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13. MODIFIED EXAMINATION

13.1 INTRODUCTION

13.1.1 The Choice of Modified Examination

- 13.1.1.1 Modified examination under sec 48 is an alternative to standard examination under sec 45. However, modified examination is only available for a complete application for a standard patent and where a patent has been granted in a prescribed foreign country in respect of a prescribed application made in that country (sec 47(1)). Under modified examination, the description and claims are made "the same" (see para 13.5.3 and 13.7 below) as those of a patent granted in a prescribed foreign country. Modified examination is usually quicker because the search is truncated, there are no sec 40 considerations by an examiner and there is no provision corresponding to sec 45(3), so unlike examination conducted under sec 45, the applicant is not required to supply search results.
- 13.1.1.2 When the Commissioner directs an applicant to ask for examination, the applicant has a choice. The applicant may ask for examination (or modified examination) as directed, or may ask the Commissioner to defer examination. The applicant would ask for deferment when he or she intends to ask for modified examination later on. Deferment is possible only if a prescribed application has been made in a prescribed foreign country and a patent has not been granted in that country.

13.1.2 Prescribed Foreign Countries

Prescribed foreign countries are, currently, Canada, New Zealand and the United States of America, and any country that is a signatory to the *Convention on the Grant of European Patents*. At present, these are Austria, Belgium, Cyprus, Denmark, Finland, France, Germany, Hellenic Republic, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Portugal, Spain, Sweden, Switzerland, and United Kingdom. See reg 3.21.

13.1.3 Prescribed Application

13.1.3.1 According to reg 3.20(2), the prescribed application can be:

- a) an application which derives priority from the Australian application, or from a provisional application associated with the Australian application;
- b) a basic application in relation to the Australian application; or
- c) an application which derives priority from a basic application in relation to the Australian application.

13.1.3.2 Examiners should note that the words "in relation to" in para 13.1.3.1 above only require that the Australian application and the basic application are directed to the same invention. They do not require any priority link between the two applications. It should also be noted that the Act defines a "basic application" as an "application for protection in respect of an invention, being an application made in a Convention country", and does not require any priority link.

Thus, the prescribed application could for example be:

- d) the application on which the Australian application, being a Convention application, is based; or
- e) an application relating to the same invention as the Australian application, the Australian application being a non-Convention application, or a Convention application having no priority link to the prescribed application.

Refer also to para 13.7.9, below.

13.1.3.3 Both the Australian and the prescribed application may be a Convention application or an international (PCT) application. The prescribed application may also be a European application designating a prescribed foreign country (see para 13.1.2 above), a United States continuation-in-part or a United Kingdom divisional or refiled application. Other alternatives are also possible.

13.2 REQUEST FOR DEFERMENT (SECTION 46)

13.2.1 Conditions for Deferment

When an applicant asks for deferment, Patent Operations Section checks the request, and defers examination if the request is in order. Normally the case file would not reach an examiner at this stage. The request for deferment must meet all of the following four conditions.

- a) The applicant has made a complete application for a standard patent.
- b) A prescribed application for a patent has been made in a prescribed foreign country.
- c) A patent has not been granted on the prescribed application.
- d) The Commissioner gave the direction under reg 3.20(4), that is, "on the ground that he or she considers it expedient to give the direction, having regard to the progress made in the examination of applications filed before the filing date of the application concerned". If the Commissioner directed the applicant on any other ground, examination is not to be deferred.

13.2.2 Approved Form and Details

The applicant must make the request for deferment on form P/00/014 (or equivalent), and give full details of the prescribed application on which a patent has not been granted. The applicant needs to give details of only one pending foreign application. If there is one such foreign application on which a patent has not been granted, it does not matter whether a patent has been granted on another foreign application. For example, the applicant may ask for deferment based on a pending United States application, even though a United Kingdom patent has already been granted.

See *Cam Gears Ltd.'s Application*, (1979) AOJP 1758.

13.3 LAPSING AFTER DEFERMENT

13.3.1 No Lapsing Under Section 142(2)(a)

If the Commissioner defers examination, the application will not lapse under sec 142(2)(a). That is, the application will not lapse merely because the applicant does not ask for an examination within the six-month period specified under reg 3.16(2).

