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APPLICATION
GUIDE

A guide to applying for your patent

PATENTS

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- To process your, or another person's, patent application.
- To process a request or notice in relation to a patent or patent application.
- To enable third parties and IP Australia to contact you about your patent or patent application or about a request or notice that you have filed in relation to a patent or patent application.
- To perform other functions under the Patents Act.

The Patents Act requires or authorises the Commissioner of Patents to disclose and publish the information provided to us in specified circumstances, as explained in IP Australia's Privacy Policy. This includes disclosure to foreign intellectual property (IP) offices in a number of countries and to IP rights' information subscribers. The information may be published in Official Journals, Registers and data bases in Australia and elsewhere which may be accessed over the internet and/or as paper copy. Periodically, IP Australia (or a company under contract to us) will use your personal information to contact you to conduct market research about our products and services.

IP Australia is committed to complying with the *Privacy Act 1988*, which contains information on privacy principles that IP Australia must observe when collecting, using and disclosing personal information. The personal information handling practices of IP Australia are detailed in IP Australia's Privacy Policy, which contains information about accessing and amending records held by IP Australia containing personal information.

To make a complaint about IP Australia's collection or handling of your personal information, contact IP Australia's Privacy Contact Officer:

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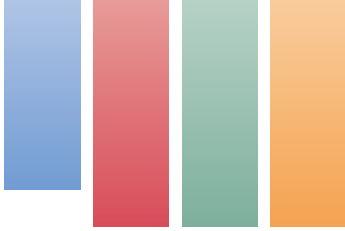
To read IP Australia's Privacy Policy visit our website: www.ipaustralia.gov.au

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This publication serves as a guide and should not be regarded as an authoritative statement on the relevant law and procedure. Whilst we make every effort to ensure the information presented is accurate and up to date, you should check with IP Australia before relying on the information. Although our staff cannot give you advice about your particular circumstances, we can answer general questions about the Australian patent system. We recommend that you seek professional assistance before applying for a patent.

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



First the basics

WHAT IS A PATENT?

A patent is an IP right granted for new technology you have invented. It is legally enforceable and gives you the exclusive right to commercially exploit your invention in Australia for the term of the patent. You can also obtain patent protection overseas.

SEEK PROFESSIONAL ADVICE

Patenting and commercialising an invention can be costly, time-consuming and requires a range of skills you may not currently have. Furthermore, as a first time applicant, you probably don't know what you don't know.

We strongly recommend you seek advice from a patent attorney. Most people would not purchase a home without professional assistance, and yet obtaining a patent is more complex. If you get it wrong from the outset, it can be impossible to correct an error, resulting in a lost opportunity to protect your invention.

KEEP YOUR INVENTION A SECRET

Your invention must be kept secret until you have applied for patent protection. If you demonstrate, sell or discuss your invention in public before you apply, you can lose the opportunity to patent it.

You can still talk to your employees, business partners or advisers about your invention, but make it clear that the information is to be kept confidential. You should use written confidentiality agreements, particularly when negotiating with potential business partners.

PRIORITY DATE—AN IMPORTANT CONCEPT

The date you first file a patent application establishes what is known as a priority date. Potential competitors who file an application at a later date for the same invention will not be entitled to patent it due to your earlier priority date.

DON'T REPLICATE SOMETHING ALREADY PATENTED

You don't want to apply for a patent for an invention that isn't new. Before investing large amounts of time and money, search patent databases, sales brochures and the internet. This will help you determine if your invention has already been thought of by someone else.

SEARCHING AUSTRALIAN PATENT DATABASES

You can search Australian patent documents without any charge via our website using the databases listed below.

AusPat, the search system for Australian patent data provides a single point of enquiry for information on Australian patents. AusPat provides quick, structured or advanced search options to search several bibliographic fields including, document number, International Patent Classification mark, Applicant/Inventor name, and title. Data from AusPat dates back to 1920.

Australian Published Patent Data Searching contains abstracts of Australian patent applications from 1975 onwards in image (not text) format, and some bibliographic data for pre-1975 applications going back to 1920.

AU Patent Specifications allows you to search full copies of Australian patent documents in image format by application number or patent number.

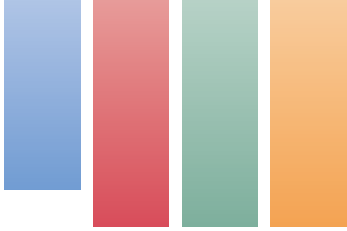
SEARCHING PATENTS WORLDWIDE

Our website provides links to a range of patent databases, including those of the major overseas IP offices. Most of these databases are free to search, but using them effectively is a specialised skill. You may want to contact a patent attorney or professional searcher to search for you.

