

# FREQUENTLY ASKED QUESTIONS FROM OUR INTERNATIONAL ASSOCIATES AND CLIENTS

## Australia – Patents, Designs & Copyright

### Patents

Are there any restrictions on filing route, such as PCT or Direct filing, depending on the country of priority filing?

There are no restrictions on filing route in Australia depending on the country of priority filing, and both national phase PCT applications and convention and non-convention applications are available, as well as provisional patent applications.

For an Australian national phase PCT application, the deadline for entering the national phase in Australia is 31 months from the earliest priority date.

For an Australian convention application, the deadline is 12 months from the earliest priority date.

It should be kept in mind that if the first (i.e. priority) filing for the invention is to occur in Australia, and one or more of the inventors or applicants are citizens or residents outside of Australia, or the invention was at least partially made outside of Australia, or subject matter of the invention may be of interest to national defence or security, then an appropriate foreign filing licence may be required depending on the circumstances.

Is there a grace period?

A one year grace period is provided.

However, in order to take advantage of the grace period, it is necessary to file a complete patent application (either a PCT application or a standard Australian patent application, but not a provisional patent application) the day before the expiry of the one year grace period at the latest.

What is the typical time from filing to grant?

The timeframe from application lodgement to grant of the patent depends on several factors, such as:

- timeliness of a request for examination;
- examination report processing times (i.e. time from

requesting examination to issuance of first examination report), which are approximately 12 months at present; and

- timeliness of response to an examination report.

The timeframe for achieving the grant of a patent, given a 12-month wait to receive an examination report and exhausting all deadlines, is approximately 29 months at present. This timeframe may be significantly reduced. See below *Is it possible to speed up the process?* for more information.

How soon does the search report issue?

Requests for an 'International-type search' (in respect of an Australian provisional patent application) are usually completed within six weeks.

As mentioned above *What is typical time from filing to grant?*, there is presently a 12-month wait to receive an examination report once examination has been requested.

Is it possible to speed up the process? For example, fast lanes for green technologies?

There are several ways of accelerating the patent prosecution process.

IP Australia offers several popular options for accelerating examination:

1. Patent Prosecution Highway (PPH) program, for applicants with allowed/accepted patent applications in certain foreign countries. See below.
2. Fast track for green technology. Australian patent applications featuring climate-conscious technology may be eligible for expedited examination.
3. Fast track for patent applicants that are small to medium enterprises.
4. Commercialisation, infringement and licensing reasons.

Other ways of accelerating the patent prosecution process include:

- Requesting examination upon lodgement of the patent application, rather than waiting for IP Australia to issue an examination direction.
- Quickly responding to examination reports. Patent applicants have 12 months from the issuance of the first examination report to achieve acceptance, but in our experience a suitable response can be prepared in a fraction of that time (depending on the complexity of the matter).

### What is the patent prosecution highway and is Australia a participant?

Australia joins many other nations in participating in the Patent Prosecution Highway (PPH) program.

Under PPH, certain Australian patent applications associated with foreign national phase entries of international patent applications, or with European patent applications, may be examined on an expedited basis where an associated application has achieved allowance/acceptance.

Under examination via PPH, applicants receive the benefit of (1) rapid examination and (2) deference to the allowance/acceptance of the associated application to some extent.

### Can the process be delayed?

Generally speaking, patent applicants are unable to delay the patent prosecution process as deadlines are set by law.

However, applicants may choose to pace the examination process by requesting postponement of acceptance when requesting examination. This allows for a period of time to consider amendments to a specification before a favourably-examined application proceeds to acceptance by the deadline.

### What is the process for requesting examination?

Examination of a patent application must be requested within five years of lodgement of the application, or within two months following issuance of a direction to request examination by IP Australia.

The process for requesting examination is straightforward and does not require any documentation or information from the applicant. It is usually completed within one business day.

### Are there any deadlines in which to achieve acceptance?

Please note that Australian patent applications must be substantively examined before they are accepted and granted.

With that said, there are two critical deadlines for all patent applications to achieve acceptance:

#### 1. Examination request deadline.

See [What is the process for requesting examination?](#) for more information.

