

# Patent Information Sheet

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## FILING A PATENT APPLICATION IN AUSTRALIA

This information is intended to provide a brief explanation as to obtaining an Australian Patent and is intended as general guidance only. It is not meant to be a substitute for obtaining advice and if you have a specific query, you should contact the Chrysiliou IP Patent Attorney team who will work with you to ensure your interests are fully protected.

- **Requirements of Novelty and Inventiveness**

To be patentable, an invention must be novel and inventive over the "prior art". The prior art in relation to a "standard" patent includes information made available by the doing of an act or information made available by publication in a document anywhere in the world. By lodging a patent application, a priority date is established. If samples of the invention have been sold, offered for sale or merely publicly displayed before the priority date, then the invention is no longer "novel and inventive" and a valid Australian patent cannot be obtained, except in certain circumstances relating to a "grace" period.

By "inventive" we mean that the invention differs by more than a trivial amount from the prior art. An invention is "inventive" if it is not obvious to a person skilled in the relevant field. As an example, if two components which are well known are combined into a single unit and there is no ingenuity or technical difficulty in combining them together, then while the combined unit may be novel, it will normally not be considered inventive. However, it is always advisable to seek the expert advice and guidance of the Patent Attorney team at Chrysiliou IP as to whether your invention or "idea" meets the requirements of novelty and inventiveness.

- **Provisional Patent Specification (PPS)**

Assuming an invention is novel and inventive, normally the first step in obtaining an Australian Patent is to file a Provisional Patent Specification (PPS) which clearly describes the invention. The importance of a PPS is that it establishes a priority date, after which the inventor may inform others of the subject matter of the invention, without negating the patentability of the invention. It is in this area that the services of the patent attorneys in CHRYSILIOU IP are important to ensure that the PPS is expertly drafted, so that rights are not lost and foundations are properly laid for subsequent standard patent protection in Australia and overseas.

To prepare a provisional specification, we require a brief description of how your invention works. Drawings and sketches are often essential. An explanation of how the invention differs from similar products would be helpful. We can handle this process without your visiting our offices.

Utilising our services in regard to a PPS will afford an inventor a period of 12 months, from the date of filing, within which patent applications can be lodged internationally with the benefit of the PPS date of filing. CHRYSILIOU IP has implemented systems to assist its Clients in the marketing of or in the search for licensees of the invention, during the 12 month grace period for pursuing international protection. Utilising the PPS

## Patent Information Sheet

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process and our services in this manner will allow inventors an opportunity to disclose and market the invention on an international basis in the best economic manner, without the fear of losing their rights as they existed at the date of filing of the PPS.

- **Searches**

### **Novelty**

It is possible to conduct searches of existing patent documents to provide an indication of the novelty and inventiveness of an invention. However, it should be noted that any printed publication, published at any time before the lodgement of the first application, may be validly raised against a patent application. Obviously, no search can cover all publications.

CHRYSILIOU IP can have “novelty type” searches conducted that cover published patent specifications from most of the industrialised countries. This "novelty type" search will often give a good indication of novelty and inventiveness of your invention.

### **Infringement**

As a separate matter from seeking protection for your invention, it is important to ensure that you do not infringe another person's current patent by commercialising your product. Even if your invention is novel and inventive it may still infringe an earlier patent. If you intend placing the invention on the market, it is advisable to utilise the services of CHRYSILIOU IP in having infringement searches carried out in each country where manufacture, sale or use will occur.

An infringement search will also provide an indication of novelty and inventiveness, but since it is only necessary to view current, in force, patents, it does not provide as good an indication as a novelty type search.

### **Patent Office Searches**

As a service separate from processing of a patent application, the Australian Patent Office will, for a fee offer the service of, conducting an international type search in relation to an application. It is advisable to make a request for an international type search within three months of filing a provisional application. An international type search only covers patent documents from a selected group of countries. Furthermore, there is no such thing as an exhaustive search and hence there is always the risk that the Patent Office may omit relevant prior art and accepts no responsibility for doing so.

