INFORMATION SHEET | POST AUSTRALIAN PROVISIONAL APPLICATION v220518

This information sheet is relevant to persons who have filed an Australian provisional patent application as a first application and now considering the next filing steps and provides some background information that may assist in understanding some of the basic concepts, issues and considerations.

The information sheet is not exhaustive in any sense and is no substitute for specific advice relevant to a person's circumstances and requirements.

We trust you find this information sheet helpful however if anything is unclear please let us know.

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COMPLETE APPLICATIONS | THE 'FURTHER APPLICATIONS'

This information sheet is relevant to patent applicants who have an existing Australian provisional patent application in place (a 'provisional application'). In the case of applicants who have more than one provisional application for the same invention a reference to 'the provisional application' in this information sheet will be a reference to the earliest filed provisional application.

As you may be aware Australian provisional applications lapse as a matter of course 12 months after the official filing date of the relevant application.

Therefore a complete patent application including a patent specification with claims and formal drawings must be lodged in relation to each convention country (most of the notable countries in the world) including Australia where patent protection is required ('the further applications') before the provisional application lapses to claim the benefit of the priority date established by the provisional application.

Subject to the countries of interest an applicant may have a choice on when, where and how these further applications are lodged.

NATIONAL | REGIONAL | INTERNATIONAL PATENT APPLICATIONS

The types of further patent applications that are available include:

1. national patent applications,
2. regional patent applications (for example a European Patent application) ,
3. international patent application (ie a Patent Cooperation Treaty Patent Application) or
4. a combination of the applications in 1 to 3.

We will briefly describe each of these in turn later on.

PATENT SPECIFICATION | CLAIMS | FORMAL DRAWINGS

A complete patent specification must be prepared to accompany these further applications and is based on the provisional patent specification (the 'provisional specification') previously lodged with the provisional application and can include changes, improvements or additions to the invention that have evolved since the provisional application was lodged. In the case of the applicant having more than one provisional patent application then all the information in the corresponding provisional specifications are consolidated into the one complete specification.

The complete patent specification must include a set of claims which we prepare to define the legal scope of the protection sought in the application. If formal drawings have not already been prepared they will be required to be lodged with each application. The one complete specification can be used as a basis for all the required further applications with some adaptations on a country by country basis to meet the practice or requirements of the relevant country.

COMPLETE SPECIFICATION | COSTS

The cost to draft a complete specification with claims starts from $3000 but can be significantly more.

The actual cost is contingent on several factors. If we have previously prepared a corresponding provisional specification then this will help mitigate the costs at this stage particularly if there has been no development or changes to the invention since the provisional specification was drafted. Otherwise the costs are contingent on factors such as the technology involved, the nature of the invention itself, the amount and nature and quality of information that is provided to us about the invention and prior art as a starting point, and how much material we have to ascertain ourselves based on incomplete or limited or unclear descriptive information provided to us.

Another cost variable at this stage is the cost of preparing formal drawings if required to accompany the

complete patent specification. If formal drawings already have been prepared in a corresponding earlier application and can be readily adapted for use in the complete application then this can mitigate drawing costs. Otherwise drawing costs will be contingent on several factors including the nature and quality and detail of drawings provided to us by the inventor and whether we have to develop and author original drawings consistent with the structure of the patent specification and the inventors own drawings.

Drawing costs typically start from about $450 however can be significantly more and varies on a case-by-case basis.

Another cost variable at this stage is attendances and consultations in the matter that you may require or be required to clarify, help formulate information about the invention.

Additional costs may be incurred later in adapting the Australian complete specification and claims in accordance with local requirements of foreign countries in which patent applications are to be filed.

NATIONAL PATENT APPLICATIONS | COSTS

National applications are available in relation to most countries and are lodged with the patent office of each relevant country.