WHAT NEXT?

Now you know the basics, there are some important decisions ahead. They are:

- Decision 1: Can I patent my invention?
- Decision 2: Should I patent my invention?
- Decision 3: What type of patent?
- Decision 4: What type of application?



Decision 1: Can I patent my invention?

A patent may be granted for a device or machine, a substance, a process or computer hardware and software, and even some business methods—in short, almost anything commercially useful. For a patent to be granted an invention must:

- be a manner of manufacture. A patent may be granted only for a tangible invention. No matter how ingenious or unusual they may be, you cannot patent artistic creations, mathematical models, theories, ideas or purely mental processes
- be **new** (the legal term is “novel”), which means that the invention has not been publicly disclosed in any form, anywhere in the world. Examples of disclosures that could show your invention is not new include published patent specifications (both Australian and foreign), textbooks and technical journals, internet sites, or the sale or use in a public area (including demonstrations) of a product in Australia
- involve an **inventive step** for a *standard* patent. The invention must not be obvious to someone with knowledge and experience in the technological field of the invention
- involve an **innovative step** for an *innovation* patent. There must be a difference between the invention and what is known about that technology, and this difference must make a substantial contribution to the working of the invention
- be **useful**, your invention should do what you say it will do
- not have been secretly used by you or with your consent.

Valid patents must also meet other requirements of the *Patents Act*, in particular:

- a sufficiently clear and complete description. It is extremely important that you put into the description (including any drawings) all the necessary information about the technical details of your invention
- claims and the description in respect of the same invention. Are the claims **fairly based**? For example, if your application described a solar cell, claims that make no mention of how light is converted to energy may not be fairly based
- claims must define only **one invention**.

If you want to protect the way your invention works then patenting may be the most appropriate option, but if the appearance of your product is important and innovative (rather than how it works), then a registered design may be more appropriate. For more information on registered designs visit www.ipaustralia.gov.au.

Decision 2: Should I patent my invention?

It's futile patenting an invention unless you have a plan for commercialisation and can defend it against infringement. A patent should be considered simply as a "barbed wire fence" around your property. It's not bullet proof and requires maintenance, but it does send a strong signal to potential trespassers.

You should strongly consider patenting if:

- the possibility of commercial returns outweighs the time, effort and money required to acquire and maintain a patent
- the limited monopoly a patent offers would help mitigate the risks of IP theft in the markets you are interested in
- you have the resources to manage your intellectual property
- a thorough search reveals no other similar technology
- you own the invention and have kept it a secret.

Lodging your application via a patent attorney can greatly reduce the risk of serious mistakes and improve the commercial value of your patent.

There are several reasons why you may not want to file a patent. Being first to market may be worth more to you than a patent. Lodging a patent tells the whole world what you're working on. Some inventors of products with short life-cycles often seek to establish a market leader position before competitors can react. In these cases a trade mark may be a valuable asset as it protects the name of the product and the values consumers relate to that name.

For inventions with a limited market value, the cost of getting and maintaining a patent may not be justified. Your invention may have a limited market or may only be useful in countries where it's difficult to secure patent protection.

Even if your invention is patentable, keeping a trade secret via confidentiality agreements can sometimes be a better strategy. The main benefit of trade secrecy is that it can exist for as long as the information remains confidential, whereas patents and designs have a limited monopoly term. This type of strategy is only worthwhile if the product is difficult to reverse engineer (which means that it is difficult to ascertain exactly how it is manufactured).

If your invention is new, not publicly disclosed and has commercial potential, then you are ready to consider what type of patent will suit your needs.

Decision 3: What type of patent?

There are two types of patents in Australia:

- A **standard** patent gives long-term protection and control over an invention. It lasts for up to 20 years (or 25 years for pharmaceutical substances).
- An **innovation** patent is a relatively quick and inexpensive way to protect an incremental advance on existing technology rather than a ground-breaking invention. Protection lasts for a maximum of eight years.

The following table provides a quick overview of the major differences between a standard patent and an innovation patent.