- **Complete Specification**

If you have filed a provisional patent specification, you must file a Standard or Innovation Patent Application with a complete specification (as a continuation) within 12 months of the provisional specification filing date if you wish to obtain the benefit of the provisional filing date. Foreign applications must also be lodged within this time frame. If you have published your invention, this 12 month deadline may represent an absolute deadline. The Standard Patent Application is the application which leads to the actual examination and subsequent grant of the patent right. It contains patent claims, which define the scope of monopoly and, as such, the drafting skills of the patent

## Patent Information Sheet

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attorneys in CHRYSILIOU IP are of prime importance in achieving optimum protection for the invention and also in protecting against future challenges to the validity of the patent.

- **Best Method**

It is a requirement of the Australian Patents Act that the complete specification must include "the best method known to the applicant of performing the invention". Failure to describe the "best method" is a ground of invalidity of a patent. Thus, if you have made modifications or improvements to your invention since filing the provisional specification, no matter how minor, you should supply all relevant information to the CHRYSILIOU IP before disclosing the modifications/improvements so that our Attorneys are well briefed to obtain the best protection for your invention.

- **Drawings**

When filing the complete specification it is necessary to file "formal drawings". Whilst sketches are acceptable for a provisional specification, they are not acceptable when filing the complete specification. Formal drawings must be clean, legible, executed in bold lines, (preferably on a white background without any colouring or shading) suitable for reproduction and within specified margins. CHRYSILIOU IP can engage the services of an experienced patent draftsman to prepare formal drawings if required.

- **Examination**

Once the complete specification is filed, it is necessary to request examination and pay a fee before the application will be formally examined by the Patent Office. Normally, the Patent Office issues a direction to the applicant to request examination some time after filing the complete specification. The direction provides six months to request examination, otherwise the application will lapse. It is possible to voluntarily request examination at any time prior to issue of a direction.

Once examination is requested, an Examiner's report, in which objections as to novelty and clarity may be raised, usually issues 6 to 9 months later. A period of 21 months is provided in which to place the application in order for acceptance, otherwise the application will lapse.

- **Acceptance and Sealing**

Once the application is accepted, it is advertised as accepted in an Official Journal and third parties are given 3 months to oppose the grant of the patent. If no opposition is lodged, the patent is sealed after payment of the acceptance fee.

- **Innovation Patent (INP)**

INP is a more easily obtained patent for inventions which may not meet the requirements of the standard patent process. Inventions which are novel and involve an innovative step (as compared to the inventive step requirement of the standard patent process) will qualify for an INP. An INP is granted after a formalities check but, if it

## Patent Information Sheet

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needs to be enforced, then it needs to undergo an examination process to be certified as meeting the requirements of the Patents Act. It is advisable to seek the advices and guidance of the CHRYSILIOU IP before making any decisions as to the nature of the patent protection most suited to your invention, especially as rights could be lost or seriously undermined by making the wrong decision.

- **Foreign Patent Applications**

CHRYSILIOU IP has an extensive network of foreign associate attorney firms with which it works to ensure that clients' interests are properly protected in each jurisdiction covered under the CHRYSILIOU IP foreign protection programme.

Australia and most countries of the world are parties to a Convention which allows an applicant to file foreign applications up to 12 months after the first Australian application and claim the Australian filing date as the "priority date". This date is either the date of filing of the provisional patent application or, if a provisional patent application has not been filed, the date of filing of the standard patent application. The priority date is the date at which the invention is tested for novelty and inventiveness. Applications may be filed outside the 12 month period but then cannot claim benefit from the Australian application and the actual filing date is the priority date. If the invention has been disclosed by use or publication in a document before foreign applications are made, the 12 month period represents an absolute deadline for most countries.

Protection may be extended into foreign countries by filing applications with national patent offices, and/or via a PCT international application (discussed in more detail later).

Once a foreign application is filed, there will be additional costs involved in obtaining the patent, such as examination fees, dealing with Examiner's reports and payment of issue fees. These additional costs may equal the initial application costs but can be less or more. Many countries also set short periods for responding to Examiner's reports, so it is necessary to promptly deal with such reports.

