

Australian Patent Re-examination

What is re-examination?

In Australia, re-examination is a means for challenging the validity of a granted patent (or certified innovation patent). Any person can request re-examination at any time after a patent is granted (or certified) by filing a request with the Patent Office.

There are a number of grounds on which a patent can be re-examined, including that:

- the claimed invention is not a patentable invention
- the claimed invention lacks novelty and/or an inventive (or innovative) step
- the claimed invention is not useful, and
- the claims are not supported by the description.

What is the process?

The first step involves the filing of a request for re-examination, which sets out the grounds on which the patent is to be re-examined, along with documents and/or evidence supporting those grounds. Upon receiving a request for re-examination, the Patent Office must re-examine the patent.

Once the patent has been re-examined, the Patent Office will issue a report. If the report is adverse to the patentee, the patentee is given two months to respond. The response may be in the form of arguments and/or amendments. The Patent Office may issue a further report once the patentee's response has been considered. Depending on whether and how the patentee is successful in overcoming the objections, the result of the re-examination will be that the patent is either maintained in its granted form or in an amended form, or is revoked in whole or in part. The patentee has the right to appeal a decision of the Patent Office to the Federal Court.

The party requesting the re-examination has no right to be involved in the re-examination proceedings once the request has been filed (the proceedings are "*ex parte*"). However, if the outcome of the re-examination is not in the requestor's favour, further requests for re-examination can be filed. The requesting party can also still seek revocation of the patent in the Federal Court. Any amendments sought to be made by the patentee during the re-examination can also be opposed before the Patent Office.

The Patent Office also has the discretion to initiate its own re-examination of the patent. This may occur if, for example, new prior art that was not considered during the original examination of the patent is subsequently identified during examination of a corresponding foreign application, or if the Patent Office identifies other relevant invalidity grounds during the re-examination.

Novelty and inventive step

To support a ground of lack of novelty and/or lack of inventive step both documents and acts can be relied on. Acts may include public displays or uses of the invention. Evidence in the form of declarations can also be submitted. Documents that have previously been cited against the Australian application during examination, as well as documents that were cited by patent offices in other countries during examination of corresponding applications, can be used.

How much does re-examination cost?

The costs involved will depend on a number of factors including the nature and extent of the submissions filed, whether any evidence is prepared and filed, and how many times re-examination is requested. However, as it is not necessary to file evidence, and due to the *ex parte* nature of the process, a re-examination will typically be less expensive than an opposition, and will be much less expensive than a revocation action before the Court.

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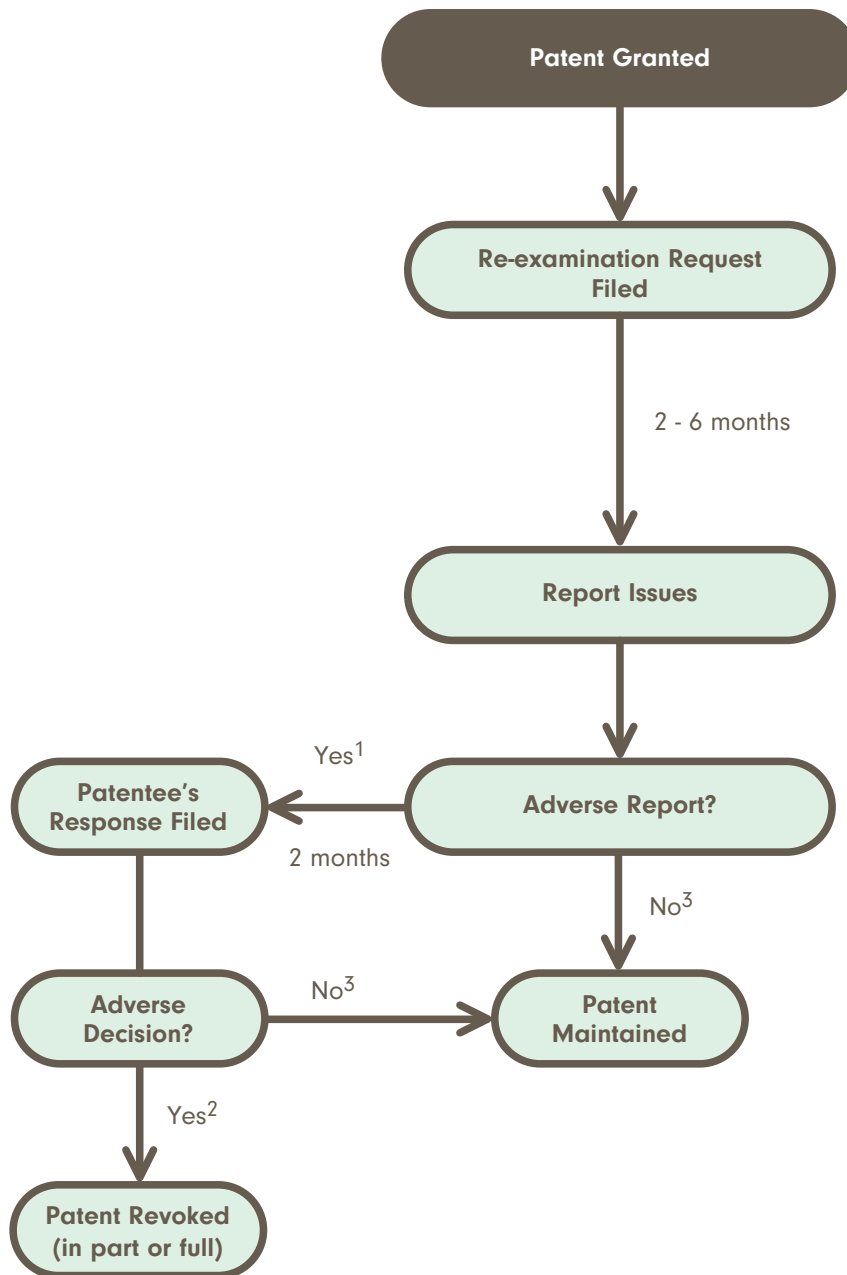
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- offering advice to develop and strengthen existing IP portfolios
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- representing clients at patent and trade mark opposition proceedings
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Australian Patent Re-examination Process



1. Any amendments made will be advertised for opposition purposes
2. Opportunity for appeal to Federal Court
3. The requestor can request re-examination again