The cost to prepare and lodge national applications once the Australian complete specification has been prepared will vary on a country by country basis but typically starts from $3000 but can vary significantly to over $8000 in some countries/regions. As you may appreciate, national language, national filing and legal requirements and foreign exchange rates, and the cost of doing business generally in a foreign country on a country by country basis contribute to the relatively wide variations in application costs. Specific estimates of costs from foreign countries can be prepared on request.

Other costs on a per application basis may be incurred in attending to national formality requirements, examination matters, and third party opposition procedures, and to grant or issue of the patent. These other costs generally are progressively incurred over one to three or more years following the time the relevant application is lodged and typically can be of the same order of costs as the initial application costs in a straight forward case where the application is not opposed by a third party. Therefore an allowance of an amount at least equivalent to the application costs should be set aside in the budget to meet these other costs.

If an opposition to the national application arises then the matters raised in the opposition will have to be successfully attended to before a patent can be granted incurring additional costs, however in our experience only a small percentage of applications are ever opposed by third parties, and even less so successfully.

Other frequently incurred costs relate to the maintenance/renewal fees required for the duration of the application or granted patent to keep the application or patent in force. These fees may be as frequently as an annual basis in some countries such as in Australia or less frequently in other countries. Generally the maintenance/renewal fees progressively increase over the life of the application/patent. Therefore an allowance should be set aside in the budget to meet these progressively increasing maintenance/renewal fees.

REGIONAL APPLICATIONS

In countries which belong to a multi country regional patent system, these further applications can be lodged by way of a single patent application (a ‘regional application’) directly with the relevant regional patent office designating each eligible regional member country of interest.

The four types of regional patent systems presently exist and they are:

1. the European Patent Convention (EPC) that covers up to at least 38 European countries by way of a single European patent application (a list of countries covered by a European patent is provided in schedule 1 herein for your perusal);
2. the Eurasian Patent Convention (EAPC) that covers at least 9 countries former USSR republics by way of a single Eurasian patent application;
3. the African Regional Industrial Property Organization (ARIPO) regional patent system which covers at

least 16 African countries by way of a single ARIPO patent application; and

4. the Organisation Africaine de la Proprie Intellectuelle (OAPI) regional patent system that covers at least 17 African countries by way of a single OAPI patent application.

A list of countries party to each of the four above referenced regional patents can be found in the annexure entitled PCT states.

EUROPEAN PATENT APPLICATION

The most notable regional patent application is the European patent application.

SINGLE APPLICATION TO GRANT PROCEDURE
The European patent procedure provides for a single patent application and patent specification with claims, a single examination, opposition and grant procedure (which can all be in English), followed by a national validation procedure of the granted European patent in each country of continued interest where a national patent is granted.

NATIONAL VALIDATION
The national validation procedure before each European country is more of a formalities procedure including the payment of national validation fees and may require the lodgement of a translated version of the claims in the European patent into the relevant national language. Once a European patent is validated in a country it is then subject to the normal national maintenance/renewal fees required for the duration of the patent to keep the patent in force in the relevant country.

COSTS
A European patent application will typically cost in the order of a minimum of $15000 to $20000. Examination of the application can add another $3000 to $6000 or more, and when the application is allowed further costs will be incurred to validate the European patent on a national level in each country of continued interest.

These national validation costs include costs in translating the specification and claims of the granted European patent into the each relevant national language if required and can amount to the order of $3000 or more per non English country.

EXAMINATION STANDARD
A point of note of pursing a European patent is that a European application will be examined according to the standards of the European patent system, which may have a higher threshold of patentability compared to some of the national thresholds in its member countries. Therefore an applicant may miss out on obtaining a national patent in some countries if the European application is refused in circumstances where it may have otherwise obtained a national patent if it pursued a national application in the first instance rather than a European application.

OPPOSITION
Another point of note is that an opponent may oppose the European application in a single opposition procedure rather than having to oppose the corresponding national applications in multiple countries.