- **PCT Applications**

It is recommendable to file a Patent Cooperation Treaty (PCT) International Patent Application if you have a product which is marketable in many countries. A PCT application is, in effect, an option to proceed with national applications at a later date. If the PCT application is filed within 12 months of the first Australian application, any applications derived from the PCT application may claim priority from the first Australian application.

Not all countries are members of the PCT and a list of member countries follows for your reference. New member countries are added from time to time.

A PCT application is subject to a search and an optional examination.

Within about 3 months of filing the PCT application, the Australian Patent Office will

## Patent Information Sheet

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conduct a search of patent specifications from a selected group of countries and issue an International Search Report. This will give an *indication* of the novelty and inventiveness of the invention. However, it has been known for relevant prior art not to be raised and the Patent Office takes no responsibility for inadequacies in the search report. However, if relevant prior art is found and it is decided not to proceed, the major cost of converting to a series of national applications is avoided.

The time limit for proceeding from a single PCT application to a series of national applications is 30 months from the earliest priority date claimed (normally the filing date of the Australian provisional specification) for most countries, although a few require a demand for examination (see below). The cost of proceeding to a series of national applications is substantially the same as in the case of normal national applications, discussed earlier, but the deadline and cost is thus delayed by 18 months for most countries.

If a demand for International Preliminary Examination is lodged, the PCT application is examined and any objections are raised in a written opinion. The PCT application may be amended to overcome the objections and so avoid similar objections being raised against the national applications, saving costs. This is one area where the expertise of the CHRYSILIOU IP foreign protection programme can benefit clients.

- **European Patent Applications**

It is possible to apply for a European Patent, either directly, or via the PCT route. A European Patent application may designate any or all of its member countries as set out on the PCT list of member countries.

The European application is processed as a single application, but when granted it is necessary to validate it in each designated country in which patent rights are to continue. This involves payment of a (substantial) fee to the national patent office and filing of a translation, if appropriate (also at substantial cost). However, these costs are incurred at the end of the application procedure, rather than at the beginning if national applications are filed.

- **Term**

A patent can last for 20 years for most countries, if periodic renewal fees are paid.

