

## STANDARD PATENT APPLICATIONS · AUSTRALIA · NEW ZEALAND · V260517

Please find following an information sheet for patent applications in Australia and New Zealand.

The information sheet is not exhaustive in any sense but covers common items during filing and we trust you find this information sheet helpful however if anything is unclear please let us know.

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### REQUIREMENTS TO COMPLETE NATIONAL FILING OR NATIONAL ENTRY

#### SCHEDULE 1 - FILING REQUIREMENTS

## PROCEDURE FROM NATIONAL FILING/ NATIONAL ENTRY TO GRANT

### 1. NATIONAL FILING AND NATIONAL ENTRY TIME LIMITS

The time limit to file an application under the Paris Convention or enter national phase of a PCT application in Australia and New Zealand under Chapter I or Chapter II is as follows.

#### AUSTRALIA

#### NEW ZEALAND

TYPE OF NATIONAL FILING	MONTHS FROM EARLIEST PRIORITY DATE	TYPE OF NATIONAL FILING	MONTHS FROM EARLIEST PRIORITY DATE
Paris Convention	12	Paris Convention	12
PCT Chapter I	31	PCT Chapter I	31
PCT Chapter II	31	PCT Chapter II	31

### 2. NATIONAL FILING AND NATIONAL ENTRY REQUIREMENTS

The national filing and national entry requirements are set out in schedule 1.

### 3. EXAMINATION

Australian and New Zealand patent applications including those by way of PCT national entry are subject to a national substantive examination procedure.

#### AUSTRALIA

##### *exam request*

Examination is only conducted after a request for examination has been made and an examination fee is paid

##### *time limits*

Examination must be requested within 2 months of being officially directed to do so by the patent office and in any event must be requested within 5 years of the patent application filing date

##### *administrative delays*

An examination direction typically may issue within 8 to 14 months or more after national filing or entering national phase if examination is not requested beforehand

Once examination is requested it may take at least 3 to 6 months or more before the next official action issues such as an examination report or a notice of acceptance

#### NEW ZEALAND

##### *exam request*

Examination is only conducted after a request for examination has been made and an examination fee is paid

##### *time limits*

Examination must be requested within 2 months of being officially directed to do so by the patent office and in any event must be requested within 5 years of the patent application filing date

##### *administrative delays*

An examination direction typically may issue within 8 to 14 months or more after national filing or entering national phase if examination is not requested beforehand

Once examination is requested it may take at least 3 to 6 months or more before the next official action issues such as an examination report or a notice of acceptance

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### *expedited examination*

Examination maybe accelerated under certain circumstances

### *expedited examination*

Examination maybe accelerated under certain circumstances

### *modified exam*

Modified examination can no longer be requested after 15 April 2013

## 4. PUBLICATION

### **AUSTRALIA**

A patent application is made available to the public as a matter of course about 18 months after its priority date

### **NEW ZEALAND**

A patent application is made available to the public as a matter of course about 18 months after its priority date

## 5. NOTICE OF ENTITLEMENT

### **AUSTRALIA**

#### *notice of entitlement*

A notice of entitlement must be lodged with the patent office that sets out the basis of how the person nominated for the grant of the patent acquired or is entitled to the rights of the invention and corresponding claim to priority if applicable.

### **NEW ZEALAND**

#### *notice of entitlement*

A notice of entitlement must be lodged with the patent office that sets out the basis of how the person nominated for the grant of the patent acquired or is entitled to the rights of the invention and corresponding claim to priority if applicable.

#### *time limit*

All requests for examination of standard patents filed from 23 March 2013 must include a statement of entitlement to grant and if applicable to claim priority.

#### *time limit*

The notice of entitlement must be lodged before the patent application will be accepted for sealing or grant.

#### *notice of entitlement requirements*

The requirements are set out in the filing requirements section herein.

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The requirements are set out in the filing requirements section herein.