FILING STRATEGY
However it is a common filing strategy to pursue a European patent rather than multiple national European applications when protection is required in several countries because of the advantages of the single application/grant procedure in the regional European application generally outweighs any drawbacks that may potentially exist in the in the European patent system.

INTERNATIONAL APPLICATION | PATENT COOPERATION TREATY | PCT

In countries which belong to the Patent Cooperation Treaty (PCT) international patent system (at least 148 countries including Australia), these further applications can be lodged by a single patent application filed in the Australian patent office commonly referred to as a ‘PCT application’ or an ‘international patent application’.

PCT COUNTRIES | REGIONS
A list of countries that are covered by a PCT application is provided in Schedule 2 of this annexure and we bring to your particular attention that not all countries are within the PCT application system. For example one such notable country is Taiwan.

Additionally we point out that all the four previous mentioned regional patent application systems (EPC, EURASIA, ARIPO, OAPI) are included in the PCT application system and consequently the regional patent applications need not be lodged separately from the PCT application.

INTERNATIONAL PHASE | PCT APPLICATION
When the PCT application is first lodged it remains in its 'international phase' which expires generally no later than about 18 months after the PCT application is lodged, and before the international phase expires the PCT application must be converted into a national or regional application in each country/region of continued interest by 'entering the national/regional phase' of the PCT application.

INTERNATIONAL PHASE | DURATION
The actual time limit to enter national/regional phase once a PCT application is strictly referable to the priority date of the PCT application which can be up to 12 months before the actual filing date of the PCT application itself, and the strict time limit to enter national/regional phase generally is up to 30 months from the priority date, leaving about 18 months after the PCT application is lodged if priority is claimed from an earlier patent application such as an Australian provisional patent application.

NATIONAL PHASE | REGIONAL PHASE
The effect of entering the national/regional phase is to effectively convert the international application into a national/regional patent application before each national/regional patent office of the relevant country or region.

From then on the national or regional application is subject to and prosecuted in accordance with the national/regional laws of the relevant country/region including being subject to the full examination procedures and other processes that apply in the country or region.

NATIONAL PHASE | REGIONAL PHASE | ENTRY REQUIREMENTS
To enter national or regional phase in a country or region a formal request with a fee must be lodged with each relevant national/regional patent office and each patent office may have additional requirements such as the need to lodge a translation of the patent specification and claims and other documents into the relevant national language of the instant country/region.

NATIONAL PHASE | REGIONAL PHASE | COST EQUIVALENCE
The costs to enter national/regional phase in each country or region is generally the same as the costs in preparing and lodging a national/regional application in the first instance and therefore the previous cost estimates and considerations provided for lodging national and regional patent applications will equally apply to applications lodged by way of national/regional phase entry of a PCT.

However in pursuing the PCT application route rather than filing national/regional applications in the first instance provides a cash flow advantage in that the national/regional phase entry commitment and the associated application costs in meeting all the national/regional filing requirements effectively can be deferred up to 18 months after the PCT application is lodged consequently giving the applicant that 18 months to asses which of the PCT countries/regions are of continued commercial interest.

INTERNATIONAL SEARCH REPORT (ISR) | INTERNATIONAL SEARCH OPINION (ISO)
The PCT application procedure during the international phase includes a potentially valuable international prior art search and a first examination opinion on the on the patentability of the invention in the PCT application as part of the application process and fees.

The results of the search in the form of an ISR and ISO which typically is available within 2 to 4 months after the PCT application is lodged, provides the applicant a relatively early preview of potentially problematic prior art and an opportunity to reassess the application in light of the ISR and ISO while the application remains in the international phase as a single application.

INTERNATIONAL PRELIMINARY EXAMINATION (IPE)
The PCT application procedure also provides an optional international preliminary examination (IPE)

procedure in the application during which the applicant has an opportunity to lodge submissions and or amendments to the application to overcome any adverse objections in the ISO with the view to obtain a clear or favourable international preliminary examination report (IPER) by the end of the international phase as the IPER ultimately is made available for public viewing.