13.3.2 Lapsing Under Section 142(2)(c)

The Act does not specify how long the examination is deferred. However, the application will lapse under sec 142(2)(c) if the applicant does not ask for examination within 9 months from the date of filing the request for deferment (reg 13.2). The date of the Commissioner's direction to request examination is not relevant.

13.3.3 Request for Examination After Deferment

After deferment, the applicant may ask for standard examination or for modified examination. If the applicant asks for modified examination based on a foreign patent, that patent need not have been granted on the foreign application used for deferment. For example, the applicant may ask for deferment based on a Canadian application, but may later ask for a modified examination based on a New Zealand patent.

13.4 REQUEST FOR MODIFIED EXAMINATION (SECTION 47)

The applicant may ask for modified examination instead of standard examination.

13.4.1 Conditions for the Request

The request must meet all three of the following conditions.

- a) The applicant has made a complete application for a standard patent.
- b) A patent in English has been granted in a prescribed foreign country (see para 13.1.2, above, and 13.6.2, below).
- c) The foreign patent has been granted on a prescribed application (see para 13.1.3, above, and 13.6.3, below) made in that country.

13.4.2 Approved Form

The request must be on form P/00/005 (or equivalent).

13.4.3 Withdrawal of the Request

The applicant may withdraw in writing, at any time before acceptance, the request for modified examination and may instead ask for standard examination under sec 45. If the applicant asks for standard examination after modified examination has begun, a fee is payable. If the applicant withdraws the request for modified examination, he or she does not have to file a certified copy of a foreign patent.

When the applicant requests conversion under sec 47(2), the sec 45(3) provisions require all relevant search results to be filed within the appropriate time limits.

Where a request for modified examination is converted to a request for full examination, the period of time for acceptance extends to either 21 months from the date of the first examination report under sec 48 or 12 months from the date of the first examination report under sec 45, whichever is later.

13.4.4 Replacing a Request for Standard Examination with a Request for Modified Examination

There is no specific provision for replacing a request for standard examination with a request for modified examination. However, before standard examination has begun, the applicant may either withdraw the request for standard examination and ask the Commissioner for modified examination, or amend the request under sec 104 (see para 13.4.6, below). Simultaneous withdrawal and request may be necessary to prevent lapsing of the application under sec 142. Once standard examination has started, it is not possible to change to modified examination.

See also para 22.13.9 and 23.1.3 of this volume.

13.4.5 Fee Payable on Varying the Type of Examination

- 13.4.5.1 If the applicant asks for standard examination after modified examination has started, the prescribed fee for standard examination is payable in addition to the fee already paid for modified examination. However, no response fees are required to be paid if the applicant asks for standard examination more than 12 months after the first report under modified examination. If the applicant withdraws the request for modified examination before it has started, then no extra fees are required to be paid

See also para 22.13.9.1 of this volume.

- 13.4.5.2 If the applicant asks for modified examination before standard examination has started, only the prescribed fee for modified examination is payable. As a result, the applicant would not need to pay any extra fees, since the fee for modified examination is either the same as or less than the fee for standard examination, depending on whether the application is a national phase case upon which the Australian Patent Office issued an IPER. If the examiner has any doubt about the fee payable, or if the applicant has asked the Commissioner to exercise discretion under reg 22.6, the examiner should refer the matter to the supervising examiner.

See also para 22.12.9.2 of this volume.

13.4.6 Amending the Request for Modified Examination

An amendment under sec 104 to a request for examination is generally allowable. However, if the amendment is so extensive as to result, in effect, in a new request and the amendment is filed after examination has commenced, the amended request will be considered as being a new request filed out of time. Such an amendment may, for example, be to change a request for normal examination to one for modified examination (see also para 13.4.4, above, and 22.13.9, 23.1.3 and 23.1.4, below) or to change the granted foreign patent upon which modified examination is based to, for example, a patent granted in another jurisdiction (see also para 22.13.9 and 23.1.4, below).

13.4.7 Foreign Search Results not Required

If the applicant asks for modified examination or for deferment of examination, sec 45(3) is not applicable, and the applicant is not required to supply any search results. If, after deferment, the applicant asks for standard examination, sec 45(3) becomes applicable.

