



Australian Government

IP Australia

Exchanging Information on Patent Applications

September 2007

Purpose

The purpose of this document is to inform stakeholders of the amendments IP Australia is proposing to introduce to the *Patents Regulations 1991* (the Regulations) to:

- Extend the circumstances under which the Commissioner of Patents (the Commissioner) may make priority and other documents available to the World Intellectual Property Organization (WIPO) and other intellectual property offices (IPOs). This includes, on request by the applicant, placing priority documents in a secure digital library to enable the applicant to meet the requirements of the Patent Cooperation Treaty (PCT) or foreign IPOs for the filing of priority documents.
- Further reduce the circumstances where applicants are required to routinely file documents with IP Australia when those documents are not immediately required by IP Australia or, if required, are available to it from a recognised digital library.

In the present context, a ‘recognised digital library’ will generally be a library maintained by IP Australia, another IPO or any other reputable intellectual property organisation in which collections are stored in electronic/digital formats (as opposed to print, microfilm or other media). The documents within the collection can be accessed remotely via secure computer networks.

Background

A critical component of the global business strategy for many applicants is obtaining patent rights in a number of foreign jurisdictions. These foreign patents generally must be obtained through a patent application proceeding independently in each jurisdiction. This may be initially accomplished by filing a single international application under the auspices of the PCT. Alternatively multiple applications may be filed directly with IPOs under the *Paris Convention* (Convention applications). In either case the earlier priority date of an initial application may be preserved if subsequent applications are filed within 12 months. To preserve the earlier priority, applicants are generally required to file copies of various documents with WIPO or each of a number of IPOs (eg a copy of the earlier application and in some cases verified translations). Other documents – such as search results, examination reports and certified copies of patents – may also need to be filed with a foreign IPO during the prosecution of a patent application and, if filed, may provide a benefit to the applicant through speedier prosecution or reduced costs.

To meet these requirements applicants have traditionally been required to obtain certified copies of documents from the IPO where the original application was made and file them separately with other IPOs. This can be a time consuming and costly exercise and may even put the obtaining of a foreign patent at risk if errors arise in the handling of documents at intermediate points in the application process. There is also a high administrative cost for IPOs associated with handling the volume of documents involved, particularly if the documents are provided in paper.

The increasing use of secure electronic filing and information storage systems by IPOs around the world provides significant opportunities for addressing this issue. Currently there are various systems, either in use or being developed, which allow for the electronic transfer of priority documents to/from digital libraries. The Trilateral Offices – comprising the United States Patent and Trademark Office (USPTO), the Japanese Patent Office (JPO) and the European Patent Office (EPO) – have commenced the electronic exchange of patent

documents through their Priority Document Exchange (PDX) system. The PCT also includes a mechanism whereby priority documents for international applications are forwarded and disseminated by WIPO. Together with the Trilateral Offices and other IPOs, WIPO is currently establishing a global framework or “digital access service” (DAS) for priority documents. Information about this initiative is available from WIPO at http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=82452.

While the advent of digital libraries enables ready access to documents by IPOs, the libraries also allow IPOs to retrieve documents only when necessary. Hence IPOs will no longer have to ask or require applicants to file documents as a matter of course. Australia’s current patent legislation provides for this in some circumstances but not others and, for example, requires the applicant to file copies of priority documents for all Convention applications before the finalisation of examination (“acceptance”).

Furthermore, there are other documents which the applicant is required to provide under Australian legislation during the course of examination or which can assist the Commissioner in conducting the examination. These documents are becoming increasingly available online and hence the Commissioner can retrieve these documents directly from another IPO and/or digital library. This means that the applicant no longer needs to file them with IP Australia which can result in significantly reduced costs for applicants. The direct retrieval of documents also improves the efficiency of examination.

Conversely the examination of corresponding applications by other IPOs can be assisted by IP Australia providing access to its search and examination results. There are a number of cooperative arrangements currently being developed by IPOs to facilitate this for the benefit of both IPOs and applicants. It is therefore important that Australia’s patent legislation provide sufficient flexibility for IP Australia to participate in these arrangements.

A key issue in the ability of the Commissioner to enter a document into a digital library or to otherwise make it available to another IPO is that the *Patents Act 1990* (the Act) and the Regulations, with limited exceptions, do not currently require or authorise the Commissioner to provide copies of patent specifications or other documents that are not open to public inspection (NOPI). Furthermore, provisions within the *Privacy Act 1988* (Cth) (the Privacy Act) restrict the Commissioner’s ability to disseminate personal information contained in documents unless the applicant has consented to its release.

Changes to address the issues

The issues relating to the exchange of information and compliance with documentary filing requirements above can be addressed by making appropriate amendments to the Regulations. This will enable patent applicants to take advantage of the international developments referred to and should result in significant savings for applicants seeking patent protection overseas as well as in Australia. The proposed amendments will streamline and facilitate the exchange of information on patent applications between IP Australia and IPOs and/or digital libraries in other jurisdictions.

Patents regulations

IP Australia is proposing to initiate amendments to the Regulations that will have the effect of implementing the changes discussed above.

In the first instance, the proposed amendments will prescribe, for the purposes of subsection 194(c) of the Act, the information which may be released by the Commissioner. The proposed amendments will also set out the circumstances under which, and the persons to whom, NOPI information may be released. Information for this purpose may include information about a patent application and personal details relating to the applicant(s) and/or inventor(s), all or part of a patent specification, amendments to a patent specification, search reports, search information statements, and examination reports.

As a result of the proposed amendments, NOPI patent specifications will only be released after the applicant has requested their release, and other information will only be released after the applicant has consented to its release. An indication of the applicant's request to release documents or the applicant's consent to release information may be incorporated into a revised patent request form or other patent office form.

In the second instance, the proposed amendments will have the effect of removing the routine requirement for an applicant to file copies of priority documents, verified translations, granted patents and other documents except:

- when there are issues which require the Commissioner to refer to or access such documents, and
- those documents cannot be retrieved by IP Australia staff from a recognised digital library or cannot be supplied directly by another IPO.

Hence, there will be fewer circumstances when the Commissioner will request applicants to file documents with IP Australia.

If the Commissioner requests the supply of priority documents, it is proposed that these documents will need to be supplied by:

- three months from the date of request by the Commissioner if the patent application has been accepted or the innovation patent certified; or
- not earlier than 16 months from the filing date of the earliest priority document but before acceptance if the patent application has not yet been accepted; or
- not earlier than 16 months from the filing date of the earliest priority document but before certification if the innovation patent has not yet been certified.

If the applicant is unable to supply a copy of the priority document within the required timeframe, then the Convention application may be converted to a non-Convention application in accordance with current procedures. If the application is converted, it will lose its right of priority and its priority date will revert to the filing date of the application in Australia.

It should be noted that these proposed provisions are similar to the existing provisions that apply to PCT applications.

The Process

IP Australia invites written comments on the processes discussed above and the proposed amendments to the Regulations by **COB Wednesday, 17 October 2007**.

Please email comments to Jeff.Carl@ipaustralia.gov.au in the first instance.

Comments may also be sent by mail or facsimile to:

Jeff Carl
Domestic Policy Section
IP Australia
PO Box 200
WODEN ACT 2606
Facsimile: (02) 6291 7247

Confidentiality

All comments will be treated as public unless the author clearly indicates to the contrary.

A request made under the *Freedom of Information Act 1982* (FOI Act) for access to a comment marked “confidential” will be determined in accordance with the FOI Act.