## 6. PROSECUTION & ACCEPTANCE

Once examination is commenced if the application is in order a notice of acceptance will issue indicating favourable completion of examination and all filing formalities are complete.

If an adverse examination report issues during examination this will establish an acceptance time limit by which time the application must be placed in order for acceptance otherwise the application will lapse.

### **AUSTRALIA**

#### *acceptance time limit*

The acceptance time limit is 12 months from the date of the first adverse examination report

### **NEW ZEALAND**

#### *acceptance time limit*

The acceptance time limit is 12 months from the date of the first adverse examination report

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### *administrative delays*

In practice a final response should be lodged no later than 8 months from the date of the first adverse examination report to allow the patent office time to consider the response before the application lapses by default due to the expiry of the acceptance time limit

### *administrative delays*

In practice a final response should be lodged no later than 8 months from the date of the first adverse examination report to allow the patent office time to consider the response before the application lapses by default due to the expiry of the acceptance time limit

As matter of prudent practice the notice of entitlement or the declaration of inventorship should not be filed with the relevant patent office in order to force at least one adverse examination report to issue before acceptance to provide the applicant an opportunity to make voluntary amendments to the application before acceptance in light of relevant prior art identified in corresponding foreign applications or for any other reason.

## 7. OPPOSITION & SEALING

Once the application is accepted it will then be made open to third parties for opposition.

The opposition period is three months from the date the official notice of acceptance is advertised. If the application is timely opposed this must be successfully and favourably resolved before the patent can be sealed and issue.

If the accepted application remains unopposed by the end of the opposition period it is then eligible to be granted and the patent sealed and issued.

### **AUSTRALIA**

#### *acceptance fee*

If the accepted application in Australia remains unopposed by the end of the opposition period it is then eligible to be granted and the patent sealed on the payment of an official acceptance fee

### **NEW ZEALAND**

#### *acceptance fee*

A patent in New Zealand will be granted and issue automatically at the end of the opposition period if the accepted application remains unopposed as no official acceptance fee is payable

The official acceptance fee is contingent on the number of claims in the accepted application and the minimum fee includes the first 20 claims. An excess claim fees apply to claims in excess of 20

#### *Re-examination*

Re examination procedures are available after acceptance and after grant.

Re examination after acceptance and before grant can only be initiated by the patent office at its discretion.

Re examination after grant may be initiated by the patent office, by the applicant or a third party.

#### *Re-examination*

Re examination procedures are available after acceptance and after grant.

Re examination after acceptance or after grant may be initiated by the patent office, by the applicant or a third party.

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If an adverse examination report issues grant will not occur or may be revoked while objections remain unresolved by submissions and or amendment and or by a hearing.

If an adverse examination report issues grant will not occur or may be revoked while objections remain unresolved by submissions and or amendment and or by a hearing.

Typically a patent deed will be sealed and issue within 2 to 3 months after the end of the relevant opposition period if the application remains unopposed and any applicable acceptance fees are timely paid.

### 8. VOLUNTARY AMENDMENTS

#### AUSTRALIA

##### *allowable amendments before acceptance*

Allowable voluntary amendments before acceptance include corrections of clerical errors and obvious mistakes and amendments that do not result in the broadening of the description and/or claims by the incorporation of new matter (beyond the disclosure of the application, as filed)

Voluntary amendments may also be lodged after acceptance but the scope of allowable amendments is restricted to the correction of clerical errors and obvious mistakes and such amendments that do not result in the claiming of new matter (beyond the disclosure of the international application as filed) and do not broaden the scope of the claims existing before the amendments

##### *amendment fees*

Voluntary amendments filed before examination is requested or after the patent application is accepted must be accompanied by official fees

##### *National law & practice amendments*

It would be prudent that a foreign prepared specification and claim set is reviewed to recommend voluntary amendments if required in light of Australian law and practice

In the case of a convention application if these voluntary amendments are incorporated into the specification and claims at the time of filing the national application then no official amendment fees are incurred otherwise if filed before examination is requested or after acceptance

