about the correctness of the objection. In this sense, the applicant is given the benefit of the doubt.

When considering further reports, objections are maintained if there is little uncertainty as to whether the objection still applies (having regard to the response from the applicant). The benefit of the doubt should not be given to the applicant when the counter-argument advanced by the applicant is possible, but not credible.

Examiners may have doubts as to how the law applies to a particular case, or what the person skilled in the art may understand, or how the person skilled in the art would assess words or react to circumstances. It must be appreciated that for the purpose of an examination report, it is the examiner's doubts that matter. The doubts of any person other
than the examiner (for example, doubts expressed by the patent attorney on behalf of the applicant) are not relevant.

Note: The formality considerations outlined below do not apply to PCT applications that have entered the national phase. For these applications, examiners should refer to 2.20.1.4 Formality Requirements and 2.20.1.4A Formalities Check.

After filing, COG will check each application for compliance with the formality requirements of the Regulations and issue a direction under reg 3.2A if necessary. Thus, most cases received by examiners will have already been placed in order, where required. Further information regarding formal requirements is provided in 2.29 Formalities and Forms.

A direction under reg 3.2A is concerned with formality requirements only and does not allow for amending the complete specification. Although an applicant may respond to a reg 3.2A direction using the provisions of sec 104 to amend the specification, the normal response to a reg 3.2A direction is the filing of substitute pages. If examiners notice during examination that the substitute pages include changes in the disclosure or meaning, then an objection should be taken that:

- the substitute documents differ in disclosure or meaning from the original document, specifying the differences; and
- since reg 3.2A does not provide for the substitution of documents that incorporate changes in disclosure or meaning, the particular differences involved should be formally proposed as amendments under sec 104, or substitute pages that do not incorporate those changes should be filed.

However, if the changes are such as to result in the specification contravening the requirements of sec 102(1) (see 2.23.8 Allowability Under Section 102(1)), the examination report should include the matters above, plus a statement to the effect that the specification as intended to be corrected under reg 3.2A does not comply with the requirements of sec 102(1). Examination should only be conducted to the extent possible on those claims that define allowable subject matter as outlined in 2.23.8.2 Section 102(1) Examination Practice, Reporting on Amendments Not Allowable Under Section102(1).

2.13.7 Amendments
2.13.7.1 Amendments in Anticipation

Where a statement of proposed amendments is filed in anticipation of an examination report, examiners are to report upon the application and complete specification as proposed to be amended and report whether the proposed amendments are not allowable.

**Note:** Where proposed amendments are not allowable, examiners should refer to 2.23.8.2 Section 102(1) Examination Practice, Reporting on Amendments Not Allowable Under Section 102(1).

Where examination has been requested and the attorney or applicant has indicated that amendments in anticipation will be filed, but has not yet done so, examiners should phone the applicant/attorney and enquire when the amendments are expected to be filed. Examiners should then indicate that they will commence examination on a certain date (not necessarily that which is indicated by the applicant or attorney). If the amendments are not received by the time the case is examined and the report is adverse, the report should be issued. If the report will be clear, examiners should advise the applicant/attorney that the case is ready for acceptance and that any amendments or request for deferment should be filed immediately. Records of phone conversations are to be placed on file (see 2.2.7.2 Communication with Applicants or Attorneys by Phone).

2.13.7.2 Notice of Incoming Amendments

Applicants and attorneys may wish to file amendments before a previously filed response has been reported on. In such circumstances, applicants and attorneys have been requested to phone examiners and forewarn them of the incoming amendments. Upon such notification, examiners are to delay examination until the further amendments are filed.

2.13.7.3 Amendments in Partial Response to a Report

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.13.7.4 Suggesting Amendments

A response to a report may sometimes be directed to certain objections, it being clear that a future response will address the remaining objections. In addition to any objections arising directly from the response, any further report must include an objection which formally maintains the previous objections not addressed by the response.

2.13.7.4 Suggesting Amendments

An objection may explicitly indicate a particular solution, but must not dictate a specific amendment. Applicants have the right to amend the specification however they consider appropriate, and a well written objection which accurately and clearly conveys the issues should elicit suitable amendments. Where there are major issues, it is even more important that applicants be allowed to follow their own course of action.

Furthermore, examiners should not dictate a specific amendment as:

- the very act of doing so may result in applicants feeling obliged to respond as dictated to ensure acceptance of their application, thereby denying themselves other, possibly better, options;
- the amendment as dictated could be wrong (see Pittsburg Plate Glass Co. (1971) RPC 55 at page 60, lines 3-19 and page 61, lines 27-31); and
- examiners, in dictating amendments, risk losing objectivity.

2.13.7.5 Late Filing of Amendments and Responses

Where attorneys intend filing a response less than one week prior to the final acceptance deadline, they have been requested to forewarn examiners by phone and subsequently forward a copy of the response via email. However, as email is not an official means for filing a response, a follow-up copy of the response must be filed by an official means (e.g. eServices) before the final deadline.

Upon such notification, examiners are to proceed with examination on the basis of the response received via email, but to delay acceptance until receipt of the official copy of the response.
2.13.8 Review of Classification

Where the IPC mark(s) allocated to an application are clearly incorrect, examiners must re-classify the application using the procedures outlined in 5.9.4 Re-Indexing Applications.

2.13.9 Searching

Under the Act, the extent of the search is discretionary. Examiners are required to report to the best of their knowledge whether the invention so far as claimed is novel and involves an inventive/innovative step when compared with the prior art base as it existed before the priority date of the claim. The prior art base is defined in Schedule 1.

Examiners will often have one or more earlier search results on which they can rely. However, where no earlier search results are available, or the earlier search results are inadequate, examiners will have to perform an original/additional search. Original/additional searches must be developed by a three person team [see 4.1.4.1 Three Person Team (3PT) and 4.1 Searching] and carried out in a manner similar to PCT international searches, as such searches could potentially assist applicants in determining whether or not to seek protection for their invention in one or more foreign countries via the PCT route.

An original/additional search may include one or more of the searching databases listed on the Patent Examination Workbench, including the Technology Specific Workbenches.

Note: Examiners are to consult with a senior examiner before conducting an original/additional search at further report stage. The senior examiner is to record the
Modified Date: 25 September 2019

2.13.11 Notices Under Section 27

Overview

Subsection 27(1) enables any person to file a notice asserting that the invention of a complete specification filed in relation to a standard patent application is not a patentable invention due to non-compliance with sec 18(1)(b). The notice must be filed between OPI and 3 months after publication in the Official Journal of acceptance of an application for a standard patent. Notices received before the OPI date are deemed not to have been filed and may not be considered in subsequent proceedings. Wherever practicable, arrangements may be made for the return of any premature notices to the original person.

During examination, examiners are required to consider matters stated in any notice filed prior to acceptance (reg 3.18(4)). Where an objection is appropriate based on the matter filed, this is to be included in either a first or further report, depending on when the notice was filed. If a notice is filed after acceptance, it may instead form the basis of a pre-grant re-examination under sec 97(1). Section 27 is not intended to be an informal type of opposition proceedings before examiners, and there is no provision in either the Act or Regulations for argument or filing of counter-evidence.
2.13.11.1 Notifications

**Note:** Under sec 28, a person may file a notice asserting that an innovation patent is invalid (see 2.31.1.11 Notification by Third Parties). The following considerations similarly apply to sec 28 notices.

**Notice Requirements**

Notices may be sent to the Commissioner by mail or filed electronically via eServices (using the General eService Request form for Patents) or via AusPat (this will generate an email to IP Australia).

The notice must contain:

- a full identification of the application to which the notice relates;
- reasons why the validity of any patent issued on the application would be affected under sec 18(1)(b); and
- a copy of any document referred to in the reasons, or a reference or URL link to the document.

If the published document is not a patent, the notice must in addition be accompanied by evidence establishing where and when that document was published (if this is not apparent from the document itself).

If a document is not in English (whether patent or non-patent), a translation must be provided. *(For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided).* Any documents accompanying the notice are OPI.

**Filing of Notice**

It is the responsibility of the person filing a notice under sec 27(1) to ensure the correctness of the contents of the statement or any other accompanying documents. Notices are not subject to examination and, pursuant to sec 27(2), the Commissioner will inform the applicant of any matter to which the notice relates without any verification of that matter. There is no limitation on the number of notices under sec 27(1) which may be filed by the same person, or by a number of persons.

Notices filed pursuant to sec 27(1) are inspected by COG to ensure that they are properly filed. The inspection is of the notice only and does not extend to any attachments. Notices...
duly filed before commencement of examination are added to the Ecase under the document name ‘Notices under subsection 27(1)’.

Any notice filed after acceptance will be drawn to the attention of the supervising examiner of the relevant section who will consider, in conjunction with Patent Oppositions, whether re-examination of the application should be carried out. This consideration should not be undertaken until after the deadline for filing sec 27(1) notices has expired, to ensure that all material filed up to that time is taken into consideration in a consolidated process.

Any purported notice under sec 27(1) which is received out of time is to be referred to the Assistant General Manager (OEP).

Note: Similar considerations apply to sec 28 notices filed in respect of an innovation patent.

Examiners should consider the contents of any notices under sec 27(1) before formulating their examination reports.

Every published document referred to in the notice should be taken into account, to the extent practicable. This is notwithstanding any failure to meet the requirements referred to in 2.13.11.1 Notifications, for example the provision of a translation.

If the assertion made in the notice is such as to affect the validity of any patent (if issued), and examiners consider that assertion to be supported by the documents referred to in the notice, an appropriate objection is to be included in either the first or further report, depending on when the notice is filed.

Examiners may consider matter published in documents including books, patent specifications, periodicals and similar publications. Matter made publicly available through prior use or by oral communication may also be taken into account. This includes declarations by persons allegedly having seen or used the invention, or alleged actual samples of the invention, or statements where the invention may be inspected or publicly seen.
Publication Date

Before citing a document accompanying a notice under sec 27(1), examiners must be satisfied that the document was in fact published before the relevant priority date. Provided the date of publication is clearly and unambiguously given, examiners are entitled to consider the matter.

In Roberts Mfg. Inc.'s Application (1977) AOJP 2345, a declaration stating that certain brochures were available "early in January 1972", together with other evidence which failed to specify exact dates, was held to be insufficient to establish publication before the priority date of 14 February 1972. At page 2346 it was stated that:

"In view of the fact that the priority date is ... (close to the date of alleged publication) ... a more accurate indication of the date when any person may have received such a brochure by post, or otherwise, appears to me to be essential in order to establish publication for the purposes of taking a definite objection under section 48(3)."

Incorrect Translation of Documents

Note: The information in this part only applies to translations filed after 25 September 2019.

Where a document accompanying a sec 27 notice is not in English, the person filing the notice is required to provide a translation (see 2.13.11.1 Notifications).

Where examiners have any doubts about the accuracy of the translation of a document, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, then the person who filed the notice should be requested to file either:

- a corrected translation of the document and a certificate of verification for the corrected translation; or
- a certificate of verification for the translation.

Examiners should contact COG (via email to era@ipaustralia.gov.au) with a request that a corrected translation and/or certificate of verification be obtained from the person who filed the notice under the provisions of reg 22.15A. Examiners should clearly identify the relevant document(s) in their request. COG will issue a notification to the person and allow them a 2 month period in which to respond.
Examiners should in the meantime issue the examination report. As a novelty or inventive step objection may be raised based on the corrected/verified translation once received, it is possible that the final date for acceptance may extend beyond the 12 month period that usually applies. In this situation examiners should follow the procedures outlined in 2.15.7.2 Objections Based on a Section 27 Notice, Documents From Section 27 Notice – Outstanding Request for Corrected Translation or Certificate of Verification.

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**Notices Received After Issue of Adverse Report**

Notices received after an adverse report has been issued are added to the Ecase, but are not referred to the relevant examination section until a response is received to the previous report. Any objections based on such notices must be raised in the next adverse report that issues. Where a novelty or inventive step objection is taken for the first time as a consequence of the filing of a sec 27 notice, the applicant has 3 months from the date of the adverse report to respond, regardless of whether that 3 month period extends beyond the 12 month period for acceptance (reg 13.4(1)(i)(i)). In this situation, examiners should follow the procedures outlined in 2.15.7.2 Objections Based on a Section 27 Notice for extending the period for acceptance.

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**2.13.12 Other Prescribed Matters**

Under sec 45(1)(d), the Commissioner must examine the patent request and specification and report on such other matters as are prescribed. Subregulation 3.18(2) lists the matters which are presently prescribed. These include, for example, whether the request and specification for an additional application comply with the requirements of sec 81.
2.13.13.2 Initial Handling

A publication prohibition order may be applied to a patent application under the provisions of sec 152 ("associated technology") and sec 173 (in the interests of the defence of the Commonwealth).

In the Safeguards Act, "associated technology" means a document containing information that is primarily applicable to the enrichment of nuclear material, reprocessing of irradiated nuclear material, production of heavy water or nuclear weapons, or nuclear information that is covered by an international agreement and is declared by the Minister to be information for the purposes of this definition. A document is defined to include a photograph, model or other thing from which the information may be obtained. Information that is publicly available is excluded from the definition.

Modified Date: 15 April 2013

2.13.13.2 Initial Handling

Applications that arrive in the Office via safe hand under international arrangements, and with authorisation for the applicant to file in Australia subject to the application remaining classified, are automatically made the subject of a prohibition order.

Notwithstanding the above, all patent applications are reviewed for possible disclosure of information that would give rise to a prohibition order. If the Commissioner forms the opinion that advice should be sought as to whether a prohibition order should be placed on a particular application:

- a prohibition order is put on the application pending receipt of advice; and
- the application is sent to a relevant Agency to obtain that advice.

The prohibition order is subsequently revoked if the Agency indicates that prohibition is not required.

See also 2.26.5 Secret Cases.

Modified Date: 03 April 2018

2.13.13.3 Allocation and Handling of Cases

When a request for examination is filed in respect of a patent application upon which there is a publication prohibition order, the Prohibited Case Manager (PCM) will inform the
supervising examiner of the relevant examination section, who will then advise the PCM of the name of the examiner who will examine the application.

Cases which are under a sec 152 or sec 173 prohibition order are to be handled in accordance with the Protective Security Manual. In particular:

- applications that are subject of a prohibition order can be assumed to contain information that would be classified as either Restricted, or Secret, under the National Security Classification. As the number of applications involved is very small, all applications are handled as if the files were classified as Secret.

- all prohibited applications are maintained as paper files under the control of a specified Team Leader in COG (the PCM).

- all case file movements must be made by personal hand delivery (safe hand). At each movement of the case file between officers the movement register and action sheet must be endorsed and signed.

- Examiners (and other staff) will only be given access to these case files if they have:
  - a current security clearance to Secret;
  - successfully completed relevant training on issues relating to handling classified material; and
  - a ‘need to know’.

- Examiners must ensure that the case file is only passed on to a person that has the relevant clearance, training and a need to know. If the case file needs to be shown or passed on to another person, examiners must first ascertain from either the PCM, or the Security Officer, whether the case file can be shown or passed to that person.

- Examiners must not assume that their usual supervisor has a current security clearance and completed the relevant training. Where the normal supervisor does not have clearance, or has not completed the training, supervision will need to be arranged with a different supervisor. The PCM, or the Security Officer, can provide advice on this matter.

- Examination is to take place in a lockable room. Examiners are not to examine the application in a cubicle or open-plan environment where other staff can potentially view the contents of the application.

- Examination reports are to be saved on a CD, which is kept in the case file. If a CD is not included in the case file, examiners should contact COG and request that one be provided. Examiners should not commence writing the report until a CD is provided, as the report must only be saved on the CD. The report is not to be saved on the LAN, or on the computer's hard drive.
When an application requires examination action, the PCM will contact file to be handed over. If examiners need to be absent from the room in which they are examining the case for a short period, the room must be locked. If examiners will be away from the room for more than a few minutes, the case file must be returned to the PCM for deposit in the safe. **It is not sufficient to lock the case file away in the room or in a drawer.** The case file must be returned to the PCM before the end of each day, and examiners are expected to liaise with the PCM about their respective hours of departure to ensure safe keeping of the case file. **At each movement of the case file between officers the movement register and action sheet must be endorsed and signed.**

When a response to an examination report is filed, the PCM will contact the examiner who issued the report (provided the person is available and has a current clearance) and arrange for the case file to be handed over.

**Completion of Examination Report**

Examiners should proceed as follows:

**Adverse Reports**

Examiners should download the appropriate template from DocGen and save it onto the CD. When drafting the examination report, examiners will need to manually enter the application details. **Examiners must** ensure that the report is **only** saved on the CD which is kept in the case file. The report is **not to be saved on the LAN, or on the computer's hard drive.** Any printouts of the report **must** be placed in the case file or disposed of in the secure bins. Once the report is completed, examiners should print out 2 copies (one for file and one for dispatch) and then return the case file by hand to the PCM, who will arrange for dispatch of the report.

**Clear Reports**

Examiners should print out a copy of the final report form located on the V: drive and complete the form by hand (see Final Report on the Examination or Modified Examination of Application No., and 2.13 Annex B – Guidelines for Completing the Final Report Form). The form should be placed in the case file and the accepted case then handed to the PCM, who will arrange for the applicant to be notified.

**Note:** When completing the final report form, examiners should fill in the Abridgement Information on page 1. This information is required in the event that a prohibition order for the application is later revoked and the application consequently becomes OPI.
2.13.13.4 Searching Prohibited Cases

Since an objection of lack of novelty or inventive step cannot be based on a prohibited case (such cases being unpublished), there is normally no need for examiners to carry out a search of currently prohibited cases. This includes searching for a possible 'whole of contents' novelty citation.

If examiners believe the circumstances of a particular case require a search to be conducted of current prohibited applications, the matter should be discussed with the Assistant General Manager (OEP). In the absence of endorsement from that AGM, examiners will not have established a 'need to know' that will allow them to gain access to those applications.

2.13.13.5 Recording Search/Classification Details

Classification details of prohibited cases are not to be entered into any computer system or classification system. Details of the search conducted and related art should be recorded on the Search Information Statement (SIS). Examiners should download a copy of the SIS template from DocGen. The SIS must be saved onto a CD and must not be saved on the LAN, or on the computer's hard drive (see also 4.1 Annex D - Search Information Statement). Any printouts of the SIS must be placed in the case file or disposed of in the secure bins. Once the SIS is completed, examiners should print out 2 copies (one for file and one for dispatch) and then return the case file by hand to the PCM, who will arrange for dispatch with the examination report.

2.13.14 Copying of Material and Copyright Implications

In this topic:

Subsection 183(1) of the Copyright Act relevantly provides:
‘The copyright in a literary, dramatic, musical or artistic work or a published edition of such a work, or in a sound recording, cinematograph film, television broadcast or sound broadcast, is not infringed by the Commonwealth or a State, or by a person authorized in writing by the Commonwealth or a State, doing any acts comprised in the copyright if the acts are done for the services of the Commonwealth or State.’

Where copying is carried out by IP Australia for the purposes of examining patent applications, the provisions of sec 183 of the Copyright Act must be complied with to rely on the Crown defence against copyright infringement. That is, copyright is not infringed by the Commonwealth in a literary work (e.g. examination reports) or a cinematograph film (e.g. YouTube videos), if copying is done for the service of the Commonwealth. This defence can therefore only be relied upon by examiners when making a copy of a work in the official course of their examination duties, for example, examining a particular patent application.

Should examiners make copies of any documents or videos from any social media website, to stay within the parameters of the Crown use defence, they must only download the document or video to the V: drive and not distribute further (except upon request by the applicant should the document or video have been taken offline at the time of the request).

**Note:** Where examiners have any doubts about breaching copyright or terms and conditions of a social media platform, they should contact the Office of Legal Counsel for assistance prior to storing copies of the material on the V: Drive.

For further information on use of the V: Drive in examination, see 5.7.4 Guidelines for Using the V: Drive in Examination.

For information on citing YouTube videos, see 1.1.12.5.4 Citation of URLs and 1.1.12.5.5 Citation Examples.

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**Notifying Copyright Holder**

It is not necessary to notify the copyright holder. This is because IP Australia is a member of two statutory authorities:

- The **Copyright Agency Limited** (CAL) is the declared collecting society (in accordance with a declaration under sec 153F of the Copyright Act) in relation to Government Copies of Works (excluding Works in sound recordings, cinematograph film and broadcasts) and manages the statutory licence for the Commonwealth’s use of hard copy material. CAL also conducts periodic surveys of government agencies to determine usage of copyright material.
2.13.14 Copying of Material and Copyright Implications

- **Screenrights** (Audio-Visual Copyright Society Limited) is the declared collecting society (in accordance with a declaration of the Copyright Tribunal under sec 153F of the Copyright Act) and manages the statutory license for the Commonwealth use of Sound Recordings, Cinematographic Films and television or sound broadcasts.

Information regarding the declaration from the Australian Copyright Council can be found at the following URL which expressly notes that YouTube videos may be downloaded based on the Crown use statutory provisions:

Under sec 183A(1) of the Copyright Act, the requirement to 'inform the owner of the copyright' under sec 183(4) of the Act does not apply where there is a statutory authorised collecting society, and the agreement between the agency and the collecting society is current at the time of copying.

The affected copyright holders are remunerated by way of compensation, and this is usually done by 'sampling'. The library staff in IP Australia will complete any annual surveys required under the Copyright Act. The surveys are administered by the collecting society to make the relevant payments towards the copyright holders.

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**Proprietary Electronic Databases e.g. STN**

Proprietary electronic databases (e.g. STN, IEEE and Derwent), electronic books and journals are covered by individual licence agreements, and the general copyright exceptions (as noted above) should not be relied upon. Under the terms of these licence agreements, examiners are able to save material obtained from electronic sources to the V: drive only (and not to PAMS), but must not supply such material to applicants or attorneys. Any requests for copies of material obtained from electronic sources must instead be referred to COG.

**Chemical Abstracts (CAS) Registry Numbers**

When an examination report cites a Chemical Abstracts (CAS) Registry Number, examiners are not precluded from including an associated chemical name and/or examiner-prepared chemical structure (e.g. using ChemDraw) in the report. However, copied images/snapshots of abstracts/structures/database entries from STN or CAS are not to be included.

For further information on citing CAS Registry Numbers, see 2.1.7.5 Non-Patent Literature.
Other Copyright Exceptions

Several other copyright exceptions exist, including:

- copying undertaken by libraries pursuant to the library copying provisions of the Copyright Act; and

- copying which is the subject of an express or implied licence, or which falls within one of the exceptions under the Copyright Act, including:
  
  - Section 40: Research (the careful search or inquiry, endeavour to discover new or collate old facts by scientific study of a subject, course of critical investigation).
  
  - Section 182A: State legislation or statutory instruments and judgements of state courts and tribunals.
  
  - Section 200AB: Special cases not already covered by another specific exception.

**Note:**

- Section 40, sec 43, and sec 182A restrict copying to one copy only.

Copyright in a literary work generally ceases 70 years after the death of the author.

**Note:** There are no copyright restrictions upon Australian provisional and complete specifications, and other prescribed documents, due to the waiver in sec 226 of the Patents Act where that document is open for public inspection. Prescribed documents include documents usually associated with the case file of a patent application, for example attorney correspondence. However, documents such as journal articles are excluded and the normal copyright restrictions apply.

2.13.15 Preliminary Search and Opinion (PSO)
Under sec 43A, the Commissioner may conduct a preliminary search and opinion (PSO) on a complete application for a standard patent filed on or after 15 April 2013. In practice, a PSO will only be conducted where requested by the applicant (applicant requested PSO).

A PSO is a report on the main (but not all) grounds of objection that apply under sec 45. However, examiners should note that the PSO is not intended to be a final or binding determination of the validity of the application and does not replace the usual examination processes.

An applicant may request a PSO at any time before the filing of a request for standard examination. Where the PSO request is filed:

- with a request for examination; or
- after examination has already been requested;

the PSO Practice Officer (Supervising Examiner ELEC 1) will contact the applicant and advise that in these circumstances a PSO will not be carried out.

**Fees**

A fee is payable at the time of filing the PSO request. Where the fee is not paid, COG will send a letter to the applicant indicating that the request will not be acted upon due to non-payment of the fee. An invitation to pay the fee will not be issued and the application will not lapse as a result of failure to pay the fee. Where the applicant wishes to proceed with the PSO, a new request will have to be filed, together with the fee.

Where the fee is paid but the PSO cannot be carried out, the fee will be refunded.
2.13.15.4 Search Procedure

The search should be conducted in accordance with the procedures outlined in 4.1 Searching. For cases where there is a lack of unity, examiners should refer to 2.13.15.4.1 Lack of Unity.

2.13.15.4.1 Lack of Unity

In general, examiners are expected to conduct a search and opinion in respect of the first claimed invention only and any other invention(s) that under the PCT would be searched without issuing an invitation to pay additional fees (see 1.1.4.9 Issuing the Invitation to Pay Additional Search Fees and PCT International Search and Preliminary Examination Guidelines Chapter 10, parts 10.64 – 10.65).

However, where the three person team conclude that the first claimed invention does not reflect the ‘main’ invention disclosed in the specification, the case should be referred to a supervising examiner. Where the supervising examiner is in agreement, the examiner should phone the attorney/applicant to discuss the lack of unity and seek clarification of the claims to be searched. A record of any conversation must be placed on file.

2.13.15.4.2 Non-Patentable Subject Matter

Where some of the claims are directed to subject matter that is not patentable under Australian law, the search should only be conducted in respect of those claims that define
patentable subject matter. The PSO should clearly indicate the claims that have not been searched and provide reasons why a search was not conducted.

If the three person team conclude that none of the claims are directed to patentable subject matter, the case should be referred to a supervising examiner. Where the supervising examiner is in agreement, the case should be referred to the PSO Practice Officer (Supervising Examiner ELEC 1).

2.13.15.5 Opinion

Modified Date: 01 March 2013

2.13.15.5.1 Novelty and Inventive Step

The reporting requirements for novelty and inventive step are the same as apply to examination of a standard patent application under sec 45. (Note that information made available through the doing of an act may also be considered for novelty and inventive step purposes). ‘Whole of contents’ novelty objections should be included under the heading ‘Novelty and Inventive Step’.

2.13.15.5.2 Patentable Subject Matter

The reporting requirements for patentable subject matter (manner of manufacture) are the same as apply to examination of a standard patent application under sec 45. Where some of the claims define subject matter that is not patentable under Australian law, and these were not searched, the opinion should clearly indicate the claims that have not been searched and provide reasons why a search was not conducted.

2.13.15.5.3 Other Issues

The following issues should also be considered (in accordance with the practices for examination under sec 45):
• Lack of unity – the opinion should identify all inventions and indicate the invention(s) searched;
• Clear enough and complete enough disclosure;
• Support;
• Clarity;
• Usefulness;
• Omnibus claims; and
• Multiple applications.

Examiners are not required to report on:
• Entitlement;
• Formalities relating to the patent request, complete specification or the Budapest Treaty; and
• Postponement of acceptance.

2.13.15.6 PSO Form Completion

The PSO form should be completed in accordance with the instructions provided in 4.11.8 Preliminary Search and Opinion (PSO). The level of detail required is the same as for a report under sec 45.

2.13.15.7 Response to PSO

The applicant may file submissions or amendments in response to the PSO, however this is not a mandatory requirement. Any submissions or amendments will only be considered if the application proceeds to examination under sec 45 at a later date.

Annexes
### First Report

**Note:** The order of these steps is not mandatory and may be varied as appropriate.

<table>
<thead>
<tr>
<th>Step</th>
<th>Description</th>
<th>Remarks</th>
</tr>
</thead>
</table>
| 1.   | Determine the type of application as procedures may vary, e.g. divisional, additional, national phase etc. | [2.10 Divisional Applications](#)  
[2.19 Patents of Addition](#)  
[2.20 National Phase Applications](#) |
| 2.   | Check that the application is in force if the date of the patent is more than 4 years ago. | [2.13.2.1 Forms of Lapsing](#) |
| 3.   | Check that a request for examination has been made. | [2.13.4. Requests for Examination](#) |
| 4.   | Check the case file for any matters pertaining to examination or any other outstanding actions. | [2.13.1 Initial Considerations](#) |
| 5.   | Check the patent request (where applicable):  
- proper authorisation  
- nominated person a legal person  
- title  
- address for service. | [2.6.2 Patent Requests](#)  
[2.21.3.1 General Requirements](#)  
[2.21.3.7 Patent Requests and Entitlement](#) |
| 6.   | Check entitlement. | [2.6.3 Entitlement](#)  
[2.20.3.2 Entitlement](#)  
[2.21.3.7 Patent Requests and Entitlement](#) |
<table>
<thead>
<tr>
<th>7. If a Convention application, check:</th>
<th>2.21.1 Introduction</th>
</tr>
</thead>
<tbody>
<tr>
<td>• prescribed foreign country</td>
<td>2.21.2 Convention Countries</td>
</tr>
<tr>
<td>• application in time</td>
<td>2.21.3 Making Convention Applications</td>
</tr>
<tr>
<td>• details in accord with the patent request/notice of entitlement</td>
<td></td>
</tr>
<tr>
<td>• priority documents (where applicable)</td>
<td></td>
</tr>
<tr>
<td>• filed in time</td>
<td></td>
</tr>
<tr>
<td>• first made in prescribed foreign country</td>
<td></td>
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<tr>
<td>• certified copy</td>
<td></td>
</tr>
<tr>
<td>• translation.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>8. Check to see whether any amendments have already been filed. Examination includes the consideration of any amendments filed in anticipation of an examination report.</th>
<th>2.13.7.1 Amendments in Anticipation</th>
</tr>
</thead>
<tbody>
<tr>
<td>2.23.2.7 Priority in Reporting on Voluntary Requests to Amend</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>9. Check formal requirements.</th>
<th>2.13.6 Matters of Form</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>10. Read the claims and, if necessary, the description to get a broad understanding of the scope of the invention:</th>
<th>2.9.2 Patentable Subject Matter (Manner of Manufacture)</th>
</tr>
</thead>
<tbody>
<tr>
<td>• determine whether the claims define a manner of manufacture, or are objectionable under sec 50(1).</td>
<td>2.9.3.2 Food or Medicines, Being Mere Admixtures</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>11. Read the complete specification and determine:</th>
<th>2.11 Section 40 – Specifications</th>
</tr>
</thead>
<tbody>
<tr>
<td>• what is the admitted prior art</td>
<td>2.11.2.2 Rules of Construction</td>
</tr>
<tr>
<td>• what is the problem to be overcome</td>
<td></td>
</tr>
<tr>
<td>• whether it meets the requirements of sec 40(2).</td>
<td></td>
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<tr>
<td>Step</td>
<td>Description</td>
</tr>
<tr>
<td>------</td>
<td>-------------</td>
</tr>
<tr>
<td>12.</td>
<td>Constructure the claims, determine their scope and note:</td>
</tr>
<tr>
<td></td>
<td>• whether they define one invention</td>
</tr>
<tr>
<td></td>
<td>• whether they meet the requirements of sec 40(3).</td>
</tr>
<tr>
<td>13.</td>
<td>Review classification.</td>
</tr>
<tr>
<td>14.</td>
<td>Determine the search strategy, if necessary. Check for FERs.</td>
</tr>
<tr>
<td>15.</td>
<td>Conduct the search, if necessary, using appropriate search tools.</td>
</tr>
<tr>
<td>16.</td>
<td>When conducting the search, or reviewing FERs, consider:</td>
</tr>
<tr>
<td></td>
<td>• novelty, including &quot;whole of contents&quot;</td>
</tr>
<tr>
<td></td>
<td>• inventive step and other sec 18 matters.</td>
</tr>
<tr>
<td>17.</td>
<td>Check if any material has been filed under sec 27.</td>
</tr>
<tr>
<td>18.</td>
<td>Check for multiple applications claiming the same</td>
</tr>
</tbody>
</table>
invention and obtain case files of these. 101B)

19. Complete the Search Information Statement, if necessary. 4.1.6 Recording the Search Details
   4.1 Annex D – Search Information Statement
   2.1.7.2 Identifying Citations

20. Prepare the report, ensuring that all important objections are raised. Submit the report for supervision, where necessary.
   2.1.5 Inconsistent or Piecemeal Examination
   2.1.6 Examination and Report Requirements
   2.1.7.2 Identifying Citations

Further Reports

Adverse

1. Check that the application is in force. 2.13.2.3 Lapsing at Further Report

2. Consider whether the amendments filed, and/or the arguments in rebuttal, overcome the objections:
   • determine whether the amendments are allowable
   • consider form of the amendment.
   2.1.8 Furthers
   2.23.8 Allowability Under Section 102(1)
   2.23.3.8 Form Amendments Should Take

3. Check for new objections. Check for FERs. 2.1.9.2 FER Retrieval
   2.1 Annex A - Open Patent Services (OPS) FER Process

<table>
<thead>
<tr>
<th>Step</th>
<th>Task</th>
<th>References</th>
</tr>
</thead>
<tbody>
<tr>
<td>4.</td>
<td>Check if any material has been filed under sec 27.</td>
<td>2.13.11 Notices Under Section 27</td>
</tr>
<tr>
<td>5.</td>
<td>Maintain existing objections where appropriate.</td>
<td>2.1.8 Furthers, 2.13.5 Stringency of Tests During Examination, 2.1.5 Inconsistent or Piecemeal Examination, 2.1.7.2 Identifying Citations</td>
</tr>
<tr>
<td>6.</td>
<td>Submit third and subsequent reports for review by the supervising examiner.</td>
<td>2.1.8 Furthers</td>
</tr>
</tbody>
</table>

## Clear

<table>
<thead>
<tr>
<th>Step</th>
<th>Task</th>
<th>References</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Check that the application is in force.</td>
<td>2.13.2.3 Lapsing at Further Report</td>
</tr>
<tr>
<td>2.</td>
<td>Accept the case if the necessary requirements are met.</td>
<td>2.15 Acceptance of Standard Patent Applications</td>
</tr>
<tr>
<td>3.</td>
<td>At the final report stage:</td>
<td>2.13.8 Review of Classification, 4.1.6 Recording the Search Details, 4.1 Annex D – Search</td>
</tr>
<tr>
<td></td>
<td>• review classification</td>
<td></td>
</tr>
<tr>
<td></td>
<td>• check that the Search Information Statement has been correctly completed, if necessary</td>
<td></td>
</tr>
<tr>
<td></td>
<td>• complete acceptance task</td>
<td></td>
</tr>
</tbody>
</table>
2.13 Annex B - Guidelines for Completing the Final Report Form

General

The following guidelines relate to completing the final (clear) report form for paper cases. When accepting cases in the PAMS environment, examiners should refer to 5.10.19 Acceptance.

Abridgement Information

Abridgement information **only** needs to be provided for those applications that are not yet OPI. The broadest claim number must be indicated at Item 57. Where:

- the claim selected is not considered to be descriptive enough; or
- the claim employs a definition; or
- there are additional noteworthy disclosures; or
- alternative subject matter is claimed; or
- the claim selected is unduly long or complex and examiners believe a brief summary would assist a searcher to quickly grasp the inventive concept; or
- the application is for a patent of addition and the selected claim refers to a claim in the parent; or
- the inventive concept is not readily apparent from the claim;

then an explanatory statement or explanatory notes may also be included. Thus examiners may:

- indicate a suitable short passage from the specification at the ‘Extract page(s)’ box. The extract must be identified by filing date and amendment item number (if applicable).
2.14 Modified Examination

- enter a more informative title at Item 54.
- select additional claims. These must be identified by filing date and amendment item number (if applicable).
- in the case of an application for a patent of addition, attach a copy of the parent claim.
- prepare a short summary or statement and include it in the ‘Explanatory Notes’ box, supplemented (if necessary) by attached pages. Claims that require an explanatory statement are usually those where the inventive concept is not immediately apparent. Such claims can sometimes appear invalid due to the apparent absence of an inventive step. Under no circumstances should the summary or statement express a negative view as to the merits of the invention. Where examiners are in doubt as to whether a claim requires an explanatory note they should seek the advice of a senior examiner.

Final Report Form

Modified Date: 01 February 2019

2.14 Modified Examination

Modified examination under sec 48 was an alternative to standard examination under sec 45. However, modified examination was only available for a complete application for a standard patent and where a patent had been granted in a prescribed foreign country in respect of a prescribed application made in that country. Under modified examination, the description and claims were required to be "the same" as those of a patent granted in a prescribed foreign country in order for acceptance to occur.

The Patents Act 1990 ceased to allow the filing of requests for modified examination on 15 April 2013.

2.15 Acceptance of Standard Patent Applications

Modified Date: 02 April 2013

2.15.1 Introduction
2.15.2 Misleading, Unfair or Derogatory References

Under sec 49(1), the Commissioner (or acceptance delegate thereof) must accept a patent request and complete specification where certain requirements are met. If sec 49(1) does not apply, the Commissioner may refuse to accept the request and specification (sec 49(2)).

"Where it appears manifest that a valid patent could not be granted, the Commissioner not only has the power but is under a duty to reject the application."

*Commissioner of Patents v Microcell Ltd.* *(1959) 102 CLR 232.*

However, in practice the Commissioner will not refuse to accept a request and specification until the matter has been considered at a hearing.

**2.15.2 Misleading, Unfair or Derogatory References**

An application should not proceed to acceptance while it contains misleading, unfair or derogatory references to another Australian application or patent, or the invention thereof (see *Wadham's Application* *(1910) 27 RPC 172* and *Ehrig's Application* *(1933) 50 RPC 176*).

Situations of this kind are rare, since claiming an advantage over the prior art is not in itself objectionable. For example, in the case of a selection, the specification must describe the advantage possessed by the selected members and upon which the selection is based (2.4.6.6.2 Selection Specification Must Describe Advantage). Similarly, applicants may distinguish their invention from the prior art and no objection should be taken to statements such as "the process of Australian specification ..... gives a yield of .....% while the process of the present invention yields 20% more".

Where a specification contains misleading, unfair or derogatory references, the case should be referred through a supervising examiner to the Assistant General Manager (OEP) for a determination of any matters to be communicated to the applicant in this regard.

**2.15.3 Processes Operated Outside the Jurisdiction of Australian Law**

It is doubtful whether a process or method to be used wholly outside the jurisdiction of Australian law, for example a method of landing on the moon or a communication system
using devices extrinsic to Australian airspace, could form the subject of an Australian patent (see Application by Standard Telephones and Cables Pty. Ltd. (1965) AOJP 2301).

Where a specification is objectionable for this reason, the case should be referred through a supervising examiner to the Assistant General Manager (OEP) for a determination of any matters to be communicated to the applicant in this regard.

---

**2.15.4 Clear Reports**

Where the requirements of sec 49(1) are met, the Commissioner (or acceptance delegate thereof) must accept the patent request and specification. This applies at both first and further report stages.

During the acceptance process, the 'Acceptance Report' screen in PAMS (screen 6 of 7) should be completed by the examining delegate. The acceptance delegate should then complete the ‘Final Acceptance’ screen (screen 7 of 7), indicating concurrence with the examining delegate’s report and, where appropriate, granting leave to amend and allowing the amendments. The examining delegate and the acceptance delegate may be the same person. Where the examining delegate and the acceptance delegate are not the same person, the acceptance delegate must be at the senior examiner level or higher (see also 5.10.19.3.8 Acceptance Report and 5.10.19.3.9 Final Acceptance).

Once an application has been formally accepted, i.e. the Acceptance Task has been completed, that acceptance cannot be reversed other than in exceptional circumstances (see 2.15.5 Revocation of Acceptance).

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**2.15.5 Revocation of Acceptance**

In this topic:

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Overview

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This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
Examiners are to ensure that as far as practicable, all matters bearing on the acceptance of an application are considered fully prior to acceptance. Where an issue comes to an examiner's attention after the acceptance of an application has been completed, acceptance cannot be reversed, undone or re-done other than in exceptional circumstances.

Where an application is accepted on or after 15 April 2013, and the patent has not yet been granted, acceptance may be revoked under sec 50A. This has the effect that the application is taken never to have been accepted and examination of the application can continue. The granting of leave to amend and the allowance of any amendments that occurred at the same time will also be revoked by virtue of reg 10.6B.

If acceptance is revoked, the final date for acceptance (FDA) is then governed by reg 13.4(1)(ga) and will (unless other circumstances apply) be the latter of the normal FDA and 3 months from the date that acceptance was revoked.

The power to revoke acceptance under sec 50A is only to be exercised by the Assistant General Manager (OEP) or the Supervising Examiner (Patent Oppositions). If it becomes apparent that an error has occurred in accepting an application, the matter is to be referred to Patent Oppositions immediately.

### Conditions for Revocation

Under sec 50A, the Commissioner may revoke the acceptance of a patent request and complete specification if satisfied, on the balance of probabilities, that:

- a. a patent has not been granted on the application; and
- b. the request and specification should not have been accepted, taking account of all the circumstances that existed when the request and specification were accepted (whether or not the Commissioner knew then of their existence); and
- c. it is reasonable to revoke the acceptance, taking account of all the circumstances.

Paragraph (a) is a fundamental prerequisite for the operation of sec 50A. After grant, acceptance cannot be revoked. Before grant, acceptance may be revoked, regardless of whether acceptance has been advertised or whether an opposition has been filed. Any actions taken on the basis of the revoked acceptance are void and of no effect.

Paragraph (b) clarifies that the Commissioner is able to take account of any circumstance that existed which should have prevented acceptance. It is not necessary that the Commissioner knew, or was in a position to know, of the existence of the circumstances at the time the application was accepted for this paragraph to apply. This may include an error of judgement or omission on the part of an examiner, or information regarding the application.
that was not available to the Commissioner at the time of examination. It is important to note that the Commissioner is not limited in what he or she may consider.

Paragraph (c) clarifies that the Commissioner must act reasonably, and have regard to all the circumstances, when deciding whether to revoke acceptance. The intention of this provision is to focus attention on the reasonableness of the Commissioner’s actions, and not on whether an ‘error or omission’ or a ‘special circumstance’ preceded the acceptance of the application.

### Relevant Circumstances

The following is not intended to limit the circumstances under which the Commissioner will revoke acceptance under sec 50A. However, acceptance will generally be revoked where it is clear that, in light of the documents then on file, the application should not have been accepted. This includes where the application was accepted:

- without relevant amendments or submissions being taken into account; or
- based on the wrong specification or set of amendments; or
- based on the wrong statutory provisions; or
- without consideration of any other clear bar to acceptance.

However, it is not the practice of the Commissioner to revoke acceptance where re-examination is available and consequently will not be entertained where relevant prior art is identified after acceptance, or an examiner subsequently comes to a different view on a substantive ground of objection. In these circumstances, the Commissioner will consider whether the application should be re-examined under the provisions of sec 97.

Acceptance will also not be revoked merely because the applicant requests the Commissioner to do so, for example, to allow further amendments to be filed and considered. The Commissioner will also not entertain third party requests to consider revoking acceptance as an alternative to opposition.

Revocation of acceptance will not occur unless that action is requested by the applicant, the applicant has indicated its consent or the applicant has been given the opportunity to be heard as prescribed in reg 22.22.
2.15.5 Revocation of Acceptance

**Consequences of Revocation**

If the Commissioner revokes acceptance:

a. the patent request and complete specification are taken to have never been accepted; and

b. the Commissioner must continue to examine, and report on, the application under sec 45; and

c. sec 49 and sec 50 continue to apply in relation to the request and specification.

Furthermore, under reg 10.6B, any leave to amend that was granted at the time of acceptance and the allowance of the amendment will also be revoked. Examination can then proceed as if acceptance and allowance of the amendments had not occurred. However, the time for acceptance may be extended where a decision is made to revoke acceptance. This is governed by reg 13.4(1)(ga), such that the final date for acceptance will be 3 months from the date that acceptance is revoked, unless a later date applies. This may include the normal date for acceptance that would have applied had the application not been accepted.

Any further actions taken that are dependant on the acceptance of the application, including advertisement, publication and the liability for acceptance fees, will be of no effect and will be reversed. Any notice of opposition filed will also be of no effect.

---

**Process for Revocation**

Where it becomes apparent that an error has occurred in accepting an application, the matter is to be referred to Patent Oppositions immediately. Patent Oppositions will consider the circumstances and determine whether the purported acceptance is a valid acceptance (i.e. is not *ultra vires*), is valid but should be revoked, or is valid and re-examination of the application should be considered.

Patent Oppositions will carry out any administrative actions required, including providing the applicant with an opportunity to be heard, arranging for the PAMS record to be corrected and adjusting the date for acceptance as appropriate. Where a notice of acceptance has been published, Patent Oppositions will also arrange for a corrigendum to be issued.

The power to revoke acceptance under sec 50A is **only** to be exercised by the Assistant General Manager (OEP) or the Supervising Examiner (Patent Oppositions).
2.15.6 Time for Acceptance

**Acceptance ultra vires**

An acceptance will be of no effect if it is *ultra vires*, for example, if an examiner accepts a case whilst there is a current postponement of acceptance in place, or if the acceptance is dated beyond the final date for acceptance.

A purported acceptance that is found to be *ultra vires* cannot be revoked under sec 50A, as the application has, in reality, not been accepted. In this case, the provisions of sec 50A and reg 13.4(1)(ga) do not apply. The granting of leave to amend effected at the same time may, however, be revoked under reg 10.6B(3).

Where Patent Oppositions determine that an acceptance is *ultra vires*, it will undertake take any steps necessary to correct the PAMS record, or any other consequential actions if required. This may include consideration of whether an extension of time should be granted under sec 223(1) for acceptance of the application.

Modified Date: 25 February 2019

**2.15.6 Time for Acceptance**

A complete application for a standard patent lapses if the patent request and complete specification are not accepted within the period prescribed (sec 142(2)(e)). Regulation 13.4 specifies the relevant period, which for most cases will be a period expiring 12 months from the date of a first examination report. All examination reports must indicate the period of time for acceptance.

Where the time for acceptance expires on a day that the Office is not open for business, then the acceptance may be carried out on the next day that the Office is open for business (see **2.3.4 Reckoning of Time**). For the purposes of sec 222A, an acceptance carried out by outposted and home based examiners is an act done at the Office (i.e. in Canberra). However, note that the Melbourne IP Office (MIPO) [formerly the Melbourne Patent Examination Centre (MPEC)] is **not** considered a sub-office for the purposes of sec 222A.

Consequently, examiners need only have regard to non-business days that apply to the Office in Canberra and not to the local holidays to which they are entitled. For example, for an application which has Melbourne Cup Day as the last day for acceptance, acceptance cannot be validly carried out on the following day by a Melbourne based outposted examiner (or an examiner based at MIPO/MPEC) unless covered by an extension of time.
2.15.7 Exending the Time for Acceptance

2.15.7.1 Objections Based on "Whole of Contents"

Where an objection is raised based on "whole of contents", then the period of time for acceptance may be extended where necessary (see also 2.4.11.7 Citation Not OPI). The time for acceptance may be extended until 3 months after the date of:

- publication of the cited specification; or
- lapsing, refusal or withdrawal of the citation;

whichever is the earliest (reg 13.4(1)(d)).

Where examiners consider that the time for acceptance will be extended, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, examiners must update the final date for acceptance (FDA) in PAMS prior to creating the examination report in DocGen (see 5.5.3.4 Exam Details). A case note should be added to the file, stating that the FDA has changed as a result of the whole of contents objection.

**Warning:** The FDA should only be changed when it is appropriate to do so. Examiners should consult Patent Oppositions before changing the FDA in PAMS.

The examination report should indicate that the FDA is a later date. This later date is to be specified in the report as being the FDA by including an additional comment in the introductory paragraph as follows:

"The provisions of regulation 13.4(1)(d) provide that the final date for acceptance of this application is now <insert appropriate date in bold>.”

2.15.7.2 Objections Based on a Section 27 Notice

In this topic:
An objection based on a document from a sec 27 notice may in some circumstances extend the period of time for acceptance by up to 3 months (see also 2.13.11.2 Action by Examiner, Notices Received After Issue of Adverse Report).

Where the period ending 3 months from the date of a report that first raises an objection based on a sec 27 notice extends beyond the final date for acceptance (FDA) that otherwise applies (generally 12 months from the date of the first report), the FDA will be the later date, i.e. 3 months from the date of the report which first mentions the objection (reg 13.4(1)(l)(i)).

Where examiners consider that the time for acceptance will be extended, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, examiners must update the FDA in PAMS prior to creating the examination report in DocGen (see 5.5.3.4 Exam Details). A case note should be added to the file, stating that the FDA has changed as a result of an objection based on a sec 27 notice.

**Warning:** The FDA should only be changed when it is appropriate to do so. Examiners should consult Patent Oppositions before changing the FDA in PAMS.

The examination report should indicate that the FDA is a later date. This later date is to be specified in the report as being the FDA by including an additional comment in the introductory paragraph as follows:

"The provisions of regulation 13.4(1)(l)(i) provide that the final date for acceptance of this application is now 3 months from the date of this report."

The report should identify any documents arising from a sec 27 notice which form the basis of an objection.

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**Documents From Section 27 Notice – Outstanding Request for Corrected Translation or Certificate of Verification**

**Note:** The information in this part only applies to translations filed after 25 September 2019.

Where a document accompanying a sec 27 notice is not in English, the person filing the notice is required to provide a translation (see 2.13.11.1 Notifications).

In rare circumstances the person who filed the notice may be requested to file either:

- a corrected translation of the document and a certificate of verification for the corrected translation; or
- a certificate of verification for the translation

(see 2.13.11.2 Action by Examiner, Incorrect Translation of Documents).
Where the corrected or verified translation has not been received prior to issuing an examination report, examiners should, following consultation with Patent Oppositions, include an additional comment in the introductory paragraph of the report as follows:

"**Note:** A section 27 notice has been filed in respect of this application. The notice is accompanied by a translation of a document. The person who filed the notice has been requested to provide a corrected translation of the document and a certificate of verification for the corrected translation, or a certificate of verification for the translation of the document, under regulation 22.15A.

Following receipt of the corrected/verified translation, the final date for acceptance of this application may change under regulation 13.4(1)(c) or regulation 13.4(1)(l)."

Where a novelty or inventive step objection is subsequently raised based on the corrected/verified translation, and examiners consider that the time for acceptance will be extended, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, examiners should follow the procedures for extending the time for acceptance outlined in this section or in 2.15.7.3 Request for Corrected Translation or Certificate of Verification as appropriate.

**Note:** The information in this part only applies to translations filed after 25 September 2019.

In rare circumstances where the Commissioner reasonably believes that a translation does not accurately reflect the contents of a document (e.g. PCT specification, Article 19 and Article 34 amendments, basic specification), the applicant may be requested to either file:

- a corrected translation of the document and a certificate of verification for the corrected translation; or
- a certificate of verification for the translation.

(see reg 3.5AC(9), reg 3.5AF(2D) and reg 22.15A)
2.15.7.3 Request for Corrected Translation or Certificate of Verification

The applicant has 2 months in which to respond to the request, otherwise the application will lapse.

Where a request is made by the Commissioner for a corrected translation and/or a certificate of verification, the period of time for acceptance may be extended by up to 2 months.

Thus, where a request for a corrected translation and/or a certificate of verification is included in a (first or further) report, the final date for acceptance (FDA) is 14 months from the date of the first report (reg 13.4(1)(c)).

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Examination Practice

Where examiners have any doubts about the accuracy of the translation, they should first consult Patent Oppositions to determine an appropriate course of action.

In the situation where no examination report is to issue, examiners should contact COG (via email to era@ipaustralia.gov.au) with a request that a corrected translation and/or certificate of verification be obtained from the applicant. Examination should be placed on hold pending receipt of the corrected translation and/or certificate of verification. After receipt of the document(s), examiners should follow the procedures outlined in Extending the Time for Acceptance below.

In the situation where an examination report is to issue, examiners should contact COG (via email to era@ipaustralia.gov.au) with a request that a corrected translation and/or certificate of verification be obtained from the applicant.

Examiners should in the meantime issue the examination report. The report should include a note informing the applicant that formal notification regarding a request to provide a corrected translation and/or certificate of verification will issue (this will be sent by COG). The time for acceptance should also be extended as indicated below.

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Extending the Time for Acceptance

Where examiners consider that the time for acceptance will be extended, they should consult Patent Oppositions. If Patent Oppositions are in agreement, examiners must update the FDA in PAMS prior to creating the examination report in DocGen (see 5.5.3.4 Exam Details). A case note should be added to the file, stating that the FDA has changed as a result of a request by the Commissioner for the applicant to provide a corrected translation and/or a certificate of verification.
2.15.7.4 Request for Basic Specification

**Warning:** The FDA should only be changed when it is appropriate to do so. Examiners should consult Patent Oppositions before changing the FDA in PAMS.

The examination report should indicate that the FDA is a later date. This later date is to be specified in the report as being the FDA by including an additional comment in the introductory paragraph as follows:

"The provisions of regulation 13.4(1)(c) provide that the final date for acceptance of this application is now <insert appropriate date in bold>.'"  

In the case of a first report, the following text should also be included:

"You have 14 months from the date of this report to overcome all my objection(s) otherwise this application will lapse."

**2.15.7.4 Request for Basic Specification**

The Commissioner will only request an applicant to file a basic specification and/or its translation* in certain circumstances (see 2.21.3.8 Basic Specifications). A request by the Commissioner for a copy of the basic specification and/or its translation may in some circumstances extend the period of time for acceptance by up to 5 months.

*Note: For translations that were filed before or on 25 September 2019, a certificate of verification for the translation must also be provided.

In general, an applicant has 3 months from the date of the request in which to provide the documents (reg 3.14D(2)). However, where the period ending 5 months from the date of a report that first requests the applicant to provide a basic specification and/or its (verified) translation extends beyond the final date for acceptance (FDA) that otherwise applies, the FDA will be the later date, i.e. 5 months from the date of the report which first mentions the objection (reg 13.4(1)(k)).

Where examiners consider that the time for acceptance will be extended, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, examiners must update the FDA in PAMS prior to creating the examination report in DocGen (see 5.5.3.4 Exam Details). A case note should be added to the file, stating that the FDA has changed as a result of a request by the Commissioner for the applicant to provide a copy of a basic specification.

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
Warning: The FDA should only be changed when it is appropriate to do so. Examiners should consult Patent Oppositions before changing the FDA in PAMS.

The examination report should indicate that the FDA is a later date. This later date is to be specified in the report as being the FDA by including an additional comment in the introductory paragraph as follows:

“The provisions of regulation 13.4(1)(k) provide that the final date for acceptance of this application is now 5 months from the date of this report.”

Modified Date: 25 September 2019

2.15.7.5 Entitlement Disputes During Examination

Where there is an entitlement dispute in progress during the examination of an application, examination can continue, however the application must not be accepted.

Section 36 allows a person to challenge the entitlement of the applicant. Section 32 allows a co-applicant to challenge the entitlement of another co-applicant. Until the Commissioner has made a determination in an entitlement dispute, the entitlement of the nominated person of record is uncertain. It follows that the Commissioner cannot be satisfied that the requirements of sec 15 have been met, and an objection under reg 3.18(2)(a)(i) applies (regardless of whether any statement relating to entitlement has been made).

Note: If examiners become aware, during examination, that there is an unresolved application under sec 32 or sec 36, they are to raise an objection (see PERP code [B9]). The objection is to be maintained in any subsequent reports, and acceptance is not to take place until the entitlement dispute has been resolved or withdrawn.

The final date for acceptance (FDA) is reset to 3 months after the Commissioner has made a decision under sec 32 or sec 36, if that date is later than the FDA that otherwise applies (reg 13.4).

Where examiners consider that the time for acceptance will be extended, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, examiners must update the FDA in PAMS prior to creating the examination report in DocGen (see 5.5.3.4 Exam Details). A case note should also be added to the file, indicating that the FDA has changed as a result of a decision by the Commissioner under sec 32 or sec 36.
2.15.7.6 Action by a Court or Tribunal

**Warning:** The FDA should only be changed when it is appropriate to do so. Examiners should consult Patent Oppositions before changing the FDA in PAMS.

The examination report should indicate that the FDA is a later date. This later date is to be specified in the report as being the FDA by including an additional comment in the introductory paragraph as follows:

"The provisions of regulation 13.4(1) provide that the **final date for acceptance of this application is now** <insert appropriate date in bold>.

See also:

- 3.2.7 Sections 17 and 32 – Disputes Between Applicants and Co-Owners; and
- 3.2.8 Entitlement – Sections 33, 34, 35, 36 and 191A.

Where there is a court or tribunal action relating to the patent request or specification, then the period of time for acceptance may be extended where necessary. The final date for acceptance (FDA) may be extended to a date 3 months from the day when the action is withdrawn, or finally dealt with, or a further period determined by the court or tribunal (reg 13.4(1)(h) and reg 13.4(1)(j)).

Where examiners consider that the time for acceptance will be extended, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, examiners must update the FDA in PAMS prior to creating the examination report in DocGen (see 5.5.3.4 Exam Details). A case note should also be added to the file, indicating that the FDA has changed as a result of a court or tribunal action.

**Warning:** The FDA should only be changed when it is appropriate to do so. Examiners should consult Patent Oppositions before changing the FDA in PAMS.

The examination report should indicate that the FDA is a later date. This later date is to be specified in the report as being the FDA by including an additional comment in the introductory paragraph as follows:

"The provisions of regulation 13.4(1) provide that the **final date for acceptance of this application is now** <insert appropriate date in bold>."
2.15.8 Postponement of Acceptance

An applicant may request postponement of acceptance until any date up to the date prescribed for the purposes of sec 142(2)(e) (usually the final date for acceptance). It is open to the applicant to cancel the postponement at any time.

Although sec 49A gives the Commissioner the discretion to postpone acceptance even if the applicant has not requested it, this provision will rarely be used. In the event that the Commissioner decides to postpone acceptance, such cases will be handled by Patent Oppositions.

Processing of Request

Any request for postponement of acceptance will normally be processed by COG. If the request has met the necessary requirements, COG will send a letter to the applicant advising that the request has been allowed and that acceptance of the application has been postponed. COG will also record this information in PAMS and the ‘Examination Details’ screen of the Ecase will indicate that there is a postponement of acceptance in place. If examiners become aware of a postponement request which has not been processed, they should immediately notify COG. While supervising examiners have the delegation to grant postponement requests, COG have primary responsibility for handling these. Thus, supervising examiners should not have to exercise their delegation in this regard other than in exceptional circumstances. Where this occurs, COG should be notified as soon as possible for administrative purposes.
2.15.8 Postponement of Acceptance

Examination Practice

The examination of an application for which a postponement of acceptance is in place is to proceed as per usual, except that if the application is otherwise in order for acceptance, it is not to be accepted. When examining a case on which a postponement has been requested, examiners must check the correspondence to determine whether the postponement is currently in force and, if so, raise the issue in an adverse report as indicated below.

Other Objections in Addition to Postponement

If a postponement is still current but there are other objections, the following note should be included in the report:

"NOTE: There is a current postponement of acceptance in place. If you overcome all other objections before the expiration of that postponement, the Commissioner will only accept the application at that time if you have filed a clear and unambiguous statement requesting the withdrawal of that postponement. Otherwise, a further adverse report will be issued."

This text will be automatically included in the report when the appropriate option is selected in response to the question 'Is there a Postponement of Acceptance in effect?' in the 'Report Finalisation' section in Intelledox (DocGen).

Where an applicant files correspondence withdrawing a postponement of acceptance, but does not address issues raised in a previous report, examiners should issue a further report stating:

"I have received your letter requesting withdrawal of the postponement of acceptance. However the matters raised in the previous report remain outstanding."

Postponement Only Objection

Where a postponement remains in effect and this is the only outstanding objection, an adverse report is to be sent to the applicant stating:

"While the application is otherwise in order for acceptance, it cannot be accepted because there is a current postponement of acceptance in place.

You must respond to this report in order to gain acceptance. The Commissioner will only proceed to accept the application if you file a clear and unambiguous statement requesting the postponement be withdrawn with sufficient time for the request to be
processed. If the application is not accepted by <final date for acceptance> your application will lapse."

This text, and the final date for acceptance, will be automatically included in the report when the appropriate option is selected in response to the question 'Is there a Postponement of Acceptance in effect?' in the 'Report Finalisation' section in Intelledox (DocGen).

**Note:** Even though a report has issued stating that the application is in order for acceptance, but that acceptance has been postponed, it is still open for applicants to propose amendments under sec 104 in their response. Such amendments are to be treated in the usual manner.

### Withdrawal of Postponement

In order for acceptance to occur, the applicant must **explicitly** withdraw the request for postponement. Wording such as "I submit the application is now in order for acceptance, which action is earnestly solicited" is **not** to be inferred as withdrawing the postponement. In order to remove the postponement, a statement that "We formally withdraw any requests for postponement of acceptance", or words to that effect, is required.

**Note:** An explicit withdrawal of the postponement is required, even if the applicant (in their request for postponement) has specified a date on which the postponement is to expire. It should also be noted that no date for the expiry of the postponement is recorded in PAMS; the 'Examination Details' screen merely indicates that a postponement of acceptance is in place.

If the case is ready for acceptance and the postponement has been formally withdrawn, examiners should remove the postponement of acceptance from the Ecase using the procedures outlined in 5.10.12.3.1 Removing Postponement of Acceptance.

**Note:** If a case is accepted whilst there is a current postponement of acceptance in place, examiners should follow the procedures outlined in 'Acceptance *ultra vires* in 2.15.5 Revocation of Acceptance.
The Patents Act 1990 ceased to allow the filing of applications for petty patents on 24 May 2001. From that date the Patents Amendment (Innovation Patents) Act 2000 came into force allowing for the filing of applications for innovation patents. See 2.31 Innovation Patents for information on the practices and procedures pertaining to innovation patents.

