

# Australian Patent Office

## Manual of Practice and Procedure

### Updates

Part Amended	Amendment Reason	Updated
<a href="#">1.8.1 Introduction</a>	Transitional arrangements for outstanding Singapore work.	11 January 2011
<a href="#">2.20.3.2 Notice of Entitlement</a>	Clarifying that where there is a deficiency in the Rule 4.17 declaration(s), examiners should include an objection to this effect in their report. The objection should explain why the declaration(s) do not meet the requirement for filing a notice of entitlement.	23 December 2010
<a href="#">2.13 Annex D - Search Information Statement</a>	Amended to address the issues raised in the IL P1875.	23 December 2010
2.18 Multiple Applications (Sections 64 and 101B(6))	Updated to reflect current practice. The main change is the inclusion of additional information regarding objections under sec 101B(6) (2.18.3.2).	23 December 2010
<a href="#">2.2 Annex A - Customer Service Charter</a> <a href="#">Timeliness Guidelines</a>	Annex A has been deleted and a link to 1.1.19 Annex T has been provided.	1 December 2010
<a href="#">2.13 Annex D - Search Information Statement</a>	Clarification in respect to formats for names in the Search Information Statement. There is no need to change a format if it is auto populated by the system.  Clarification of the use of the V drive.	1 December 2010
<a href="#">2.30.1 Sealing of Duplicate Patent</a>	Minor clarification.	1 December 2010

<a href="#">2.11.5.2 One Sentence</a>	Minor correction.	1 December 2010
2.13 - <a href="#">Annex A - Procedural Outline to Full Examination of a Standard Patent Application</a>	Inclusion of link to 2.20.3.2	1 December 2010
<a href="#">2.13.13.3 Allocation and Handling of Cases</a>	Updated to reflect current practice.	1 December 2010
<a href="#">2.21.2.2 Basic Applications Filed Before Intergovernmental Organisations</a>	Minor correction.	1 December 2010
<a href="#">2.13.11.2 Action by Examiner</a>	Removal of incorrect link.	1 December 2010
2.31 - All	Updated to reflect current practice. In particular the main changes are re-formatting of some sections (2.31.2.1, 2.31.2.4 and 2.31.3.2) and inclusion of information on categorising citations relevant to an innovation patent (2.31.4.5.4)	1 December 2010
<a href="#">1.3.6.1 Response to Opinion</a>	Clarified that if the only outstanding issue relates to Rule 6.2(a) matters (omnibus claims), the examiner should establish the IPRPII regardless of any timing considerations	1 December 2010
<a href="#">1.3.8.4 Box III Non-establishment of Opinion</a>	Minor change	1 December 2010
1.2.9 Public Availability	Topic deleted due to incorrect reference to Public availability of Art 15(5) searches. Subsequent topics renumbered.	1 December 2010
<a href="#">1.5.5 Search Report</a>	Reference to non existent Annex A1 has been deleted.	1 December 2010
<a href="#">1.1.8.2.1 Composition of</a>	Clarification regarding the composition and	1

<a href="#">Three Person Team</a> <a href="#">1.1.19 Annex K</a>	functions of three person search team.	December 2010
<a href="#">1.3.8.3 Box II Priority</a>	Clarified that priority need not to be checked for P,A documents.	1 December 2010
<a href="#">1.3.8.1 Front Page and Notification Application Details</a>	Clarified that all claims replacement sheets must be annexed to the IPER even though there may not be an amendment on each page.	1 December 2010
<a href="#">1.1.19 Annex T</a> <a href="#">1.3.3 The Demand and IPRPII</a>	Clarified that the 4 weeks period for completing IPE opinions and reports begins from the start of IPRPII or response to a previous opinion, or from the most recent office action.	1 December 2010
<a href="#">2.20.10.1 General Considerations Amendments</a>	Updated mailboxes for Business Process Improvement section	1 November 2010
<a href="#">3.28.11 Term of Patent Granted under Section 35</a>	New topic added	1 November 2010
<a href="#">2.20.5.1 Priority Sources</a>	Explanation of the provisions where a national phase application can claim priority from a basic application filed more than 12 months before the international filing date of the PCT if priority has been restored by the receiving office.	1 November 2010
<a href="#">2.13.9.8 Recording the Search Details</a> <a href="#">2.13 Annex D - Search Information Statement</a>	Update of instructions for completing the Search Information Statement (SIS).	22 September 2010
<a href="#">1.5.4 Search Procedure</a>	Corrected minor typo	22 September 2010
<a href="#">1.1.12.5.3 Citation of the Documents</a>	Clarified that identification of documents should be made according to WIPO standard unless indicated otherwise in the manual.	22 September 2010

