

i) [Certain aspects of the applicable national or regional patent law](#)

<p>1. Prior Art</p>	<p>1. Information from documents made publicly available or information made publicly available through doing an act before the filing date (priority date), whether in Australia or elsewhere.</p> <p>2. For deciding whether an invention is novel, information contained in an Australian patent application (including all PCT applications designating Australia) published on or after the priority date with an earlier filing date (priority date), if the information was contained in the application at its filing date.</p>
<p>2. Novelty</p>	<p>The invention does not form part of the prior art. The prior art consists of information from documents or acts publicly available before the filing date (priority date), whether in Australia or elsewhere and information contained in an Australian patent application (including all PCT applications designating Australia) published on or after the priority date with an earlier filing date (priority date), if the information was contained in the application at its filing date.</p>
<p>3. Inventive Step (Obviousness)</p>	<p>The invention is not obvious to a person skilled in the relevant art in the light of the common general knowledge in Australia or elsewhere alone, or when combined with the prior art. The prior art consists of information from documents and acts publicly available before the filing date (priority date), whether in Australia or elsewhere, <u>and includes combinations of any 2 or more pieces of prior art that the skilled person could, before the priority date of the relevant claim, be reasonably expected to have combined.</u></p>
<p>4. Grace Period</p>	<p>1. Disclosure not to be taken into consideration in determining novelty and inventive step if it occurred:</p> <p>(a) within six months before the filing of a provisional or basic application (provided a complete application is filed within 12 months from filing of the provisional or basic application), or otherwise within 12 months before the filing of a complete application;</p> <p>(i) by showing, use or publication of the invention at a recognized exhibition;</p> <p>(ii) in a paper written by the inventor and read before, or published with the inventor's consent by or on behalf of, a learned society;</p> <p>(b) within 12 months before the filing of a provisional or basic application (provided a complete application is filed within 12 months from the filing of the provisional or basic application), or otherwise within 12 months before the filing of a complete application by working the invention in public for the purposes of reasonable trial due to the nature of the invention;</p> <p>(c) within 12 months before the filing of a complete application in Australia, where disclosure was (i) with the consent of the nominated person, patentee or predecessor in title or (ii) without consent and the information disclosed was derived from the patentee or predecessor in title;</p> <p>(d) at any time before the filing date, if the information disclosed was given by or with the consent of the patentee or predecessor in title, to the Commonwealth or a State or Territory, an authority thereof or person authorized thereby, to investigate the invention; and anything done for the purpose of such investigation.</p> <p>2. In the cases of 1.a.(i), the applicant shall:</p> <p>(a) when filing the application, state that the invention has been disclosed at the exhibition;</p>

	(b) before the publication of the application, file a statement issued by the exhibition authority.
5. Sufficiency of Disclosure	An application shall: <ol style="list-style-type: none"> 1. disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; 2. include the best method known to the applicant of performing the invention
6. Exclusions from Patentable Subject Matter	<ol style="list-style-type: none"> 1. Matter that is not a “manner of manufacture”. This generally includes: <ol style="list-style-type: none"> (a) Discoveries, abstract ideas, scientific theories and principles, mathematical algorithms without material effect (b) Aesthetic creations; (c) Schemes, rules and plans; (d) Genetic information where the information is not made; (e) Presentation of information characterized solely by its content without a material advantage; (f) Mere working directions for using an existing apparatus or process to produce an identical product; (g) Collocations or kits of known integers where is no actual or potential working interrelationship; mere admixtures of food or medicine without synergistic effect; (h) New uses of a known substance for a purpose for which the substance’s known properties make it suitable; new uses of an old contrivance without ingenuity in analogous manner and purpose to the old use; analogous uses of a known device for its ordinary purpose. 2. Applications where the only disclosed uses of the patent are illegal. 3. Matter that lacks utility due to a failure to achieve the promised benefit, or a lack of a specific, substantial and credible use. 4. Human beings and the biological processes for their generation. 5. Inventions secretly used in the patent area before the priority date of a claim by, or on behalf of, or with the authority of, the patentee or nominated person or the patentee’s or nominated person’s predecessor in title to the invention. 6. A substance that is capable of being used as food or medicine (whether for human beings or animals and whether for internal or external use) and is a mere admixture of known ingredients; or a process producing such a substance by mere admixture.
7. Exceptions and Limitations of the Rights	<ol style="list-style-type: none"> 1. Certain uses concerning foreign vessels, aircraft and land vehicles which temporarily or accidentally enter national territory. 2. Continued prior use by person who, at the filing date (priority date), was using the invention in Australia independently of the patent owner or his predecessor in title, or was taking definite steps for that purpose. 3. Acts for obtaining regulatory approval for pharmaceuticals and non-pharmaceuticals. 4. Acts for experimental purposes. 5. Compulsory licenses where necessary for the public interest or to remedy other anti-competitive practices, subject to remuneration. 6. Compulsory licenses for patented pharmaceutical products for manufacture and export to developing countries which are experiencing a public health crisis, subject to remuneration.