If the applicant does not take the IPE option then the ISO becomes the IPER that is published.

While the IPER is not binding in any way it includes an examiners opinion on the patentability of the invention and if it contains adverse objections this can be problematic later during the national/regional phase examination as the same adverse objections generally will be raised during national/regional examination at which time they must be successfully overcome before the national/regional application can proceed to acceptance and or grant.

Therefore a clear IPER is strongly recommended to avoid having to deal with any adverse objections in the IPER on multiple fronts during national/regional phase and incurring associated multiple costs.

Requesting IPE also can have an additional cost efficiencies advantage in that it provides an opportunity to include voluntary amendments to the application before the application proceeds to national/regional phase and avoid having to implement those voluntary amendments on multiple fronts during national/regional phase and incurring associated multiple costs.

Requesting IPE also has another fortuitous advantage in some countries in that the deadline to enter national phase in those countries is 30 months after the priority date of the PCT application only if IPE is requested otherwise it is generally 20 months after the priority date.

For all these reasons requesting IPE is strongly recommended as matter of prudent practice even though it is an optional procedure.

COSTS | PCT APPLICATION
The costs to prepare and lodge an international patent application with a claim to priority in relation to all available PCT countries will typically cost in the order of about $8000 - $9000 or more once the PCT specification, claims and formal drawings have been prepared. This amount includes an allowance for official fees, our fees and for our disbursements and our costs to obtain one certified copy of an Australian priority document, but does not include an allowance for drafting the specification and claims, drawings, consultations or conferences and we refer you to the previous estimates under the heading ‘costs – complete specification’.

COSTS | ISR | ISO
Shortly after lodgement and typically within about 3 months of lodging the PCT application a further cost of about a minimum $2000 to $3000 will be incurred in attending to receiving and reporting the results of the international search report and the international search opinion. This amount includes a small amount of professional time to attend to these matters, and for official fees, our fees and for our disbursements. If copies of prior art documents cited in the report have to be obtained then additional costs will be incurred in obtaining and forwarding these documents.

COSTS | IPE
A voluntary request for International preliminary examination of the application can add at least another $3000 to $4000 or more. Most of these costs are incurred at the time of requesting examination strictly within 22 months of the priority date or typically within 10 months of lodging the PCT application, however the costs can increase significantly as they are subject to the nature and number of prior art citations and adverse objections in the ISR and ISO that have to be dealt with a and overcome.

COSTS | VOLUNTARY AMENDMENTS
However if any amendments are required during the international phase pursuant to the ISR or an adverse ISO then that will typically incur about $1000 per round of amendments however these costs are subject to the nature and extent of amendments required.

COSTS | NATIONAL PHASE ENTRY | REGIONAL PHASE ENTRY
The next round of cost relate to the costs associated with entering national or regional phase and these costs are comparable to the costs in lodging a national or regional application in the first instance given previously in this annexure.

COSTS | NATIONAL PHASE DURATION | REGIONAL PHASE DURATION
Of course the other costs in attending to the national or regional phase of the international application through to grant are the same costs that would be incurred in attending to the comparable national or regional application through to grant.

GST

All amounts provided herein unless otherwise stated are exclusive of goods and services tax (GST) liability. Therefore an allowance for any GST liability that may apply should also be made as this tax will be added to our charges to you.

GENERAL COMMENTS

The information and costs provided herein is intended to be a guide only and is subject to change with time and is not offered as being applicable to your matter but is offered as mere background information that may be relevant to your matter.

Additionally there are different filing strategies available each having different timing and costs implications that may be better suited to a client's specific circumstances or requirements.

However the filing strategy described herein is a common strategy adopted by those initiating the patent application process from Australia. Therefore if you have any questions or you require assistance specific to your matter then please let us know.

