

Innovation Patent Strategies

Have you considered all the options?

- a) determining the properties of the invention;
- b) determining the scope of a claim relating to the invention;
- c) improving or modifying the invention;
- d) determining the validity of the patent or of a claim relating to the invention;
- e) determining whether the patent for the invention has been infringed.

Modified examination

This examination option, available since the early 1970's, is to be removed. The provision has not been extensively used and differences in examination standards and laws have diminished its value.

Transition Provisions

There has been a partial win for patent applicants, in that the substantive changes for considering patent validity (e.g. tougher inventive step/obviousness test, and stricter utility/usefulness and enablement requirements) will only apply to patent applications where a request for examination has not been filed by the date of commencement (as opposed to the original proposal of the date of the First Examiner's Report/Office Action, being a date that the applicant does not have control over).

Commencement Date

The commencement date will be 12 months after the Act is formally adopted by Royal Assent (which may occur in the next few months, depending on how quickly the legislation passes through the two Houses of Parliament) – the period is normally 6 months. The commencement date therefore is likely to fall in late 2012.

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The Australian innovation patent system has been around for almost ten years now, but is yet little used. Innovation patents are a patent tool and should always be considered when framing an intellectual property strategy.

The innovation patent was introduced in Australia in 2001 to provide protection for "lower level inventions". Whilst innovation patents provide the same exclusive rights as standard patents, albeit for a shorter term of eight years from the filing date, there is no requirement for the invention to involve an inventive step (i.e. non-obviousness). The requirement for an inventive step is replaced by an "innovative step" test. The test for an innovative step involves:

- a) comparing the invention, on a claim-by-claim basis, with each prior art disclosure separately, to determine any differences between the claimed invention and the prior art disclosure; and
- b) looking at the differences through the eyes of a person skilled in the relevant art and assessing whether the invention as claimed in the relevant claim only varies from the prior art disclosure in ways that make no substantial contribution to the working of the invention.

In the well-reported Delnorth series of cases, where Spruson & Ferguson was successful on the patent owner's behalf, the term "working of the invention" was confirmed by the Federal Court to be the working of the device or process that is the subject of the relevant claim, and that the assessment is a factual enquiry from a perspective of a person skilled in the art possessing the relevant common general knowledge. It does not matter whether features that distinguish the invention from the prior art are well-known or obvious to a person skilled in the art. All that is required is for at least one distinguishing feature of the claimed invention to make a substantial

contribution, being a contribution that is "real" or "of substance", to the manner in which the claimed device or process works.

How can an innovation patent be used? Consider the following:

- » A divisional innovation application could be filed in circumstances where a standard patent might be open to an attack on the basis of a lack of inventive step (e.g. during a pre-grant opposition or re-examination).
- » A divisional innovation application could be lodged where potential infringement is identified and the standard patent application is delayed in prosecution or an opposition.
- » A divisional Innovation application can be granted, published and certified to be enforceable within a matter of months.
- » A divisional innovation application could be filed, or a standard application could be converted to an Innovation patent application where inventive step (obviousness) objections are preventing the acceptance of the standard application.
- » A divisional innovation application could be filed as a backstop for commercially important inventions that may be subject to a validity attack (i.e. doubling up).

You really cannot afford to ignore the innovation patent system.



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