<a href="#">1.10.3 Authorised Officer</a>	Included that OH&L staff are the authorised officer for a request for restoration of priority under PCT.	22 September 2010
<a href="#">2.7.3.1 Introduction</a>	Change of name of International Depositary Authority.	22 September 2010
<a href="#">2.13.5.2.2 Balance of Probabilities</a> <a href="#">2.13.5.2.3 Benefit of Doubt</a>	Clearer guidance on applying the balance of probabilities for novelty, inventive step and innovative step objections.  Clearer guidance on applying the benefit of doubt for all other objections.	22 September 2010
<a href="#">2.13.8.2.10 Identifying Citations</a>	Clarifying that where a document is cited for the first time in an examination report as the result of an original or additional search, it is not necessary to identify the source of the document.	22 September 2010
2.10 - <a href="#">Annex A - Procedural Outline to Divisional Application Examination</a>	Revised case management of divisional applications and related parent applications to ensure prompt resolution of the status of the applications particularly where the claimed subject matter of the divisional application is the same as its parent.	22 September 2010
<a href="#">2.10.11 Case Management of Divisional Applications</a>	New topic added.  Revised case management of divisional applications and related parent applications to ensure prompt resolution of the status of the applications particularly where the claimed subject matter of the divisional application is the same as its parent.	22 September 2010
<a href="#">2.1.2.5 Quality Standard 5</a> <a href="#">2.2.4.4 Clear Cases of Lack of Unity</a> <a href="#">2.11.8.1 Reporting on Lack of Unity</a> <a href="#">2.13.5.1 Degree of</a>	Dealing with lack of unity and avoiding wasted effort in searching and examining claims that could be deleted by subsequent amendment.	1 September 2010

<p><a href="#">Consideration</a></p> <p><a href="#">2.13.9.5 Reserving the Search</a></p>		
<p><a href="#">2.9.2.7 Computer Software Related Inventions and Mathematical Algorithms</a></p> <p><a href="#">2.9.2.10 Business Methods</a></p>	<p>Incorporating practice on business methods arising from <i>Invention Pathways Pty Ltd</i> decision [2010] APO 10.</p>	<p>1 September 2010</p>
<p><a href="#">2.2.2.2 The General Approach to Examination</a></p>	<p>Update on use of PERP code P90 at the end of third and subsequent adverse reports (approval of supervising examiner for issuing of the report).</p> <p>Update on involvement of OH&amp;L where outstanding issues remain after 3 adverse reports without substantial amendments being proposed.</p> <p>Also, an update on consultation with supervising examiner where an objection has been raised and maintained for 2 reports and the examiner believes on the basis of submissions alone that the objection should be abandoned.</p>	<p>1 September 2010</p>
<p><a href="#">2.11.7.1 General Principles</a></p>	<p>Discussion added with examples on the appropriateness of raising an objection of lack of fair basis where the claimed invention is inconsistent with some elements of the description, and determining whether a benefit of doubt should be given to the applicant only after a response is received from the applicant.</p>	<p>1 September 2010</p>
<p>2.13 - <a href="#">Annex A - Procedural Outline to Full Examination of a Standard Patent Application</a></p>	<p>Inclusion of references to checking for FERs at first and further report stages (in line with 2.13.10.1).</p>	<p>1 September 2010</p>
<p><a href="#">2.13.8.2.1 Degree of Specificity Required</a></p>	<p>Amendment to degree of specificity required in investigating and reporting on all claims.</p>	<p>1 September</p>