INFORMATION WE REQUIRE TO PREPARE A PATENT APPLICATION AND SPECIFICATION

To assist in the preparation of a patent specification and application and to minimise costs please provide the information requested in Schedule 3 herein.

SCHEDULE 1 | EUROPEAN REGIONAL PATENT CONTRACTING STATES

A list of countries party to European regional patent as of 1 March 2018 follows.

A current list can obtained from this web link | EPC CONTACTING STATES |.

States for which only a EPO regional patent can be obtained otherwise national patent is not available	States for which a EPO regional patent can be obtained in addition to, or instead of a national patent	States not included in EP designation but to which a European patent can be extended
1. BE Belgium	1. AL Albania	1. BA Bosnia and Herzegovina
2. CY Cyprus	2. AT Austria	2. KH Cambodia
3. FR France	3. BG Bulgaria	3. ME Montenegro
4. GR Greece	4. CH Switzerland	4. MA Morocco
5. IE Ireland	5. CZ Czech Republic	5. MD Republic of Moldova
6. IT Italy	6. DE Germany	6. TN Tunisia
7. LT Lithuania	7. DK Denmark	
8. LV Latvia	8. EE Estonia	
9. MC Monaco	9. ES Spain	
10. MT Malta	10. FI Finland	
11. NL Netherlands	11. GB United Kingdom	
12. SI Slovenia	12. HR Croatia	
	13. HU Hungary	
	14. IS Iceland	
	15. LI Liechtenstein	
	16. LU Luxembourg	
	17. MK The former Yugoslav Republic of Macedonia	
	18. NO Norway	
	19. PL Poland	
	20. PT Portugal	
	21. RO Romania	
	22. RS Serbia	
	23. SE Sweden	
	24. SK Slovakia	
	25. SM San Marino	
	26. TR Turkey	

SCHEDULE 2 | PCT COUNTRIES

A current list of countries party to PCT can be found by following this link | PCT CONTRACTING STATES |

PCT COUNTRIES & REGIONS AS OF 9 MARCH 2017 | 152 COUNTRIES

1. United Arab Emirates
2. Antigua and Barbuda
3. Albania
4. Armenia2
5. Angola
6. Austria
7. Australia
8. Azerbaijan
9. Bosnia and Herzegovina
10. Barbados
11. Belgium
12. Burkina Faso
13. Bulgaria
14. Bahrain2
15. Benin
16. Brunei Darussalam
17. Brazil
18. Botswana
19. Belarus2
20. Belize
21. Canada
22. Central African Republic
23. Congo
24. Switzerland
25. Côte d'Ivoire
26. Chile2
27. Cameroon
28. China3, 4
29. Colombia
30. Costa Rica
31. Cuba2
32. Cyprus
33. Czechia
34. Germany
35. Djibouti
36. Denmark
37. Dominica
38. Dominican Republic
39. Algeria2
40. Ecuador
41. Estonia
42. Egypt
43. Spain
44. Finland5
45. France2, 6
46. Gabon
47. United Kingdom7
48. Grenada
49. Georgia2
50. Ghana
51. Gambia
52. Guinea
53. Equatorial Guinea
54. Greece
55. Guatemala
56. Guinea-Bissau
57. Honduras
58. Croatia
59. Hungary2
60. Indonesia2
61. Ireland
62. Israel
63. India2
64. Iran (Islamic Republic of)
65. Iceland
66. Italy
67. Jordan
68. Japan
69. Kenya
70. Kyrgyzstan2
71. Cambodia
72. Comoros
73. Saint Kitts and Nevis
74. Democratic People's Republic of Korea
75. Republic of Korea
76. Kuwait
77. Kazakhstan2
78. Lao People's Democratic Republic2
79. Saint Lucia2
80. Liechtenstein
81. Sri Lanka
82. Liberia
83. Lesotho
84. Lithuania
85. Luxembourg
86. Latvia
87. Libya
88. Morocco
89. Monaco
90. Republic of Moldova2
91. Montenegro
92. Madagascar
93. The former Yugoslav Republic of Macedonia
94. Mali
95. Mongolia
96. Mauritania
97. Malta2
98. Malawi
99. Mexico
100. Malaysia2
101. Mozambique2
102. Namibia
103. Niger
104. Nigeria
105. Nicaragua
106. Netherlands8
107. Norway5
108. New Zealand
109. Oman2
110. Panama
111. Peru
112. Papua New Guinea
113. Philippines
114. Poland5
115. Portugal
116. Qatar 2
117. Romania2
118. Serbia9
119. Russian Federation2
120. Rwanda
121. Saudi Arabia
122. Seychelles
123. Sudan
124. Sweden5
125. Singapore
126. Slovenia
127. Slovakia
128. Sierra Leone
129. San Marino
130. Senegal
131. Sao Tome and Principe
132. El Salvador
133. Syrian Arab Republic
134. Swaziland
135. Chad
136. Togo
137. Thailand2
138. Tajikistan2
139. Turkmenistan2
140. Tunisia2
141. Turkey
142. Trinidad and Tobago
143. United Republic of Tanzania
144. Ukraine2
145. Uganda
146. United States of America11, 12
147. Uzbekistan2
148. Saint Vincent and the Grenadines2
149. Viet Nam
150. South Africa2
151. Zambia
152. Zimbabwe

