

Grace Periods

A safety net only under certain circumstances

at its website (www.commercialisationaustralia.gov.au). I suggest that all potential applicants thoroughly address each of these criteria.

S: Commercialisation Australia has indicated that an application will be turned around within 45 days - that's pretty quick, isn't it?

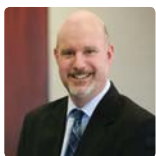
R: This approval period is pretty quick. However, applicants often underestimate the time and effort involved in preparing the application. Remember that the programme is competitive, so you will need to convince your assessor why you should be the one getting the grant by making a compelling case, using coherent and concise language and providing persuasive evidence, if available.

S: What happens to the successful applicant, apart from getting the funding, of course?

R: Well, successful applicants will need to sign a Funding Agreement with the Australian Government. The Funding Agreement sets out, amongst other things, the timetable for receiving the grant money, the conditions as to how the grant money should be spent, and the conditions relating to intellectual property rights generated from the project. It is important to ensure that the Funding Agreement is complied with when carrying out the project, and especially when applicants are also receiving investment from a third party.

The applicants will further receive help from a case manager, and from volunteer business mentors, to guide them through the commercialisation process.

S: Thank you Rob. This is a new era for Australia's innovative community. We wish all applicants the best of luck.



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It sometimes arises that an invention has been published or used before a patent application covering the invention is filed. In most jurisdictions, the prior publication or use will form part of the prior art base against which any subsequently filed patent application will be assessed, potentially jeopardising the ability to secure valid patent rights for the invention.

For this reason, the golden rule for protecting your invention is to file a patent application before making any disclosure of the invention.

Fortunately for Australian applicants, there is a safety net in the form of "grace period" provisions, which offer an opportunity under limited circumstances to protect an invention that was disclosed before an Australian patent application has been filed.

Self disclosure and authorised disclosure

Where an owner has published or used, or authorised publication or use of, the invention without first having filed a patent application and the owner subsequently files a **complete** Australian patent application (as opposed to a provisional patent application) within 12 months of that publication or use, the publication or use will be disregarded when deciding the novelty, inventive step, or innovative step of the invention claimed in the complete patent application.

Thus, if you believe that there has been or may have been disclosure of any aspect of your invention before you have filed a patent application relating to that invention, it is imperative that you seek professional advice from your patent attorney as soon as possible.

Reasonable trial and experimentation

If the physical nature of the invention makes it reasonably necessary for working of the invention for the purpose of reasonable trial to be in public, then such working of the invention may be disregarded when deciding the novelty, inventive step, or innovative step of the invention, provided that a patent

application is filed within 12 months of the earliest date of public working of the invention. The recent case of *Mack Innovations & Anor v Rotorco Pty Limited & Anor* in the Supreme Court of Queensland considered such reasonable trial in respect of a "Cable Pulling Apparatus for Helicopters" and confirmed that a provisional application filed within 12 months of the earliest date of public working of the invention was sufficient to enliven this particular "grace period" provision.

Learned Societies and Recognised Exhibitions

The "grace period" provisions also provide limited opportunities to protect an invention disclosed in relation to a "recognised exhibition" or a "learned society". It should be noted that "recognised exhibitions" are a particular class of international exhibition and generally exclude exhibitions of an essentially commercial nature. There are strict requirements associated with the "grace period" provisions for recognised exhibitions and learned societies and we recommend that you seek professional advice from your patent attorney regarding the specific circumstances prior to disclosing your invention.

Whilst the "grace period" provisions offer limited opportunities to obtain patent protection in Australia for inventions that may have been disclosed, most jurisdictions do not offer equivalent saving provisions. Accordingly, to maximise opportunities for patent protection and commercialisation in Australia and overseas, we recommend that patent applications be filed prior to any disclosure of an invention.



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