

Re-examination systems

Australia

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.¹

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the emergence of new prior art (whether as a result of a Section 27 notice, or from other sources), or in response to a withdrawn opposition.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.

¹ Note: the innovation patent is being phased out. It is no longer possible to apply for an innovation patent, although existing patent applications filed prior to 26 August 2021 (the effective date of Sch 1 Pt 2 of the Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2020 (Cth)) may allow the applicant to amend an existing application or file a divisional application for an innovation patent.