SCHEDULE 3 | INFORMATION REQUIRED TO PREPARE A PATENT APPLICATION

Applicants details
The full legal name and address of each person, company or other legal entity in whose name the application is to be made. Please provide the ACN, or the ARBN, if relevant for any company that is an applicant.

Owners details
The full name and address of each person, company or other legal entity who owns the invention. Please provide the ACN, or the ARBN for any company that is an owner. Usually the applicant is the owner of the invention. In the case of more than one owner, the proportion of ownership of each owner.

Inventors Details
The full name and address of each person who contributed to the invention. The inventors can only be people.

Basis of entitlement to ownership
If any of the owners of the invention are not one of the inventors please tell us the basis these owners have ownership by selecting one (or more) of the following:

1. Was the inventor an employee of the owner and the invention was created for the employer during the ordinary course of employment?
2. Did the inventor create the invention for the owner pursuant to an order, agreement or contract for money or something else? If yes, please specify details.
3. Did the owner buy the invention and all rights to the invention from the inventor pursuant to an assignment or contract? If yes, please specify details.
4. Did the owner acquire the invention and all rights to the invention from the inventor pursuant to some other entitlement or devolution in law? If yes, please specify details.

Evidence of entitlement to ownership
If any of the owners of the invention is not one of the inventors then has the entitlement to ownership been formalised in writing by an effective written assignment? Please specify yes/no/not sure.

Invention details
Please answer the following questions as best you can and while some of the information may be self-evident from the information we may have your perspective will be of assistance:

1. Why was the invention developed?
2. Is the invention a product/device or a method/process?
3. What prior art is the most similar to the invention? Please provide any references or pictures/drawings or any other information that you may have about the prior art.
4. Does the invention overcome specific problems with or in the prior art? If so what problem(s) does it overcome and what features in the invention provide that/those advantage(s)?
5. Does the invention provide other advantages over the prior art? If so, what feature(s) in the invention provide those other advantages?
6. In a sentence describe the technical field the invention belongs to? For example ‘the invention relates to a new method of making plastic pipes’ or ‘the invention relates to a paint additive to help the paint dry quicker when applied to a surface’.
7. Is the invention fully developed or some further development needs to be completed? If so please specify what you are further developing in your invention.

Other information required
Please provide a full description of how the invention works and is used including simple drawings which may help us understand. If the description includes terms of the art please provide a brief explanation of the terms/jargon.

A set of good quality unmarked drawings without borders, titles or dimensions or any text presented on A4 paper should also be included with the description, and an electronic copy for reproduction or further manipulation may also help.