#### NEW ZEALAND

##### *allowable amendments before acceptance*

Allowable voluntary amendments before acceptance include corrections of clerical errors and obvious mistakes and amendments that do not result in the broadening of the description and/or claims by the incorporation of new matter (beyond the disclosure of the application as filed)

Voluntary amendments may also be lodged after acceptance but the nature of allowable amendments is restricted to amendments to correct clerical errors and obvious mistakes only by way of disclaimer, correction or explanation, and no other amendment is allowed, except for the purpose of correcting an obvious mistake, the effect of which would be that the application as amended would claim or describe matter not disclosed in substance in the application before amendment, or that any amended claim would not fall wholly within the scope of a claim of the application before amendment

##### *amendment fees*

Voluntary amendments filed before and after acceptance must be accompanied by official fees

##### *National law & practice amendments*

It would be prudent that a foreign prepared specification and claim set is reviewed as early as possible and voluntary amendments are made and filed as required in light of New Zealand law and practice

In the case of a convention application if these voluntary amendments are incorporated into the specification and claims at the time of filing the national application then no official amendment fees are incurred otherwise if filed at any other time then official amendment fees are incurred

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occurs then official amendment fees are incurred in the case of a national entry application these voluntary amendments will incur official amendment fees if they are filed before examination is requested or after acceptance occurs

in the case of a national entry application these voluntary amendments will incur official amendment fees at the time of filing

### 9. CONTINUATION / RENEWAL FEES

National continuation / renewal fees are payable in Australia and New Zealand in order to keep the patent application alive or a granted patent in force, otherwise the application or patent will lapse or cease in due course.

#### AUSTRALIA

##### *annual fees*

Annual national continuation or renewal fees become due before the 4<sup>th</sup> anniversary of the filing date of the patent application (PCT or national) and then due before the anniversary of the filing date every year thereafter, the last due before the 19th anniversary

##### *late renewal*

Continuation / renewal fees can be paid up to a maximum 6 months after they fall due (the renewal grace period) but must be accompanied by an additional monthly late fee for each month, or part of a month after the due date

The actual lapsing of an application does not occur until the expiry of this 6 month renewal grace period but the lapsing of the application is backdated to the date it was originally due

#### NEW ZEALAND

##### *annual fees*

Annual national continuation or renewal fees become due before the 4th anniversary of the filing date of the patent application (PCT or national) and then due before the anniversary of the filing date every year thereafter, the last due before the 19th anniversary

##### *late renewal*

Continuation / renewal fees can be paid up to a maximum 6 months after they fall due but must be accompanied by an application for an extension of time and a corresponding extension of time fee

## REQUIREMENTS TO COMPLETE NATIONAL FILING OR NATIONAL ENTRY

### SCHEDULE 1 - FILING REQUIREMENTS

#### APPLICATION DETAILS

We require the application details in English such as:

- full legal name of each applicant
- full legal name of each inventor
- full details of any claim to priority (number, country, filing date)
- title of the invention
- figure number to accompany the abstract

In the case of a PCT national entry application we will also require:

- the international application number
- the international filing date
- preferably a copy of front page of the PCT pamphlet will help

#### SPECIFICATION, CLAIMS, DRAWINGS

In the case of a national application we will require a copy of the specification, claims, drawings and abstract in English that is to form the basis of the national application.

In the case of a national phase entry for a PCT application that was filed in a language other than English then we will require:

- for applications being filed under CHAPTER I: a verified English translation of the PCT specification description, claims as amended (if at all) under Article 19 together with any Article 19 statement, text matter of drawings (if applicable), and abstract
- for applications being filed under CHAPTER II: a verified English translation of the PCT specification description, claims, any text matter of drawings, abstract (if any of those parts has been amended, only as amended by the annexes to the international preliminary examination report)

#### TRANSLATION REQUIREMENTS

Translations (if required) of PCT applications must be filed at the same time as the request for national entry is filed in Australia however in the case of New Zealand they can be filed up to 3 months after the request for national entry is filed.