	Innovation Patent	Standard Patent
Your invention must:	Be new, useful and involve an innovative step	Be new, useful and involve an inventive step
The application should include:	A title, description, up to five claims, drawings (if applicable), an abstract and forms	A title, description, no limit to the number of claims, drawings (if applicable), an abstract, and forms
A patent is granted if:	The application satisfies formalities requirements (note a 'granted' innovation patent can not be enforced)	The application is examined and found to satisfy substantive requirements
Examination:	Optional. Examination can be requested by you or a competitor to clarify your legal rights	Mandatory as substantive requirements must be met before a patent is granted
Certification:	Must comply with substantive requirements as determined by an examiner. Only after certification can it be enforced.	N/A
Publication in the Australian Official Journal of Patents:	At grant and again at certification	18 months from priority date and again at acceptance
Protection period:	Eight years, if annual fees paid	20 years, if annual fees paid (or 25 years for pharmaceuticals)
How long does the process take?	One month for grant	Six months to several years depending on circumstances
How much does it cost? Note: Fees are subject to change	Approximately \$1500 including maintenance fees over 8 years (not including advisor fees)	Approximately \$9000 including maintenance fees over 20 years (not including advisor fees)

INNOVATION PATENT VS. STANDARD PATENT

There is no simple rule for determining whether your invention is more likely to be suited for standard patent or innovation patent protection. This depends entirely on the nature of the advance made by your invention and what is already known in the same field of technology. For example, the invention of a new substance that re-grows hair may be appropriate for a standard patent, whereas a treadmill adjusted to be an automated dog walker may be more suitable for an innovation patent. The following are the three main differences explained.

1. THE INNOVATION PATENT HAS A LOWER INVENTIVE THRESHOLD

The innovation patent option aims to provide business with a relatively inexpensive form of IP protection, which is quick and easy to obtain, for inventions having a short commercial life (e.g. simple tools, utensils, machinery or equipment).

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

2. THE STANDARD PATENT PROVIDES LONGER PROTECTION

For inventions, in areas such as pharmaceuticals, that have a longer development and commercialisation cycle, or inventions involving more complex technological advances, a standard patent may be more suitable.

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

3. EXAMINATION IS MANDATORY FOR STANDARD PATENTS

Both innovation and standard patents must be examined before you can enforce your rights. However, by default, innovation patents are not examined unless specifically requested. This saves you time and money by delaying examination until you really need it. Standard patents must be examined. At the time of examination you will be sent a notice to pay the examination fee. If you don't pay the fee your application will lapse.

Once you have identified the best patent type, you need to determine the right type of three application options.



Decision 4: What type of application?

There are three types of patent applications: provisional applications, complete applications and international applications.

PROVISIONAL APPLICATIONS

This is the easiest way to get the earliest possible **priority date**, however, it does not give you patent protection on its own. If you decide to pursue patent protection then you need to file a complete application within 12 months of your priority date.

Provisional applications are only optional, but useful if you operate in a highly competitive industry where constant innovation demands the earliest possible priority date. You may also appreciate some time to determine if your invention is worthy of further time, money and effort.

If you don't file a complete application before the 12 months is up then you lose your priority date.

COMPLETE APPLICATIONS

Applications for standard or innovation patents are called **complete applications**. A complete application is necessary to actually have a patent granted. Complete applications should be considered "the real thing", whereas a provisional gets you priority date and signals your intention to lodge a complete application in the near future.

IP Australia publishes details of your patent application in the Australian Official Journal of Patents (AOJP), which is made available to the public through our website.