	7. Exploitation or acquisition by the Commonwealth, State or Territory Governments, where necessary for the proper provision of services or in the interest of national security, subject to remuneration.
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ii) National and regional laws on opposition systems and other administrative revocation and invalidation mechanisms

Opposition

Australia

There are two types of patents in Australia, the 'standard' patent and the 'innovation' patent (similar to a utility model).¹ Australia operates a pre-grant opposition system for standard patent applications.² ~~where a~~ Any person may oppose the granting of a patent by filing a Notice of Opposition within three months of acceptance of the application being advertised in the Official Journal of Patents.³ Oppositions to innovation patents can only be initiated after the patent has been granted and then certified.⁴

According to Section 59 of the Patents Act 1990 (Cth) (*'Patents Act'*), the Minister or any other person may, in accordance with the Regulations, oppose the grant of a standard patent on one or more of the following grounds, but on no other ground:⁵

- (a) that the nominated person is either:⁶ ~~is either~~
 - (i) not entitled to the grant of a patent for the invention; or
 - (ii) entitled to the grant of a patent for the invention, but only in conjunction with some other person;
- (b) that the invention is not a patentable invention;⁷

¹ It is no longer possible to file a new application for an innovation patent. However, an applicant who has filed a patent application before 26 August 2021 (the effective date of Sch 1 Pt 2 of the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2020 (Cth)*) may file an amendment to convert that application to an application for an innovation patent or use that application to file a divisional application for an innovation patent.

² There are two types of patents in Australia, the 'standard' patent and the 'innovation' patent (similar to a utility model). Oppositions to innovation patents can only be initiated after the patent has been granted and then certified. Note: although the innovation patent is being phased out, opposition to innovation patents could still occur until at least 2029. It is no longer possible to apply for an innovation patent, although existing patent applications filed prior to 26 August 2021 (the effective date of Sch 1 Pt 2 of the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2020 (Cth)*) may allow the applicant to amend an existing application or file a divisional application for an innovation patent.

³ Subsection 49(1) of the *Patents Act* provides that, subject to Section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent, if the Commissioner is satisfied, on the balance of probabilities: (a) that the specification complies with subsections 40(2) to 40(4), i.e. disclosure, clarity, support and unity; (b) that the invention satisfies the criteria mentioned in paragraphs 18(1)(a), (b) and (c), i.e. manner of manufacture, novelty, inventive step and usefulness; and (c) that the invention is a patentable invention under Subsection 18(2) (human beings, and biological processes for their generation, are not patentable inventions).

⁴ Although the innovation patent is being phased out, opposition to innovation patents could still occur until at least 2029.

⁵ Section 101M of the *Patents Act* allows for opposition under analogous grounds for certified innovation patents, with an innovative step instead of an inventive step.

⁶ The applicant is taken to be the nominated person for the grant of the patent (Regulation 3.1A), and in this context the term 'person' means a legal person and includes a body politic (e.g. Commonwealth of Australia, French Republic) and a body corporate (e.g. a company incorporated under the laws of the State of Victoria), as well as a natural person.

⁷ Under Subsection 18(1), this includes a lack of novelty or inventive step, manner of manufacture or utility.

- (c) that the specification filed in respect of the complete application does not comply with Subsection 40(2), ~~or (3)~~ or (3A).⁸

Under Section 60 of the *Patents Act*, the opposition is heard by the Commissioner who must, on the balance of probabilities, decide the case in accordance with the Regulations. The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding the case. The Commissioner may, in deciding the case, take into account any ground on which the grant of a standard patent may be opposed, whether relied upon by the opponent or not. The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this Section.