# Patent Information Sheet

## PATENT CO-OPERATION TREATY (PCT)

Member Countries as at 1 JANUARY 2010 as specified by WIPO

| CONTRACTING PARTY                     | TREATY                    | STATUS    | ENTRY INTO FORCE  |
|---------------------------------------|---------------------------|-----------|-------------------|
| Albania                               | Patent Cooperation Treaty | In Force  | October 4, 1995   |
| Algeria                               | Patent Cooperation Treaty | In Force  | March 8, 2000     |
| Angola                                | Patent Cooperation Treaty | In Force  | December 27, 2007 |
| Antigua and Barbuda                   | Patent Cooperation Treaty | In Force  | March 17, 2000    |
| Argentina                             | Patent Cooperation Treaty | Signature |                   |
| Armenia                               | Patent Cooperation Treaty | In Force  | December 25, 1991 |
| Australia                             | Patent Cooperation Treaty | In Force  | March 31, 1980    |
| Austria                               | Patent Cooperation Treaty | In Force  | April 23, 1979    |
| Azerbaijan                            | Patent Cooperation Treaty | In Force  | December 25, 1995 |
| Bahrain                               | Patent Cooperation Treaty | In Force  | March 18, 2007    |
| Barbados                              | Patent Cooperation Treaty | In Force  | March 12, 1985    |
| Belarus                               | Patent Cooperation Treaty | In Force  | December 25, 1991 |
| Belgium                               | Patent Cooperation Treaty | In Force  | December 14, 1981 |
| Belize                                | Patent Cooperation Treaty | In Force  | June 17, 2000     |
| Benin                                 | Patent Cooperation Treaty | In Force  | February 26, 1987 |
| Bosnia and Herzegovina                | Patent Cooperation Treaty | In Force  | September 7, 1996 |
| Botswana                              | Patent Cooperation Treaty | In Force  | October 30, 2003  |
| Brazil                                | Patent Cooperation Treaty | In Force  | April 9, 1978     |
| Bulgaria                              | Patent Cooperation Treaty | In Force  | May 21, 1984      |
| Burkina Faso                          | Patent Cooperation Treaty | In Force  | March 21, 1989    |
| Cameroon                              | Patent Cooperation Treaty | In Force  | January 24, 1978  |
| Canada                                | Patent Cooperation Treaty | In Force  | January 2, 1990   |
| Central African Republic              | Patent Cooperation Treaty | In Force  | January 24, 1978  |
| Chad                                  | Patent Cooperation Treaty | In Force  | January 24, 1978  |
| Chile                                 | Patent Cooperation Treaty | In Force  | June 2, 2009      |
| China                                 | Patent Cooperation Treaty | In Force  | January 1, 1994   |
| Colombia                              | Patent Cooperation Treaty | In Force  | February 28, 2001 |
| Comoros                               | Patent Cooperation Treaty | In Force  | April 3, 2005     |
| Congo                                 | Patent Cooperation Treaty | In Force  | January 24, 1978  |
| Costa Rica                            | Patent Cooperation Treaty | In Force  | August 3, 1999    |
| Côte d'Ivoire                         | Patent Cooperation Treaty | In Force  | April 30, 1991    |
| Croatia                               | Patent Cooperation Treaty | In Force  | July 1, 1998      |
| Cuba                                  | Patent Cooperation Treaty | In Force  | July 16, 1996     |
| Cyprus                                | Patent Cooperation Treaty | In Force  | April 1, 1998     |
| Czech Republic                        | Patent Cooperation Treaty | In Force  | January 1, 1993   |
| Democratic People's Republic of Korea | Patent Cooperation Treaty | In Force  | July 8, 1980      |
| Denmark                               | Patent Cooperation Treaty | In Force  | December 1, 1978  |
| Dominica                              | Patent Cooperation Treaty | In Force  | August 7, 1999    |
| Dominican Republic                    | Patent Cooperation Treaty | In Force  | May 28, 2007      |
| Ecuador                               | Patent Cooperation Treaty | In Force  | May 7, 2001       |
| Egypt                                 | Patent Cooperation Treaty | In Force  | September 6, 2003 |
| El Salvador                           | Patent Cooperation Treaty | In Force  | August 17, 2006   |
| Equatorial Guinea                     | Patent Cooperation Treaty | In Force  | July 17, 2001     |
| Estonia                               | Patent Cooperation Treaty | In Force  | August 24, 1994   |
| Finland                               | Patent Cooperation Treaty | In Force  | October 1, 1980   |
| France                                | Patent Cooperation Treaty | In Force  | February 25, 1978 |
| Gabon                                 | Patent Cooperation Treaty | In Force  | January 24, 1978  |
| Gambia                                | Patent Cooperation Treaty | In Force  | December 9, 1997  |