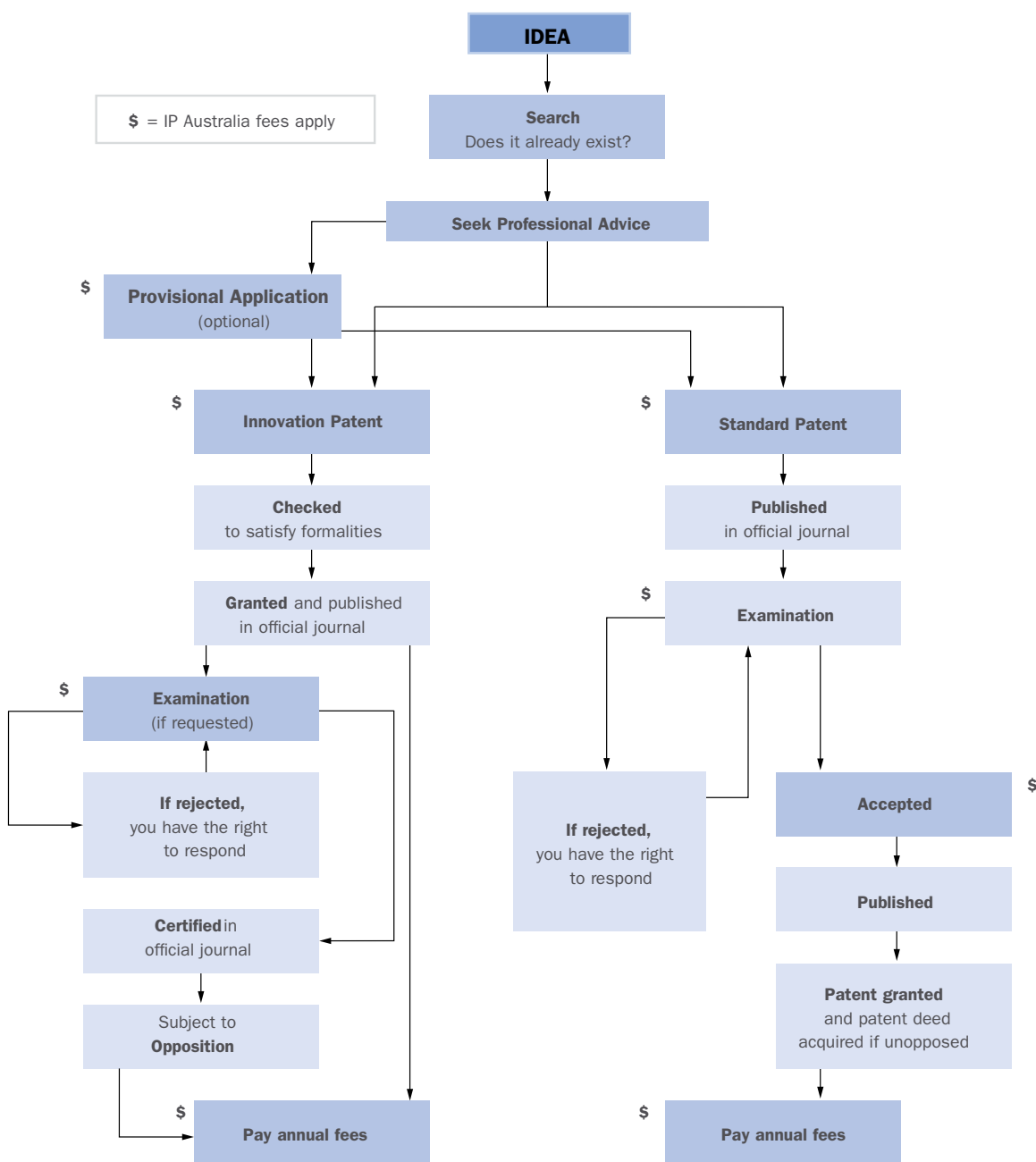
Publication is an important step for two reasons. First, the contents of your standard patent application or innovation patent are no longer confidential which means that your invention becomes part of the knowledge of the general public and may therefore subsequently assist in advancing industry and technology. For example your invention may inspire others or be used to help solve other problems.

The second reason concerns possible action you can take if someone else infringes your patent. Once you have a granted standard patent or a certified innovation patent you may wish to take legal action for any infringements that occurred from the date we published your application.

INTERNATIONAL APPLICATIONS

An international application is a useful way to apply for patents in a number of different countries simultaneously and protect your potentially important export markets. These applications are also known as PCT (Patent Co-operation Treaty) applications. For more information on international applications see page 21.

THE PROCESS OF PATENTING



Other things you need to know

HOW TO FILE A PROVISIONAL APPLICATION

There are several ways you can file, you can

- use the services of a patent attorney
- apply online through our website, www.ipaustralia.gov.au
- lodge in person at certain CBD post offices or at IP Australia, 47 Bowes St Phillip ACT
- mail your application to The Commissioner of Patents, IP Australia, PO Box 200, Woden ACT 2606
- fax your application to our secure Business Transactions Fax (02) 6283 7999.

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

WHAT DOCUMENTS DO I NEED TO FILE?

Your provisional application should include:

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

PREPARING YOUR PROVISIONAL APPLICATION

Patent request form

The patent request form can be downloaded from our website www.ipaustralia.gov.au. An electronic version is used if you apply online. Please read the online instructions carefully before filling in the patent request form, and **keep a copy of the completed form for your own records**.

Provisional specification

The purpose of a provisional specification is to describe your invention. It should include as much detail as possible, especially if you intend to use it to establish a priority date. **Keep a copy of the provisional specification for your records**. The specification should include a Title and Description.

An example provisional specification is shown on page 12.