Oppositions can also arise with regard to procedural matters including:

- (a) amendments: under Subsection 104(4) of the *Patents Act*, the Minister or any other person may oppose the allowance of an amendment. Section 102 of the *Patents Act* provides that amendment of the complete specification is not allowable if, as a result of the amendment, the amended specification would claim or disclose matter that extends beyond that disclosed in the specification as filed, together with other prescribed documents (if any);
- (b) extensions of time: under Subsection 223(6) of the *Patents Act*, any person may oppose the granting of an extension of time;
- (b) extensions of term for a pharmaceutical patent: under Section 75 of the *Patents Act*, any person may oppose the grant of an extension of term under Section 70 but only on the ground that one or more of the requirements specified in Section 70 (defining what subject matter is available for extension of term) and Section 71 (relating to the form and timing of an application) are not met;
- (c) grant of a licence to exploit an invention: under Regulation 22.21(4) of the *Patents Regulations 1991 (Cth)*, a person who receives a copy of an application for a licence can oppose the granting of that licence.

⁸ Subsection 40(2) of the *Patents Act* provides that a complete specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art, disclose the best method known to the applicant of performing the invention, and end with a claim or claims defining the invention. Subsection 40(3) states that the claims or claim must be clear and succinct and supported by matter disclosed in the specification. Subsection 40(3A) states The claim or claims must not rely on references to descriptions, drawings, graphics or photographs unless absolutely necessary to define the invention.

Re-examination

Australia

Chapter 9 of the *Patents Act 1990* provides for re-examination of applications for standard patents and granted standard patents under certain circumstances. Re-examination of certified innovation patents is also provided for in Chapter 9A, under Section 101G.⁹

The grounds for re-examination are novelty, inventive (innovative) step, usefulness, manner of manufacture, disclosure, clarity, support and patentable inventions. The procedure is *ex parte*, i.e. between the Commissioner and the patentee or applicant. The person who requests re-examination has limited opportunity to submit evidence and be heard during the process.

The options for initiating re-examination depend on the stage of the patent cycle. At any time between acceptance of a standard patent application and grant of the corresponding patent, only the Commissioner can initiate re-examination. This may happen due to an adverse finding of an internal quality review, the emergence of new prior art (whether as a result of a Section 27 notice, or from other sources), or in response to a withdrawn opposition. At any time after grant of a standard patent or certification of an innovation patent, the patentee, any third party, or a court may request re-examination. The Commissioner can also initiate re-examination without an external request.

The Commissioner will instigate re-examination voluntarily only if intending to issue an adverse re-examination report. In contrast, the Commissioner must re-examine where a patentee or third party requests re-examination, regardless of whether the report is adverse or not. The applicant or patentee has the opportunity to respond to any adverse report through amendments and/or submissions and if the adverse findings are not resolved, the Commissioner has the power to refuse an application or revoke a patent.

The applicant or patentee may appeal to the Federal Court against a decision of the Commissioner, according to Subsections 100A(3), and 101(4) and 101J(5), respectively.

⁹ [Note: the innovation patent is being phased out. It is no longer possible to apply for an innovation patent, although existing patent applications filed prior to 26 August 2021 \(the effective date of Sch 1 Pt 2 of the Intellectual Property Laws Amendment \(Productivity Commission Response Part 2 and Other Measures\) Act 2020 \(Cth\)\) may allow the applicant to amend an existing application or file a divisional application for an innovation patent.](#)

iv) Compilation of laws and practices regarding the scope of client attorney privilege and its applicability to patent advisors

Australia

Summary

The client-attorney privilege accorded to patent attorneys in Australia is prescribed by statute (section 200, *Patents Act 1990 (Cth) ('Patents Act')*). It does not originate from the common law. Subsection 200(2A) of the *Patents Act 1990* provides that a record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.

Since the commencement of various provisions contained in the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* on 15 April 2013, the statutory privilege applicable to registered patent attorneys in Australia was extended to foreign IP professionals, provided that they were individuals authorised to do patents work under a law of another country or region (*Patents Act subsection-s 200(2B), Patents Act 1990*).

National aspects

Discovery procedure and how privilege protection operates against discovery

Legal professional privilege protects the confidentiality of communications that are made in connection with giving or obtaining legal advice or in the provision of legal services in relation to litigation.

Privilege mainly arises as an issue in connection with processes of discovery or disclosure in litigation or in response to subpoenas to produce documents. Privilege is claimed so that confidentiality may be retained over documents or records that would otherwise be required to be disclosed or produced.

The law governing legal privilege in Australia is a combination of the common law and Evidence Acts that apply in Federal, State and Territory jurisdictions. Broadly, the *Evidence Act 1995 (Cth)* governs privilege issues which arise in federal litigation, whereas the common law governs questions concerning privilege that arise pre-trial except to the extent otherwise provided in legislation or within a court's governing rules.

