

PROCEDURES FOR OBTAINING PATENT PROTECTION IN AUSTRALIA

What is a Patentable Invention?

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

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

When is a patentable Invention patentable?

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

Types of Patents

- Standard Patent - provides protection for 20 years from the filing date of the patent application.

Procedure for Seeking Patent Protection

- Standard Patent (20-Year Protection)

Applying for Patent Protection

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

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

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

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

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

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

Publication of the Application

After lodgement of the complete application, the application will be published within 18 months from the priority date. After publication of the application, the complete application and the provisional application (if lodged) will become open to public inspection at the Patent Office and any member of the public may obtain a copy of the application including a copy of the specification describing the invention.

Examination of the Application

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

The most common grounds for objecting the application are:

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

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

Acceptance and Grant

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

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

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

Infringement

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

Renewals

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

Costs

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

About Wrays

Working with start-ups to multinationals since 1920, we are one of Australia & New Zealand's largest independent IP specialist firms.

Intellectual property lawyers, attorneys and advisors all under one roof, ready to protect, grow and defend your valuable assets, locally and globally.