TITLE

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

DESCRIPTION

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

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

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

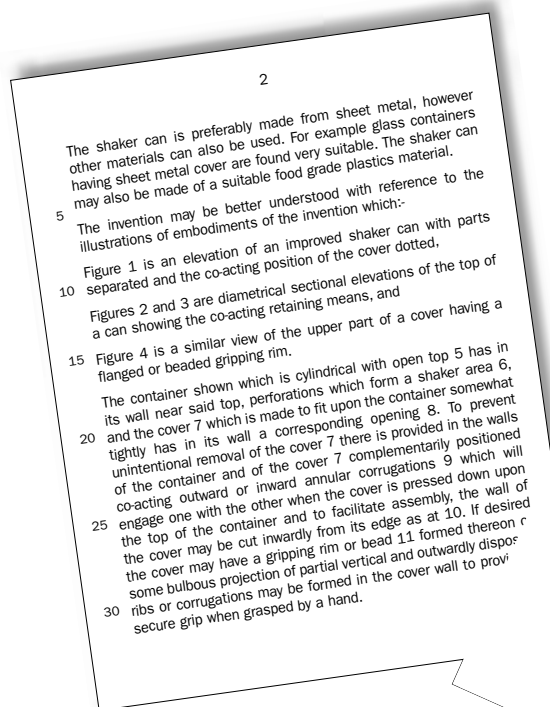
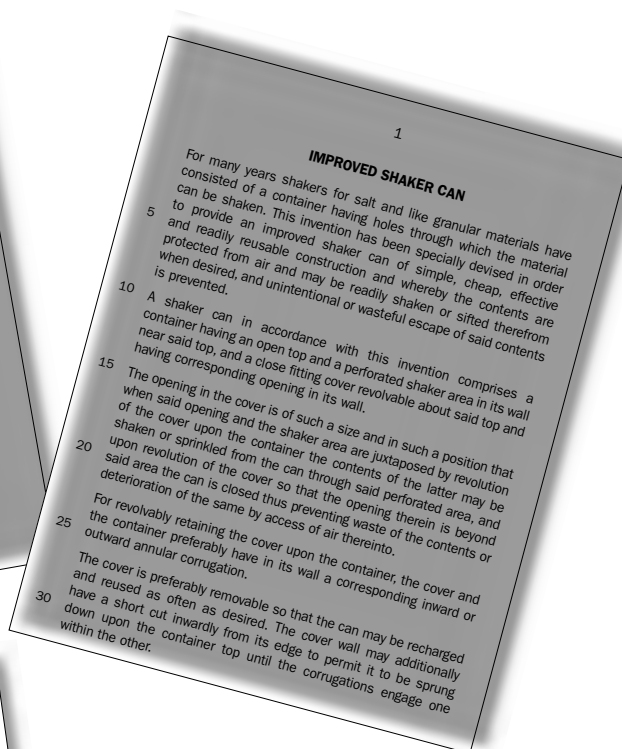
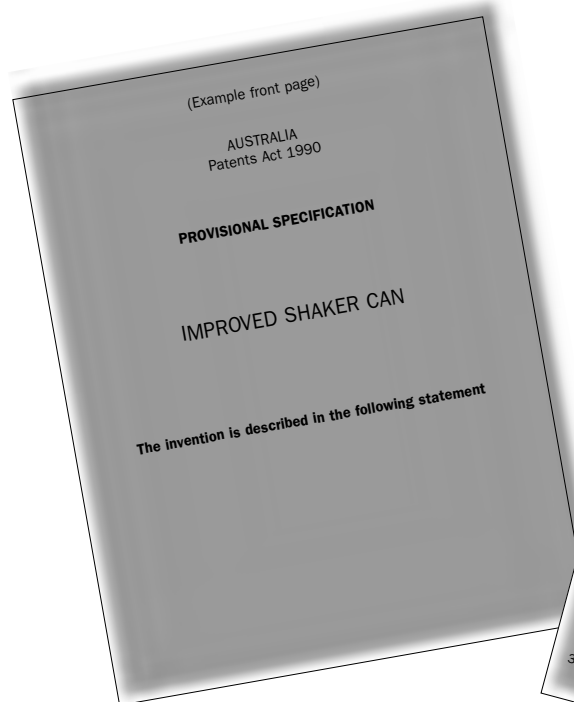
The example specification describes in detail an improved shaker can with reference to Figures 1– 4. The figures are listed and a few words are given against each figure in the list to explain what it illustrates. The features of the “shaker can” illustrated in the figures have been given their own reference numeral which is used when referring to those features in the description. Only one example of a “shaker can” according to the invention is described, but where an invention can take different forms it may be desirable to describe several examples of the invention.

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

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

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

EXAMPLE: PROVISIONAL SPECIFICATION



HOW TO FILE A COMPLETE APPLICATION

Remember “complete” simply refers to a **standard** or **innovation** patent application that’s ready to go. When filing you can:

- use the services of a patent attorney
- apply online through our website, www.ipaustralia.gov.au
- lodge in person at certain CBD post offices or at IP Australia, 47 Bowes St Phillip ACT
- mail your application to The Commissioner of Patents, IP Australia, PO Box 200, Woden ACT 2606
- fax your application to (02) 6283 7999.