13.5 MODIFIED EXAMINATION (SECTION 48)

Normally, it will be clear whether the request is for standard, or for modified, examination. If there is any doubt, the examiner should check with the applicant or attorney before starting examination. This may happen if the examination request, the fee, or other documents are not consistent.

The examiner carries out modified examination in the same procedural manner (report by examiner, amendments or arguments by applicant) as standard examination.

13.5.1 Prescribed Matters

When an applicant asks for modified examination the Commissioner (in practice, the examiner) must examine the application and report on the prescribed matters. Reg 3.18(2) lists matters prescribed for both standard and modified examination.

13.5.2 Section 40 not Applicable

Unlike standard examination, modified examination does not include reporting under sec 40. Accordingly the examiner does not report on, whether the invention and best method of performance are fully described, whether the claims are clear, succinct and fairly based and relate to one invention only.

13.5.3 Matters Specific to Modified Examination

The following matters are prescribed in reg 3.18(3) specifically for modified examination.

The examiner reports on whether the specification under modified examination is the same as the copy of the specification filed under reg 3.20(6), apart from:

- a) matters of form;
- b) the omission of a claim that is made in the foreign specification;
- c) an amendment of a claim consequential on that omission;
- d) an obvious mistake in the foreign specification; or
- e) a difference arising from the requirements of sec 6(c) of the Act provided that the micro-organism deposited for the foreign specification is the same as that deposited for the specification under modified examination.

The examiner reports whether, for an invention to which sec 6 ("deposit requirements for micro-organisms") applies, those requirements have been met.

13.5.4 Copy of the Foreign Specification

- 13.5.4.1 Under reg 3.20(6), the applicant must file a certified copy of the specification relating to the foreign patent before acceptance. If the certified copy is not filed within the period prescribed for acceptance in reg 13.4, the application will lapse under sec 142(2)(e).

- 13.5.4.2 Where the applicant only supplies a copy of some of the patent or a copy which does *not* fall into any of the categories set down in para 13.6.5.2, below, the examiner should undertake such examination as may be appropriate and report accordingly, whilst drawing attention to the need to file a certified copy of the patent. If the applicant has not filed any copy of the patent, the examiner need only object to the absence of a certified copy and any deficiency in the application documents and reserve all other objections until the applicant either files that copy or requests standard examination. In this way the time for acceptance is set at 21 months from the date of this (first) report.

13.6 THE GRANTED PATENT

13.6.1 Specification of the Granted Patent

The relevant foreign specification is the specification of the granted patent, and not the specification which accompanied the application in that foreign country. Normally the certified copy will be that of the foreign specification in the form that it was in on the date of grant. However, if the foreign specification has been amended after grant, the applicant may file a copy of the amended specification.

In the case of ecase files it is acceptable (assuming legibility) for examination purposes for the certified copy of the specification of the granted patent to exist as a scanned document in PAMS.

13.6.2 Patent Must be in English

Under reg 3.20(3), the granted patent must be in English. An English translation of the foreign language text of the granted patent is not acceptable.

13.6.3 Patent Must Have Been Granted

A necessary condition for asking for modified examination is that a prescribed foreign patent has been granted. It does not matter if the granted patent, on which modified examination is based, ceases or is revoked at some stage. For example, the United Kingdom Patents Act 1977 in sec 73(2) empowers the Comptroller in certain circumstances to revoke a "British patent" granted under that Act. That British patent may be the basis of modified examination even though it has been revoked by the Comptroller and irrespective of whether the revocation takes place before or after the applicant asks for modified examination.

13.6.4 Patent Must be for an Invention

The granted patent must result from a foreign application for protection of an invention. Where any other form of industrial property has been granted, such as a Registered Design, Design Patent, Utility Model, or Plant Patent, sec 47 is not applicable.

13.6.5 Certification or Verification

- 13.6.5.1 The copy of the specification relating to the foreign patent must be:
- a) certified by the official chief or head of the Patent Office of the prescribed foreign country that granted the patent; or
 - b) otherwise verified to the reasonable satisfaction of the Commissioner.

