

AUSTRALIA RESPONSE – SCP 29 Request for Information

(i) Input on research exception

Australia – Research Exception

The Australian Patents Act 1990 provides an exemption from patent infringement for research and experimental activities. Under Section 119C, a researcher is exempt from patent infringement for experimental purposes that relate to the subject matter of an invention. The experimental purposes include, but are not limited to:

- determining the properties of the invention;
- determining the scope of a claim relating to the invention;
- improving or modifying the invention;
- determining the validity of the patent or of a claim relating to the invention;
- determining whether the patent for the invention would be, or has been, infringed by the doing of an act.

However, the exemption does not apply where the main purpose of activities is to commercialise the invention, or to manufacture it for the purpose of sale or use for commercial purposes. Additionally, ‘market research’ on a patented invention (e.g. making and using the invention to test the likely commercial demand for a product) is not exempt, as this too has a predominantly commercial purpose.

The exemption does also not apply to the use of patented ‘research tools’. A ‘research tool’ is something that is used to facilitate an experiment, rather than something that is the subject of the experiment. For example, a researcher testing the effect of a particular herbicide on different plants might use a patented wetting agent to facilitate uptake of the herbicide. Here use of the wetting agent should not be exempt from infringement, as it is being used as a tool and the experiments do not relate to it.

Section 119C came into force on 15 April 2013 as part of the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012*. Subsequent evaluation has not identified any issues with the implementation of Section 119C, and indicates that the provision has given certainty and clarity to researchers.

(ii) Updated information on national and regional laws on opposition systems and other administrative revocation and invalidation mechanisms

Australia – Opposition Systems

Australia operates a pre-grant opposition system for standard patent applications¹ where any person may oppose the granting of a patent by filing a Notice of Opposition within three months of acceptance of the application² being advertised in the Official Journal of Patents.

¹ There are two types of patents in Australia, the ‘standard’ patent and the ‘innovation’ patent (similar to a utility model). Oppositions to innovation patents can only be initiated after the patent has been granted and then certified.

² Subsection 49(1) of the Patents Act provides that, subject to Section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent, if

According to Section 59 of the Patents Act 1990, the Minister or any other person may, in accordance with the Regulations, oppose the grant of a standard patent on one or more of the following grounds, but on no other ground:³

- (a) that the nominated person⁴ is either (i) not entitled to the grant of a patent for the invention or (ii) entitled to the grant of a patent for the invention, but only in conjunction with some other person;
- (b) that the invention is not a patentable invention;⁵
- (c) that the specification filed in respect of the complete application does not comply with Subsection 40(2) or (3).⁶

Under Section 60 of the Patents Act, the opposition is heard by the Commissioner who must decide the case in accordance with the Regulations. The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding the case. The Commissioner may, in deciding the case, take into account any ground on which the grant of a standard patent may be opposed, whether relied upon by the opponent or not. The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this Section. Oppositions can also arise with regard to procedural matters including:

- (a) amendments: under Subsection 104(4) of the Patents Act, the Minister or any other person may oppose the allowance of an amendment. Section 102 of the Patents Act provides that amendment of the complete specification is not allowable if, as a result of the amendment, the amended specification would claim or disclose matter that extends beyond that disclosed in the specification as filed, together with other prescribed documents (if any);
- (b) extensions of time: under Subsection 223(6) of the Patents Act, any person may oppose the granting of an extension of time;
- (c) extensions of term for a pharmaceutical patent: under Section 75 of the Patents Act, any person may oppose the grant of an extension of term under Section 70 but only on the ground that one or more of the requirements specified in Section 70 (defining what subject matter is available for extension of term) and

the Commissioner is satisfied, on the balance of probabilities: (a) that the specification complies with subsections 40(2) to 40(4), i.e. disclosure, clarity, support and unity; (b) that the invention satisfies the criteria mentioned in paragraphs 18(1)(a), (b) and (c), i.e. manner of manufacture, novelty, inventive step and usefulness; and (c) that the invention is a patentable invention under Subsection 18(2) (human beings, and biological processes for their generation, are not patentable inventions).