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

WHAT DOCUMENTS DO I NEED TO FILE?

Applications for standard patents or innovation patents (i.e. complete applications) should include:

- either a Patent Request: Standard Patent form or a Patent Request: Innovation Patent form
- a complete specification including an abstract
- the filing fee.

PREPARING YOUR COMPLETE APPLICATION

Patent Request form—standard or innovation patent

A blank copy of the patent request form for standard patents together with instructions for filling it in can be downloaded from our website. Please read the instructions carefully before filling in the patent request form, and **keep a copy for your own records**.

The patent request form for an innovation patent is made up of three parts and must include all applicants and the nature of the invention. All completed parts must be signed by the same person and filed at the same time.

WHAT IS A COMPLETE SPECIFICATION?

A complete specification is made up of Title, Description, Claims, an Abstract and Drawings (optional). The specification should be drafted carefully since this is the document on which a patent, if granted, is based.

TITLE

The title should appear on the first page as shown in the example on page 16. If the patent is based on a provisional application then you should use the same title.

DESCRIPTION

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

CLAIMS

Claims are an important concept and function like mining rights. In the early days of a gold rush, miners staked claims in the ground where they wanted exclusive rights to dig for gold. Patent “claims” work in a similar way, except they’re based on exclusive rights to an invention rather than a piece of land.

If you try to claim too much, it may be difficult to obtain or at least defend those rights. However, if you claim too little you may miss out on valuable opportunities. Poorly worded claims can be confusing and completely miss the true “inventive step” in your technology. Patent Attorneys are experts at writing claims, which is why you are strongly advised to use their services.

Claims are important because they determine the scope of the monopoly given by a patent. The claims must:

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

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

A standard patent can have any number of claims (note: additional fees apply at the time of acceptance if the number of claims exceeds 20). An innovation patent can have up to five claims.

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

Page 3 of the example of a complete specification gives examples of *well written* claims. It defines only those features that are essential to the operation of the shaker can.

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

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

Claims 2 to 4 of the example specification make explicit reference to one or more previous claims by using such phrases as “The shaker can as claimed in claim 1”. The purpose of this approach is to define features that you consider to be desirable or optional—such as the use of sheet metal in Claim 3 of the example specification—but not essential to your invention.

Claim 5 of the example defines the most preferred form of the invention with reference to the description and/or drawings.

