



## Spruson & Ferguson wins the 2009 BRW Client Choice Awards

We are pleased to announce that Spruson & Ferguson has been voted the **Best Patent Attorney and Trade Mark Firm** in Australia in the 2009 BRW Client Choice Awards. This achievement is the result of "the largest study of the clients of professional services in the world" and was conducted by Beaton Consulting.

We would like to extend our thanks to all of our clients and associates who participated in the survey, for helping us to achieve this great result. Providing our clients with the best quality service and expertise has been, and will remain, our absolute priority.

## Current State of Play

### Australian Patent Office relaxes requirements for certified copies

As a result of amendments to the Australian Patents Regulations that came into force on 1 January 2009, there is no longer a requirement to lodge certified copies of priority applications in respect of Australian patent applications, unless the Australian Patent Office specifically requests such a certified copy. We expect that the Australian Patent Office will only make such a request if intervening prior art is identified that requires assessment of the priority date of specific claims. If the Australian Patent Office requests a certified copy, it must be filed within three months of the request.

This change in practice is in line with the current practice for Australian design applications which already does not require the filing of certified copies of priority applications, unless requested by the Australian Designs Office.

There is also no longer a requirement to file a certified copy of the granted foreign patent on which any request for modified examination of an Australian patent application is based, unless specifically requested by the Australian Patent Office.

The specification of any Australian application that is the subject of modified examination must, however, still be identical to that of the granted foreign patent, apart from matters of form. If the Australian Patent Office does request a certified copy of the granted foreign patent, it must be filed prior to acceptance (i.e., allowance) of the Australian application.

### Software and Business Method Patents in the U.S.

The recent decision of the Court of Appeals of the Federal Circuit in the case of *In re Bilski* has been appealed to the U.S. Supreme Court. The case decided by the Court of Appeals concerns an appeal against a decision of the United States Patent and Trademarks Office (USPTO). The USPTO has subsequently filed an Opposition to the appeal to the Supreme Court.

The Court of Appeal's decision relates to the scope of patentable subject matter in the United States of America and is of fundamental importance to computer software and business method patents.

Favourably to patent applicants, the Court of Appeals declined "to adopt a broad exclusion over software or any other category of subject matter beyond the exclusion of claims drawn to fundamental principles set forth by the Supreme Court" and reaffirmed its finding in the *State Street* decision that business methods, like other processes or methods, may be patentable.

However, the Court of Appeals repudiated its own prior "useful, concrete and tangible result" test as being insufficient for establishing patent eligibility. The proper test for whether a method or process claims is patent eligible, the Court said, is: (1) whether the claimed invention is tied to a particular machine or apparatus; or (2) whether the claimed invention transforms a particular article into a different state or thing. This appears to represent a restriction in the scope of patent eligible subject matter. In consideration of future developments in technology, the Court added that claims that do not meet the new test may yet be patentable. A positive result to the new test is thus sufficient, but a negative result does not *per se* preclude patent eligibility.

The decision confirms that a computer performing an operation upon data that characterises a physical object is clearly patent eligible. However, claims directed to a pure business method, even when performed using a computer, may not meet the new test for patent eligibility. Some judges, in dissent, expressed concern that the Court's majority decision would be regressive and possibly disadvantage some software-related patent applications.

A copy of the decision is available at: <http://www.cafc.uscourts.gov/opinions/07-1130.pdf>



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Spruson & Ferguson produces two electronic bi-monthly newsletters:

**Trade Marks E-news** – a breakdown of important issues for trade marks and branding in Australia

**Biotech E-news** – a review of important issues in the Australian biotechnology industry

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