2.17 Publications

Modified Date: 02 April 2013

2.17.1 Significance of Publication

During examination, the date of publication of a complete specification is significant in determining whether that document can be used as the basis for a novelty (including "whole of contents" novelty) objection, or an inventive/innovative step objection.

2.17.2 Date of Publication

Under the provisions of sec 54, a complete specification filed in respect of an application for a standard patent (other than a PCT application) becomes open to public inspection (OPI) on the date upon which it is advertised as such in the Official Journal. Apart from the exceptions covered by the specific provisions within sec 54, this date is either:

- the earliest convenient date after 18 months from the priority date of the application; or
- the date upon which acceptance is advertised in the Official Journal.

Similarly, in the case of innovation patents, the complete specification becomes OPI on the date upon which it is advertised as such. Under sec 62(2), this date is the date upon which a notice is published in the Official Journal that the patent is granted and that the request and complete specification are OPI.

For national phase applications filed on or after 1 January 2004 (and which enter the national phase more than 18 months from the priority date), the OPI date is generally the date upon which the PCT pamphlet is published under Article 21 (see also reg 8.3(1D), sec 56A and reg 4.4)*.
Since the Official Journal is published weekly, all specifications due to become OPI in a particular week become OPI on the same day.

Specifications which have not been notified in the Official Journal as OPI, apart from those relating to international applications, are not OPI even though they were due to become so under the provisions of sec 54 or sec 62(2). Where examiners become aware that a specification has not been notified as OPI in the Official Journal, even though it should have been, the specification should not be considered as OPI for the purposes of any objection under the Act. The matter should also be brought to the attention of COG.

Where examiners become aware that a specification was notified as OPI by error, this should be brought to the attention of COG. If only a short period of time has elapsed since the erroneous notification took place, then provided copies of the specification have not been prepared and located where members of the public could have accessed them, the error may possibly be rectifiable by way of a corrigendum in the Official Journal. However, if publication has in fact occurred, then it is irreversible, irrespective of the notification in the Official Journal having been entered in error.

Where a specification which has been notified as OPI in error could be used as a citation subject to having in fact become OPI on the date of the notification, examiners, on referring the matter to COG, should ask to be advised as soon as a determination is made as to whether a corrigendum is to be prepared. No examination report should be issued pending advice on the determination.

When citing the date on which an Australian specification became OPI, examiners are not required to check the date in the Official Journal. Instead, the date may be taken from a copy...
2.17.5 Published Documents

In this topic:

Non-PCT Applications

When a complete specification becomes OPI, all documents associated with the application and in the possession of the Office become OPI at the same time, with the exception of the following (sec 55(1) and reg 4.3):

a. documents that would be privileged from production in legal proceedings on the ground of legal professional privilege;

b. documents subject to court or tribunal orders prohibiting disclosure of the document or information that it contains; and

c. a document that the Commissioner has reasonable grounds for believing should not be made OPI. (Note that under sec 56, such documents are available for inspection upon request. For further information, see 3.13 Documents Not OPI – Orders for Inspection).

Examiners should note that, apart from the exceptions identified above, all documents associated with the application (whether or not they are physically present on a paper case file or attached to an Ecase file) become OPI when the complete specification becomes OPI, including examiners’ reports, the search information statement (or information sheet), attorney correspondence, any file notes, quality assurance check sheets, any citations associated with the case file (including any annotations on the citations), as well as associated provisional specifications and basic documents.

When a notice of acceptance of a standard patent (or grant of an innovation patent) is published in the Official Journal, the following documents become OPI if they are not already:

- all documents filed in relation to the application (or the patent) whether before or after acceptance (or grant);
• copies of all documents relating to the application (or patent) given by the Commissioner to the applicant (or patentee); and

• any documents filed after the patent ceases, is expired or revoked;

with the exception of the following:

• documents subject to court or tribunal orders prohibiting disclosure of the document or information that it contains; and

• a document that the Commissioner has reasonable grounds for believing should not be made OPI.

Hence in the case of applications for standard patents, documents subject to legal professional privilege become OPI when acceptance is advertised.

A specification or other document which has become OPI is deemed to have been published (sec 55(3)).

The "specification" referred to in sec 55(1) is the specification originally filed and any substitute specification (or part of a specification) that may have been subsequently filed.

Where a specification is amended prior to becoming OPI, then upon notification that the specification is OPI, both the unamended and the amended forms of the specification are OPI. Similarly, where the specification is amended after notification that the specification is OPI, the amended form of the specification is also OPI. Proposed or requested amendments are OPI when the complete specification becomes OPI, whether or not they have been allowed.

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**PCT Applications**

The provisions relating to the publication and inspection of PCT applications are essentially the same as those outlined above (see sec 56A and reg 4.4). Note, however, that where the International Bureau does not publish a document that is part of a PCT application and which contains sensitive personal or financial information that is not essential to the working of an invention, that document must not be made OPI unless:

• the information has been redacted; and

• the redacted document is not covered by points a) to c) above.
2.17.6 Publication Date of PCT and Foreign Specifications for Citation Purposes

When citing PCT and foreign specifications during examination, the relevant date of publication is the date of publication by WIPO or the particular foreign country, as the case may be. This date is usually found on the front page of the PCT pamphlet or foreign specification in question (see also 2.1.7.2 Identifying Citations).

2.18 Multiple Applications (Sections 64(2) and 101B)

2.18.1 Introduction

The effect of a patent is to give the patentee an exclusive right in respect of the invention (sec 13). Accordingly, the grant of multiple patents for the same invention would conflict with the nature of the rights provided by a patent.

The Act contains specific provisions relating to multiple applications for the same invention.

Subsection 64(1) permits the grant of two or more patents on applications for identical, or substantially identical, inventions having the same priority date. However, sec 64(2) prohibits such a grant upon a standard application where the application claims an invention that is the same as an invention that is the subject of another patent, made by the same inventor and having the same priority date.

Similarly, under sec 101F, a ground of revocation of an innovation patent is that the patent claims an invention that is the same as an invention that is the subject of another patent, made by the same inventor and having the same priority date.

2.18.2 Practice
Examiners should object to a standard application, or an innovation patent, which claims an invention that is the same as the invention claimed in a granted patent by the same inventor, where the relevant claims have the same priority date. The basis for the objection is that the application or patent contravenes sec 64(2), or sec 101B, respectively.

Examiners are to interpret the reference to a 'patent' in sec 64(2) and sec 101B as meaning a patent that is in force. Thus, the existence of a granted patent does not prohibit the grant of a standard patent, or give rise to the revocation of an innovation patent, for the same invention, provided the pre-existing patent is not in force at the time the standard patent is to be granted or the innovation patent is being examined (e.g. it has been surrendered).

Where a renewal fee on a granted patent has not been paid, but the 6-month grace period for paying that fee has not expired, that patent is still a patent for the purposes of sec 64(2) or sec 101B.

Strictly speaking, an objection under sec 64(2) or sec 101B only applies in relation to a pre-existing patent. However, insofar as objections under sec 64(2) are concerned, examiners must also raise an objection where the same invention is claimed in another patent application that has not been granted or accepted (the 'other case') (see 2.18.3.1 Application for a Standard Patent). Where the 'other case' has not been accepted, the objection should be based on the specification of the 'other case' as currently proposed to be amended. The objection should also be raised during examination of the 'other case'.

However, examiners should not raise an objection under sec 101B where the 'other case' is an application which has not yet proceeded to grant (see 2.18.3.2 Innovation Patent).

**Note:** Where an objection under sec 64(2) or sec 101B does not apply solely because the 'other case' (whether a granted patent or an application) claiming the same invention is not in force, examiners must place a note outlining the situation on the 'other case' file, unless the 'other case' is a family member that has lapsed due to failure to gain acceptance/certification in time. This is to ensure that the matter is considered in any subsequent application to restore the 'other case'.

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**2.18.3 Examination Reports**

Modified Date: 01 September 2015

**2.18.3.1 Application for a Standard Patent**

In this topic:
2.18.3.1 Application for a Standard Patent

Under reg 3.18(2)(e), a standard patent cannot be granted on an application because of non-compliance with sec 64(2). However, examiners should note that non-compliance with sec 64(2) is not a bar to acceptance, but is rather a bar to grant. Where sec 64(2) applies, at least one adverse examination report must be issued which includes an objection drawing attention to the situation. This includes:

i. raising an objection at first report even where sec 64(2) is the only issue.

ii. raising an objection at further report where sec 64(2) is the only issue and the situation has not previously been drawn to the attention of the applicant.

See below for procedures to follow where:

- the other case is a granted patent; or
- the other case is a patent application.

Other Case a Granted Patent

Examination Report

Where one or more claims of the application being examined repeat claims of a granted patent, the examination report must include the following objection:

“In my opinion, claims of the present application repeat claims of granted patent <765432. I consider that claims 30-40 of the present application repeat claims 10-20 of the granted patent.>

While this does not preclude the present application from being accepted, under the provisions of Subsection 64(2) of the 1990 Act, a patent cannot be granted on this application in its present form while the same claims are present in another granted patent by the same inventor, having the same priority date and currently being in force.

In order for a patent to be granted on the application in its present form either:

- the granted patent must cease or be surrendered; or,

- the relevant claims of the granted patent must be amended so as to no longer be the same as those of the present application.

Otherwise you will need to amend the present claims.”

[See also PERP code P13]
This objection must be reiterated in every subsequent adverse report if the sec 64(2) situation still applies and there are other outstanding objections preventing acceptance of the application, but should acknowledge any remedial action proposed by the applicant. Where there is no other outstanding objection preventing acceptance of the application, the case should be accepted despite the sec 64(2) situation.

Acceptance and Grant

When an application for a standard patent with an outstanding sec 64(2) situation in respect of a granted patent is accepted, a sec 64(2) bar to grant is to be placed on the file and this should be indicated on the ‘Acceptance Report’ screen (screen 6 of 7) during the acceptance process (see 5.10.19.3.8 Acceptance Report).

Where an applicant resorts to surrendering the other patent to overcome the non-compliance with sec 64(2), it is essential that any procedure under sec 137 is completed before the time for granting a patent on the pending application expires.

Similarly, if an applicant chooses to amend the other patent to overcome the non-compliance with sec 64(2), the amendment must have been allowed before a patent can be granted on the pending application.

When the application is, apart from the sec 64(2) bar to grant, ready to be granted, COG will assess whether the application has changed via amendment and whether the other granted patent is still in force and/or has been amended. If these circumstances have not changed since acceptance and the sec 64(2) issue therefore still applies, COG will send a letter to the applicant advising them that the application cannot be granted. If the circumstances have changed since acceptance, COG will forward the case to the relevant examination section for review by the examiner.

Note: When examiners receive a case for review, the task must be given a high priority to ensure that grant of a patent on the pending application is not unnecessarily delayed.

If, upon reviewing the case, the examiner considers that the application still contravenes sec 64(2), a bar-to-grant letter, along the lines set out in 2.18 Annex A - Bar-to-Grant Letter, should be sent by the examiner to the applicant and the bar to grant left in place pending the outcome of the letter.

Note: Where an applicant proposes amendments to an accepted application in order to overcome the non-compliance with sec 64(2), these should be processed according to the procedures outlined in 2.23 Amendments and 5.13 Voluntary Amendments. Examiners should note that the bar to grant should remain in place until the amendments have been allowed.
Other Case a Patent Application

Examination Report

Note: No objection applies where one or more claims of an innovation patent being examined repeat claims of a patent application (see 2.18.3.2 Innovation Patent).

Where one or more claims of the application being examined repeat claims of another patent application, the examination report must include the following objection:

"In my opinion, claims of the present application repeat claims of patent application <2007209999. I consider that claims 30-40 of the present application repeat claims 10-20 of 2007209999.>

While this does not preclude both applications from being accepted, under the provisions of Subsection 64(2) of the 1990 Act, two patents cannot be granted having claims for the same invention where the inventor and priority date are the same.

If a patent is granted on the present application, it follows that the other application will be barred from grant, unless the relevant claims of that application are amended so as to no longer be the same as those of the present application."

[See also PERP code P15]

This objection must be reiterated in every subsequent adverse report if the sec 64(2) situation still applies and there are other outstanding objections preventing acceptance of the application, but should acknowledge any remedial action proposed by the applicant. Where there is no other outstanding objection preventing acceptance of the application, the case should be accepted despite the sec 64(2) situation (see below).

Acceptance and Grant

When an application for a standard patent with an outstanding sec 64(2) situation is accepted, a sec 64(2) bar to grant is to be placed on the file and this should be indicated on the ‘Acceptance Report’ screen (screen 6 of 7) during the acceptance process (see 5.10.19.3.8 Acceptance Report).

At the time for grant, the application containing the sec 64(2) bar to grant will be returned to examination for review.
Note: When examiners receive a case for review, the task must be given a high priority to ensure that grant of a patent on the pending application is not unnecessarily delayed.

If the sec 64(2) situation still exists and:

- the other patent application has **not yet been granted**, the present application may be granted. The examiner must place a case note on the file of the other application stating that the present application has been granted.

Thus, where the sec 64(2) issue is extant, only the first application to reach grant can be granted.

- the other application **has been granted**, the present application **must not** be granted. Examiners should proceed as outlined in ‘Other Case a Granted Patent, Acceptance and Grant’ above and consider whether a bar-to-grant letter should be sent to the applicant.

Note: Where an applicant proposes amendments to an accepted application in order to overcome the non-compliance with sec 64(2), these should be processed according to the procedures outlined in 2.23 Amendments and 5.13 Voluntary Amendments. Examiners should note that the bar to grant should remain in place until the amendments have been allowed.

An innovation patent must satisfy the requirements of sec 101B before it can be certified. Where one or more claims of an innovation patent being examined repeat claims of a **granted patent**, an adverse examination report must be issued which includes an objection drawing attention to the situation.

Note: Where one or more claims of the innovation patent being examined repeat claims of an application that has not yet proceeded to grant, this **cannot** be used as the basis of an objection under sec 101B. In these circumstances, examiners must place a case note outlining the situation on the innovation patent file.
Examination Report

Where one or more claims of the innovation patent being examined repeat claims of a granted patent, the examination report must include the following objection:

“In my opinion claims of the present innovation patent repeat claims of granted patent <765432. I consider that claims 1-5 of the present innovation patent repeat claims 10-14 of the granted patent.>

Under the provisions of Section 101B of the 1990 Act, the current innovation patent cannot be certified in its present form while the same claims are present in another granted patent by the same inventor, having the same priority date and currently being in force.

In order for the innovation patent to be certified in its present form either:

- the granted patent must cease or be surrendered; or

- the relevant claims of the granted patent must be amended so as to no longer be the same as those of the present innovation patent.

Otherwise you will need to amend the present claims.”

This objection must be reiterated in every adverse report issued in respect of the innovation patent if the situation still applies, but should acknowledge any remedial action proposed by the patentee.

Expiry of Examination Period

Where an objection under sec 101B is overcome before the expiry of the examination period (and there are no other outstanding examination issues), the innovation patent may be certified. Note, however, that if a patentee resorts to surrendering the other patent to overcome the non-compliance with sec 101B, it is essential that any procedure under sec 137 is completed before the expiry of the examination period.
2.18.4 Requirement that Inventors be the Same

Similarly, if a patentee chooses to amend the other patent to overcome the non-compliance with sec 101B, the amendment must have been allowed before the expiry of the examination period.

If the sec 101B objection has not been overcome when the period for examination expires, the innovation patent will cease.

The pre-existing patent or patent application must have the same inventor as the standard application or innovation patent being examined, regardless of whether the respective applicants/nominated persons/patentees (as the case may be), are the same.

An objection should also be raised if two specifications claim the same invention and each has a common inventor, but where one or both of the specifications also has other inventors.

For example:

- specification 1 has inventors A and B; and
- specification 2 has inventors A and C;

or

- specification 3 has inventors A and B; and
- specification 4 has inventor A.

In addition, examiners are to question the statements in the patent requests and/or notices of entitlement which set out the inventors' names. In the examples above, there is doubt as to whether the patent requests/notices of entitlement are accurate, since where the invention claimed in two specifications is the same, the inventors would also be expected to be the same.

Equally, the patent request/notice of entitlement should be questioned if two specifications claim the same invention and the applicant/nominated person is the same, but there are no common inventors. In this case, examiners should include a note in their report advising the applicant that if the inventors are in fact the same, an objection under sec 64(2) or sec 101B may apply.

Where a standard application is a divisional application of a pre-existing parent patent, but the inventor(s) of the divisional application have not been stated in the patent request or
2.18.5 Inventions Claimed in a Claim

In order to satisfy sec 64(2) or sec 101B, the invention must be claimed in a claim of each specification, i.e. it is the claims of the two specifications that are being compared. Thus, in the case of innovation patents which have been granted (but not certified) and in which there are no, or no "genuine", claims, sec 64(2) and sec 101B do not come into consideration. A "non-genuine" claim would be, for example,

“Claim 1. My invention is worth one million dollars.”

2.18.6 Same Invention

The test for whether the claims define the same invention is:

"if the claims of the two specifications were located in the same specification, would there be redundancy of claiming?"

i.e. whether there are claims of identical scope (see Smith Kline Beecham p.l.c.’s Application [2000] APO 54). However, the requirement for "identical scope" does not necessarily impose a requirement for identical wording; it is the overall scope of each of the claims that is considered.

In Arbitron v Telecontrol Aktiengesellschaft [2010] FCA 302 at [150] Emmett J stated:

“The fact that the claims of one patent are not literally identical to the claims of another patent does not necessarily mean that they are not for the same invention. If the differences in wording of the claims are inconsequential, the two sets of claims may nevertheless relate to the same invention.”

When considering whether the claims define the same invention:

"any situation giving rise to an objection under sec 64(2) must be so plainly evident that it is beyond reasonable argument".
2.18.7 Priority Dates

Examiners should note that where an applicant or patentee successfully rebuts an objection based on sec 64(2) or sec101B, respectively, by indicating that the priority dates of the claims involved are not the same, a novelty objection based on whole of contents will then apply against whichever application or patent has the later priority date.

**Note:**
- If the later case is a standard application that has not yet commenced examination, examiners must place a case note outlining the situation on the file.
- If the later case is a granted standard patent, or a certified innovation patent, examiners must consult Patent Oppositions with a view to initiating re-examination.
- If the later case is a granted innovation patent, examiners must consult Patent Oppositions with a view to initiating examination.

2.18.8 Additionals/Divisionals

Objections based on sec 64(2) apply equally to additional or divisional applications and their respective parent applications, as well as to unrelated applications. Similarly, objections based on sec 101B apply equally to divisional applications, as well as unrelated applications.

2.18.9 Omnibus Claims
Note: Only certain types of omnibus claims are allowable for:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For further information see 2.11.2.3.9A Omnibus Claims.

An objection under sec 64(2) or sec 101B may also apply where the claims in question are omnibus claims. However, omnibus claims of identical wording are not necessarily claiming the same invention. For example, claims to "A device as claimed in claim 1 substantially as described with reference to the drawings." in two specifications having identical drawings do not necessarily claim the same invention where the claim 1s differ.

Dear ........,

As you are aware, your application was accepted despite an objection under subsection 64(2).

Before the application proceeds to grant, the Commissioner has a duty to consider whether there is a bar to grant. In this regard, the Commissioner has reconsidered the objection and considers that claims ........ repeat claims ........ of your patent number .........

In order to assist you to decide on a course of action, the following explanation is provided.

[Include an explanation of why the sec 64(2) objection is still applicable in the light of any responses from the applicant. This can include a reference to a previous report(s) if appropriate].

You are entitled to be heard before any determination is made. Should you not wish to be heard, you may file written submissions on the matter. If the Commissioner remains of the opinion that there is a bar to grant, then a hearing will be set down forthwith to allow you to be heard.

Alternatively, you may file a request to surrender your existing patent or, if you believe that the objection can be overcome by amendment, you may file a request under section 104 to amend either specification.
Consequently, you are requested to either:

a. request a hearing in this matter,

b. file written submissions,

c. file a request to surrender your patent number........, or

d. file a request to amend under section 104,

within 60 days of the date of this letter.

Yours sincerely

2.19 Patents of Addition (Chapter 7)

2.19.1 Applications for Patents of Addition

Modified Date: 02 April 2013

2.19.1.1 Introduction

*Chapter 7* of the Act provides for the grant of a patent of addition. Where a patent for an invention ("the main invention") has been applied for or granted (the parent application or patent), and the applicant or patentee applies for a further patent for an improvement in, or modification of, the main invention, a patent of addition may be granted for the improvement or modification. The phrase “the main invention” means the invention as claimed in the parent specification (see *Monsanto Chemicals Ltd.'s Application* (1968) AOJP 348).

*Section 80* states that patents of addition do not apply to innovation patents. Thus, neither the patent for the main invention (the parent patent), nor the patent of addition, can be an innovation patent.
2.19.1.3 Conditions of Filing

The general conditions for the filing of standard patent applications also apply to applications for patents of addition. Examiners should note, however, that the patent request for the patent of addition must include an indication that it is for a patent of addition and must state the parent application or patent number.

2.19.1.4 Patent Must be in Force

Section 81 does not explicitly preclude the filing of an application for a patent of addition where the parent application or patent is not in force. However, the requirement under sec 83 that the patent of addition remains in force for as long as the parent patent remains in force would render such an application meaningless.

Examiners are required to check at each report stage whether the parent application or patent is in force by checking the status and 'In Force' date on the ECase Summary screen in PAMS. (Note: The ‘In Force’ date is the date up until which continuation or renewal fees have been paid). In general, a parent that has an ‘In Force’ date that is in the future and a status of:

- ‘Filed’ or ‘Accepted’ in the case of an application;
- ‘Granted’ in the case of a patent;

is in force.

A status of ‘Lapsed’, ‘Refused’ or ‘Withdrawn’ (in the case of an application), or ‘Ceased’ or ‘Expired’ (in the case of a patent), indicates that the parent is not in force. (Examiners should note that for the status of Lapsed, ‘Refused’ or ‘Withdrawn’, this is regardless of the ‘In Force’ date). Where examiners have any doubts as to whether the parent is in force, they should consult a senior examiner. If the parent application or patent is not in force (regardless of whether the 6 month grace period for paying a continuation or renewal fee has expired), then an objection should be taken that the application cannot proceed as a patent of addition. Opinion on all other matters should be reserved pending resolution of whether the application is to proceed as an application for a standard patent (see 2.19.3 "Improvement" and "Modification").
Continuation fees are payable in respect of an application for a patent of addition. The date for determining the payment of continuation fees is the filing date of the patent of addition application (reg 13.3(1)). However, no renewal fee is payable on a patent of addition (sec 86) and the patent of addition normally ceases when the parent patent ceases (sec 83(1)). Where an application is both a divisional and an additional, the continuation fee payable is determined on the basis of its status as a divisional application. However, upon grant the renewal fee is determined on the basis of its status as a patent of addition, i.e. no renewal fee is payable.

The applicant for a patent of addition, at the time of acceptance, must also be:

- the applicant for a patent in respect of the main invention (the parent application); or
- the patentee in respect of the main invention (the parent patent); or
- have the authorisation of the applicant or patentee above.

If the application purports to be for a patent of addition at the time of examination, but does not meet one of the preceding conditions, an objection should be taken. Note, however, that no objection applies where the application for a patent of addition has been made by an authorised applicant and the ownership of the main invention subsequently changes by devolution or other process of law (sec 81(1)(b)).

If the patent request for the patent of addition is made by a person other than the applicant/patentee of the application/patent in respect of the main invention, then the
provisions of reg 3.1(2)(g) apply and a statement of authorisation by the applicant/patentee of the main invention is required.

For statements of authorisation filed before 25 August 2018 there is a requirement that the statement be signed. The signature on the statement of authorisation must be that of the applicant/patentee in respect of the main invention, as the provisions of sec 213 (which relate to making and signing an application, notice or request) do not extend to the statement of authorisation (see Sir W.G. Armstrong Whitworth and Co.(Engineers) Ltd.'s Application (1969) AOJP 1166). Arguments that the patent attorney acting for the applicant for the patent of addition has been, and still is, authorised to represent the owners of the parent application/patent, are not admissible (see also 2.29.10 Signature Requirements for Received Documents).

Modified Date: 02 April 2013

2.19.1.8 One Parent Only

An application for a patent of addition may not proceed unless it is in respect of one parent application/patent only (see H.S.J.'s Application (1914) 31 RPC 47).

Modified Date: 02 April 2013

2.19.1.9 Plural Additional Applications

There may be several applications for patents of addition filed in respect of one main invention and they may be related to one or several of the claims of the parent specification.
There is no objection if any of the applications for a patent of addition is filed at the same time as the application in respect of the main invention.

Modified Date: 02 April 2013

**2.19.1.10 Additional to an Additional**

A patent of addition may be applied for, and granted, in respect of another patent of addition (see *McFeely's Application* (1912) 29 RPC 386). There is also no objection if there is a longer series of additional applications. However, it is essential that the patent request discloses all relevant facts, such that the term of any patent issued can be readily determined.

Modified Date: 02 April 2013

**2.19.1.11 May be Both an Additional and Divisional**

An application can be an additional to one application (or patent) and a divisional of a different application (or patent). The term of an additional will be the same as its parent (i.e. the application or patent for the main invention), regardless of whether it also claims divisional status.

In order for an application for a divisional and an additional of the same parent to be accepted, all of its claims must satisfy the criteria of both a divisional and an additional application.

It is difficult to envisage this occurring under normal circumstances, given that an "improvement or modification of the main invention" cannot be matter disclosed in the parent application (see 2.19.3 "Improvement" and "Modification"). However, in the case of application 17561/00 (759625), an independent claim comprised two notional claims, one of which met the criteria for being a divisional of 36806/97 (736856), and the other which met the criteria for being an additional of the same parent. The applicant sought both divisional and additional status for the application. This was considered permissible and the application was allowed to proceed to grant.

2.19.1.5 Fees provides details on the continuation/renewal fees applicable in these circumstances.
2.10.4 Status of Parent provides guidance on the situation where an application is a divisional application of:

- a patent of addition; or
- an application for a patent of addition.

2.19.2 Examination Procedure

Modified Date: 01 December 2016

2.19.2.1 Examination Practice

In this topic:

Overview

Examination of an additional application cannot commence unless a request for examination of the parent has been made (sec 81(2)). Where a request for examination of the parent has not been made, examiners should refer the parent application to COG for the issuance of a direction under sec 44(2). Wherever possible, examiners should issue a first report on the parent application before issuing a first report on the additional application, in order to avoid complications at acceptance (see paragraph below).

Note: Examiners must not accept an application for a patent of addition until the parent application has been accepted (2.19.2.2 Grant Requirements). Where there are outstanding objections to the parent application, examiners should state in their report that the opinion in respect of Chapter 7 of the Act is tentative pending resolution of the objections to the parent application. A report to this effect should be issued, even when the application for the patent of addition is otherwise in order for acceptance.

Special Considerations
A patent of addition cannot claim matter that was disclosed in the parent specification, as this would give rise to an objection of lack of novelty in the light of the parent. However, an objection of lack of inventive step with respect to the parent is not applicable by virtue of sec 25 (see 2.19.3 “Improvement” and “Modification” and 2.19.6 Differentiation from the Parent for further information).

The specification of the patent of addition may contain a claim that specifically refers to the parent specification. Such claims must be considered carefully to ensure that any reference is unambiguous. Examiners should note, however, that it is often necessary to refer to a particular claim of the parent specification, in order to avoid ambiguity.

Where an application for a patent of addition is in respect of a specific apparatus for carrying out a method or process of the main invention, and essentially includes integers which function to perform all the steps of that process or method, the application may proceed as an application for a patent of addition. However, if the apparatus claimed is of a general, rather than a specific, nature, the applicability of Chapter 7 is doubtful. Cases of this kind should be referred to a supervising examiner.

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### Failure to Meet Patent of Addition Requirements

Where an application for a patent of addition does not meet the requirements of Chapter 7, e.g. the patent of addition is not an improvement in or modification of the main invention, examiners should object accordingly. In this situation the patent request for the patent of addition may be amended under sec 104 so as to no longer invoke Chapter 7. Amendment of the specification, and any statement relating to entitlement, may also be necessary. Any subsequent report on an application so amended is to report as though the application has not invoked Chapter 7, including, where appropriate, that an inventive step objection may now apply based on the earlier parent application.

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### Conversion to Patent of Addition

A patent request for an ordinary application for a patent may be amended under sec 104 to an application for a patent of addition in rebuttal of an examiner's objection (e.g. lack of inventive step), provided that all the requirements of Chapter 7 are satisfied (see also 2.23.13.7 Amending a Patent Request to a Patent Request for a Patent of Addition).
Further information on the examination of additional applications is provided in:

- 2.19.3 “Improvement” and “Modification”;
- 2.19.4 Amendments; and
- 2.19.6 Differentiation from the Parent.

Modified Date: 02 April 2013

**2.19.2.2 Grant Requirements**

A patent **must not** be granted on an application for a patent of addition before the grant of the parent patent for the main invention (sec 81(3)). In practice, examiners must not accept an application for a patent of addition until the parent application has been accepted (see 2.19.2.1 Examination Practice). Examiners must therefore place a case note on each file to ensure that these provisions are observed. In some circumstances, the grant of the parent may be accelerated (see 2.19.5 Timing Provisions).

Modified Date: 01 April 2019

**2.19.3 "Improvement" and "Modification"**

In this topic:

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**General Considerations**

An application for a patent of addition must disclose an improvement in, or modification of, the “main invention” applied for or granted in the parent specification (Georgia Kaolin Co. Ltd.’s Application (1956) RPC 121 and Welwyn Electrical Laboratories Ltd.’s Application (1957) RPC 143). The “main invention” must be the invention claimed in the parent specification, as distinct from an invention merely disclosed in it (sec 81(1)(a); see also SNF (Australia) Pty Ltd v BASF Australia Ltd [2018] APO 26 at [60]-[62]). The mere claiming of the parent invention from a different aspect, or the claiming of subject matter described in
the earlier specification, but not claimed therein, does not constitute an improvement or modification (Welwyn Application supra).

Furthermore, a patent of addition cannot claim matter that was disclosed in the parent specification, as this would give rise to an objection of lack of novelty in the light of the parent. This applies even if the claims also encompass an improvement in, or modification of, what was disclosed in the parent (Welwyn Application supra). Note, however, that an objection of lack of inventive step with respect to the parent is not applicable (sec 25; see also 'Failure to Meet Requirements for "Improvement" or "Modification"' below and 2.19.6 Differentiation From the Parent).

A patent of addition cannot validly claim something that was implicit in the parent (Aluminium Co of America's Application (1971) 41 AOJP 4259). Guidance from Baracuda (Pty) Ltd v Chauvier [1987] APO 3 suggests that a patent of addition cannot comprise a mere design optimisation of the main invention, while Fisons Ltd's Application [1983] APO 40 indicates that a patent of addition must disclose and claim matter substantially different from what was claimed in the parent. However, those decisions were peculiar to the ground of prior claiming under the 1952 Patents Act and are not to be taken as being indicative of the degree to which the subject matter of the patent of addition must be different from the main invention. Rather, for the purposes of the 1990 Act, the wording from Baracuda and Fisons supra is to be understood as synonymous with the requirement that the patent of addition be novel over the parent; see SNF (Australia) Pty Ltd v BASF Australia Ltd supra at [70]-[74].

Where a claim of the application for a patent of addition is directed to matter disclosed in the parent specification, either in the body of that specification or in the claims, an objection that matter which was actually part of the parent specification cannot be an improvement in, or modification of, the parent invention may apply. The only exception to this is the situation envisaged in 2.19.1.11 May be Both an Additional and Divisional.

Similar considerations apply where a claim of an application for a patent of addition is directed to matter which is inherent in the parent specification (see Aluminium Company of America's Application (1971) AOJP 4259).

Determinatoin of “Improvement” and “Modification”

Elliott Brothers Application

The terms "improvement" and "modification" have been broadly judicially defined in relation to patents of addition in Elliott Brothers (London) Ltd.'s Application (1967) RPC 1. Thus,
there is authority as to the extent or nature of the relationship required between the subject matter of the additional and the parent.

In relation to this case, Lloyd-Jacob J observed that:

“A modification is an alteration which does not involve a radical transformation and an improvement is a variation, whether by addition, omission or alteration, to secure a better performance, whilst retaining some characteristic part.”

The case was concerned with two patent applications claiming instruments for indicating a rate of turn in an aircraft, the claimed instruments having a number of features in common, but differing in the way in which the amount of movement of a certain component of the instrument was measured. During examination, it became apparent that all of the features that were common between the two instruments were also present in prior art instruments, and consequently the only features which could possibly be novel and inventive were the movement sensing mechanisms.

Lloyd-Jacob J considered that the nature of the invention of the parent (i.e. the "main invention") could not be properly understood without reference to the prior art, and when it was so understood, the second application, which the applicants wished to be a patent of addition of the first, had removed all of the novel features introduced by the first. Lloyd-Jacob J referred to this as "the most complete form of radical transformation possible" and held that the second application could not become a patent of addition to the first (Elliott Brothers (London) Ltd's Application supra at 5).

Therefore, the proper basis for determining if an application for a patent of addition is an improvement in, or modification of, the main invention is a comparison between the novel contribution which each claim makes over the prior art.

A generalisation of the facts of the Elliott Brothers case would be as follows:

Consider the “main invention”, i.e. the claimed invention, to comprise features A+B+C, where feature C represents the novel contribution. An application for a patent of addition is filed in respect of A+B+C+D. This application retains all of the features of the “main invention” and the addition of feature D makes this an improvement in the “main invention”. On the other hand, an application for a patent of addition for A+B+D, where feature D represents the novel contribution, leads to a different outcome. The novel feature C of the “main invention” has been removed, and consequently this is a new invention, rather than a modification of the “main invention”. D may also be considered a radical transformation or variation of C. The invention A+B+D is therefore more than an improvement in, or modification of, the main invention and is not suitable subject matter for a patent of addition.

Alternatively, an application for a patent of addition consists of claims directed to features A+B+C*, where feature C* represents the novel contribution. Provided C* is only a minor transformation or variation of feature C of the parent specification, then the invention A+B+C* is an improvement in, or modification of, the “main invention” and thus meets the
requirements for a patent of addition. Of course, it must be determined on the facts of the case whether C* represents a minor transformation of feature C.

Although the above examples have dissected the claimed integers into parts, the words "modification" and "improvement" relate to the invention; they do not necessarily relate to individual integers of the claims. Thus, there may be one modification or one improvement of an invention, even though more than one integer has been changed.

Subsection 40(4) "Test"

It should be noted that sec 81(1) does not require that a patent of addition should be more limited in scope than the parent. An applicant or a patentee may use the provisions of the section to effectively broaden the parent. Thus, the patent of addition could be made broader than the parent by omission of a feature, the omission then constituting the modification (see Hughes Tool Company v. Ingersoll-Rand Company Limited (1977) FSR 406). Usually, if a claim could have been properly included in a parent specification without giving rise to an objection of lack of unity, that claim may be deemed to be for an improvement or modification.

Thus, if the claims of the complete specification are such that, had they been present in the parent complete specification, no breach of sec 40(4) would have occurred, then the application can proceed as an additional application. This means that the feature making the technical contribution over the prior art cannot be said to be defining a new invention. However, it should be noted that this "test" is for general guidance only, as there may be cases which, although not strictly falling within this rule, may properly invoke Chapter 7. This test is also unsuitable where a claim is debarred on the grounds specified in the cases referred to above (Georgia Kaolin Co. Ltd.’s Application supra, Welwyn Electrical Laboratories Ltd.’s Application supra, Aluminium Company of America’s Application supra and Elliott Brothers (London) Ltd.’s Application supra).

It should also be noted that whilst certain claims may be properly included in an application for a patent of addition, they do not necessarily fit into one such application, i.e. sec 40(4) is fully applicable. Each application for a patent of addition may be made in respect of one improvement or one modification only. Different improvements or modifications may constitute different inventions and should, if that is the case, be made the subject of separate applications for patents of addition; the main invention cannot serve as a common element of novelty. However, where the invention which is the subject of the application for a patent of addition involves several changed integers (or steps), there is no objection if all those changed integers (or steps) are included in one claim, since all those changed integers (or steps) may constitute one modification of the invention. Examiners should clearly distinguish between improvements or modifications of the invention and improvements or modifications of individual elements of a claim.
In cases where the co-existence of independent claims in an application for a patent of addition would be objectionable under sec 40(4), the provision of alternative forms in the one claim is equally objectionable.

**Note:** The suitability of an application to proceed as an application for a patent of addition should be determined at the time when the specification of the application for the patent of addition is otherwise in order for acceptance (P. and S.’s Application (1952) 69 RPC 249). Any opinion on this matter expressed at an earlier date must be regarded as tentative only and subject to review at any time before acceptance. If the scope of the invention claimed in the parent specification is altered before acceptance, the invention of the application for a patent of addition must be capable of being considered as an improvement in, or modification of, the altered invention of the parent specification (see also 2.19.4 Amendments).

### Failure to Meet Requirements for “Improvement” or “Modification”

If an application for a patent of addition does not meet the requirements of Chapter 7 because it is not an improvement in, or modification of, the main invention, examiners should object accordingly. Where the application for the patent of addition claims matter disclosed in the parent specification, a novelty objection in light of the parent may also apply (as discussed in “General Considerations” above).

In this situation, the applicant may decide to amend the patent request for the patent of addition so as to no longer invoke Chapter 7 (see 2.19.2.1 Examination Practice).
requirement, the case should be referred to the Assistant General Manager (OEP), via a supervising examiner.

Similar considerations apply where a request is made under sec 104 to amend the specification of an accepted application for a patent of addition or a granted patent of addition.

Grant Requirements

A patent of addition must not be granted before the patent for the main invention is granted (sec 81(3)). In practice, examiners must not accept an application for a patent of addition until the parent application has been accepted. The procedures stated in 2.19.2 Examination Procedure apply in all cases and in some situations difficulties may arise. However, in certain circumstances the grant of the parent patent may be accelerated and the grant period of the additional patent may be extended (see sec 61(2) and reg 6.2(1)(b)). Cases involving timing complications of this type are to be referred to a supervising examiner.
Additional to an Additional

In the case of applications for a patent of addition to a patent of addition, the “main
invention” of the second application for a patent of addition is the invention which is the
subject of the first patent of addition (or the application therefor), and not the initial parent
patent. Similarly, where there is a longer chain of additions to additions, the "main
invention" for the purposes of sec 81(2) is that of the immediately preceding application or
patent. Thus, additions to additions can take place only in chronological order (see also
2.19.1.9 Plural Additional Applications).

The claims of a patent of addition must be for matter which was not disclosed in the
specification of the parent. However, under sec 25 and reg 2.4, such matter need not
involve an inventive step with respect to the parent (P. and S.’s Application (1952) 69 RPC
249) (see also ‘Section 25’ below). The claims of the patent of addition must, however, meet
the requirements for inventive step with respect to matter other than that disclosed in the
parent.

Note: Section 25 does not preclude an objection of lack of novelty in the light of the parent
specification.

In the case of a series of additional applications, sec 25 does not protect the second
application from an objection based on the publication of the invention in the parent of the
parent (or earlier, where applicable) specification.

If part of the subject matter described in the complete specification of the parent application
or patent is excised after the parent case becomes open to public inspection, sec 25 will not
protect the additional application from an objection based on the excised matter if that matter
was published before the priority date of the additional application (see P. and S.’s
Application supra).
2.19.7 Considering Parent File During Examination

Section 25

Section 25 and reg 2.4 preclude objections on the ground of lack of inventive step having regard to publication during the period extending from the priority date of the claims of the main invention (or the earliest priority date of the claims of the main invention in the case of multiple priorities) to the priority date of the relevant claim of the additional application.

Section 25 does not apply where there was publication or use of the main invention before the priority date (or earliest priority date) of the claims of the parent specification.

The publication and use of the main invention referred to in sec 25 means publication or use either by the applicant or by other persons. Thus, "publication" is not restricted to publication in the specification in which the main invention was described (see Monsanto Co.'s (Salyer's) Application (1969) RPC 75).

Note: Where the application for the patent of addition contains one or more claims that repeat claims of the parent application or patent, an objection under sec 64(2) may apply (see 2.18.8 Additionals/Divisionals).

2.19.7 Considering Parent File During Examination

Examiners must consider the parent case file during examination and check whether the application for a patent of addition complies with the necessary requirements; see:

- 2.19.2 Examination Procedure;
- 2.19.3 "Improvement" and "Modification";
- 2.19.5 Timing Provisions; and
- 2.19.6 Differentiation From the Parent.

Note: Examiners must not accept an application for a patent of addition until the parent application has been accepted (see 2.19.1.1 Examination Practice).
Parent Case Under Opposition or Re-Examination, or Contains a Section 27 Notice

Where the parent case is under opposition or re-examination, or contains a [sec 27](#) notice, examiners should consider any available material or documentary evidence filed in those proceedings at each report stage. Examiners should also consider any issues raised in the material on the parent file and check whether these apply to the application for a patent of addition. Taking the available material into account, examiners are to report in the usual way, but should avoid making comments which prejudge the outcome of any proceedings in respect of the parent case.

However, the fact that the parent case may be subject to proceedings, e.g. opposition, and those proceedings have not concluded, does not mean that examination of the application for a patent of addition should be delayed, provided that prejudging the outcome of the opposition does not occur. Where the circumstances are such that this condition cannot be met, the case must be referred to the Assistant General Manager (OEP).

It is particularly important that examiners consider the potential relevance of any decision which has issued in respect of the parent application.

---

**Annex A - Procedural Outline to Patents of Addition Examination**

(supplementary to the outline to full examination ([2.13](#) Examination – Annex A))

<table>
<thead>
<tr>
<th>1. Consider all ‘relative’ case files (<a href="#">Registry Manager</a>) to supply paper case files)</th>
<th>2. Check application in force if the date of the patent is more than 4 years ago (usually this will only arise in the case of divisional applications).</th>
</tr>
</thead>
<tbody>
<tr>
<td>Neither the parent nor the patent of addition can be an innovation patent.</td>
<td>2.13.2 Applications in a State of Lapse or Lapsed</td>
</tr>
<tr>
<td>2.19.7 Considering Parent File During Examination</td>
<td>2.19.1.4 Patent Must be in Force</td>
</tr>
<tr>
<td>2.19.1.2 Neither Can be an Innovation Patent</td>
<td></td>
</tr>
<tr>
<td></td>
<td></td>
</tr>
<tr>
<td>---</td>
<td>---</td>
</tr>
<tr>
<td>3.</td>
<td>Check that the parent is in force at each stage of examination of the patent of addition. The patent of addition is in force provided the parent is in force.</td>
</tr>
<tr>
<td>4.</td>
<td>Check that the request for examination of the parent has been filed before commencing examination of the patent of addition.</td>
</tr>
<tr>
<td>5.</td>
<td>Check that the patent of addition was filed on or after the filing of the parent application.</td>
</tr>
<tr>
<td>6.</td>
<td>Check that the patent request indicates the parent application or patent number. Check that the applicant for the patent of addition is the same as the applicant or patentee for the parent or has the consent of the parent applicant or patentee.</td>
</tr>
<tr>
<td>7.</td>
<td>Check that the patent of addition is in respect of an improvement in, or modification of, the main invention.</td>
</tr>
<tr>
<td>8.</td>
<td>Check that the patent of addition is in respect of only one improvement in, or modification of, the main invention. Check that there is no claim in the patent of addition which is identical in scope to a claim in the parent.</td>
</tr>
<tr>
<td>9.</td>
<td>Consider novelty implications if the parent was published prior to the priority date of the claims of the patent of addition. The patent of addition does not need to involve an inventive step in view of the parent.</td>
</tr>
</tbody>
</table>

This document is controlled. Its accuracy can only be guaranteed when viewed electronically. Effective Date: 25 September 2019
### 2.20 National Phase Applications

#### 2.20.1 Introduction

**Modified Date:** 01 February 2017

### 2.20.1 Introduction

**Note:** For information on international applications and matters prior to national phase entry, refer to Volume 1 International.

International applications which designate Australia may be processed before the Australian Patent Office with a view to the grant of a patent in Australia. Designation of all countries is automatic upon the filing of a PCT application. (Although a designation may subsequently be withdrawn, this happens very rarely, if it all, in the case of Australia). Such applications are commonly referred to as national phase applications. The national phase is the final stage of processing an international application originally filed in the receiving Office of one of the contracting states of the PCT.

A summary of issues to consider when examining national phase applications is provided in [2.20 Annex A – Examination of National Phase Applications: Indicators of Special or Different Considerations](#).

<table>
<thead>
<tr>
<th>Step</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>10.</td>
<td>Check all 'relative' case file(s) for any relevant material filed in relation to sec 32 or sec 36 requests, opposition, re-examination or notices under sec 27 or sec 28 which may give rise to an objection on the patent of addition.</td>
</tr>
<tr>
<td>11.</td>
<td>Check that the parent has been accepted or is already a patent before accepting the patent of addition.</td>
</tr>
<tr>
<td>12.</td>
<td>Where the case is supervised, submit all paper ancestor case file(s) with the patent of addition case file.</td>
</tr>
</tbody>
</table>

[2.19.7 Considering Parent File During Examination](#)

[2.19.2.2 Grant Requirements](#)
2.20.1.1 Definitions of Terms

In this part, the following terms have the definition indicated:

**International application** - an application filed under the PCT.

It therefore has the same meaning as in the PCT, i.e. the application need not designate Australia, nor have been given an international filing date.

**PCT application** - an international application in which Australia has been designated under Article 4(1)(ii) of the PCT and which has been given an international filing date.

It therefore has the same meaning as in the Patents Act.

**National phase application** - a PCT application in relation to which the applicant has met the necessary requirements of the Patents Act.

Where those requirements are met, further processing of the PCT application before the Australian Patent Office may occur. This processing is commonly referred to as **national phase** processing, hence terms such as “national phase”, “national phase application” and “entering the national phase”.

Modified Date: 01 February 2017

2.20.1.2 Key Features of the Legislation

**Note:** The information in this part only applies to PCT applications filed before 15 April 2013. For all other PCT applications, see 2.20.1.2A Key Features of the Legislation.

In this topic:

- Particular aspects of the PCT, the Patents Act and the Patents Regulations are relevant to considerations in the national phase.
2.20.1.2 Key Features of the Legislation

**Article 3**: An international application shall contain a request, description, claim(s), drawing(s) where required and an abstract.

**Article 4**: The request shall designate the contracting states (e.g. Australia) in which protection is sought.

**Article 8**: The international application may claim priority from an earlier national application(s).

**Article 11**: The international filing date is the date of receipt of the international application by the receiving Office, if requirements of right to apply and language and application formalities are met. This date is considered the actual filing date in each designated state.

**Article 19**: After receiving the ISR and ISO, the applicant is entitled to one opportunity to amend the claims at the International Bureau. A statement in support may also be made. The amendments should not go beyond the disclosure in the international application as filed.

**Article 27**: No national law shall require compliance with requirements relating to the form or contents (e.g. formality requirements) of the international application different from, or additional to, those of the PCT.

**Article 34**: Before the IPEA establishes the IPER/IPRPII, the applicant is entitled to amend the claims, description and drawings. The amendments should not go beyond the disclosure in the international application as filed.

**Article 41**: In the national phase, amendments should not go beyond the disclosure in the international application as filed, unless this is permitted under national law.

**Rule 91**: Obvious mistakes in the international application may be rectified by the relevant authority upon request by the applicant.

The relevant authority to which the applicant sends a request to rectify the application differs depending on what part of the international application is to be rectified. The receiving Office may only correct mistakes in the request. The ISA and IPEA can correct mistakes occurring in the application and documents submitted to the authority, but not those that occur in the request. The International Bureau is the relevant authority for correcting mistakes occurring in documents which do not form part of the application or amendments/corrections to the application.

**Rule 92bis**: The International Bureau shall record changes in the person, name, residence, nationality or address of the applicant, at the request of the applicant or receiving Office, only if the request is made within the time limit.
2.20.1.2A Key Features of the Legislation

**Patents Act**

**Section 88(1):** A PCT application must be treated as a complete application for a standard patent.

**Section 88(3):** The description, drawings and claims of a PCT application are treated as the complete specification, but, in accordance with sec 89(2), are not presumed to satisfy sec 40.

**Section 88(4):** The filing date of a PCT application is its international filing date.

**Section 89(1):** A PCT application is to be taken to comply with the prescribed requirements for a patent application (see reg 8.1(3)), but is not taken to comply with other applicable requirements.

**Section 89(3):** The applicant cannot ask that any action be taken in relation to an application unless the required documents are filed and the fees paid.

**Section 89(4):** Where a translation has been filed, an application is taken to have been amended, on the day on which the translation was filed, by substituting the translation for the international application.

**Section 89(5):** An application is taken to be amended by amendments made under Article 19 or Article 34 (if timing provisions are met), or by rectifications made under Rule 91, on their date of filing.

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**Patents Regulations**

**Regulation 8.2(5):** For a PCT application, the applicant is taken to be the nominated person.

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Modified Date: 25 February 2019

2.20.1.2A Key Features of the Legislation

**Note:** The information in this part only applies to PCT applications filed on or after 15 April 2013. For all other PCT applications, see 2.20.1.2 Key Features of the Legislation.

In this topic:
Particular aspects of the PCT, the Patents Act and the Patents Regulations are relevant to considerations in the national phase.

**PCT**

**Article 3:** An international application shall contain a request, description, claim(s), drawing(s) where required and an abstract.

**Article 4:** The request shall designate the contracting states (e.g. Australia) in which protection is sought.

**Article 8:** The international application may claim priority from an earlier national application(s).

**Article 11:** The international filing date is the date of receipt of the international application by the receiving Office, if requirements of right to apply and language and application formalities are met. This date is considered the actual filing date in each designated state.

**Article 19:** After receiving the ISR and ISO, the applicant is entitled to one opportunity to amend the claims at the International Bureau. A statement in support may also be made. The amendments should not go beyond the disclosure in the international application as filed.

**Article 27:** No national law shall require compliance with requirements relating to the form or contents (e.g. formality requirements) of the international application different from, or additional to, those of the PCT.

**Article 34:** Before the IPEA establishes the IPER/IPRP1I, the applicant is entitled to amend the claims, description and drawings. The amendments should not go beyond the disclosure in the international application as filed.

**Article 41:** In the national phase, amendments should not go beyond the disclosure in the international application as filed, unless this is permitted under national law.

**Rule 91:** Obvious mistakes in the international application may be rectified by the relevant authority upon request by the applicant.

The relevant authority to which the applicant sends a request to rectify the application differs depending on what part of the international application is to be rectified. The receiving Office may only correct mistakes in the request. The ISA and IPEA can correct mistakes occurring
in the application and documents submitted to the authority, but not those that occur in the request. The International Bureau is the relevant authority for correcting mistakes occurring in documents which do not form part of the application or amendments/corrections to the application.

Rule 92bis: The International Bureau shall record changes in the person, name, residence, nationality or address of the applicant, at the request of the applicant or receiving Office, only if the request is made within the time limit.

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**Patents Act**

**Section 29A(1):** A PCT application is to be treated as a complete application for a standard patent.

**Section 29A(2):** The description, drawings, graphics, photographs and claims of a PCT application are treated as the complete specification.

**Section 29A(4):** A PCT application is to be taken to comply with the prescribed requirements for a patent application, but is not taken to comply with other applicable requirements.

**Section 29A(5):** To enter the national phase in Australia, an applicant must file the prescribed documents, pay the prescribed fees and, where appropriate, file an English translation of the application, within the prescribed period.

**Section 30:** The filing date of a PCT application is determined under reg 3.5AA. In general, the filing date is the international filing date.

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**Patents Regulations**

**Regulation 3.1A(2):** For a PCT application, the applicant is taken to be the nominated person.

**Regulation 3.5AC(2):** Where a translation has been filed, an application is taken to have been amended, on the day on which the translation was filed, by substituting the translation for the international application.
Regulations 3.5AC(3), 3.5AC(4) and 3.5AC(5): An application is taken to be amended by amendments made under Article 19 or Article 34 (if timing provisions are met), or by rectifications made under Rule 91, on their date of filing.

Modified Date: 25 February 2019

2.20.1.3 National Phase Preliminaries

Note: The information in this part only applies to PCT applications filed before 15 April 2013. For all other PCT applications, see 2.20.1.3A National Phase Preliminaries.

In this topic:

Overview

The national phase is the final stage of processing an international application originally filed in the receiving Office of one of the contracting states of the PCT.

The receiving Office accords an international filing date to the international application after checking for compliance with Article 11. The receiving Office then sends a record copy of the international application to the International Bureau (IB) and a search copy to the ISA. The receiving Office also checks the international application for defects under Article 14(1). These defects include it not being signed, not having a title, not containing an abstract and not complying with the prescribed physical requirements (as set out in Rule 11).

A PAMS record is created for every PCT application having an AU designation. The record includes an allocated Australian patent application number, title and details of one applicant. The application number has ten numerals, wherein the first four numbers represent the current calendar year, the fifth number designates the type of patent (with 2 up to 7 designating a standard application) and the remaining five numbers are taken from a five digit series.

Search and Publication
The ISA competent for the receiving Office will conduct an international search and establish an ISR and ISO for the international application. The ISR will be published when the international application is published in a document called "the pamphlet", which is sent to each designated office. The pamphlet is published with a WO number identification for the application and may be in a foreign language. Publication usually takes place 18 months after the priority date of the application.

The ISO will be published by the IB 30 months after the priority date of the application as an IPRPII, but only if there is no demand for IPE. If the applicant has filed comments in respect of the ISO, the IB will publish these as well. Where the applicant files a demand for IPE, an IPRPII will be established and published 30 months after the priority date.

For national phase applications filed on or after 1 January 2004 and which enter the national phase more than 18 months from the priority date, the OPI date is the date upon which the PCT pamphlet is published under Article 21. For all national phase applications filed before 1 January 2004 and for national phase applications filed on or after 1 January 2004 which enter the national phase less than 18 months from the priority date, the OPI date is the date upon which it is advertised as such in the Official Journal (sec 90(b) and sec 92(3); see also 2.17.2 Date of Publication).

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**National Phase Entry**

Article 22 and Article 39 allow applicants a period of 30 months from the priority date for their PCT applications to enter the national phase. Contracting states may, however, allow a longer period and in the case of Australia the period is 31 months (reg 8.1(4)).

To enter the national phase in Australia:

- The national phase entry fee specified at item 214A of schedule 7 of the Regulations must have been paid. It should be noted that there is no requirement for an examination fee to be paid at this stage.

- If the PCT application has not been published under Article 21 of the PCT, a copy of the application must be filed (see also Copy of the International Application Furnished by Applicant below).

- If the PCT application was not filed with a Receiving Office in English, a translation of the application must be filed (unless a translation was filed in the international phase and published under Article 21).

Before applicants can request that any action be taken in relation to an application, they must also have filed:
2.20.1.3 National Phase Preliminaries

- A document stating an address for service in Australia.
- A certificate of verification for any translation.

The above matters will be checked by COG before case files are forwarded to examination sections. However, where examiners notice deficiencies in any of these matters, the case file is to be referred to COG for action. Examiners should note that COG will only check that these actions have been done and will not check for content, e.g. there will be no check made on the verification of any translation.

**Note:** PCT applications that enter the national phase on or after 15 April 2013 will be subject to a formalities check; see 2.20.1.4A Formalities Check.

---

### Copy of the International Application Furnished by Applicant

The situation where an applicant is required to furnish a copy of the international application to enter the national phase usually arises where the applicant requests early national phase entry of an application, e.g. less than 18 months from the priority date.

**Examination Practice**

Where the applicant furnishes a copy of the international application, this copy remains a proxy specification for the actual PCT application (pamphlet) that will eventually be published by WIPO. Before commencing examination on a case with a proxy specification, examiners should check Patentscope to see whether a copy of the pamphlet is available. If the pamphlet is not available, examination should be carried out on the proxy specification. If the pamphlet is available, examiners should download a copy and import it into the PAMS case file. The downloaded version then becomes the official specification which is used for examination purposes and the proxy specification is disregarded.

See also 2.20.7 National Examination Where the ISR is Missing.

**Note:** When importing the pamphlet into PAMS, it should be separated into its component parts, i.e. Abstract, Description, Claims, Drawings and Gene Sequence. The front page of the PCT pamphlet forms the Abstract. The 'Document Status' for all documents should be 'Filed' (see 5.6.7 Document Manipulation).

**Note:** An Assembly Note should also be added to the case file to alert COG that the pamphlet is the official version of the specification (see 5.10.11.3 Assembly).
2.20.1.3A National Phase Preliminaries

Note: The information in this part only applies to PCT applications filed on or after 15 April 2013. For all other PCT applications, see 2.20.1.3 National Phase Preliminaries.

In this topic:

Overview

The national phase is the final stage of processing an international application originally filed in the receiving Office of one of the contracting states of the PCT.

The receiving Office accords an international filing date to the international application after checking for compliance with Article 11. The receiving Office then sends a record copy of the international application to the International Bureau (IB) and a search copy to the ISA. The receiving Office also checks the international application for defects under Article 14(1). These defects include it not being signed, not having a title, not containing an abstract and not complying with the prescribed physical requirements (as set out in Rule 11).

A PAMS record is created for every PCT application having an AU designation. The record includes an allocated Australian patent application number, title and details of one applicant. The application number has ten numerals, wherein the first four numbers represent the current calendar year, the fifth number designates the type of patent (with 2 up to 7 designating a standard application) and the remaining five numbers are taken from a five digit series.

Search and Publication

The ISA competent for the receiving Office will conduct an international search and establish an ISR and ISO for the international application. The ISR will be published when the international application is published in a document called "the pamphlet", which is sent to each designated office. The pamphlet is published with a WO number identification for the
application and may be in a foreign language. Publication usually takes place 18 months after the priority date of the application.

The ISO will be published by the IB 30 months after the priority date of the application as an IPRPI, but only if there is no demand for IPE. If the applicant has filed comments in respect of the ISO, the IB will publish these as well. Where the applicant files a demand for IPE, an IPRPII will be established and published 30 months after the priority date.

For national phase applications filed on or after 1 January 2004 and which enter the national phase more than 18 months from the priority date, the OPI date is the date upon which the PCT pamphlet is published under Article 21. For all national phase applications filed before 1 January 2004 and for national phase applications filed on or after 1 January 2004 which enter the national phase less than 18 months from the priority date, the OPI date is the date upon which it is advertised as such in the Official Journal (sec 56A and reg 4.4; see also 2.17.2 Date of Publication and 2.17.5 Published Documents).

---

**National Phase Entry**

Article 22 and Article 39 allow applicants a period of 30 months from the priority date for their PCT applications to enter the national phase. Contracting states may, however, allow a longer period and in the case of Australia the period is 31 months (reg 3.5AE).

To enter the national phase in Australia:

- The national phase entry fee specified at item 214A of schedule 7 of the Regulations must have been paid. It should be noted that there is no requirement for an examination fee to be paid at this stage.

- If the PCT application has not been published under Article 21 of the PCT, a copy of the application must be filed (see also Copy of the International Application Furnished by Applicant below).

- If the PCT application was not filed with a Receiving Office in English, a translation of the application must be filed (unless a translation was filed in the international phase and published under Article 21).

Once in the national phase, the application must also meet the requirements of a formalities check (see 2.20.1.4A Formalities Check). If the requirements are not met and any deficiencies not addressed, the application will lapse.
The above matters will be checked by COG before case files are forwarded to examination sections. However, if examiners notice any formalities deficiencies during examination, an objection should be taken.

### Copy of the International Application Furnished by Applicant

The situation where an applicant is required to furnish a copy of the international application to enter the national phase usually arises where the applicant requests early national phase entry of an application, e.g. less than 18 months from the priority date.

#### Examination Practice

Where the applicant furnishes a copy of the international application, this copy remains a proxy specification for the actual PCT application (pamphlet) that will eventually be published by WIPO. Before commencing examination on a case with a proxy specification, examiners should check Patentscope to see whether a copy of the pamphlet is available. If the pamphlet is not available, examination should be carried out on the proxy specification. If the pamphlet is available, examiners should download a copy and import it into the PAMS case file. The downloaded version then becomes the official specification which is used for examination purposes and the proxy specification is disregarded.

See also [2.20.7 National Examination Where the ISR is Missing](#).

**Note:** When importing the pamphlet into PAMS, it should be separated into its component parts, i.e. Abstract, Description, Claims, Drawings and Gene Sequence. The front page of the PCT pamphlet forms the Abstract. The 'Document Status' for all documents should be 'Filed' (see [5.6.7 Document Manipulation](#)).

**Note:** An Assembly Note should also be added to the case file to alert COG that the pamphlet is the official version of the specification (see [5.10.11.3 Assembly](#)).
A PCT application is taken to meet the requirements of schedule 3. Consequently, there is no mechanism for objecting that a PCT application as filed does not meet the schedule 3 requirements (equivalent to PCT formalities). However, where documents associated with a PCT application are subsequently filed during the national phase, e.g. sec 104 amendments, and do not substantially comply with the requirements of schedule 3 (or, in certain circumstances, the Formalities Determination – see 2.29 Formalities and Forms), an objection may be taken.

In the case of a verified translation, any non-compliance with schedule 3 may be drawn to the attention of the applicant in the form of a note in the examination report. However, it is not mandatory for the applicant to address any formalities deficiency.

In rare circumstances, a PCT application may not list the inventor(s). This can be the basis of an objection that the entitlement of the applicant to the grant of the patent is not clear.

After national phase entry, a PCT application must meet the requirements of a formalities check otherwise it may lapse.

Under reg 3.2C:

- An address for service in Australia or New Zealand must be provided.
- The inventor name(s) must be provided.
- Where the application was not published in English, and a translation of the application has been provided by the applicant before or on 25 September 2019, a certificate of verification for the translation must also be filed.
- The application must comply with certain formality requirements (see also 2.29 Formalities and Forms).
The above matters will be checked by COG before case files are forwarded to examination sections. However, if during examination examiners notice any deficiencies in these matters, an objection should be taken.