<a href="#">When Reporting</a>		2010
<a href="#">2.8.1 Introduction</a> <a href="#">2.8.2 Contents and Form</a> <a href="#">2.8.3 Amendment of Abstract</a>	Updated to reflect current practice.	1 September 2010
<a href="#">2.3.1 Definitions in the Patents Act</a> <a href="#">2.3.2 Effect of the Acts Interpretation Act</a> <a href="#">2.3.3 Some Examples of Intended Ambits</a> <a href="#">2.3.4 Determining the Date of Filing of Documents</a> <a href="#">2.3.4.1 Effect of Hours of Business, Time Zones and Public Holidays</a> <a href="#">2.3.4.2 Examples</a> <a href="#">2.3.4.3 Effect of Errors in PAMS</a> <a href="#">2.3.5 Reckoning of Time</a>	Updated to reflect current practice. The main changes are: <ul style="list-style-type: none"> <li>replacing references to state offices with references to sub-offices;</li> <li>updating 2.3.4.3 Effect of Errors in PAMS; and</li> <li>re-formatting of some sections.</li> </ul>	1 September 2010
1.3.11 - Annex A Sub-Annexes - <a href="#">Annex AC - Best Practice Example 3</a> <a href="#">Annex AD - Best Practice Example 4</a>	Changes to positive statement for Novelty and Inventive step.	1 September 2010
1.1.19 <a href="#">Annex B - Completed ISR</a> <a href="#">1.3.8.7 Box VI Certain Documents Cited</a>	Annex B7 -Replaced 'E, X' with 'E'. E documents are relevant to novelty only so an 'X' should not be placed after the letter 'E'.	1 September 2010

<a href="#">1.1.8.2.4 Reconvening of Three Person Team - Review of Search Strategy and Search Results</a>	<p>Guidance on reconvening three person team to re-evaluate the search results.</p>	<p>1 September 2010</p>
<a href="#">1.8.7.2.8 Novelty, Inventive Step and Industrial Applicability</a>	<p>Reference to Singapore Act corrected</p>	<p>1 September 2010</p>
<p><a href="#">2.13.2.3 Lapsing at Further Report</a></p> <p><a href="#">2.13.8.3 Delayed or Non-receipt of the Report by the Applicant</a></p> <p><a href="#">2.24.3.1 Lapsing Under Section 142</a></p> <p><a href="#">3.24.3.3 Extensions of Time for Acceptance - Supervising Examiner's Limited Delegation</a></p> <p>3.24 <a href="#">Annex A Section 223(1) Extension of Time for Acceptance File Note</a></p>	<p>The delegation to grant extensions under section 223(1) has been altered. The delegation will only be exercised by AGM(OHL). These changes reflect that alteration.</p>	<p>1 September 2010</p>
<a href="#">3.10.7 Withdrawal of Request for Dismissal of Opposition</a>	<p>Remove reference to regulation that no longer exists.</p>	<p>2 August 2010</p>
<a href="#">2.5.3.3.5 "Obvious to Try"</a>	<p>Redraft of the subject of "obvious to try" to make it clear that this is a legitimate approach, and to explain the limits of the approach.</p>	<p>2 August 2010</p>
<p><a href="#">2.20.3.2 Notice of Entitlement</a></p> <p><a href="#">2.20 Annex H – Declaration Under Rule 4.17</a></p>	<p>Inclusion of an additional example of a declaration under Rule 4.17. Clarification of the declarations that are necessary in order to meet the requirements for filing a notice of entitlement.</p>	<p>2 August 2010</p>
<a href="#">2.20.7 National Examination Where the</a>	<p>Clarification of procedures that should be followed where the ISR is not on file.</p>	<p>2 August 2010</p>