## Patent Information Sheet

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|----------------------------------|---------------------------|-----------|--------------------|
| Georgia                          | Patent Cooperation Treaty | In Force  | December 25, 1991  |
| Germany                          | Patent Cooperation Treaty | In Force  | January 24, 1978   |
| Ghana                            | Patent Cooperation Treaty | In Force  | February 26, 1997  |
| Greece                           | Patent Cooperation Treaty | In Force  | October 9, 1990    |
| Grenada                          | Patent Cooperation Treaty | In Force  | September 22, 1998 |
| Guatemala                        | Patent Cooperation Treaty | In Force  | October 14, 2006   |
| Guinea                           | Patent Cooperation Treaty | In Force  | May 27, 1991       |
| Guinea-Bissau                    | Patent Cooperation Treaty | In Force  | December 12, 1997  |
| Holy See                         | Patent Cooperation Treaty | Signature |                    |
| Honduras                         | Patent Cooperation Treaty | In Force  | June 20, 2006      |
| Hungary                          | Patent Cooperation Treaty | In Force  | June 27, 1980      |
| Iceland                          | Patent Cooperation Treaty | In Force  | March 23, 1995     |
| India                            | Patent Cooperation Treaty | In Force  | December 7, 1998   |
| Indonesia                        | Patent Cooperation Treaty | In Force  | September 5, 1997  |
| Iran (Islamic Republic of)       | Patent Cooperation Treaty | Signature |                    |
| Ireland                          | Patent Cooperation Treaty | In Force  | August 1, 1992     |
| Israel                           | Patent Cooperation Treaty | In Force  | June 1, 1996       |
| Italy                            | Patent Cooperation Treaty | In Force  | March 28, 1985     |
| Japan                            | Patent Cooperation Treaty | In Force  | October 1, 1978    |
| Kazakhstan                       | Patent Cooperation Treaty | In Force  | December 25, 1991  |
| Kenya                            | Patent Cooperation Treaty | In Force  | June 8, 1994       |
| Kyrgyzstan                       | Patent Cooperation Treaty | In Force  | December 25, 1991  |
| Lao People's Democratic Republic | Patent Cooperation Treaty | In Force  | June 14, 2006      |
| Latvia                           | Patent Cooperation Treaty | In Force  | September 7, 1993  |
| Lesotho                          | Patent Cooperation Treaty | In Force  | October 21, 1995   |
| Liberia                          | Patent Cooperation Treaty | In Force  | August 27, 1994    |
| Libyan Arab Jamahiriya           | Patent Cooperation Treaty | In Force  | September 15, 2005 |
| Liechtenstein                    | Patent Cooperation Treaty | In Force  | March 19, 1980     |
| Lithuania                        | Patent Cooperation Treaty | In Force  | July 5, 1994       |
| Luxembourg                       | Patent Cooperation Treaty | In Force  | April 30, 1978     |
| Madagascar                       | Patent Cooperation Treaty | In Force  | January 24, 1978   |
| Malawi                           | Patent Cooperation Treaty | In Force  | January 24, 1978   |
| Malaysia                         | Patent Cooperation Treaty | In Force  | August 16, 2006    |
| Mali                             | Patent Cooperation Treaty | In Force  | October 19, 1984   |
| Malta                            | Patent Cooperation Treaty | In Force  | March 1, 2007      |
| Mauritania                       | Patent Cooperation Treaty | In Force  | April 13, 1983     |
| Mexico                           | Patent Cooperation Treaty | In Force  | January 1, 1995    |
| Monaco                           | Patent Cooperation Treaty | In Force  | June 22, 1979      |
| Mongolia                         | Patent Cooperation Treaty | In Force  | May 27, 1991       |
| Montenegro                       | Patent Cooperation Treaty | In Force  | June 3, 2006       |
| Morocco                          | Patent Cooperation Treaty | In Force  | October 8, 1999    |
| Mozambique                       | Patent Cooperation Treaty | In Force  | May 18, 2000       |
| Namibia                          | Patent Cooperation Treaty | In Force  | January 1, 2004    |
| Netherlands                      | Patent Cooperation Treaty | In Force  | July 10, 1979      |
| New Zealand                      | Patent Cooperation Treaty | In Force  | December 1, 1992   |
| Nicaragua                        | Patent Cooperation Treaty | In Force  | March 6, 2003      |
| Niger                            | Patent Cooperation Treaty | In Force  | March 21, 1993     |
| Nigeria                          | Patent Cooperation Treaty | In Force  | May 8, 2005        |
| Norway                           | Patent Cooperation Treaty | In Force  | January 1, 1980    |
| Oman                             | Patent Cooperation Treaty | In Force  | October 26, 2001   |
| Papua New Guinea                 | Patent Cooperation Treaty | In Force  | June 14, 2003      |
| Peru                             | Patent Cooperation Treaty | In Force  | June 6, 2009       |
| Philippines                      | Patent Cooperation Treaty | In Force  | August 17, 2001    |
| Poland                           | Patent Cooperation Treaty | In Force  | December 25, 1990  |
| Portugal                         | Patent Cooperation Treaty | In Force  | November 24, 1992  |
| Republic of Korea                | Patent Cooperation Treaty | In Force  | August 10, 1984    |
| Republic of Moldova              | Patent Cooperation Treaty | In Force  | December 25, 1991  |
| Romania                          | Patent Cooperation Treaty | In Force  | July 23, 1979      |