Note: Unusual formality situations may arise in the case of Article 19 and Article 34 amendments; see 2.20.10.2 Formality Considerations.

2.20.2 Classification

All published PCT applications will have been classified or indexed by an ISA. The allocated IPC marks will appear on the 'Indexing and Formalities 2' screen in PAMS. These applications are not subjected to re-classification when entering the national phase, or when lapsing due to failure to enter the national phase. Where there is a missing or no recognised valid IPC mark(s) provided, ERA will generate an indexing task to be completed by the relevant examination section.

Where the allocated IPC mark(s) are clearly incorrect, examiners must re-classify the application following the procedures outlined in 5.9.4 Re-Indexing Applications.

2.20.3 Patent Request and Entitlement

2.20.3.1 Patent Request Form

A national phase application is taken to comply with the requirements of the Act and Regulations relating to a patent request.

Thus, there is no need for an applicant to file:

- a patent request form;
- a copy of the international request; or
- any "statement of intent to proceed in the national phase". Such statements are often supplied by attorneys but have no official status.
All the information usually included in a patent request form will be found on the pamphlet front page (or original request form where the pamphlet is not available; see 2.20.9 According International Filing Dates and Article 25 Applications). Thus, the applicant and inventor for Australia are shown on the front page at INID Codes 71 and 72 respectively (see 2.20 Annex B – Applicant and Inventor Details as Shown on PCT Pamphlet Front Page). Priority data (where applicable) are given at INID Codes 31, 32 and 33. Patent of addition information is mentioned at INID Code 61.

Where a patent request form is filed, and the relevant data differ from that on the front page of the pamphlet, examiners should query the difference(s) in the absence of any explanatory material on the case file, e.g. Rule 92bis notification. The applicant may subsequently rectify any differences by amendment of the patent request form under sec 104.

Where, after national phase entry, the applicant seeks to alter details normally shown in the patent request form (e.g. conversion from one type of application to another, change of name of applicant), this can be processed under sec 104. The applicant may also file a new patent request form incorporating the amendment, but this is not a formal requirement.

In this topic:

**Note:** For all requests for examination of standard patents filed from 15 April 2013 (from 23 March 2013 for requests filed through eServices and B2B), a statement of entitlement to grant and to claim priority must be included in the request.

**COG** will check for compliance and take any appropriate action. This can include treating the request as not having been filed or directing that the request be rectified. **COG** will not object where the request indicates that a valid notice of entitlement is already on file or PCT Rule 4.17(ii) and (iii) declarations have been made.

**General**

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
A notice of entitlement must be filed either as part of the request for examination or otherwise, unless the applicant has included in its PCT Request the necessary declarations under Rule 4.17(ii) and/or Rule 4.17(iii) which designate Australia. Rule 4.17(ii) declarations relate to the applicant’s entitlement to be granted a patent. Rule 4.17(iii) declarations relate to the applicant’s entitlement to claim priority from an earlier application.

Where Rule 4.17 declarations have been made, this will be indicated on the front page of the pamphlet and also in the IASR/IASF. They may also be referred to in a request for examination filed on or after 15 April 2013. Examples of declarations are provided in Annex C - Declaration Under Rule 4.17. For applications published from 1 April 2006, Australia is automatically designated for any declaration. For applications published before 1 April 2006, Australia is designated if the declaration refers to ‘AU’ or ‘all designations’.

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**Examination Practice**

**No Notice of Entitlement and No Rule 4.17 Declarations**

Where there is no notice of entitlement and no Rule 4.17 declarations on file, an objection should be raised during examination (see, for example, PERP code [B3]).

**Note:** An objection is not necessary if a statement of entitlement is implicit from other documents on the PAMS case file, for example, where the inventor is also the applicant. Note that documents on Patentscope are not part of the PAMS file and therefore an objection will still apply if the relevant facts are only apparent from Patentscope.

---

**No Notice of Entitlement and Rule 4.17 Declarations on File**

Where there is no notice of entitlement on file and there is a deficiency in the Rule 4.17 declaration(s), examiners should include an objection that the entitlement of the applicant is not clear and explain why. It is not sufficient to merely object that there is no notice of entitlement on file.

In practice:

- **If no priority is claimed** and a declaration under Rule 4.17(ii) nominating Australia is present, then the notice of entitlement requirements are met.

- **If priority is claimed:**
2.20.3.2 Entitlement

a. If declarations under Rule 4.17(ii) and Rule 4.17(iii) nominating Australia are both present, then the notice of entitlement requirements are met.

b. If a declaration under Rule 4.17(ii) nominating Australia is present, but a declaration under Rule 4.17(iii) is not present, then a statement of entitlement to claim priority is required.

For example, if there is a US basic and the applicant in the PCT application is not the inventor (i.e. it is a company that is the assignee of the basic applicant), the applicant will need to establish entitlement to claim priority. This can be done by a declaration under Rule 4.17(iii). If there is no declaration under Rule 4.17(iii), an objection should be taken that the applicant has not stated its entitlement to claim priority from the basic document.

The objection can simply state:

“There is no notice of entitlement to claim priority from the earlier application(s).”

See also PERP code [B5].

Name of Inventor(s)

If the name of the inventor(s) is not included in the PCT Request or another document on file, and a declaration under Rule 4.17(i) (relating to the identity of the inventor) has not been made, an objection should be raised that the entitlement of the applicant is not clear.

Copy of Declaration

It is not necessary for a copy of the declaration to be on the file and declarations will not routinely be placed on file. However, if circumstances arise where it is necessary to have a copy of the declaration, examiners should check whether the declaration is available from Patentscope. If the declaration is present, a copy should be downloaded and attached to the case file. If the declaration is not available, a copy may be ordered from the IB through COG.
Rule 92bis Changes

Where the applicant has made the necessary Rule 4.17 declarations and the person, name, residence, nationality or address of the applicant has changed during the international phase (under Rule 92bis), a new notice of entitlement is required, unless the change of name was supported by appropriate documentary evidence establishing the authority of the person making the request (noting sections 422 and 422bis of the PCT Administrative Instructions and paragraphs 310 and 311 of the PCT Receiving Office Guidelines). This practice is analogous to that outlined in 2.6.4 Changing the Applicant or Nominated Person.

2.20.4 Complete Specification in a Foreign Language

In this topic:

Overview

The Act specifies that the description, drawings, graphics, photographs and claims as contained in a PCT application (i.e. as originally filed and including any amendments under Article 19, Article 34 or Rule 91) shall be treated as the Australian complete specification.

Where the language of filing of a PCT application is other than English, a translation* must be filed for national phase entry. This translation becomes the Australian specification for examination purposes and will be either:

- a document supplied by the applicant (see 2.20.4.2 Translation Supplied by the Applicant); or

- a PCT pamphlet which is identified on its front page as an English translation (see 2.20.4.3 Translation Supplied by the International Bureau).

For information on Article 19, Article 34 and Rule 91 amendments and translations, see 2.20.10.5 Translation of Amendments.

Note: Where a translation of the PCT application is not supplied, COG will not allow the application to proceed to national phase. However, if such a case accidentally reaches examination, it is to be returned to COG.
2.20.4.2 Translation Supplied by the Applicant

*Note: For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be filed.

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**Section 102 Considerations**

Where the PCT application as originally filed is in a foreign language, the filing of a translation does not alter the status of the description, drawings, graphics, photographs and claims of the original non-English PCT application as being the Australian complete specification as filed, such as for the purposes of sec 102(1) (see also 2.23.8.2 Section 102(1) Examination Practice, Translations).

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**Micro-Organism Deposits**

In relation to a deposited micro-organism, an indication in accordance with Rule 13bis.4 forms part of the description, even though that indication may be furnished separately.

Modified Date: 25 September 2019

**2.20.4.2 Translation Supplied by the Applicant**

In this topic:

In the case of a translation supplied by the applicant, examiners are required to check that there are no obvious discrepancies (e.g. missing pages) in the translation, and that the translation is suitable for reproduction.

For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be filed. In this situation examiners are required to check the verification. A simple verification will be to the satisfaction of the Commissioner (see, for example, 2.20 Annex D - Verification of Translation). It is not necessary for the person...
making the “certificate of verification” to use the exact words as specified. In particular, it is not necessary that the word “verify” (or any of its derivatives) appears in the verification. Provided there is a signed/dated statement to the effect that the document is a translation, with it being readily inferable from the circumstances that the statement indicates that it is a true and complete translation, then the translation requirements are to be regarded as having been met.

Where a translation is provided, but there is no verification, an objection should be taken (see, for example, PERP code [K1]).

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**Incomplete Translation**

*Note:* The following information only applies to translations filed before or on 25 September 2019. For all other translations, see Incorrect Translation below.

Where the translation is incomplete, examiners must draw this to the attention of the applicant, since the translation is taken to be the Australian complete specification. Examination should otherwise proceed to the extent that the translation allows. Where the translation is so incomplete that examination cannot be undertaken (e.g. only an abstract or one page), the case file is to be referred to COG.

*Note:* Where a translation of Article 19 or Article 34 amendments has not been filed, see 2.20.10.5 Translation of Amendments.

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**Incorrect Translation**

*Note:* The following information only applies to translations filed after 25 September 2019. For all other translations, see Incomplete Translation above.

Where examiners have any doubts about the accuracy of the translation supplied by the applicant, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, then the applicant should be requested to file either:
2.20.4.2 Translation Supplied by the Applicant

- a corrected translation of the specification and a certificate of verification for the corrected translation; or
- a certificate of verification for the translation.

In this situation the period of time for acceptance may be extended by up to 2 months – see 2.15.7.3 Request for Corrected Translation or Certificate of Verification for the procedures to be followed.

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**Drawings, Graphics and Photographs**

The drawings, graphics and photographs forming part of the foreign language specification (usually the pamphlet) are the drawings, graphics and photographs of the Australian complete specification, unless replaced by drawings, graphics and photographs filed with the translation, and would not usually include foreign language text. However, where the drawings, graphics and photographs include foreign language text:

- in the case of translations filed before or on 25 September 2019, examiners should object and request a translated version.
- in the case of translations filed after 25 September 2019, examiners should follow the procedures outlined in Incorrect Translation above.

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**Abstract**

Although the translation of a PCT application may include a translation of the abstract, this is not part of the Australian complete specification and its inclusion should be disregarded for all purposes pertaining to the complete specification. An abstract in this respect is taken to be any passage in the translation having the heading "Abstract".

Modified Date: 25 September 2019
2.20.4.3 Translation Supplied by the International Bureau

Where the filing language of the international application is not one of the languages of publication under the PCT, the Receiving Office may forward an English translation of the international application to the International Bureau and this is published as the pamphlet rather than the original language version. These pamphlets are readily identified from their front page (see 2.20 Annex E – PCT Pamphlet Front Page, where the publication language [INID Code (26)] differs from the filing language [INID Code (25)]).

In the circumstances mentioned above the file will not include a copy of the foreign language specification and it is not necessary for it to do so.

Where the file contains both a translation in the form of a pamphlet and a translation supplied by the applicant, the examination report should be based on the pamphlet and the applicant informed of that fact.

For translations filed before or on 25 September 2019, there is the requirement that the translation be verified. In this situation, the pamphlet provided by the International Bureau is considered to be the verified translation of the PCT application. Although not accompanied by a declaration made by a translator, the translation was prepared by a PCT Authority and is accepted as verified to the satisfaction of the Commissioner.

Note: The languages of publication under the PCT are Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish.

Incorrect Translation

Note: The following information only applies to translations filed after 25 September 2019.

Where examiners have any doubts about the accuracy of the translation supplied by the International Bureau, they should follow the procedures outlined in 2.20.4.2 Translation Supplied by the Applicant, Incorrect Translation.

2.20.5 Priority Considerations
Note: The information in this part only applies to standard patent applications with an examination request filed before 15 April 2013. For all other standard patent applications, see 2.20.5.1A Priority Sources.

In this topic:

A national phase application may claim priority from:

- an earlier Australian application (provisional, complete or innovation);
- several earlier Australian applications;
- one or more foreign applications in a Convention country;
- an earlier international application;
- an earlier European application; or
- both an earlier Australian application and an earlier foreign application in accordance with Article 8 and Rule 4.10.

Under the PCT, the usual Convention priority rights are provided by Article 8(2)(a) and Rule 4.10. This covers priority applications actually filed in a proclaimed Convention country, as well as for such a country, i.e. a country designated in an international or EP application.

Article 8(2)(b) covers priority applications filed in or for Australia. This provides that Australia, in its own national law, shall set the conditions for and the effect of such priority claims.

For the purpose of determining a priority date for a national phase application which claims priority from an Australian provisional, complete or innovation application, this provisional, complete or innovation application is treated, under reg 3.12(2)(c), to be analogous to a basic document in a Convention application.

A national phase application, being a complete application under the Act, can claim priority from both an associated provisional, complete or innovation application, and from a basic application. The relevant priority date is determined in the same manner as for an application having a plurality of basic applications, or a plurality of provisional applications, i.e. in accordance with sec 43 and reg 3.12.

Note: In certain situations, a national phase application under examination may claim priority from a published document, such as a PCT application. That PCT application may in turn
have its own priority document, which may have been filed more than 12 months before the filing date of the application being examined. Where these circumstances arise, examiners should check the priority date of the claims (see also 2.12.1.1 Priority Date of Claims).

**Restoration of Priority**

Under reg 3.12(2)(c), a national phase application can claim priority from a basic application filed in Australia or in any Convention country **more than 12 months** before the international filing date of the PCT application, if priority has been restored by the receiving Office under Rule 26bis.3. This rule allows restoration where the loss of priority was either despite due care or unintentional. If examiners have reason to believe that the priority should not have been restored, they should discuss the case with Patent Oppositions to determine whether the restoration was ineffective.

**US Filed PCT Application**

Under USPTO procedures, it is permissible for a US filed PCT application to be a divisional or continuation of an earlier application and reference may be made to this under INID Code 60 on the front page of the pamphlet. This may be disregarded for the purposes of national phase examination in Australia.

**Note:** The information in this part only applies to standard patent applications with an examination request filed on or after 15 April 2013. For all other standard patent applications, see 2.20.5.1 Priority Sources.
A national phase application may claim priority from:

- an earlier Australian application (provisional, complete or innovation);
- several earlier Australian applications;
- one or more foreign applications in a Convention country;
- an earlier international application;
- an earlier European application; or
- both an earlier Australian application and an earlier foreign application in accordance with Article 8 and Rule 4.10.

Under the PCT, the usual Convention priority rights are provided by Article 8(2)(a) and Rule 4.10. This covers priority applications actually filed in a proclaimed Convention country, as well as for such a country, i.e. a country designated in an international or EP application.

Article 8(2)(b) covers priority applications filed in or for Australia. This provides that Australia, in its own national law, shall set the conditions for and the effect of such priority claims.

For the purpose of determining a priority date for a national phase application which claims priority from an Australian provisional, complete or innovation application, this provisional, complete or innovation application is treated, under reg 3.13A, to be analogous to a basic document in a Convention application.

A national phase application, being a complete application under the Act, can claim priority from both an associated provisional, complete or innovation application, and from a basic application. The relevant priority date is determined in the same manner as for an application having a plurality of basic applications, or a plurality of provisional applications, i.e. in accordance with sec 43 and reg 3.13A.

Priority is determined for PCT applications under reg 3.13A both where priority is claimed under Article 8 and where, in the national phase, the application is amended to claim priority from an earlier application, where that claim could have been made under Article 8. Thus, in both cases the conditions for claiming priority are derived directly from the Paris Convention under Article 8(2)(a).

Note: In certain situations, a national phase application under examination may claim priority from a published document, such as a PCT application. That PCT application may in turn have its own priority document, which may have been filed more than 12 months before the filing date of the application being examined. Where these circumstances arise, examiners should check the priority date of the claims (see also 2.12.1.1A Priority Date of Claims).
2.20.5.2 Obtaining and Considering Priority Documents

Restoration of Priority

Under reg 3.13A(2), a national phase application can claim priority from a basic application filed in Australia or in any Convention country more than 12 months before the international filing date of the PCT application, if priority has been restored by the receiving Office under Rule 26bis.3, by the Commissioner under Rule 49ter.2 or by the Commissioner granting an extension of time under sec 223 with the same effect. If examiners have reason to believe that the priority should not have been restored, they should discuss the case with Patent Oppositions to determine whether the restoration was ineffective.

US Filed PCT Application

Under USPTO procedures, it is permissible for a US filed PCT application to be a divisional or continuation of an earlier application and reference may be made to this under INID Code 60 on the front page of the pamphlet. This may be disregarded for the purposes of national phase examination in Australia.

A copy of a priority document is not required for national phase applications, except under the following circumstances:

a. where third parties request a copy of the document;

b. in examination or re-examination, where there is a citation published after the priority date and before the filing date, or a whole of contents citation with a priority date after the priority date and before the filing date, of the case being examined;

c. in examination or re-examination, where there is a whole of contents citation having a priority date before the priority date of the case being examined; or

d. in opposition, when requested by the opponent.
2.20.6 National Examination Where the ISR is Available

During examination, if either of circumstances b. and c. arises and examiners have reason to believe that the claims are not entitled to the claimed priority date, they should check whether the relevant priority document(s) is available from Patentscope or another database, e.g. USPTO Public PAIR, in order to verify the priority claim. If the document is present, a copy should be downloaded and added to the case file. Where the priority document is not available, examiners should contact ERA with a request to obtain the document from WIPO. The procedures to be followed are the same as those for obtaining basic specifications (see 2.21.3.8 Basic Specifications and in particular Obtaining Basic Specifications and Time Limits for Providing Basic Specifications).

2.20.7 National Examination Where the ISR is Missing

A PCT application may enter the national phase before the Office is in possession of the associated ISR (and therefore also the ISO/IPRP). Situations where this may occur are:

- where the applicant meets the requirements for national phase entry prior to international publication. In this case, the format of the documents will be different from the usual PCT application, as there will be no published pamphlet (and therefore no front page containing all the bibliographic details) and no ISR. Instead, the file will contain a copy of the international application including the original
2.20.8 Use of IPRP

A PCT application may contain:

- an ISO, if national phase entry occurs before the publication of the IPRPI at 30 months after the priority date;
- an IPRPI, provided IPE has not been demanded; or
- an IPRPII.

Note: In the situation where Australia was the ISA, the ISR and ISO, although not published, should be available on INTESS and examination should be carried out according to 2.20.6 National Examination Where the ISR is Available. However, as the ISR and ISO are not OPI:

- a copy of the ISR and ISO must not be added to the PAMS case file; and
- examiners must not refer to any reasoning in the ISO and instead draft their own objection or reproduce the text of the ISO in their report. The source of any citations should be identified as ‘Cited in the ISR’.

Modified Date: 01 February 2017

2.20.8 Use of IPRP

A PCT application may contain:

- an ISO, if national phase entry occurs before the publication of the IPRPI at 30 months after the priority date;
- an IPRPI, provided IPE has not been demanded; or
- an IPRPII.

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.20.8 Use of IPRP

If a national phase application contains an ISO or IPRPI, it may also contain comments from the applicant in relation to the ISO.

IPRPI/IPRPIIs are relevant to examination considerations and therefore these reports must be utilised as per the guidelines set down in 2.1.9 Guidelines for Using IPRPI/IPRPIIs and Other Foreign Examination Reports (FERs) in Examination. While IPRPI/IPRPIIs are advisory only and use some criteria that differ from certain requirements of the Act, e.g. multiply dependent claims, they are prepared using novelty and inventive step tests that are the same as, or more stringent than, the requirements of Australian law.

Where an IPRPI/IPRPII is missing from a case file, examiners should follow the procedures outlined in 2.20.10.1.2A Determining Whether Article 19 and Article 34 Amendments are Considered During Examination.

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**Translation of IPRPII**

The IPRPII will be translated into English by the International Bureau if it is not already in English (as per Article 36 and Rule 44bis.3 and Rule 72). Any annex (i.e. the Article 34 amendments) will be in the language of publication of the pamphlet, i.e. in the original language. Where there is no translation of the IPRPI on file examiners should check Patentscope. If the translation is available, a copy should be downloaded and added to the case file.

Where the amendments are not in English, it is the responsibility of the applicant to supply a translation within the time limit for entry into national phase as per Article 36(2) and Rule 74 (see also 2.20.10.5 Translation of Amendments).

**Note:** Although the IPRPII is advisory, its annexes/replacement sheets (resulting from amendments made under Article 34) usually form part of the national phase application; see 2.20.10 Amendments and Corrections Prior to Examination.

**Note:** A PCT application filed before 1 January 2004, and which has entered the national phase, may contain an IPER if Australia is elected. Examiners are unlikely to encounter national phase applications containing an IPER. Nevertheless, the examination considerations discussed in this chapter for IPRPI/IPRPIIs apply equally to IPERs.

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Modified Date: 25 September 2019
2.20.9 According International Filing Dates and Article 25 Applications

Where an international application designating Australia is accorded an international filing date, a PCT application will result. Where an international filing date is not accorded by the receiving Office, the application is taken to be withdrawn. However, such an application may still be considered to be a PCT application in spite of this by virtue of sec 10.

A variety of defects may result in an application not being accorded an international filing date by the receiving Office, such as Article 11 defects and/or Article 14 defects.

The International Bureau (IB) will consider the international application to be withdrawn under Article 12(3) if a record copy (i.e. a true copy) of the international application has not been received by the IB within the prescribed time limit. However, the application will nevertheless have an international filing date accorded by the receiving Office (provided it fulfilled the requirements of Article 11(1)(i) to (iii)).

Upon receipt of a declaration from the receiving Office of non-accordance of a filing date, or a notification from the IB that the international application is considered withdrawn under Article 12(3), applicants may request the IB to send copies of any document on file to any of the designated Offices that they name by virtue of Article 25(1)(a).

Where Australia is one of the named designated Offices, COG will create an Ecase file for the documents provided by the IB, allocate a 10 figure Australian application number and ask the relevant Assistant General Manager to review the case.

Where:

- a refusal to accord an international filing date by the receiving Office; or
- a declaration that the international application is withdrawn by the receiving Office; or
- a finding by the IB leading to the international application being withdrawn;

was a result of an error or omission on the part of the receiving Office or IB, Article 25(2)(a) directs the designated Offices to treat the international application as if such an error or omission had not occurred.

The provisions of the Regulations enable Australia, as a designated Office, to decide on the matter of error or omission on the part of the receiving Office or IB. Accordingly, if the Assistant General Manager finds that such an error or omission:

**Has Occurred**

- Provided the prescribed fees have been paid and a verified translation (if required) has been filed, the Assistant General Manager will direct that the application be treated as a PCT application.
The format of the documents will be different from the usual PCT application, as there will be no published pamphlet (and therefore no front page containing all the bibliographic details) and no ISR. Instead, the file will contain a copy of the international application including the original request form, together with a translation if required. Examination should be carried out in accordance with the procedures outlined in 2.20.7 National Examination Where the ISR is Missing (however see also 2.20.1.3 National Phase Preliminaries).

In the situation where the receiving Office did not accord an international filing date, the application will be given the international filing date it should have been given under the PCT by virtue of sec 10 (see also Article 11).

The application will become OPI.

Has Not Occurred

COG will ask the applicant whether the application is to proceed as an ordinary national application, in which case:

- The benefit of an international filing date will not be accorded the application.
- The filing date is the date of receipt in Australia of the documents provided under Article 25(1)(a).
- The application will follow the usual national application procedures, i.e. all filing, indexing and examination requirements apply.
- Time constraints will almost certainly preclude the issue of any direction to the applicant to take any necessary action to ensure the application complies with requirements prescribed by the Regulations.

- The application will become OPI.

A national phase application may contain amendments already made in the international phase under Article 19, Article 34, Rule 91 or Rule 92bis. There may also be amendments made, or proposed, in the national phase under sec 104 prior to examination.
It is essential at the outset of national phase examination to correctly identify the documents upon which examination is to be based.

In general, examination must proceed on the basis of amendments already made, whether or not incorporated into the complete specification on file. However, examiners should note that where a translation of a PCT application becomes the complete specification, special considerations apply (see 2.20.4 Complete Specification in a Foreign Language and 2.20.10.5 Translation of Amendments).

2.20.10.1 Determining Whether Amendments Made Under Articles and Rules of the PCT are Considered During Examination

Modified Date: 01 February 2017

2.20.10.1.1 General Provisions

Note: The information in this part only applies to PCT applications filed before 15 April 2013. For all other PCT applications, see 2.20.10.1.1A General Provisions.

In general, amendments made under Article 19, Article 34 or Rule 91 are deemed to amend the Australian specification at the date of filing of the amendments (sec 89(5) and reg 8.1).

Special Considerations for Article 34 Amendments

For applications which enter the national phase from 23 December 2004, amendments made under Article 34 are deemed to amend the Australian specification at the date of filing of the amendments, provided that the IPER/IPRPII is established before national phase entry (sec 89(6)). However, this provision does not apply if a report is issued under sec 45(1AA) or sec 45(1AB), and the applicant advises that:

- no demand was made under Article 31 of the PCT; or
- no amendments were made under Article 34 of the PCT; or
- the demand was made under Article 31 of the PCT, or the international preliminary examination report was established, after the application entered the national phase;
or if the applicant elects to abandon any amendments that may have been made under Article 34 of the PCT.

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**Translations**

A translation filed by virtue of sec 89(3) amends the PCT application as of the day on which it was filed (sec 89(4)). Further information on Article 19 and Article 34 amendments and translations is provided in 2.20.10.5 Translation of Amendments.

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**Special Considerations for Article 34 Amendments**

Amendments made under Article 34 are deemed to amend the Australian specification at the date of filing of the amendments, provided that the IPRPII is established before national phase entry (reg 3.5AC(5)). However, an exception is where the circumstances of reg 3.5AC(6) apply and the applicant advises that:

- no demand was made under Article 31 of the PCT; or
- no amendments were made under Article 34 of the PCT; or
- the demand was made under Article 31 of the PCT, or the international preliminary examination report was established, after the application entered the national phase;
or if the applicant elects to abandon any amendments that may have been made under Article 34 of the PCT.

## Translations

A translation amends the PCT application as of the day on which it was filed (reg 3.5AC(2)). Further information on Article 19 and Article 34 amendments and translations is provided in 2.20.10.5 Translation of Amendments.

**Note:** The information in this part only applies to PCT applications filed before 15 April 2013. For all other PCT applications, see 2.20.10.1.2A Determining Whether Article 19 and Article 34 Amendments are Considered During Examination.

In this topic:

This section outlines the procedure for retrieving the IPRPII (to determine whether Article 34 amendments exist) and then the steps examiners should follow to determine whether Article 19 amendments and Article 34 amendments are to be considered during examination (including expedited examination and examination of voluntary sec 104 amendments before acceptance).

### Retrieval of IPRPII
2.20.10.1.2 Determining Whether Article 19 and Article 34 Amendments are Considered During Examination

**Note:** If there is no indication that a demand was filed before the national phase entry date, examination can proceed without further consideration of whether there are any Article 34 amendments. However, examiners should still consider whether there are Article 19 amendments (see 2.20.10.3 Article 19 Amendments).

In certain circumstances where there is no IPRPII on file, ERA will issue a notice requesting that an applicant provide a copy of the document (reg 8.3). In response, the applicant may:

- provide a copy of the IPRPII; or
- advise that:
  - no demand for international preliminary examination was filed; or
  - no Article 34 amendments were made; or
  - the demand for international preliminary examination was filed, or the IPRPII was established, after national phase entry; or
- elect to abandon any Article 34 amendments.

**Note:** Where situation a. applies, there are no Article 34 amendments to consider. Where situation c. applies, any Article 34 amendments will not form part of the specification, unless pursued under sec 104.

Where the applicant fails to comply with the request within 6 months, ERA will forward the case to the relevant examination section for processing. In this situation, examiners should proceed as indicated in Step 2 below.

Where a notice does not appear to have been issued and there is no IPRPI/IPRPII on file, and the document is not available on Patentscope (or INTESS, if IP Australia was the IPEA), and a demand has been filed before national phase entry, then examiners should keep the Exam Request task and email ERA requesting them to issue a notice as above. Examination should not proceed until the applicant has replied or 6 months from the date of issue of the notice has expired.

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**Determining Whether Article 19 and/or Article 34 Amendments are to be Considered During Examination**

The following procedure should be used to determine whether Article 19 and/or Article 34 amendments are to be considered during examination.
1. Are there Article 19 amendments?
   - No – Go to Step 2 (see also note below).
   - Yes – Determine whether the amendments form part of the specification. See 2.20.10.3 Article 19 Amendments.

   If the amendments do not form part of the specification, then they are excluded from examination. Go to Step 2.

   **Note:** If examiners have reason to believe that there are Article 19 amendments (for example, as indicated on the front page of the PCT pamphlet) and these are not on file, they should first check Patentscope. (Article 19 amendments are filed directly with WIPO and therefore will not be available on INTESS). If the amendments are available, a copy should be downloaded and attached to the case file. If the amendments are not available, examiners should contact ERA and request that a copy be obtained from WIPO. Examination should not proceed until the amendments have been received.

2. Is there an IPRPI or IPRPII on the PAMS case file?
   2a. Yes
      - For an IPRPI there are no Article 34 amendments to consider, proceed with examination.
      - If an IPRPII has been established and there are no Article 34 amendments, proceed with examination (see also note below).
      - If an IPRPII has been established and there are Article 34 amendments, go to Step 3.
   2b. No
      - If there is no IPRPI/IPRPII on the PAMS case file and the applicant has indicated that there are no Article 34 amendments to consider (see 'Retrieval of IPRPII' above), proceed with examination.
      - If there is no IPRPI/IPRPII on the PAMS case file and the applicant has not complied with the request issued by ERA, examiners should first check Patentscope. If the IPRPI/IPRPII is available a copy should be downloaded and attached to the case file. Proceed as in Step 2a above.
      - If the IPRPI/IPRPII is not available from Patentscope, check the IASR on Patentscope to determine whether an IPRPII and Article 34 amendments exist. Where an IPRPII and Article 34 amendments exist and IP Australia was the IPEA, the amendments should be copied from INTESS to the PAMS case
2.20.10.1.2 Determining Whether Article 19 and Article 34 Amendments are Considered During Examination

If an IPRPII and Article 34 amendments exist, but they are not available from either Patentscope or INTESS:

- If a Chapter II demand was filed before the National Phase Entry (NPE) date:
  - **Non-expedited Examination, Expedited Examination, Voluntary Sec 104 Amendment Before Acceptance** – issue a report indicating that the IPRPII is missing by selecting this option at the ‘Specification Examined?’ prompt in the Intelledox (DocGen) ‘Basis of the Report’ template.
  - Intelledox will include an appropriate introductory paragraph in the report.

- If there is no indication that a demand was filed before the NPE date, proceed with examination.

**Note:** If examiners have reason to believe that there are Article 34 amendments (for example, as indicated in Box I of the IPRPII) and these are not on file, they should check Patentscope or, if IP Australia was the IPEA, they should also check INTESS. If the amendments are available from either of these sources, then a copy should be attached to the PAMS case file; proceed to Step 3. If the amendments are not available from either of these sources, examiners should contact ERA and request that a copy be obtained from WIPO. Examination should not proceed until the amendments have been received.

3. Was the demand filed before the National Phase Entry (NPE) Date?
   - **Yes** – Go to Step 4.
   - **No** – Examine excluding Article 34 amendments (see also note below).

4. Was the IPRPII established before the NPE date?
   - **Yes** – Examine including Article 34 amendments.
   - **No** – Examine excluding Article 34 amendments (see also note below).

**Note:** Where Article 34 amendments do not form part of the specification and examiners consider their incorporation was intended and will facilitate examination, they may phone the attorney to discuss options for inclusion of the amendments.

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This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
Determination of Dates

To determine the date of:

- **National Phase Entry** – see the ‘Nat. Phase’ Date on the Ecase Summary screen in PAMS.
- **Filing of the demand** – see either the ‘Date of submission of the demand’ on the front page of the IPRPII or section 2.20.10.1.3 The IASR.
- **IPRPII establishment** – see ‘Date of completion of this report’ on the front page of the IPRPII.

In this topic:

This section outlines the procedure for retrieving the IPRPII (to determine whether Article 34 amendments exist) and then the steps examiners should follow to determine whether Article 19 and Article 34 amendments are to be considered during examination (including expedited examination and examination of voluntary sec 104 amendments before acceptance).

Retrieval of IPRPII

**Note:** If there is no indication that a demand was filed before the national phase entry date, examination can proceed without further consideration of whether there are any Article 34 amendments. However, examiners should still consider whether there are Article 19 amendments (see section 2.20.10.3 Article 19 Amendments).
In certain circumstances where there is no IPRPII on file, ERA will issue a notice requesting that an applicant provide a copy of the document (sec 45(1A) and reg 3.17B). In response, the applicant may:

- provide a copy of the IPRPII; or
- advise that:
  - no demand for international preliminary examination was filed; or
  - no Article 34 amendments were made; or
  - the demand for international preliminary examination was filed, or the IPRPII was established, after national phase entry; or
- elect to abandon any Article 34 amendments.

**Note:** Where situation a. applies, there are no Article 34 amendments to consider. Where situation c. applies, any Article 34 amendments will not form part of the specification, unless pursued under sec 104.

Where the applicant fails to comply with the request, ERA will refer the matter to Patent Oppositions.

Where a notice does not appear to have been issued and there is no IPRPI/IPRPII on file, and the document is not available on Patentscope (or INTESS, if IP Australia was the IPEA), and a demand has been filed before national phase entry, then examiners should keep the Exam Request task and email ERA requesting them to issue a notice as above. Examination should not proceed until the applicant has replied or the matter considered by Patent Oppositions.
2.20.10.1.2A Determining Whether Article 19 and Article 34 Amendments are Considered During Examination

If the amendments do not form part of the specification, then they are excluded from examination. Go to Step 2.

**Note:** If examiners have reason to believe that there are Article 19 amendments (for example, as indicated on the front page of the PCT pamphlet) and these are not on file, they should first check Patentscope. (Article 19 amendments are filed directly with WIPO and therefore will not be available on INTESS). If the amendments are available, a copy should be downloaded and attached to the case file. If the amendments are not available, examiners should contact ERA and request that a copy be obtained from WIPO. Examination should not proceed until the amendments have been received.

2. Is there an IPRPI or IPRPII on the PAMS case file?

2a. **Yes**

- For an IPRPI there are no Article 34 amendments to consider, proceed with examination.
- If an IPRPII has been established and there are no Article 34 amendments, proceed with examination (see also note below).
- If an IPRPII has been established and there are Article 34 amendments, go to Step 3.

2b **No**

- If there is no IPRPI/IPRPII on the PAMS case file and the applicant has indicated that there are no Article 34 amendments to consider (see Retrieval of IPRPII above), proceed with examination.

**Note:** If examiners have reason to believe that there are Article 34 amendments (for example, as indicated in Box I of the IPRPII) and these are not on file, they should check Patentscope or, if IP Australia was the IPEA, they should also check INTESS. If the amendments are available from either of these sources, then a copy should be attached to the PAMS case file; proceed to Step 3. If the amendments are not available from either of these sources, examiners should contact ERA and request that a copy be obtained from WIPO. Examination should not proceed until the amendments have been received.

3. Was the demand filed before the National Phase Entry (NPE) Date?

- **Yes** – Go to Step 4.
- **No** – Examine excluding Article 34 amendments (see also note below).

4. Was the IPRPII established before the NPE date?

- **Yes** – Examine including Article 34 amendments.
2.20.10.1.3 The IASR

- **No** – Examine **excluding** Article 34 amendments (see also note below).

**Note:** Where Article 34 amendments do not form part of the specification and examiners consider their incorporation was intended and will facilitate examination, they may phone the attorney to discuss options for inclusion of the amendments.

---

**Determination of Dates**

To determine the date of:

- **National Phase Entry** – see the ‘Nat. Phase’ Date on the Ecase Summary screen in PAMS.

- **Filing of the demand** – see either the ‘Date of submission of the demand’ on the front page of the IPRPII or 2.20.10.1.3 The IASR.

- **IPRPII establishment** – see ‘Date of completion of this report’ on the front page of the IPRPII.

---

Modified Date: 01 February 2017

**2.20.10.1.3 The IASR**

The International Application Status Report (IASR) provides certain information and bibliographic data regarding an international application. In particular, it may be used to determine the date of filing of a demand for international preliminary examination (Chapter II demand).

The IASR is available from Patentscope. Where a demand has been filed, this is indicated under the “International Report on Patentability” heading as shown below.

**International Report on Patentability (IPRP) Chapter II of the PCT:**

Chapter II demand received: 10 July 2013 (10.07.2013)

**Note:** The IASR replaced the International Application Status Form (IASF) as of 27 April 2009.
2.20.10.1.4 The IASF

**Note:** WIPO generates an IASR based on the information it receives and in the vast majority of cases this information is accurate. However, the accuracy of the information provided in an IASR could be affected by unusual events, for example where WIPO was not sent relevant information. In general, examiners should rely upon the information provided in an IASR, unless they have good reason not to.

Modified Date: 01 February 2017

### 2.20.10.1.4 The IASF

**Note:** The IASF was replaced by the International Application Status Report (IASR) as of 27 April 2009; see 2.20.10.1.3 The IASR for further information.

The International Application Status Form (IASF) provides certain information regarding an international application. In particular, it may be used to determine the date of filing of a demand for international preliminary examination (Chapter II demand).

An IASF will be provided in either XML or PDF format.

---

**XML Format**

The demand information, where provided, is always just above the invention title.
Where no demand is filed, this information is absent from the IASF.

PDF Format

The demand information is provided in Box VII-1. Where a demand is filed, the box will indicate “Yes” and the date of filing of the demand. Where no demand is filed, the box will indicate “No”.

<table>
<thead>
<tr>
<th>VII</th>
<th>INTERNATIONAL PRELIMINARY EXAMINATION</th>
</tr>
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<td>VII-1</td>
<td>A demand electing the State(s) for which the Office acts as an elected Office has been received by the International Preliminary Examination Authority (where the elected Office is a regional Office, indication of the State(s) elected in respect of which the Office acts as an elected Office):</td>
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**Note:** WIPO generates an IASF based on the information it receives and in the vast majority of cases this information is accurate. However, the accuracy of the information provided in an IASF could be affected by unusual events, for example where WIPO was not sent relevant information. In general, examiners should rely upon the information provided in an IASF, unless they have good reason not to.
Where Article 19, Article 34 or Rule 91 amendments have been made, unusual formality situations may arise. For example:

- amended claims may have an unusual numbering arrangement - see 2.20 Annex F – Amended Claims Format where claims 3-6 are cancelled (Example 1) and where claim 25 is the first claim (Example 2).

- the amendments may result in non-sequential page numbering.

Such numbering is an allowable formality under the PCT and does not give rise to an objection during national examination. However, the applicant may voluntarily renumber the claims and/or pages by amendment under sec 104 as outlined below.

---

**Article 19 Amendments**

Where the pamphlet includes both the original claims and the claims as amended under Article 19, examiners should not object to the presence of the original claims. Instead, a statement is to be included in the ‘Additional Comments’ section of the report as follows:

'I have examined this application on the basis of the claims as amended under Article 19. You may wish to correct the non-sequential page/claim numbering caused by the Article 19 amendments.'

This text will be automatically included in the report in DocGen (by responding ‘Yes’ to the question ‘Do any Article 19 amendments result in non-sequential page/claim numbering?’).

---

**Article 34 Amendments**

Where Article 34 amendments result in non-sequential page or claim numbering, examiners should not object, but instead include a statement in the ‘Additional Comments’ section of the report as follows:

‘I have examined this application on the basis of the specification as amended under Article 34. You may wish to correct the non-sequential page/claim numbering caused by the Article 34 amendments.’
2.20.10.3 Article 19 Amendments

Under Article 19, the applicant is entitled to amend the claims of the international application after receiving the ISR and ISO. The applicant may also file a brief statement explaining the amendments.

Article 19 amendments are always published as part of the pamphlet by the International Bureau (albeit sometimes as a republished pamphlet, together with the original claims. In this case, it is the republished pamphlet that becomes the specification). If the source of the Article 19 amendments is unknown, or the amendments are attached to other correspondence or filed separately, then there is a *prima facie* assumption that they are not bona fide amendments. In this situation, examiners should confirm the existence of the Article 19 amendments by checking Patentscope. (Amendments present on Patentscope are accepted as being the "official" amendments). If there are no Article 19 amendments present, then the amendments obtained from the unknown source (or attached to other correspondence or filed separately) do not form part of the specification and should be disregarded.

**Note:** If examiners have reason to believe that there are Article 19 amendments (for example, as indicated on the front page of the PCT pamphlet) and these are not on file, they should first check Patentscope. If the amendments are available, a copy should be downloaded and attached to the case file. If the amendments are not available, examiners should contact ERA and request that a copy be obtained from WIPO. Examination should not proceed until the amendments have been received.

**Note:** Where the National Phase Entry (NPE) date is after 23 December 2004, and the Article 19 amendments are made after NPE, then the amendments do not form part of the specification.

Modified Date: 01 February 2017

### 2.20.10.3 Article 19 Amendments

This text will be automatically included in the report in DocGen (by responding ‘Yes’ to the question ‘Do any Article 34 amendments result in non-sequential page/claim numbering?’).

---

Modified Date: 25 February 2019

### 2.20.10.4 Article 34 Amendments

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
Under Article 34, the applicant is entitled to amend the claims, description and drawings during the IPE process. The amendments must be made before the IPRPII is established and will have effect in Australia provided the circumstances set out in 2.20.10.1A General Provisions are met. Article 34 amendments supersede any Article 19 amendments where they amend the same page.

Article 34 amendments will always be included in the IPRPII. If the source of the Article 34 amendments is unknown, or the amendments are attached to other correspondence or filed separately, then there is a prima facie assumption that they are not bona fide amendments. In this case, examiners should confirm the existence of the Article 34 amendments by checking Patentscope. (An IPRPII and any associated Article 34 amendments present on Patentscope are accepted as being the "official" IPRPII/amendments). If there are no Article 34 amendments present, then the amendments obtained from the unknown source (or attached to other correspondence or filed separately) do not form part of the specification and should be disregarded. (Note, however, that any IPRPII and associated Article 34 amendments provided by the applicant should be accepted as being the "official" IPRPII/amendments).

**Note:** If examiners have reason to believe that there are Article 34 amendments (for example, as indicated in Box I of the IPRPII) and these are not on file, they should first check Patentscope. If the amendments are available, a copy should be downloaded and attached to the case file. If the amendments are not available, examiners should contact COG and request that a copy be obtained from WIPO. Examination should not proceed until the amendments have been received.

**Note:** If the Australian Patent Office is the IPEA and the IPRPII is missing, it may be accessed from the PCT file held by the Office or from INTESS. Paper files may be requested from Registry Manager via email.

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**IPE Proceeding in Parallel With National Examination**

In the situation where Australia is the IPEA and international preliminary examination is proceeding in parallel with national examination, the only amendments relevant to national examination are the sec 104 amendments. To the extent that there are any differences between Australian law and the PCT, those differences will need to be reflected in the content of the reports issued under the respective procedures.
In this topic:

Overview

For a national phase application of a PCT application that was filed in a foreign language, the translation becomes the Australian specification from the date on which the translation was filed. Amendments made under Article 19, Article 34 or Rule 91 can amend the contents of the translation in certain circumstances. Thus:

- The translation supersedes any previous amendments made under Article 19, Article 34 or Rule 91, whether included in the translation or not.
- Article 19, Article 34 and Rule 91 amendments made after national phase entry do not form part of the translation, unless pursued under sec 104.
- Article 34 amendments are only effective if the IPRPII was established before national phase entry, regardless of when the amendments were filed (see also 2.20.10.1.2 Determining Whether Article 19 and Article 34 Amendments are Considered During Examination).
- In the rare circumstance that the translation is filed before the other requirements for national phase entry are met, any Article 19, Article 34 or Rule 91 amendments made between the date of filing the translation and national phase entry will amend the contents of the translation.

Note: Where the description and/or claims were amended under Article 19, Article 34 or Rule 91 and a translation thereof has been filed, a translation of the original description and/or claims is not required.

Note: For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be filed. See also PERP code [K1].

Examination Practice
Any Article 19, Article 34 or Rule 91 amendments that have already been made should be present in the text of the translation when it is filed. It is permissible to file the translation of the amendments as a separate document, for example one having its own verification, provided the translations are filed conjointly.

**Translation of Amendments Not Filed**

If the amendments are not included in the translation, there is no bar to national phase entry and no objection arises. However, as the amendments are not part of the translation, they do not form part of the national phase specification. If the amendments only exist in a foreign language upon filing of the translation, or a translation of the amendments has been provided but has not been incorporated in, or filed conjointly with, the translation of the application, the amendments are non-binding and are considered to be of no effect.

Consequently, after entry into the national phase, any subsequent filing of translations of Article 19, Article 34 or Rule 91 amendments will not automatically alter the text of the translation. In order for those amendments to be included in the text of the translation, a proposed amendment to that effect will need to be made under sec 104.

When amendments are not part of the translation and thereby not part of the national phase specification, examiners are to include a note in their report as shown in PERP code [K10].

**Note:** Where Article 19, Article 34 or Rule 91 amendments do not form part of the specification and examiners consider their incorporation was intended and will facilitate examination, they may phone the attorney to discuss options for inclusion of the amendments.

**Incorrect Translation**

**Note:** The following information only applies to translations filed after 25 September 2019.

Where examiners have any doubts about the accuracy of the translation of Article 19, Article 34 or Rule 91 amendments, they should follow the procedures outlined in 2.20.4.2 Translation Supplied by the Applicant, Incorrect Translation.

Modified Date: 01 February 2017
2.20.10.6 Amendments Resulting in a Claim to New Matter

The PCT provides that the amendments made under Article 19, Article 34 and Rule 91 shall not go beyond the disclosure of the international application as filed. Where it is subsequently found that a claim of a national phase application is based on matter first introduced by an Article 19, Article 34 or Rule 91 amendment, its priority date is determined to be the date that the amendment was made (sec 114 and reg 3.14).

Where a translation includes matter that was not disclosed in the specification as filed, the priority date of claim(s) to that matter is the date on which the translation was filed. However, examiners should normally assume that the translation does not introduce new matter, unless they have evidence to the contrary.

Examination Practice

Amendments filed during the international phase are deemed to amend the specification on the date those amendments were made. Thus, amendments of this type must be treated as having been already incorporated into the specification when national examination commences. Therefore, examiners are not permitted to object to the allowability of such amendments under sec 102 during examination, even if those amendments have resulted in claims which go beyond the disclosure of the international application as filed.

Note: Although an objection cannot be taken to the allowability of amendments to the claims, in certain circumstances a proposed amendment to insert the new matter into the description will not be allowable under sec 102 (see 2.23.8.2A Section 102(1) Examination Practice and in particular ‘Matter From Article 34 Amendments’).

Amendments which go beyond the original disclosure must be taken into account for the purposes of national examination. This is despite the fact that such amendments are excluded from IPE. (Where amendments are considered to go beyond the original disclosure at the establishment of the IPRPII, this will be identified at item 4 of Box I and/or the supplemental sheet(s) of that report).

Examiners should note that if new matter is claimed, the international search may be inadequate, in which case an additional search in respect of the new matter is required (see 4.1.3.3 Additional Searching).
2.20.10.7 Rule 91 Amendments

Rectifications of obvious errors authorised by the receiving Office, ISA or International Bureau in accordance with Rule 91 will be incorporated into the published pamphlet, are recognised under the Act and require no further consideration.

Rectifications of obvious errors authorised by the IPEA in accordance with Rule 91 will appear as rectified sheets annexed to the IPRPII and are recognised under the Act as part of the complete specification.

**Note:** A PCT pamphlet may be published with “A request for rectification under Rule 91.3(d)” and the request may include replacement sheets of the application. However, the PCT application has **not** been rectified by these sheets and therefore the sheets **do not** form part of the application for the purposes of examination. The applicant should be informed accordingly by the inclusion of a note in the examination report. In these circumstances, it may be possible for the applicant to pursue the request for rectification under the provisions of sec 104.

2.20.10.8 Rule 92bis Amendments

**Rule 92bis** allows for the recording of changes in the person, name, residence, nationality or address of the applicant during the international phase. Similarly, changes to the person, name or address of the agent may also be recorded. The International Bureau will provide notification of such changes and, where possible, the changes will be reflected in the front page of the pamphlet.

All such notifications are effective in the national phase, including applicant name or person changes. **Rule 92bis** changes are usually processed by ERA. However, prior to acceptance, examiners should check the file for any unrecorded **Rule 92bis** amendment and contact ERA if appropriate.

2.20.10.9 Corrected Versions of Pamphlet and IPRPII
In this topic:

**Pamphlet**

On rare occasions, the International Bureau (IB) will publish a corrected version of a pamphlet after it has entered the national phase. When this occurs, the pamphlet as published (or republished) at the time of national phase entry is the specification for the purposes of examination. Any subsequent republication of the pamphlet is to be ignored for the purpose of determining the specification in the national phase. However, such a republication will become relevant when considering the allowability of any amendments under sec 102(1).

As PAMS downloads the version(s) of the pamphlet available in IP Australia at national phase entry, there is a slight possibility that national phase entry will occur between republication by the IB and IP Australia receiving the corrected pamphlet (there is a 7-10 day delay in the receiving the new publication from the IB). For examination purposes it should be assumed that this has not occurred, unless examiners are aware of information to the contrary (such as by being informed by the applicant or when looking up other information on Patentscope). Where this circumstance arises, the matter should be referred to Business Process Improvement for attention.

**IPRPII**

A corrected version of an IPRPII may also be issued. If there are amendments referred to in the corrected version of the IPRPII which are dated later than those referred to in the original IPRPII, then the establishment date of the IPRPII must change. Otherwise, the later version of the IPRPII may be treated as a mere 'correction' and not a re-established IPRPII.
Amendments requested during examination of a national phase application must be made under sec 104 (see 2.23.2. General Provisions – Section 104 Amendments).

However, where amendments under sec 104 would result in the claiming of matter not in substance disclosed in the specification as filed, solely as a result of those amendments (as per sec 102(1)), then examiners should object accordingly (see also 2.23.8.1 The Section 102(1) Provisions Explained, Meaning of “as a result of the amendment”).

Where the specification is a translation, applicants may wish to amend the specification during examination to claim apparently new matter which is allegedly disclosed in the foreign language specification as filed. In this situation, applicants must establish that the text of the foreign language specification is what they allege it to be (as distinct from what is present in the translation filed to enter the national phase). In order to meet this requirement, applicants will normally need to supply a new verified translation of the foreign language specification. In some circumstances, this translation may only be of the relevant part of the specification. An amendment to the claims should only be allowed if examiners are satisfied that the matter was in substance disclosed in the foreign language specification.
2.23.8.1A The Section 102(1) Provisions Explained, Meaning of “as a result of the amendment”).

Where the specification is a translation, applicants may wish to amend the specification during examination to claim apparently new matter which is allegedly disclosed in the foreign language specification as filed. In this situation, applicants must establish that the text of the foreign language specification is what they allege it to be (as distinct from what is present in the translation filed to enter the national phase). In order to meet this requirement, applicants will normally need to supply a new translation of the foreign language specification as indicated below. In some circumstances, this translation may only be of the relevant part of the specification. An amendment to the claims should only be allowed if examiners are satisfied that the matter does not extend beyond that disclosed in the foreign language specification as filed (taken together with any other prescribed documents).

**New Translation Filed Before or On 25 September 2019**

A certificate of verification for the new translation must be provided.

**New Translation Filed After 25 September 2019**

Where applicants become aware of an error or omission in the translation of the specification, they may file a corrected translation under the provisions of reg 3.5AC and reg 3.5AF.

**Modified Date: 25 February 2019**

**2.20.12 Chapter 15 Applications (Sections 147 to 153)**

In certain circumstances, an application which involves ‘associated technology’ (e.g. nuclear weapons) can be restored (sec 150) or reinstated (sec 151(1), sec 151(2) and sec 151(3)) as an international application. Such a restored or reinstated international application will then follow the normal national phase procedures.

Within the context above, a situation may arise wherein an international application (which designated Australia) cannot be reinstated as an international application merely because, under the PCT, it was considered withdrawn. However, if the applicant files a request that the application be treated as a standard patent application, together with any prescribed
documents and prescribed fees, then the application must be treated as so requested (sec 151(4)).

The prescribed documents include a patent request, the complete specification and an abstract (reg 15.2(2)). The description, claims, drawings, graphics and photographs contained in the international application and filed in the Office are treated as the complete specification for the standard patent application in accordance with sec 151(4)(f). The filing date accorded to the application and complete specification is the date on which the relevant international application was filed (sec 151(4)(g)). Any specification (or other document) subsequently filed (e.g. with the sec 151(4)(c) request) is to be regarded as an amendment in anticipation.

Annexes

Modified Date: 01 February 2017

Annex A - Examination of National Phase Applications: Indicators of Special or Different Considerations

| Formalities                                  | 2.20.1.4 Formality Requirements  
|                                             | 2.20.1.4A Formalities Check       |
| Patent Request                               | 2.20.3.1 Patent Request Form      |
| Notice of Entitlement                        | 2.20.3.2 Entitlement              |
| Specification                                | 2.20.1.3 National Phase Preliminaries  
|                                             | 2.20.7 National Examination Where the ISR is Missing  |
### Annex A - Examination of National Phase Applications: Indicators of Special or Different Considerations

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<thead>
<tr>
<th>Pamphlet in a foreign language.</th>
<th>2.20.4 Complete Specification in a Foreign Language</th>
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| Article 19 and/or Article 34 amendments | 2.20.10.1.1 General Provisions  
2.20.10.2 Formality Considerations  
2.20.10.3 Article 19 Amendments  
2.20.10.4 Article 34 Amendments  
2.20.10.5 Translation of Amendments  
2.20.10.6 Amendments Resulting in a Claim to New Matter |
| Search Strategy |  |
| ISR available | 2.20.6 National Examination Where an ISR is Available |
| ISR not available | 2.20.7 National Examination Where the ISR is Missing |
| Examination |  |
| IPE report available | 2.20.8 Use of IPRP |
| Priority Documents |  |
| Where required | 2.20.5.2 Obtaining and Considering Priority Documents |
| Amendments |  |
| Article 19, Article 34, Rule 91, Rule 92 | 2.20.10 Amendments and Corrections Prior to Examination |
| Section 104 | 2.20.11 Amendments During Examination |

Modified Date: 01 September 2011
Annex B - Applicant and Inventor Details as Shown on PCT Pamphlet Front Page

EXAMPLES 1 & 2

(21) Int. Application Number: PCT/GB98/00021
(22) Int. Filing Date: 14 January 1998 (14.01.98)
(31) Priority Application Number: GB9700849
(32) Priority Date: 15 January 1997 (15.01.97)
(33) Priority Country: GB
(71)(72) Applicant and Inventor: Binstead, Ronald Peter [GB/GB]; 15 Seely Road, Radford, Nottingham NG7 1NU (GB).
(74) Agent: GOODMAN, Christopher; Eric Potter & Clarkson, 14 Oxford Street, Nottingham NG1 3BP (GB).
(81) Designated States: AT (European patent), AU, BE (European patent), CH (European patent), DE (European patent), FR (European patent), GB, GB (European patent), IT (European patent), JP, LU (European patent), NL (European patent), SE (European patent), US.

APPLICANT.

Binstead, R.P.

INVENTOR.

Binstead, R.P.
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<td>14 January 1988 (14.01.88)</td>
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<tr>
<td>(31) Priority Application Number:</td>
<td>003,774</td>
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<td>(32) Priority Date:</td>
<td>16 January 1987 (16.01.87)</td>
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<td>(33) Priority Country:</td>
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<tr>
<td>(71) Applicant:</td>
<td>THE DOW CHEMICAL COMPANY [US/US]; 2030 Dow Center, 2030 Dow Center, Midland, MI 48640 (US).</td>
</tr>
<tr>
<td>(74) Agent:</td>
<td>KARADZIC, Dragan, J.; The Dow Chemical Company, P.O. Box 1967, Midland, MI 48641-1967 (US).</td>
</tr>
</tbody>
</table>

**APPLICATION.**

The Dow Chemical Company

**INVENTOR.**

i) Laursen, L.J.

ii) Schrenk, W.J.

iii) Coomer, V.W.

**EXAMPLES 3 & 4**
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<td>8 October 1987 (08.10.87)</td>
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<td>(33) Priority Country:</td>
<td>DE</td>
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<tr>
<td>(71) Applicant:</td>
<td>COUWENBERGS, Paul [NL/DE]; Scheibenbergstraße 17, D-7500 Karlsruhe (DE).</td>
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<td>COUWENBERGS, Paul [NL/DE]; Scheibenbergstraße 17, D-7500 Karlsruhe (DE).</td>
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<tr>
<td>(72) Inventors/Applicants:</td>
<td>SANDER, Rainer [DE/DE]; Gemmingen Straße 16, D-7331 Neuhausen 2 (DE); OTTO, Werner [DE/DE]; Waldstraße 23, D-4033 Aldorf (DE).</td>
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<td>(81) Designated States:</td>
<td>AT (European patent), AU, BE (European patent), BG, BI (OAPI patent), BR, CF (OAPI patent), CH (European patent), CM (OAPI patent), DE (European patent), DK, FI, FR (European patent), GA (OAPI patent), GB (European patent), HU, IT (European patent), JP, KR, LU (European patent), NL (OAPI patent), NO (OAPI patent), NL (European patent), NO, RO, SE (European patent), SN (OAPI patent), SU, TD (OAPI patent), TG (OAPI patent), US.</td>
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**EXAMPLE 5**

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<td>SE</td>
</tr>
<tr>
<td>(72) Inventor:</td>
<td>WESTERMARK, Per [SE/SE]; Dalmarbo, S-740 22 Bällinge (SE).</td>
</tr>
<tr>
<td>(73) Inventor:</td>
<td>WESTERMARK, Per [SE/SE]; Dalmarbo, S-740 22 Bällinge (SE).</td>
</tr>
<tr>
<td>(74) Agents:</td>
<td>BERGANDER, Håkan et al.; Pharmacia AB, S-751 02 Uppsala (SE).</td>
</tr>
<tr>
<td>(81) Designated States:</td>
<td>AU, DK, FI, JP, NO.</td>
</tr>
</tbody>
</table>

**APPLICANT.**

Couwenbergs, P.

**INVENTOR.**

i) Couwenbergs, P.

ii) Sander, R.

iii) Otto, W.

**APPLICANT.**

i) University of Minnesota

ii) Westermark, P.

**INVENTOR.**

i) Westermark, P.

ii) Johnson, K.H.
Example 1

APPLICANT.

Vaso Products Australia Pty. Limited.

INVENTOR.

i) Lane, R.J.

ii) Spencer, P.
Annex C - Declaration Under Rule 4.17

Example 2
Annex C - Declaration Under Rule 4.17

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Effective Date: 25 September 2019
Annex D - Verification of Translation

VERIFICATION OF TRANSLATION

I (name and address of translator or other signatory)

state that the attached document is a true and complete translation of

the best of my knowledge and belief.

Signature of translator or other signatory

Dated:

Note: Where a verification of a translation is given by a person other than the actual
translator, it must be assumed that the person concerned has a basis for attesting to the
accuracy of the translation in the terms indicated above.
ANNEX E - PCT Pamphlet Front Page

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
Example 1

AMENDED CLAIMS
(received by the International Bureau on
01 September 1982 (01.09.82))

1 (Amended) An arrangement for forming the bottom of a packaging container (1) by folding and sealing the container's bottom wall panels (4, 8, 11) by means of a packaging machine of the type comprising movable drivers (12) for the transfer of tubular packaging container blanks (1) between different processing stations (16, 17, 28, 24, 26, 35), the said arrangement comprising two co-operating folding devices (20) provided on both sides of the plane of motion of the drivers (12) and capable of being driven in opposite directions about mutually parallel axes of rotation (30), characterised in that the axes (30) of the folding devices (20) are at an angle of 10-300 in relation to the momentary position of the longitudinal axis of the drivers (12) which supports the packaging container blank (1) while it is being processed by the folding devices (20).

2 (Amended) An arrangement in accordance with claim 1, characterised in that every folding device (20) comprises two fingers (33, 34) which with a certain mutual displacement project radially from the centre axis of the folding device and between themselves form an angle of 30-600.

3 Cancelled

4 Cancelled

5 Cancelled

6 Cancelled

7 (Amended) An arrangement in accordance with claim 1 or 2, characterised in that the axes (30) are inclined in the direction of movement of the drivers (12).

8 (Amended) An arrangement in accordance with any of the preceding claims, characterised in that the folding devices (20) are capable, be means of a common drive mechanism (22), of being rotated synchronously with the movement of the
drivers (12).

9 (Amended) An arrangement in accordance with any of the preceding claims, characterised in that the drivers (12) consist of mandrels radially arranged on a mandrel-wheel (13) capable of being rotated in steps.

---

Example 2

AMENDED CLAIMS
(received by the International Bureau on 29 March 1982 (29.03.82))

1 to 24 Cancelled

25 (New) A method for producing glass including the steps of:

- feeding glass batch into a melting furnace near one end of the furnace;
- heating the furnace to melt the glass batch;
- impinging the surface of the molten glass with a flame of high energy heat from at least one oxy-fuel burner; and
- withdrawing molten glass near the other end of the furnace.

26 (New) A method according to claim 25 wherein the flame creates a localized hot spot on the surface of the molten glass.

27 (New) A method according to claims 25 or 26 wherein the flame impinges the surface of the molten glass essentially across the width of the furnace transverse to the flow of molten glass in the furnace.

