

SUMMARY OF CHANGES TO AUSTRALIAN INTELLECTUAL PROPERTY

Important changes to the Australian intellectual property system came into effect on 15 April 2013.

The Intellectual Property Amendment (Raising the Bar) Act 2012 seeks to raise the quality of granted patents by changing the tests for patentability. The changes also seek to improve the efficiency of examination and opposition procedures for patents and trade marks.

The changes to patentability standards apply to all Australian patent applications filed on or after 15 April 2013 and pending patent applications on which examination had not been requested before 15 April 2013. The changes to trade mark registrability apply to trade mark applications filed on or after 15 April 2013. Changes to opposition proceedings for patents and trade marks apply from 15 April 2013.

Patentability

The Raising the Bar Act makes a number of significant changes to the tests for patentability, including:

- Raising the inventive step threshold - Common general knowledge (CGK) has been expanded to include information from anywhere in the world. Further, any information publicly available prior to the priority date may be combined with the CGK when assessing inventive step. In contrast, the previous standard restricted information to that which a skilled person could be reasonably expected to have ascertained, understood, and regarded as relevant.
- Usefulness - The specification must disclose a "specific, substantial and credible use".
- Enablement - The specification must disclose the invention in a manner that is "clear enough and complete enough" for the invention to be performed by a skilled person.
- Fair Basis (Support) - The claims must be "supported by matter disclosed in the specification", in contrast to the present "fairly based" requirement. The new requirement is applicable for establishing priority, making amendments, and internal support for the claims.

Patent Examination

- Period for requesting examination following a Direction to Request Examination has been shortened from 6 months to 2 months.
- Examination period from first examination report date for placing an application in order for acceptance has been shortened from 21 months to 12 months, minimising the ability to await prosecution outcomes in foreign jurisdictions.
- Amendments that extend the scope of the disclosure are not allowable, even if there is no impact on the claims. It was previously possible to amend the specification, provided that the amendment did not result in any new subject matter being claimed.
- Divisional applications must be filed before the expiry of 3 months after the date of advertisement of acceptance of the parent application. It is no longer possible to file divisional applications beyond that 3 month period, such as during an opposition.
- Conversion of a Standard Patent Application into a Standard Divisional Application is restricted to a period ending 3 months from the date of advertisement of acceptance of the parent application and no later than acceptance of the Divisional Application.
- A Notice of Entitlement stating the applicant's entitlement to the invention from the inventors and the right to claim priority (if relevant) must be provided at the time of filing a Request for Examination.
- Modified examination and deferment of examination are no longer available.

Granting of Patents

- Patent applications will no longer be "sealed". Rather, a Certificate of Grant will issue in relation to both standard and innovation patents.

Service of Documents

- It is no longer necessary to serve documents on the other party in opposition proceedings. Documents are now to be filed at IPAustralia and IPAustralia will provide copies to the relevant parties.
- Opposition evidence is to be submitted electronically, in an approved form.

Trade Mark Examination

- Section 41 has been amended to clarify the presumption of registrability. To raise a ground for rejection under Section 41 during examination, a Trade Mark Examiner must be satisfied on the balance of probabilities that the ground for rejection exists.

Trade Mark Oppositions

- The opposition period is now 2 months (reduced from 3 months), in relation to trade marks advertised as accepted on or after 15 April 2013.
- The Notice of Opposition has 2 components:
 - (i) a Notice of Intention to Oppose; and
 - (ii) a Statement of Grounds and Particulars.
- A Notice of Opposition is taken to have been filed when both the Notice of Intention to Oppose and the Statement of Grounds and Particulars have been filed.
- The Notice of Intention to Oppose must be filed within the 2 month opposition period.
- The Statement must be filed within 1 month of the date of filing of the Notice of Intention to Oppose. The Statement sets out the grounds of opposition and provides material facts to support those grounds.
- A Notice of Intention to Defend has been introduced. The Notice of Intention to Defend must be filed by the applicant within 1 month of being given a copy of the opponent's Statement of Grounds and Particulars.
- A cooling-off period has been introduced to facilitate negotiations during opposition proceedings. Both parties must agree to the cooling-off period. A cooling-off period can be requested after a Statement of Grounds and Particulars has been filed, but before the Registrar has made a decision on the opposition or dismissed the opposition.
- The cooling-off period is initially for six months and can be extended for a further six months. Only one cooling-off period is allowed per opposition.
- The periods for filing Evidence in Support and Evidence in Answer remain at 3 months. However, the period in which to file Evidence in Reply has been reduced to 2 months.
- The new legislation narrows the circumstances under which an extension of time for providing evidence will be granted.

