

Proposed amendments to Australian patent law: Specifications

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The intention of the legislature is to raise the specification requirements of Australian patents to be more consistent with the standards of other major jurisdictions. This is to be realised through legislative changes which will introduce more stringent requirements for specifications.

In brief

- I A Bill to amend Australia's patent law is currently being considered, and is intended for implementation in early to mid 2012.
- I The Bill proposes a number of changes to Australian patent law, including changes to specification requirements.

Overview of proposed changes to specification

The intention of the legislature is to raise the specification requirements of Australian patents to be more consistent with the standards of other major jurisdictions. This is to be realised through legislative changes which will introduce more stringent requirements for specifications.

Description of the invention

Currently, Australian law provides that the description part of a patent specification is sufficient provided that it permits the skilled worker to produce *something* within each claim. One outcome is that multiple embodiments of an invention may be claimed provided that the description describes at least one of the claimed embodiments.

Further to this, provisional applications need not describe the invention in as much detail as the complete application. They need not 'enter into all the minute details as to the manner in which the invention is to be carried out'. There is no requirement to describe the best mode.

Under the proposed legislation, there will be a requirement that the description must enable the claimed invention to be produced across the full scope of each claim and not merely in relation to one among other embodiments. The enablement requirement will have a similar effect to the corresponding provisions of UK legislation, the European Patent Convention and the Patent Cooperation Treaty.

This requirement will also apply to provisional applications, however there will remain no requirement to describe the best mode in a provisional specification.

Introducing new matter

Under the proposed legislation, whether amendments are allowable will no longer be dependent on claim scope but rather whether the amendment changes the description contained in the specification as filed.

Currently, the invention need only be fully described at grant. For example, an applicant may file an inadequate description of the best mode of the invention, which can be subsequently remedied by amendment in order to meet the full description requirements before the date of grant. Any amendment is however subject to the requirement that, as a result of the amendment, the specification does not *claim* matter not disclosed in the specification as filed.

Under the proposed legislation, applicants will not be allowed to add new matter that would go beyond the *disclosure* contained in the specification at its filing date, except to correct a clerical error or obvious mistake.

Fair Basis

Currently, the requirement for fair basis is whether there is consistency between what the body of the specification as a whole describes and the monopoly claimed.

The proposed legislation will replace 'fair basis' with the European concept of 'support', namely:

- | there must be a basis in the description for each claim; and
- | the scope of the claim must not be broader than is justified by the extent of the description, drawings and contribution to the art.

Usefulness

Currently, the law requires that the invention as claimed achieve the promise as understood from the specification.

The proposed legislation will introduce the additional requirement that the invention has a specific, substantial and creditable use. The use will need to be set out in the specification.

Omnibus claims

Currently, any omnibus claims are permitted.

Under the proposed legislation, omnibus claims will be allowed only where strictly necessary. For example, where a chemical composition can only be described with reference to a spectroscopic profile.

For further information on these developments, the Exposure Draft of the Explanatory Memorandum for the Bill can be found on the IP Australia website.¹

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Endnotes

1. Exposure Draft of the Explanatory Memorandum for the Bill

More information

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