---

2.21 Convention Applications

Modified Date: 02 April 2013

2.21.1 Introduction
The Act provides for the making of Convention applications. These provisions derive from Australia being a signatory to the Paris Convention for the Protection of Industrial Property (usually referred to as the Paris Union or Paris Convention).

The effect of the Convention is to recognise and maintain an applicant's right to an application made in a Convention country if other applications for the same invention are made in other countries within 12 months.

2.21.2 Convention Countries

A list of Convention countries is provided in schedule 4 of the Regulations.

2.21.2.1 Convention Country Listing

Note: The information in this part only applies to Convention applications filed before 15 April 2013. For all other Convention applications, see 2.21.2.1A Convention Country Listing.

Under reg 1.4, countries which are signatories to the Paris Convention, or countries that are full members of the World Trade Organization, are “Convention countries”.

A list of countries that are signatories to the Paris Convention is available from WIPO.

A list of countries that are full members of the World Trade Organization is available from the WTO.

Note: The information in this part only applies to Convention applications filed on or after 15 April 2013. For all other Convention applications, see 2.21.2.1 Convention Country Listing.
2.21.2.2 Basic Applications Filed Before Intergovernmental Organisations

Under the Regulations, several types of documents may serve as a priority document for a Convention application. These include the documents filed at the same time as a basic application that is related to the Convention application.

Where the basic application is a PCT, EP, EA*, AP* or OA* application, the patent request must clearly identify the basic document as being one of these types of application. By their nature, these applications imply that there is at least one Convention country designated in the basic application and, therefore, the patent request will have sufficient detail to satisfy the requirements of the Act. There is no requirement that the patent request additionally mentions at least one individual Convention country.

*Note:  AP  African Regional Intellectual Property Organization
       EA  Eurasian Patent Organization
       OA  African Intellectual Property Organization.

2.21.2.3 Convention Country Status Change

Note: The information in this part only applies to Convention applications filed before 15 April 2013. For all other Convention applications, see 2.21.2.3A Convention Country Status Change.

Section 94 provides for the making of a Convention application. Accordingly, where an application has been made in a foreign country, a Convention application can only be made if, at the time of filing an application in Australia, the foreign country was a Convention country identified in schedule 4 of the Regulations (see 2.21.2.1 Convention Country Listing). Thus, if the country of the earlier application (as stated on the patent request) was not a Convention country at the time of making the application in Australia, an objection should be taken that the (Australian) application cannot proceed as a Convention application. A subsequent change in status of the foreign country to that of a Convention country under the Act will not overcome the objection, i.e. the benefit of sec 94 cannot apply retrospectively.
2.21.2.3A Convention Country Status Change

**Note:** The information in this part only applies to Convention applications filed on or after 15 April 2013. For all other Convention applications, see 2.21.3 Convention Country Status Change.

Section 29B provides for the making of a Convention application. Accordingly, where an application has been made in a foreign country, a Convention application can only be made if, at the time of filing an application in Australia, the foreign country was a Convention country as defined in reg 1.4 (see 2.21.2.1A Convention Country Listing). Thus, if the country of the earlier application (as stated on the patent request) was not a Convention country at the time of making the application in Australia, an objection should be taken that the (Australian) application cannot proceed as a Convention application. A subsequent change in status of the foreign country to that of a Convention country under the Act will not overcome the objection, i.e. the benefit of sec 29B cannot apply retrospectively.

2.21.3 Making Convention Applications

**2.21.3.1 General Requirements**

A Convention application may be made for a standard patent or an innovation patent. To obtain the benefits of the Convention, an application must comply with the requirements of the Act, as outlined in the following parts of this chapter.

Matters particularly relevant to Convention applications include:

- the application must be made within the prescribed time, however if the last day for filing a Convention application is a day on which the Office is not open for business, filing on the day the Office re-opens for business complies with this requirement;
- the patent request must identify the basic application by number, date and country of origin;
- the basic application must have been made in a Convention country; and
2.21.3.2 Who May Apply

A Convention applicant in Australia must be a person as specified in schedule 1 of the Act (see definition of ‘Convention applicant’).

The Act allows a single Convention application made in Australia to be based on 2 or more basic applications. These basic applications may have been made in different Convention countries and by different applicants. Where a Convention applicant is not the same as a basic applicant, examiners should check that the Convention applicant is a person as defined in schedule 1.

See also 2.21.3.6 Basic Applications Having a Parent Application, e.g. Continuations-in-Part.

2.21.3.3 Basic Applications

In general, if a Convention country grants any form of protection for an invention for which a patent could have been obtained in Australia, an application for this form of protection in the Convention country may be used as the basis for a Convention application in Australia. Thus, in addition to applications for patents made in Convention countries, applications for other types of protection may serve as the basis for a Convention application.

Examples of other types of protection include:

- an application for registration of a utility model (e.g. in Japan);
- a "Gebrauchsmuster" application (made under the laws of Germany); and
- an application for a certificate of authorship (e.g. as provided in the laws of some European countries).

If the form of protection applied for in the Convention country is acceptable as the basis for a Convention application in Australia, e.g. an application for a patent, but the particular application is for subject matter which is not patentable in Australia, there is no objection that the Australian application does not meet the requirements of a Convention application. However, a manner of manufacture objection will apply. Thus, for example, if an application...
2.21.3.4 Timing Provisions

in Japan for registration of a utility model is considered to be merely concerned with a new industrial design which is not patentable in Australia, no formal objection is to be taken that the Australian application does not meet the requirements of a Convention application. However, the examination report should indicate why the application is otherwise inadequate.

A number of Convention countries have provisions in their laws for divisional applications and additional applications and such applications may be used as a basis for Convention applications. Where the basic application is an additional, the application in Australia does not have to be an additional. Similarly, where the basic application is a divisional, the application in Australia does not have to be a divisional.

Basic Application Requirements Not Met

A Convention application may be based on an application in a Convention country for protection of an invention that includes the word "patent". However, the word "patent" is not always conclusive that the matter for which the patent protection is afforded is an invention, for example, when used in US "design patents" (see Anchor Wall Systems, Inc v Keystone Retaining Wall Systems, Inc [1996] APO 33). Where examiners have any doubts, the issue should be referred to a supervising examiner.

In Agfa-Gevaert A.G.’s Application (1982) RPC 441, it was held that Convention priority could not be claimed from a German registered design application for the purposes of the UK Patents Act 1977.

A Convention application cannot be based on a US application for a "re-issue" patent. A re-issue application cannot be the first application for an invention in a Convention country, since its subject matter must be essentially the same as the patent it replaces.

Modified Date: 03 August 2015

2.21.3.4 Timing Provisions

A Convention application must be made within 12 months from the date of the earliest basic application, unless that basic application is disregarded (see 2.21.3.5 Basic Application Outside 12 Month Convention Period).
Where several applications disclosing the invention claimed in an Australian Convention application have been made in one or more Convention countries, the 12 month period within which the Convention application must be made is limited to being 12 months from the time of making the earliest of those basic applications.

Some countries have a system of protection which allows applicants to file an application with only a "provisional" specification, to which they can add a more complete specification at a later date. In this case, the 12 month period is taken from the date of the basic application (i.e. the provisional) and not from the date of any subsequently filed specifications.

See also 2.12.1.3 Priority Date Issues Specific to Convention Applications.

Note: The information in this part only applies to:

• standard patent applications with an examination request filed before 15 April 2013.
• innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.21.3.5A Basic Application Outside 12 Month Convention Period.

In this topic:

Overview

If there are claims in a specification which are fairly based on a disclosure in a basic application made more than 12 months before the date of filing of an Australian application, and sec 43(5) does not apply (see below), then those claims do not satisfy the conditions of
2.21.3.5 Basic Application Outside 12 Month Convention Period

reg 8.5(2) and cannot take the filing date of the basic application as their priority date (reg 3.12).

This is irrespective of whether those same claims are fairly based on matter disclosed in a basic application filed within the 12 month period permitted by reg 8.5(2).

Where sec 43(5) does not apply, examiners should object that the Australian application does not meet the requirements of a Convention application.

See also 2.12.1.3 Priority Date Issues Specific to Convention Applications for determination of the priority date in this situation.

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**Subsection 43(5)**

Where the claims are fairly based on both:

- a basic application made more than 12 months before the filing date of the Convention application (the ‘earlier application’); and
- a basic application filed within 12 months of filing the Convention application (the ‘later application’); and the applicant wants the claims in the Convention application to take the filing date of the later application as their priority date, this is only possible if the earlier application can be disregarded for the purposes of the Act (sec 43(5)) (see also Mobil Oil Corporation’s Application (1975) AOJP 1277, which was concerned with a corresponding, but non-identical, provision in the Patents Act 1952).

In order for sec 43(5) to apply, the following requirements must be met:

- an earlier application must have been made in a Convention country for protection of the invention;
- the earlier application must have been made more than 12 months before the filing of the Convention application (reg 3.14C);
- the earlier application must have been withdrawn, abandoned or refused without becoming open to public inspection (OPI) anywhere in the world;
- the earlier application must not have been used as the basis of claiming a right of priority in any Convention country; and
- a later application must have been made in a Convention country for the same invention for which the earlier application was made, and the later application must
have been made by the same applicant who made the earlier application. Note that the earlier and later applications need not have been made in the same Convention country.

Without becoming “open to public inspection” is limited to the time when a Convention application is made for a patent in Australia.

**Note:** A special case exists with US continuation-in-part applications where the parent specification has been abandoned. The abandoned parent specification usually becomes OPI on the issue of the patent on the continuation-in-part application. Provided it was abandoned and not OPI when the Convention application was made in Australia, sec 43(5) can apply.

**Examination Practice**

If an applicant indicates that an earlier application is to be disregarded under sec 43(5), examiners should consider the matter during examination.

Where the sec 43(5) requirements are met, the examination report should indicate that the earlier application has been disregarded.

If the requirements are not met, the report should explain the reasons why the earlier application cannot be disregarded. Examiners should also object that pending resolution of this matter, the application under examination does not meet the requirements of a Convention application.

Where the requirements are met and the case is in order for acceptance, the fact that the earlier application has been disregarded should be indicated on the ‘Acceptance Information’ screen in PAMS (screen 4 of 7) (or, during certification, on the Innovation Certification Form (under ‘Certification Checklist’)).

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed **on or after** 15 April 2013.
• innovation patents with an examination request filed on or after 15 April 2013.
• innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.21.3.5 Basic Application Outside 12 Month Convention Period.

In this topic:

Overview

If there are claims in a specification which are enabled by a disclosure in a basic application made more than 12 months before the date of filing of an Australian application, and sec 43(5) does not apply (see below), then those claims do not satisfy the conditions of reg 3.11 (reg 8.5(2)) and cannot take the filing date of the basic application as their priority date (reg 3.13B).

This is irrespective of whether those same claims are enabled by a disclosure of a basic application filed within the 12 month period permitted by reg 3.11 (reg 8.5(2)).

Where sec 43(5) does not apply, examiners should object that the Australian application does not meet the requirements of a Convention application.

See also 2.12.1.3A Priority Date Issues Specific to Convention Applications for determination of the priority date in this situation.

*Note: Regulation 8.5(2) only applies to Convention applications filed before 15 April 2013.

Subsection 43(5)

Where the claims are enabled by the disclosure of both:

• a basic application made more than 12 months before the filing date of the Convention application (the ‘earlier application’); and
2.21.3.5A Basic Application Outside 12 Month Convention Period

- a basic application filed within 12 months of filing the Convention application (the 'later application');

and the applicant wants the claims in the Convention application to take the filing date of the later application as their priority date, this is only possible if the earlier application can be disregarded for the purposes of the Act (sec 43(5)) (see also Mobil Oil Corporation’s Application (1975) AOJP 1277, which was concerned with a corresponding, but non-identical, provision in the Patents Act 1952).

In order for sec 43(5) to apply, the following requirements must be met:

- an earlier application must have been made in a Convention country for protection of the invention;
- the earlier application must have been made more than 12 months before the filing of the Convention application (reg 3.14C);
- the earlier application must have been withdrawn, abandoned or refused without becoming open to public inspection (OPI) anywhere in the world;
- the earlier application must not have been used as the basis of claiming a right of priority in any Convention country; and
- a later application must have been made in a Convention country for the same invention for which the earlier application was made, and the later application must have been made by the same applicant who made the earlier application. Note that the earlier and later applications need not have been made in the same Convention country.

Without becoming “open to public inspection" is limited to the time when a Convention application is made for a patent in Australia.

**Note:** A special case exists with US continuation-in-part applications where the parent specification has been abandoned. The abandoned parent specification usually becomes OPI on the issue of the patent on the continuation-in-part application. Provided it was abandoned and not OPI when the Convention application was made in Australia, sec 43(5) can apply.

**Examination Practice**

If an applicant indicates that an earlier application is to be disregarded under sec 43(5), examiners should consider the matter during examination.
2.21.3.6 Basic Applications Having a Parent Application, e.g. Continuations-in-Part

Where the sec 43(5) requirements are met, the examination report should indicate that the earlier application has been disregarded.

If the requirements are not met, the report should explain the reasons why the earlier application cannot be disregarded. Examiners should also object that pending resolution of this matter, the application under examination does not meet the requirements of a Convention application.

Where the requirements are met and the case is in order for acceptance, the fact that the earlier application has been disregarded should be indicated on the ‘Acceptance Information’ screen in PAMS (screen 4 of 7) (or, during certification, on the Innovation Certification Form (under ‘Certification Checklist’)).

Modified Date: 02 April 2013

2.21.3.6 Basic Applications Having a Parent Application, e.g. Continuations-in-Part

Basic applications which are additional applications, divisional applications and US continuations and continuations-in-part are, *prima facie*, subsequent applications for the same subject as an earlier (parent) application (in accordance with paragraph (4) of Article 4C of the Paris Convention). Consequently, if a Convention application is based on one or more of these types of applications and is filed more than 12 months after the parent application, *prima facie* the claims of the Convention application are not entitled to take the filing date of the basic application as their priority date, unless the parent application is disregarded (see 2.21.3.5 Basic Application Outside 12 Month Convention Period).

However, where the basic application derives from a parent application filed more than 12 months prior to the filing of the Convention application, the applicant should not be asked to file a certified copy of the parent application, or a declaration that the parent application did not disclose anything claimed in the Convention application. It is implicit in the fact that the application invokes Convention rights that the applicant considers that the parent application does not disclose anything claimed in the Convention application. This also applies where it comes to the examiner’s attention that a corresponding foreign application has been made in respect of the subject matter of the parent more than 12 months prior to the filing of the Convention application.

Consequently, examiners should consider the Convention application to meet the necessary requirements, with priority determined from the basic application identified in the patent request.

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Effective Date: 25 September 2019
2.21.3.7 Patent Requests and Entitlement

In this topic:

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**Patent Request**

The patent request must set out the number, date and country of origin in respect of the basic applications upon which the Australian application is based. The country codes, as specified in WIPO Information and Documentation Standard ST.3, are an acceptable identification of any particular foreign country.

When the request indicates that a Convention application has been made, but either:

- the application in Australia was not made within 12 months of the date of the first basic application made in respect of the invention;
- the number, date or country of origin of the basic application identified on the patent request differ from other documents on file;
- the applicant in Australia does not meet the definition of a "Convention applicant"; or
- a copy of the basic specification, translation or other relevant document is not provided when required (see 2.21.3.8 Basic Specifications);

the application is not entitled to proceed as a Convention application, and examiners should object accordingly.

In response to an objection, the applicant may, as applicable:

- amend the patent request under sec 104 to convert the application to a non-Convention application (see 2.21.3.9 Converting Convention Applications to Non-Convention, and Vice Versa) and proceed on that basis;
- amend the patent request under sec 104 to correct wrong details of the basic application;
- indicate that an earlier application is to be disregarded (see 2.21.3.5 Basic Application Outside 12 Month Convention Period); or
- request an extension of time.
2.21.3.8 Basic Specifications

Where the patent request does not indicate that a Convention application has been made, but other documents on file indicate that the applicant intended to invoke the Convention provisions, the applicant should be informed of the situation and allowed to make any rectifications as necessary.

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**Entitlement**

The general provisions relating to notices of entitlement are applicable to Convention applications. The applicant is required to make at least a generic statement that they have entitlement from an applicant of the basic applications listed in the patent request. Details of how entitlement is derived may be provided, however this is not required by the Commissioner, unless the Commissioner has information which puts the applicant’s entitlement to claim priority in doubt (see 2.6.3 Entitlement).

The notice is not required to state that the basic application was the first application made in a Convention country in respect of the invention the subject of the Australian specification.

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2.21.3.8 Basic Specifications

In this topic:

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**Obtaining Basic Specifications**

A copy of the specification relating to the basic application(s) (basic specification) is not required, except in the following circumstances:

a. where third parties request a copy of the document;

b. in examination or re-examination, where there is a citation published after the priority date and before the filing date, or a whole of contents citation with a priority date after the priority date and before the filing date, of the case being examined;

c. in examination or re-examination, where there is a whole of contents citation having a priority date before the priority date of the case being examined; or
d. in opposition, when requested by the opponent.

During examination, if either of circumstances b. and c. arises and examiners have reason to believe that the claims are not entitled to the claimed priority date, they should check whether the relevant basic specification is available from Patentscope or another database, e.g. USPTO Public PAIR. If the document is present, a copy should be downloaded and added to the case file. Where the basic specification is not available, examiners should contact COG (via email to era@ipaustralia.gov.au) with a request to obtain the document from WIPO. COG will attempt to obtain the document either via the WIPO Digital Access Service (“DAS”) or directly from the International Bureau. If it emerges that the basic specification is not available within a reasonable time (about 3 weeks), examiners should issue a report with a request that the applicant provide a copy of the document certified according to reg 3.14D(1)(c) within 3 months (sec 43AA). It may also be necessary for examiners to request a translation at the same time as requesting the basic specification (see Translations of Basic Specifications below).

Note: The approval of a senior examiner must be obtained before issuing a request to the applicant to provide basic specifications.

If the applicant in response states that the basic specification is available via the WIPO DAS, examiners should again email COG with a request to retrieve the document. COG will verify that the Office was granted access to the document in the time allowed, inform examiners of this and retrieve the document. If the Office was not provided access in time, examiners should proceed on the basis that the time limit was not complied with. If access is provided, but for technical reasons the document cannot be retrieved from WIPO DAS, COG will direct the applicant to file or make the document available within a further period of 2 months (reg 3.14D). COG will then provide the document or advise that the time limit was not complied with. Failure of the applicant to comply with a request to provide basic specifications within the time limit will result in a loss of priority. If this situation arises, examiners should consult Patent Oppositions before taking any further action.

Translations of Basic Specifications

The Commissioner will only request an applicant to file translations of basic specifications where there is a validity-related issue in which the determination of the correct priority date is, or is likely to be, important. Examples of such circumstances are given in b. to d. above. It is not expected that the Commissioner will require translations to be filed on the request of third parties.
Where a basic specification is on file, but COG have been unable to source an English translation thereof, examiners should assess the basic specification before requesting that the applicant provide a translation. Examiners should make use of qualified translators within the Office (see 1.10.5 Examiners with Foreign Language Capabilities), or a machine based translation (provided the basic specification is a published document), to initially assess whether a full translation is required. Similarly, an initial assessment of the figures (including chemical structures and amino acid/nucleotide sequences) can be used to determine whether a full translation is required.

If the basic specification is not available from an approved digital library, e.g. Patentscope, and is obviously in a foreign language (such as Japanese applications or EP applications by French or German companies), then both the basic specification and the translation* should simultaneously be requested from the applicant. For further information on translations, see 2.21.3.10 Translation Requirements.

*Note: For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided.

### Time Limits for Providing Basic Specifications

A request by the Commissioner for a copy of the basic specification and/or its translation* may in some circumstances extend the period for acceptance by up to 5 months. For further information on the procedures to be followed, see 2.15.7.4 Request for Basic Specification.

*Note: For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided.

### Certification of Basic Specifications

A certified copy of a basic specification is only required when requested by the Commissioner.

A certification "by the competent authority" (as required by reg 3.14D(1)(c)) means a certification by a person authorised in the relevant jurisdiction to issue such certifications (see definition of “competent authority” in reg 1.3(1)). For example, where an application...
2.21.3.9 Converting Convention Applications to Non-Convention, and Vice Versa

In certain circumstances, the patent request may be amended under sec 104 to convert a non-Convention application to a Convention application (see 2.23.13.3 Amending a Non-Convention Patent Request to a Convention Patent Request).

Similarly, the patent request may be amended under sec 104 to convert a Convention application to a non-Convention application (see 2.23.13.4 Amending a Convention Patent Request to a Non-Convention Patent Request).

2.21.3.10 Translation Requirements

In certain circumstances, the Commissioner may request an applicant to file a translation of a basic specification (see 2.21.3.8 Basic Specifications).
A translation of a basic specification should comprise a full translation of that specification, including any certification.

For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be filed (see Certificate of Verification below).

The translation and certificate of verification (where required) need not necessarily be original documents. Photocopies are acceptable, provided they are accompanied by a declaration, properly executed in accordance with reg 22.13, to the effect that they are true copies of the originals.

The translation must be in respect of the whole of the foreign specification, including the claims, any substantive text that may appear on the drawings, graphics or photographs and any official certificates annexed thereto. For the translation to be a true translation, it must not incorporate any extraneous matter.

Certificate of Verification

Under reg 1.3, a "certificate of verification" is a statement that:

- a document to which the statement relates is a true and complete translation of the relevant document to the best of the knowledge of the person who signs the statement; and

- is dated and signed.

It is not necessary that the "certificate of verification" use the exact words as specified, i.e. whilst it might be desirable to use those particular words, if other words are used which (in practical terms) are of the same effect, the requirements are satisfied. In particular, it is not necessary that the word “verify” or any of its derivatives appear in the verification.

Accordingly, provided there is a signed and dated statement to the effect that the document is a translation, with it being readily inferable from the circumstances that the statement infers that it is a true and complete translation, then the translation requirements are to be regarded as having been met.

The verification will usually be in the form of a statement by the translator that:

- the translator is familiar with both languages involved; and

- the translation is a true and correct translation into the English language.

However, reg 1.3 does not require a statement that the translator is familiar with both of the relevant languages to be in the certificate of verification and does not preclude a person...
other than the translator from making the verification. An acceptable form of verification is shown in 2.20 Annex D – Verification of Translation. Provided the verification meets these requirements, no objection should be taken.

A properly verified statement setting out any differences between a translation of a basic specification and the complete specification filed in respect of the Convention application, if it is in English, or a verified translation of the complete specification, if it is not in English, is also acceptable for meeting the requirements of a verified translation of a basic specification.

**Correction of Translation**

For translations filed **before or on** 25 September 2019, examiners should not check the correctness of the translation, even if they are familiar with the foreign language concerned. If examiners nonetheless become aware of an apparent error in a translation, no objection should be taken in this regard, as the translation provided is accepted as being verified to the satisfaction of the Commissioner.

For translations filed **after** 25 September 2019, where examiners become aware of errors in the translation, they should follow the procedures in 2.15.7.3 Request for Corrected Translation or Certificate of Verification.

**Other Considerations**

The law in countries having a national language other than English may permit or require the basic specification to be filed in English, but the certification by the competent authority of the country’s patent office is given in the national language. Where this occurs, a translation of the certificate must be provided. (For translations filed **before or on** 25 September 2019, a certificate of verification for the translation must also be provided).

Where the certificate from the competent authority is printed in two languages, one of which is English, no objection is to be taken and a separate translation of the certificate is not required, even if the non-English text appears to be more extensive than the English text (provided all required particulars are stated in English).
The introductory pages of French basic specifications may include pages entitled "Requete" and "Page de Garde". Neither of these is required under the Regulations and if present do not need to be translated.

Modified Date: 02 April 2013

2.21.3.11 Date of Basic Application

The date of the basic application stated on the patent request should be taken as correct, unless there is evidence on file to the contrary. In this case, examiners should object that the date shown on the request is *prima facie* incorrect.

In certain circumstances, a basic application can have an effective filing date different from the actual filing date (ante-dating and post-dating). However, when this is the case, there must be supporting documentation.

See:

- *La Soudure Electrique Autogene S.A.'s Application* (1939) 56 RPC 218; and
- *Poly-Resin Products Ltd.'s Application* (1961) RPC 228.

Modified Date: 01 November 2017

2.21.3.12 Convention Priority Dates

**Note:** The information in this part only applies to:

- standard patent applications with an examination request filed before 15 April 2013.
- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.21.3.12A Convention Priority Dates.

The priority date of the claims of a Convention application is determined by reg 3.12 (see 2.12.1.1 Priority Date of Claims and 2.12.1.3 Priority Date Issues Specific to Convention Applications).

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Effective Date: 25 September 2019
In general, examiners will not need to determine the priority date of the claims during examination. An exception to this occurs if a document is found that would constitute a citation against a claim only if the claim takes a priority date of the date of filing of the application. Where claims take a later priority date because a basic application is filed outside the 12 month Convention period, examiners should follow the practice outlined in 2.21.3.5 Basic Application Outside 12 Month Convention Period.

A Convention application may also derive priority under other provisions of the Act and Regulations, for example, by being associated with a provisional application or by being a divisional application.

Note: The information in this part only applies to:

- standard patent applications with an examination request filed on or after 15 April 2013.
- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other standard patent applications/innovation patents, see 2.21.3.12 Convention Priority Dates.

The priority date of the claims of a Convention application is determined by reg 3.13B (see 2.12.1.1A Priority Date of Claims and 2.12.1.3A Priority Date Issues Specific to Convention Applications).

In general, examiners will not need to determine the priority date of the claims during examination. An exception to this occurs if a document is found that would constitute a citation against a claim only if the claim takes a priority date of the date of filing of the application. Where claims take a later priority date because a basic application is filed outside the 12 month Convention period, examiners should follow the practice outlined in 2.21.3.5A Basic Application Outside 12 Month Convention Period.

A Convention application may also derive priority under other provisions of the Act and Regulations, for example, by being associated with a provisional application or by being a divisional application.
2.22 Re-Examination

Modified Date: 25 September 2019

2.22.1 Introduction

Note: Prior to 15 April 2013, the only grounds available for consideration during re-examination were novelty and inventive/innovative step. For re-examination reports issued on or after 15 April 2013, expanded grounds are available for consideration during re-examination (see 2.22.4.1 Scope of the Consideration). This applies regardless of whether the report is an initial report, or a subsequent adverse report.

In this topic:

General

Chapter 9 of the Act provides for "re-examination" of applications for standard patents and granted standard patents, and Chapter 9A, Part 2 provides for "re-examination" of certified innovation patents. This procedure allows the Office to decide certain questions of validity in accepted applications for standard patents, granted standard patents and certified innovation patents.

The substantive grounds available for consideration during re-examination are listed in 2.22.4.1 Scope of the Consideration. The process is instigated at the Commissioner's discretion, upon request by the patentee or any interested person, or by the direction of a prescribed court before which the validity of a patent is in dispute. The procedure is ex parte, i.e. does not involve a third party who requests re-examination.

The Commissioner will instigate re-examination voluntarily only if an adverse re-examination report will issue. Consequently, the report will only refer to citations which give rise to an objection. In contrast, the Commissioner must re-examine where the patentee or third party requests re-examination. In these circumstances, the report will address all citations provided in the request and may be favourable in some or all respects. The standard required for both types of reports is the same as the third report standard.

The practices and procedures set out below relate to re-examination under Chapter 9 of standard patents and applications therefor. Corresponding practices and procedures apply to re-examination of certified innovation patents under Chapter 9A, Part 2.
Initiation of Re-Examination

Third Party Requests

Patent Oppositions will prepare a hard copy folder of the documents that have been filed in support of the request and send it to the relevant examination section through the internal mail system. The supervising examiner will then assign the folder to an examiner for re-examination. For third party requests, re-examination must be conducted and either an adverse or non-adverse report must be issued.

Withdrawn Oppositions

Patent Oppositions will send the hard copy opposition file to the relevant examination section through the internal mail system. The supervising examiner will then assign the file to an examiner for review. The examiner will conduct a re-examination only if it is warranted and with the agreement of the supervising examiner.

Examiners should not automatically review all documents listed in the statement of grounds and particulars. Where the relevance of the documents is stated, examiners should consider this and focus on those documents where there is reason to believe they could be citations. Where there is no relevance indicated, examiners would not normally have reason to believe that any of the documents could be a citation. However, in the case of non-patent literature, the title of a document could suggest it is relevant. Finally, if the statement only lists a small number of documents without indicating their relevance, examiners should review those documents (on the basis that the opponent seems to have been selective and therefore those documents could be particularly relevant).

Section 27 Notices

For notices filed after acceptance, but before grant of a patent, COG will email the supervising examiner of the relevant section and request urgent consideration of the notice. The supervising examiner will then allocate the task to an examiner for review. The examiner will conduct a re-examination only if it is warranted and with the agreement of the supervising examiner.

Following Quality Review

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Effective Date: 25 September 2019
2.22.1 Introduction

A decision should be made within the examination section, and with the agreement of the supervising examiner, as to whether re-examination is warranted. However, Patent Oppositions must be consulted before proceeding with re-examination.

New Prior Art Located After Acceptance or Grant

A decision should be made within the examination section, and with the agreement of the supervising examiner, as to whether re-examination is warranted in view of the relevant prior art documents. However, Patent Oppositions must be consulted before proceeding with re-examination.

Overview of Re-Examination Procedure

Allocation of Re-Examination Tasks

The supervising examiner is responsible for the allocation of re-examination tasks within a section. It is preferable that re-examination is undertaken by an examiner who is not the original examiner. However, the re-examination should be assigned to whoever is best placed to complete the task within the Customer Service Charter timeframe (see Customer Service Charter Timeliness Guidelines). Consequently, there may be situations where the original examiner is asked to undertake the re-examination, particularly if that person is best qualified to understand the technology.

Note: Where a Tier 1 Finding has been finalised, and that Finding could jeopardise the validity of an accepted application, the re-examination task will be allocated as above. The examiner assigned the task must consult with Patent Oppositions before proceeding with re-examination. Any re-examination report should be issued within 8 weeks from the date of finalising the Finding.

Intention to Re-Examine Letter (Section 112)

For re-examination of granted patents, an ‘intention to re-examine’ letter must be sent to the patentee at least 7 days before the re-examination report is issued. This letter is for the purposes of satisfying the requirements of sec 112 (no letter is required for an application for which a patent has not been granted). For re-examination based on third party requests,
2.22.2 Transitional Provisions

Patent Oppositions will send the letter before the hard copy folder of documents is forwarded to the relevant examination section.

Examiners should not include any further requests for sec 112 information in their re-examination reports, regardless of the time from the date of issue of the first re-examination report until the date of issue of the final non-adverse report. (Note that a non-adverse report is issued once all the objections raised in an adverse report are overcome).

Further information regarding post-grant re-examination is provided in 2.22.3.2 Post-Grant (Standard and Innovation Patents).

Report Procedure

**Note:** There is no re-examination category of task in PAMS. All re-examinations are done as an Edit Ecase and the appropriate report template must be used.

Once the examiner has completed a draft of the re-examination report it must be supervised by a senior examiner (or if the report is done by a senior examiner, peer reviewed by another senior examiner) and an email then sent to Patent Oppositions (email to ohl@ipaustralia.gov.au) advising that supervision is complete. Patent Oppositions will perform an editorial review of the report to ensure that all reports are broadly consistent in style. Once the examiner has made any changes directed by Patent Oppositions, the report is dispatched in the usual manner. However, Patent Oppositions must be advised by email of the actual date of issue in order to create a diary entry of the 2 month response date.

Further information on the report process is provided in 2.22.5 Re-Examination Report and 2.22.7 Copy of Report on Re-Examination.

An outline of the process, showing the major steps, is provided in the flowchart at 2.22 Annex A - Re-Examination Processing. (Note that this flowchart does not comprehensively include all variations and their steps).

A re-examination checklist is provided at 2.22 Annex C – Re-Examination Checklist.

Modified Date: 01 June 2012

2.22.2 Transitional Provisions

The transitional provisions of sec 233(3) and sec 234(4) state that complete specifications of:
2.22.3.1 Between Acceptance and Grant (Applications for Standard Patents)

- patents granted under the 1952 Act;
- applications lodged under the 1952 Act which have not been withdrawn or finally dealt with at the commencement date; and
- patents granted on such applications;

are not subject to re-examination. Means other than re-examination by which validity issues may be raised against the above specifications are:

- Section 138 Revocation of patents in other circumstances.
- Section 59 Opposition to grant of standard patent.

2.22.3 When Re-Examination Applies

Modified Date: 01 October 2015

2.22.3.1 Between Acceptance and Grant (Applications for Standard Patents)

At any time between acceptance of a standard patent application and grant of the corresponding patent, the Commissioner may decide to re-examine the application. The decision to re-examine an accepted application is entirely at the discretion of the Commissioner, i.e. no third party (including an opponent) has a right to ask for re-examination to occur before grant.

A decision to re-examine will typically arise during this period as a result of:

- quality review;
- new prior art;
- sec 27 notice; or
- withdrawn opposition.

In addition, applicants may themselves provide search results or documents that they wish to have considered.

Note: Commissioner initiated re-examination of an application which is related to another application undergoing examination, should be discussed with Patent Oppositions prior to issuing any re-examination report.
2.22.3.2 Post-Grant (Standard and Innovation Patents)

In this topic:

At any time after grant of a standard patent or certification of an innovation patent, the patentee or any other person may request re-examination. The Commissioner may also decide to re-examine after the grant or certification of a patent without a request for re-examination being made. This may occur, for example, when a staff member of the Office or the patentee brings to the Commissioner's attention prior art which was not raised in relation to the application at any time pre-grant or pre-certification.

Re-examination based on prior art brought to the attention of the Commissioner by "interested" persons will generally only be undertaken upon a formal request being made by the person(s) concerned.

Note: Commissioner initiated re-examination of a patent which is related to an application undergoing examination should be discussed with Patent Oppositions prior to issuing any re-examination report.

Intention to Re-Examine Letter (Section 112)

Under sec 97(4) and sec 101K(2), the Commissioner must not re-examine a patent where relevant proceedings are pending. Where relevant proceedings are initiated after re-examination has commenced, there are statutory provisions suspending the re-examination process (sec 97(5) and sec 101K(3)).

Before re-examining a granted patent, examiners must check the file to see if there is any indication of court action. Where a third party requests re-examination, Patent Oppositions will enquire whether relevant proceedings are pending prior to the case file being referred to the relevant examination section. However, if the Commissioner initiates re-examination, examiners will need to check the file. There may already be a statement that there is no
court action, for example, in the case where there is a recent application for an extension of term under sec 70. If there is no indication of a court action on the file, examiners must write to the patentee and inform them that the Commissioner intends to re-examine the patent unless advised within 7 days that relevant proceedings are pending. The following text should be used:

"I am writing to inform you that the Commissioner intends to re-examine the above patent. Under Section 97(4), where relevant proceedings in relation to a patent are pending, the Commissioner must not re-examine the complete specification in relation to the patent.

Please advise the Commissioner of any relevant proceedings or court actions within seven (7) days of the date of this letter.

If no reply to this letter is received within this time, it will be considered that there are no relevant proceedings and the patent will be re-examined and a re-examination report will issue in due course. Under Section 97(5), where the Commissioner has started to re-examine the complete specification and relevant proceedings in relation to a patent are started, the Commissioner must not continue the examination. You are therefore requested to inform the Commissioner of any such proceedings immediately that they are started."

See also 2.22 Annex B – Intention to Re-Examine Letter.

Upon sending the “Intention to Re-Examine Letter” the examiner is to advise Patent Oppositions (via email to ohl@ipaustralia.gov.au) providing the relevant patent number and the date the letter was issued.

The re-examination report must not be issued before the seven day period has expired.

Provided this letter has been sent, examiners should not include any further requests for sec 112 information in their re-examination reports, or request such information prior to completing the sec 104 voluntary allowance form (if appropriate) at the conclusion of the re-examination process. When completing the form, the box relating to relevant proceedings pending should be checked (on the condition that the intention to re-examine letter was sent and the patentee is aware of the on-going requirement to advise of any proceedings).

**Note:** Under the Federal and Supreme Court rules, the Commissioner has to be informed of any court action on a patent. However, there have been instances where the parties have neglected to inform the Commissioner of a court action.
2.22.3.3 Re-Examination of Standard Applications and Innovation Patents by the Commissioner During Opposition

**Court Directed Re-Examination**

A prescribed court may, at its discretion, direct the Commissioner to re-examine the complete specification of a patent, the validity of which is in dispute. The Commissioner would present the findings of the re-examination to the court, which could then take the result into account.

In these circumstances, the patentee is notified by the Commissioner of the decision to re-examine the complete specification if the patentee did not request re-examination.

In *VIP Plastic Packaging Pty Ltd v B.M.W. Plastics Pty Ltd* [2009] FCA 593 the respondent asked the court to order re-examination. The patentee argued that such re-examination would not obviate the need for evidence on the issues of novelty and inventive step. The judge denied the motion, stating that a re-examination would not necessarily expedite proceedings.

**Modified Date: 19 December 2013**

**2.22.3.3 Re-Examination of Standard Applications and Innovation Patents by the Commissioner During Opposition**

The Act and Regulations allow the Commissioner to re-examine standard applications and innovation patents during opposition. This is entirely at the discretion of the Commissioner, and neither the opponent nor any other person has the right to ask for re-examination to occur.

The Commissioner will only consider re-examining an application during opposition if it is likely that the opposition proceedings can be curtailed and where all parties agree to re-examination taking place. This is because re-examination is *ex parte* and the opponent has no right of involvement or appeal. The documents being considered may also be raised in opposition and dealing with them in re-examination could be seen as "pre-judging" the opposition.

In *Novozymes A/S v North Carolina State University and Bioresource International, Inc.* [2009] APO 18 the opponent, after serving its statement of grounds and particulars, requested that the Commissioner re-examine the patent application in question. The applicant subsequently objected. The Deputy Commissioner decided that in this case there was a significant likelihood that re-examination would prolong the opposition without achieving any better result than if the opposition was prosecuted promptly, and that therefore re-examination was inappropriate.
Where an opposition has been withdrawn, the normal requirements for re-examination apply. The opposition file will be referred to the relevant examination section and allocated by the supervising examiner to an examiner for review. In such cases, the examiner will instigate re-examination only if it is warranted and with the agreement of the supervising examiner.

Where re-examination is required, the report should be issued within 8 weeks from the date of withdrawal of the last opposition, consistent with the Customer Service Charter Timeliness Guidelines.

**2.22.4 Re-Examination Consideration**

**Modified Date: 03 February 2014**

**2.22.4.1 Scope of the Consideration**

**Note:** Prior to 15 April 2013, the only grounds available for consideration during re-examination were novelty and inventive/innovative step. For re-examination reports issued on or after 15 April 2013, expanded grounds are available for consideration during re-examination. This applies regardless of whether the report is an initial report, or a subsequent adverse report.

In this topic:

During re-examination, consideration is given to:

i. whether the specification does not comply with sec 40(2) or sec 40(3);

ii. whether the invention, so far as claimed in any claim:
   - is not novel; or
   - does not involve an inventive step or an innovative step, as applicable; or
   - is not useful; or
   - is not a manner of manufacture.

iii. whether the invention is not patentable under sec 18(2) or sec 18(3), as applicable.

Examiners should also note that prior use may be considered for novelty and inventive/innovative step purposes.
Consideration of Sec 40(2) and Sec 40(3) and Usefulness

During re-examination, the sec 40(2) and sec 40(3) grounds to consider are the same as those considered during examination. Usefulness should be considered as detailed below.

Examination Request Filed Before 15 April 2013

In this situation, the sec 40 issues to be considered during re-examination are:

- full description, including best method of performance;
- clarity and succinctness; and
- fair basis.

Usefulness should be considered only in terms of whether the claimed invention achieves the promised benefit (see 2.9.3.4.1A Does the Invention Achieve the Promised Benefit?)

Innovation Patent Where Commissioner Decided Before 15 April 2013 to Examine the Patent

Refer to ‘Examination Request Filed Before 15 April 2013’ above.

Examination Request Filed On or After 15 April 2013

In this situation, the sec 40 issues to be considered during re-examination are:

- clear enough and complete enough disclosure, including best method of performance;
- clarity and succinctness; and
- support.

Usefulness should be considered according to the procedures outlined in 2.9.3.4A Useful (Utility).
2.22.4.2 Re-Examination Request

Innovation Patent Where Commissioner Had Not Decided Before 15 April 2013 to Examine the Patent

Refer to ‘Examination Request Filed On or After 15 April 2013’ above.

2.22.4.2 Re-Examination Request

A request for re-examination must meet the following requirements:

- Identify the documents on which the re-examination is to be based and state the relevance of each document.
- If a document is not available in the Office, a copy of that document must accompany the request.
- If the document relied on is not in English, a translation must be provided. For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided.
- Include evidence of the date and place of publication of each document (if this is not apparent from the document itself).

If the request does not satisfy these requirements, then re-examination cannot take place.

A person who has made a request may, by filing a notice in writing, amend or withdraw the request before re-examination commences.

2.22.4.3 Material Considered During Re-Examination

Information previously considered during examination does not provide an appropriate pretext for re-examination (unless it is part of a request by the patentee or a third party or, following quality review, re-examination is clearly warranted in light of such information).

Therefore, the documents considered in re-examination will be those of the prior art base that the Commissioner considers necessary such as:

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Effective Date: 25 September 2019
2.22.4.3 Material Considered During Re-Examination

- any published material that the Commissioner becomes aware of through Office staff;
- any published material referred to by an opponent in a statement of opposition;
- any material identified by a person requesting re-examination; or
- any material as informed by a court directing re-examination.

In addition, examiners are to check if there are any FERs that were not available at the time of examination and consider whether these are relevant.

When determining the relevance of documents or other material, for example brochures, consideration should be given to whether the information is publicly available (see 2.4.4.3 Publicly Available).

Examiners should further note that account may be taken of material from the prior art base which consists of information made publicly available only through the doing of an act anywhere, whether in or out of the patent area. (See also ‘Consideration of Prior Use’ in 2.13.5.2A Balance of Probabilities, noting that the information under this sub-heading applies to all re-examinations).

Material may also be provided in the form of a declaration or as hearsay evidence and 3.5.1.1 Written Evidence and Declarations and 3.5.2 Admissibility of Evidence provide some guidance in this regard.

Where examiners are in doubt as to whether material meets the necessary prior art requirements they should consult Patent Oppositions.

Incorrect Translation of Documents

**Note:** The information in this part only applies to translations filed after 25 September 2019.

Where a document accompanying a re-examination request is not in English, the person making the request is required to provide a translation (see 2.22.4.2 Re-Examination Request).

In this situation, examiners should determine from the outset whether they have any doubts about the accuracy of the translation of a document. Examiners are not required to determine whether the document is a citation, but whether the translation appears to be incorrect (e.g. lack of continuity). If examiners consider that the translation is incorrect, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, then the person who made the re-examination request should be asked to file either:

- a corrected translation of the document and a certificate of verification for the corrected translation; or
2.22.4.4 Re-Examination in Light of the Traditional Knowledge Digital Library (TKDL)

- a certificate of verification for the translation.

Examiners should email Patent Oppositions (ohl@ipaustralia.gov.au) asking for a corrected translation and/or certificate of verification to be obtained from the person who made the re-examination request under the provisions of reg 22.15A. The email should clearly identify the relevant document(s). Patent Oppositions will issue a notification to the person and create a diary entry of the 2 month response date.

The re-examination process should in the meantime be placed on hold. Where no response is received in 2 months, re-examination should be carried out on the basis of the other documents identified in the re-examination request. Where the 'incorrect' translation is the only document, examiners should consult Patent Oppositions.

Modified Date: 19 December 2016

2.22.4.4 Re-Examination in Light of the Traditional Knowledge Digital Library (TKDL)

The TKDL (http://www.tkdl.res.in/) is an Indian digital knowledge repository of traditional knowledge. It includes information about medicinal plants and their formulations as used in traditional Indian systems of medicine.

The database was established in 2001 as a collaboration between the Council of Scientific and Industrial Research (CSIR) and the Department of Ayurveda, Yoga, Naturopathy, Unani, Siddha and Homeopathy. The database contains information on about 250,000 medicinal formulations (in 2019).

IP Australia and TKDL entered into an access agreement in 2011. Under the agreement, IP Australia has access to the database for searching purposes. Additionally, TKDL staff can advise IP Australia of TKDL documents they consider relevant to the patentability of an application that has been advertised as accepted. The notification will be sent to Patent Oppositions in the form of an email or a letter.

The email/letter will be addressed to the Assistant General Manager (OEP) and will, at least, contain the Australian patent/application number, relevant patent claim numbers and the TKDL Database Accession number.

Patent Oppositions will acknowledge receiving of the notice of relevant documents. The Commissioner will then decide if re-examination is warranted, based on the TKDL documents. If it is decided that a re-examination is not necessary, TKDL still have the option of requesting re-examination under sec 97(2).
2.22.5 Re-Examination Report

Modified Date: 19 December 2013

2.22.5.1 Initial Report

Re-examination will only be instigated at the discretion of the Commissioner if an adverse report is to issue. Consequently, the report will only refer to documents which give rise to an objection.

In contrast, where the patentee or a third party requests re-examination, the Commissioner must re-examine the patent. In these circumstances, the report will address all documents provided in the request and should include positive or negative statements regarding each claim. (It is possible that the report will be positive in respect of every claim). However, examiners need only report in detail on those documents found to be relevant, or discussed as being relevant by the person making the request. Any documents not considered to be relevant and not discussed as being relevant by the person making the request may be grouped together and addressed in terms of a positive statement.

A re-examination report should state that the application or patent has been re-examined, outline the findings and, in the case of an adverse report, give the applicant or patentee a period of 2 months from the date of the report to respond.

The initial re-examination report must take into account any information or submissions on file, including any provided prior to acceptance, or in evidence filed during opposition. Areas of doubt should be resolved, wherever possible, before issuing a report. The report must give sufficient detail of the nature of the objection and the examiner's consideration of any available information to enable the applicant or patentee to address the issues in as few responses as possible. An adverse report should explicitly identify each claim that is rendered either not novel or lacking an inventive/innovative step. The standard required for an adverse report is the same as the third report standard.

All re-examination reports, both adverse and non-adverse, must be supervised by a senior examiner (see 2.22.5.7 Supervision of Reports). The practice outlined in 2.22.7 Copy of Report on Re-Examination should also be followed.

Note: For re-examination of patent applications prior to grant, examiners should ensure that a bar to grant is in place by completing the 'Deferment of Grant Details' box in the 'Examination Details' screen in PAMS.
2.22.5.2 Statement under Section 99 or Section 101H

Where an adverse re-examination report has been issued, the applicant or patentee may, within a period of 2 months after the day on which the report was sent:

- file a statement under sec 99 (or sec 101H for innovation patents) that disputes the findings of the report;
- amend the complete specification either voluntarily or as a result of a direction under sec 106 or sec 107 to amend; or
- do both of the above.

2.22.5.3 Copy of the Statement under Section 99 or Section 101H

A copy of the statement under sec 99 or sec 101H must be given to:

- an opponent in the case of re-examination under sec 97(1) of an application which is under opposition;
- a person who requests re-examination if that person is not the patentee; and
- the court, if a prescribed court directed the Commissioner to re-examine the patent under sec 97(3) or sec 101K(1).

2.22.5.4 Subsequent Adverse Reports

If an applicant or patentee does not respond to a re-examination report, the Commissioner is likely to set the matter for hearing with a view to refuse the application or revoke the patent (see 2.22.8 Refusal to Grant a Patent Following Re-Examination and 2.22.9 Revocation of Patent Following Re-Examination). However, in some circumstances the Commissioner may
choose to issue a subsequent re-examination report, rather than head directly to refusal or revocation. These include:

- where an applicant or patentee has made a reasonable attempt to respond to the initial re-examination report (either by way of submissions or proposed amendments), but where there are still some issues outstanding. In this situation another re-examination report can be issued.

Where a subsequent re-examination report is based on a sec 99 or sec 101H statement by the applicant or patentee that was not accompanied by a request for leave to amend the complete specification, the report should address all the arguments raised in the statement.

Where a subsequent re-examination report is to be issued and the applicant or patentee has requested leave to amend the complete specification, then the practice of 2.22.5.5 Proposed Amendments are Allowable or 2.22.5.6 Proposed Amendments are not Allowable should be followed as appropriate.

- where an applicant or patentee advises the Commissioner in writing that they intend to prosecute the application and can provide satisfactory reasons why they have been unable to meet the 2 month response deadline, despite taking all reasonable steps to do so.

Consequential requests for further time to respond to a re-examination report will be considered by Patent Oppositions. If appropriate, Patent Oppositions will issue another re-examination report with a new 2 month response time.

If subsequent re-examination reports are issued, similar considerations as outlined in 2.22.5.1 Initial Report apply. In particular, the report must be supervised by a senior examiner or supervising examiner depending on the circumstances and Patent Oppositions consulted before the report is issued (see 2.22.5.7 Supervision of Reports).

**Note:** The timeframe for actioning a response to a re-examination report is within 20 working days from the date of receiving the response (in accordance with the Customer Service Charter).

**Note:** There is no specific legislative provision for the Commissioner to issue further re-examination reports in response to a submission, or to extend the time to respond to a re-examination report (except under sec 223). Instead, the subsequent re-examination report is a completely new re-examination action, re-starting the re-examination process and with its own 2 month response deadline.

This subsequent re-examination report provides the applicant or patentee with another opportunity to overcome the objections raised in the previous re-examination report.
2.22.5.5 Proposed Amendments are Allowable

However, it is only issued on the understanding that the applicant or patentee is genuinely attempting to address the objections as expeditiously as possible.

Re-examination is intended as an efficient legislative means to dispose of invalid claims. It is inconsistent with this scheme to have protracted debates on the same issues over multiple re-examination reports.

However, issuing subsequent re-examination reports would not be appropriate in the following situations:

- in the case of re-examination directed by a prescribed court (sec 97(3) and sec 101K(1)); and

- in the case of re-examination during an opposition. In this circumstance, the Assistant General Manager (OEP) should be consulted prior to issuing a subsequent re-examination report.

2.22.5.5 Proposed Amendments are Allowable

Where a response to a re-examination report includes a request for leave to amend the specification, the Commissioner must report on the request according to sec 104(2) and reg 10.2(1). Where the proposed amendments are allowable and overcome the issues raised in the re-examination report, the procedure of 2.22.6.2 Conclusion of Re-Examination Otherwise is to be followed.

Where the amendments are allowable, but do not overcome the objections outlined in the re-examination report, examiners should consider issuing a subsequent re-examination report. The report must be supervised by a senior examiner or supervising examiner depending on the circumstances and Patent Oppositions consulted before the report is issued (see 2.22.5.7 Supervision of Reports).

Issuing subsequent re-examination reports after proposed amendments have been filed is distinctly different from issuing further examination reports on a standard patent application or innovation patent after proposed amendments have been filed. For further examination reports, the Commissioner should report as if each proposed amendment had been made. In contrast, in the case of a report in a subsequent re-examination action, there is no legislative basis for reporting as if each proposed amendment had been made.

Therefore, in this situation any subsequent adverse re-examination report should:
2.22.5.6 Proposed Amendments are not Allowable

- formally maintain any outstanding issues that were raised in the previous report and which were not overcome by the applicant's or patentee's statement under sec 99 or sec 101H (by reproduction of the text of the objections, or by reference to the report); and

- acknowledge that, although the proposed amendments are allowable, they (and any statement under sec 99 or sec 101H) do not overcome the issues raised in the previous re-examination report, giving appropriate explanations.

Leave to amend should not be formally granted until the issues raised in the re-examination report have been overcome, and no further issues arise as a result of the proposed amendments. Such practice:

- expedites the re-examination process as much as possible. Awaiting allowance of the amendments would interrupt the process, as a subsequent report could not be issued and new amendments proposed until the previous amendments had been advertised and allowed; and

- removes the need for the applicant or patentee to file a new request for leave to amend after each re-examination report is issued (with the accompanying fee).

Modified Date: 01 October 2015

2.22.5.6 Proposed Amendments are not Allowable

Where a response to a re-examination report includes a request for leave to amend the specification, and the amendments are not allowable, the report on the request for leave to amend under sec 104(2) and reg 10.2(1) should proceed as a separate action from the re-examination process. Thus, any adverse report on the allowability of the voluntary amendments should not comment on the substantive issues that were raised in the re-examination report. A subsequent re-examination report should not be dispatched until the allowability issue has been resolved. In particular, examiners should not issue a re-examination report on the specification as proposed to be amended, if the amendments are not allowable.

Where an adverse report on the amendments is issued, the applicant or patentee is given 1 month in which to respond and informed that if no response is received within this time, the Commissioner may set the matter for a hearing to consider concurrently:

- refusal or revocation of the patent or patent application on the basis of the re-examination report; and
2.22.5.7 Supervision of Reports

- refusal of the request for leave to amend on the basis of the adverse report under reg 10.2(1).

If a response to an adverse report on the allowability is received and a subsequent adverse report is warranted, then a further month should be given for a response. The adverse report should also include the above comments.

Once allowable amendments have been filed, the procedures outlined in 2.22.5 Proposed Amendments are Allowable should be followed.

**Note:** Patent Oppositions should be consulted before any adverse report on the allowability of the voluntary amendments is issued.

Re-examination reports are to be supervised by a senior examiner (or if the report is done by a senior examiner, peer-reviewed by another senior examiner). This applies to both adverse and non-adverse reports, apart from third and higher adverse reports (see below). An email is then sent to Patent Oppositions (email to ohl@ipaustralia.gov.au) advising that supervision is complete. Patent Oppositions will perform an editorial review to ensure that all reports are broadly consistent in style. Once the examiner has made any changes directed by Patent Oppositions, the report is dispatched in the usual manner. However, Patent Oppositions must also be advised of the date of issue, as per 2.22.7 Copy of Report on Re-Examination.

If a third adverse report is to be issued, this is to be considered by a supervising examiner. If the supervising examiner agrees that there are valid issues and that the arguments have reached an impasse, the case should be referred to the Assistant General Manager (OEP) to determine whether the matter is best progressed by way of a hearing.

Fourth adverse reports dealing with substantive problems must be reviewed by Patent Oppositions before being dispatched, to determine whether refusal or revocation action should be initiated instead.

It should be noted that it is the overall number of reports that have been issued since the initial re-examination report that is counted, regardless of whether they were strictly adverse re-examination reports, or adverse reports on sec 104 amendments filed in response to a previous re-examination report.
2.22.6 Completion of Re-Examination Process

Modified Date: 01 October 2015

2.22.6.1 Completion of Re-Examination in an Opposition Proceeding

Regulation 9.5 defines when re-examination is "completed" in relation to re-examination under sec 97(1). In practice, this regulation is only relevant when re-examination occurs in the context of an opposition proceeding.

Where re-examination is "completed" according to reg 9.5, some or all of the issues raised in the re-examination report may remain outstanding. Completion will either result in a further re-examination action being instigated, or in the opposition re-commencing. Patent Oppositions should be consulted before taking any further action.

2.22.6.2 Conclusion of Re-Examination Otherwise

In this topic:

Regulation 9.5 (completion of re-examination) only applies to re-examination under sec 97(1) and is only of relevance if re-examination was conducted in opposition proceedings. Otherwise, the legislation does not define exactly when re-examination has been "completed". The following information relates to re-examination outside of opposition proceedings.

After issuing a re-examination report and receiving a statement under sec 99 or sec 101H, the re-examination action per se has concluded.

Issues Raised in Re-Examination Report Not Overcome

In this situation the Commissioner has the following options:
• set the matter for refusal or revocation - see 2.22.8 Refusal to Grant a Patent Following Re-Examination and 2.22.9 Revocation of Patent Following Re-Examination; or

• issue subsequent re-examination reports, i.e. commence a further re-examination action - see 2.22.5.4 Subsequent Adverse Reports; or

• issue an adverse report on the allowability of amendments - see 2.22.5.6 Proposed Amendments are not Allowable.

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**Issues Raised in Re-Examination Report Overcome**

If the statement under sec 99 or sec 101H, or the proposed amendments, overcome the issues raised in the re-examination report, and do not give rise to any further issues (including non-allowability of amendments), examiners should proceed as follows.

If there are no proposed amendments, examiners are to write to the applicant or patentee and inform them that the statement under sec 99 (in the case of a standard patent) or sec 101H (in the case of an innovation patent) has addressed all of the issues raised in the re-examination report and that the re-examination has now concluded. In the case of an application for a standard patent, the applicant should be informed that the patent will be granted pursuant to sec 61 in due course. (This advice is a courtesy only and is not a legislative requirement).

If there are proposed amendments, examiners are to write to the applicant or patentee and inform them that once the amendments have been allowed, the objections raised in the re-examination report will be overcome. In the case of an application for a standard patent, the applicant should be informed that the patent will then be granted pursuant to sec 61 in due course. (This advice is a courtesy only and is not a legislative requirement). For processing of the amendments, see 5.15.2.7 Allowing Voluntary Sec 104 Amendments Filed During Re-Examination Process.

**Note:** When completing the sec 104 voluntary allowance form for amendments to a granted patent, examiners should check the box relating to relevant proceedings pending. They are not required to request sec 112 information from the patentee, provided this information was requested in the ‘intend to re-examine’ letter sent at the commencement of re-examination (see 2.22.3.2 Post-Grant (Standard and Innovation Patents)).

After any amendments have finally been allowed, Patent Oppositions will inform the applicant or patentee that the issues raised in the re-examination report have been
overcome, and that the re-examination has concluded. In the case of an application for a standard patent, the applicant will be informed that the patent will be granted pursuant to sec 61 in due course. (This advice is a courtesy only and is not a legislative requirement).

Modified Date: 01 June 2015

2.22.7 Copy of Report on Re-Examination

Following supervision of a re-examination report (as per 2.22.5.7 Supervision of Adverse Reports), examiners should send the re-examination report to the applicant or patentee as per normal. They should also email Patent Oppositions (email to ohl@ipaustralia.gov.au) and provide the following details:

- case number; and
- date that the report was issued.

Patent Oppositions will create a diary entry of the 2 month response date (if appropriate) and then send a copy of the report to:

- the opponent following re-examination under the circumstances of opposition; or
- the person who requested re-examination after grant of the patent, if that person is not the patentee.

A similar practice is to be followed if a subsequent re-examination report is issued in light of the patentee’s statement under sec 99 or sec 101H. The third party will be advised by Patent Oppositions that the Commissioner has decided to re-examine the patent again and sent a copy of the new re-examination report. Sending the third party a copy of the initial re-examination report is a statutory requirement (reg 9.3(1)). Subsequent reports are initiated by the Commissioner and are therefore not covered by this regulation. They are, however, sent to the third party as a matter of courtesy, as are any amendments or statements under sec 99 (or sec 101H) filed by the patentee.

Any material sent to the third party should be accompanied by a covering letter (generated by Patent Oppositions) informing them that:

- this material is being sent to them as a matter of courtesy only (or as a consequence of reg 9.3(1)); and
- that they have no right to any further involvement in the re-examination process (such as filing submissions for the examiner to consider, to appear at any refusal or revocation hearing, or right of appeal of any decision the Commissioner may
2.22.8.1 Decision by the Commissioner

subsequently make), but that the Commissioner will endeavour to forward to them any relevant correspondence concerning the re-examination process.

Where there are proposed amendments, the opponent needs to be additionally informed that they have the right to oppose the amendments under sec 104(4) once leave to amend has been granted and advertised in the Official Journal. However, they should be monitoring the Journal themselves to ensure that they know when leave has been granted and not relying on the Commissioner to advise them when advertisement will occur.

2.22.8 Refusal to Grant a Patent Following Re-examination

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Modified Date: 01 June 2012

2.22.8.1 Decision by the Commissioner

In the case of re-examination of an application under sec 97(1), where an adverse report has been made, the Commissioner may refuse to grant the patent on the application (sec 100A). The Commissioner must not refuse to grant the patent unless the Commissioner:

- has given the applicant a reasonable opportunity to be heard; and
- has, where appropriate, given the applicant a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the applicant has failed to do so (note also sec 107).

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Modified Date: 15 April 2013

2.22.8.2 Appeal by the Applicant

The applicant may appeal a decision to refuse to grant the patent to the Federal Court.

However, before refusal action is initiated, regard should be given to the practice outlined in 2.22.5.4 Subsequent Adverse Reports.

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2.22.9 Revocation of Patent Following Re-examination

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.22.9.1 Decision by the Commissioner

In the case of re-examination of a granted patent, where an adverse report has been made, the Commissioner may revoke the patent either wholly or in so far as it relates to a particular claim. The Commissioner will give notice in writing of the revocation. The Commissioner must not revoke a patent unless the Commissioner:

- has given the patentee a reasonable opportunity to be heard; and
- has, where appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the patentee has failed to do so (note also sec 106(1) and sec 101J(3)).

However, before revocation action is initiated, regard should be given to the practice outlined in 2.22.5.4 Subsequent Adverse Reports.

In particular, the allowability of any amendments filed during the re-examination process must be considered and dealt with prior to any decision to revoke the patent (Commissioner of Patents v Emperor Sports Pty Ltd [2006] FCAFC 26; 67 IPR 488).

2.22.9.2 Where Proceedings are Pending

If relevant proceedings in relation to the patent are pending, then the patent must not be revoked as a result of re-examination.

2.22.9.3 Appeal by the Patentee

The patentee may appeal a decision to revoke the patent to the Federal Court.
2.22.9.4 Appeal by a Third Party

A third party has no right to appeal a decision by the Commissioner on re-examination to the Federal Court. Revocation proceedings under sec 138 are the only course of action available to a third party.