Professionals covered by the privilege and secrecy obligation

Professionals covered by legal professional privilege include an Australian lawyer, Australian registered foreign lawyer and overseas registered foreign lawyer or natural person who, under the law of a foreign country is permitted to engage in legal practice in that country (section 117, *Evidence Act 1995 (Cth)*).

An Australian lawyer means a person who is admitted to the legal profession by a Supreme Court of a State or Territory of Australia, under a law of that State or Territory.

Patent attorneys are granted patent attorney privilege by statute (section 200, *Patents Act 1990*). The Australian Patents Act restricts patent attorneys from preparing documents to be filed in court, or transacting business or conducting proceedings in court, distinguishing it from that of lawyers who may prepare documents, transact business and conduct proceedings in court.

In comparison, Australia also provides for the same privilege to trade marks attorneys as prescribed for their patent attorney counterparts. Australia's *Trade Marks Act of 1995*, as amended by the *Intellectual Property Laws Amendment Act 1998*, extends the same rights to Australian patent and trade marks attorneys (section 229, *Trade Marks Act 1995*).

In-House Patent Attorney

Privilege applies to in-house patent attorneys, provided that they meet the various requirements outlined in section 200, *Patents Act 1990*. The requirements for privilege to apply are that:

- (a) The patent attorney is registered under the *Patents Act-1990*.
- (b) The patent attorney is acting in their capacity as a patent attorney rather than in any commercial or technical capacity.
- (c) The privilege exists "in the same way, and to the same extent" as communications, records or documents made for the dominant purpose of a legal practitioner providing legal advice to a client (subsections 200(2) and 200(2A), *Patents Act-1990*).
- (d) The privilege attracts to only "intellectual property advice" as defined by subsection 200(2C), *Patents Act-1990*.

"Intellectual property advice" is defined in subsection 200(2C) *Patents Act 1990* to mean advice in relation to:

- (a) patents; or
- (b) trademarks; or
- (c) designs; or
- (d) plant breeder's rights; or
- (e) any related matters.

Scope of privilege

Confidential communications between a client and their legal adviser are privileged, whether oral or written, if the communications are made for the dominant purpose of either giving or receiving legal advice or for use in existing or anticipated litigation.

To qualify and apply privilege in relation to advice, the advice must be:

- (a) professional advice given by the legal adviser in their professional capacity as a lawyer; and
- (b) the communication must be for the dominant purpose of obtaining legal advice.

Privilege will not attach to advice that is predominantly for a different financial, personal or commercial purpose, it must be legal advice that is predominantly sought.

To qualify and apply privilege in relation to confidential communications between a legal adviser or client and a third party, in connection with litigation, the communication must also be created for the dominant purpose of use in, or in relation to litigation that is existing or reasonably anticipated.

Patent attorneys have a similar "advice" privilege to lawyers which is provided by section 200, *Patents Act-1990*. The privilege applies to:

- (a) Communications made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client (subsection 200(2), *Patents Act-1990*).
- (b) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client (subsection 200(2A), *Patents Act-1990*).

Communications, records and documents are defined to be privileged “in the same way, and to the same extent” as those “made for the dominant purpose of a legal practitioner providing legal advice to a client.”

The privilege applicable to patent attorneys is subject to certain conditions:

- (a) The patent attorney is registered under the *Patents Act-1990*.
- (b) The patent attorney is acting in their capacity as a patent attorney rather than in any commercial or technical capacity.
- (c) The privilege exists “in the same way, and to the same extent” as communications, records or documents made for the dominant purpose of a legal practitioner providing legal advice to a client (subsections 200(2) and 200(2A), *Patents Act-1990*).
- (d) The privilege attracts to only “intellectual property advice” as defined by subsection 200(2C), *Patents Act-1990*.

“Intellectual property advice” is defined in subsection 200(2C) *Patents Act-1990* to mean advice in relation to:

- (a) patents; or
- (b) trademarks; or
- (c) designs; or
- (d) plant breeder’s rights; or
- (e) any related matters.

Patent attorneys do not have a “litigation” privilege equivalent to lawyers. Subsection 200(3) *Patents Act-1990* provides that nothing in section 200 of the Act authorises a registered patent attorney to prepare a document to be issued from or filed in a court or to transact business, or conduct proceedings, in a court.

The limitations and exceptions to the privilege

Exceptions to the legal professional privilege in Australia take the form of common law exceptions or statutory exceptions. Common law exceptions include the name of the client (*Commissioner of Taxation v Coombes* (1999) 92 FCR 240), the circumstances in which allowing the claim of legal professional privilege would frustrate legal processes (*R v Bell; Ex parte Lees* (1980) 146 CLR 141-) and where communication between the lawyer and the client is for the purpose of committing a crime or fraud.