If translations are necessary please provide a translation verification certificate – you may ask us for one or you may construct one from the following:

#### VERIFICATION OF TRANSLATION

I (full name name of translator) of (full address of translator) state that I am familiar with both languages involved and that the attached document is a true and complete translation of (identification particulars of document that is translated) into the English language to the best of my knowledge and belief.

Signature of translator.....

Dated:.....

## **PCT NATIONAL ENTRY APPLICATION BEFORE PUBLICATION**

In the case of a PCT national entry application that is being requested before the application has been published by the international bureau then generally we will require for filing purposes a full copy of the international application together with verified English translations of the same if the international application was not filed in English.

We will preferably require a soft copy in English of the specification, claims and drawings in pdf format for your instruction purposes and a soft copy in English in Microsoft word format for our working / amendment purposes with drawings as 'pdf' or 'dwg' format.

## **AMENDMENTS DURING INTERNATIONAL PHASE**

Please advise if any amendments were made to the PCT specification, claims & drawings during international phase and if applicable please provide the full particulars of such amendments.

## **VERIFIED TRANSLATION OF PRIORITY DOCUMENTS**

Verified translation of priority documents will only be required if the patent office issues a direction which generally only occurs if the priority date becomes an issue.

## **POWER OF ATTORNEY / AUTHORISATION OF AGENT**

In the case of Australia and New Zealand a power of attorney / authorisation of agent is not required.

## **NOTICE OF ENTITLEMENT**

*Australia | s15 | r3.1A | EM 2.63*

In the case of Australia a notice of entitlement must be filed as part of the request for examination unless in the case of PCT national entry cases the applicant has included in the PCT Request (as indicated on front page of PCT pamphlet and the IASR/IASF) the necessary entitlement declarations under Rule 4.17(ii) and/or Rule 4.17(iii) which designate Australia

So we can assess the notice of entitlement requirements please advise if the applicant(s) for the patent:

entitlement to grant

- a) is/are the inventor(s); or
- b) has / have entitlement from the inventors by (assignment, agreement, employment or service contract, or other legal basis). In the case of other legal basis please specify the basis.

entitlement to claim priority for convention applications (if applicable)

- c) is / are the applicants(s) of the basic application(s) relied upon for claiming priority; or
- d) has entitlement from the applicant(s) of the basic application(s) relied upon for claiming priority by (assignment, agreement, employment or service contract, or other legal basis). In the case of other legal basis please specify the basis. Or

entitlement to claim priority for PCT applications with a priority claim (if applicable)

- e) is / are the applicants(s) of the application(s) listed in the declaration under Article 8 of the PCT or on the patent request form; and / or
- f) has entitlement from the applicant(s) of application(s) listed in the declaration under Article 8 of the PCT or on the patent request form.

Documentary evidence in support of the basis of entitlement is not required unless requested by the patent office.



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### *New Zealand | s22 | s73 | r12 | r81*

In the case of New Zealand a notice of entitlement must be filed before acceptance can occur.

The notice must include the grounds on which the applicant (the nominated person) has the right to be granted the patent.

So we can assess the notice of entitlement requirements please advise if the applicant(s) for the patent:

- a) is/are the inventor(s); or
- b) derive(s) title to the invention from the inventor(s) by (assignment, agreement, employment or service contract, or other legal basis). In the case of other legal basis please specify the basis; or
- c) is the personal representative of a deceased person referred to in (a) or (b).

Documentary evidence in support of the basis of entitlement is not required unless requested by the patent office.

### **VOLUNTARY AMENDMENTS TO THE NATIONAL SPECIFICATION**

A copy of voluntary amendments that you require (if any) to be filed in the national application.

### **[www.spc.com.au](http://www.spc.com.au)**

The filing requirements can also be found on our website if required by following link | [Filing Requirements](#) |