- 13.6.5.2 For the purposes of para 13.6.5.1(b), the following are acceptable:
- a) a true copy of the specification of the granted patent, certified as being such by an Australian patent attorney, an equivalent thereof in a foreign jurisdiction or a person listed in reg 22.13(3).
 - b) a true copy of a certified copy in accordance with para 13.6.5.1(a), certified as being such by an Australian patent attorney, an equivalent thereof in a foreign jurisdiction or a person listed in reg 22.13(3).
 - c) a document which is stated or certified by an Australian patent attorney, an equivalent thereof in a foreign jurisdiction or a person listed in reg 22.13(3) to be a copy of an officially published version of the specification of the granted patent.
- 13.6.5.3 The examiner should accept as accurate a properly certified copy of the foreign specification which may also have authenticated alterations. The examiner should not check the certified copy of the specification of the granted patent to see whether any page or part of a page is missing or whether there is any other flaw. The examiner only compares the Australian specification with the certified foreign specification. The examiner may make the applicant aware of any seeming flaw, but should not take a formal objection under the Act.

13.6.6 United Kingdom and New Zealand

The specification must be that of the granted patent. United Kingdom and New Zealand Patent Offices publish the specification on acceptance.

For UK patents, where the certificate says that the printed specification is a copy of the specification as accepted, the Office needs a further certificate saying that no amendments were made during the period between acceptance and sealing. Otherwise, a certificate saying that the printed specification is a true copy of the specification at the time of grant is acceptable. Likewise, where the certification of a NZ patent states

“I hereby certify that annexed is a true copy of the Complete Specification as published in connection with an application for Letters Patent XXXXXX in the name of YYYY”,

a further certificate saying that no amendments were made during the period between acceptance and sealing, or that the printed specification is a true copy of the specification at the time of grant, is required.

However, from about October 2004 the certification of granted NZ patents will be changed to read

“I hereby certify that annexed is a true copy of the Complete Specification as at the date of issue of this certificate in connection with an application for Letters Patent XXXXXX in the name of YYYY.”

The certification will then go on to state the date on which the patent was granted. Provided the date of grant is before the date of certification (which would normally be the case), this form of certification is acceptable.

13.6.7 United States and Canada

A printed specification under a certificate from the United States or Canadian Patent Office saying that it is a true copy of the printed specification at the time of issue of the patent is satisfactory for modified examination. The words "at the time of issue" show that the copy is of the specification of the patent at the time of grant. However, where the certificate states that "the annexed is a true copy from the records of this office of US Patent....", this is also satisfactory.

13.6.8 European Patent

The certification may be issued by a national Patent Office of a signatory country or by the European Patent Office. Either of the following are acceptable:

- a) A certification in the form of a rubber stamp imprint on the last page of the printed copy of the specification, worded as set out below and signed by an authorized person from a national Patent Office. For example, in the United Kingdom Patent Office, the person would sign as "Acting for the Comptroller". The form of wording of the rubber stamp is as follows-

"I certify this, including the drawings forming part hereof, to be a printed copy of the specification as published at grant of the patent in accordance with Article 98 and Rule 54 of the European Patent Convention."

- b) A certification made by a certifying officer of the European Patent Office in relation to a certificate of grant:

where the certificate of grant certifies that "a European patent has been granted in respect of the invention described in the annexed patent specification for the contracting states named in the specification";

where the certificate of grant is attached by ribbon and seal to the copy of the specification in the English language; and

where certification by the certifying officer of the European Patent Office indicates that the copy provided is identical to the original certificate.

13.6.9 Certificate of Correction

Sometimes an applicant may file a certificate of correction issued by the relevant Patent Office. If the certificate amends the granted patent specification, the examiner uses the so amended specification for modified examination.

13.6.10 Defective Certified Copy

- 13.6.10.1 If the applicant alleges that the certified copy is defective in some respect, the examiner should ask the applicant to file official confirmation of the defect and its correction. The applicant may file an amending certificate, or a duly certified copy of any defective or missing page, or a fresh certified copy of the foreign specification. Meanwhile, the examiner should also report as follows:

- a) If the text and drawings (if any) of the Australian specification have not been made the same as the text of the patent specification filed with the request, the examiner should so object, or maintain an earlier objection to that effect.
- b) If the text and drawings (if any) of the Australian specification have been made the same, the examiner should reserve further opinion under sec 48.

