

Patents

A patent gives its owner the exclusive right to commercially exploit an invention for up to 20 years, or potentially longer in relation to pharmaceuticals. You will not automatically have a patent over anything you invent. You must apply for and obtain the grant of a patent and pay for it.

Patents are administered by the Patent Office of IP Australia. The Patent Office will examine a patent application to ensure it meets the criteria for a patent and, if it does, will grant the patent. The owner then has the exclusive right to exploit the patent for a specified period if it continues to pay the maintenance fees.

Types of patents

There are two types of patents:

1. **Standard patent** - may last for up to 20 years (25 years for pharmaceuticals).
2. **Innovation patent** - may last for up to eight years.

Criteria for grant of a patent

There are four criteria that have to be met for an invention to obtain standard patent protection. The invention must:

1. **Be new** – (with limited exceptions) it cannot have been disclosed to the public anywhere in the world before the date the patent application was lodged;
2. **Involve an inventive step** - it must not be obvious to someone with knowledge and experience in the technological field of invention;
3. **Be a 'manner of manufacture'** - the invention should offer some material advantage and have a commercial application which extends beyond the fine arts or mere intellectual endeavours.
4. **Be useful** - it must achieve a useful result.

An innovation patent also differs from a standard patent in the following ways:

1. Rather than the "inventive step" requirement referred to above, an innovation patent only requires an "innovative step". There only needs to be a difference between the invention and what is currently known about that technology that makes a substantial contribution to the working of the invention; and
2. Innovation patents are usually faster, cheaper and easier to obtain than standard patents and they do not initially require the examination process to occur.



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Application stage

There are three types of applications that can be made when seeking a patent:

1. Provisional application

This type of application need only describe the invention. The purpose of this type of application is to establish the date on which your rights prevail over later patent filings, should your application be successful. This date is known as the priority date. You then have up to 12 months to assess the viability of your invention, decide which type of patent to apply for and in which countries you want to seek a patent.

2. Complete application

If the patent owner decides to pursue patent protection for their invention then some time before the 12 months is up after filing a provisional application, they can file a *complete* application for either an innovation patent or a standard patent. This type of application requires a detailed explanation and disclosure of the invention and is usually prepared by a patent attorney. Once filed, the Patent Office will then examine the application to determine whether it is a valid patent.

3. International application

This type of application allows you to apply for patents in multiple countries at once but its effect is essentially the same as filing a separate application in each country. An *international* application is still assessed in each country (when it enters the "national phase") according to their patent requirements and, if granted, applies only in that country.

Examination stage

Examination is the process whereby the Patent Office examines your complete patent application to see if it complies with the requirements of the *Patent Act 1990*. If any deficiencies exist the Patent Office will issue you a report pointing out the deficiencies in your application and allow you the opportunity to respond. You can present arguments as to why the assessment is incorrect and respond with modifications to correct the deficiencies. This report and response process may occur several times. If all deficiencies are addressed or corrected, the Patent Office will then accept the patent and your patent application will proceed to the next stage.

- **Standard patents:** you will need to request the examination of a standard patent after you have lodged your complete application for it. If you have not requested an examination of your standard patent after a certain period of time then the Patent Office will request that you seek an examination.
- **Innovation patents:** as the patentee, you may request an examination of your innovation patent at any time after you have filed your application. You cannot enforce an innovation patent against a person that you think is infringing your patent until the innovation patent has been examined for substantive compliance. Furthermore, any third party (who might have concerns about the patent) or the Commissioner of Trade Marks may request such an examination.



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Publication and sealing stage

1. Standard patents

The Patent Office will publish your standard patent 18 months from the priority date. Upon acceptance, after successful examination, the patent office will again publish your standard patent to allow people three months to oppose registration of your patent. If there is no opposition, the patent must be granted within 6 months of advertisement and will usually have effect from the date on which you lodged your application until the end of the maximum period, provided the annual maintenance fees are paid. If registration of your patent is opposed, the proceedings are dealt with before the patent registration process can advance any further.

2. Innovation Patents

Publication occurs initially upon grant of the innovation patent. While there is no formal opposition period as there is for standard patents, people who have concerns over your patent may request the patent be examined. Once examined and if certified, the innovation patent is again published.

Commercialising your invention

The application and registration of a patent is only a small part of commercialisation. It is recommended that you seek specialist advice to assist you to develop your strategy to commercialise your invention. Specialist advice may be required for the following types of issues to:

- Determine whether a patent is the most appropriate way to protect and commercialise your invention;
- Determine if you own the appropriate rights before applying for a patent and, if not, doing what is necessary to obtain those rights;
- Put in place the appropriate ownership and operational structures for commercialisation and to appropriately apportion liability and tax;
- Determine which is the most appropriate type of patent and in which countries to apply for a patent;
- Find the right patent attorney in each relevant country for your invention and manage the patent attorney during the initial searching, patent specification drafting, lodgement and prosecution of the application;
- Defend any opposition proceedings;
- Assemble your patent together with the other necessary intellectual property rights to form the package of rights that is the "product" to be commercialised (eg. the copyright in the operating manuals, the trade mark under which it is sold and the confidential information that allows optimum performance);
- Prepare and negotiate the licence, sale, manufacturing, distribution, joint venture or other relationship documentation required to generate the income stream from the product; and
- Establish strategies to maintain and enforce your patent rights against infringers.



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Further information

The following websites are useful sources of further information on patents:

- IP Australia's website www.ipaustralia.gov.au;
- The IP menu site, www.ipmenu.com includes a list with hyperlinks to subject specific patent resources (eg. chemical abstracts, rubber & plastics) and country specific resources listed alphabetically from Austria to the USA plus WIPO;
- The International Patent Classifications are at http://www.wipo.org/classifications/fulltext/new_ipc/ and
- General search engines, such as www.google.com may be useful in ascertaining whether anyone else has come up with your invention first.

These websites are intended to provide indicative information only, and searches of these sites should not be used as a replacement for conducting full and proper patent searches through a patent attorney.

The following fact sheet provides further information about these issues:

- Protect your intellectual property