³ Section 101M of the Patents Act allows for opposition under analogous grounds for certified innovation patents, with an innovative step instead of an inventive step.

⁴ The applicant is taken to be the nominated person for the grant of the patent (Regulation 3.1A), and in this context the term 'person' means a legal person and includes a body politic (e.g. Commonwealth of Australia, French Republic) and a body corporate (e.g. a company incorporated under the laws of the State of Victoria), as well as a natural person.

⁵ Under Subsection 18(1), this includes a lack of novelty or inventive step, manner of manufacture or utility.

⁶ Subsection 40(2) of the Patents Act provides that a complete specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art, disclose the best method known to the applicant of performing the invention, and end with a claim or claims defining the invention. Subsection 40(3) states that the claims or claim must be clear and succinct and supported by matter disclosed in the specification.

- Section 71 (relating to the form and timing of an application) are not met;
- (d) grant of a licence to exploit an invention: under Regulation 22.21(4) of the Patents Regulations 1991, a person who receives a copy of an application for a licence can oppose the granting of that licence.

Australia – Re-Examination Systems

Chapter 9 of the Patents Act 1990 provides for re-examination of applications for standard patents and granted standard patents under certain circumstances. Re-examination of certified innovation patents is also provided for in Chapter 9A, under Section 101G.

The grounds for re-examination are novelty, inventive (innovative) step, usefulness, manner of manufacture, disclosure, clarity, support and patentable inventions. The procedure is *ex parte*, i.e. between the Commissioner and the patentee or applicant. The person who requests re-examination has limited opportunity to submit evidence and be heard during the process.

The options for initiating re-examination depend on the stage of the patent cycle. At any time between acceptance of a standard patent application and grant of the corresponding patent, only the Commissioner can initiate re-examination. This may happen due to an adverse finding of an internal quality review, the emergence of new prior art (whether as a result of a Section 27 notice, or from other sources), or in response to a withdrawn opposition. At any time after grant of a standard patent or certification of an innovation patent, the patentee, any third party, or a court may request re-examination. The Commissioner can also initiate re-examination without an external request.

The Commissioner will instigate re-examination voluntarily only if intending to issue an adverse re-examination report. In contrast, the Commissioner must re-examine where a patentee or third party requests re-examination, regardless of whether the report is adverse or not. The applicant or patentee has the opportunity to respond to any adverse report through amendments and/or submissions and if the adverse findings are not resolved, the Commissioner has the power to refuse an application or revoke a patent.

The applicant or patentee may appeal to the Federal Court against a decision of the Commissioner, according to Subsections 100A(3), and 101(4) and 101J(5), respectively.

Australia – Submission of Information by Third Parties

Section 27 of the Patents Act 1990 states that:

Notice of matters affecting validity of standard patents

- (1) A person may, within the prescribed period after a complete specification filed in relation to an application for a standard patent becomes open to public inspection, notify the Commissioner, in accordance with the regulations, that the person asserts, for reasons stated in the notice, that the invention concerned is not a patentable invention because it does not comply with paragraph 18(1)(b).
- (2) The Commissioner must inform the applicant for the patent in writing of any matter of which the Commissioner is notified and send the applicant a copy of any document accompanying the notice.
- (3) The Commissioner must otherwise consider and deal with a notice in accordance

with the regulations.

(4) A notice and any document accompanying it are open to public inspection.

Section 27 enables any person to file a notice asserting that the invention in a standard patent application is not patentable due to a lack of novelty and/or inventive step. This notice must be filed between the date the application was opened for public inspection and three months after publication of the acceptance of the application. The notice must include reasoning as to why there is a lack of novelty and/or inventive step, accompanied by prior art documents used to support this contention. Section 28 of the Patents Act provides analogous procedures for innovation patents to allow any person to allege a lack of compliance with paragraph 18(1A)(b) due to lack of novelty and/or innovative step.

(iii) Updated information on international work sharing and collaborative activities for search and examination of patent applications

Updated document on the Vancouver Group provided on behalf of the IP Offices of Australia, Canada and the United Kingdom (see attachment).