



Australian Government

IP Australia

Patents of Addition

This fact sheet provides information on patents of addition and answers some commonly asked questions.

What is a patent of addition?

A patent of addition is a special type of patent which is directly associated with another patent. A patent of addition is restricted to something that is an improvement or modification of the invention in the other 'parent' patent.

While a patent of addition can be for only one improvement or modification, there is no restriction on the number of patents of addition you can have.

What is an improvement or modification?

It is any change to the invention of the parent complete application (eg. by way of variation, omission, or any other change) which secures a better or different performance while retaining the essential character of the invention.

Who can apply for a patent of addition?

You can apply for a patent of addition if you are the applicant or patentee of the parent, or if you have the consent of the applicant or patentee of the parent.

If you are applying with the consent of the applicant or patentee of the parent, they

must complete a 'statement of consent'. This is usually included in the notice of entitlement form (P/00/008) that you file with your complete application.

What are the advantages of a patent of addition?

- Patents of addition allow you to gain patent protection for improvements or modifications to your previous invention, without the risk of the patent being found invalid because the improvement or modification lacks an inventive step when compared to your previous invention.
- You pay only one set of maintenance fees because fees paid in respect of the parent patent also cover the patent of addition. This applies only after we grant both patents.

What is the term of a patent of addition?

The term of a patent of addition is the same as for the parent patent. So when the parent patent ceases so will the patent of addition.

What are the requirements?

1. A patent of addition cannot be an innovation patent, and cannot have a petty patent or an innovation patent as a parent.
2. A patent of addition cannot normally exist on its own. Hence, the following conditions apply:



Australian Government

IP Australia

- We will not examine an application for a patent of addition unless you have asked us to examine the parent application, and will not accept an application for a patent of addition unless the parent application has been accepted;
- A patent of addition cannot be granted until the parent application has been granted; and
- A patent of addition will not be accepted or granted if the parent patent has ceased, either by you failing to pay the annual maintenance fees, or by reaching the end of its term.

3. The complete specification of an application for a patent of addition must be filed on or after the date on which the parent complete application was filed.

4. You should use the IP Australia Patent Request: Standard Patent / Patent of Addition form (P/00/001). You must indicate at [61] the patent or application number of the parent.

Some Common Questions

Is the specification of a patent of addition prepared any differently to any other complete specification?

No. The complete specification and claims should be drafted in the same manner as for an ordinary complete specification. However, a useful way to draft the specification is to identify the main invention, and then describe the improvement or modification that you have made to the main invention. Also, a useful variation that is permitted is the use of a reference in the independent claims to one or more claims of the parent specification - e.g. "1. A bed sheet tensioner as claimed in any one of claims 1 to 6 of Patent No. 654321,

wherein"

I have filed a provisional application for my invention and have since made some improvements or modifications. Should I apply for a patent of addition?

Usually not. Most likely, you will want to file a further provisional application to establish a priority date for your modified invention. When you file your complete application you will generally be able to associate it with both provisionals and you will not need a patent of addition. Also, you can only file a complete application for a patent of addition after you have filed a complete application for the main invention.

In my complete specification there is a preferred embodiment that has not been claimed. Can I get a patent of addition for that preferred embodiment?

No. If something has been described in your parent patent, that thing cannot be considered as an improvement or modification of the main invention, and so you cannot get a patent of addition for it. You may be able to amend the claims of the complete specification to protect it, or file a divisional application.

If my parent application ceases before my patent of addition has been granted, does my application for a patent of addition cease as well?

No. However your application cannot continue as an application for a patent of addition, because you must have a current parent. You will need to amend the request form to make your application an ordinary application for a standard patent. This can be done when your application is examined.



Australian Government

IP Australia

If you allow your parent to cease before the patent of addition has been granted, the parent specification is not automatically excluded from the considerations of inventive step of your application.

Seek Professional Advice

This sheet provides only basic information. Patent matters can involve complex legal issues and it may be in your best interests to consult a patent attorney, solicitor experienced in intellectual property matters, or your business adviser.

For a list of IP professionals, visit the IP Australia website www.ipaustralia.gov.au or search your local Yellow Pages Directory.

Disclaimer:

This information is intended to help the reader gain a basic understanding of some IP principles. It is not designed to provide legal, business or other relevant professional advice. IP Australia recommends that you seek independent legal, business or other relevant specialist advice.

© IP Australia 2005