

Patents

What is a Patent?

A patent is a temporary monopoly granted by the government to an inventor in return for disclosing the invention to the public in a patent specification. The monopoly provides the patentee with the exclusive right to exploit the invention in Australia, assuming the invention does not infringe a third party's prior patent or contravene other laws. Once the monopoly ends, the invention described in the specification becomes public property and may be freely used by anyone.

Confidentiality

It is essential that an invention is not disclosed to anyone before a patent application is filed. Early disclosure of the invention may reduce the scope of any patent eventually granted or may lead to the patent being invalid. Disclosure may take place by the spoken word, drawings, a written description, exhibition, use or sale. Some limited confidential disclosure may not be damaging, but it is best to seek advice before disclosing the invention.

Applying for Patents in Australia

The first step in obtaining a patent in Australia usually involves filing a provisional specification at the Patent Office. The provisional specification is a written description of the invention, and filing it establishes a "priority date" for the invention described. The priority date is the date at which the novelty of the invention will be assessed. The filed application will have priority over later-filed applications or published documents, and any patent eventually granted on the same invention will not be damaged by them.

After the provisional specification has been filed, the invention described may be used, provided that your patent attorney is informed of any subsequent modifications. The specification is kept secret by the Patent Office and the only information published by the

Patent Office at this stage is the title, the applicant's name, the application date and the provisional number.

A complete specification must be filed within one year of filing the provisional specification in order to maintain the priority date. The complete specification is based on the provisional specification but includes details of any modifications, developments or improvements to the invention. The complete specification includes a set of "claims" defining the scope of protection sought for the invention. The monopoly granted under the patent will be determined by the wording of the claims. Once a complete specification has been filed, no new matter may be added to the specification.

A new patent application number is given by the Patent Office at this stage. The entire specification will be published by the Patent Office 18 months after the priority date. Damages may be assessed retrospectively to the date of publication in any successful infringement action which is brought after the patent is granted.

The Patent Office usually directs examination to be requested about one to two years after the complete specification is filed. During examination a patent Examiner will conduct an international search for earlier published documents to establish whether or not the invention is novel and inventive. An official report is then issued containing details of the search and any other objections raised by the Examiner. Provided the invention is novel and inventive, objections can usually be overcome by proposing amendments to the specification, by presenting counter arguments, or both. Once any objections have been overcome, the application is accepted. Acceptance is advertised in the *Australian Official Journal of Patents* to allow interested third parties to oppose the application. If there is no opposition, or an opposition is unsuccessful, the patent is sealed and a deed of letters patent is issued. The application becomes a patent at sealing.

The maximum duration of a patent is 20 years from the filing date of the complete

specification. Fees for maintaining the application and patent in force must be paid every year starting from the fifth anniversary of the filing of the complete specification. Griffith Hack usually refers renewal matters to CPA Global which pays Australian and overseas renewal fees on behalf of our clients. CPA Global will issue you with reminders, and you will need to send them your instructions if you elect to keep your patent in force.

Overseas Protection

By virtue of an International Convention, patent applications lodged in many overseas countries within one year of the priority date in that country will be treated as if they had been lodged on the priority date, and the novelty of the invention will be judged accordingly. If you are thinking of obtaining overseas patent protection you should discuss the various options with us, as early as possible.

Patent Searching

Patents provide a vast resource of technical information which can be searched for a variety of reasons. Examples include checking that a new product does not infringe an earlier patent, determining whether an invention is new and patentable, and watching developments in a particular class of technology or a competitor's activities.

Infringement Searching

Before launching a new product it is often prudent to ensure that it will not infringe an earlier patent. This type of search can be expensive, so we suggest you discuss your particular requirements with a patent attorney before deciding to proceed with an infringement search. If you intend to trade overseas you can extend the search to include those overseas countries in which you will trade.

For more information about Griffith Hack, please visit our website:

www.griffithhack.com.au

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