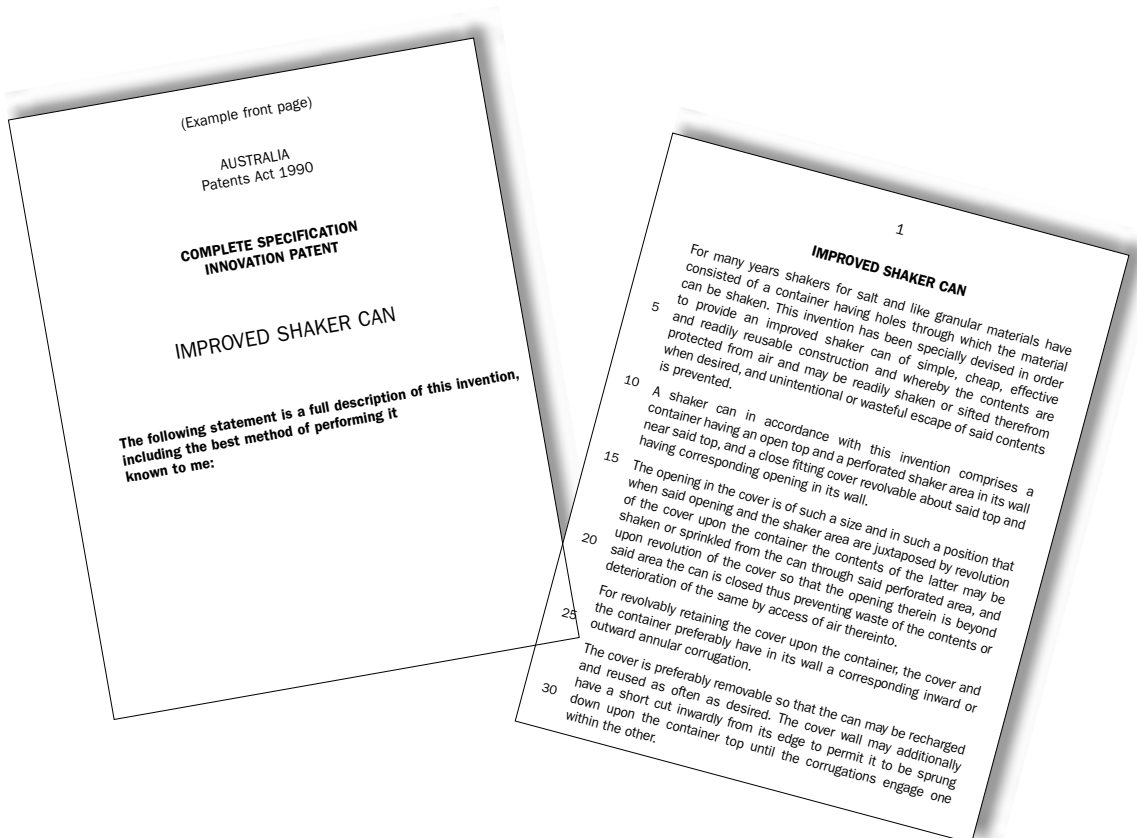
ABSTRACT

Patent applications can be lengthy and technical documents. You should include an abstract at the back of your specification to act as an executive summary. This will help the reader quickly identify the key features of your invention. The example on page 17 includes an abstract for the “shaker can”. Note: drawings are optional but recommended if they help explain your invention.

IF YOU LEAVE THINGS OUT

It’s important to include all the necessary information about your invention before you file a complete application. If you leave something out you may be able to add it later to the specification, but you will usually not be able to claim it. However, in some circumstances you may be able to get patent protection by filing another type of patent application. This is discussed in our fact sheets *Patents of Addition* and *Divisional Applications*.

EXAMPLE: COMPLETE SPECIFICATION



EXAMPLE: COMPLETE SPECIFICATION

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

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

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

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

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

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

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The claims defining the invention are as follows:

1. A shaker can comprising a container having an open top and a-perforated shaker area in its wall near said top and a close-fitting cover revolvable about said top and having a corresponding opening in its wall.

2. A shaker can as claimed in claim 1, wherein the container has an annular outward or inward corrugation in its wall, and the cover has a corresponding complementary outward or inward annular corrugation in its wall which allows for retaining the cover tightly and revolvably on the container.

3. A shaker can according to any claims 1 and 2 wherein the container and cover are made from sheet metal.

4. A shaker can according to any of the claims 1-3 wherein the cover has a gripping rim or bead formed thereon.

5. A shaker can substantially as herein before described with reference to figures 1-4 of the accompanying drawings.

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

1 JUNE 2001
(Date)

ABSTRACT

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

PROCESSING YOUR INNOVATION PATENT APPLICATION

After you have filed a complete application for an innovation patent, IP Australia will conduct a simple formalities check to make sure that your application is in order. Generally, within one month you will receive notification from IP Australia formally granting you an innovation patent (provided you have paid the filing fee).

Please note that the innovation patent is granted without substantive examination. IP Australia has not assessed whether the patent is valid which may make it more difficult to sell or license.

If you wish to legally enforce your rights, you must request your innovation patent be examined.

If your innovation patent is infringed, you can take legal action against the infringing party **only** if your innovation patent is examined and **certified**.

EXAMINATION AND CERTIFICATION OF INNOVATION PATENTS

To request an examination, you must complete a *Request for Examination* form, and pay the required fee.

Your competitors can also request examination of your innovation patent. This commonly occurs when they own a patent that might be infringed by your invention. In these instances, the other interested party pays half of the examination fee, and you pay the other half (if your patent is certified you stand to benefit from this action). If you do not pay the balance, the patent will cease. The third party is not given a copy of any notice or examination report sent to you.

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

- A notice that your patent has been successfully certified, in which case your rights are then legally enforceable.
- An adverse report explaining why your innovation patent, in its present form, does not meet the requirements of the *Patents Act*.

The next step depends on the problems identified in the report. Sometimes inventions aren't properly described, **or are indistinguishable from existing technology**. Often you can resolve these by changing your description or claims. This procedure may be repeated several times, **however, if the problems aren't resolved, your innovation patent will cease**.

Once certified, your competitors may start opposition proceedings to show that your innovation patent is invalid — see *Acceptance, Opposition and Grant* on page 20. **If opposition proceedings are successful, your innovation patent will cease.**

PROCESSING YOUR STANDARD PATENT APPLICATION

Requesting examination of standard patent applications

When your application has reached the front of the queue at IP Australia, you will receive a “Request for Examination” form. You have up to six months to submit this form if you need more time to assess the value of continuing the patenting process. If you don’t request examination, your application will lapse.

For IP Australia to commence examination, you must complete a *Request for Examination* form, and pay the required fee.

