

# Australia – response to C.9141

*(i) a draft reference document on the exception regarding the use of articles on foreign vessels, aircrafts and land vehicles. The inputs may relate to, for example, relevant court cases, challenges faced by Member States in implementing the exception and the results of the national/regional implementation.*

No input.

*(ii) a further study on the sufficiency of disclosure (Part II), relating to inventions having an experimental nature in unpredictable art, such as chemistry and biotechnology, and any other areas that deserve special attention, as proposed in document SCP/31/8 Rev.*

No input.

*(iii) a document compiling information relating to the expedited examination programs of IP offices, including information on Prioritized Examination of COVID-19 related patent applications. Any additional contributions may include, for example, objectives and qualifying grounds for expediting examination programs, institutional arrangements, fees etc. (see document SCP/33/4, Annex).*

In Australia, an applicant can request expedited examination of an application for a standard patent in the circumstances outlined below.

Currently it can take more than a year from the submission of an examination request for the examination process to begin. Accelerating the examination process potentially reduces this waiting time to between four and eight weeks. Expedited examination can be helpful if an applicant is seeking to enforce patent rights, and to inform commercial decisions.

Eligibility for expedited examination will depend on the circumstances of the case in question. The Australian Patents Regulations provides that the Commissioner may expedite examination if reasonably satisfied that:<sup>1</sup>

- it is in the public interest
- there are special circumstances that make it desirable.

Without limiting the circumstances that the Commissioner may consider justify expedited examination, reasons currently include:

- the invention is in the field of green technology

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<sup>1</sup> Patent Regulations 1991 (Cth) r 3.17.

- the applicant is a small or medium enterprise
- the claims of the invention have been found acceptable by certain patent offices under the Global Patent Prosecution Highway program, or the IP Australia-European Patent Office Patent Prosecution Highway program
- an applicant needs a granted patent in order to commercialise or license out their invention
- an applicant is concerned that their invention may be infringed and wants to commence infringement proceedings.

Unless requesting expedited examination using a Patent Prosecution Highway program, an applicant must provide reasons why an application is eligible for expedited examination.

Expedited examination can be requested at any time following the filing of the patent application and there is no additional cost associated with expedited examination.

*(iv) a compilation on how jurisdictions around the world address the issue of artificial intelligence (AI) inventorship through jurisprudence, legislation and practice. In this context, Member States and Regional Patent Offices are kindly invited to transmit inputs with regard to the general concept of inventorship, including employee inventors and joint inventors, as well as the application of that concept to inventions by AI.*

The DABUS application and the various court decisions in this matter highlight the unique challenges facing the IP system through the increased use of AI in innovation.

In April 2022, the Full Federal Court of Australia found that an AI cannot be named as an inventor on a patent application. The High Court of Australia has denied further appeal, meaning the decision of the Full Court is final. This decision overturned the previous decision by a single Judge of the Federal Court of Australia which held that an AI system can be named as an inventor in a patent application in Australia.

Australia has been exploring policy issues at the intersection of AI and IP. Accordingly, we welcome further discussions on AI and IP issues, including inventorship within SCP to build a common understanding of the issues.