- 13.6.10.2 Any writing between the lines, alteration, erasure or amendment (referred to generally as an alteration) made in a certified copy of the specification of the foreign patent granted must be authenticated. Handwritten alterations appearing in a printed copy of a United Kingdom specification are deemed to be sufficiently authenticated by an official Patent Office stamp appearing on each page on which an alteration appears. Where an alteration is not authenticated, the examiner is to raise the matter in a report and require official confirmation that the alteration was in fact made in the specification of the foreign patent.

13.7 COMPARISON OF THE SPECIFICATIONS

13.7.1 Title on the Patent Request to be Amended

If the title of the specification of the foreign granted patent is different from that of the complete application, the applicant must amend the title on the complete specification. There is no need to amend the title on the Request, provided that it can be established from the documents on the casefile that the Request and the complete specification relate to the one application (see para 10.4.2.1 of this volume). However, it is the title shown on the Request which will appear on both the deed and the Register.

13.7.2 Specifications Being the Same

- 13.7.2.1 The specification includes the description, the claims and the drawings. The specification which is to be compared with the foreign specification granted is the Australian complete specification. If the Australian specification has been amended before examination, the amended specification, rather than the specification as filed, is to be compared with the foreign specification. Usually, the applicant would propose amendments to the specification at the same time as requesting modified examination. In this case, the specification, as proposed to be amended, is to be compared with the foreign specification.
- 13.7.2.2 The examiner reports on the documents as proposed to be amended, and also on whether the amendments are allowable. Allowance of the amendments will take place only when, as a result of these amendments, all lawful grounds of objection have been removed. Normally, acceptance would follow immediately after allowance of the amendments. See para 22.2.7.2 of this volume for the action to be taken if the applicant makes a voluntary request for amendment during prosecution of modified examination or at the end of such examination, but before acceptance.
- 13.7.2.3 Where the texts to be compared are not the same, the applicant is required to file a statement of proposed amendments. The statement must comply with reg 10.1 and must not be simply a broad direction to "amend the existing specification to make the texts the same".
- 13.7.2.4 Reg 3.18(3)(b) specifically determines the extent to which differences may exist. These differences relate to matters of form, the omission of a claim that is made in the foreign specification, an amendment of a claim that is consequential on such an omission, an obvious mistake in the foreign specification, or, (for inventions relating to microorganisms) a difference relating to sec 6(c) of the Act.

- 13.7.2.5 In practice, examiners are to check that the claims are exactly the same (apart from matters of form). They are not required to do such detailed analysis of the description but should check that the first and last sentences of each paragraph of the description correspond with the foreign specification and that the paragraphs of the foreign specification are roughly equal in length to the paragraphs of the Australian application.

13.7.3 Matters of Form

- 13.7.3.1 "Form" relates mainly to the preambles in the Australian and foreign formats of the specifications, and to the manner in which the text is set out on the pages of the specifications.
- 13.7.3.2 In particular, the following alterations would be a change of the text and not a matter of form:
- a) corrections of errors or mistakes appearing in the patent specification, except "obvious mistakes",
 - b) changes in nomenclature, terms, units and the like,
 - c) recognition, or otherwise, of registered trade marks,
 - d) redrafting of independent claims into appendant claims, or vice versa,
 - e) alterations in the wording of omnibus claims.
- 13.7.3.3 Drawings must include the same reference numerals and represent the same views or sections. Differences in scale or cross-hatchings are matters of form.
- 13.7.3.4 The matter appearing after the text of the specification, such as the name of the applicant or his attorney may be considered as a matter of form. Similarly, descriptive matter appearing on drawings about the applicant as such or to the arrangement of drawings is a matter of form.
- 13.7.3.5 The numeric identification of other specifications in the specification under examination will be treated as a matter of form. Thus, in the Australian specification, the applicant can change a United States serial number to a patent number, even though the serial number appears in the specification of the foreign patent. References to the application being a divisional or a continuation-in-part application of another application may also be deleted.
- 13.7.3.6 Reference numerals in the claims of the foreign specification are considered to be matters of substance and should be included in the Australian specification. However, these reference numerals may generally be deleted from the claims after acceptance (see para 22.9.4.1 of this volume).