Consequences of the loss of confidentiality and penalties for disclosure

The loss of confidentiality or inadvertent disclosure of confidential information subject to the privilege means the confidentiality and also the privilege are lost. A patent attorney who discloses confidential information without authorisation may be subject to disciplinary proceedings by the Trans-Tasman IP Attorneys Board (the Board) in accordance with the *Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys 2018* (‘the Code’) under regulation 20.33 of the *Patent Regulations 1991*. The Code sets out the procedures that the Board will follow in investigating a registered patent attorney or a registered trade marks attorney and in deciding whether or not to commence disciplinary proceedings. The Board has the power to refer any patent attorney who is in breach of confidentiality for professional misconduct to the Trans-Tasman IP Attorneys Disciplinary Tribunal (the Tribunal) for a formal hearing. If the Tribunal finds the patent attorney guilty of an offence, it may cancel or suspend the attorney's registration; or impose conditions on the attorney's registration; or administer a public reprimand. If the patent attorney is also a registered trade marks

attorney, then the Tribunal may also cancel or suspend the attorney's registration as a trade marks attorney.

Requirements/qualifications for patent advisors

The registration of patent attorneys and trade marks attorneys in Australia is governed by the Board, a body established under section 227A of the *Patents Act-1990*. The Board administers the regulatory and disciplinary regimes for patent and trade marks attorneys in Australia.

To register as a patent attorney in Australia, the following conditions must be met: evidence that the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a patent attorney; evidence that the Board is satisfied that the applicant has, or is entitled to, an award of a level 5 or higher qualification under the Australian Qualifications Framework (or an overseas equivalent qualification) in a field of technology that contains potentially patentable subject matter and which involves a depth of study that the Board considers sufficient to provide an appropriate foundation for practise as a patent attorney; be able to supply one or more statements of skill made by a registered patent attorney which outline the applicant's employment experience in patent matters in Australia for a period of at least two continuous years; and be of good repute, integrity or character, and not have been convicted within the past five years of offences against patents, trade marks and designs legislation.

Cross-border aspects

Recognition of Foreign Privilege in Australia

The patent attorney privilege was not applicable to communications between clients and foreign patent attorneys who are not registered under the Australian *Patents Act-1990* until 2013. In Australia, the requirement for a "registered patent attorney" was considered by the Federal Court of Australia in *Eli Lilly & Co. v Pfizer Ireland Pharmaceuticals* (2004) 137 [FCR](#) 573 (Federal Court of Australia) ["Eli Lilly & Co"]. The privilege for communications with a registered patent attorney was confined to communications with an attorney registered in Australia. The court based its decision on the limitation of the scope of the statutory privilege to registered patent attorneys.

The *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* extended the existing client-patent attorney privilege to foreign patent attorneys which entered into force on April 15, 2013. This was achieved by expanding the definition of "patent attorney" to include an individual authorised to do patents work under the law of another country or region. No further criteria are mentioned in the Act. However, the privilege applies to the extent that the attorney is authorised to provide intellectual property advice. Consequently, communications with a foreign patent attorney relating to trade marks or other rights will be privileged only if the attorney is authorised to do that work in his home country in addition to patents work. Methodologically, the Act extends the principle of the client-patent attorney privilege to foreign advisers in IP law and not in evidentiary law.

The Intellectual Property Laws Amendment (Raising the Bar) Act 2012 revised subsection 200(2) of the *Patents Act* as follows:

- (2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client.
- (2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to same

extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.

(2B) A reference in subsection (2) or (2A) to a registered patent attorney includes a reference to an individual authorised to do patents work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided.

(2C) Intellectual property advice means advice in relation to:

- (a) patents; or
- (b) trademarks; or
- (c) designs; or
- (d) plant breeder's rights; or
- (e) any related matters.

The intention is that the privilege provision captures communications between clients and foreign IP professionals who are authorised to perform work similar to the work done by their Australian counterparts. This will include not only persons authorised under the law of a nation state, but also persons registered under an international treaty, such as Article 134 of the [European Patent Convention 1973 \(EPC\)](#), which authorises persons to do patents work before the European Patent Office.

The scope of the privilege is limited to the scope of a person's authority to perform the work in their home country or region. Further, the communication, record or document must be made for the "dominant" purpose of a patent attorney providing intellectual property advice to a client in order for the communication, record or document to attract the privilege. The definition of "intellectual property advice" in subsection 200(2) limits the scope of privilege to only those fields in which patent attorneys have specialist qualifications and knowledge.