Modified Date: 04 October 2016

2.22 Annex B - Intention to Re-Examine Letter

Intention to Re-Examine

Patent Details

Patent No.: 20XXXXXXXX

Patentee(s): ABC

Your reference: 1234

Earliest Priority Date: 3 February 2010

Examination Request Date: 3 January 2012

I am writing to inform you that the Commissioner considers that re-examination of the above patent is warranted and intends to re-examine the above patent.

Actions you can take

Under Section 97(4), where relevant proceedings in relation to a patent are pending, the Commissioner must not re-examine the complete specification in relation to the patent.

Please advise the Commissioner of any relevant proceedings or court actions within seven (7) days of the date of this letter.

If no reply to this letter is received within this time, it will be considered that there are no relevant proceedings and the patent will be re-examined and a re-examination report will issue in due course. Under Section 97(5), where the Commissioner has started to re-examine the complete specification and relevant proceedings in relation to a patent are started, the Commissioner must not continue the re-examination. You are therefore requested to inform the Commissioner of any such proceedings immediately that they are started.
2.23 Amendments

Modified Date: 01 February 2013

2.23.1 Introduction

Chapter 10 of the Act provides for the amendment of certain documents concerning a patent application or a patent. This part provides guidance on amendment actions in respect of a patent request or complete specification, or any other filed document, requested under sec 104.

2.23.2 General Provisions - Section 104 Amendments

Modified Date: 01 February 2013

2.23.2.1 Who May Request Amendment

Under sec 104, an applicant or patentee may ask for leave to amend a patent request, complete specification or any other filed document, for any purpose including (but not limited to) removing a lawful ground of objection or correcting a clerical error or an obvious mistake.

Only the applicant, in the case of an application, or the patentee, in the case of a patent, may ask for leave to amend under sec 104. Where the request is not made by the applicant or patentee, examiners should issue an adverse report referring to the ineligibility of the person requesting amendment. Unless it is absolutely clear that the request cannot be amended to correct the eligibility problem, other aspects of the request should also be reported upon.
2.23.2.2 When Amendment May Be Requested

Leave to amend under sec 104 may be requested at any time, either before a request for examination is made, during examination or after acceptance or grant. Different provisions apply depending on when leave to amend is requested and an amendment request fee applies in particular circumstances (see 2.23.4.1 Fees Required for Amendment Requests).

Where amendment of a lapsed application is requested (such as in relation to an assignment) the case should be referred to ERA.

Amendments in Anticipation

In the case of an application for a standard patent, where a request for examination has not been made and the applicant files a request for leave to amend on or after 1 January 2012, the applicant may ask the Commissioner to defer consideration of the proposed amendments until substantive examination of the application commences (reg 10.6A). The applicant will be taken to have asked the Commissioner to defer consideration of the amendments if the heading “Amendments in anticipation of examination” or similar is used in the correspondence accompanying the proposed amendments.

In this situation, the request for leave to amend is taken to be filed immediately after the applicant files any subsequent request for examination (reg 10.6A(2)) and consequently no fee is payable.

Amendments in Transit

Where amendments in anticipation are filed after a request for examination is made, but examination has not yet commenced, attorneys and applicants are requested to contact ERA and forewarn them of the amendments. ERA will then place a case note on the file drawing attention to the amendments being in transit.

Modified Date: 03 March 2014

Modified Date: 01 August 2018
2.23.2.3 What Documents Can Be Amended

An applicant or patentee can ask the Commissioner for leave to amend the relevant patent request or complete specification, or any other filed document (sec 104(1)). The category ‘any other filed document’ includes notices of entitlement and provisional specifications.

See also 2.23.13 Amendment of a Patent Request or of Other Filed Documents.

Modified Date: 03 December 2018

2.23.2.4 Withdrawal of Amendment Request

A request for leave to amend may be withdrawn by a request in writing from the applicant at any time up until allowance. Withdrawal of a request is considered to be termination, not amendment, of the request, and no fee is payable.

Amendments cannot be cancelled once they have been allowed, unless a new request to do so is subsequently filed and allowed. Where such a request is made after acceptance of an application, examiners must consider whether a reversal to the original text is allowable, since broadening the scope of a claim which was previously narrowed would, except for the purposes of correcting an obvious mistake or clerical error, be contrary to sec 102(2)(a).

Modified Date: 01 February 2013

2.23.2.5 Multiple Requests for Amendment

In certain circumstances, several separate requests for voluntary amendment may be current in relation to an application or patent. These separate requests are distinguishable from situations where a statement of proposed amendments is amended by the filing of a further statement of proposed amendments to the earlier statement, before leave is granted in respect of the earlier statement (see reg 10.1(5)).

Where two or more requests under sec 104 are made in respect of entirely separate matters (for example, where each request deals with a clerical error on a separate page), examination of each request may proceed separately and regardless of the allowance of the other request or requests.

Where two or more requests under sec 104 are made, and the allowance of any one request may affect the part of the specification in which an amendment proposed by another request
is to be made, or where there is any other interdependence, the later request or requests
should not be examined until the allowance (or formal withdrawal) of the earlier request, and
the person who made the later request or requests should be informed of that deferment
accordingly.

In some circumstances, examiners may find it advisable to notify the applicant or patentee of
the procedure proposed to be adopted and to suggest that an alternative procedure is for the
individual requests to be withdrawn and that a consolidated single request be filed within a
specified period.

**Note:** Where, after a protracted period, there is no response to an adverse report on a
voluntary amendment, examiners should not assume that the amendment request has been
abandoned or withdrawn, unless there is evidence on file to the contrary.

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**2.23.2.6 National Phase Applications**

Section 2.20.10 Amendments and Corrections Prior to Examination outlines the procedures
for determining whether translations, Article 19 amendments and Article 34 amendments are
required to be examined and when examination can commence for national phase
applications.

Although the Act does not provide any specific time limits within which action on a voluntary
request to amend must be completed, examiners should deal with such requests promptly
and in accordance with the Customer Service Charter Timeliness Guidelines. Usually a
voluntary request to amend is made for a specific reason, and it may be assumed that it is in
the applicant’s or patentee’s interest to expedite proceedings. Examiners should note that
voluntary amendment requests made, and amendments considered allowable, before a
patent request and complete specification are accepted are not subject to opposition and are
allowed immediately. Therefore such requests should be actioned promptly.
2.23.2.8 Unfinalised Proposed Amendments Prior to Examination

Note: In this part, a request for leave to amend other than in anticipation of, or response to, an examination report, is termed a voluntary request and the proposed amendments thereof voluntary amendments.

In this topic:

Request for Voluntary Amendment

Where an applicant:

- files a voluntary request for leave to amend (that is not indicated as being in anticipation) before requesting examination; or

- files a voluntary request for leave to amend at the same time or after a request for examination has been made, and indicates that the amendment is not to be treated as in anticipation (see below);

COG will forward the case file to the relevant examination section. The voluntary amendment is to be processed independently of substantive examination and either an adverse sec 104 report should issue, or the amendment allowed forthwith.

If a substantive first report is to issue before leave to amend is granted, that examination report should be based on the specification as proposed to be amended and refer to the latest report issued on the amendment. If further amendments are proposed in response to the substantive examination report, then these are taken to supersede the voluntary request and any further consideration of the amendments is to be subsumed into the substantive examination.

Note: Where examiners receive a voluntary amendment request and a request for examination has been filed, they may, where they consider it efficient to do so, expedite substantive examination of the application. Consideration of the voluntary amendment is to continue separately, unless amendments are proposed in response to the substantive examination report as indicated above.
Amendments in Anticipation of Examination

Where an applicant files a request for leave to amend after a request for examination has been made, and it is not a voluntary request (see above), consideration of the amendment is to be subsumed into substantive examination. Consequently, if an examination report has already been dispatched and is awaiting a response, a further report taking the amendment into account should be issued.

For standard patent applications, where an applicant files a request for leave to amend on or after 1 January 2012, and before a request for examination has been made, the applicant may defer consideration of the proposed amendments until substantive examination of the application commences (see 2.23.2.2 When Amendment May be Requested).

Amendments Relating to Micro-Organism Deposits

Amendments which have the effect of including details of a micro-organism deposit should be allowed forthwith. For further information see 2.7.5.1 Sections 104 and 223 - Insertion of Section 6(c) Information.

2.23.3 Formalities

Under reg 10.1(1), an applicant or patentee may ask the Commissioner for leave to amend by filing a request in an approved form, together with a statement of proposed amendments. A fee may also be payable (see 2.23.4.1 Fees Required for Amendment Requests).

The requirement to file a request for leave to amend is taken to have been complied with in the case of amendments filed in response to an objection in an examiner's report, or in anticipation of examination (reg 10.1(1A)).
2.23.3.2 The Document to be Amended

Although there is an approved form for filing a request to amend (Form P/00/039), it is not necessary to use the specific form. Provided the relevant information can be ascertained from the correspondence, the amendment will be regarded as having met the requirements. Hence before acceptance, it merely has to be clear that the applicant is requesting leave to amend the specification. After a patent has been granted, the patentee is required to state that no relevant proceedings are pending in respect of the patent (see 2.23.3.5 Relevant Proceedings Pending). If there is any exclusive licensee or mortgagee of the patent, such person will also need to give consent to the amendment (see 2.23.3.6 Consent of Exclusive Licensee or Mortgagee Required).

Modified Date: 01 February 2013

2.23.3.2 The Document to be Amended

The request should clearly indicate the document to be amended. When an amendment is directed to a specification, and there are several versions of the specification, or earlier requests for amendment of the specification, on file, examiners should ensure that the amendment is directed to the appropriate document. Where a previous request under sec 104 has been allowed, a further request must be directed to the specification incorporating the allowed amendments. Similarly, after acceptance of a patent application, a request must be directed to the specification incorporating the amendments allowed at acceptance.

Modified Date: 01 February 2013

2.23.3.3 When Amendments are OPI

Where a specification is amended prior to becoming open to public inspection (OPI), then upon notification that the specification is OPI, both the unamended and the amended forms of the specification are OPI. Similarly, where a specification is amended after notification that it is OPI, the amended form of the specification is also OPI. Proposed or requested amendments are OPI when the complete specification becomes OPI, whether or not they have been allowed.

Modified Date: 01 October 2015
2.23.3.4 Amendments Arising Out of Decisions or Directions Under Appeal

Where a decision or direction of the Commissioner (which for the majority of cases will have issued in an opposition to grant under sec 59) has been appealed to the Court, an amendment of the complete specification is not allowable, pursuant to reg 10.2C(6) and sec 112A. Consequently, if an appeal is pending and the applicant files a request to amend the specification under sec 104, that request will be refused. Where it appears that the request has not been refused, the matter should be referred to Patent Oppositions.

Once the appeal has been finalised, the applicant may either file the previously refused request, or file a new request. These later amendment requests will be processed according to the usual procedures.

Case Law

The application of sec 112A was considered by the Federal Court in Suntory Holdings Ltd v Commissioner of Patents [2013] FCA 999.

An opposition to the grant of a patent was heard by the Commissioner and the Commissioner’s decision appealed by the opponent. Subsequent to the lodgement of the appeal, the applicant requested leave to amend the complete specification under sec 104. The Commissioner refused the request on the grounds that sec 112A applied.

The Federal Court upheld this decision. The Court concluded that as the amendment had not been allowed at the time the opponent lodged the appeal, sec 112A applies. Therefore the complete specification must not be amended under sec 104 and the Commissioner can refuse the amendment.

2.23.3.5 Relevant Proceedings Pending

Note: When checking for relevant proceedings pending during re-examination, examiners are to follow the procedures outlined in 2.22.3.2 Post-Grant (Standard and Innovation Patents) and 2.22.6.2 Conclusion of Re-Examination Otherwise.
2.23.3.5 Relevant Proceedings Pending

Note: Where an amendment is in respect of a granted innovation patent, examiners are to follow the procedures outlined in 2.31.4.7 Amendments.

An amendment to the specification of a patent (that is, a granted patent and not merely an accepted application) cannot be allowed if relevant proceedings are pending in relation to the patent (sec 112). When requesting an amendment, the patentee must declare that there are no relevant proceedings pending.

If no indication is given by the patentee as to whether relevant proceedings are pending, examiners are to request that the patentee provide the relevant statement within one month (reg 10.1(4)), in addition to reporting on other aspects of the amendment request (if appropriate).

Similar procedures apply at subsequent report stages where the patentee does not include a current statement. Leave to amend is not to be granted before a current indication is given that no relevant proceedings are pending. If a reg 10.1(4) request is not complied with within one month, the amendment request must be refused (reg 10.4(c)). If a statement is received after the one month period has expired, the amendments must not be allowed unless an extension of time has been granted.

An indication in an amendment request, or separate statement, that no relevant proceedings are pending only applies at the time of filing the request or statement and may not be correct when the amendment is finally in order for allowance.

Moreover, if a request is made to amend the complete specification of an application (in which case the provisions of sec 112 are not appropriate), by the time the request is in order for allowance the application may have become a granted patent. In this situation, a declaration that no relevant proceedings are pending would not have been made at all.

If the request specifies, or the patentee during examination of the request indicates, that an action is pending, no further examination of the request is to take place. The matter should be referred to Patent Oppositions who will refuse the request.

Case Law

Atlantis Corporation Pty Ltd v Schindler (No. 3) [2000] FCA 1758 provides some guidance on relevant proceedings. In this case the Federal Court had already decided to revoke the patent. A stay was granted to allow for the determination of amendments already filed under sec 104. It was concluded that there were no relevant proceedings pending, as the revocation proceedings had already been decided.
A decision by the Commissioner to refuse a request to amend was upheld by the Federal Court in *Suntory Holdings Ltd v Commissioner of Patents* [2013] FCA 999 (see 2.23.3.4 Amendments Arising Out of Decisions or Directions Under Appeal).

**2.23.3.6 Consent of Exclusive Licensee or Mortgagee Required**

**Overview**

A registered mortgagee or exclusive licensee must consent in writing to an amendment of the complete specification of a patent, otherwise the amendment is not allowable (sec 103). The consent may be part of the request to amend, or may be a separate document filed at the time of the request or at a later date. [Section 213](#), which allows certain documents to be signed by a patent attorney, does not apply to such consents. It should be noted that a consent is not required in the case of a non-exclusive licensee.

A consent is also not required in the case of licences or mortgages that have not (or not yet) been registered. If a consent is received from a person alleging entitlement to the patent, and that entitlement has not been entered on the Register, the alleged consent may be ignored and need not be referred to in a report on the request to amend.

**Checking for Exclusive Licensee or Mortgagee**

At every report stage on a request to amend the specification of a patent, examiners are to check the Register for any registered mortgagee or exclusive licensee.

A check for whether there is a registered mortgagee or exclusive licensee can be done by following the procedure outlined in 5.13.6 How to Check for a Mortgagee or Exclusive Licensee.
2.23.3.7 Requirements in Relation to Providing Reasons for Proposed Amendments

**Examination Practice**

Where examiners are aware that a consent is required, but has not been given, the amendment request should nevertheless be examined and a report issued. The report should include, in addition to any adverse comments regarding allowability, a statement that leave to amend will not be granted unless either a consent, in writing, to the amendment is supplied, or a direction by the Commissioner under [sec 103(2)] to dispense with such a consent is given.

Before allowing amendments to a patent, examiners should confirm whether a consent is required. There may be, for example, situations where an exclusive licence or mortgage is registered after leave has been granted and before allowance of the amendments, in which case a consent from the registered party is required before the amendments can be allowed.

Where a consent has been filed, it is to be taken as extending to the amendment request, unless further amendments filed subsequent to the consent substantially change the overall nature of the amendments. If the latter occurs, an additional consent will be required and is to be requested by examiners.

**2.23.3.7 Requirements in Relation to Providing Reasons for Proposed Amendments**

Under [reg 10.1(3)]( ), it is open to the Commissioner to require a statement of reasons for the request for leave to amend and, where appropriate, evidence in support of the request. The applicant or patentee must file these within 3 months of being requested to do so. If the applicant or patentee fails to comply with this request, the Commissioner must refuse the request for leave to amend under [reg 10.4(b)]( ).

In general, reasons will not be required. However, if the amendment contravenes [sec 102(1)] and [sec 102(2)]( ), but the applicant wishes to invoke [sec 102(3)] in regard to there being a clerical error or obvious mistake (see [2.23.10 "Clerical Error" and "Obvious Mistake"]( )), then a statement as to whichever of these pretexts is being relied upon will need to be provided by the applicant or patentee. Usually evidence in support of the request will only be necessary when the amendment is in respect of a clerical error.

Apart from where a clerical error or obvious mistake is involved, examiners are not required to have regard to any reasons given by the applicant for requesting an amendment. The
Commissioner does not have any discretion to refuse a request for amendment on the basis of deficiencies in the reasons given for requesting an amendment (New England Biolabs Inc v Commissioner of Patents & Anor [2001] FCA 787 at [53, 54]; 52 IPR 1).

The amendments must be in the form of a statement of proposed amendments (reg 10.1(1)). Where proposed amendments are included in, or intermingled with, ordinary correspondence, the statement of proposed amendments will be *prima facie* ambiguous. Thus, an objection should be taken and a separate statement of proposed amendments requested.

**Note:** The formal requirements for amendments are provided for by Schedule 3 of the Regulations, or the Patents (Formalities Requirements for Patent Documents) Determination 2019 (Formalities Determination), depending upon certain timing requirements. For further information, see 2.29 Formalities and Forms.

The relevant provisions are:
- Formalities Determination (sec 18)
- Schedule 3 (clause 5(5)) (see also reg 10.1(2)).

**Amendment Item Numbers**

The numbering of proposed amendments is an important issue since it can impact upon the integrity of the future grant.

In a statement of proposed amendments, the proposed amendments must be numbered consecutively. Where amendment items are ambiguous, such that there is doubt as to the amendment to be made, an objection should be taken. Where the application would otherwise be in order for acceptance, apart from non-consecutive amendment item numbers,
examiners may notionally renumber the statement of proposed amendments and enter the appropriate amendment number when completing the ‘Amendments Report’ screen in PAMS (screen 5 of 7) at acceptance. When this course of action is contemplated, the applicant or attorney should be contacted by phone to obtain their approval. However, where a further adverse report is to issue, the report should refer to the notional renumbering (see PERP code [G30]).

It should be noted however, that the numbering of proposed amendments need not commence with 1. If there are any earlier statements of proposed amendments which have not been finally dealt with (that is, not allowed or refused), the numbering of a new statement must be consecutive with the numbers of the previous statement.

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**Form of Amendments**

**Substitute Pages or Documents**

The applicant or patentee is required to make amendments to the specification (including drawings, graphics and photographs) by means of substituting one page or document for another page or document. Amendments made by deletions and/or insertions by specifying page and line numbering are not permitted.

An amendment of the patent request or notice of entitlement is also required to be effected by means of substitute documents or pages. However, the applicant can amend particulars that appear on the patent request without replacing the patent request (see 2.23.13.1 Amendment of Patent Request).

**Page Numbering**

Under reg 10.2(1)(a), examiners must consider whether the proposed amendments comply with Schedule 3 or the Formalities Determination. A consequence of this is that an amendment cannot be allowed in cases where pages, drawings, graphics, photographs or claims are added/deleted from the specification, without substituting renumbered subsequent pages, drawings, graphics, photographs and claims (even if the only alteration to the page is the renumbering), except in the following circumstances:

- where an amendment has the effect of adding new pages to a specification, if the extra pages are numbered alpha-numerically in accordance with where they are to be inserted, for example:
'Delete page 3, insert new pages 3 and 3A.'

- where an amendment has the effect of deleting pages of a specification, it is not necessary to renumber the subsequent pages if it is clear that the existence of missing pages is intentional. This may be effected as follows:
  - at the bottom of the page immediately preceding the omitted pages, insert words such as:
    'The next page is page xx.'
  - insert a page for the missing page, containing words such as:
    'This page is intentionally blank.'
  - where several sequential pages are missing, insert a single page containing words such as:
    'Pages xxx to yyy are intentionally blank.'
  - where an amendment results in a lack of continuity in page numbering with the abstract, it is not necessary to renumber the abstract page(s) (noting that under reg 10.3(2), the amendment of an abstract is not allowable; see 2.8.3A Amendment of Abstract).

If the pages of a specification are not consecutively numbered as a result of amendments made under Article 19 or Article 34 of the PCT, and an amendment in the national phase merely continues the previous specification format, no objection applies in respect of the incorrect numbering (see 2.20.10.2 Formality Considerations).

**Missing Pages**

In the situation where a statement of proposed amendments is provided, but amended page(s) are missing from the attorney’s correspondence, examiners should request for the missing pages to be provided, either by phone or in a further report.

The attorney may provide the missing pages without a further statement, in which case the missing pages may have a different date stamp from the earlier statement in which they are formally proposed to be amended. In this situation, an Assembly Note should be added to the case file to inform COG that the statement of proposed amendments and the amended pages are in different files in PAMS (see 5.10.11.3 Assembly).

At acceptance, examiners should enter the date on which the last statement was filed in the ‘Amendments Report’ screen in PAMS (screen 5 of 7), irrespective of whether any of the amended pages have a later date stamp.
2.23.3.8 Form Amendments Should Take

**Requirement for Marked Up Copies of the Amended Pages**

Where substitute pages or documents are filed, the applicant or patentee is required to file 2 copies of each page or document, with one copy marked to indicate the nature and location of the proposed amendments. If no marked copies are filed, and the amendments are not apparent and are difficult to find, the applicant or attorney should be contacted and asked to supply the marked copy.

It may be clearer or more convenient for the applicant or patentee to mark a copy of the original (unamended) page, rather than a copy of the amended page. If the nature and location of the amendments can be determined by this means, no objection should be taken. In addition, if the amendments are so extensive that it would be impractical to mark where the changes have been made, examiners should not object to the second copy simply being marked as "new page" or "all new".

**Providing Oral Opinions on Amendments**

Where an applicant, instead of filing a statement of proposed amendments, asks for an opinion on possible new claims, the following practice should be employed:

- any opinion provided should be confined to amendments which are minor in nature;
- comment should be limited to the precise inquiry made; and
- there must be an expectation that a formal amendment will follow quickly.

Any oral opinion must be recorded on the file.

Modified Date: 25 February 2019
2.23.3.9 Amending a Complete Specification Under Section 104 to Comply with a Regulation 3.2A Direction

Where a direction has issued under reg 3.2A as a result of the complete specification at filing being:

i. in a foreign language; or

ii. relying for its disclosure in whole or in part on a cross-reference to an earlier foreign application;

the applicant may choose to comply with the direction by filing a request to amend under sec 104. In situation (i), a proposed amendment to substitute a replacement specification (in English) for the specification as filed is required, whilst in situation (ii), a proposed amendment is required to substitute the cross-reference with appropriate pages incorporating the matter the subject of the cross-reference.

Where applicants choose to comply with a reg 3.2A direction by filing a sec 104 request to amend, they may, in addition to proposing amendments that would meet the direction, include proposed amendments to the substantive text of the complete specification.

Where the sec 104 request does not have to be advertised, the reg 3.2A direction will be complied with provided, before expiry of the applicable period for compliance specified in reg 3.2A(5), the sec 104 request is allowed and the allowed amendments overcome the formalities deficiency.

If advertisement of the request to amend is required in accordance with reg 10.5(2) (after acceptance) the direction will be complied with provided, before expiry of the applicable period for compliance specified in reg 3.2A(5), the sec 104 request is cleared for advertisement, and it is deemed that when the proposed amendments are allowed they could overcome the formalities deficiency.

In certain situations, an applicant may find it difficult to comply with a reg 3.2A direction to substitute certain pages of a specification, where there is no means of preparing pages of the required standard, without undesirably altering the substantive nature of the text. In Hewlett-Packard Company's Application (20390/76), the specification as lodged contained a program listing printed by a computer line printer. This program listing was objected to under reg 7B of the 1952 Act (equivalent to reg 3.2A). After representations from the applicant, which established that accurate reproduction of the original matter was not possible with a typewriter, a request to amend the specification under sec 77 of the 1952 Act, by deletion of the offending pages and incorporation of a reference to their availability in a US specification, was allowed.
2.23.3.10 Incorporating Amendments into the Specification

COG will incorporate all voluntary amendments into the complete specification (see 5.13.2 Examining Voluntary Sec 104 Amendments and 5.13.4 Allowing Voluntary Sec 104 Amendments).

2.23.3.11 Amendments to Amino Acid and/or Nucleotide Sequences in Electronic Form

If an applicant requests amendments to sequence listings which are filed on compact disc and form part of the specification, the normal requirements for filing amendments still apply (see 2.29.9 Requirements for Amino Acid and Nucleotide Sequences on Compact Disc or Other Electronic Means).

2.23.4 Fees

2.23.4.1 Fees Required for Amendment Requests

In this topic:

Amendments Filed Before Examination has Been Requested or After Acceptance/Certification

Amendment requests filed before examination has been requested (other than those where reg 10.6A applies, see below), and after acceptance of a standard patent application or...
2.23.4.1 Fees Required for Amendment Requests

certification of an innovation patent, are termed "voluntary amendments" and attract a fee (items 222 and 224 of Schedule 7).

Each separate request to amend an application or patent requires the payment of a fee. For guidance on what constitutes a “separate” request, examiners should refer to 2.23.5.1 Granting Leave to Amend and 2.23.5.2 Publishing a Notice of the Granting of Leave to Amend.

Where multiple voluntary amendment requests are filed and a fee has been paid for the lodging of each request then, in accordance with the Corporate Guidelines for Refunds and Waivers, the fee "cannot and may not be refunded".

If the fee has not been paid, examiners should follow the procedures outlined in 2.27.3 Fees Not Paid or Requested and not examine the request.

Deferred Consideration of Request for Amendment – Regulation 10.6A

In the case of an application for a standard patent, where a request for examination has not been made and the applicant files a request for leave to amend on or after 1 January 2012, the applicant may defer consideration of the proposed amendments until substantive examination of the application commences (reg 10.6A).

In this situation, the request for leave to amend is taken to be filed immediately after the applicant files any subsequent request for examination (reg 10.6A(2)) and consequently no fee is payable (note ‘Amendments Filed After Examination has Been Requested’ below).

Amendments Filed After Examination has Been Requested

Amendments filed, or deemed to be filed (reg 10.6A), after a request for examination has been made do not require the payment of a fee. If fees for a voluntary amendment have been paid after examination has been requested, this should be brought to the attention of COG who will automatically refund the fee as an overpayment.

Modified Date: 01 February 2013
2.23.4.2 Request to Amend Where Patent/Application is not in Force

Examination of a request for leave to amend is not required if the request applies to a patent which is not in force, or an application which has lapsed or been refused or withdrawn (see, however, 2.23.2.2 When Amendment May Be Requested).

Where the request relates to an application, whether before or after acceptance, examiners must ascertain whether the application has lapsed, or been refused or withdrawn. The continuation fee status may be checked by viewing the ‘In Force’ date on the ‘Ecase Summary’ screen in PAMS. The status of the application is also indicated on the ‘Ecase Summary’ screen.

Where the request relates to an application in a state of lapse or lapsed, examiners should follow similar procedures to those outlined in 2.13.2 Applications in a State of Lapse, or Lapsed. In accordance with the Corporate Guidelines for Refunds and Waivers (see Refunds and Waivers), no automatic refund of the fee for filing the request will be made in these circumstances.

2.23.5 Granting Leave to Amend/Allowing the Amendments

2.23.5.1 Granting Leave to Amend

Note: Only examiners with the acceptance delegation have a delegation to grant leave to amend and allow amendments under sec 104. The exceptional circumstances applying to the granting of leave to amend under sec 6(c) are outlined in 2.23.5.4 Allowing Amendments Upon Acceptance of a Patent Request and Complete Specification.

As a precursor to allowing amendments to a patent request, complete specification or other filed document, the Commissioner must grant leave to amend.

Subregulation 10.5(1) specifies several requirements for leave to be granted, namely:

- a report under reg 10.2(1) cannot be adverse;

- in the case of proposed amendments in anticipation of, or in response to, an examination report in respect of a standard patent, the amendments must be considered to remove all lawful grounds of objection to the request or specification; and
2.23.5.2 Publishing a Notice of the Granting of Leave to Amend

- in the case of proposed amendments in anticipation of, or in response to, an examination report in respect of an innovation patent, the amendments must be considered to remove all lawful grounds for revocation of the innovation patent.

For granted standard patents, examiners should also check for a statement that no relevant proceedings are pending (see 2.23.5 Relevant Proceedings Pending).

Once leave to amend has been granted, that decision cannot be reversed other than in exceptional circumstances (see 2.23.5.6 Revocation of Leave to Amend).

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2.23.5.3 Allowing Amendments After Granting Leave to Amend

In many situations where leave to amend is granted, a notice of that fact is required to be published in the Official Journal. The Minister or another person may oppose the allowance of an amendment if such a notice is given (reg 10.5(3)).

Regulation 10.5(2) specifies the circumstances where a notice is required. In particular, a notice is required when the leave to amend relates to a patent request and complete specification which have been accepted under sec 49, or a decision to certify has been made under sec 101E, and where the proposed amendment concerns either:

- a complete specification; or

- a patent request or another filed document and the proposed amendment would materially alter the meaning or scope of the request or document (note however reg 10.5(4)).

Under the provisions of reg 10.5(2), a notice regarding the grant of leave to amend is not required for a proposed amendment where the patent request and complete specification have not been accepted (standard patent), or a patent is not subject to a decision to be certified (innovation patent).

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Modified Date: 01 February 2013

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.23.5.3 Allowing Amendments After Granting Leave

Only examiners with the acceptance delegation have a delegation to grant leave to amend and allow amendments under sec 104.

If a notice publishing the granting of leave is not required for an amendment request, the proposed amendments which are the subject of that request can be allowed immediately (reg 10.6(1)).

Where a notice is published, proposed amendments which are the subject of the amendment request must be allowed when the allowance of the amendments is not opposed (reg 10.6(2)). Any opposition must be filed in the period prescribed by the Regulations.

Where allowance of the amendments is not opposed, at the end of the opposition period COG will allow the amendments and incorporate them into the specification.

Where the allowance of the amendments is opposed, the allowance or otherwise of the amendments will be determined when a decision is made on the opposition (see also 2.23.15.1 Standard Patents).

No Formal Act of Acceptance

Where an amendment has been processed as allowed (including making the amendment), but there has been no formal act of acceptance (e.g. for paper cases a form has not been signed), then the amendment may still have been properly made. 2.26.4.7 Implied Delegations provides guidance on the appropriate course of action.

Amendments Affecting Register

Where an amendment is proposed after acceptance that would have an effect on what is recorded on the Register, such as an amendment to the title or to a patent request, examiners should immediately ask the Acceptance Unit to set a bar to grant flag in PAMS. This ensures grant does not occur until the amendment has been allowed or otherwise finally dealt with.
2.23.5.4 Allowing Amendments Upon Acceptance of a Patent Request and Complete Specification

Where proposed amendments are in anticipation of, or in response to, an examination report for a standard patent application, once leave to amend is granted, the amendments must be allowed immediately before acceptance. In these circumstances, the Commissioner grants leave to amend, allows the amendments and then accepts the patent request and complete specification.

An exception to the above procedure arises when the amendments relate to micro-organism deposit requirements (sec 6(c)). Any such amendments, even though they are in anticipation of, or in response to, an examination report, can be allowed immediately after granting leave, and separately from acceptance of the application (see 2.7.5 Amendments to Insert Section 6(c) Information and Extensions of Time Therefor).

2.23.5.5 Allowing Amendments Immediately Prior to OPI

A request to amend the patent request for a standard patent application to:

- convert the application to an application for an innovation patent; or
- change the priority date to a later one;

cannot be allowed until after the date on which the application is advertised in the Official Journal as being OPI, if the request to amend was filed in the three week period before that date (Chapter 10 of the Regulations).

2.23.5.6 Revocation of Leave to Amend
Examiners are to ensure that as far as practicable, all matters bearing on the allowance of an amendment are considered fully prior to granting leave. Where an issue comes to an examiner's attention after leave to amend has been granted, leave to amend cannot be reversed, undone or re-done other than in exceptional circumstances.

If an application is accepted on or after 15 April 2013, and the patent has not yet been granted, acceptance may be revoked under sec 50A (see 2.15.5 Revocation of Acceptance). Similarly, certification of an innovation patent can be revoked under sec 101EA if there are no relevant proceedings pending (see 2.31.1.6 Certification). In either case, the granting of leave and allowance of amendments that occurred at the same time is also revoked by virtue of reg 10.6B.

In other circumstances, if leave to amend is granted on or after 15 April 2013, the granting of leave may be revoked under reg 10.6B(3) if the Commissioner is satisfied that:

a. leave to amend should not have been granted, taking into account all of the circumstances that existed when leave was granted (whether or not the Commissioner knew the circumstances existed); and

b. it is reasonable to revoke the grant and allowance of the amendment (if applicable), taking into account all of the circumstances; and

c. there are no relevant proceedings pending.

If revoked:

a. leave to amend is taken to never have been granted; and

b. if allowed under reg 10.6, the amendment is taken not to have been allowed; and

c. the Commissioner must continue to examine and report on the amendment in accordance with reg 10.2(1); and

d. reg 10.5 and reg 10.6 continue to apply in relation to the amendment.

The power to revoke a grant of leave to amend under reg 10.6B(3) is only to be exercised by the Assistant General Manager (OEP) or the Supervising Examiner (Patent Oppositions). If it becomes apparent that an error has occurred in granting leave to amend, the matter is to be referred to Patent Oppositions immediately. Similar considerations to those discussed in 2.15.5 Revocation of Acceptance apply.
2.23.7 Allowability of Amendments to Complete Specifications

requirements, which can vary depending on the status of the application or patent when the amendments are sought. These requirements are detailed in the following sections of this chapter.

Note: The information in this part only applies to:

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.
- requests to amend filed on or after 15 April 2013 for:
  - standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  - innovation patents with an examination request filed before 15 April 2013.
  - innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
  - standard patents granted, and innovation patents certified, before 15 April 2013.

For all other requests to amend, see 2.23.7A Allowability of Amendments to Complete Specifications.

In this topic:

Section 102 and reg 10.3 set out the circumstances in which amendments are not allowable. These provisions are summarised below.

General Provisions
1. An amendment of a **complete specification** is not allowable **at any time**:
   
   if, as a result of the amendment, the specification would claim matter which was not in substance disclosed in the specification as filed.
   
   (see sec 102(1) and [2.23.8 Allowability Under Section 102(1)]).

2. An amendment of a **complete specification** is not allowable **after the relevant time**, that is:
   
   i. **after acceptance** of a standard patent; or
   
   ii. **after a decision to certify an innovation patent**;

   IF, as a result of the amendment:

   - a claim of the specification would not in substance fall within the scope of the claims of the specification before amendment; or
   
   - the specification would not comply with sec 40(2) or sec 40(3).

   (see sec 102(2), sec 102(2A) (meaning of “relevant time”) and [2.23.9 Allowability under Section 102(2)].)

   **BUT the provisions in 1 and 2 above do not apply** where:

   an amendment is for the purpose of correcting a **clerical error** or an **obvious mistake** made in, or in relation to, a complete specification.

   (see sec 102(3) and [2.23.10 "Clerical Error" and "Obvious Mistake"])

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**Specific Provisions Relating to Specifications for Innovation Patent Applications and Innovation Patents**

3. An amendment of a **complete specification for an application for an innovation patent** is not allowable until after the patent has been granted, unless it is an amendment proposed in response to a formalities direction under reg 3.2B.

   (see reg 10.3(7))

4. An amendment of a **complete specification for an innovation patent** is not allowable if it would result in the specification claiming:

   - a thing mentioned in sec 18(2) (human beings and the biological processes for their generation); or
2.23.7 Allowability of Amendments to Complete Specifications

- a thing mentioned in sec 18(3) (plants and animals and the biological processes for their generation) other than a thing mentioned in sec 18(4) (a microbiological process or a product of a microbiological process).

(see reg 10.3(8), sec 18(2), sec 18(3) and sec 18(4))

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Specific Provisions Relating to Specifications Relying on the Budapest Treaty

5. An amendment of a complete specification relating to the deposit requirements of sec 6(c) is not allowable if the amendment would result in the specification not including each of the matters specified in sec 6(c).

(see reg 10.3(2) and 2.23.12.1 Amendments Relating to Micro-Organisms)

6. An amendment of a complete specification is not allowable if the Commissioner has given a copy of the amendment request to a person identified below and that person has not been given a reasonable opportunity to be heard with respect to the amendment:

- a person requesting a certificate authorising release of deposited material under Rule 11.3(a) of the Budapest Treaty in respect of the patent or patent application; or
- a person who has notified the Commissioner that the micro-organism deposit requirements of sec 6(c) or sec 6(d) ceased to be satisfied in respect of the patent or patent application.

(see reg 10.3(2), reg 10.2(8), reg 10.2(9) and reg 3.25)

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Specific Provisions Relating to Specifications Where Court Proceedings are Pending

For consideration of amendments when a decision of the Commissioner in an opposition matter is under appeal, see 2.23.3.4 Amendments Arising out of Decisions or Directions Under Appeal.
2.23.7A Allowability of Amendments to Complete Specifications

Note: The information in this part only applies to:

- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.

- requests to amend filed on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other requests to amend, see 2.23.7 Allowability of Amendments to Complete Specifications.

In this topic:

Note: Where Court proceedings are pending in relation to a patent application or patent, amendments to the specification must not be allowed (see point 7 below). In this situation, which will generally be evident from the correspondence on file, examiners should refer the case to Patent Oppositions.

Section 102 sets out the circumstances in which amendments are not allowable. These provisions are summarised below with detailed discussion in ensuing paragraphs.

General Provisions

1. An amendment of a complete specification is not allowable at any time:

   if the amendment would result in the specification claiming or disclosing matter that extends beyond the combined disclosure of the complete specification as filed, together with other documents prescribed by reg 10.2A. (see sec 102(1) and 2.23.8A Allowability Under Section 102(1))
2. An amendment of a **complete specification** is not allowable **after the relevant time**, that is:

i. **after acceptance** of a standard patent; or

ii. **after a decision to certify an innovation patent**;

**IF**, as a result of the amendment:

- a claim of the specification would not in substance fall within the scope of the claims of the specification before amendment; or

- the specification would not comply with sec 40(2) or sec 40(3).

(see sec 102(2). sec 102(2A) (meaning of “relevant time”) and 2.23.9 Allowability under Section 102(2) etc)

**BUT** under sec 102(3) the above provisions do not apply where an amendment is for the purposes of:

- correcting a **clerical error** or an **obvious mistake** made in, or in relation to, a complete specification; or

- to comply with the deposit requirements of sec 6(c) (see point 5 below).

(see 2.23.10 "Clerical Error" and "Obvious Mistake")

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**Specific Provisions Relating to Specifications for Innovation Patent Applications and Innovation Patents**

3. An amendment of a **complete specification for an innovation patent** is not allowable until after the patent has been granted, **unless** it is an amendment proposed in response to a formalities direction under reg 3.2B.

(see sec 102(2D) and reg 10.2C(4))

4. An amendment of a **complete specification for an innovation patent** is not allowable if it would result in the specification claiming:

- a thing mentioned in sec 18(2) (human beings and the biological processes for their generation); or
2.23.7A Allowability of Amendments to Complete Specifications

- a thing mentioned in sec 18(3) (plants and animals and the biological processes for their generation) other than a thing mentioned in 18(4) (a microbiological process or a product of a microbiological process).

(see sec 102(2D), reg 10.2C(5), sec 18(2), sec 18(3) and sec 18(4))

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**Specific Provisions Relating to Specifications Relying on the Budapest Treaty**

5. An amendment of a **complete specification** relating to the deposit requirements of sec 6(c) is not allowable if the amendment would result in the specification not including each of the matters specified in sec 6(c).

(see sec 102(2D), reg 10.2C(2) and 2.23.12.1 Amendments relating to Micro-Organisms)

6. An amendment of a **complete specification** is not allowable if the Commissioner has given a copy of the amendment request to a person identified below and that person has not been given a reasonable opportunity to be heard with respect to the amendment:

   - a person requesting a certificate authorising release of deposited material under Rule 11.3(a) of the Budapest Treaty in respect of the patent or patent application; or
   - a person who has notified the Commissioner that the micro-organism deposit requirements of sec 6(c) or sec 6(d) ceased to be satisfied in respect of the patent or patent application.

(see sec 102(2D), reg 10.2C(3), reg 10.2(8), reg 10.2(9) and reg 3.25)

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**Specific Provisions Relating to Specifications Where Court Proceedings are Pending**

7. An amendment of a **complete specification** is not allowable if making the amendment would be contrary to sec 112 or sec 112A. That is, a complete specification must not be amended where relevant Court proceedings are pending or when an appeal has been made against a decision of the Commissioner, except where the amendments are directed by the Court under sec 105.
2.23.8 Allowability under Section 102(1)

Modified Date: 03 August 2015

2.23.8 Allowability under Section 102(1)

Note: The information in this part only applies to:

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.

- requests to amend filed on or after 15 April 2013 for:
  - standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  - innovation patents with an examination request filed before 15 April 2013.
  - innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
  - standard patents granted, and innovation patents certified, before 15 April 2013.

For all other requests to amend, see 2.23.8A Allowability Under Section 102(1).

Subsection 102(1) states:

(1) An amendment of a complete specification is not allowable if, as a result of the amendment, the specification would claim matter not in substance disclosed in the specification as filed.

This provision applies to amendments proposed and considered at any time.

2.23.8.1 The Section 102(1) Provisions Explained
2.23.8.1 The Section 102(1) Provisions Explained

**Note:** The information in this part only applies to:

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.

- requests to amend filed on or after 15 April 2013 for:
  - standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  - innovation patents with an examination request filed before 15 April 2013.
  - innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
  - standard patents granted, and innovation patents certified, before 15 April 2013.

For all other requests to amend, see 2.23.8.1A The Section 102(1) Provisions Explained.

In this topic:

**Note:** The provisions of sec 102(1) do not apply where an amendment is for the purpose of correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification (see sec 102(3) and 2.23.10 "Clerical Error" and "Obvious Mistake").

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**Meaning of “as a result of the amendment”**

Under sec 102(1), the clause “as a result of the amendment” prescribes that a proposed amendment is not allowable where that amendment results in a claim to matter not in substance disclosed in the specification as filed.

An amendment that does not claim new matter is therefore allowable. This is so even where the amendment retains new matter that was introduced in an earlier allowed amendment (e.g. voluntary sec 104, Article 34 etc).

For example, new matter may be present in a claim that was introduced by an Article 34 amendment during the international phase. In this situation, a subsequent amendment proposed under sec 104 which retains the Article 34 amendment, but does not itself add...
any new matter, would be allowable under sec 102(1). This is because the new matter was not added as a result of the subsequent sec 104 amendment; it was added by the Article 34 amendment.

Similarly, new matter can be included by an amendment to the description, provided no claim is made to, or no claim includes, that new matter. Alternatively, an amendment to the claims (only) which results in a claim to matter previously disclosed, but not claimed, would be allowable.

For further information on applying these provisions, see 2.23.8.2 Section 102(1) Examination Practice.

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**Meaning of “in substance disclosed”**

Under sec 102(1), the clause “in substance disclosed” requires that an amendment must not result in a claim to matter that was not previously disclosed, either explicitly and/or implicitly, in the specification as filed.

The meaning of "in substance disclosed", as distinct from an express disclosure, has previously been considered (A.B. Volvo’s Application 1 IPR 554). In this case, reference was made to the following statement by the High Court:

"The substance must appear from the language itself interpreted in accordance with ordinary rules of interpretation with a knowledge of the prior state of the art to which the claim relates."

*(AMP Incorporated v Commissioner of Patents (1974) AOJP 3224 at page 3227)*

Although the AMP case was referring to the substance of a claim and the allowability of amendments under a provision corresponding to sec 102(2), the comments of the High Court apply equally to the meaning of the word "substance" in the context of sec 102(1) (see Robertshaw Controls Company GSA Industries Ltd (1991) AIPC 90-784 and Kornelis’ Kunsthars Producten Industrie BV v WR Grace & Co 28 IPR 471).

Matter that is "disclosed in substance" may be either expressly disclosed or impliedly disclosed. “Impliedly disclosed” means that matter would either be implied by the expert reader or disclosed by mathematical information *(Ethyl Corporation’s Patent (1972) RPC 169)*.

A broad disclosure in the description may not be sufficient to provide the "substance" to allow an amendment to the claims. An example of this would be where the description is directed to broad generalisations and the claims as proposed to be amended are quite...
2.23.8.1 The Section 102(1) Provisions Explained

specific and provide detailed definitions of the invention broadly described (note, however, the paragraph below).

Where the specification as filed includes a term which is very broad and not exemplified, that term may be regarded as disclosing "in substance" the meaning that the skilled addressee would have understood it to mean at the priority date, based on the common general knowledge in the art (Herchel Smith's Applications (1968) AOJP 774). For example, the term "mechanical fastening means" would in substance disclose nuts and bolts if these were known in the art at the priority date.

For further information on applying these provisions, see 2.23.8.2 Section 102(1) Examination Practice.

Note: In the context of a document being considered as a whole, the words “described” and “disclosed” have an equivalent meaning (see 2.12.1.1 Priority Date of Claims - Level of Disclosure Required). Note also that the drawings form part of the disclosure of a specification (Jarvis v Doman (1986) AIPC 90-281).

Meaning of “the specification as filed”

Under sec 102(1), the allowability of amendments must be considered by comparing the subject matter of the amendments with the specification as filed, i.e. the specification as originally filed. Consequently, where the specification has been proposed to be amended by earlier statements of amendments, the relevant comparison is with the original specification only and all amendment proposals are to be disregarded. Similarly, where amendments to the specification have already been allowed following one or more requests under sec 104, the allowability of any subsequently proposed amendments is determined by reference to the specification as originally filed.

The information disclosed in an abstract filed with a complete specification may also be taken into account (reg 3.3(7)) (this does not include abstracts drafted by examiners during international or national examination).

The following matter is not part of the specification as originally filed and is therefore irrelevant to the allowability of any subsequently proposed amendments under sec 102(1):

- Article 34 amendments;
- associated applications, such as a provisional, additional, divisional or parent (or other ancestor, e.g. grandparent) applications, or a Convention document;
2.23.8.2 Section 102(1) Examination Practice

- a translation of an application originally filed in a language other than English.

For further information on applying these provisions, see 2.23.8.2 Section 102(1) Examination Practice.

Note: The information in this part only applies to:

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.

- requests to amend filed on or after 15 April 2013 for:
  - standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  - innovation patents with an examination request filed before 15 April 2013.
  - innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.
  - standard patents granted, and innovation patents certified, before 15 April 2013.

For all other requests to amend, see 2.23.8.2A Section 102(1) Examination Practice.

In this topic:

Overview

Under sec 102(1), an applicant or patentee in seeking to amend a complete specification is limited to amendments which do not result in a claim to matter not in substance disclosed in the specification as filed.

Further information on the meaning of sec 102(1) is provided in 2.23.8.1 The Section 102 Provisions Explained.
Note: Under sec 102(3), the provisions of sec 102(1) do not apply where an amendment is for the purpose of correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification (see 2.23.10 “Clerical Error” and “Obvious Mistake”).

Examination Considerations

In determining whether as a result of amendment a claim of the specification claims matter "in substance disclosed", the test for fair basis of a claim can be employed, i.e. the amended claim in effect must also be fairly based on the specification as filed. Thus, there must be “a real and reasonably clear disclosure” of the claim as proposed to be amended when compared against the original disclosure (Burchett J in RGC Mineral Sands Pty Ltd v Wimmera Industrial Minerals Pty Ltd 42 IPR 353, accepting the principle of "a real and reasonably clear disclosure" set out in CCom Pty Ltd v Jiejing Pty Ltd 28 IPR 481; see also Ethyl Corporation's Patent (1972) RPC 169 at page 195).

Note: Objections that a proposed amendment is not allowable under sec 102(1) must include a reasoned explanation justifying this conclusion (see Reporting on Amendments Not Allowable Under Section 102(1) below).

Reporting on Amendments Not Allowable Under Section 102(1)

Where, as a result of a proposed amendment, the specification would claim matter not in substance disclosed in the specification as filed, the report should indicate that the proposed amendment is not allowable under sec 102(1) and provide a reasoned explanation.

Where an amendment proposed before or during examination is not allowable under sec 102(1), examination should only be conducted to the extent possible on those claims that define allowable subject matter. No examination is to be conducted with respect to claimed matter not in substance disclosed in the specification as filed. Where only certain claims are examined, the report should clearly indicate which claims have been examined and include a statement that opinion is reserved in respect of those claims not examined.

This is illustrated in the example below, where a proposed amendment results in the claiming of component B, which was not disclosed in the specification as filed.

Claim 1. Composition containing A and a solvent.
Claim 2. Composition containing A or B.
Claim 3. Composition containing B.
Examination would be carried out on claim 1 and claim 2 in so far as it relates to a composition containing only A. Opinion would be reserved with respect to claim 2 in so far as it relates to a composition containing only B and claim 3.

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**Specific Circumstances**

**Removing or Creating Ambiguity by Amendment**

Existing ambiguity may be overcome by amendment, provided it is not resolved in such a manner as to result in a larger monopoly which was not in substance disclosed in the specification as filed (Chain Bar Mill Co. Ltd's Application (1941) 58 RPC 200).

Before acceptance, there is no provision to object to an amendment which introduces ambiguity into the specification where there was none previously. However, during examination of the application, a clarity objection should be raised on the basis of the ambiguity. After acceptance, an amendment that would result in non-compliance of the specification with sec 40(2) or sec 40(3) is not allowable under sec 102(2); see 2.23.9.6 Allowability Under Section 102(2)(b).

If the amendment itself is ambiguous, then an objection should be directed to the amendment.

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**Specific Integer or Specific Example**

A specific integer or specific example is not necessarily in substance disclosed by a description of a generic class of which it is a member. For example, in Rose Bros. (Gainsborough) Ltd's Application (1960) RPC 247, claim 1 as originally filed was directed to a device for feeding articles and included as a feature "means for feeding the articles onto the surface of the feed member". The original specification disclosed (and defined) the "means for feeding" as being a vibrating device of the electromagnetic type which could be, but was not limited to being, controlled by a feeler member which could be arranged to operate a device for varying the rate of vibration of the electromagnetic device. The proposed amendments had the effect of limiting claim 1 (and the corresponding consistory clause) to a combination comprising a vibrating feed device and a feeler member controlling the operation. The amendments were considered not allowable on the basis that whereas the original specification did disclose the broad feature "means for feeding the articles" and the specific combination of the electromagnetic vibratory feeder and rate-controlling feeler
member, it did not in substance disclose the combination of any type of vibrating feed device with a feeler member control.

Intermediate Generalisation

In certain circumstances, an amendment of a claim to an "intermediate generalisation" that falls between a general disclosure, and the specific examples described, is allowable. Thus in *Matbro Ltd. v Michigan (G.B.) Ltd.* (1973) RPC 823, original claim 1 covered shovel loaders in which the steering axis was situated at any point, whether between or outside the front and rear axles. Claim 2 defined a steering axis that was substantially midway between the axles. Amended claim 1 limited the axis to any point between the axles. It was held that the specification as a whole, including original claim 1, in substance disclosed the use of a steering axis which could be situated at any point between the axles and not merely midway as in original claim 2. The amendment was accordingly not an impermissible intermediate generalisation (see also *Screen Printing Machinery Ltd's Application* (1974) RPC 628).

Adding Further Examples

Where there are omnibus claims or other claims that refer to the description, a proposed amendment to include further examples or illustrations may not be allowable under sec 102(1). Similarly, the meaning or scope of a generic claim may be affected by the addition of examples. In particular, where an amendment seeks to alter definitions of terms used in the claims, this may result in the claiming of matter not in substance disclosed in the specification as filed.

However, if further embodiments, examples or illustrations which fall within the framework of the original disclosure are added to the specification, the inclusion of that further material in a claim will generally be allowable.

Numerical Ranges

*Ethyl Corporation's Patent* (1972) RPC 169 provides an example of the allowability of amendments in relation to ranges. The invention was a mixture comprising tetramethyl lead and a selected hydrocarbon, in which the latter was present in various percentages from 43 to 80. Examples of the mixtures were disclosed in the specification as filed. Original claim 14 had no limit on the amount of hydrocarbon, claim 15 gave a percentage of about 80 and claim 16 a lower limit of 20% of a selected hydrocarbon. The amendment consisted of replacing claims 14, 15 and 16 with a new claim 14 directed to a mixture comprising...
tetramethyl lead and a selected hydrocarbon present in the range of 20-80%. The Court determined that this latter range was in substance disclosed and the amendment was consequently allowable.

**Generic Class of Compounds**

Where the claimed invention was a generic class of compounds defined in terms of a general formula, and illustrated in the specification by certain specific examples of the class, the generic reference and the "naming" of an individual compound did not in substance disclose other members of the class, or the "named" compound where new starting materials and departures from the previously disclosed production method were required (Shionogi and Co. Ltd's Application (1967) RPC 623).

**Matter from Article 34 Amendments**

Article 34 amendments filed during the international phase are deemed to amend the specification on the date those amendments were made (provided certain circumstances are met; see 2.20.10.1.1 General Provisions). Thus, amendments of this type must be treated as having been already incorporated into the specification when national examination commences. Therefore, examiners are not permitted to object to the allowability of such amendments under sec 102 during examination, even if those amendments have resulted in claims which claim matter not in substance disclosed in the specification as filed (see also 2.20.10.6 Amendments Resulting in a Claim to New Matter).

**Matter from Documents Referred to in the Specification**

For information on proposed amendments to insert cross-referenced material into the specification, see 2.11.3.7 Inclusion of References.

**Translations**

In the case of a national phase application where the PCT application as originally filed was in a foreign language, but a translation into English has been filed in order to enter the national phase, "the specification as filed" means the original foreign language PCT application and not the translation to which the foreign language application is taken to have been amended. This issue arose in Fina Research SA v Halliburton Energy Services Inc.
2.23.8A Allowability Under Section 102(1)

[2003] FCA 251. However, the judgement deals essentially with sec 102(2) criteria. In particular, while the judgement referred to an argument made to the effect that the substitution of the translation had effect from the international filing date, that argument:

i. was not accepted by the judge as such;

ii. would appear to be contrary to the express provisions of the legislation; and

iii. was not a determination that was required to be made to reach the decision made in the judgement (i.e. the comments were obiter).

2.23.8A Allowability Under Section 102(1)

Modified Date: 01 September 2015

2.23.8A Allowability Under Section 102(1)

Note: The information in this part only applies to:

- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.

- requests to amend filed on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other requests to amend, see 2.23.8 Allowability Under Section 102(1).

Subsection 102(1) states:

(1) An amendment of a complete specification is not allowable if, as a result of the amendment, the specification would claim or disclose matter that extends beyond that disclosed in the following documents taken together:

(a) the complete specification as filed;

(b) other prescribed documents (if any).

The preamble to this provision does not impose any time constraints. Consequently, sec 102(1) applies to amendments proposed and considered at any time. In effect, sec 102(1) requires an applicant seeking to amend a specification to meet the disclosure requirements of sec 40 at the time of filing the complete specification.
To ensure that applicants are not unfairly disadvantaged by this requirement, the legislation prescribes certain documents which, in addition to the specification as filed, form part of the baseline disclosure against which a proposed amendment should be assessed (The Explanatory Memorandum). These documents are prescribed in reg 10.2A.

Note: The information in this part only applies to:

• requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.

• requests to amend filed on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other requests to amend, see 2.23.8.1 The Section 102(1) Provisions Explained.

In this topic:

Note: Under sec 102(3), the provisions of sec 102(1) do not apply to an amendment for the purposes of correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification (see 2.23.10 “Clerical Error” and “Obvious Mistake”), or to comply with the deposit requirements of sec 6(c) (see 2.7.5 Amendments to Insert Section 6(c) Information and Extensions of Time Therefor).

Meaning of “as a result of the amendment”
2.23.8.1A The Section 102(1) Provisions Explained

Under sec 102(1), the clause "as a result of the amendment" prescribes that a proposed amendment is not allowable where that amendment results in the specification claiming or disclosing matter that extends beyond the combined disclosure of the specified documents.

An amendment that does not introduce new matter is therefore allowable. This is so even where the amendment retains new matter that was introduced in an earlier allowed amendment (e.g. voluntary sec 104, Article 34 etc).

For example, new matter may be present in a claim that was introduced by an Article 34 amendment during the international phase. In this situation, a subsequent amendment proposed under sec 104 which retains the Article 34 amendment, but does not itself add any new matter, would be allowable under sec 102(1). This is because the new matter was not added as a result of the subsequent sec 104 amendment; it was added by the Article 34 amendment.

(Note that in this situation, consideration should also be given to whether the subject matter of the Article 34 amendment is supported for the purposes of sec 40(3)).

For additional information on applying these provisions, see 2.23.8.2A Section 102(1) Examination Practice.

Meaning of “claim or disclose matter that extends beyond”

Under sec 102(1), the clause “claim or disclose matter that extends beyond” requires that an amendment must not add new matter that the hypothetical skilled person could not directly derive by reading the information in the combination of documents identified in sec 102(1) and reg 10.2A, i.e. the explicit and/or implicit disclosure of the complete specification as filed, taken together with the other documents prescribed in reg 10.2A. However, where the person skilled in the art could directly derive the matter sought to be added to the specification from this combination of documents, an amendment will be allowable under sec 102(1).

Thus, the correct approach to considering whether an amendment adds new matter is to ask whether the skilled person would, on looking at the specification as proposed to be amended, learn anything about the invention which they could not learn from the combined disclosure of the complete specification as filed and other prescribed documents. This comparison is a strict one in the sense that subject matter will be added unless it is clearly and unambiguously disclosed, either explicitly or implicitly, in the relevant documents.

Conversely, it has always been permissible to add a feature to a claim if it simply excludes protection for part of the subject matter of the claimed invention and does so in a manner.
that does not add to the disclosure. (Consistent with the UK Court of Appeal in *Sudarshan Chemical Industries Ltd v Clariant Produkte (Deutschland) GMBH* [2014] RPC 6 at 186 [62])

For additional information on applying these provisions, see 2.23.8.2A Section 102(1) Examination Practice.

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### Meaning of “the complete specification as filed, and other prescribed documents”

Under sec 102(1), the allowability of amendments must be considered by comparing the subject matter of the amendments with the combined disclosure of:

a. **the complete specification as filed**, that is the description, claims and any drawings, graphics, photographs and/or sequence listing, as these stood at the filing date of the application;

and

b. **the documents prescribed by reg 10.2A** which are:

- an abstract filed with the complete specification (this does not include abstracts drafted by examiners during international or national examination);

- any part missing from the complete specification at filing that was later incorporated into the specification under reg 3.5A or PCT Rule 20.5 or Rule 20.6; and

- an amendment that has been made to the complete specification after filing, for the purpose of:
  
  i. correcting a clerical error or obvious mistake; or
  
  ii. complying with sec 6(c) (micro-organism deposit requirements).

Thus, an earlier amendment to the complete specification to correct a **clerical error or an obvious mistake**, or to comply with the **deposit requirements of sec 6(c)**, is a prescribed document for the purposes of sec 102(1). Consequently, the disclosure of such amendments must be taken into account (together with the complete specification as filed and any other prescribed documents), when considering the allowability of subsequent amendments under sec 102(1).

However, any earlier amendment request(s) for reasons **other than** to correct a clerical error or an obvious mistake, or to comply with sec 6(c), **whether previously allowed or not**, are irrelevant to the allowability of any subsequently proposed amendments under sec 102(1).
The following documents are also not part of the complete specification as filed or prescribed documents for the purposes of sec 102(1) and are therefore irrelevant to the allowability of any subsequently proposed amendments under sec 102(1):

- Article 34 amendments;
- associated applications, such as a provisional, additional, divisional or parent (or other ancestor, e.g. grandparent) applications;
- a translation of an application originally filed in a language other than English.

For further information on applying these provisions, see 2.23.8.2A Section 102(1) Examination Practice.

Note: The information in this part only applies to:

- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.

- requests to amend filed on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other requests to amend, see 2.23.8.2 Section 102(1) Examination Practice.

In this topic:

Note: Under sec 102(3), the provisions of sec 102(1) do not apply to an amendment for the purposes of correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification (see 2.23.10 "Clerical Error" and "Obvious Mistake"), or to comply with the deposit requirements of sec 6(c) (see 2.7.5 Amendments to Insert Section 6(c) Information and Extensions of Time Therefor).
**Overview**

A significant change brought in by the “Raising the Bar” legislation is that the allowability requirement imposed by sec 102(1) applies equally to amendments proposed to the claims of the specification and to the body of the specification (i.e. the description and any drawings, graphics, photographs and/or sequence listing). That is, for an amendment to be allowable, **neither the claims nor the description or any drawings, graphics, photographs or sequence listing** are permitted, after amendment, to disclose matter that extends beyond the disclosure of the complete specification as filed in combination with the documents prescribed by reg 10.2A.

Thus, sec 102(1) prohibits amendments that add matter to the disclosure of the complete specification as filed, unless the added matter can be found in the documents prescribed by reg 10.2A.

Further information on the meaning of sec 102(1) is provided in **2.23.8.1A The Section 102(1) Provisions Explained**.

**Examination Considerations**

The sec 102(1) allowability criteria apply to amendments to any part of the complete specification.

The effect of sec 102(1) is that an amendment must not add new matter that the hypothetical person skilled in the art could not directly derive by reading the information in the complete specification as filed and other documents prescribed by reg 10.2A (see **2.23.8.1A The Section 102(1) Provisions Explained**).

