



Australian Government

IP Australia

# Modified Examination

## Introduction

If you have applied for a standard patent in Australia you may qualify for a special form of examination called *Modified Examination*. You must have applied for a patent for the same invention in a foreign country. The foreign country must be one of the USA, Canada, New Zealand, or a country that is a signatory of the European Patent Convention, for example the United Kingdom.

## Benefits

The primary consideration during examination is whether your Australian specification is the same as your foreign patent. This saves you duplicating some of the effort you have already put into your foreign patent.

The fee for modified examination is less than the fee for normal examination.

## Conditions

When filing a *modified examination* you must meet the following criteria:

- Your complete patent application in Australia must be for a standard patent;
- You must have been granted a patent for your invention in at least one of the countries listed above. If the patent has not yet been granted you have the opportunity to defer examination in Australia (see below);

- The foreign patent must be in English;
- The foreign patent must be for the same invention; and
- You must file a certified copy of the granted foreign patent, if requested to do so by the Commissioner, before your Australian patent application can be accepted (see below).

If the text and drawings of your complete specification are not the same as your foreign patent, you must propose amendments to make your complete specification the same as the specification of the foreign patent. However you may omit one or more of the claims of the foreign specification.

## Requesting Modified Examination

You may ask for a modified examination by completing the appropriate part of the examination request form (P/00/005), including details of your patent granted overseas.

You may withdraw the request for modified examination at any time before acceptance and instead ask for normal examination. If you ask for normal examination after modified examination has begun, a fee is payable.

## Deferment of Examination

You can ask to defer examination if:

- we have directed you to ask for (request) examination;



Australian Government

IP Australia

- you would qualify for modified examination except the foreign patent has not yet been granted; and
- you expect the foreign patent to be granted soon.

You must make the request for deferment on form P/00/014 (or equivalent), and give full details of the foreign application which is not yet a granted patent. You need to give details of only one pending foreign application. If there is one foreign application on which a patent has not yet been granted, it does not matter whether a patent has been granted on another foreign application. For example, you may ask for deferment based on a pending United States application, even though a United Kingdom patent has already been granted. Deferring examination will give you an extra period of 9 months in which you can request examination. If the foreign patent is granted in that time you can ask for modified examination. Of course, if you fail to ask for examination within the extra period, your application will lapse.

### **Certified Copy of the Granted Foreign Patent**

Recently, (1 January 2009) the **Patents Regulations** have been amended to discontinue the mandatory requirement to file a certified copy of the granted foreign patent.

Applicants will only be required to file a certified copy when requested to do so by the Commissioner.

If the Commissioner requests, the copy of the specification relating to the granted foreign patent filed by the applicant must be:

- certified by the official chief or head of the Patent Office of the prescribed foreign country that granted the patent; or

- otherwise verified to the reasonable satisfaction of the Commissioner, including;
  - a true copy of the granted patent certified by an Australian patent attorney\*;
  - a true copy of a certified copy as above, certified by an Australian patent attorney\*; or
  - a document which is stated or certified by an Australian patent attorney\* to be a copy of an officially published version of the specification of the granted patent.

*\* Certification may also be done by a foreign equivalent to a patent attorney, a justice of the peace or a notary public instead of an Australian patent attorney as indicated above.*

### **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](http://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 2009