

Dependent or Not?

Dependent claims need not narrow scope of invention in Australia

and multimedia devices. In that regard, section 101(4) was introduced in 2006 to provide that use of a trade mark in respect of similar goods or closely related services or similar services or closely related goods could be taken into account in the exercise of the discretion under section 101(3). Although the relevant period in this case pre-dated the introduction of section 101(4), the Court held that Pioneer KK's use of the trade mark "PIONEER" on closely related goods (being audio-visual products and multimedia devices) could be taken into account in considering whether to exercise its discretion under section 101(3). In other words, the Court was of the view that the introduction of section 101(4) in 2006 simply clarified the position concerning section 101(3).

With regard to the removal services (for which no use had been established during the relevant period), the Court did not consider that the above concepts of convergence and brand extension supported the exercise of the discretion in favour of maintaining the removal services.

As a result, the two registrations remain on the Register, the removal services being excised from the second registration.

The Court's exercise of its discretion under section 101(3) was conditional upon Pioneer KK providing an undertaking not to take action against PCA for past or future use prior to 31 July 2009 of the trade mark "PIONEER".



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The Australian *Patents Act 1990* requires that a complete specification for a non-provisional patent application end with at least one claim defining the invention, and each claim must be clear, succinct, and fairly based on the matter described in the specification. Further, the claims must relate to one invention only (divisional applications may be required if there is more than one invention). These are the substantive legislative restrictions imposed on the nature and scope of claims per se in Australia. The patents legislation does not prescribe the characteristics of an independent claim, a dependent claim, and a multiple dependent claim. Instead, the rules concerning the drafting of such claims have developed through judicial precedents, although in some respects they are merely conventions.

In *Austal Ships Sales Pty Ltd v Stena Rederi Aktiebolag* [2008] FCAFC 121, the Full Court of the Federal Court held that "[t]here is no requirement of [Australian] patent law that [dependent] claims narrow the scope of earlier [base] claims, even though, as a matter of practice, this is often the case." At issue were claims concerning the hull structure of a multi-hull, catamaran-type ship. Independent claim 1 recited that "the width of the hull at the water line is substantially greater in the after body of the hull than in the forward body of the hull and continually decreases in a forward direction". However, dependent claim 7 referring back to any one of claims 1 to 5 recited that "the width of the hull at the water line is substantially constant in the case of the sternward quarter part of the vessel and then narrows towards the prow of the vessel." Thus, independent claim 1 required that the hull width at the waterline continuously decrease in a forward direction, but dependent claim 7 contradicted this aspect of claim 1 by requiring that the same hull width be substantially constant in part. The Full

Court stated that "Claim 7 is an alternative to claim 1, insofar as [independent claim 1] is limited by [the hull width continually decreasing in a forward direction]." The Full Court stated that the relevant integer of independent claim 1 and dependent claim 7 spoke of different concepts.

This is a notable point of distinction concerning claim drafting for Australia in contrast to requirements for dependent claims in the United States and Europe. The U.S. legislation permits a claim to be drafted in independent, dependent or multiple dependent form, but a claim cast in dependent form is construed to include all of the limitations of its base claim and must specify a further limitation of the subject matter claimed in the relevant base claim. Thus, in the U.S., a dependent claim must be narrower than its base claim; otherwise, a dependent claim that does not narrow the scope of the invention is invalid. Under the European Patent Convention (EPC), a dependent claim includes all the features of its base claim and a reference to the base and then states the additional features which it is desired to protect. Thus, a dependent claim that would otherwise be improper in the U.S. and Europe may be valid and enforceable in Australia. Notably, the Australian Patent Office Manual of Practice and Procedures does not reflect this decision of the Full Court of the Federal Court of Australia and states that a dependent claim will warrant an objection if the dependent claim extends beyond the scope of its base claim and does not include all the features of the invention defined by the base claims.



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