The correct approach when considering whether an amendment would result in the specification claiming or disclosing new matter is to ask whether the person skilled in the art would, on looking at the specification as proposed to be amended, learn anything about the invention which they could not learn from the complete specification as filed, in combination with the prescribed documents. This comparison is a strict one in the sense that subject matter will be added unless it is clearly and unambiguously disclosed in the relevant documents when read in combination. However, in considering the extent of the disclosure, examiners should have regard to the explicit and implicit disclosure of the specification as filed and other prescribed documents.

For example, it is permissible to add a feature to a claim if it simply excludes protection for part of the subject matter claimed and does so in a manner that does not add new subject matter. However, if an amendment would lead to the specification claiming and/or disclosing
an invention which is fundamentally different from that disclosed in the specification as filed and other prescribed documents, the conclusion can only be that it adds new matter, contrary to sec 102(1), and is therefore not allowable (consistent with the Full Court in AstraZeneca AB v Apotex Pty Ltd [2014] FCAFC 99 at [244]-[247]).

**Note:** Objections that a proposed amendment is not allowable under sec 102(1) must include a reasoned explanation justifying this conclusion (see Reporting on Amendments Not Allowable Under Section 102(1) below).

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### Reporting on Amendments Not Allowable Under Section 102(1)

Where, **as a result of a proposed amendment**, the specification would **claim or disclose matter that extends beyond** the combined disclosure of **the complete specification as filed and other prescribed documents**, the report should indicate that the proposed amendment is not allowable under sec 102(1) and provide a reasoned explanation.

Where an amendment proposed before or during examination is not allowable under sec 102(1), examination should **only** be conducted to the extent possible on the claims that define allowable subject matter. **No** examination is to be conducted with respect to claimed matter that extends beyond the combined disclosure of the specification as filed and other prescribed documents. Where only certain claims are examined, the report should clearly indicate which claims have been examined and include a statement that opinion is reserved in respect of those claims not examined.

This is illustrated in the example below, where a proposed amendment results in the claiming of component B, which was not disclosed in the specification as filed.

Claim 1. Composition containing A and a solvent.

Claim 2. Composition containing A or B.

Claim 3. Composition containing B.

Examination would be carried out on claim 1 and claim 2 in so far as it relates to a composition containing only A. Opinion would be reserved with respect to claim 2 in so far as it relates to a composition containing only B and claim 3.

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### Specific Circumstances
Removing or Creating Ambiguity by Amendment

Existing ambiguity may be overcome by amendment, provided it is not resolved in such a manner as to add new matter to the specification that extends beyond what the skilled addressee could directly derive from reading the complete specification as filed, together with other prescribed documents.

Where an amendment would introduce ambiguity into the specification where there was none previously, examiners should consider whether the ambiguity arises as a result of the addition of new matter to the specification. If so, the amendment will not be allowable under sec 102(1). If the amendment does not add new matter, and it is filed before acceptance, then during examination of the application a clarity objection should be raised on the basis of the ambiguity. After acceptance, an amendment that would result in non-compliance of the specification with sec 40(2) or sec 40(3) is not allowable under sec 102(2); see 2.23.9.6 Allowability Under Section 102(2)(b).

If the amendment itself is ambiguous, then an objection should be directed to the amendment.

**Note:** Where the complete specification includes a term which is indefinite and not exemplified, that term may be given the meaning that the person skilled in the art would have understood it to mean at the priority date, based on the common general knowledge in the art.

Amendment of Integers, Examples, Embodiments etc

A specific integer or specific example is not necessarily a disclosure of a generic class of which it is a member. For example, where the specification contains a broad reference to a “means” for carrying out a function, but the description provides a dictionary defining the “means” or provides an explicit restriction of the “means” to a specific component, an amendment to the specification to add material inconsistent with the narrower meaning would not be allowable.

Moreover, a proposed amendment which adds further embodiments, examples or illustrations to the specification will not be allowable under sec 102(1), if it adds new matter to the specification that extends beyond what the skilled addressee could directly derive from reading the complete specification as filed, together with other prescribed documents.

However if, for example, the specification as filed referred to tests having been carried out and the results of those tests, then amendments to add an example to this effect may be allowable.
Clarifying Statements (Comprising, Common General Knowledge etc)

A proposed amendment may add clarifying statements, for example, a definition of the term “comprising”, or an indication that a reference to a prior art publication does not constitute an admission that the publication forms part of the common general knowledge. Provided such statements do not add matter that extends beyond what the skilled addressee would understand from reading the complete specification as filed, together with other prescribed documents, the amendment will be allowable.

However, if the clarifying statement would result in the specification disclosing or claiming an invention that is fundamentally different from the invention disclosed in the specification as filed and other prescribed documents, the amendment will not be allowable under sec 102(1) (see also Examination Considerations above).

Numerical Ranges

It is permissible to add a feature to a claim if it simply excludes protection for part of the subject matter of the claimed invention and does so in a manner that does not add to the combined disclosure of the specification as filed and other prescribed documents. Thus, where a proposed amendment adds a numerical sub-range, which was not expressly stated in the complete specification as filed, consideration should be given to whether the sub-range extends beyond that disclosed in the specification as filed and other prescribed documents.

Each case should be assessed on its own merits. Examiners should consider what is stated about the ranges; it is not merely a question of looking for any mention of the sub-range, but rather assessing the disclosure in respect of the ranges. In general, where a proposed amendment to introduce a sub-range represents a choice from a number of alternative values in a broader range disclosed in the specification as filed, claims to the sub-range will not add new matter and the amendment will be allowable (see also Insertion or Amendment of Provisos below). However, if the applicant submits, or the amendment states, that the sub-range is a selection from the broader range disclosed, and the body of the specification does not teach that the sub-range has any advantageous properties that would support such a selection, the amendment would add new matter contrary to sec 102(1).

Insertion or Amendment of Provisos

It is permissible to add a feature to a claim if it simply excludes protection for part of the subject matter of the claimed invention and does so in a manner that does not add to the
combined disclosure of the specification as filed and other prescribed documents. This is often achieved by way of a proviso.

Where a proposed amendment adds a proviso that simply limits the scope of a claim to a subset of the original, the amendment will be allowable even where the subject matter of the proviso was not itself disclosed in the specification as filed. For example, the specification and claims relate to the use of a specified pharmaceutical compound to treat cancer. In response to an adverse report, the applicant proposes to amend the claims by adding the proviso that the compound is used to treat cancer, but not breast cancer. In general, this type of amendment does not add new matter, even where breast cancer was not explicitly mentioned in the specification as filed. This is because a broad disclosure of the treatment of “cancer” in the specification as filed would generally be considered to implicitly disclose treatment of any cancer, including breast cancer. In this situation, the amendment would be allowable since the proviso simply narrows the scope of the claims to a subset of the cancers originally disclosed in the specification at its filing date (and other prescribed documents), and no new matter is added.

However, if a proviso limits the scope of a claim to an invention that is fundamentally different from the invention disclosed in the specification as filed and other prescribed documents, the amendment will claim or disclose matter that extends beyond this disclosure and will not be allowable (see also Examination Considerations above). For example, an amendment would not be allowable where it adds a proviso to define the meaning of a word or phrase in the specification, and that meaning would not have been apparent to the person skilled in the art reading the complete specification as filed and other prescribed documents.

Amending the Description (and/or Drawing(s), Graphic(s), Photograph(s), Sequence Listing) to Add Features Present Only in the Claims

Where a feature is clearly disclosed in a claim of the specification as filed, although not mentioned in the body of the specification (i.e. the description, together with any drawings, graphics, photographs and sequence listing), it is generally permissible to amend the description to add the feature.

Furthermore, where the description is directed to broad generalisations and the claims as originally filed are quite specific and provide detailed definitions of the invention broadly described, an amendment to the description to include specifically what was in the claims would, in general, be allowable.

However, a proposed amendment that inserts matter from the claims into the description (or drawings, graphics, photographs and/or sequence listing) will not be allowable where:

i. amended claims that were filed after the filing date of the application (e.g. amendments made under Article 34) are present in the specification; and
ii. those amended claims contain new matter which extends beyond the combined disclosure of the complete specification as filed and other prescribed documents; and

iii. the proposed amendment would introduce that new matter into the description (or drawings, graphics, photographs and/or sequence listing).

Matter From Article 34 Amendments

Applicants often seek to amend the claims of a PCT application during international examination.

Article 34 amendments are filed after the filing date of the PCT application and as a consequence are not part of the Australian complete specification as filed, nor are they prescribed by reg 10.2A.

However, Article 34 amendments filed during the international phase are deemed to amend the specification on the date those amendments were made (provided certain circumstances are met; see 2.20.10.1A General Provisions). Thus, amendments of this type must be treated as having been already incorporated into the specification when national examination commences. Therefore, examiners are not permitted to object to the allowability of such amendments under sec 102 during examination, even if those amendments have resulted in claims which claim matter not in substance disclosed in the specification as filed (see also 2.20.10.6 Amendments Resulting in a Claim to New Matter).

Where Article 34 amendments include new matter not present in the specification as filed, or the other documents prescribed by reg 10.2A, a subsequent request under sec 104 to amend the specification to insert the new matter in the Article 34 amendment into the description (or drawings, graphics, photographs and/or sequence listing) will not be allowable (see Amending the Description (and/or Drawing(s), Graphic(s), Photograph(s), Sequence Listing) to Add Features Present Only in the Claims, above).

Matter Described in Associated Provisional, Additional, Divisional or Parent Applications

Matter described in the following documents, but completely omitted from the specification of a complete application, is not part of the disclosure of "the complete specification as filed". Moreover, none of these documents are prescribed by reg 10.2A:

- an associated provisional application;
- a Convention document;
- a parent specification or other ancestor;
2.23.9.1 General Comments

- an additional to, or divisional of, the application.

Therefore, examiners should not have regard to the information in any of these documents when considering the allowability of an amendment under sec 102(1).

Matter from Documents Referred to in the Specification

For information on proposed amendments to insert cross-referenced material into the specification, see 2.11.3.7A Inclusion of References.

Translations

In the case of a national phase application where the original PCT application was filed in a foreign language, but a translation into English has been filed in order to enter the national phase in Australia, “the specification as filed” means the original foreign language PCT application and not the translation to which the foreign language application is taken to have been amended (consistent with Fina Research SA v Halliburton Energy Services Inc [2003] FCA 251, albeit that this case essentially deals with sec 102(2)).

2.23.9 Allowability Under Section 102(2) etc

Note: The information in this part only applies to:

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.

- requests to amend filed on or after 15 April 2013 for:
  - standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  - innovation patents with an examination request filed before 15 April 2013.
• innovation patents where the Commissioner **decided before** 15 April 2013 to examine the patent.

• standard patents granted, and innovation patents certified, **before** 15 April 2013.

For all other requests to amend, see **2.23.9.1A General Comments**.

Subsections 102(2) and 102(2A) provide that an amendment of a complete specification is not allowable:

• after the acceptance of a specification relating to a standard patent; or

• after the Commissioner has made a decision under sec 101E to certify a specification relating to an innovation patent;

if, as a result of the amendment:

• a claim of the specification would not in substance fall within the scope of the claims of the specification before amendment; or

• the specification would not comply with sec 40(2) or sec 40(3).

Subsection 102(2B) prohibits the amending of a patent request of an application for an innovation patent filed under sec 79C to a request for a standard patent (see also **2.31.4.7 Amendments**).

**Note:** The information in this part **only** applies to:

• requests to amend filed, or deemed under reg 10.6A to be filed, **on or after** 15 April 2013, for standard patent applications where a request for examination was **not filed before** 15 April 2013, and standard patents granted on such applications.

• requests to amend filed **on or after** 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was **not filed before** 15 April 2013, or the Commissioner **had not decided before** 15 April 2013 to examine the patent.

For all other requests to amend, see **2.23.9.1 General Comments**.
Subsections 102(2) and 102(2A) provide that an amendment of a complete specification is not allowable:

- after the acceptance of a specification relating to a standard patent; or
- after the Commissioner has made a decision under sec 101E to certify a specification relating to an innovation patent;

if, as a result of the amendment:

- a claim of the specification would not in substance fall within the scope of the claims of the specification before amendment; or
- the specification would not comply with sec 40(2) or sec 40(3).

Subsection 102(2B) prohibits the amending of a patent request of an application for an innovation patent filed under sec 79C to a request for a standard patent (see also 2.31.4.7 Amendments).

Subsection 102(2D) provides that an amendment of a patent request or a complete specification is not allowable, if it is of a kind prescribed by the Regulations. The non-allowable amendments for patent requests or complete specifications are prescribed by reg 10.2B and reg 10.2C, respectively.

The word "claims" in this context means "a claim (including a dependent claim) of a complete specification". Furthermore, it is the claims immediately before amendment with which a comparison is required. Thus, where the claims have already been amended following a request made under Chapter 10, the allowability of any subsequently proposed amendments under sec 102(2)(a) is determined by reference to the claims as previously amended.

In W.J. Voit Rubber Corp.'s Application (1965) AOJP 1752, "the scope of the claims" was held to mean "the scope of the claims as a whole". The same view was expressed in AMP Incorporated v Commissioner of Patents (1974) AOJP 3224 at page 3227, where it was stated:

"The amendment may be allowed if the amending claim will in substance fall within the scope of the claims of the specification before amendment. It is necessary therefore to look at the other claims in order to see their scope ... Again it is not necessary before
an amendment is allowed to find that the amended claim would actually fall within the scope of one or all of the other claims. It need only fall in substance within that scope."

Therefore, all claims need to be considered in order to determine their scope. The monopolies of the original claims may also be added together. Thus, if the original claims included a claim to a method performed at 20°C-70°C and another claim to the same method performed at 70°C-100°C, an amended claim to the process performed at 20°C-100°C would not be objectionable (see Hilti v Ramset (1979) AOJP 1761 at page 1764).

However, it is not permissible to make a mosaic of the original claims for the purpose of determining the allowability of an amended claim. For example, if an original claim disclosed an apparatus comprising parts A, B, and C, and another original claim disclosed an apparatus comprising parts B, C and D, then an amended claim to apparatus comprising parts A and D would not be allowable.

The meaning of "in substance fall within the scope of the claim" was recently considered in the context of sec 70(2)(b) (and sec 102(2)(a)). In ImmunoGen, Inc [2014] APO 88, a claim was directed to a process for producing an antibody conjugate. The Deputy Commissioner concluded that a claim to a product made by a particular process is substantially indistinguishable in scope from a claim to the particular process used to make the product. Consequently, it was held that the antibody conjugate when produced by a process in substance falls within the scope of a claim to a process for preparing the antibody conjugate.

Modified Date: 01 February 2013

2.23.9.3 Allowability Under Section 102(2)(a)

Test for Allowability

A useful test for the allowability of amendments under sec 102(2)(a) is:

"would the amendment make anything an infringement which would not have been an infringement before the amendment?"

This test was suggested in relation to sec 31(1) of the British Act in The Distillers Co. Ld.'s Application (1953) 70 RPC 221 at page 223. Although the wording of sec 102(2)(a) differs from the wording of the then sec 31(1) of the British Act, the Commissioner in W.J. Voit Rubber Corp.'s Application (1965) AOJP 1752, when considering the corresponding provision of the Patents Act 1952, at page 1754 stated:

"the test as to whether a proposed amendment would have the effect of causing infringement when none existed before, seems to me a perfectly reasonable one".

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Effective Date: 25 September 2019
The Federal Court accepted the continuing relevance of this approach in *Boehringer Ingelheim International GmbH v Commissioner* [2000] FCA 1918.

The Federal Court has recently considered this expression in the context of sec 70(2)(a). The Full Court stated:

"we think that falling within the scope of a claim in a patent specification means included among the things claimed"

*Boehringer Ingelheim International GmbH v Commissioner* (2001) 52 IPR 529 at [42].

This means that the things that are within the scope of the claim are not the integers that appear within the claim, but the total invention that the claim defines. For example, if a claim relates to a process that uses a number of pieces of equipment, then the individual pieces of equipment *per se* do not in substance fall within the scope of the claim.

In *AMP Incorporated v Commissioner of Patents* (1974) AOJP 3224, the High Court stated at page 3227:

"The amending claim must in substance fall within the scope of the claims before amendment. The reference to substance imports the kind of test which is appropriate to a consideration of the question whether or not a particular act or a particular article is an infringement of the patent.

.....It would be of little avail to an alleged infringer to say that his article did not infringe one claim if it infringed another even though he may not in the infringement have incorporated all the features of that other claim."

---

### Applying the Test

Examiners should note that this is not a test of comparing the text of the claims before amendment with the text of the claims after amendment. The test requires consideration of the effective monopoly afforded by a claim.

It is important to distinguish the substance of the claims from the words used in it. For example, a claim may begin with the word "Apparatus" and yet be, in effect, a claim for a method. In such circumstances, substitution of a claim directed to a method may not only be unobjectionable, it may even be desirable. For the determination of allowability, the substance is much more important than the words. In *AMP Incorporated v Commissioner of Patents* (1974) AOJP 3224 at page 3227, the High Court stated:
"an amendment may be allowed where it does no more than explain what is already in the claim when it is properly construed. It may be said that such an amendment is unnecessary because it adds nothing to the claim so construed. However, when it is borne in mind that the claim is intended to speak to the world, an amendment by way of explanation so that any misapprehension can be avoided may clearly be desirable."

2.23.9.4 Broadening the Scope of the Claims

The test specified in 2.23.9.3 Allowability Under Section 102(2)(a) is useful where the amendments seek to replace claim(s) to one aspect of the invention by claim(s) to another aspect of the invention.

Claims to Article per se

A claim to an article *per se* would be infringed by the use of that article. Consequently, an amendment to claim the use of the article (in a manner already disclosed in the specification), would be a narrowing of the claim which would not make an act an infringement that was not an infringement previously (see *Farbwerke Hoechst A.G.*’s Application (1972) RPC 703). However, the reverse situation would not be allowable. A claim to the use of an article is not infringed by the article *per se* and therefore an amendment to insert a claim to the article *per se* would not be allowable (see *BoehringerIngelheim International GmbH v Commissioner* (2001) 52 IPR 529 at [42]).

Arguments to the effect that there is only one use for an article or substance, and therefore a claim to the use of that article or substance is effectively the same as a *per se* claim, are incorrect. Where such erroneous arguments are maintained, it may indicate that the applicant has a particular reason for changing the type of claims, e.g. infringement action or extension of term. In this situation, the supervising examiner should be informed of the case and if the arguments are maintained, the matter should be brought to the attention of the Assistant General Manager (OEP).

Deletion of Words and Phrases

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Effective Date: 25 September 2019
Deletion of "for use" or "suitable for use", or similar phrases from a claim may broaden the scope of the claims and therefore be objectionable.

In general, arguments that an amendment proposing the deletion of words and phrases from a claim is allowable, because such words or phrases do not delimit the claim, should be considered carefully. Although there are circumstances in which words may be deleted from a claim without any significant change in meaning, e.g. AMP Incorporated v Commissioner of Patents (1974) AOJP 3224, such situations are not at all common.

This aspect was discussed in some detail in Chrysler Aust. Ltd. v RegieNationale Des Usines Renault (1974) AOJP 4807, where it was stated:

"There is, of course, a considerable force behind the argument that deletion of a limiting clause from a claim would not be allowable under the provisions of sub-section (2) of sec 78 [1952 Act: sec 102(2)(a) of the 1990 Act corresponds]. But it is also clear that this argument may relate only to real limitations, and should not be necessarily extended to apparent limitations. In particular, one must be careful not to equate the deletion of words with the deletion of limitations, since not all words in a claim impose a limitation.

The latter aspect has been extensively dealt with in the decision of the High Court in Farbwerke Hoechst Aktiengesellschaft vormals MeisterLucius & Bruning v Commissioner of Patents 1972 AOJP 3524. The High Court allowed the deletion, from a number of claims, of the words 'of the general formula given in claim 1'. Prima facie, these words have the appearance of a definite and substantial limitation. However, in his decision, Gibbs J pointed out that the question which arises is primarily one of the interpretation of the claims in the light of the specification as a whole.

After concluding that a reading of the specification before him showed that the substance of the invention was the discovery of a process, which produced chemicals with particular properties and whose formula was unimportant, and that there was no compound that answered to the formula given in claim 1, Gibbs J stated:

"The definition of the invention in the claims now under consideration therefore comprises two parts - a correct description of the nature of the process and an incorrect statement of the formula of the resulting products. On ordinary principles of construction, if the correct part of the description defines the subject matter with certainty, the incorrect part may be rejected to enable effect to be given to the document as a whole ...... Of course, if, in the present case, the formula applied to some of the compounds produced by the process, it could not be rejected as a mere erroneous addition to the description, but would have to be given effect as limiting the class of compounds to which the description applied."

Gibbs J allowed amendments sought in relation to the process claims which entailed the deletion of the reference to the formula of claim 1, as he did not regard it as an effective
limitation and that removal of that limitation would not widen the claims, or have the result that the claims would not in substance fall within the scope of the claims before amendment.

For purposes of determining the allowability of an amendment under sec 102(2)(a), reference numerals in a claim referring to drawings, whether in brackets or not, do not place any limitations on the claim unless there is clear indication that they are intended to do so (Rodi and Wienenberger A.G. v Henry Showell Ltd. (1968) FSR 100; Lucent Technologies Inc v Krone Aktiengesellschaft (No 3) [2000] FCA 100). As a consequence, removal of these reference numerals in general will not result in the broadening of the claim. Similar considerations apply to reference numerals referring to graphics and photographs.

Modified Date: 01 February 2013

2.23.9.5 Allowability and Omnibus Claims

**Note:** The information in this part only applies to:

- requests to amend filed **before** 15 April 2013, other than those deemed under reg 10.6A to be filed **on or after** 15 April 2013.

- requests to amend filed **on or after** 15 April 2013 for:
  - standard patent applications with an examination request filed **before** 15 April 2013, and standard patents granted on such applications.
  - innovation patents with an examination request filed **before** 15 April 2013.
  - innovation patents where the Commissioner **decided before** 15 April 2013 to examine the patent.
  - standard patents granted, and innovation patents certified, **before** 15 April 2013.

For all other requests to amend, see 2.23.9.5A Allowability and Omnibus Claims.

In view of the restrictive provisions of sec 102(2)(a), the exact meaning of omnibus claims is of importance, particularly where the applicant files a completely new set of claims, or seeks to replace an omnibus claim with another form of claim. For information on the interpretation and meaning of omnibus claims see 2.11.2.3.9 Omnibus Claims.

An omnibus claim may sometimes appear to have been included for the purpose of covering every possible aspect described (or even implied) in the specification. Examples of wording of such claims are "each and every novel feature" and "the features individually and
collectively". Such claims clearly cannot be considered as defining any invention at all and their scope is indeterminate. Therefore, as a general rule, they provide no basis upon which to propose amendments allowable under sec 102(2)(a). However, it is not objectionable if such a claim is replaced by a narrow omnibus claim to features that have been claimed in a generic or substantive claim.

There may also be situations where a claim of the type mentioned above requires further consideration. Thus, in Picton Hopkins and Sons Pty. Ltd.'s Application (1965) AOJP 3118, the only claim read:

"A building partition having the features of improvement, collectively and individually as disclosed".

Amended claims, narrow in scope, were allowed to the building partitions specifically described as the invention in the specification.

In Irish's Application (1966) AOJP 321, the only claim read:

"All of the improvements herein disclosed individually and in combination".

At page 322 it was stated:

"The original claim, by no stretch of imagination, can be called clear and succinct. It does not attempt to set out in the claim a statement of any form of mechanical construction. However, by virtue of the words "all of the improvements herein disclosed" it imports any form of improved construction that is identified in the body of the specification as constituting the invention."

The claim which was ultimately allowed was narrow in scope and closely followed the consistory statement given in the provisional specification. However, this case does not serve as a precedent for situations in which no appreciation of the invention may be derived at all.

Omnibus claims should be reassessed each time amendments are proposed. Amendments to the body of the specification, the claims or the drawings may result in new objections applying to omnibus claims under either or both of the provisions of sec 102(1) and sec 102(2), i.e. claiming of matter not in substance disclosed, or broadening of scope.

Where amendments are directed solely to the description, this may result in a change to the scope of an omnibus claim. Thus, the insertion of further examples of the invention will lead to an expansion of the scope of an omnibus claim. The critical question is whether the new scope of the omnibus claim travels beyond the scope of the claims as a whole before the amendment.
Note: The information in this part only applies to:

- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and standard patents granted on such applications.

- requests to amend on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other requests to amend, see 2.23.9.5 Allowability and Omnibus Claims.

Under sec 40(3A), the claim or claims must not rely on references to descriptions, drawings, graphics or photographs unless absolutely necessary to define the invention.

In the limited circumstances where it would be absolutely necessary to define the invention in terms of an omnibus claim, the applicant may need to amend the claim before the application can be accepted. Alternatively, where an omnibus claim is not permissible, the applicant may wish to substitute the omnibus claim with another form of claim. When considering the allowability of such amendments, the scope of the omnibus claim prior to amendment may become relevant.

In view of the restrictive provisions of sec 102(2)(a), the exact meaning of omnibus claims is of importance, particularly where the applicant files a completely new set of claims, or seeks to replace an omnibus claim with another form of claim.

For information on the interpretation and meaning of omnibus claims, see 2.11.2.3.9A Omnibus Claims.

Substituting Omnibus Claims

Omnibus claims referring to "each and every novel feature" and "the features individually and collectively" are indeterminate in scope and cannot be considered as defining any invention at all. It follows that, as a general rule, they provide no basis upon which to propose amendments allowable under sec 102(2)(a).
However, in Irish’s Application (1966) AOJP 321, the only claim read:

"All of the improvements herein disclosed individually and in combination".

At page 322 it was stated:

"The original claim, by no stretch of imagination, can be called clear and succinct. It does not attempt to set out in the claim a statement of any form of mechanical construction. However, by virtue of the words "all of the improvements herein disclosed" it imports any form of improved construction that is identified in the body of the specification as constituting the invention."

The claim which was ultimately allowed was narrow in scope and in that particular case, closely followed the consistory statement given in the provisional specification. However, this case does not serve as a precedent for situations in which no appreciation of the invention may be derived at all.

In Picton Hopkins and Sons Pty. Ltd.’s Application (1965) AOJP 3118, the only claim read:

"A building partition having the features of improvement, collectively and individually as disclosed".

In this case, amended claims, narrow in scope, were allowed to the building partitions specifically disclosed as the invention in the specification.

Necessary Omnibus Claims

Where an omnibus claim is absolutely necessary to define the invention, its scope should be reassessed each time amendments are proposed. Amendments to the body of the specification, the claims, the drawings, the graphics or the photographs may result in new objections applying to omnibus claims under the provisions of sec 40(3A), sec 102(1) and sec 102(2). In particular, where a proposed amendment broadens the scope of an omnibus claim, examiners should consider whether the amendment would add new matter, contrary to sec 102(1).
Subsection 102(2) governs the allowability of proposed amendments to a complete specification of a standard patent after acceptance (including granted patents) or a certified innovation patent. The provisions of sec 102(2)(b) ensure that compliance with sec 40(2) and sec 40(3) is maintained from the unamended to the amended specification.

Proposed amendments will not be allowable under sec 102(2)(b) unless the amended specification complies with sec 40(2) and sec 40(3). Consequently, examiners must consider whether, if the amendments were made, the specification would satisfy these requirements.

2.23.10 "Clerical Error" and "Obvious Mistake"

Modified Date: 01 February 2013

2.23.10.1 General Comments

Under sec 102(3), the allowability requirements of sec 102 do not apply if the amendment is for the purpose of correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification.

The clerical error or obvious mistake need not be in the complete specification, but may simply be in relation to the complete specification. Thus, if in preparing an earlier document, for example a provisional specification or instructing letter, a clerical error or obvious mistake occurred and that error or mistake carried over to a specification prepared on the basis of the earlier document, then the provisions of sec 102(3) may apply. The onus will be on the applicant or patentee to establish that a clerical error or obvious mistake has occurred.

2.23.10.2 Clerical Error

The nature of a "clerical error" was considered fully in *R. v The Commissioner of Patents; Ex parte Martin* 89 CLR 381. The majority judgement in that case noted that:

"The characteristic of a clerical error is ... that it arises in the mechanical process of writing or transcribing."

Similarly, in *Maere's Application* (1962) RPC 182 at page 185, the hearing officer said:

"The words 'clerical error' ... mean a mistake made in the course of some mechanical process such as writing or copying as distinct from an error arising, e.g. from lack of
knowledge, or wrong information, in the intellectual process of drafting language to express intention."

Therefore, a poor translation from a foreign language is not a clerical error.

An example of a clerical error is where a person either of his or her own volition, or under the instructions of another, intends to write something and by inadvertence either omits to write it or writes something different. Thus, the incomplete revision of a template document in line with instructions has been found to be a clerical error (see BHP Billiton v Cominco Engineering [2009] APO 10). Clerical errors may also arise without intention, e.g. where a clerk misreads or misunderstands instructions and transcribes or writes the instruction as misread or misunderstood.

Certain errors in a document, on inspection of the document, may suggest a "clerical error", whilst in other circumstances, errors such as errors of omission, may only become apparent in the light of submissions and evidence from the applicant or patentee. Furthermore, in the case of some of these errors, it will not be apparent that the amendment sought would have comprised the matter that should have been present in the first place.

However, an error in reasoning cannot amount to a clerical error (see Austal Ships v Stena Rederi [2009] FCAFC 179 at [25]).

Where the applicant (or patentee) seeks the benefit of sec 102(3) on the basis of a clerical error having been made, the onus is on the applicant to make out an appropriate case for the proposed amendment including proof of the error (The Distillers Co. Ltd.'s Application (1953) 70 RPC 221). This will usually require evidence to be filed.

**2.23.10.3 Obvious Mistake**

An obvious mistake is one:

"that the instructed public can, from an examination of the specification, appreciate the existence of the mistake and the proper answer by way of correction"

General Tire and Rubber Co. (Frost's) Patent (1972) RPC 259 at page 279.

However, whilst the existence of a mistake may be obvious, the correction sought is not necessarily obvious. For example, it may be clearly apparent that a sheet of the specification is missing, however it may not be at all obvious that the sheet sought to be inserted is the sheet that should have been there in the first place. Thus, substitution of a specification for one allegedly filed by mistake was not allowed in the case of Farbenfabriken Bayer A.G.'s Application (1970) AOJP 4333.
The term "correction" means the putting right of some mistake that has been made in preparation of the specification (The National School of Salesmanship Ltd. v The Plomien Fuel Economiser Ltd. (1942) 59 RPC 95 at page 107). "Correction" should not be regarded as covering errors of judgement in the preparation of the specification as to what should be included in the claims, provided that the document, as drafted, accurately represented the intention of the draftsman at the time of drafting (Distiller Co. Ltd.’s Application (1953) 70 RPC 221).

"An error of judgment on the part of the draftsman ... is not an obvious mistake"


In Tee-Pak Inc.’s Application (1958) RPC 396 at page 398, it was stated that:

"to constitute a mistake there must be an erroneous transcription of the draftsman’s intention to express in words the description of the invention for which patent protection is sought, the manner of its performance or monopoly claim or claims made in relation to it. The word "obvious" imposes as a further qualification, the requirement that such error must be plainly evident and must be construed in an objective sense to mean so evident from an examination of the documents in the case."

A correction does not fail to be obvious merely because as a matter of drafting, there is more than one way of expressing it without affecting its meaning (Holtite Limited v Jost (Great Britain) Limited and Others (1979) RPC 81 at page 91).

Subsequent research does not make something "an obvious mistake" which was believed correct at the time of drafting (The Griffith Laboratories Application (1967) AOJP 1603).

In Egyt Gyogyszervegyeszeti Gyar’s Patent (1981) RPC 99, an application was made for a chemical compound defined by structure, molecular formula and melting points of derivatives. Subsequent research found the structure to be incorrect and it was proposed to insert the correct structure by amendment. Whilst it was argued that it was obvious that the original formula was a mistake, the new one was not allowed. However, a claim to the compound defined by its molecular formula and melting points was allowed.

The Court found that it was obvious in reading the specification as a whole that the patentees had intended to claim the product having particular characteristics of molecular formula and melting point. Graham J stated:

"... The point is what he wanted to do was to claim the result of carrying out that process. It now turns out to be the fact that the result of carrying out the process is not an imide but a diazepine. In those circumstances, it is right, when referring back to the specification, to say that not only is there an obvious mistake but also it is obvious what the answer ought to be and, therefore, he can make an amendment in accordance with section 31 even if the resultant amended claim in the specification could not be said fairly to fall within the scope of the original specification at all ..."
Where examiners are not satisfied that the mistake and the correction meet the requirements of an obvious mistake, evidence should be sought from the applicant or patentee to support the assertion that the proposed amendment is for the purpose of correcting an obvious mistake.

See also *Pittsburgh Plate Glass Co.’s Patent* (1971) RPC 55;
*Dempster Brothers Inc.’s Application* (1974) AOJP 4276; and
*Berg and Stromberg’s Application* (1985) APOR 15.

**2.23.10.4 Evidence Required to Prove a Clerical Error or Obvious Mistake**

Where a request to correct a clerical error or obvious mistake does not contravene the provisions of sec 102, evidence is not required. However, supporting evidence will usually be required where the requested amendments are for the purpose of correcting a clerical error or obvious mistake and would otherwise not be allowable under the provisions of sec 102.

Generally, in order to establish the existence of a clerical error, evidence in the form of a declaration that fully explains the facts surrounding the clerical error and the amendment sought will be required.

Where the amendment relates to the correction of an obvious mistake, evidence may be required to establish that the instructed reader of the specification would consider the mistake and the correction as satisfying the requirements of an obvious mistake.

**2.23.11 Amendments After the Grant of a Patent**

Amendments filed following the grant of a patent are inherently different to those filed during examination. As the patent has already been granted, the amendment may be motivated by
considerations other than achieving compliance with the requirements of the Act (for example, a future infringement action may be contemplated).

If an amendment is made with a view to a planned infringement action, the consequences arising from an erroneous allowance of an amendment can be significant. Similarly, amendments with a view to a future extension of term under sec 70 can have important consequences for the operation of the Pharmaceutical Benefits Scheme. Thus, these amendments carry a different risk to the public than amendments during examination.

Such cases are regarded as high risk and are therefore subject to quality assurance processes.

**Note:** For granted standard patents, examiners should always check for a statement that no relevant proceedings are pending (see 2.23.3.5 Relevant Proceedings Pending).

Modified Date: 02 April 2013

### 2.23.11.2 Allowability Criteria

Amendments to granted patents are governed by sec 102. These criteria are discussed in detail in 2.23.9 Allowability under Section 102(2) etc.

Modified Date: 02 April 2013

### 2.23.11.3 Quality Assurance Processes

All reports on amendments to a granted patent are checked by a senior examiner.

The object of the checking is to ensure that there is no consequential broadening of the scope of the monopoly, as this is the area of greatest risk to the public interest. Of particular concern are cases where there is a change in the type of claim, e.g. method claims are initially present and apparatus or substance *per se* claims are introduced.

Where an amendment merely corrects typographical errors, the checking is complete when this is determined.

### 2.23.12 Other Allowability Issues Concerning Amendments to Complete Specifications
2.23.12.1 Amendments Relating to Micro-Organisms

A proposed amendment to a complete specification is not allowable if the effect of the amendment is to remove any of the micro-organism deposit information required by sec 6(c) (Chapter 10 of the Regulations). This information includes:

- the name of a prescribed depositary institution from which samples of the micro-organism are obtainable; and
- the file, accession or registration number of the deposit given by the institution.

Amendments may be made to insert the information required under sec 6(c). These matters are dealt with in 2.7.5.1 Sections 104 and 223 - Insertion of Section 6(c) Information.

2.23.12.2 Amendments Otherwise not Allowable to a Complete Specification

In this topic:

Overview

The Commissioner may refuse a request to amend if of the opinion that the amendment is not allowable.

Where examiners become aware of any circumstances which could affect the allowance of the request, but do not in themselves give rise to an objection under sec 104(2), the case should be forwarded to the supervising examiner for consideration. If appropriate, the matter should then be referred through the supervising examiner to the Assistant General Manager (OEP).

Amendments of an accepted specification (whether or not the subject of opposition), or of a specification of a granted patent, should also be carefully checked for the possibility of extraneous effects.
For example, if there is a patent of addition, or an accepted application for a patent of addition, and a request to amend the parent specification has been filed, it is necessary to check whether the amendment would result in the claims of the additional becoming redundant, ambiguous or meaningless and, whether the invention claimed in the additional can continue to be regarded as an improvement in, or modification of, the invention claimed in the amended parent specification. Similar considerations apply where a request is made by a patentee to amend a patent of addition.

Another example is where, as a result of amendment, a specification is clearly no longer patentable or, in the case of a patent, renders the patent obviously invalid. If an otherwise allowable amendment it likely to result in invalid claims in a patent (e.g. under sec 18), examiners should consult a supervising examiner to determine whether the case should be referred to Patent Oppositions to initiate re-examination.

**Amendments During Opposition**

Where a request to amend is filed as a result of a hearing officer’s decision in opposition proceedings, examiners should consider the allowability of the amendments according to the procedure outlined in 2.23 Annex A – Section 104 Amendments During Opposition Proceedings: Check Sheet (see also 2.23.14.5 Amendments as a Result of a Decision).

**Amendments to Overcome Prior Art**

Where an amendment is sought for the reason of avoiding prior art documents that have come to the attention of the applicant or patentee (this may be apparent from the correspondence accompanying the amendment request), examiners should consider those documents.

Prior to acceptance, any relevant objections should be raised during the examination process.

After acceptance, where the proposed amendments would be objectionable under sec 40 and/or sec 18, regardless of their allowability under sec 102, examiners should consult a supervising examiner. Where appropriate, the case should then be referred to Patent Oppositions with a view to initiating re-examination.
Under sec 104, an applicant or patentee may seek to amend a patent request or any other filed document, e.g. a notice of entitlement.

Prior to acceptance of a standard patent application or certification of an innovation patent, leave to amend can be granted and the amendment allowed without advertisement. After acceptance or certification, where leave to amend is granted and the proposed amendments are in respect of:

- the complete specification; or
- the patent request or another filed document and that amendment would 'materially alter the meaning or scope of the request or document';

then the amendment must be advertised for opposition purposes (reg 10.5(2)).

An amendment may or may not materially alter the meaning or scope of a document, depending on the circumstances. For example, the addition or deletion of an inventor or nominated person will normally alter the meaning or scope of a document, whereas a minor variation of a name (e.g. to correct a spelling error) will not.

However prior to the grant of a standard patent, a proposed amendment to the name or address of the applicant does not materially alter the meaning or scope of the patent request or other filed document (reg 10.5(4)).

For further information on amending the patent request and other filed documents, see in particular the following:

- patent request
  - 2.23.13.1 Amendment of Patent Request
  - 2.10.10A Amendment of Patent Request – Conversion of Application to a Divisional
- abstract
  - 2.8.3A Amendment of Abstract
2.23.13.1 Amendment of Patent Request

- other filed documents
  - 2.23.13.10 Amendments to “other filed documents”
- amending the name of the applicant or nominated person on a patent request or notice of entitlement under sec 104 or sec 113
  - 2.6.4 Changing the Applicant or Nominated Person.

Modified Date: 01 August 2018

2.23.13.1 Amendment of Patent Request

In this topic:

**Note:** An amendment of a patent request is not allowable after the patent has been granted. This applies to innovation patents as well as standard patents.

**Note:** COG should be informed of any amendment to the patent request (see 5.5.4 Invention Details).

Form of Request to Amend, Requirement for New Patent Request

An amendment to the patent request may be included in a statement of proposed amendments under sec 104, for example an item stating:

“Amend the priority details to read US xx/xxxxxx.”

or words to that effect. The applicant may also file a replacement patent request incorporating the amendment. However, there is no formal requirement for applicants to file an amended copy of the request for reasons discussed in the paragraph below. The allowability criteria that apply are those relating to the patent request.

The patent request is a means for applicants to provide key bibliographic information that is transcribed into the record keeping systems maintained by the Commissioner. These systems are the authoritative record of the relevant facts and constitute the Register on grant. Therefore, when amending information originally provided on a patent request, it is not necessary for applicants to file an amended copy of the request. Similarly, the Commissioner will consider a request for amendment of information in the official records as
equivalent to a request to amend the patent request, and thus can be effected under sec 104. This applies regardless of whether the case is a national phase application.

The request may also be amended under sec 113 (persons claiming under assignment or agreement). Information on sec 113 and sec 104 amendments, involving a change in the name of the applicant or nominated person, is provided in 2.6.4 Changing the Applicant or Nominated Person.

**Note:** Any amendment to make the nominated person different from the applicant is of no effect, as the applicant is taken to be the nominated person (reg 3.1A). Applicants should be advised of this fact.

Where a change occurs in the stating of the inventors (including where this is as a result of restricting the invention, such that all the originally stated inventors are no longer the actual inventors of the invention), an amended request specifying the revised actual inventors must be filed as a sec 104 amendment. These amendments are processed by COG.

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**Effect of Amendments to Patent Request on Notice of Entitlement**

If a notice of entitlement was filed prior to the amendment (e.g. as part of the request for examination), then a new notice may be required. Any notice filed subsequent to the amendment must be consistent with the changed circumstances.

See also 2.6.3.1 Notices of Entitlement, Requirement for New Notice of Entitlement.

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**Non-Allowable Amendments to Patent Request**

The amendment of a patent request is **not allowable** in certain circumstances.

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**After Grant**
After grant of a patent, a patent request cannot be amended, regardless of the nature of the proposed amendment. This applies to innovation patents as well as standard patents. Therefore, when a proposed amendment to the patent request of a granted patent is received, an adverse report should be issued explaining that:

1. the proposed amendment is not allowable; and
2. rectification of the Register may be sought under sec 191A.

Note: Grant occurs automatically unless a bar to grant flag is set in PAMS. Where a proposed amendment after acceptance, but before grant, would affect what is recorded on the Register (such as an amendment to the title or to a patent request), examiners should immediately contact COG to arrange a bar to grant flag in PAMS. This ensures grant does not occur until the amendment has been allowed or otherwise finally dealt with.

After Acceptance – Conversion of Patent Application

After acceptance of a patent, an amendment to a patent request is not allowable if the proposed amendment would convert the patent application:

a. from an application for a standard patent to an application for an innovation patent; or
b. from an application for an innovation patent to an application for a standard patent; or
c. into a divisional application under sec 79B or sec 79C where both:
   - the request to amend was filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013; and
   - if the application is for a standard patent, a request for examination was not filed before 15 April 2013.

At Any Time – Conversion to Divisional Application Under Specific Circumstances

At any time an amendment to a patent request is not allowable if all of the following conditions are met:

a. the amendment would convert the application into a divisional application under sec 79B or sec 79C; and
b. the time in which a divisional application could have been filed under sec 79B(3) or sec 79C(2) (as in force after 15 April 2013) has expired; and

c. the request to amend the patent request was filed (or deemed to be filed under reg 10.6A) on or after 15 April 2013; and

d. if the application is for a standard patent, no request for examination was filed before 15 April 2013.

Note: Even if the application in question was filed before 15 April 2013, the time period that applies, with reference to sec 79B(3) and sec 79C(2), is nevertheless the same as that which would apply to a divisional application filed after that date.

Prior to Publication

An amendment to a patent request is not allowable where both of the following conditions are met:

a. the proposed amendment is requested in the 3 week period before a notice under sec 54 is due to be published including the date of publication; and

b. the proposed amendment either:

   • converts the patent application from an application for a standard patent to an application for an innovation patent; or

   • changes the priority date of the application to a later date.

2.23.13.2 Amending a Standard Patent Request to an Innovation Patent Request and Vice Versa

In this topic:

Before acceptance, a patent request can be amended under sec 104 to convert a request for an innovation patent to one for a standard patent and vice versa.
Examination Practice – Conversion From Standard to Innovation

Where the conversion is from a standard to an innovation patent application, and a first or subsequent report has issued on the standard patent application, examination must necessarily cease following the conversion, as there is no longer a standard patent application to examine. There is also no refund of the examination request fees for the standard application.

However, in the situation where there are outstanding sec 104 amendments on file, examiners should establish (by contacting the attorney if necessary) whether the applicant intends for the amendments to be included in the specification prior to the conversion, or to be treated as amendments in anticipation once the conversion has taken place. If the intention is for the amendments to be included prior to the conversion, examiners should proceed as follows:

- where the amendments are allowable, complete the voluntary sec 104 allowance form; or
- where the amendments are not allowable, issue an adverse (voluntary amendment) report, noting that any outstanding issues may not be resolved before the final date for acceptance or the conversion.

Note: In either situation, the only consideration is the allowability of the amendments, irrespective of whether the amendments address the issues raised in any previous examination report.

Where the amendments are allowed prior to the conversion, these will form part of the granted innovation patent that is subsequently created. Otherwise, the amendments will remain on the innovation patent file as amendments in anticipation.

If examiners are in any doubt about the appropriate course of action they should consult a senior examiner.

Note: The previous examination request for the standard application does not apply to the newly created innovation patent application. Instead, the innovation patent application...
Amendment Not Allowable

**Note:** An amendment to a patent request is not allowable after the patent has been granted. This applies to both standard patents and innovation patents.

After acceptance, an amendment which would convert an innovation patent application to one for a standard patent and vice versa is not allowable (Chapter 10 of the Regulations).

An amendment to a patent request **relating to an innovation patent application upon which a patent has not yet been granted** is not allowable if:

- the patent application was provided for in sec 79C (divisional application for an innovation patent made after grant of an innovation patent); and
- the effect of the proposed amendment would be to convert the application from one for an innovation patent to one for a standard patent (sec 102(2B)).
In general, a request to amend a non-Convention to a Convention patent request will, if allowed, 'materially alter the meaning or scope of the request'. This is because the amendment will *prima facie* change the priority date of the claim(s) of the complete specification, resulting in an earlier priority date than would otherwise be the case had the patent request remained a non-Convention one.

Prior to acceptance, leave to amend can be granted and the amendment allowed without advertisement. After acceptance leave to amend must be advertised before the amendment is allowed (reg 10.5(2)).

As indicated above, such an amendment *prima facie* results in the claims having a later priority date, i.e. the date of filing of the original patent request and complete specification. Therefore, any previous novelty assessment may need to be reviewed if the application has been examined and accepted. If examiners are aware of any documents that would cast doubt on the novelty of the claims if the amendment was made, leave to amend should not be granted. Instead, examiners should consult a supervising examiner to determine whether the case should be referred to Patent Oppositions to initiate re-examination.
Modified Date: 01 August 2018

2.23.13.5 Amending Convention Particulars on a Patent Request

Note: COG should be informed of any amendment to the patent request (see 5.5.4 Invention Details).

In general, requests to amend the Convention particulars require similar consideration to that outlined in 2.23.13.3 Amending a Non-Convention Patent Request to a Convention Patent Request. Prior to acceptance, leave to amend can be granted and the amendment allowed without advertisement. After acceptance, the following leave to amend must be advertised before allowance (reg 10.5(2)):

- the grant of leave for a request to amend the date of filing of the basic application to an earlier date;
- the grant of leave for a request to amend the date of filing of the basic application to a later date; and
- the grant of leave for requests which seek to correct details of the basic country, the basic application number or the date. For example, a change of priority document number by merely one digit can have a profound impact upon the priority date of the claims, i.e. from no priority to full priority. (Note, however, that if the detail being corrected is an obvious mistake then advertisement is not required).

Unless the Convention details are obviously incorrect (e.g. priority date after date of filing), then evidence is required to support the amendment. Evidence such as the basic document or relevant correspondence should be requested, unless suitable evidence is already on file.

Modified Date: 01 August 2018

2.23.13.6 Adding a Second or Subsequent Basic Application to a Convention Patent Request

Note: COG should be informed of any amendment to the patent request (see 5.5.4 Invention Details).

The only reason for adding an extra priority document is the possibility (as considered by the applicant) that it will materially affect the priority date of at least some of the claims. Prior to acceptance, leave to amend can be granted and the amendment allowed without
2.23.13.7 Amending a Patent Request to a Patent Request for a Patent of Addition

advertisement. After acceptance leave to amend must be advertised before the amendment is allowed (reg 10.5(2)).

Modified Date: 01 August 2018

2.23.13.7 Amending a Patent Request to a Patent Request for a Patent of Addition

Note: COG should be informed of any amendment to the patent request (see 5.5.4 Invention Details).

Where a request to amend the patent request to one for a patent of addition is made, the patent request and complete specification must be checked to determine whether they are suitable to become a patent of addition. If this is the case, then prior to acceptance leave to amend can be granted and the amendment allowed without advertisement. After acceptance leave to amend must be advertised before the amendment is allowed, as the proposed amendment will materially alter the meaning of the patent request (reg 10.5(2)).

If the patent request and complete specification are not suitable to become a patent of addition after acceptance, the case should be referred to the Assistant General Manager (OEP) via a supervising examiner.

Modified Date: 01 February 2013

2.23.13.8 Amendments to a Provisional Specification

Note: The information in this part only applies to provisional applications filed before 15 April 2013. For all other provisional applications, see 2.23.13.8A Amendments to a Provisional Specification.

A proposed amendment of a provisional specification is not allowable if it would materially alter the meaning or scope of the specification (reg 10.3(1)).

In considering whether an amendment materially alters the meaning or scope of the specification, it must be noted that the purpose of a provisional specification is to provide the basis for priority rights when seeking a patent in Australia or overseas. Furthermore, when determining priority dates, all material contained in a provisional specification is taken to
have been filed on its filing date. There is no mechanism to accord a different date to material added to a provisional specification by way of amendment.

Examples of amendments that would materially alter the meaning or scope of the specification are:

- addition of “missing” pages;
- insertion or deletion of text; and
- correction of formulae.

Examples of amendments that would not materially alter the meaning or scope of the specification are:

- correction of spelling (noting that some “corrections” of spelling could give rise to a material change of meaning);
- grammatical corrections (noting that a correction to remove a real ambiguity would materially alter the meaning or scope);
- renumbering of items in the drawings with corresponding changes in the text; and
- changing measurement units to clearly equivalent measurement units (e.g. from degrees Fahrenheit to degrees Centigrade).

Subsection 102(3) provides a general exemption from the provisions of sec 102(1) and sec 102(2) for the purpose of correcting a clerical error or obvious mistake in a complete specification. However, there is no such exception for the amendment of provisional specifications. Therefore, an amendment to correct a clerical error in a provisional specification is not allowable if it would materially alter the meaning or scope of the specification.

In general, an amendment which is properly in the category of correcting an ‘obvious mistake’ would not materially alter the meaning or scope of the specification. Similarly, amendments that make no change in the technical disclosure, such as replacing quantities with exact equivalences, or replacing imperial measurements with equivalent metric measurements, would not materially alter the meaning or scope. Otherwise, there is a high presumption that the amendment would materially alter the meaning or scope of the document and is not allowable. In particular, any amendment which is ‘worthwhile’ would appear to fall within this category.

When a request is made for a certified copy of a provisional specification which has been amended, copies of the specification as filed and as amended, are certified together, and supplied. As the determination of priority dates is the responsibility of each individual jurisdiction, that determination can only be made if the jurisdiction is aware of the disclosure in the specification as filed, as well as the specification as amended.
A proposed amendment of a provisional specification is not allowable if, as a result of the amendment, the specification would claim or disclose matter that extends beyond that disclosed in the following documents taken together:

- the provisional specification as filed;
- an abstract that was filed with the provisional specification;
- a missing part of a provisional application that was incorporated into the specification in accordance with reg 3.5A.

(reg 10.3(1))

For information on the considerations for determining whether an amendment would claim or disclose matter that extends beyond that disclosed in the relevant documents taken together, see 2.23.8.1A The Section 102(1) Provisions Explained, Meaning of “claim or disclose matter that extends beyond”.

Subsection 102(3) provides a general exemption from the provisions of sec 102(1) and sec 102(2) for the purposes of correcting a clerical error or an obvious mistake, or for complying with sec 6(c) (deposit requirements). However, there is no such exception for the amendment of provisional specifications. Therefore, an amendment to correct a clerical error in a provisional specification is not allowable if, as a result of the amendment, the provisional specification would claim or disclose matter that extends beyond that disclosed in the relevant documents taken together.

In general, an amendment which is properly in the category of correcting an 'obvious mistake' would not result in the specification claiming or disclosing matter that extends beyond that disclosed in the provisional specification as filed (together with other relevant documents). Similarly, amendments that make no change in the technical disclosure, such as replacing quantities with exact equivalences, or replacing imperial measurements with equivalent metric measurements, would not extend beyond the earlier disclosure. Otherwise, there is a high presumption that the amendment would result in the specification
claiming or disclosing matter that extends beyond that disclosed in the relevant documents. In particular, any amendment which is 'worthwhile' would appear to fall within this category.

When a request is made for a certified copy of a provisional specification which has been amended, copies of the specification as filed and as amended, are certified together, and supplied. As the determination of priority dates is the responsibility of each individual jurisdiction, that determination can only be made if the jurisdiction is aware of the disclosure in the specification as filed, as well as the specification as amended.

An amendment to a request for examination is generally allowable. However, the circumstances in which a request requires amendment are likely to be rare.

In this topic:

A notice of entitlement is a filed document which can be amended under sec 104; see also 2.6.4 Changing the Applicant or Nominated Person.

However, certain filed documents cannot be amended under sec 104. These include statutory declarations, certificates and sworn documents (see Horst Johannes Wohlgemuth’s Application (1970) 40 AOJP 4037).
2.23.13.10 Amendments to "other filed documents"

Documents That are Not Filed Documents

The front sheet of a PCT pamphlet is not a filed document and therefore may not in itself be amended under sec 104. However, the information contained on the front sheet (and which is normally found in a patent request) is recorded as bibliographic data in PAMS and may be amended. See also 2.20.3.1 Patent Request Form.

Substantial Amendment

Where an amendment request relates to a filed document and the proposed amendment is substantial, it may in effect constitute the filing of a new document, as distinct from the amendment of the document already filed. In this case, the request under sec 104 may not be appropriate and a request under sec 223 may be required instead.

Amendment of Documents That Relate to a Basic Application

A copy of the specification relating to the basic application can be amended under sec 104, for the purpose of correcting a clerical error or obvious mistake, by filing a new document. Such a document is regarded as an amendment and not a late filing.

In certain circumstances, at the time of filing a copy of the basic specification and its annexed translation, the translation may have been incorrect or otherwise not verified to the satisfaction of the Commissioner. If the applicant, before acceptance, wishes to voluntarily file a new translation, or to restate the verification of the translation of the basic specification, an additional certified translation may be filed, without invoking sec 104. This should be accompanied by a statement and evidence, if required, providing details of, and reasons for, the unsatisfactory aspects of the originally filed document. An extension of time is not required for the filing of such a document (see Saint-Gobain Industries' Application (1978) AOJP 1364). After acceptance, sec 104 must be invoked for this purpose.

For translations filed after 25 September 2019, where the Commissioner believes that the translation does not accurately reflect the contents of the basic specification, the applicant may be requested to file a corrected translation and/or certificate of verification (see 2.15.7.3 Request for Corrected Translation or Certificate of Verification).
2.23.14 Amendments During Section 59 Opposition and Section 101M Opposition Proceedings

Modified Date: 01 February 2013

2.23.14.1 General Comments

Regulations 10.2(6) and 10.2(6A) provide that if the grant of a standard patent is opposed under sec 59, or a certified innovation patent is opposed under sec 101M, and the applicant or patentee requests leave to amend the patent request or complete specification, the Commissioner must:

- provide a copy of the request and the statement of proposed amendments to the opponent as soon as practicable after the applicant or patentee has filed the request; and
- invite the opponent to comment on the request and statement of proposed amendments.

The primary purpose of this provision is to facilitate resolution of the opposition proceedings. Thus, the applicant or patentee is provided with the opportunity to consider the views of the opponent on the proposed amendments and consequentially to rectify any deficiencies identified by the opponent.

Modified Date: 01 October 2015

2.23.14.2 Issuing the Invitation

When a request to amend an application or patent under opposition is filed, Patent Oppositions will arrange for a copy of the request, the proposed amendments and any submissions to be sent to the opponent, and invite them to comment on the amendments within the allowed period. In accordance with reg 10.2(7), the period provided is 21 days. If the opponent does not consider 21 days sufficient, they may seek further time (up to the maximum of 2 months from the initial invitation) to comment. Any such request should be accompanied by reasons and should not be assumed as being automatically available. If an examiner receives a case file with amendments for consideration and the invitation has not been issued, the file should be returned to Patent Oppositions for processing. Once the
invitation has been issued, the file will be returned to the examiner for consideration of the amendments (see 2.23.14.4. Considering the Amendments).

This topic is reserved for future use.

2.23.14.4 Considering the Amendments

Modified Date: 01 October 2015

2.23.14.4.1 Task Priority

When examiners receive a file for consideration of amendments during opposition proceedings, they must give high priority to the task and ensure the file is returned to Patent Oppositions as soon as possible (see also 2.2.5 Work Priorities and Case Allocation).

2.23.14.4.2 Proposed Amendments are Allowable

Where the proposed amendments are considered allowable, the action required by examiners will vary depending on whether the opponent has provided any comments on those amendments. For information on the procedures to be followed, see 2.23 Annex A – Section 104 Amendments During Opposition: Check Sheet and 2.23.14.4.5 Dealing with Comments.

2.23.14.4.3 Proposed Amendments are not Allowable

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Where the proposed amendments are not allowable, the action required by examiners will vary depending on whether the opponent has provided any comments on those amendments. For information on the procedures to be followed, see 2.23 Annex A – Section 104 Amendments During Opposition: Check Sheet and 2.23.14.4.5 Dealing with Comments.

Modified Date: 01 October 2015

2.23.14.4.4 Further Proposed Amendments

If the applicant or patentee files a further statement of proposed amendments, Patent Oppositions will send the opponent a copy of the amendments and any submissions, together with an invitation to comment.

The amendments will then be forwarded to the examiner for consideration. The procedures outlined in 2.23.14.4.2 Proposed Amendments are Allowable or 2.23.14.4.3 Proposed Amendments are not Allowable should be followed as appropriate.

Modified Date: 01 October 2015

2.23.14.4.5 Dealing with Comments

When comments on a statement of proposed amendments are received from an opponent, examiners must reconsider any previous report or opinion under sec 104, having regard to those comments.

The opponent can provide comments on any issue and is not restricted to the allowability criteria of sec 102. Thus, for example, the opponent may address issues of novelty. However, adverse comments that go beyond the sec 102 criteria are irrelevant to the allowability of the amendments and therefore cannot form the basis of an objection in an adverse report under sec 104.

For information on the procedures to be followed when comments are received from an opponent, see 2.23 Annex A – Section 104 Amendments During Opposition Proceedings: Check Sheet.

Modified Date: 01 October 2015
2.23.14.5 Amendments as a Result of a Decision

Where a hearing officer in an *inter partes* matter has issued a decision which gives an opportunity to amend, examination of the amendment must be conducted by a person other than the hearing officer.

Examiners should have regard to whether the proposed amendments overcome the deficiencies identified in the decision. Where it appears that the amendments do not overcome those deficiencies, this should be communicated to the applicant or patentee by means of observations in a report, using the normal adverse report format for voluntary amendments (see PERP code [G60]). However, the failure of the amendments to overcome the deficiencies identified in the decision does not, in itself, provide a basis for refusing to allow the request to amend. If the applicant or patentee indicates the intention to persist with the amendments, examiners should consider those amendments in the usual manner. In determining whether an observation is warranted, examiners should take into account any comments received from the opponent (see 2.23.14.4.5 Dealing with Comments).

Examiners should not enter into a detailed debate about whether the deficiencies in the decision have been overcome. Where it appears that the applicant or patentee wishes to debate the observation, examiners should contact Patent Oppositions for advice on how to deal with the matter.

Modified Date: 01 February 2013

2.23.14.6 Opposing Allowance of the Amendments

Opponents who have been invited to comment on proposed amendments are not precluded from opposing the allowance of those amendments, nor restricted in their opposition under sec 59 or sec 101M by any comments they may have provided under reg 10.2(7).

Modified Date: 15 April 2013

2.23.14.7 Amendments Where Opposition Decision is Being Appealed

If a request to amend an application under sec 104 is filed while an opposition decision is being appealed, the Commissioner will refuse the request. Under sec 112A, an amendment of a complete specification is not allowable where an appeal against a decision of the

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Effective Date: 25 September 2019
2.23.15.1 Standard Patents

Commissioner has been made to the Court (see also 2.23.3.4 Amendments Arising Out of Decisions or Directions Under Appeal).

2.23.15 Opposition to Amendments

Modified Date: 01 February 2013

2.23.15.1 Standard Patents

Note: The information in this part only applies to:

- requests to amend filed before 15 April 2013, other than those deemed under reg 10.6A to be filed on or after 15 April 2013.

- requests to amend filed on or after 15 April 2013 for:
  - standard patent applications with an examination request filed before 15 April 2013, and standard patents granted on such applications.
  - standard patents granted before 15 April 2013.

For all other requests to amend, see 2.23.15.1A Standard Patents.

There is no opposition available for sec 104 amendments allowed before or at acceptance. However, where an examiner has inadvertently allowed an amendment which in fact was not in substance disclosed, the provisions of sec 114(1) and reg 3.14(b) will operate to give a later priority date to the amended claim.

After the specification has been accepted, the particulars of the request to amend are advertised in the Official Journal. The purpose of this advertisement is to set a time limit for any opposition proceedings. The only ground for opposition to allowance of a proposed amendment of a complete specification is that the amendment is not allowable under sec 102 (reg 5.3(4)).

After acceptance, amendments which would materially alter the meaning or scope of the patent request or other filed document are also advertised for opposition purposes.

