

## Proposed amendments to Australian patent law: Standard of proof required for allowance

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### In brief

- | A Bill is now before the Australian parliament that proposes to amend the Australian patent statute, thereby changing the standard of proof required to obtain acceptance (allowance) of an Australian patent application.
- | The provisions of the Bill relevant to the standard of proof may be implemented as early as early 2012.

### Current law & Patent Office practice

Presently, there are two standards of proof applied by the Australian Patent Office (the Office).

First, the Office must allow an application if 'satisfied' on the balance of probabilities that the criteria for novelty and inventive step have been met. The question is whether the Office is of the view that it is more likely than not that the relevant claim defines an invention that is novel and that contains an inventive step.

Second, the Office must allow an application unless it is 'clear' or 'appears practically certain' that a patent granted on the application would be invalid. More particularly, where the Office considers there to be doubt concerning validity on the grounds of patentable subject matter, unity of invention, fair basis, clarity, succinctness, full description and best method, the applicant is to receive the benefit of the doubt.

### Impact of proposed amendment

According to the relevant amendment, the Office is to apply the civil standard of proof to all grounds of invalidity considered during examination. Importantly, allowance may be refused if the Office is not satisfied on the balance of probabilities that the relevant invention and specification satisfy all grounds.

Given this, the key outcomes would be

- i. the standard of proof required for novelty and inventive step would not be affected by the amendment
- ii. it would be for the applicant to persuade the Office that it is more likely than not that the invention and specification satisfy grounds including patentable subject matter, enablement, support, written description, and clarity of claims.

Interestingly, the expectation of the legislature is that in practice, the proposed changes should not impose any requirement on the Office to conduct further enquiries during examination than are currently undertaken. Given this, our expectation is that if there is to be any observable difference in obtaining allowance, this will most likely be seen in second and further examination reports where the Office will exercise the balance of probabilities standard on non prior art grounds. In the circumstances, this would point to the continuing importance of building a convincing case of likelihood of validity on all grounds in response to a first examination report.

For further information on these developments, the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 can be found on the IP Australia website<sup>1</sup>.

**This article was written by Carol Burnton, Patent Scientist and Tom Gumley, Partner, Melbourne.**

### Endnotes

1. Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

## More information

For information regarding possible implications for your business, contact



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