#### 2. Acceptance deadline

The acceptance deadline is 12 months from the date of issuance of the first examination report. It should be noted that this deadline is not a response date, but the date by which all objections raised on the application (including those raised in any subsequent examination reports, should they issue) need to be overcome so that the application may progress to acceptance.

### What documents are required to effect national phase entry into Australia?

The Australian national phase of an English-language international patent application may be entered without the need to provide any documents. A national phase entry largely involves confirming key bibliographic information before finalising the request.

However, further documents may be required such as:

- a translation of the international patent application if filed in a language other than English; and
- an amended patent specification if requesting voluntary amendments upon filing.

Other documents, such as inventors' oaths, powers of attorney, or prior art disclosure statements, need not accompany an Australian national phase entry.

### Are divisional applications an option?

Yes, divisional applications are allowable in Australia.

### What is the deadline for filing a divisional?

One or more divisional applications can be filed up until three months from the date of publication of acceptance of the parent application, or by the acceptance deadline if the parent application is not in order for acceptance by that time.

Please note that payment of acceptance fees of a patent application does not preclude lodgement of a divisional patent application (within the abovementioned three month period).

### What are the limitations regarding divisional applications (ie claim scope)?

The divisional application may include a broader claim set, or a claim set directed to a different invention than that claimed in the accepted application.

A divisional application must have at least one claim defining an invention that is disclosed in the 'parent' application in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art.

Typically, a divisional application is filed when there is more than one invention described in the accepted application or when an applicant believes the accepted application may be opposed.

#### Is re-examination available?

Re-examination of Australian patents, including certified innovation patents, can be requested .

#### Can a third party file third party observations?

Yes, third-party observations can be filed before the expiry of three months after a notice of acceptance of the application is published.

#### Is there an opposition process?

Yes, a process for opposing the grant of a patent is provided.

The Australian patent opposition process is a 'pre-grant' opposition process.

Opposition proceedings against an accepted application may be initiated at any time during the three-month advertisement period following publication of acceptance of the application.

## Designs

#### Is Australia a member of the Hague Agreement?

No, Australia is not a contracting party of the Hague Agreement.

#### How long does a design registration last?

A design is registered for an initial term of five years from the date of filing the application, with a further period of five years available on application, providing a possible maximum term of 10 years.

#### Are there any documents that are required to be signed by the applicant or designer(s) when lodging the design application?

No.

#### Does a priority document or a DAS code need to be provided with a design application?

Only priority application details are required to be submitted as part of the application. Neither a document nor DAS code is required.

IP Australia reserves the right to request these if considered necessary.

#### Are there any exceptions to loss of novelty?

There is a 12-month 'grace period' for publication or use by the owner or designer occurring on or after 10 March 2022. The declaration can be filed before the design is examined or during examination if there are issues with prior disclosures which fall within the grace period.

#### Does a design application need to be examined?

Whilst a design does not need to be examined, it cannot be enforced until a Certificate of Examination has issued. A Certificate of Examination will only issue on successful completion of substantive examination, which can be requested at any time after the design application has proceeded to registration.

#### Can related designs be filed as part of a single design application?

Multiple designs can be included in the one application initially but separate registrations issue for each design. Our general recommendation is therefore to file a separate application for each design.

#### What else should I know about designs?

- Design publications may be deferred until 6 months from priority date.
- After filing, an application undergoes a formalities examination, successful completion of which will result in registration of the design.

## Copyright

#### Is the protection for copyright provided through a registration process?

Although there is no formal system of copyright registration in Australia, copyright protection is free and automatic once an idea or information is suitably formalised.

Australia is a party to both the Berne Convention and the Universal Copyright Convention (UCC).

In respect of copyright for software (code), copyright will automatically subsist by virtue of the Copyright Act 1968 without the need to seek registration, provided that certain deeming provisions (i.e. the work is original and was made by a "qualified person" under the Act) are satisfied.

*The above comments are provided as a guide only and we encourage you to contact us to discuss your specific circumstances.*

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## 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.