Note, however, that advertisement does not mean the amendment has been allowed. Actual allowance is advertised in a separate advertisement under the provisions of sec 110.

Where amendments are opposed, the allowance or refusal of the amendments will be determined when a decision is made on the opposition. Examiners should note that a
decision which finds that any one of the amendments is not allowable has the effect of refusing to allow all amendments proposed with the request to amend. This is also the case where the statement of proposed amendments which accompanied the request to amend is amended by the filing of a further statement of proposed amendments. The effect of refusing to allow any one of the amendments in this situation would be to refuse all amendments the subject of the earlier and further statements of proposed amendments.

Where a request to amend is filed following an interim decision in opposition proceedings, while an opponent has the opportunity to provide comments (reg 10.2(7)), failure to do so does not preclude that opponent from opposing the request after it is advertised.

Where the Commissioner refuses an amendment request under reg 10.4 and a Court reverses the decision of the Commissioner, such reversal implies, in cases which have not been accepted, that the amendment should be allowed. However, where the case has been accepted, the Court's reversal allows for an advertisement under reg 10.5(2), and for possible opposition proceedings under the provisions of Chapter 5.

Note: The information in this part only applies to:

- requests to amend filed, or deemed under reg 10.6A to be filed, on or after 15 April 2013, for standard patent applications where a request for examination was not filed before 15 April 2013, and
- standard patents granted on such applications.

For all other requests to amend, see 2.23.15.1 Standard Patents.

There is no opposition available for sec 104 amendments allowed before or at acceptance. However, where an examiner has inadvertently allowed an amendment which adds new matter contrary to sec 102(1), the provisions of sec 114(1) and reg 3.14 will operate to give a later priority date to the amended claim.

After the specification has been accepted, the particulars of the request to amend are advertised in the Official Journal. The purpose of this advertisement is to set a time limit for any opposition proceedings. The only ground for opposition to allowance of a proposed amendment of a complete specification is that the amendment is not allowable under sec 102 or reg 10.3 (reg 5.21).
After acceptance, amendments which would materially alter the meaning or scope of the patent request or other filed document are also advertised for opposition purposes.

Note, however, that advertisement does not mean the amendment has been allowed. Actual allowance is advertised in a separate advertisement under the provisions of sec 110.

Where amendments are opposed, the allowance or refusal of the amendments will be determined when a decision is made on the opposition.

Where a request to amend is filed during opposition proceedings, either before or after any decision, while an opponent has the opportunity to provide comments (reg 10.2(7)), failure to do so does not preclude that opponent from opposing the request after it is advertised.

Where the Commissioner refuses an amendment request under reg 10.4 and a Court reverses the decision of the Commissioner, such reversal implies, in cases which have not been accepted, that the amendment should be allowed. However, where the case has been accepted, the Court's reversal allows for an advertisement under reg 10.5(2), and for possible opposition proceedings under the provisions of Chapter 5 (reg 5.10(1)).

The practice and procedure concerning the opposition to amendments to innovation patents is the same as for standard patents,* except that the particulars of the request to amend are not advertised until after a decision to certify has been made under sec 101E (reg 10.5.2(a)).

Note: *For

- requests to amend filed before 15 April 2013,
- requests to amend filed on or after 15 April 2013 for:
  - innovation patents with an examination request filed before 15 April 2013;
  - innovation patents where the Commissioner decided before 15 April 2013 to examine the patent;
  - innovation patents certified before 15 April 2013;

see 2.23.15.1 Standard Patents.
For:

- requests to amend filed on or after 15 April 2013 for innovation patent applications, and innovation patents where a request for examination was not filed before 15 April 2013, or the Commissioner had not decided before 15 April 2013 to examine the patent;

see 2.23.15.1A Standard Patents.

Modified Date: 01 February 2013

2.23.16 Amendment of Refused Application

Where the Commissioner has refused an application, the Commissioner is unable to deal with any request to amend the application. The Commissioner becomes functus officio at the time the decision to refuse becomes operative, and any pending amendment requests are res nullae (see Kyowa’s Application [1969] FSR 183).

Annexes

Modified Date: 01 February 2019

Annex A - Section 104 Amendments During Opposition Proceedings: Check Sheet

PATENT OPPOSITIONS ACTION:

Application/Patent No ______________________

Statement of proposed amendments no _____ (1st, 2nd, 3rd, etc)

The Regulations require amendments proposed on an application under opposition to grant, to be provided to the opponent for comment.

HAVE AMENDMENTS BEEN PROPOSED AFTER A SUBSTANTIVE DECISION HAS BEEN ISSUED? YES/NO
DATE STATEMENT OF PROPOSED AMENDMENTS FILED BY APPLICANT/PATENTEE

DATE COPIES FORWARDED TO OPPONENT BY OPPOSITION OFFICER

DATE COMMENTS FROM OPPONENT DUE

Examiners should note that Patent Opposotions will send a copy of the request (if any) and the amendments to the opponent and invite them to file comments within 21 days of the date of the letter. If the opponent does not consider 21 days sufficient, they may seek further time (up to the maximum of 2 months from the initial invitation) to comment.

If the invitation has not been sent, examiners should bring this to the attention of Patent Opposotions. Examiners must not grant leave to amend until the opponent(s) have had the opportunity to consider the amendments.

PLEASE RETURN THE FILE TO PATENT OPPOSITIONS ONCE THE AMENDMENTS HAVE BEEN CONSIDERED - DO NOT HOLD ONTO THE FILE

HAVE COMMENTS BEEN RECEIVED? YES/NO
HAS THE TIME FOR FILING COMMENTS EXPIRED? YES/NO

1. EXAMINER ACTION: COMMENTS HAVE NOT BEEN RECEIVED.

A. IF THE TIME FOR FILING COMMENTS HAS EXPIRED AND:

(i) the report is adverse, issue the report as per normal (Note: There is no statutory time period for the applicant to respond to an adverse report, however the Commissioner’s expectation is that the applicant responds in a timely manner – Patent Opposotions to monitor); or

(ii) the report is clear, the examiner should grant leave to amend and direct advertisement of the amendment.

B. IF THE TIME FOR FILING COMMENTS HAS NOT EXPIRED AND:

(i) the report is adverse, issue the report and include a note that the time for comments has not yet expired and that comments will be forwarded when
received. If the comments are received proceed as per EXAMINER ACTION: COMMENTS HAVE BEEN RECEIVED (see below).

(ii) the report is clear, place a note to that effect on the correspondence file drawing this to the attention of Patent Oppositions, then return the file to Patent Oppositions. When the time for comments expires the file will be returned to the examiner. If no comments have been received, the examiner is then to grant leave to amend and direct advertisement of the amendments. If comments are received proceed as per EXAMINER ACTION: COMMENTS HAVE BEEN RECEIVED (see below).

### 2. EXAMINER ACTION: COMMENTS HAVE BEEN RECEIVED.

**DATE COMMENTS FILED BY OPPONENT**

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_____/_____/_____
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#### A. IF AN ADVERSE REPORT IS WARRANTED

A report is to be issued (or another report, if a report has already issued) as per normal (see note above in 1(A)).

#### B. IF AN ADVERSE REPORT IS NOT TO ISSUE

The examiner should immediately grant leave to amend and direct the advertisement of the amendments.
Annex B - Guidelines for Completing the Voluntary Section 104 Allowance Form

General Requirements

A request for leave to amend other than in anticipation of, or in response to, an examination report is generally termed a voluntary request, and the proposed amendments accompanying such a request voluntary amendments.

As a precursor to allowing amendments to a complete specification, the Commissioner must grant leave to amend.

Voluntary Amendments Filed Before Examination

For voluntary amendments filed before examination, the amendments are allowed immediately after leave to amend is granted. In these situations, examiners should complete the S104 Voluntary Amendment Allowance Before Acceptance template in Intelledox. This template is accessed by selecting Acceptance Forms from the Create Correspondence screen in PAMS (see 4.11.9 Allowing Voluntary S104 Amendments).

Voluntary Amendments Filed After Acceptance

For voluntary amendments filed after acceptance, the amendments are not allowed immediately after leave to amend is granted. Where the leave to amend relates to a complete specification which has been accepted, a notice of that fact must be published in the Official Journal. A period of 2 months from the date of publication of the notice is allowed for an opposition to be filed against the allowance of the amendments. The amendments cannot be allowed before this period has expired, or if an opposition is filed.

The two-stage procedure for processing voluntary amendments filed after acceptance is outlined below.

Granting Leave to Amend
At the time of granting leave to amend, examiners need only complete the relevant portions of the S104 Voluntary Amendment Allowance After Acceptance template or S104 Voluntary Amendment Allowance After Grant template in Intelledox. These templates are accessed by selecting Acceptance Forms from the Create Correspondence screen in PAMS (see 4.11.9 Allowing Voluntary S104 Amendments).

Notes:

a. Do not formally allow the amendments at this time.

b. Leave to amend a granted patent is not to be granted before a current indication is given that no relevant proceedings are pending. If no indication is already on file, examiners should request that the patentee provide one.

c. Leave to amend a granted patent is not to be granted unless any registered mortgagee or exclusive licensee has consented in writing to the amendment. Examiners are to check for any registered mortgagee or exclusive licensee and, where these exist, request a consent if not already provided (see 5.13.6 How to Check for a Mortgagee or an Exclusive Licensee).

Allowance of the Amendments

COG will diary the case for 2 months and 2 weeks from the date of advertisement. If no opposition is filed within this period, COG will allow the amendments. For voluntary amendments filed in respect of a granted patent, COG will seek a further indication from the patentee that no relevant proceedings are pending before allowance of the amendments. COG will also at this time confirm whether consent is needed from a registered mortgagee or exclusive licensee.
2.24.1.2 Direction to Request Examination

The applicant must file a request for examination before examination of a standard patent application may begin (reg 3.15). Similarly, the patentee or a third party must file a request for examination before examination of an innovation patent may commence (reg 9A.1).

Modified Date: 25 February 2019

2.24.1.2 Direction to Request Examination

The Commissioner may direct the applicant to ask for examination. A direction may be issued where any of the conditions specified in reg 3.16(1) are satisfied. Examiners are unlikely to be involved in the issue of directions, except where the applicant of an application for a patent of addition has requested examination of the additional, but has not requested examination of the parent (see 2.19.2.1 Examination Practice).

Under sec 44(3), a person may require the Commissioner to direct the applicant to ask for examination. The Commissioner must give a direction, unless the applicant has already asked, or been directed to ask, for examination (sec 44(4)).

Where the Commissioner directs an applicant to request examination, the applicant must file the request within 2 months from the date of the Commissioner's direction. If examiners become aware of an application containing a request filed outside the 2 month period, and for which lapsing action has not taken place, the case should be referred to COG.

Alternatively, the applicant does not have to wait for a direction and may voluntarily ask for examination within 5 years from the date of filing of the complete specification (reg 3.15).

The final date to request examination in all circumstances is 5 years from the date of filing. If no examination request is made before this date (whether it is a voluntary request or a request made following a direction) the application will lapse.

2.24.2 Withdrawal of Applications (Section 141, Regulation 13.1A)

Modified Date: 01 June 2015

2.24.2.1 Withdrawal Opportunity and Effect

An applicant may withdraw an application under sec 141 at any time before grant, except for the three week period prior to the due date on which a notice is to be published in the Official Journal that the application is OPI, or the three week period prior to the due date for

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Effective Date: 25 September 2019
acceptance to be advertised in the Official Journal. If the request is filed during the prescribed period, that notice is of no effect, and the applicant should be advised as follows:

"I refer to your request to withdraw this application, which was filed on xxxxx. I advise that the date of filing your request was within a period prescribed by regulation 13.1A(1), and accordingly is of no effect. If you wish the application to be withdrawn, you will need to file a new request after the prescribed period has expired."

A request for withdrawal must be in writing and signed by the applicant. There is no approval process for a withdrawal and the withdrawal is effective on the date the request is received. A notice of the withdrawal is published in the Official Journal.

While it is possible to withdraw a lapsed application, it is unusual to do so. Rather, an application to withdraw a lapsed application may be an indication that the applicant has identified the wrong application (see 2.24.2.2.1 Reversing Withdrawal of an Application). Unless the request notes that the application is lapsed, and despite this they request withdrawal, the applicant should be asked to confirm that they wish to withdraw the application despite it being lapsed. If confirmation is received, the withdrawal will be processed.

Note: Special considerations apply where the applicant wishes to withdraw an application that has been opposed under sec 59. In particular, the consent of the Commissioner is required.

Effect of Withdrawal

The effect of a withdrawal is to stop any further processing of the application, however documents on the case file remain in the Office. Withdrawal of an application also means:

- the application will not be OPI if it has not been advertised under sec 54;
- the applicant of a withdrawn application may be entitled to at least a part refund of fees in an amount which will depend on the circumstances of the particular case;
- the application cannot be used as a citation in a "whole of contents" novelty objection if it is withdrawn before it has been advertised under sec 54;
- the application cannot be used as the parent of a divisional application under sec 79B or sec 79C filed after the date of the withdrawal; and
- any requests for amendment under sec 104 involving the application cannot be processed further.
Generally withdrawal of an application is final and a notice cannot itself be withdrawn or the withdrawal reversed. However, in very limited circumstances a request to withdraw an application may be considered to have no effect and reversed – see 2.24.2.2.1 Reversing Withdrawal of an Application.

Withdrawn Ecases are usually marked with the status "WITHDRAWN" on the ECcase Summary screen in PAMS, however occasionally this may be omitted. Examiners should therefore check the contents of the case prior to issuing any report. In particular, examiners should check the correspondence to see whether it contains an applicant's written notice of withdrawal.

An application may only be withdrawn following a request in writing signed by the applicant or each joint applicant. There is no prescribed form and no fee is payable. A letter from the patent attorney nominated in the address for service, stating that the application is withdrawn, or requesting its withdrawal, is sufficient. However, the patent attorney must sign the letter. The name of the firm of patent attorneys is not sufficient.

A person signing a request to withdraw an application must ensure that they have the authority to do so. This is particularly important where there are multiple applicants.

In general, withdrawal of a patent application cannot be reversed. This is intended to promote public certainty around the status of patent rights and give effect to Article 4 C(4) of the Paris Convention which permits certain patent applications to be disregarded for the purpose of that Article only if, at the relevant time, the application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding. Given the serious consequences of withdrawal, the Act requires a notice of withdrawal to be signed by the applicant and, by extension, each applicant where there is more than one.
2.24.2.3 PCT Application

There are no statutory provisions allowing withdrawal to be reversed, however there are two circumstances where the Commissioner may consider a notice of withdrawal to have no effect:

1. It is apparent on the face of the notice or on the basis of information available to the Commissioner that the person or persons who signed the request were not the applicants and did not have an express or implied authority from the applicants to make the request.

   An example of this is where a patent attorney files a notice, but it is subsequently found that the attorney only had the authority to act for one of a number of joint applicants.

2. The notice of withdrawal results from a clerical error, that is, an error that arises in the mechanical process of writing or transcribing, or where a person misreads or misunderstands instructions and transcribes or writes the instruction as misread or misunderstood.

   Examples of this type of error include where the notice includes the wrong application number or where instructions to an attorney or clerical assistant are misunderstood as a request to withdraw the application.

A withdrawal cannot be reversed in other circumstances even if the decision to request withdrawal was based on an erroneous belief or error in judgement by the applicant or their attorney.

Where a notice of withdrawal is invalid on its face and should not have been processed by the Commissioner, withdrawal will be immediately reversed. In other cases, the Commissioner may not reverse the withdrawal if the applicant does not act promptly to notify the Office of the relevant circumstances. The Commissioner may alternatively require steps be taken to protect third party interests, for example, publication of a notice of the proposed reversal with the opportunity for third parties to be heard – see AMP Inc's Application (1978) AOJP 2335. This recognises the potential impact on third parties who may have acted on the basis of the withdrawal and that there are no 'protection and compensation provisions' similar to those provided by sec 223(9) and reg 22.21.

Modified Date: 01 March 2013

2.24.2.3 PCT Application
2.24.2.4 Stated Disinterest in Proceeding with the Application

A letter from an applicant or its patent attorney stating that an application will not be further processed, or that the applicant no longer intends to proceed with the application, is not a proper request to withdraw the application. Where the Office receives such a letter, the application will remain in force until it lapses, for example through the failure to pay a continuation fee. Until the application lapses, miscellaneous official actions not requiring any prescribed fee, such as publication under sec 54(3), the issue of a further report where amendments have been filed or acceptance where a clear report has been issued, will continue to take place. However, examiners should not issue a first examination report on such cases, or issue a first report pursuant to a voluntary request to amend under sec 104, before the continuation fee becomes due, even though a request for examination or a sec 104 request to amend has been filed. Instead, the supervising examiner is to write to the applicant acknowledging receipt of the letter and stating that no action will be taken in relation to the examination or amendment request unless and until the continuation fee is paid. If the continuation fee is paid on or before it is due, normal processing of the application is resumed, otherwise the application will lapse.

Modified Date: 01 April 2011

2.24.2.5 Indexing if Withdrawn After OPI

An application withdrawn after it becomes OPI should be fully indexed, as it forms a normal part of the search records of the Office.

Where an application is withdrawn before publication, it can only be searched on PAMS using the Non-OPI Search Engine (NOSE) (see 5.8.9 Non-OPI Search Enquiry). Detailed bibliographic data and documents will also not be available on AusPat or eDossier, or sent to external databases, e.g. EPOQUE.
2.24.6 Amendments Proposed After Withdrawn

Where amendments are proposed under sec 104 in respect of a withdrawn application, the matter should be referred to the supervising examiner who will then communicate the facts of the case to the applicant.

2.24.7 Related Applications

The withdrawal of an application does not result in the withdrawal of any related applications for patents of addition that are made before the date of withdrawal. The application for the patent of addition may be examined (as an independent application), provided a request for examination is filed and the patent request form is appropriately amended in due course. The applicant is also entitled to amend the application for the patent of addition under sec 104, before filing the request for examination.

2.24.3 Lapsing of an Application

2.24.3.1 Lapsing Under Section 142

An application will lapse under sec 142 as follows:

- A provisional application will lapse at the end of the prescribed period. Usually this is 12 months after its filing date, or if the prescribed period is extended, at the end of the extended period.

- A complete application for a standard patent will lapse where any one of the following apply:
  - the applicant has not requested examination within 5 years of filing of the complete application.
2.24.3.2 Lapsing for Non-payment of Continuation Fee

- the Commissioner has directed the applicant to request examination, and the applicant has not requested examination within the prescribed period.

- the applicant has failed to pay a continuation fee within the prescribed period. The prescribed period is the period ending at the last moment of the anniversary of a date which would be the date of the patent if a patent were granted on the application. For a divisional application, the date of the patent granted on such an application is the date of the patent of the parent application.

- the patent request and complete specification are not accepted within the prescribed time. The prescribed time for acceptance is outlined in 2.15.6 Time for Acceptance.

- if the application is a PCT application, under prescribed circumstances.

Where, under sec 107, the Commissioner has directed the applicant to amend a standard application and the applicant has not complied with the direction within the time specified by the Commissioner, then the application will lapse.

An application that has lapsed may be restored if the relevant time is extended under sec 223. Under the provisions of sec 223, an extension of time:

- must be allowed by the Commissioner where, because of an error or omission by Office staff, a relevant act has not been done within a prescribed time; or

- may be allowed by the Commissioner where, either because of an error or omission by, or on behalf of, the person concerned, or due to circumstances beyond the control of the person concerned, a relevant act has not been done within a prescribed time.

The meaning of 'relevant act' is given in sec 223(11). Note that this is extremely broad, although it excludes certain actions prescribed in reg 22.11(4).

Examiners should forward any case on which action under sec 223 may be required, or upon which there is an unactioned application under sec 223, to the supervising examiner. The supervising examiner will then refer the matter to Patent Oppositions.

Further information is provided in 3.11 Extensions of Time and Restoration of the Right of Priority.

Modified Date: 01 March 2013

2.24.3.2 Lapsing for Non-payment of Continuation Fee

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Effective Date: 25 September 2019
Regulation 13.3(1A) allows for a 6 month 'grace period' for paying a continuation fee. Accordingly, the actual lapsing of an application does not occur until the expiry of this 6 month period. If the continuation fee is still not paid after this 6 month period ends, the lapsing of the application is backdated to the date on which the prescribed time expired. The reference to the payment of a continuation fee is taken to include payment of that fee by a person other than the applicant, as well as the applicant.

During the 6 month grace period, the application is regarded as being in a "state of lapse" and only certain actions are possible during that period (see 2.13.2 Applications in a State of Lapse, or Lapsed).

Where an application lapses through non-payment of continuation fees after a first report is issued, the applicant, when seeking an extension of time under sec 223 to pay the continuation fees, will need to take into account the time left for acceptance upon 'restoration' of the application occurring and allow sufficient time in the extension request not only to address the reasons for lapsing, but also to gain acceptance. Note that the "stopped clock" ruling in Ferplas Industries Ltd's Application (1979) 14 AOJP 1185 does not apply to the Patents Act 1990 - see G & J Koutsoukos Holdings Pty Ltd v Capral Aluminium Limited [2003] APO 28.

Where an extension to the time for acceptance has been allowed, examiners must ensure that the final date for acceptance (FDA) is updated in PAMS (see 5.5.3.4 Exam Details). A case note should also be added to the file, indicating that the FDA has changed as a result of the extension of time.

**Warning:** The FDA should only be changed when it is appropriate to do so. Examiners should consult with a supervising examiner or senior examiner before changing the FDA in PAMS.

In certain circumstances, an application which involves 'associated technology' (e.g. nuclear weapons) will lapse (sec 148). It is also possible for such applications to be restored where the conditions giving rise to the lapsing no longer apply (sec 150). Examination is not to commence, or continue, on an application which lapses under sec 148. If such an application is restored, then examination can proceed.
2.24.3.4 Lapsing Under Regulations 3.2A(5) and 3.2B(3)

If a complete specification is not suitable for reproduction when it is filed, the Commissioner can treat the specification as having been filed and issue a direction under reg 3.2A or reg 3.2B. Where such a direction is not complied with by the times set out in reg 3.2A(5) or reg 3.2B(3), the application will lapse (see 2.29.4 Substitute Pages of Specifications).

2.24.3.5 Lapsing under Regulation 22.2B

If a provisional specification is filed with a request for a patent, or a complete specification is filed with a request for an innovation patent or a standard patent, but the appropriate fees are not paid when payable, the Commissioner may within one month invite payment of the fee. The fee must then be paid within two months of the date of the invitation. If the fee is not paid within this period, the application will lapse (or the will patent cease, as appropriate) at the end of the two month period.

**Note:** Under Regulation 22.2F, if the Commissioner does not give the invitation within one month, the application will not lapse.

2.24.4 Extension of Term (Chapter 6, Part 3)

Detailed practice and procedures relating to extension of term are provided in 3.12 Extension of Term of Standard Patents Relating to Pharmaceutical Substances.
2.24.5 Dealing with Lapsed, Withdrawn, Refused, Revoked, Ceased and Expired Cases

In this topic:

The power of the Commissioner to deal with an application/patent that has lapsed, ceased or expired, or been withdrawn, refused or revoked, depends on whether there is still an application or patent in existence. The following provides general guidance on how to approach such matters.

Note: Where it is uncertain whether the Commissioner has the power to carry out an action on an application/patent which is lapsed/withdrawn/refused/revoked/ceased/expired, the matter should be discussed with Patent Oppositions.

Lapsed/Withdrawn

Where an application has lapsed or is withdrawn, it is no longer subsisting (see *Esso Research & Engineering Co v Commissioner of Patents* [1960] HCA 31). The Commissioner has no power to take action on an application that does not subsist (unless the Act clearly indicates a contrary intention). Consequently, the Commissioner cannot amend an application that has lapsed.

However, a lapsed application can be restored under sec 223, as this is clearly the intention of this section. Consequently, an applicant who wishes to amend (or otherwise deal with) a lapsed application must first restore the application before any other action can be considered.

Actions under sec 36 can also proceed in relation to lapsed or withdrawn applications, since this is explicitly permitted by sec 36(2).

Refused/Revoked

Similar considerations apply where an application/patent is refused or revoked. An application/patent that has been refused or revoked is properly regarded as not subsisting and consequently the Commissioner cannot perform any actions on the application/patent (see *Kyowa’s Application* [1969] FSR 183).
However, where there is an appeal against a decision to refuse or revoke, the refusal or revocation is effectively put on hold until the appeal is decided. Consequently, the application/patent continues to subsist until the appeal is resolved.

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**Ceased/Expired**

Where a patent has ceased or expired it is no longer in force. It is not the case that the patent does not subsist, as the patentee has the right to bring an action for infringements that occurred while the patent was in force. As the patent continues to subsist, the Commissioner can carry out actions such as amending the patent or recording an assignment of the patent.

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### 2.25 The Register of Patents (Chapter 19)

**Modified Date: 02 April 2013**

#### 2.25.1 The Register

The Office maintains a Register of Patents which contains details of standard patents and innovation patents. Under sec 186(2), the Register may be kept wholly or partly by use of a computer. Until 9 February 2009, the Register was held only in paper form. From 9 February 2009, the Register changed to electronic form for all patents granted from 24 May 2001.

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#### 2.25.2 Entries in the Register

The Register of Patents contains particulars of patents in force. The particulars recorded are as follows:

- patent number;
- name(s) and address(es) of the patentee(s);
2.25.3 Registration of, and Amendment to, Particulars

- name(s) of the inventor(s);
- title of the patent;
- term of the patent;
- date accepted;
- date granted;
- status of the patent;
- expiry date;
- date ceased;
- date revoked;
- priority details;
- divisional and/or additional details;
- issuing of duplicate deeds;
- alteration or correction of ownership details;
- mortgagee, licensee or other interests;
- transfer of entitlement to the patent or licence, or a share in the patent or licence;
- details of court orders concerning a patent, being orders filed or served on the Commissioner;
- details of a sequestration notice, or other document or order, declaring the previous holder of patent rights bankrupt;
- extension of term;
- an amendment to the complete specification after grant; and
- restoration.

Modified Date: 02 April 2013

2.25.3 Registration of, and Amendment to, Particulars
Information on the registration of particulars of patents, and the amendment thereof, is provided in:

- 3.10.2 Recording Particulars in the Register; and
- 3.10.3 Amendment of the Register.

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**2.25.4 Correction of the Register**

The Register may be rectified by a prescribed court under the provisions of sec 192.

Similarly, the Commissioner may, under the provisions of sec 191A, amend an entry in the Register to correct an error or omission, or to correct ownership details.

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**2.25.5 Obtaining Information from Register**

Where examiners require a record of the information on the Register, an extract from the Register may be obtained from E-Register on AusPat. Examiners must ensure that a copy of the extract is attached to the case file.

Examiners should bear in mind that AusPat may not record the very latest details for a patent. Where examiners have any queries regarding the information obtained from AusPat, these should be referred to COG in the first instance.

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**2.26 Employees, Delegations, Administration**

**2.26.1 Restrictions on Patent Office Staff (Sections 182-185)**

Modified Date: 15 April 2013

**2.26.1.1 Trafficking in Inventions, Trafficking Exemptions**
Except for the circumstances specified in sec 182(3), employees in the Patent Office are prohibited from engaging in any transactions involving an invention or a patent. As all staff employed in IP Australia under a duty statement are employed in the Patent Office (as well as the Trade Marks Office and the Designs Office), the prohibition is not limited to patent examiners or to staff directly processing patent applications. “Employee” is defined in schedule 1 and accordingly the terms of employment are immaterial. Therefore, the prohibition applies irrespective of whether a person is employed on a salary basis or otherwise.

In the context of sec 182, the term "patent" is not confined to the definition in schedule 1, but also includes a foreign patent. However, the "invention" referred to in sec 182 is to be understood in terms of the definition specified in that schedule.

### Prohibition

The prohibition under sec 182 is of a broad nature and covers transactions including:

- acquisition for the purpose of manufacture;
- acquisition for licensing to others to manufacture, acquisition in order to exclude competition to a family business, investment;
- brokering the transfer of an invention between companies; and
- acting as an intermediary for the transfer of a patent between companies, etc.

There is no allowance for waiving the provision, or for relaxing its interpretation other than those of sec 182(3) (see below). Any transaction by a staff member involving an invention or patent and outside the circumstances specified in sec 182(3) is void. Furthermore, such a transaction is an offence with a penalty.

It may be assumed that sec 182 includes activity that is in some way controlled or directed by a staff member. Thus, the use of a family company or trust (for example), where the employee has a controlling interest, is likely to be in breach of sec 182. Staff members involved in such arrangements will need to obtain their own legal advice about their position.
2.26.1.2 Provision of Advice

Exemptions

An inventor, or a person to whom an invention is bequeathed, is exempt from the above restriction. It therefore follows that under the Patents Act, staff are free to apply for patents, to assign, sell or licence such patents, and to dispose of inventions, provided they are the inventors or have been bequeathed the invention. However, other restrictions may arise by way of the Public Service Act, for an employee wanting to deal with such an invention.

Modified Date: 02 May 2016

2.26.1.2 Provision of Advice

The issue of IP Australia staff providing advice is discussed in the Information and Advice Policy. In summary, staff should:

- adopt a positive approach to providing information and advice (as reflected in the Customer Service Code of Practice) to ensure customers are given the best possible customer service;
- exercise duty of care when providing information and advice to customers;
- seek to understand customers' needs, and to meet those needs, rather than just providing standard answers to questions;
- keep informed of the latest developments in IP Australia;
- advise customers about the range of products and services within their area of responsibility;
- advise customers to contact other agencies for products and services outside their area of responsibility; and
clearly explain the difference between the services provided by IP Australia and those provided by IP professionals and business advisers.

The Policy recognises that there is a dividing line between what can and cannot be provided to the customer. The following statements provide guidance on where the "line" should be drawn. Thus, staff should not:

- offer personal opinions or make decisions for customers;
- give partial or biased information which could limit the customer's options;
- assume knowledge of the customer's needs without first asking questions;
- ask misleading questions or make misleading statements;
- go beyond the limits of their personal knowledge, authority and experience;
- advise on subjects that are beyond IP Australia's area of responsibility or authority;
- offer legal, financial or business advice to customers; or
- provide services to customers that would contravene the relevant legislation and IP Australia's duty of care.

Information on the progress of an application which is not yet OPI should not be given to anyone other than the applicant or their attorney (sec 183).

Examiners must be satisfied as to the true identity of any person seeking information which is not yet publicly available. Publicly available information can be obtained from the Office or AusPat.

Enquiries from the media must be referred to Strategic Communication (for further information see Managing Media).

Modified Date: 15 April 2013

2.26.1.3 Helping to Prepare Documents

In this topic:

Under sec 185(a), it is an offence for an employee of IP Australia to prepare, or help to prepare:

- a patent specification; or
The reference to ‘other than a document which is in an approved form’ allows staff to assist applicants with filling out approved forms per se, although this does not extend to the patent specification itself.

Staff may be faced with requests to help prepare documents in both a work and private capacity. The following provides guidance on how to deal with such situations.

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**Work Capacity**

**Examination Staff**

Examiners should consider what level of explanation or assistance is appropriate to provide in an examination report, without contravening sec 185(a). This issue is more likely to arise in the case of private applicants (see **2.2.2 “Private Applicant” Cases**).

A situation which would not be regarded as ‘helping to prepare’ a patent specification is where examiners object to a claim and note that the objection would not apply if, for example, a particular phrase is used. This may be viewed as illustrating the nature of the problem, rather than advice to use the particular phrase. However, any suggestion that the particular phrase must be used may be inappropriate.

Examiners need to be particularly careful when dealing with private applicants, as typically they will be seeking guidance regarding what action to take. Accordingly, examiners should be careful when expressing alternative wordings and ensure that these are merely an indication of the reason for the objection, and not a suggestion for amendment to the specification.

When faced with a difficult examination issue, applicants may seek to discuss the objection with examiners and how it can be overcome. Records of any conversations should be placed on file (**2.2.7.2 Communication with Applicants or Attorneys by Phone**). When dealing with attorneys, it will usually be reasonable to assume that they have full responsibility for preparing the specification or other documents, and nothing that examiners might say in discussing a report will transfer any element of that responsibility. Accordingly, examiners may discuss objections with attorneys without impinging upon sec 185(a). However, in rare situations attorneys may seek to abrogate their responsibility for preparing the specification or other document, by directly or effectively asking examiners to write a claim or amendment for them. Such approaches must be rejected and the focus returned to the reason for the objection.
Non-Examination Staff

The considerations are the same as those arising under ‘Private Capacity’ (see below).

Private Capacity

Staff members can freely discuss with family and friends how the patent system works in general and pass on the type of information that is included in the various information kits available from IP Australia.

However, any discussion that arises in knowledge of an alleged invention will be problematic. In particular, staff members must avoid discussing:

- how a person should draft their specification (in whole or in part) as it relates to their particular invention. (Note that hypothetical questions such as “Assuming my invention was (some well known article), how would you draft the specification?” do not avoid the prohibition under sec 185(a)).

- whether a particular idea is patentable, including any assessment of whether it might be best filed as an application for a standard patent or an innovation patent, or whether it should be better filed as an application for a design.

In these circumstances, staff members should avoid any discussion about the particular invention. Discussion should be limited to the general requirements for a patent (noting, for example, the material available on the IP Australia website), suggestions that they read recent Australian patent specifications to see how specifications are drafted, suggestions that they should conduct a search of patent specifications to ascertain whether they have a new idea and informing them that there are various avenues of assistance available (e.g. patent attorneys, business planners, grant programs etc).

Employee is Inventor

The prohibition against preparing a patent specification does not apply to employees who are drafting the specification for their own invention. However, under no circumstances are
employees to prepare documents relating to an application in respect of their own invention in Office time, or using Office equipment.

Particular difficulties may arise in the case of multiple inventors. The reference to ‘the inventor’ in sec 185(a) would appear to be a reference to all inventors. Thus, where one inventor is an employee, and the other is not, sec 185(a) precludes the employee inventor from preparing the specification and other documents on behalf of both inventors.

Where employees acquire an invention or patent by bequest or devolution of law (sec 182(3)), they will usually not be an inventor. Accordingly, employees are unable to prepare the specification or other documents.

2.26.2 Conflict of Interest

Section 185(b) prohibits employees from searching the records of the Office other than in their official capacity. A penalty may be imposed for a breach of this provision, apart from any action that may arise under the Public Service Act.

Employees of IP Australia are free to use public search material for their own benefit in the same manner as members of the public. However, they are not entitled to use (except in their official capacity) any of the search facilities which contain Office records not available to the public, e.g. the Non-OPI Search Engine (NOSE) in PAMS (see also last paragraph below).

Any use of public search facilities for private purposes must occur in employees’ own time and using public facilities or public access. Staff members should assume that accessing the ‘records of the Office’ for private purposes, using equipment provided for their duties within IP Australia, would be in contravention of this provision, even if it is asserted that they are doing it ‘in their own time’.

Information in applications that are not OPI cannot be used for personal purposes. The use of such information for financial advantage is improper and, apart from penalties under the Patents Act and the Public Service Act, may also constitute an offence of insider trading under the Corporations Law.
In this topic:

The APS Values require examiners to deliver services impartially. Where examiners have a conflict of interest in relation to a specific case, there could be a perception that the service has not been delivered impartially.

In situations where examiners believe they have a conflict of interest, they should bring the case to the attention of a supervising examiner. If a conflict exists, the supervising examiner will allocate the case to another examiner who does not have a conflict. Similarly, supervising examiners or senior examiners should not supervise a case where they have a conflict of interest.

Conflict of interest can also arise as indicated below. Other situations should be brought to the attention of a supervising examiner.

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**Financial Interest as a Shareholder in a Company That is an Applicant for a Patent**

Examiners should not examine an application if they hold shares in a company that is an applicant, since this may be perceived as improperly favouring the applicant. Similarly, where examiners are aware of a direct shareholding by a close family member, they should also abstain from examining the case.

An indirect financial interest, such as by membership of a superannuation fund that owns shares in a company, would not normally represent a conflict of interest.

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**Prior Involvement With the Applicant**

Prior involvement with an applicant (or if there are reasons to believe a third party will oppose the application, with that third party) may raise concerns regarding a lack of impartiality. Examples are if the applicant is a friend, family member, colleague, recent former employee or, of course, the examiner themself. Consequently, in these situations examiners should not examine the case.
Where examiners were previously a customer of the applicant, that prior involvement does not represent a conflict of interest.

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Prior Involvement With the Case

Issuing an adverse report on an application (or on a parent of an application) does not represent a conflict of interest.

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Prejudgement

Examiners have knowledge of the legal and technical matters relevant to the examination of cases within their technology. This is an essential prerequisite to examination and is not a prejudgement of the case or any issues that may be raised. However, examiners must be prepared to consider arguments presented by applicants in relation to their specific case.

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Rule of Necessity

Where the only examiner competent (on technical grounds) to examine an application is barred because of a conflict of interest, the matter should be referred to an Assistant General Manager to decide whether necessity requires that the case be examined in spite of the conflict.

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Case Law

The rules that govern bias of judges do not apply as strictly to administrators. However, some guidance may be drawn from the following cases:
2.26.3 Information Obtainable From the Commissioner (Section 194)

Under sec 194, the Commissioner may give any person information about:

- a patent; or
- an application for a patent that is OPI; or
- any prescribed document or matter.

A request for information must be in the approved form (reg 19.2).

2.26.4 Delegations (Section 209)

The Patents Act and Regulations empower the Commissioner to undertake various actions for their administration. In practice, these actions are not undertaken personally by the Commissioner, but by staff delegated to perform those tasks in the name of the Commissioner.
Note: The existence of a delegation does not prevent the Commissioner (or the deputy commissioners) from exercising any powers or functions which have been delegated (Acts Interpretation Act 1901, sec 34AB(1)(d)).

2.26.4.1 Statutory Provisions

Modified Date: 15 April 2013

2.26.4.1.1 Patents Act 1990

The basic provision for the delegation of the Commissioner's powers is given in sec 209. The Commissioner's power is to delegate to "a prescribed employee, or a prescribed class of employees".

Schedule 1 defines an "employee" with reference to persons employed in the Patent Office. Persons employed by IP Australia are employed in the Patent Office if their duty statement refers to matters to be performed under the Patents Act (and the Commissioner may inspect the relevant duty statement prior to issuing a delegation). Regulation 21.2 specifies those persons who may be delegated under sec 209(1).

Subject to any direction by the Commissioner, a deputy commissioner has all the other powers and functions of the Commissioner, except the power to delegate (sec 208(2)).

Modified Date: 15 April 2013

2.26.4.1.2 Acts Interpretation Act

The extent and nature of the delegations given under the Patents Act are interpreted in the context of the relevant sections of the Acts Interpretation Act. These sections are 34AA (Delegations), 34AB (Effect of delegation) and 34A (Exercise of certain powers and functions by a delegate).

2.26.4.2 Types of Delegations Made by the Commissioner

Modified Date: 01 September 2016
2.26.4.2.1 General Delegations

Under sec 209, the Commissioner has the power to delegate any or all of his or her powers to a prescribed employee or class of employees. Persons employed as examiners of patents all have the power to examine applications under sec 45(1), sec 101A, sec 101B and sec 104(2). Examiners with acceptance delegation have broad powers under the Act, including the acceptance of patent applications under sec 49 and sec 52.

The Commissioner has directed that examiners with acceptance delegation should only be exercising their delegation on their own cases and should not accept cases on behalf of, or currently assigned to, another examiner. This also means that an examiner with acceptance delegation who is supervising another staff member in a senior examiner’s absence cannot accept the staff member’s case, unless the acceptance delegate is formally acting in the senior examiner’s position. Note, however, that foreign furthers are not covered by this directive. Such cases are assignments to a new examiner and consequently become the new examiner’s case, which can then be accepted in the usual way.

Senior examiners may accept cases examined by an examiner who does not have the acceptance delegation. If a senior examiner and an examiner disagree on the formulation of a report, the matter should be referred to a supervising examiner.

Similarly, supervising examiners have a broad delegation. They also have the managerial power to transfer responsibility for examination of a particular case from the examiner currently having that responsibility to another examiner, or to themselves where, for example, a dispute arises.

Further information on general delegations and guidelines for their use is provided at Patent Delegations.

2.26.4.2.2 Specific Delegations

These delegations are given to specific persons, usually for a specific task. A specific delegation usually includes delegated powers not covered by a general delegation. For example, senior examiners do not have a general delegation of the power to refuse to accept a patent application following an examiner's adverse report, or to hear and decide an opposition, and require a specific delegation to carry out these functions. Note that apart from the Commissioner, the deputy commissioners and hearing officers, no-one has the power of refusal to accept an application without a specific delegation to do so.
If a delegate is unable to complete a delegated task (e.g. a hearing officer dying between a hearing and the issuing of a decision), no-one else can exercise that delegation, and the task may have to be recommenced (e.g. a new hearing).

However, where the delegation implicitly (or explicitly) relates to several tasks (e.g. an initial hearing and decision, and a final hearing and decision), the unavailability of the delegate after completion of some of those tasks does not invalidate those tasks completed by the delegate.

See *R. v Smith; Ex parte Mole Engineering Pty Ltd* 147 CLR 340.

A delegation **MUST** be remade in the following circumstances:

- any amendment to the statutory provisions which the instrument of delegation specifically delegates; or
- any change in the identification of the prescribed employees, or the prescribed class of employees, to which the delegation applies.

However, when there is a temporary or permanent change in the person occupying the position of Commissioner of Patents, the delegation is not required to be remade immediately. A delegation is from the Office of the Commissioner of Patents, and is not a personal delegation from the person occupying the Office. Thus, a delegation does not lose its effectiveness through a change in the person occupying the Office of Commissioner.

Only the Commissioner has the power to revoke a delegation. A revocation may be made at any time and, as with the delegation itself, is required to be in writing.

A revocation of a delegation can arise:

- as a preamble to a remade delegation;
- where there is no intention that a delegation be used; or
2.26.4.5 General Issues Regarding Delegations

- where management issues dictate that a delegation should be revoked.

A delegate cannot delegate a power under the Act to another person (Acts Interpretation Act 1901, sec 34AB(1)(b)). Where a person has been delegated a power under the Act, that person must personally exercise that power, either by doing the work themselves, or by formally agreeing with and endorsing work done by others. Giving a subordinate a rubber-stamp signature to apply in the name of the delegate is not a valid exercise of the delegation.

The existence of a delegation to a person for a certain matter does not prevent the making of an identical delegation to another person in respect of the same matter (Acts Interpretation Act 1901, sec 34AB(1)(d)). However, generally in such circumstances one of the delegations should be revoked to avoid confusion, or where that is not appropriate, good management practices should ensure that only one person is exercising a particular power at any one time in respect of the same matter.

Persons exercising a delegation do so upon their opinion, belief or state of mind in relation to the matter. Delegates are not required to try to ascertain what the opinion etc. of the actual Commissioner would be in the matter.

A delegation can be exercised in favour of a specified office or position, even if the office or position does not come into existence until after the delegation is given (Acts Interpretation Act 1901, sec 34AA). Consequently, if a delegation is made to persons holding a position in a class of positions, the delegation will operate in relation to positions falling within the relevant class and also those which are created after the delegation is given.

Where staff members have concerns or doubts regarding a power delegated to them, they should seek advice on the exercise of that power from their supervisor.
2.26.4.7 Implied Delegations

The preparation of delegations for the Commissioner's signature is the responsibility of the Section Head of the relevant work area. Delegations for administration of the Patents Act and Patents Regulations are prepared by the Supervising Examiner (Patent Oppositions).

Modified Date: 19 December 2016

2.26.4.7 Implied Delegations

Staff should ensure that they only exercise the powers that they have been delegated and do not process actions unless the appropriate delegations have been exercised.

Where an action that requires the exercise of a delegation has occurred without there being any record of the exercise of the relevant power by either the Commissioner or a delegate, the matter is to be referred to either the Assistant General Manager (OEP) or Supervising Examiner (Patent Oppositions) for assessment of whether there has been an implied delegation or exercise of the Commissioner's powers, or an *ultra vires* action.

Most delegations are exercised within PAMS, which retains a record of the exercise of the delegation. In a small number of situations, delegations are exercised by signing paper forms. Where a paper form is on file, but there has been an omission to sign the form, it must be determined if there has been an implied exercise of power. A case note should be added to the file by an acceptance delegate to indicate what has happened and whether the action should be taken to have happened. The note should also indicate whether the action would have been allowed at the present date, if that had been required. The original form must never be signed and back dated. If the action was *ultra vires*, an Assistant General Manager will annotate the file accordingly.

For example, in a case where an amendment to insert an extra inventor on the patent request was processed without a formal acceptance of the amendment, the amendment was considered to have been properly made and the file was annotated to record this fact.

When deciding whether there has been an implied delegation, the Assistant General Manager (OEP) will consider all circumstances, including whether subsequent matters proceeded on the assumption that the power had been properly exercised, whether the action is in accordance with the legislative regime and the time that has elapsed since the action was done.

The applicant should be advised by letter of what has occurred and what has been recorded on the file to remedy the situation.
2.26.5 Secret Cases

Under sec 173, the Commissioner may prohibit the publication of information about the subject matter of an application. This occurs where it is in the interests of the defence of the Commonwealth to do so. Such cases are referred to as secret cases.

COG identify potentially secret cases, which are then referred to examination staff with a security clearance for a preliminary assessment. The preliminary assessment is normally done by a staff member from Patent Oppositions, however occasionally security cleared staff outside Patent Oppositions will be asked to carry out the assessment due to unavailability of Patent Oppositions staff. If it is considered that the case is potentially secret, then a prohibition order will be issued, and the case referred to the Department of Defence for consideration. For guidance on the kinds of subject matter that may be secret, see the Defence and Strategic Goods List.

A delegation is not required in order to conduct the preliminary assessment, but is required to sign the prohibition order. The prohibition order should only be signed by a staff member from Patent Oppositions (the Deputy Commissioner, the Supervising Examiner or the Senior Examiner).

See also 2.13.13 Examining Cases Subject to a Prohibition Order.

2.27 Payment of Fees (Section 227)

2.27.1 Prescribed Fees

The prescribed fees for the purpose of sec 227 are referred to in reg 22.2 and reg 22.3 and set out in schedule 7 of the Regulations.

In general, fees are payable in respect of:
2.27.3 Fees Not Paid or Requested

- the doing of an act by the Commissioner;
- the doing of an act by a person other than the Commissioner;
- the filing of a document; and
- the filing of a request.

Regulations 22.2B - 22.2D, reg 22.2EA and regs 22.2G – 22.2I provide for the consequences of failing to pay a fee in accordance with the Regulations. These regulations enable the Commissioner to issue an invitation to pay the relevant fee that has not been paid. If the fee is not paid within the period allowed in the invitation, the application, request or other relevant document is taken not to have been filed or made, or the application lapses or the patent ceases, as the case may be.

However, the above consequences do not arise in special circumstances where a fee has not been paid in accordance with the Regulations and the Commissioner has not given an invitation to pay within the time allowed (reg 22.2F).

In the situation where a fee is paid late and there has been a change in the fee schedule since the due date, the fee payable is the fee applicable at the date the fee is paid, plus the extension of time penalty for late payment in accordance with the schedule.

Note: Any reference to the payment of a continuation fee or renewal fee is to be taken to include payment of that fee by a person other than the applicant or patentee, as well as the applicant or patentee (sec 143B).

Where a fee payable in respect of the filing of a document has not been paid, COG will normally issue an invitation to pay the fee. In most situations, the case file will not be sent to the relevant examination section until the fee is paid. If an examiner receives a case file containing a document in respect of which a fee has not been paid but has been requested, COG should be notified immediately.

Where examiners receive a case file containing a document or request for action in respect of which a payable fee has not been requested, the following procedure applies:

- if the case is received within one month of the receipt of the document or request in the Office, examiners should immediately notify COG, who in turn will arrange for an
2.27.4 When Refund or Transfer Not Available

expeditious request of the fee (to meet the requirements of the applicable regulation); or

- if the case is received more than one month from the date of receipt of the document or request, examiners should proceed with examination of the case. A note should be added, at the end of any report issued, that the fee has not yet been paid. It is to be understood that whilst under the provisions of reg 22.2F(2) the document or request is deemed to have been filed or made, reg 22.2F(7) still provides that the fee remains payable.

Given the consequences arising from the failure to pay a fee, in most cases where an invitation to pay has issued, no examiner action is to occur. For example, in the situation where a fee is payable in respect of the doing of an act by the Commissioner, such as a request for examination under sec 45 or a request to amend under sec 104, the act shall not be done until the fee is paid. In this situation, if the fee is not paid the request is taken not to have been made.

Modified Date: 01 April 2011

2.27.4 When Refund or Transfer Not Available

Where a fee has been paid in respect of doing a specifically stated act or in respect of filing a specifically stated document, and that act has been done or that document has been filed, that fee is not available for refund or transfer.

Modified Date: 25 February 2019

2.27.5 Actioning of Requests for Refund or Exemption

Requests for refunds of fees in accordance with reg 22.7(1) should be referred to COG and those in accordance with reg 22.7(2) to the PCT Unit. Requests for exemption from payment of fees in accordance with reg 22.6(1) should be referred to the relevant Assistant General Manager.
2.27.6 Mention of Fee Treatment in Examiner's Report

Examiners should not include in their reports any suggestion of waiving, transferring or refunding a fee.

Modified Date: 25 February 2019

2.27.7 Error or Omission in the Patent Office

Where, by reason of an error or omission in the Office, there has been a delay in examination or acceptance (e.g. either in the transmission of the application to the examination section or while the application has been in the section), the case should be referred (together with a statement outlining the circumstances) to a supervising examiner for consideration of whether reg 22.6(2) applies. If the supervising examiner is in agreement that an office error or omission has contributed to a delay in examination or acceptance, the matter should be referred to the relevant Assistant General Manager for consideration.

Modified Date: 01 April 2011

2.27.8 Continuation Fee Timing

The timing provisions for the payment of continuation fees are discussed in 2.24.3.1 Lapsing Under Section 142 and 2.10.7 Continuation Fees.

Modified Date: 15 April 2013

2.27.9 Exemption From Fees

Regulation 22.6(1) states:

“The Commissioner may exempt a person from the payment of the whole or any part of a fee if the Commissioner is reasonably satisfied that the action is justified, having regard to all the circumstances.”
Any exemptions granted under this provision must be in accordance with the Corporate Guidelines for Refunds and Waivers.

It is not possible to be prescriptive about all the circumstances where the Commissioner might exempt a person or organisation from payment of fees, since each case needs to be assessed on its own merits. However, the following general principles outlined in the Corporate Guidelines for Refunds and Waivers apply:

- if IP Australia has made an error, given incorrect advice or failed to provide a notification, in such a way as will make the customer liable for a fee that they would not otherwise have needed to pay; or
- if IP Australia has made an error or given incorrect advice that has given the customer a clear expectation that they need to pay an amount that is less than the prescribed fee;

the Commissioner will exempt the customer from paying that fee, either in whole or in part.

In general, the Commissioner will not exempt payment of a fee for filing a document associated with an action upon subsequent withdrawal of that action (e.g. filing a notice of opposition and subsequent withdrawal of the opposition, withdrawing a request under sec 223 for an extension of time and withdrawing a request for examination).

Regulation 22.7(1) states (subject to reg 22.7(2)) that if:

- a complete application for a standard patent has been filed; and
- the application is withdrawn before the specification becomes open to public inspection;

so much of the fee paid on the filing of the application as the Commissioner reasonably thinks fit may, on written application made to him or her, be refunded.

When a complete standard application is withdrawn before it is OPI and a request for a refund of the application fee is received, the Commissioner will refund fees in excess of the costs associated with processing the application.

In general, the costs associated with receiving and processing an application are reflected in the costs of filing a provisional application. In addition, where the application has been
2.28.1 Introduction

The transitional and savings provisions of the Patents Act 1990 (Raising the Bar Act) address the need to deal with patent applications filed, and patents granted, under the Patents Act 1990 (as in force immediately before 15 April 2013) and the Patents Act 1952. These provisions are usually associated with any act which repeals or amends another, and codify principles of common law relating to such acts.

2.28 Transitional and Savings Provisions

Modified Date: 03 June 2013

2.28.1 Introduction

The transitional and savings provisions of the Patents Act 1990 (Raising the Bar Act) address the need to deal with patent applications filed, and patents granted, under the Patents Act 1990 (as in force immediately before 15 April 2013) and the Patents Act 1952. These provisions are usually associated with any act which repeals or amends another, and codify principles of common law relating to such acts.

2.28.2 Provisions of the Patents Act 1990 (as in Force Immediately Before 15 April 2013)

The provisions of the Act, as in force immediately before 15 April 2013, continue to apply to certain patent applications and patents as indicated in the relevant parts of this volume.

In general, the provisions of the Act as they existed before 15 April 2013 continue to apply to standard patent applications and innovation patents with an examination request filed before 15 April 2013. However, there are certain exceptions, for example re-examination, and examiners should therefore check the appropriate parts of this volume.

2.28.3 Patent Applications Filed, and Patents Granted, Under the Patents Act 1952

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
In the rare event that examiners encounter a patent application filed, or a patent granted, under the 1952 Act, the matter should be referred to Patent Oppositions.

**2.29 Formalities and Forms**

Modified Date: 25 February 2019

**2.29 Formalities and Forms**

The formal requirements for documents filed under the Act and the Regulations are provided for by Schedule 3 of the Regulations, or the Patents (Formalities Requirements for Patent Documents) Determination 2019 (Formalities Determination). The provisions that apply depend upon certain timing requirements, as indicated below. However, examiners should note that in general the formal requirements for documents are the same, regardless of whether provided for by Schedule 3 or the Formalities Determination.

**Relevant Formalities Provisions**

**Standard**

- Standard patent applications filed **on or after** 24 February 2019, and standard patents granted on such applications – Formalities Determination.

- Standard patent applications filed **before** 24 February 2019, and standard patents granted on such applications – Schedule 3, however see also Requests to Amend below.

**PCT Applications**

- PCT applications that entered the national phase **on or after** 24 February 2019 – Formalities Determination.

- PCT applications that entered the national phase **before** 24 February 2019 – Schedule 3.

**Innovation**

- See Requests to Amend below.

**Requests to Amend**

- Requests to amend filed **on or after** 24 February 2019, for **standard patent applications and standard patents** – Formalities Determination.
2.29.1 Introduction

Note: For the purpose of examination, objection against the requirements of Schedule 3 or the Formalities Determination is mandatory only where the non-compliance leads to a significant lack of clarity in the form and content of the specification.

At filing, or after national phase entry, all applications (apart from certain national phase applications; see 2.20.1.4 Formality Requirements) are subjected to a check for compliance with formal requirements by COG. Therefore, most cases will have already been placed in order, where required, before they reach examination sections.

However, there may be circumstances where such a check has not been made, or where rectifying action has not taken place, or where changes in the relevant administrative procedures have come into effect.

The following parts provide information on formality requirements that may be relevant during examination.

2.29.2 Fitness for Reproduction

Filed documents must be fit for reproduction. Thus, the patent request, specification and abstract must be typewritten or otherwise machine printed, except for symbols relating to graphic matter, or chemical or mathematical formulae, which may be handwritten or drawn. In general, handwriting is not considered to be an approved process, although the Commissioner may consent to the patent request, specification or abstract being handwritten.
2.29.3 Numbering of Pages

The main criterion used to determine whether documents are acceptable is whether they can be reproduced satisfactorily. If examiners are in any doubt as to whether a document is suitable for reproduction, they should contact COG. The unfitness of the complete specification for reproduction is a significant issue and should be objected to where appropriate.

**Note:** The relevant provisions are:

- **Formalities Determination** (sec 7 and sec 11)
- **Schedule 3** (clause 2 and clause 7).

See [2.29 Formalities and Forms](#) for further information.

Modified Date: 25 February 2019

### 2.29.3 Numbering of Pages

Each page of a specification must be numbered. The cover sheet of a specification, if used, is numbered as page 1. The remaining pages are numbered 2, 3, etc. The numbering of pages should be at the top of the page, however no objection should be taken if the numbering is located at the bottom of the page.

Drawings (figures), graphics and photographs are not numbered as pages of the specification, but are numbered separately by means of sets of 2 Arabic numerals separated by an oblique stroke, the first numeral in each set being the consecutive number of each sheet, beginning with the number 1, and the second being the total number of sheets containing the drawings, graphics or photographs. An expanded view of part of a drawing (figure), graphic or photograph should be numbered as a separate drawing (figure), graphic or photograph.

**Note:** For information on allowable amendments to page numbers, see [2.23.8 Form Amendments Should Take](#), ‘Page Numbering’.

**Note:** The relevant provisions are:

- **Formalities Determination** (sec 10)
- **Schedule 3** (clause 5).

Note that the requirements for graphics and photographs only apply with respect to the Formalities Determination.
2.29.4 Substitute Pages of Specifications

At the time of filing, or after national phase entry in the case of certain national phase applications (see 2.20.1.4A Formalities Check), if a complete specification (including any drawings, graphics or photographs) is not suitable for reproduction through failure to comply with the requirements specified in Schedule 3 or the Formalities Determination, COG will issue a direction to the applicant (reg 3.2A, reg 3.2B or reg 3.2C). Where the applicant does not comply with such a direction within the prescribed period, the application will lapse.

Alternatively, where the applicant does not file additional information in response to a notice under reg 3.5(4), the application is taken not to have been filed (reg 3.5(5)).

Substitute pages or drawings, graphics or photographs of a specification, filed pursuant to a direction under the Regulations, are stamped with the date of filing and incorporated into the specification by COG. Documents that incorporate substitute pages or drawings, graphics or photographs are identified in the Ecase file by the text “Comply(ied) Formalities” in the Document Name. Substitute pages are not checked for accuracy by COG. Examiners should also note that the original versions of the documents are retained in the Ecase file.

A substitute specification, or a specification which includes some substitute pages or sheets of drawings, graphics or photographs, is treated for all purposes as the "original" specification. However, this does not preclude any person from inspecting, or obtaining a copy of, the original specification (i.e. the unsubstituted version), individual pages, or drawings, graphics or photographs, once the complete specification has been notified as OPI.

When examiners encounter an application in which substitute documents were filed, they should be aware that such documents were supplied in order to comply with a statutory direction. Consequently, the substitute documents are to be treated as the documents for examination purposes and any amendments proposed, or requested, should be directed to those documents.

**Note:** The requirements for graphics and photographs only apply with respect to the Formalities Determination. See 2.29 Formalities and Forms for further information.
2.29.5 Substitute Documents

In this topic:

All documents filed in relation to an application become a permanent part of the application file and of the official record, apart from rare cases (see 2.29.8 Return or Deletion of Filed Documents). However, where substitute documents are filed, these do not become effective unless permitted under the Act. Generally, this will be by amendment under sec 104. For example, substitute documents filed pursuant to a direction issued by the Commissioner under reg 3.2A are considered to be a request for amendment and are processed accordingly.

If the case file contains documents purporting to be formal or substitute documents, but which were not filed in response to a direction or otherwise do not constitute a request to amend, examiners should indicate in their report that these documents do not formally replace existing documents, however they may be incorporated by amendment under sec 104.

Complete Specification in a Foreign Language

If a complete specification is filed in a foreign language, COG will issue a direction to file a substitute specification in English. If a direction is not issued in respect of a specification which is wholly or partly in a foreign language, it will be necessary for the applicant to amend the specification under sec 104 to be in English. Where it is not possible (with a reasonable amount of certainty) to ascertain the content of the foreign language text, it may also be necessary for the applicant to file a translation of the foreign language text in order for the amendment to be allowed.
Complete Specification a Cross-Reference

If a complete specification relies either wholly or partly on a cross-reference to an earlier foreign application, COG will issue a direction under reg 3.5A to file substitute sheets incorporating the matter which is the subject of the cross-reference (see 2.12.2.1 Filing Dates).

Modified Date: 25 February 2019

2.29.6 Units and Terminology

Terminology and signs used in specifications should be in accordance with Schedule 3 or the Formalities Determination. For example, temperature is to be expressed in degrees Celsius and the metric system used. However, no objection should be taken where the terminology and signs used in the specification are not as required.

Note: The relevant provisions are:

- Formalities Determination (sec 5)
- Schedule 3 (clause 1).

See 2.29 Formalities and Forms for further information.

Modified Date: 25 February 2019

2.29.7 Forms

The Act and Regulations specify that certain documents must be in an "approved form", where an "approved form" is one approved by the Commissioner for the purposes of a provision where specified. The Forms Officer is responsible for the update of approved forms. A set of approved forms relevant to applying for a patent is available from the IP Australia website (Patents Forms).

If a document, other than a patent request, specification or abstract, is filed which does not substantially comply with reg 22.15 or the formal requirements, or is not in accordance with the relevant "approved form", the Commissioner may treat the document as:
2.29.8 Return or Deletion of Filed Documents

- if it had not been filed and notify the person from whom it was received, including in the notification a statement indicating how the document or form does not so comply or accord (reg 22.16(2)(a)); or

- having been filed, but direct the person from whom it was received to take action such that it will so comply or accord (reg 22.16(2)(b)). Where the person does not comply with the direction within the prescribed period, the document is treated as not having been filed (reg 22.16(4)).

However, in general, Office practice is to treat a form which is in substantial compliance with an approved form as being in accordance with the relevant approved form.

Modified Date: 25 February 2019

2.29.8 Return or Deletion of Filed Documents

Under Chapter 4 of the Act, documents filed for a patent or patent application generally become open to public inspection (OPI). In many cases, correspondence will be available to the public from IP Australia’s website within 24 hours of it being filed. Consequently, the marking of correspondence as ‘confidential’ does not have any effect on the disclosure of that correspondence to other parties under the Patents Act.