## Patent Information Sheet

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|---|---------------------------|----------|--------------------|
| Russian Federation                        | Patent Cooperation Treaty | In Force | March 29, 1978     |
| Saint Kitts and Nevis                     | Patent Cooperation Treaty | In Force | October 27, 2005   |
| Saint Lucia                               | Patent Cooperation Treaty | In Force | August 30, 1996    |
| Saint Vincent and the Grenadines          | Patent Cooperation Treaty | In Force | August 6, 2002     |
| San Marino                                | Patent Cooperation Treaty | In Force | December 14, 2004  |
| Sao Tome and Principe                     | Patent Cooperation Treaty | In Force | July 3, 2008       |
| Senegal                                   | Patent Cooperation Treaty | In Force | January 24, 1978   |
| Serbia                                    | Patent Cooperation Treaty | In Force | February 1, 1997   |
| Seychelles                                | Patent Cooperation Treaty | In Force | November 7, 2002   |
| Sierra Leone                              | Patent Cooperation Treaty | In Force | June 17, 1997      |
| Singapore                                 | Patent Cooperation Treaty | In Force | February 23, 1995  |
| Slovakia                                  | Patent Cooperation Treaty | In Force | January 1, 1993    |
| Slovenia                                  | Patent Cooperation Treaty | In Force | March 1, 1994      |
| South Africa                              | Patent Cooperation Treaty | In Force | March 16, 1999     |
| Spain                                     | Patent Cooperation Treaty | In Force | November 16, 1989  |
| Sri Lanka                                 | Patent Cooperation Treaty | In Force | February 26, 1982  |
| Sudan                                     | Patent Cooperation Treaty | In Force | April 16, 1984     |
| Swaziland                                 | Patent Cooperation Treaty | In Force | September 20, 1994 |
| Sweden                                    | Patent Cooperation Treaty | In Force | May 17, 1978       |
| Switzerland                               | Patent Cooperation Treaty | In Force | January 24, 1978   |
| Syrian Arab Republic                      | Patent Cooperation Treaty | In Force | June 26, 2003      |
| Tajikistan                                | Patent Cooperation Treaty | In Force | December 25, 1991  |
| Thailand                                  | Patent Cooperation Treaty | In Force | December 24, 2009  |
| The former Yugoslav Republic of Macedonia | Patent Cooperation Treaty | In Force | August 10, 1995    |
| Togo                                      | Patent Cooperation Treaty | In Force | January 24, 1978   |
| Trinidad and Tobago                       | Patent Cooperation Treaty | In Force | March 10, 1994     |
| Tunisia                                   | Patent Cooperation Treaty | In Force | December 10, 2001  |
| Turkey                                    | Patent Cooperation Treaty | In Force | January 1, 1996    |
| Turkmenistan                              | Patent Cooperation Treaty | In Force | December 25, 1991  |
| Uganda                                    | Patent Cooperation Treaty | In Force | February 9, 1995   |
| Ukraine                                   | Patent Cooperation Treaty | In Force | December 25, 1991  |
| United Arab Emirates                      | Patent Cooperation Treaty | In Force | March 10, 1999     |
| United Kingdom                            | Patent Cooperation Treaty | In Force | January 24, 1978   |
| United Republic of Tanzania               | Patent Cooperation Treaty | In Force | September 14, 1999 |
| United States of America                  | Patent Cooperation Treaty | In Force | January 24, 1978   |
| Uzbekistan                                | Patent Cooperation Treaty | In Force | December 25, 1991  |
| Viet Nam                                  | Patent Cooperation Treaty | In Force | March 10, 1993     |
| Zambia                                    | Patent Cooperation Treaty | In Force | November 15, 2001  |
| Zimbabwe                                  | Patent Cooperation Treaty | In Force | June 11, 1997      |