Standard patent applications generally take more time to process than innovation patents. You can request early examination (known as expediting) of your complete application for a standard patent, but you should be careful about initiating this action.

Early examination and grant of a patent can have unexpected results. For example, your application may be published too early for you to have time to file an application for protection overseas.

Remember that when granted, your patent rights can be retrospectively enforced from the publication date of your complete application, so there is usually no benefit in finalising your patent quickly unless you need to take immediate legal action against an infringer or require a granted patent for licensing or financing negotiations.

EXAMINATION OF STANDARD PATENT APPLICATIONS

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

The test for an inventive step requires a comparison of your invention as defined in the claims with the same information used to determine novelty in relation to innovation patents. In addition, your invention will also be referenced against background knowledge in the technical field of your invention which is sourced from common work practices as well as standard texts and handbooks, technical dictionaries and other material widely consulted in the field.

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

After examination you will be sent either an adverse report or a notice that your standard patent application has been accepted. If adverse, you will be given the opportunity to make changes to your specification to correct the problems identified. **However, if the problems cannot be overcome your complete application will lapse.**

ACCEPTANCE, OPPOSITION AND GRANT

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

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

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

EXTENSIONS OF TIME

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

Before being given an extension of time you must explain in a statutory declaration the chain of events that caused the unintentional mistake, and pay any unpaid fees. For further information please see our fact sheet, *Applying for an Extension of Time*.

WHAT HAPPENS AFTER MY PATENT IS GRANTED?

You need to pay annual maintenance fees if you want to keep your patent in force. We do not send out reminders for maintenance fee payments.

It is also your responsibility to take legal action to enforce your rights in Australia. You should seek legal advice if you wish to challenge another person's patent or if your patent is being infringed.

Patenting overseas

No matter where you want to patent your invention, it is often a good idea to start with a provisional application. After that you have a number of choices.

Remember, if you want to claim priority from an earlier provisional application, you must file any subsequent application within 12 months.

There are two ways to obtain patents in other countries.

An Australian patent provides protection only in Australia. There is no such thing as a “world patent”. To obtain similar protection in other countries you generally have two choices:

- **Patent Cooperation Treaty Application (PCT)** – File a single international application under the PCT with a Receiving Office (RO) which gives you the choice of over 100 countries in which to seek patent protection. IP Australia is the RO for international applications made by Australian nationals or residents.
- **Convention applications** – If you want to patent your invention in only a few countries it may be cost effective to file separate convention patent applications in each country.

Whichever option you choose, you will still end up with separate patent applications in each country. The PCT is simply a streamlined way of applying in a number of countries (including Australia) at the same time since it enables you to file a single international application that has the same effect as a separate filing in each of those countries.

If you want more information about applying for an international application, you should obtain a copy of our publication *The International Patent Application Guide*.

SHOULD YOU USE A PATENT ATTORNEY?

Patent attorneys can advise you of the patent requirements in other countries and can also arrange representation in each country as required. There can be differences between countries in terms of the patent granted, its legal effect, cost and application procedures.

In countries which do not use English as an official language, all documents must be translated into the language required by the patent office concerned. This may add considerably to the costs involved.



HOW WE CAN ASSIST YOU TO MAKE A CHOICE

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

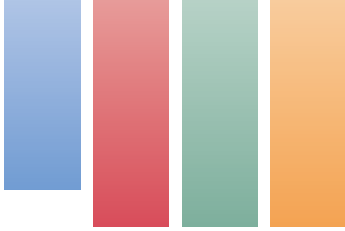
CHOOSE CAREFULLY

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

Costs

To view the current patent application fees visit www.ipaustralia.gov.au or contact IP Australia's Customers Contact Centre on 1300 651 010.

**Please note. Fees may vary depending on how applications are filed.*



Where to find more information

IP Australia staff are happy to help you, however, we cannot assist clients on legal matters or provide business advice. Our Customer Service Charter outlines the standards of service you can expect. To obtain a copy of the charter, simply ring **1300 651 010** or visit our website www.ipaustralia.gov.au.

CONTACTING IP AUSTRALIA

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

Postal address: **PO Box 200, WODEN ACT 2606**

Phone: **1300 651 010**

Fax: **(02) 6283 7999**

Email: **assist@ipaustralia.gov.au**—for general enquiries only.

Website: **www.ipaustralia.gov.au**

Communications sent to other contact points electronically will not gain the benefits provided by the Electronic Transactions Act such as security and certainty of receipt. Further details on IP Australia's electronic communication business rules can be found at www.ipaustralia.gov.au

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

PROFESSIONAL IP ADVICE

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