<a href="#">ISR is Missing</a>		
<a href="#">1.3.8.6 Box V Reasoned Statement Regarding Novelty, Inventive Step &amp; Industrial Applicability</a> <a href="#">1.3.8.7 Box VI Certain Documents Cited</a>	<p>Changes in practice regarding listing of P and E documents in Box VI of ISO/IPEO/IPRP/II</p> <p>Guidance on level of comments required on A citations.</p>	2 August 2010
<a href="#">1.3.8.8 Box VII Certain Defects</a>	Amended to read more clearly.	2 August 2010
<a href="#">1.3.5.1 First IPE action</a>	Clearer guidance on additional searching following PCT art 19 and 34 amendments	2 August 2010
<a href="#">1.3.8.3 Box II Priority</a>	Link to PCT ISPE Guidelines provided.	2 August 2010
<a href="#">1.3.7 IPRP/II and Notification</a> <a href="#">1.3.9.3 General Notes on Form Completion</a> <a href="#">1.8.7.3 Examination Opinion/Report Completion</a>	Information on the addition of supplemental Box Sheets to macros.	2 August 2010
<a href="#">2.29.5 Substitute Documents</a>	Correction of links to the Patents Regulations.	1 July 2010
<a href="#">2.13.10.1 Guidelines for Using IPRP/IPERs and Other Foreign Examination Reports (FERs) in Examination</a>	Clarification of procedures for using FERs. In particular examiners should check for FERs at both first and further report stages.	1 July 2010
<a href="#">2.9.7 Food or Medicines, Being Mere Admixtures</a>	Correction of references to the Patents Act.	1 July 2010
<a href="#">2.4.11.3 Priority Date Considerations</a>	Clarifying that when raising a 'whole of contents' novelty objection, it is reasonable to assume that the 'whole of contents' citation is entitled to its earliest priority date.	1 July 2010
<a href="#">22.2 Annex A - Re-</a>	Changes to the re-examination process	1 July 2010



<a href="#">Examination Processing</a>		
<a href="#">2.14.4.3 Withdrawal of the Request</a> <a href="#">2.15.8 Conversion from Modified to Full Examination</a>	Minor clarification.	1 July 2010
<a href="#">2.11.2.3.12 Parametric Claims</a>	Inclusion of new section on parametric claims.	1 July 2010
<a href="#">2.10.4 Status of Parent</a>	Clarification of the procedure that should be followed for a divisional application where the parent application is a PCT application in a foreign language.	1 July 2010
<a href="#">2.22.1 Introduction</a> <a href="#">2.22.5.1 Initial Adverse Report</a> <a href="#">2.22.5.4 Subsequent Adverse Reports</a> <a href="#">2.22.5.5 Proposed Amendments are Allowable</a> <a href="#">2.22.5.6 Proposed Amendments are not Allowable</a> <a href="#">2.22.5.7 Supervision of Adverse Reports</a> <a href="#">2.22.6.2 Conclusion of Re-examination Otherwise</a> <a href="#">2.22.7 Copy of Report on Re-examination</a>	Updated to indicate that OH&L should be consulted before any adverse re-examination report is issued.	1 July 2010
<a href="#">3.25.3.2 Regulation 10.7(1)</a>	Remove reference to obsolete requirements	1 June 2010

<p><a href="#">2.11.9 Title of the Specification</a></p>	<p>Clarification that the title on the front sheet of a PCT pamphlet cannot of itself be amended under S104 as the front sheet of the pamphlet is not a filed document. However the information on the front sheet (and which is normally found in an Australian patent request) is captured as bibliographic data in PAMS and may be amended under S104.</p> <p>Any request from an applicant to amend the title on the front sheet of a PCT pamphlet will be treated as a request to change the record in the PAMS bibliographic data.</p>	<p>1 June 2010</p>
<p>1.1.19 <a href="#">Annex T - Customer service charter timeliness</a></p> <p>2.2 <a href="#">Annex A - Customer Service Charter Timeliness Guidelines</a></p>	<p>Clarification of charter standard relating to IPE opinions and reports.</p>	<p>1 June 2010</p>
<p>2.23 <a href="#">Annex D - Guidelines for Completing the Voluntary sec 104 Allowance Form</a></p>	<p>Inclusion of guidelines for completing the new voluntary sec 104 allowance forms.</p>	<p>1 June 2010</p>
<p><a href="#">2.4.4.6.3 Grace Period</a></p>	<p>Inclusion of additional information regarding grace periods.</p>	<p>1 June 2010</p>
<p><a href="#">2.23.3.5 Relevant Proceedings Pending</a></p>	<p>Minor correction.</p>	<p>1 June 2010</p>
<p><a href="#">2.4.11.4 Publication Considerations</a></p>	<p>Clarifying that a PCT application that designates Australia may be used as a 'whole of contents' citation.</p>	<p>1 June 2010</p>