IP Australia is also subject to the Archives Act 1983, under which the destruction or alteration of a Commonwealth record is an offence. Therefore, a request for the Commissioner to return, delete or redact documents that have become part of a Commonwealth record, including documents filed in relation to patents and patent applications, will be refused.

However, where documents are filed in error and are not part of the official record they may be returned or destroyed.

Where a filed document is part of the official record, the Commissioner may, in certain circumstances, order that filed documents not be OPI; see 3.13 Documents not OPI – Orders for Inspection.

Note: Requests for documents to be returned, deleted or not be OPI should be referred to the Assistant General Manager (OEP).

Modified Date: 25 February 2019

This document is controlled. Its accuracy can only be guaranteed when viewed electronically.

Effective Date: 25 September 2019
2.29.9 Requirements for Amino Acid and Nucleotide Sequences on Compact Disc or Other Electronic Means

Applicants may file an amino acid or nucleotide sequence on a compact disc (CD) or other electronic means. The supplied sequences must be in a format approved by the Commissioner, i.e. the sequences must comply with the standard provided for in Annex C of the Administrative Instructions under the PCT. The software known as PatentIn conforms to the format specified in the Annex and is available at:

http://www.uspto.gov/patents/resources/tools/checker/patentinrel.jsp

For national applications, examiners should note that a computer readable form of a sequence listing on CD is instead of any written sequence listing in the application, rather than in addition to the sequence listing as required for applications filed under the PCT. (Paragraphs 39 and 40 of Annex C of the Administrative Instructions do not apply.) The sequence listing and identifying data can be provided to the Office on CD as a general text file generated by PatentIn, or as a text file identical to that generated by PatentIn.

Note: The provision of sequences in electronic form is optional. Applicants may therefore choose to supply such sequences in printed form. Examiners cannot request that applicants supply sequences in electronic form.

Note: The relevant provisions are:

• Formalities Determination (sec 16)
• Schedule 3 (clause 12).

See 2.29 Formalities and Forms for further information.

CD Requirements

The entire printable copy of the sequence listing and identifying data should be contained within one text file on a single standard (ISO9660) CD-ROM or CD-R in an uncompressed format. If the text file is too large for a single CD, then multiple CDs may be filed. Each CD should contain one text file only.
CDs will be subject to a formality check at the time of filing by COG. This will check for viruses, determine if there is a text file on the disc and whether it can be opened. However, it should be noted that the content of the CD will not be checked in any way and the onus is on the applicant to ensure that all the desired sequences are actually on the CD. Where a CD is supplied, but does not comply with the requirements, e.g. the information is unreadable or the CD has a virus associated with it, the applicant will be issued with a formalities notice and asked to supply a substitute CD.

Any amendment to the CD must be made by submitting a substitute CD. Any correction or amendment of the CD is subject to the normal provisions of the Act, including that the amendment must be allowable under sec 102.

**Note:** The CD must be submitted as part of the application. If a CD is submitted later, it must be accompanied by a request under sec 104 and will be subject to the normal provisions for amendments.

Documents Requiring a Signature

Many documents and forms completed by applicants and attorneys, for actions under the Act, require a signature. However, there are certain situations where the typed name of a relevant person may be used in place of a signature.

**Note:** Digital or electronic signatures are an acceptable means for signing documents (see sec 10 of the *Electronic Transactions Act 1999*).
Under the legislation, there are a number of provisions that explicitly require a signature. Declarations made under the Act, or other relevant legislation, always require a signature. Documents relevant to examination that require a signature include the following:

- Certificate of verification statements;
- Deposit receipts under the Budapest Treaty;
- Patent assignment forms (sec 14); and
- Notice of withdrawal of a patent application (sec 141).

**In order to comply with the legislation, a signature must be present on these documents.**

Under reg 22.25, if a person is required to sign a document and the Commissioner is reasonably satisfied that the person cannot comply with the requirement, the Commissioner may dispense with the requirement. Where this appears to be the case, examiners should refer the matter to Patent Oppositions.

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**Prescribed Forms**

Where the requirement for a signature arises solely from a prescribed form, the typed name of the person completing the form, or the typed name of the person who is their agent, may be used in place of a signature. In this context, the person who has applied their name, or approved someone else to apply their name, is taken to have approved the content of the form.

Examples of prescribed forms include the patent request.

It is also appropriate to apply this principle to other correspondence, e.g. responses to examination reports.

**Note:** The typed name of an attorney firm, or any other business name, is **not** acceptable.
2.29.11 Drawings, Graphics and Photographs

**Note:** The requirements for graphics and photographs, and the use of colour, only apply with respect to the [Formalities Determination](#). See [2.29 Formalities and Forms](#) for further information.

At filing, COG will check that any drawings, graphics or photographs in the specification are suitable for reproduction. Where suitable reproductions cannot be made, COG will issue a direction requiring the filing of a satisfactory replacement.

Drawings, graphics and photographs are saved as the document type ‘Drawings’. Photographs will be scanned into the Ecase file by COG and the original photographs stored as physical media (see [5.10.7 Physical Media](#)).

A graphic or photograph may be filed in substitution for a drawing where it is impossible to represent in a drawing what is to be shown ([sec 15(2) of the Formalities Determination](#)). However, an objection to graphics or photographs is not to be taken unless the filing of such documents is clearly inappropriate. An example of the appropriate use of photographs would be to describe a plant variety (see [2.7.2.2 Some Specific Requirements for the Written Description of Plant Varieties](#)).

Where examiners have any doubts regarding graphics or photographs in a specification, they should consult a senior examiner.

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**Use of Colour**

At filing, COG will check that any colour drawings, graphics or photographs are suitable for reproduction. Where suitable reproductions cannot be made, COG will issue a direction requiring the filing of a satisfactory replacement.

Under [sec 15(3) of the Formalities Determination](#), the use of colour is only permitted in a drawing, graphic or photograph if the colouring is indispensable to understanding the invention. In practice, examiners should consider whether the use of colour assists the interpretation of the specification.

An example where colour may be essential to the interpretation of the specification and claims is plant variety inventions (see [2.7.2.2 Some Specific Requirements for the Written Description of Plant Varieties](#)). Similarly, colour may better convey information where it is necessary to distinguish components of the same shape that have different physical or chemical properties.

Where examiners have any doubts regarding the use of colour in drawings, graphics or photographs, they should consult a senior examiner.
It is a formal requirement that:

"a complete application must not contain or consist of scandalous matter."

There have been no administrative and judicial decisions considering the term "scandalous matter" under the Australian patents legislation. The only guidance in this area derives from a number of administrative and judicial decisions considering the term "scandalous matter" under the Australian and United Kingdom trade marks legislation. These decisions have not arrived at clear or objective criteria or guidelines for determining whether a trade mark is scandalous. However, they have stated and applied the following principles:

- the ordinary meaning of the word "scandalous" is intended by the legislation (Cosmetic, Toiletry and Fragrances Association Foundation v Fanni Barns [2003] ATMO 10). The word includes matter that is disgraceful to reputation, shameful or shocking, and defamatory or libellous. It goes beyond merely giving offence.

- the Registrar of Trade Marks must consider the general taste of the time as well as the susceptibilities of persons who may still be regarded as old fashioned (La Marquise Footwear Inc's Application (1947) 64 RPC 27 at 30).

- the standard is how the ordinary person would react to the trade mark (Ellis & Co's Trade Mark (1904) 21 RPC 617).

Note: The relevant provisions are:

- Formalities Determination (sec 17)
- Schedule 3 (clause 14).

See 2.29 Formalities and Forms for further information.

Where there is more than one claim the claims should be numbered consecutively in Arabic numerals beginning with “1”. Consistent with 2.29.1 Introduction, an objection is only
2.30.1 Sealing of Duplicate Patent

Note: The relevant provisions are:

- **Formalities Determination** (sec 10)
- Schedule 3 (clause 5).

See [2.29 Formalities and Forms](#) for further information.

2.30 Patent Deed

Modified Date: 02 April 2013

2.30.1 Sealing of Duplicate Patent

Note: The information in this part only applies to patents granted before 15 April 2013.

The Commissioner may seal a duplicate of a patent (deed) if satisfied that the original is lost, stolen, damaged or destroyed.

In general, the Commissioner would be so satisfied if:

- the damaged deed was provided to the Office with a request for a duplicate; or
- the patentee (or their patent attorney or other legal representative) provides a written statement setting out the circumstances and clearly stating that they believe the deed to be lost, stolen or destroyed. There is no requirement for an explanation of any measures undertaken, such as searches of premises, to support this written statement. However, the Commissioner may, in some circumstances, require the written statement to be in the form of a declaration.

2.31 Innovation Patents

2.31.1 Features of the System

Modified Date: 01 May 2014

2.31.1.1 Introduction
Overview

The innovation patent system enables applicants and inventors to obtain quick and inexpensive patent protection for their inventions compared with standard patents. This is achieved in two main ways:

1. For innovation patents, grant occurs without examination, unlike standard patents where examination is a prerequisite for grant. Examination of an innovation patent (and the associated costs) only occurs when initiated by the patentee, third parties or the Commissioner. However, it should be noted that, in contrast with standard patents, the grant of an innovation patent does not bestow any enforceable rights and privileges upon the patentee. This only occurs after examination has been carried out and the innovation patent is certified. Thus, even if patentees threaten to enforce their rights before certification, this is considered to be an unjustified threat. Therefore, the role of examination in the patent system is retained.

2. It is not necessary for an innovation patent to be in respect of an inventive step, as is the case with standard patents. Rather, an innovation patent need only be in respect of an innovative step, in accordance with the Act.

Note: An innovation patent has a maximum term of 8 years, compared with 20 years for a standard patent (and possibly up to 25 years for pharmaceutical patents) and is limited to a maximum of 5 claims, whereas standard patents have no limit.

Processing of Innovation Patents

An innovation patent will potentially go through a number of processing phases. These are, in order of occurrence (except for opposition and re-examination which may be reversed):

- Filing;
- Formalities Check;
- Acceptance;
- Grant (plus publication);
- Examination;
- Certification (plus publication);
- Opposition;
2.31.1.2 Filing

- Re-examination; and
- Ceasing/Expiring.

**Note:** Examination should not be commenced until after an application for an innovation patent has been published. Publication generally follows immediately after acceptance and grant – see 2.31.1.4 Acceptance and Grant.

As examination/certification, opposition and re-examination must be initiated by the patentee, third parties or the Commissioner, a granted innovation patent which ceases will not necessarily have been through all of these phases.

In most situations, acceptance and grant will be practically the same action. However, the separation of these processing phases allows for those cases where there is a prohibition on the publication of the patent (for security reasons). Thus, these cases can be accepted, but not granted.

Further information on each of the phases listed above is provided in the following parts of this chapter. See also:

- 2.31 Annex B – Procedural Outline for Examination of an Innovation Patent; and

Modified Date: 03 August 2015

**2.31.1.2 Filing**

The filing date is determined by reg 3.5, as outlined in 2.12.2.1 Filing Dates.

Innovation patent applications may be:

- associated with provisional applications;
- Convention applications; or
- divisional applications.

However, they cannot be:

- additional applications; or
filed by the PCT route (although it is possible to convert a national phase standard application to an innovation patent application).

Further information on the types of innovation patent applications is provided in 2.31.2 Types of Innovation Patent Application.

2.31.1.3 Formalities Check

For information on the procedures to be followed, see 2.31.3 Formalities Check for Innovation Patents.

2.31.1.4 Acceptance and Grant

In most situations, acceptance and grant will occur practically simultaneously, the exception being those cases where there is a prohibition on the publication of the patent (see 2.31.1.1 Introduction). Acceptance will normally be carried out by COG. The only exception to this is where there are amendments proposed in response to a formalities direction and these involve more than just substitution of sheets. In this case, the examiner who considers the amendments will have responsibility for accepting the application and must have acceptance delegation.

**Note:** Proposed amendments to the complete specification, other than those proposed in response to a formalities direction, cannot be allowed until after grant [reg 10.2C(4)]. Where an examiner considers that amendments filed prior to acceptance are not allowable, an adverse report should be issued.

See also 2.31.4.7 Amendments.

Once an innovation patent application has been accepted it is then granted. Following grant, the patent is published for the first time as an A4 level publication. (If an application does not pass the formalities check, it will lapse non-OPI).

**Note:** Examination should not be commenced until after an application for an innovation patent has been published which generally follows immediately after acceptance and grant.
2.31.1.5 Examination

For information on the procedures to be followed, see 2.31.4 Examination.

**Note:** Examination should not be commenced until after an application for an innovation patent has been published. Publication generally follows immediately after acceptance and grant – see 2.31.1.4 Acceptance and Grant.

2.31.1.6 Certification

In this topic:

**Overview**

Certification is the outcome of a favourable examination finding. The major implication of certification is that the innovation patent becomes enforceable. However, other important consequences arise from certification including:

- the provisions of sec 102(2) apply to any sec 104 amendments requested after the decision to certify;
- opposition and re-examination actions can now be initiated; and
- the specification is published again, as a B4-level publication.

**Note:** Instructions for completing the innovation patent certification form are provided in 5.11.8 Certification.
Certification in Error – Revocation of Certification

Once an application has been formally certified, i.e. the Certification Task has been completed, that certification cannot be reversed other than in exceptional circumstances.

Where it becomes apparent after certification that the decision was affected by an error, similar considerations to those discussed in 2.15.5 Revocation of Acceptance apply.

If a certificate of examination of an innovation patent is issued **on or after** 15 April 2013, the certificate may be revoked under sec 101EA. This has the effect that the patent is taken never to have been certified and examination of the patent can continue.

The final date for certification is then governed by reg 9A.4(g) and will generally be the later of the date 6 months from the examiner’s first report and 3 months from the decision to revoke certification.

Furthermore, under reg 10.6B, any leave to amend that was granted at the time of the certification decision (i.e. the decision under sec 101E(1)(a)) and allowance of the amendment will also be revoked. Examination can then proceed as if certification and allowance of the amendments had not occurred.

The power to revoke certification under sec 101EA is **only** to be exercised by the Assistant General Manager (OEP) or the Supervising Examiner (Patent Oppositions). Certification can also only be revoked if there are no relevant proceedings pending.

If it becomes apparent that an error has occurred in certifying an innovation patent, the matter is to be referred to Patent Oppositions immediately.

An innovation patent may be opposed under sec 101M at any time after certification. For oppositions under different sections of the Act, e.g. sec 104 or sec 223, the usual time limits and procedures apply, notwithstanding that an innovation patent is involved.

When an opposition under sec 101M to an innovation patent is filed, it must be accompanied by a statement of grounds and particulars. The time for filing the statement can only be extended under sec 223.

Failure of the opponent to provide the statement of grounds and particulars with a notice of opposition is a ground for dismissal of the opposition by the Commissioner.
2.31.1.8 Re-Examination

The re-examination procedure for innovation patents is the same as that for standard patent applications (see 2.22 Re-Examination).

2.31.1.9 Ceasing/Expanding

An innovation patent will expire at the end of 8 years from the date of the patent. The date of a patent is either the date of filing, or the date determined by reg 6.3 (sec 65).

An innovation patent ceases if, inter alia:

- the filing fee is not paid;
- the patentee fails to pay the examination fee (or half of the fee if a third party requests examination) within the time allowed;
- the innovation patent is not certified within the time allowed from the first examination report; or
- a renewal fee (required from the second anniversary of the date of the patent) is not paid by the due date or within the 6 month grace period (sec 143A(d) and reg 13.6).

2.31.1.10 Amendments

For information on the procedures to be followed, see 2.31.4.7 Amendments.

2.31.1.11 Notification by Third Parties
2.31.2.1 Section 79B and Section 79C Divisional Applications

Sections 79B and 79C provide for the filing of divisional applications for innovation patents.

Under sec 79B, the divisional application is filed prior to the grant of a parent application (either a standard patent application or an innovation patent application).

Under sec 79C, the divisional application is filed after the grant of a parent innovation patent.

The divisional application must be filed within certain time limits and meet particular requirements. Information on procedures relating to divisional applications is provided in 2.10 Divisional Applications (Sections 79B and 79C) and in particular:

- 2.10.1 Application;
- 2.10.3 Time Limits for Filing Applications; and
- 2.10.4 Status of Parent.

2.31.2.2 Association with Provisional Applications

The Act does not allow for “division” of an innovation patent application from a provisional application. However, one or more innovation patent applications may be “associated” with one or more provisional applications in order to take advantage of earlier disclosure in the provisional application(s).
2.31.2.3 Applications for Patents of Addition

Under sec 80 an innovation patent cannot be a patent of addition. This exclusion extends to innovation patents in the role of either parent or additional (by virtue of sec 81).

2.31.2.4 Convention Applications

An innovation patent application may be a Convention application. The statutory requirements and associated procedures are the same as those outlined for standard patent applications (see 2.21 Convention Applications).

Basic Specifications

A copy of the basic specification for an innovation patent will only be required in the same circumstances as for a standard patent application (see 2.21.3.8 Basic Specifications).

If the basic specification is in a language other than English, the patentee does not need to file a translation unless requested to do so by the Commissioner. The Commissioner will only request a translation where the circumstances set out in 2.21.3.8 Basic Specifications arise.
2.31.2.5 International (PCT) Applications

Time Limits for Providing Basic Specifications and/or Translations

The patentee must file the basic specification and/or its translation within 3 months from the date of the Commissioner's request under sec 43AA.

A request by the Commissioner for a copy of a basic specification and/or its translation during examination may in some circumstances extend the period for certification by up to 5 months. For further information on the procedures to be followed, see 2.31.4.2 Period for Examination to be Carried Out.

*Note: For translations filed before or on 25 September 2019, a certificate of verification for the translation must also be provided.

2.31.2.6 Parallel Applications

"Parallel applications" or "parallel protection" refers to the practice of having both a standard patent application and an innovation patent application in respect of the same subject matter proceeding at the same time. The two applications may be linked together utilising the provisions of sec 79B and sec 79C, or they may be quite independent applications. The rationale behind parallel protection is to take advantage of the shorter time taken to grant an innovation patent, as well as the longer term and the absence of a statutory limit on the number of claims applying to a standard patent.

Applications involving parallel protection are subject to the usual provisions of the Act. However examiners should also be aware of:
• "Whole of contents" considerations, if the respective priority dates are different; and
• Multiple applications considerations, if the respective priority dates are the same.

Office practice in relation to "parallel protection" applications is to treat each application on its own merits and in the usual manner. Thus, examination of the innovation patent should not be delayed until an examination request makes concurrent examination of the standard application possible. However, if an examination request has been filed such that processing of both applications can occur simultaneously, then it may be more efficient to examine both applications together. (Note, however, the procedures for managing divisional applications outlined in 2.10.11 Case Management of Divisional Applications).

A cross-reference should be placed on both case files as soon as the examiner is aware of the co-existence of the application for a standard patent and innovation patent.

See also:
• 2.4.11 "Whole of Contents" Novelty;
• 2.18.3.1 Application for a Standard Patent; and
• 2.18.3.2 Innovation Patent.

2.31.3 Formalities Check for Innovation Patents

Modified Date: 02 April 2013

2.31.3.1 Introduction

For every innovation patent application filed, the Commissioner must undertake a formalities check (sec 52(1)). If the application passes the formalities check, the Commissioner must accept the patent request and complete specification (sec 52(2)).

Modified Date: 25 February 2019

2.31.3.2 Formalities to be Checked

In this topic:
2.31.3.2 Formalities to be Checked

Overview

Regulation 3.2B specifies the formalities that are to be checked. In practice, most formalities will be checked by COG. Examiners are only required to check whether the complete specification contravenes sec 18(2) or sec 18(3), i.e. it must not be in respect of humans, plants or animals, or biological processes for their generation (reg 3.2B(1)(g)).

Formalities 2 Check – Compliance With Subsections 18(2) and 18(3)

All examiners hold the delegation to undertake a formalities check, which is performed during indexing of the application (see 5.9.3.2 Innovation Indexing). The check need only focus on whether the complete specification contravenes sec 18(2) or sec 18(3). Guidance on what constitutes a human being, plants or animals, or biological processes for their generation, is provided in 2.31.4.6 Ground (3): Subsections 18(2) and (3).

Examiners should assume that COG have already checked all other requirements and that any issues have been identified and the appropriate directions sent out. However, where there is an issue which does not appear to have been addressed, COG should be notified.

Failure to Pass Formalities Check

Where an application contravenes sec 18(2) or sec 18(3), examiners are to issue a direction to the applicant using the procedures outlined in 5.9.3.2.1 Innovation Indexing Fails Formalities 2.

The applicant has 2 months from the date of the direction to respond, otherwise the application will lapse. However, where the applicant responds within 2 months, the applicant has additional time in which to comply with the direction. Thus, if the formalities objection is not overcome within 4 months from the date of issuing the direction, the application will lapse (reg 3.2B(6)).

Where a Formalities 2 direction is issued, examiners must inform COG as outlined in 5.9.3.2.1 Innovation Indexing Fails Formalities 2.

Where an innovation patent application fails the formalities check and lapses, the applicant will be advised of the lapsing and the lapsing will be advertised in the Official Journal.
2.31.4.1 Introduction

Acceptance

Once an application has passed the formalities check and been indexed, acceptance will normally be carried out by COG. The only exception to this is where there are amendments to consider before acceptance, and these involve more than just substitution of sheets, e.g. amendments filed in response to a Formalities 2 direction. In this case, the examiner who considers the amendments will have responsibility for accepting the application and must have acceptance delegation (see also 2.31.4.7 Amendments).

2.31.4 Examination

Modified Date: 02 April 2013

2.31.4.1 Introduction

Chapter 9A requires the Commissioner to carry out examination of an innovation patent if requested to do so by the patentee or a third party. The Commissioner may also decide to carry out examination. Only a granted innovation patent can be examined.

Once examination has commenced, no further requests for examination can be made (reg 9A.1(5)).

Fees Payable

If patentees request examination, they must pay an examination fee. If a third party requests examination, both the third party and the patentee must pay an examination fee. If the patentee fails to pay this fee, the patent will cease. If the Commissioner decides to examine the innovation patent, the patentee is not required to pay any fee.

Withdrawal of Request

Only the person who requested examination can withdraw the request and withdrawal can only be based on error. The request for examination cannot be withdrawn after examination has begun (reg 9A.1(4)).
2.31.4.2 Period for Examination to be Carried Out

**Examination Practice**

All examiners hold the delegation to examine innovation patents, however acceptance delegation is required for certification.

Where a third party requests examination, a copy of each adverse report is to be sent to that party, as well as the patentee (see 5.11.4.1.3 Examiner’s Adverse Report to 3rd Party).

In the case of a clear report, COG will send a notice of certification to the third party once the innovation patent has been certified.

Modified Date: 25 September 2019

**2.31.4.2 Period for Examination to be Carried Out**

In this topic:

In general, the period within which examination must be carried out is 6 months from the date of issuing the first report under sec 101B.

If objections raised in an adverse report are still outstanding when the period for examination expires, the patent will cease.

**Response to Report**

Where a response to a report is received close to the expiry of the period for examination, similar procedures apply as for standard patent applications when responses are received close to the expiry of the period for acceptance (see 2.13.2.3 Lapsing at Further Report).

Where the time for examination expires on a day that the Office is not open for business, the examination process can be completed on the next day that the Office is open for business (in the same way as for the time for acceptance, see 2.15.6 Time for Acceptance).
2.31.4.2 Period for Examination to be Carried Out

Where a response to an examination report is received in the Office after the final date for certification (FDC), the case file should not be forwarded to the relevant examination section. However, where an examiner does receive such a file, COG should be notified, who will in turn advise the patentee of the status of the patent.

Non-Receipt of Report

If a report is issued but is not received by the patentee, then there may be grounds for an extension of time under sec 223 to the period for examination. Similar considerations apply as for standard patents (see 2.2.4.2 Delayed or Non-Receipt of the Report by the Applicant or Attorney).

Extending the Period for Examination

In certain circumstances, the period for examination may be extended as follows:

- where a "whole of contents" novelty citation is not yet published, by the period set out in reg 13.4(1)(d);
- in the case where an appeal has been made to a prescribed court in relation to the patent, 3 months from the date that the appeal is withdrawn or finally dealt with or determined (note that the court may substitute a period greater than 3 months);
- where the Commissioner requests a basic specification and/or its translation, 5 months from the date of the request (note that for translations filed before or on 25 September 2019, a certificate of verification for the translation is also required);
- where an adverse report raises a novelty or innovative step objection based on information in a sec 28 notice, 3 months from the date of the report in which that objection was first raised.

In these situations, the procedures to be followed are similar to those for standard patent applications (see 2.15.7 Extending the Time for Acceptance). Thus, where examiners consider that the period for examination will be extended, they should first consult Patent Oppositions. If Patent Oppositions are in agreement, examiners must update the FDC in PAMS prior to creating the examination report in DocGen (see 5.5.3.4 Exam Details). A case note should be added to the file, indicating that the FDC has changed as a result of
2.31.4.3 Grounds of Examination

particular circumstances, for example a request by the Commissioner for the patentee to provide a copy of a basic specification.

**Warning:** The FDC should only be changed when it is appropriate to do so. Examiners should consult Patent Oppositions before changing the FDC in PAMS.

The examination report should indicate that the FDC is a later date (see **Example – Request for Basic Specification** below).

**Example – Request for Basic Specification**

A request by the Commissioner for a copy of a basic specification during examination may in some circumstances extend the period for certification by up to 5 months. In general, a patentee has 3 months from the date of the request in which to provide the documents (reg 3.14D(2)). However, where the period ending 5 months from the date of a report that first requests the patentee to provide a basic specification extends beyond the FDC that otherwise applies (generally 6 months from the date of the first report), the FDC will be the later date, i.e. 5 months from the date of the report which first mentions the objection (reg 9A.4(d)). This later date is to be specified in the report as being the final date to remove all grounds of revocation by including an additional comment in the introductory paragraph as follows:

"The provisions of regulation 9A.4(d) provide that the final date to remove all grounds of revocation is now 5 months from the date of this report."

Modified Date: 25 February 2019

**2.31.4.3 Grounds of Examination**

**Note:** The information in this part only applies to:

- innovation patents with an examination request filed **before** 15 April 2013.
- innovation patents where the Commissioner **decided before** 15 April 2013 to examine the patent.

For all other innovation patents, see **2.31.4.3A Grounds of Examination**.

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Effective Date: 25 September 2019
The grounds of revocation of an innovation patent for invalidity are as follows:

1. the patent does not comply with sec 40;
2. the patent does not comply with sec 18(1A)(a) or sec 18(1A)(b);
3. the patent does not comply with sec 18(2) or sec 18(3);
4. use of the invention is contrary to law;
5. the invention is a food or medicine containing a mere admixture of known ingredients;
6. the invention is a process producing a food or medicine through mere admixture of known ingredients;
7. the patent contains a claim that includes the name of a person as the name or part of the name of an invention;
8. the patent claims an invention that is the same as an invention that is the subject of a patent and is made by the same inventor where the relevant claims of each patent have the same priority date; and
9. the patent does not comply with other matters prescribed in the Regulations.

**Note:** Examiners are not to object to the lack of a notice of entitlement. Entitlement is not a ground of examination (although it is ground of opposition) and there is no requirement for a notice to be filed. (Statements regarding entitlement are included in the patent request).

The consideration of these grounds is substantially the same as the consideration of the corresponding grounds of examination for standard patent applications. It should be noted that the grounds of examination for standard patent applications which are equivalent to:

- grounds (4), (5), (6) and (7) referred to above are contained in sec 50; and
- ground (8) is contained in sec 64(2) (see [2.18.3.1 Application for a Standard Patent](#) and [2.18.3.2 Innovation Patent](#)).

In considering the grounds of revocation, the Commissioner must be “satisfied” that the criteria for novelty and innovative step are met. For all other grounds of revocation, the Act requires that the Commissioner “considers” that a ground for revocation has not been made out (see [2.13.5 Stringency of Tests During Examination](#)).

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**Private Applicant Cases**

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Effective Date: 25 September 2019
In the case of private applicants, examiners must include the following text at the end of any adverse examination report:

“You must pay annual renewal fees by when they are due or your patent will cease. Please note that you will not be notified by the Office of any due dates for the payment of fees. You will need to keep track of this yourself. For innovation patents, the first of these fees is usually due two years from the filing date, however depending on the circumstances of your application, another date may apply. Information about the fees that you will need to pay and when they will be due may be obtained by phoning 1300 651010.”

[See PERP code R71]

Note: The information in this part only applies to:

- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other innovation patents, see 2.31.4.3 Grounds of Examination.

The grounds of revocation of an innovation patent for invalidity are as follows:

1. the patent does not comply with sec 40;
2. the patent does not comply with sec 18(1A)(a) or sec 18(1A)(b) or sec 18(1A)(c);
3. the patent does not comply with sec 18(2) or sec 18(3);
4. use of the invention is contrary to law;
5. the invention is a food or medicine containing a mere admixture of known ingredients;
6. the invention is a process producing a food or medicine through mere admixture of known ingredients;
7. the patent contains a claim that includes the name of a person as the name or part of the name of an invention;
8. the patent claims an invention that is the same as an invention that is the subject of a patent and is made by the same inventor where the relevant claims of each patent have the same priority date; and

9. the patent does not comply with other matters prescribed in the Regulations.

**Note:** Examiners are not to object to the lack of a notice of entitlement. Entitlement is not a ground of examination (although it is ground of opposition) and there is no requirement for a notice to be filed. (Statements regarding entitlement are included in the patent request).

The consideration of these grounds is substantially the same as the consideration of the corresponding grounds of examination for standard patent applications. It should be noted that the grounds of examination for standard patent applications which are equivalent to:

- grounds (4), (5), (6) and (7) referred to above are contained in sec 50; and
- ground (8) is contained in sec 64(2) (see 2.18.3.1 Application for a Standard Patent and 2.18.3.2 Innovation Patent).

In considering the grounds of revocation, the Commissioner must be "satisfied, on the balance of probabilities" that the invention meets the necessary requirements (see 2.13.5 Stringency of Tests During Examination).

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**Private Applicant Cases**

In the case of private applicants, examiners must include the following text at the end of any adverse examination report:

“You must pay annual renewal fees by when they are due or your patent will cease. Please note that you will not be notified by the Office of any due dates for the payment of fees. You will need to keep track of this yourself. For innovation patents, the first of these fees is usually due two years from the filing date, however depending on the circumstances of your application, another date may apply. Information about the fees that you will need to pay and when they will be due may be obtained by phoning 1300 651010.”

[See PERP code R71]
2.31.4.4 Ground (1): Section 40

The consideration of sec 40 issues is the same for innovation patents as it is for standard patent applications, except that innovation patents are limited to 5 claims, any number of which may be independent (sec 40(2)(c)).

Where an innovation patent has more than 5 claims, examiners should issue a report stating:

"Your Innovation Patent does not comply with Section 40(2)(c) of the Patents Act because it has more than five claims defining the invention. You will need to file amended claims having no more than five claims."

[See PERP code E90]

Unless all claims can be examined with negligible additional effort, examiners should reserve opinion on all other examination issues pending response to the report.

2.31.4.5 Ground (2): Subsection 18(1A)

Modified Date: 02 April 2013

2.31.4.5.1 Requirements

Subsection 18(1A) provides that to be a patentable invention for the purposes of an innovation patent, the invention as far as claimed in any claim must be:

- a manner of manufacture within the meaning of section 6 of the Statute of Monopolies;
- novel and involve an innovative step;
- useful; and
- not secretly used in the patent area without relevant authority.

Furthermore, sec 18(2) and sec 18(3) provide that certain inventions are not patentable inventions for the purposes of an innovation patent.

See also:

- 2.31.4.5.2 Manner of Manufacture;
- 2.31.4.5.3 Novelty;
2.31.4.5.2 Patentable Subject Matter (Manner of Manufacture)

- 2.31.4.5.4 Innovative Step; and
- 2.31.4.6 Ground (3): Subsections 18(2) and (3).

The subject matter of an innovation patent must meet the same manner of manufacture requirements as for a standard patent application (see 2.9.2 Patentable Subject Matter (Manner of Manufacture)).

However, whilst examiners should consider the possibility of raising a manner of manufacture objection in tandem with an inventive step objection for standard patent applications (2.9.2 Patentable Subject Matter (Manner of Manufacture)), the same does not apply to innovation patents. The legislation on innovation patents stipulates that the requirement for an inventive step is replaced by the requirement for an innovative step, and that lack of an inventive step does not render an innovation patent invalid.

**Note:** If, during examination of a standard patent application, it is considered that there is a lack of patentable subject matter, examiners should only raise the possibility of converting the application to one for an innovation patent if there is subject matter for which a valid innovation patent could be granted and certified. This is only likely to arise where an objection of lack of an inventive step applies to the standard patent application, but there is the possibility that the requirements for an innovative step could be met. Otherwise, there should be no mention of innovation patents in the report.

2.31.4.5.3 Novelty

The claims of an innovation patent must satisfy the same tests for novelty as those that apply to a standard patent application (see 2.4 Novelty). In particular, there is no difference in the prior art base against which novelty of the invention is compared for the two types of patent.
Note: The information in this part only applies to:

- innovation patents with an examination request filed before 15 April 2013.
- innovation patents where the Commissioner decided before 15 April 2013 to examine the patent.

For all other innovation patents, see 2.31.4.5.4A Innovative Step.

In this topic:

Overview

The claims of an innovation patent must involve an innovative step. As to what constitutes an innovative step, sec 7(4) provides that:

"an invention is to be taken to involve an innovative step when compared with the prior art base unless the invention would, to a person skilled in the relevant art, in the light of the common general knowledge as it existed in the patent area before the priority date of the relevant claim, only vary from the kinds of information set out in subsection (5) in ways that make no substantial contribution to the working of the invention." (emphasis added)

Subsection 7(5) identifies the information to be of the following kinds:

"(a) prior art information made publicly available in a single document or through doing a single act;

(b) prior art information made publicly available in 2 or more related documents, or through doing 2 or more related acts, if the relationship between the documents or acts is such that a person skilled in the relevant art in the patent area would treat them as a single source of that information."

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Effective Date: 25 September 2019
Examination Practice

Examiners should note that the prior art base against which an assessment is made of whether an invention involves an innovative step is the same as that used in relation to standard patent applications when assessing whether an invention involves an inventive step. However, for inventive step considerations, the prior art information is limited to information that the skilled person could be reasonably expected to have "ascertained, understood and regarded as relevant". There is no such limitation for innovative step considerations. Thus, although the prior art base for inventive step and innovative step is the same, the prior art information that can be considered for each is different.

An adverse innovative step finding must rely on a published document. Information available only through the doing of an act is not to be considered during examination.

Unlike an adverse inventive step finding, an adverse innovative step finding cannot rely on common general knowledge per se, whether considered separately or together with the disclosure of a document. The reference to common general knowledge in sec 7(4) relates to the assessment of the contribution a feature makes to the working of the invention, and not to whether that feature is itself common general knowledge.

Note: When categorising citations relevant to an innovation patent, the ‘X’ category should be used for those documents where the claimed invention cannot be considered novel, or cannot be considered to involve an innovative step, when the document is taken alone. Where two or more related documents are considered as a single source of information (sec 7(5)), the primary document should be categorised as an ‘X’ and the secondary document (referred to explicitly in the primary document) should be categorised as an ‘L’. The ‘Y’ category does not apply to innovation patents, as an innovative step objection cannot be based on a combination of (unrelated) documents, or the combination of a document and common general knowledge.

Determination of Innovative Step

An innovative step requires that the invention is not only novel, but that it also differs from what was already known in a way that is not merely superficial (or trivial) or peripheral to the invention. The variation must be of practical significance to the way the invention works, so as to make a "substantial contribution" to the working. However, in contrast to a standard patent application, there is no requirement that an invention claimed in an innovative patent must be non-obvious. Therefore, the inventive threshold for innovation patents is lower than that for standard patent applications.
The concept of innovative step was considered in *Dura-Post (Aust) Pty Ltd v Delnorth Pty Ltd* [2009] FCAFC 81. As set out by the Court at paragraph 54, the test for an innovative step requires the consideration and, where necessary, the identification of:

a. the invention "so far as claimed in any claim";
b. the "person skilled in the relevant art";
c. the common general knowledge as it existed in Australia before the priority date; and

then to ask, in accordance with sec 7(4), whether the invention only varies from the kinds of information in sec 7(5) in ways that make no substantial contribution to the working of the invention. This approach has been followed in subsequent decisions on innovation patents (see, for example, *Seafood Innovations Pty Ltd v Richard Bass Pty Ltd* [2010] FCA 723 and *SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatments Limited* [2012] FCAFC 95).

### Substantial Contribution

The nature of the "substantial contribution" was considered in the *Dura-Post* decision and the following points can be made:

- The assessment of innovative step is a matter of fact. Examiners will not normally have available to them direct evidence that could assist in this regard and will need to make an assessment of whether an innovative step exists based on their own knowledge. However, the balance of probabilities applies.

- "Substantial" in the context of substantial contribution means "real" or "of substance" rather than "more than insubstantial" or "distinctions without a real difference".

- The substantial contribution is in relation to the working of the invention itself and not the contribution that is made to the art.

- There is no provision in sec 7(4) or sec 18(1A) which provides means for distinguishing the essential features of the invention (as defined in the claims) from its non-essential features. The concept of essential features/non-essential features is not part of the consideration for innovative step.

2.31.4.5.4.2 Examples discusses the features that were found in the Dura-Post decision to provide a "substantial contribution" to the working of the invention despite being known in the art.
2.31.4.5.4.1 Indicators of Innovative Step

**Note:** The information in this part applies to all innovation patents.

As to the level of contribution necessary to be ‘substantial’ and thus meet the innovative step test, no definitive measure applies and examiners need to assess each case on its own merits given the nature of the invention.

Questions which may assist in considering the requirement for a ‘substantial’ contribution include:

- Does the difference identified between the invention and the prior art convey an advantage to the invention?

- Does the difference provide a technical or functional contribution to the invention? In assessing this indicator, the concept of 'technical nature or feature' in terms of that used in relation to manner of manufacture may be helpful (see 2.9 Patentable Subject Matter). Technical in this sense is in relation to vendible or economic value having a practical application, i.e. there is some usefulness or physical effect resulting from the working of the invention. Mere aesthetic effects are not considered to fall within the realms of technical.

- Is the difference a significant aspect of the operation of the invention?

Answering ‘yes’ to these questions suggests that the invention is likely to be innovative, while answering ‘no’ suggests that the invention may lack an innovative step. However, it must be borne in mind that these questions are merely indicators and each case needs to be considered on its own merits. *Product Management Group Pty Ltd v Blue Gentian LLC* [2015] FCAFC 179 makes it clear that the appropriate test to apply remains whether there is a substantial contribution to the working of the invention as per 2.31.4.5.4 Innovative Step. In this regard, examiners should reflect the appropriate test in their objections.

Examiners should note that objections of innovative step are raised, and maintained, on the balance of probabilities (see 2.13.5.2 Balance of Probabilities).

*Dura-Post (Aust) Pty Ltd v Delnorth Pty Ltd* [2009] FCAFC 81 (and *Delnorth Pty Ltd v Dura-Post (Aust) Pty Ltd* [2008] FCA 1225) also provide some guidance on assessing innovative step.

2.31.4.5.4.2 Examples discusses the features in the Dura-Post decision that were found to confer an innovative step and the advantages or contributions that they made to the invention.
Certain claims considered in *Dura-Post (Aust) Pty Ltd v Delnorth Pty Ltd* [2009] FCAFC 81 were found innovative, while others lacked an innovative step. These examples may assist in applying the "substantial contribution" aspect of the innovative step test.

The roadside post of sheet spring steel was found to be innovative over prior disclosures of posts made of plastic or fibre reinforced synthetic material. While the various materials have the same objective (flexibility), the materials themselves are different and the use of sheet spring steel was a significant aspect in the operation of the roadside post and was found to make a substantial contribution.

Additional features of the roadside post, all of which were known individually in the art, were found to contribute to the working of the invention. These features were a marker hole (which ensured installation of the post to the correct depth and aided in extraction), a barb (which served to anchor the post in the ground), a tapered end (which facilitated installation), longitudinally extending ribs (which improved resistance to buckling and reduce wind shimmeying) and the particular dimensions as defined in the claim. Each of these features was found to make a substantial contribution to the working of the roadside post.

However, the roadside post was found not innovative in light of a "highway marking device" which differed only in the placement of the post in relation to the road. The placement was found not to make a substantial contribution to the working of the post.

The surface coating on the roadside post was also found not innovative. The judge in *Delnorth Pty Ltd v Dura-Post (Aust) Pty Ltd* [2008] FCA 1225 stated at paragraph 83 that:

“I do not suggest that it has no functional purpose, rather that the contribution is not significant enough”.

More guidance in applying the "substantial contribution" aspect of the innovative step test can be gained from the following reported cases which applied the test for novelty as stated in *Griffin v Issacs* [1942] AOJP 739 at 740; 1B IPR 619 and which preceded the reverse infringement test. The test for innovative step is a modified form of this previous novelty test.
The invention concerned an industrial dry cleaning or washing machine. The High Court noted a "significant difference" between the prior art machine which had a drum mounted on an inclined axis, whereas the patent in suit had an axis which was substantially horizontal. The Court regarded this "as a very marked distinction affecting the entire design criteria and in that respect distinguishable from the case of Griffin v Issacs".

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**Thetford Corporation v Sanitation Equipment 7 IPR 77**

The portable toilet of the invention differed from a prior art device in that a component which was provided as a separate part in the prior art was defined as an integral part of the portable toilet in the claim. This difference was considered to contribute to the working of the invention as it was stated “It may well be that the provision of an interlocking part simplifies construction or lowers the cost of construction, and as no evidence to the contrary has been produced the doubt on this point must be resolved in favour of the applicant.”

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**Whitco v Austral Lock 13 IPR 115**

A claim to a cylinder lock differed from a prior device with a cover member, in that the cover member included projections which extended at least partially into the tumbler pin passages. This difference was found to make no substantial contribution to the working of the invention, since the projections contributed no more to closing the passages, or to retaining any springs and tumbler pins therein, than a cover without such projections.

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**Carpenter v Sue 23 IPR 63**

The tool of the invention differed from a prior device by the addition of a barb feature. The barb feature enabled the tool to be used in a way enhancing its operation. This difference was found to clearly contribute to the working of the invention.
Re Application of Bruce Lake 24 IPR 281

The invention related to a cleaning process for ducting and differed from the prior art by way of a self-propelling feature of the cleaning nozzle when supplied with pressurised air. The self-propelling feature was found to make a substantial contribution to the working of the invention.

Bausch & Lomb Inc v Allergan Inc (1992) AIPC 90-913

The invention was a method of cleaning and disinfecting contact lenses, which significantly reduced the time needed to complete the process. It was found that the prior art method, which consisted of two steps, was not an equivalent of the method according to the invention which combined these two steps into one.

Note: The information in this part only applies to:

- innovation patents with an examination request filed on or after 15 April 2013.
- innovation patents where the Commissioner had not decided before 15 April 2013 to examine the patent.

For all other innovation patents, see 2.31.4.5.4A Innovative Step.
Overview

The claims of an innovation patent must involve an innovative step. As to what constitutes an innovative step, sec 7(4) provides that:

"an invention is to be taken to involve an **innovative step** when compared with the prior art base unless the invention would, to a person skilled in the relevant art, in the light of the common general knowledge as it existed (whether in or out of the patent area) before the priority date of the relevant claim, only vary from the kinds of information set out in subsection (5) in ways that **make no substantial contribution to the working of the invention**." (emphasis added)

Subsection 7(5) identifies the information to be of the following kinds:

"(a) prior art information made publicly available in a single document or through doing a single act;

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Examination Practice

Examiners should note that the prior art base against which an assessment is made of whether an invention involves an innovative step is the same as that used in relation to standard patent applications when assessing whether an invention involves an inventive step.

However, unlike an adverse inventive step finding, an adverse innovative step finding cannot rely on common general knowledge *per se*, whether considered separately or together with the disclosure of a document. The reference to common general knowledge in sec 7(4) relates to the assessment of the contribution a feature makes to the working of the invention, and not to whether that feature is itself common general knowledge.

Examiners should also note that an adverse innovative step finding can rely on information made publicly available through doing an act, including a prior use.

**Note:** When categorising citations relevant to an innovation patent, the ‘X’ category should be used for those documents where the claimed invention cannot be considered novel, or cannot be considered to involve an innovative step, when the document is taken alone.
Where two or more related documents are considered as a single source of information (sec 7(5)), the primary document should be categorised as an ‘X’ and the secondary document (referred to explicitly in the primary document) should be categorised as an ‘L’. The ‘Y’ category does not apply to innovation patents, as an innovative step objection cannot be based on a combination of (unrelated) documents, or the combination of a document and common general knowledge.

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**Determination of Innovative Step**

An innovative step requires that the invention is not only novel, but that it also differs from what was already known in a way that is not merely superficial (or trivial) or peripheral to the invention. The variation must be of practical significance to the way the invention works, so as to make a "substantial contribution" to the working. However, in contrast to a standard patent application, there is no requirement that an invention claimed in an innovative patent must be non-obvious. Therefore, the inventive threshold for innovation patents is lower than that for standard patent applications.

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1. the invention "so far as claimed in any claim";
2. the "person skilled in the relevant art";
3. the common general knowledge as it existed before the priority date; and

then to ask in accordance with sec 7(4), whether the invention only varies from the kinds of information in sec 7(5) in ways that make no substantial contribution to the working of the invention. This approach has been followed in subsequent decisions on innovation patents (see, for example, *Seafood Innovations Pty Ltd v Richard Bass Pty Ltd* [2010] FCA 723 and *SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatments Limited* [2012] FCAFC 95).

**Substantial Contribution**

The nature of the "substantial contribution" was considered in the *Dura-Post* decision and the following points can be made:
2.31.4.5.4.1 Indicators of Innovative Step

- The assessment of innovative step is a matter of fact. Examiners will not normally have available to them direct evidence that could assist in this regard and will need to make an assessment of whether an innovative step exists based on their own knowledge. However, the balance of probabilities applies.

- "Substantial" in the context of substantial contribution means “real” or "of substance" rather than “more than insubstantial” or “distinctions without a real difference”.

- The substantial contribution is in relation to the working of the invention itself and not the contribution that is made to the art.

- There is no provision in sec 7(4) or sec 18(1A) which provides means for distinguishing the essential features of the invention (as defined in the claims) from its non-essential features. The concept of essential features/non-essential features is not part of the consideration for innovative step.

2.31.4.5.4.2 Examples discusses the features that were found in the Dura-Post decision to provide a "substantial contribution" to the working of the invention despite being known in the art.

Note: The information in this part applies to all innovation patents.

As to the level of contribution necessary to be 'substantial' and thus meet the innovative step test, no definitive measure applies and examiners need to assess each case on its own merits given the nature of the invention.

Questions which may assist in considering the requirement for a 'substantial' contribution include:

- Does the difference identified between the invention and the prior art convey an advantage to the invention?

- Does the difference provide a technical or functional contribution to the invention? In assessing this indicator, the concept of 'technical nature or feature' in terms of that used in relation to manner of manufacture may be helpful (see 2.9 Patentable Subject Matter). Technical in this sense is in relation to vendible or economic value having a practical application, i.e. there is some usefulness or physical effect resulting from the working of the invention. Mere aesthetic effects are not considered to fall within the realms of technical.
2.31.4.5.4.2 Examples

- Is the difference a significant aspect of the operation of the invention?

Answering ‘yes’ to these questions suggests that the invention is likely to be innovative, while answering ‘no’ suggests that the invention may lack an innovative step. However, it must be borne in mind that these questions are merely indicators and each case needs to be considered on its own merits. Product Management Group Pty Ltd v Blue Gentian LLC [2015] FCAFC 179 makes it clear that the appropriate test to apply remains whether there is a substantial contribution to the working of the invention as per 2.31.4.5.4 Innovative Step. In this regard, examiners should reflect the appropriate test in their objections.

Examiners should note that objections of innovative step are raised, and maintained, on the balance of probabilities (see 2.13.5.2 Balance of Probabilities).

Dura-Post (Aust) Pty Ltd v Delnorth Pty Ltd [2009] FCAFC 81 (and Delnorth Pty Ltd v Dura-Post (Aust) Pty Ltd [2008] FCA 1225) also provide some guidance on assessing innovative step. 2.31.4.5.4.2 Examples discusses the features in the Dura-Post decision that were found to confer an innovative step and the advantages or contributions that they made to the invention.

Modified Date: 03 September 2018

2.31.4.5.4.2 Examples

Note: The information in this part applies to all innovation patents.

Certain claims considered in Dura-Post (Aust) Pty Ltd v Delnorth Pty Ltd [2009] FCAFC 81 were found innovative, while others lacked an innovative step. These examples may assist in applying the "substantial contribution" aspect of the innovative step test.

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Additional features of the roadside post, all of which were known individually in the art, were found to contribute to the working of the invention. These features were a marker hole (which ensured installation of the post to the correct depth and aided in extraction), a barb (which served to anchor the post in the ground), a tapered end (which facilitated installation), longitudinally extending ribs (which improved resistance to buckling and reduce wind...
shimmying) and the particular dimensions as defined in the claim. Each of these features was found to make a substantial contribution to the working of the roadside post.

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The surface coating on the roadside post was also found not innovative. The judge in *Delnorth Pty Ltd v Dura-Post (Aust) Pty Ltd* [2008] FCA 1225 stated at paragraph 83 that:

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**Washex Machinery Corporation v Roy Burton & Co (1975) 49 ALJR 12**

The invention concerned an industrial dry cleaning or washing machine. The High Court noted a "significant difference" between the prior art machine which had a drum mounted on an inclined axis, whereas the patent in suit had an axis which was substantially horizontal. The Court regarded this "as a very marked distinction affecting the entire design criteria and in that respect distinguishable from the case of Griffin v Issacs".

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**Thetford Corporation v Sanitation Equipment 7 IPR 77**

The portable toilet of the invention differed from a prior art device in that a component which was provided as a separate part in the prior art was defined as an integral part of the portable toilet in the claim. This difference was considered to contribute to the working of the invention as it was stated "It may well be that the provision of an interlocking part simplifies construction or lowers the cost of construction, and as no evidence to the contrary has been produced the doubt on this point must be resolved in favour of the applicant."
Whitco v Austral Lock 13 IPR 115

A claim to a cylinder lock differed from a prior device with a cover member, in that the cover member included projections which extended at least partially into the tumbler pin passages. This difference was found to make no substantial contribution to the working of the invention, since the projections contributed no more to closing the passages, or to retaining any springs and tumbler pins therein, than a cover without such projections.

Carpenter v Sue 23 IPR 63

The tool of the invention differed from a prior device by the addition of a barb feature. The barb feature enabled the tool to be used in a way enhancing its operation. This difference was found to clearly contribute to the working of the invention.

Re Application of Bruce Lake 24 IPR 281

The invention related to a cleaning process for ducting and differed from the prior art by way of a self-propelling feature of the cleaning nozzle when supplied with pressurised air. The self-propelling feature was found to make a substantial contribution to the working of the invention.

Bausch & Lomb Inc v Allergan Inc (1992) AIPC 90-913

The invention was a method of cleaning and disinfecting contact lenses, which significantly reduced the time needed to complete the process. It was found that the prior art method, which consisted of two steps, was not an equivalent of the method according to the invention which combined these two steps into one.
2.31.4.6 Ground (3): Subsections 18(2) and (3)

Subsection 18(2)

The consideration of sec 18(2) issues is the same for innovation patents as it is for standard patent applications, i.e. human beings, and the biological processes for their generation, are not patentable.

Subsection 18(3)

Subsection 18(3) specifically excludes certain subject matter from the scope of an innovation patent. An innovation patent is not permitted for plants and animals, and biological processes for the generation of plants and animals. In particular, this includes:

- genetically modified whole plants, plants produced by cross-breeding of one strain with another strain, or selection of a plant from a range of plants;
- genetically modified whole animals (including human beings), animals produced by cross-breeding of one strain with another strain, or selection of an animal from a range of animals;
- seeds of plants, plant tissue cultures, or any matter that could give rise to a plant; and
- animal embryos or foetuses, zygote, or any matter or group of cells, that could give rise to an animal.

The intent of the exclusion in the legislation was in part to avoid overlap between innovation patents and Plant Breeder's Rights.

The Plant Breeder's Rights Act 1994 defines “plant” as follows:

"plant includes all fungi and algae, but does not include bacteria, bacteroids, mycoplasmas, viruses, viroids and bacteriophages."

Consequently, for the purposes of an innovation patent, the meaning of "plant" under sec 18(3) includes all fungi (including yeasts and moulds) and algae.

However, claims to micro-organisms (including bacteria, protozoans, bacteroids, mycoplasmas, viroids, bacteriophages and viruses per se) are not excluded under sec 18(3), since they are not considered to be either plants or animals.
Note that processes which use a plant or animal, or part thereof, but which do not result in a plant or animal, are not excluded. For example, the use of rennet to make cheese, or the use of potatoes to make chips, would not be excluded.

**Subsection 18(4)**

Subsection 18(3) does not apply if the invention is a microbiological process, or a product of such a process (sec 18(4)). Thus:

- preparation of cheese, wine making, brewing and industrial processes involving the use of micro-organisms, such as microbial bleaching or leaching of ores using micro-organisms;
- the use of enzymes derived from micro-organisms for the preparation of, for example, cheese or detergents comprising protease;
- the use of yeast, fungi or moulds for the production of useful products, for example penicillin, enzymes, fermented meats, or industrial alcohol and the products produced by such use; and
- the use of viruses in the preparation of vaccines;

are patentable inventions.

Where examiners have any doubts as to whether an invention is patentable, the matter should be referred to a supervising examiner.

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**2.31.4.7 Amendments**

The procedure concerning amendments for innovation patents is substantially the same as for standard patents (see 2.23 Amendments), except as follows:

- the provisions of sec 102(2) do not apply until a decision has been made to certify the patent;

- an amendment to the patent request for an innovation patent application filed under sec 79C to convert the application to a standard application is not allowable (sec 102(2B)). Note that, as is the case for standard patents, an amendment of the patent request of a granted innovation patent is also not allowable (see 2.23.13.1 Amendment of Patent Request);
proposed amendments to the complete specification, other than those proposed in response to a formalities direction, cannot be allowed until after grant;

an amendment which would result in the specification claiming human beings, plants or animals, or biological processes for the generation of human beings, plants or animals, is not allowable. This is to ensure that once an innovation patent has been granted, but not yet examined, the patentee cannot make amendments to include material which would contravene sec 18(2) or sec 18(3); and

when an amendment is in respect of a granted innovation patent, examiners are required to check:

whether there is a mortgagee or licensee (see 2.23.3.6 Consent of Exclusive Licensee or Mortgagee Required and 5.13.6 Checking for a Mortgagee or an Exclusive Licensee).

whether any court action is pending. This will be evident by the presence of documents labelled ‘Court Documents’ in the PAMS file. In this situation the matter should be referred to Patent Oppositions.

Note: The order of these steps is not mandatory, and may be varied as appropriate.

<p>| | |</p>
<table>
<thead>
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<tbody>
<tr>
<td>1.</td>
<td>Check that the patent specification does not claim a human being, plant or animal, or biological processes for their generation.</td>
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<tr>
<td></td>
<td>2.31.3.2 Formalities to be Checked</td>
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<tr>
<td></td>
<td>2.31.4.6 Ground (3): Subsections 18(2) and (3)</td>
</tr>
<tr>
<td>2.</td>
<td>Classify the invention.</td>
</tr>
<tr>
<td></td>
<td>5.9.3.2 Innovation Indexing</td>
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</table>

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Effective Date: 25 September 2019
2.31 Annex B - Procedural Outline for Examination of an Innovation Patent

**Note:** The order of these steps is not mandatory and may be varied as appropriate.

## First Report

1. Determine the type of innovation patent. An innovation patent application may be for a divisional or Convention application, "associated" with provisional(s), but not for a patent of addition.

2. Check the case file for any matters pertaining to examination or any other outstanding actions.

3. If a Convention application, check:
   - priority documents (where applicable)
   - filed in time
   - first made in prescribed foreign country
   - certified copy.

4. Check to see whether any amendments have already been filed.
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<tr>
<td>5.</td>
<td>Read the claims and, if necessary, the description to get a broad understanding of the scope of the invention:</td>
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<td></td>
<td>• determine whether the claims define a manner of manufacture.</td>
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<td>6.</td>
<td>Read the complete specification and determine:</td>
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<td>• what is the admitted prior art</td>
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<td>• what is the problem to be overcome</td>
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<td></td>
<td>• whether it meets the requirements of sec 40(2).</td>
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<td>7.</td>
<td>Construe the claims, determine their scope and note:</td>
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<td></td>
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<td></td>
<td>• whether they define one invention</td>
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<td></td>
<td>• whether they meet the requirements of sec 40(3)</td>
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<td></td>
<td>• whether the specification ends with at least 1, and not more than 5, claims.</td>
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<td>8.</td>
<td>Determine the search strategy.</td>
</tr>
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<td>9.</td>
<td>Conduct the search where appropriate.</td>
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<tr>
<td>10.</td>
<td>When conducting the search, consider:</td>
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<td></td>
<td></td>
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<td></td>
<td>• novelty including &quot;whole of contents&quot;</td>
</tr>
<tr>
<td></td>
<td>• innovative step and other sec 18 matters.</td>
</tr>
<tr>
<td>11.</td>
<td>Check for multiple applications claiming the same invention.</td>
</tr>
<tr>
<td>12.</td>
<td>Complete the Search Information Statement.</td>
</tr>
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Effective Date: 25 September 2019
13. Prepare the report, ensuring all relevant grounds of revocation are raised. Submit the report for supervision where necessary.

For first reports, set the time for certification at six months from the date of the first report.

Where third parties have requested examination, ensure a copy of the report is sent to them, as well as the patentee.

Further Reports

Adverse

1. Check that the period for examination has not expired.

2. Consider whether the amendments filed, and/or the submissions in rebuttal, overcome the grounds of revocation raised in the last report:
   - determine whether the amendments are allowable
   - consider form of the amendments.

3. Check for new grounds of revocation.

4. Maintain existing grounds or raise new grounds where appropriate.
5. Submit third and subsequent reports for review by the supervising examiner.

6. For further reports, ensure that the report indicates the final date for certification is six months from the date of the first report, or a later date, if applicable.

Where third parties have requested examination, ensure a copy of the report is sent to them, as well as the patentee.

### Clear

1. Check that the period for examination has not expired.

2. Certify the case if the necessary requirements are met.

At final report stage:

- ensure all the pages of the final report form are complete
- submit for supervision if necessary.

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**Annex C - Key Features of Innovation Patent System**

In this topic:

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**General**

- An innovation patent has a maximum term of 8 years and is limited to 5 claims, any number of which may be independent (see **2.31.4.4 Ground (1): Section 40**).
Annex C - Key Features of Innovation Patent System

- An innovation patent application may be associated with a provisional application, may be a Convention application or may be a divisional application (see 2.31.2.1 Section 79B and 79C Divisional Applications, 2.31.2.2 Association with Provisional Applications and 2.31.2.4 Convention Applications).

- An innovation patent application cannot be an additional application and cannot be filed via the PCT route. However, it is possible to convert a standard national phase application to an application for an innovation patent, provided this is done before acceptance (see 2.31.1.2 Filing, 2.31.2.3 Applications for Patents of Addition and 2.31.2.5 International (PCT) Applications).

Formalities Check

- A formalities check must be undertaken for every innovation patent application. If the application passes the formalities check, the Commissioner must accept the application (see 2.31.3.1 Introduction).

- In practice, most of the formalities checks will be performed by COG. The innovation patent application will then be referred to the appropriate examination section for indexing. During indexing, examiners must check that the complete specification does not contravene sec 18(2) or sec 18(3), i.e. it must not be in respect of humans, plants or animals, or biological processes for their generation (see 2.31.3.2 Formalities to be Checked and 2.31.4.6 Ground (3): Subsections 18(2) and (3)).

- Acceptance will normally be carried out by COG. The only exception to this is where there are amendments to consider before acceptance, and these involve more than just substitution of sheets. In this case, the examiner who considers the amendments will have responsibility for accepting the application and must have acceptance delegation (see 2.31.3.2 Formalities to be Checked).

Examination

General

- An innovation patent can only be examined once it has been granted (see 2.31.4.1 Introduction).
• All examiners hold the delegation to examine an innovation patent, however acceptance delegation is required for certification.

• The timeframe for issuing a report on an innovation patent is 8 weeks from the date of receiving the request for examination. However if the examination fee is not paid at the time of making the request, the 8 week period commences upon payment of the fee.

• The period within which examination must be carried out is usually 6 months from the date of issuing the first report (see 2.31.4.2 Period for Examination to be Carried Out).

Grounds of Examination

• Examiners should not object to the lack of a notice of entitlement, as this is not a ground of examination (see 2.31.4.3 Grounds of Examination).

• The consideration of sec 40 issues is the same for innovation patents as it is for standard patent applications (see 2.31.4.4 Ground (1): Section 40).

• The subject matter of an innovation patent must meet the requirements for a manner of manufacture (see 2.31.4.5.2 Manner of Manufacture).

• In order for an innovation patent to be certified, the claimed invention must be novel and involve an innovative step (see 2.31.4.5.3 Novelty and 2.31.4.5.4 Innovative Step).

• Further information on the grounds of revocation of an innovation patent is outlined in 2.31.4.3 Grounds of Examination.

Additional Information

• Information on processing innovation patents in PAMS is provided in 5.11 Innovation Examination.

• PERP codes that may be useful when preparing an innovation examination report are given in 6.8.6 Innovative Step.

Part 2 Printable Version

You will be redirected to the printable version.
If you are not redirected click here for the printable version of the Part 2 of the manual.