13.7.4 Omission of a Claim

- 13.7.4.1 The applicant may omit one or more of the claims of the foreign specification. Other claims may have to be amended consequential on such omission. For example, other claims may be renumbered, references to other claims may be altered, antecedents may be adjusted, and the text of the omitted claim may be inserted into its appendant claim(s). The examiner should note that only amendments in consequence of the omission of claims are allowable, and that such amendments may only be made to other claims and not to the body of the specification.
- 13.7.4.2 If some claims are deleted, and the remaining claims need to be amended in consequence of it (for example, to have the correct dependencies), it is the applicant's responsibility to propose suitable amendments. However, if the applicant does not suitably amend the remaining claims, no objection applies.
- 13.7.4.3 When some claims are deleted and others are amended in consequence of it, the texts of the relevant specifications will no longer be the same. This difference in texts, and, of course, any differences which are matters of form, should not be considered when reporting on the identity of the relevant texts.

13.7.5 Obvious Mistake

The meaning of the term "obvious mistake" is the same as that in sec 102(3) of the 1990 Act. For guidance on what may be an "obvious mistake", see para 22.10.3 of this volume. Any obvious mistakes in the foreign specification need not be carried over into the Australian complete specification.

13.7.6 Difference Arising from Section 6(c)

Section 6 states the conditions which must be fulfilled in order to satisfy the deposit requirements for micro-organisms. The differences referred to in reg 3.18(3)(b)(v) arise from sec 6(c) and relate to the name of the depository institution, date of deposit, and file or registration number. If the micro-organism deposited is the same, it does not matter if the name of the institution, date, or file number are different.

See Part 6 of this volume.

13.7.7 Abstract not a Part of the Foreign Specification

The formats of specifications of granted patents vary between countries. If a granted patent includes an abstract on a bibliographic data sheet on the front of the document (as for US patents), that abstract is not to be taken as part of the specification and the examiner should not object if the abstract is not included. However if an abstract is included in the patent document in such a way as to appear as a part of the specification, an objection should be taken if it has not been included. The latter practice follows the decision in the *Institut Français du Pétrole des Carburants et Lubrifiant's Application*, (1971) AOJP 4334.

13.7.8 Amendment must be Allowable

Any proposed amendment must be an allowable amendment, in the sense that the specification, as a result of the amendment, must not claim matter which was not in substance disclosed in the specification as filed. Any matter which was disclosed for the first time as a result of an earlier amendment cannot be taken into consideration as having been "in substance disclosed" in the specification as filed, even though that (earlier) amendment has been allowed.

13.7.9 Foreign Patent Must be for the Same Invention

The foreign patent must be directed to the same invention as the complete application. Otherwise, an amendment of the complete specification to make it the same as the foreign specification would not be allowable. Such an amendment would result in the specification claiming matter not in substance disclosed in the specification as filed.

13.8 SEARCHING THE PRIOR ART**13.8.1 Search**

A patent granted by a prescribed foreign country would have been searched and examined according to procedures similar to or in some cases stricter than our procedures. Therefore, the practice of the office is that a search is NOT to be undertaken unless the examiner considers that better citable art is likely to be found. The determination of the need to search and any search strategy should be according to the principles in part 12.9.6.

13.8.2 Publication by an act, Section 27 Notice

As in standard examination, the examiner must not have regard to information made publicly available only through doing an act anywhere in the patent area. If a notice has been filed under sec 27(1) ("matters affecting validity of standard patents"), the examiner must consider that notice when reporting on novelty and inventive step.

13.8.3 Disclosure by the Prescribed Application

If there is no Convention priority link between the applications, it may be possible that the prescribed application (or a patent granted on it) has been published before the earliest priority date of the Australian application. The examiner should check it and object if appropriate.

13.8.4 Separate Searches for Separate Inventions

Where the claims are directed to several inventions requiring separate searches, the examiner will be required to assess the novelty of, and, if appropriate, conduct a search in respect of, each invention.