<p><a href="#">2.13.9.2 Original Searching</a></p> <p><a href="#">2.13.9.6 Additional Searching</a></p>	<p>Updated to reflect current practice. When considering earlier search results, examiners must also take into account any Article 15(5) search reports.</p>	<p>1 June 2010</p>
<p><a href="#">2.13.8.2.1 Degree of Specificity Required When Reporting</a></p>	<p>Clarifying the degree of specificity required when reporting on a large number of claims.</p>	<p>1 June 2010</p>
<p><a href="#">2.31.4.4 Ground (1): Section 40</a></p>	<p>Clarification of procedures for examining innovation patents with more than 5 claims.</p>	<p>1 June 2010</p>
<p><a href="#">2.20.10.2 Features Common to Article 19, Article 34 and Rule 91 Amendments</a></p>	<p>Minor corrections to more clearly distinguish processes for amendments under the Articles and Rules of the PCT depending on time of entry into the national phase.</p>	<p>1 June 2010</p>
<p><a href="#">2.20.10.5 Features of Article 19 Amendments</a></p>	<p>Inclusion of link to PERP code where Article 19 amendments lead to non-sequential page numbering.</p>	<p>1 June 2010</p>
<p><a href="#">2.9.2.2 Short History of Manner of Manufacture</a></p>	<p>Formatting corrections</p>	<p>1 June 2010</p>
<p><a href="#">1.8.6.2 Search Procedure</a></p> <p><a href="#">1.8.8.3 Search and Examination Opinion/Report completion</a></p> <p><a href="#">1.1.12.1 Background Search Report and Notification Form Completion</a></p>	<p>Deleted the statement that the examples should be carefully followed and reference made to 1.3.8.6 for the minimum requirements for Box V.</p>	<p>1 June 2010</p>

<a href="#">1.3.8.6 Box V Reasoned Statement Regarding Novelty, Inventive Step &amp; Industrial Applicability</a>	Included that any interpretation of claims that affects the categorisation of citations or raises other possibilities may be put in Box V Item 2 at a place considered appropriate by the examiner.	1 June 2010
<a href="#">1.1.11.2 Inventive Step</a>	Comments regarding the contents of MPP 1.3.8.6.2 included.	1 June 2010
<a href="#">1.2.8 Search Report</a>	Clarified that Irrespective of whether a search statement has been provided or not, when a specification comprises claims, they should be reported on against the documents cited in the Art 15(5) search report	1 June 2010
<a href="#">1.8.1 Introduction</a>	Deleted that standard of Singapore examination must exceed that of PCT examination.	1 June 2010
<a href="#">1.10.5 Examiners with Foreign Language Capabilities</a>	Update of the list of selected examiners with foreign language capabilities.	1 June 2010
<a href="#">3.26.2.1 Regulation 3.6 Requirement</a>	Instruction updated in respect to acceptance, in respect to assembly of specifications, assembly including abstracts, in respect to apology letters, innovation patents, PDF file, case notes, acceptance error messages	3 May 2010
<a href="#">3.23.8.6 Renewal Fees</a>	Correction of the reference to the renewal fee payable during extension of term.	3 May 2010
<a href="#">3.25.3.2 Regulation 10.7(1)</a>	Qualification of what is meant by obvious mistake in relation to correcting the Register.	3 May 2010

<p>1.1.19 <a href="#">Annex S - Refund of search fees</a></p>	<p>In the case of an earlier search, PCT unit will enter the application number of the earlier search on front cover of the PCT file in the relevant field and will also place a copy of the earlier search on the PCT file.</p>	<p>3 May 2010</p>
<p>1.1.4.9 <a href="#">Issuing the Invitation to Pay Additional Search Fees</a></p>	<p>Clarified that the correct number of additional search fees is one less than the number of inventions provided work entailed in searching for and examining each extra invention is estimated to be “significant additional effort”.</p>	<p>3 May 2010</p>
<p>1.1.11.5 <a href="#">Conducting the Search</a></p>	<p>Reference to PAIS replaced with EPOQUE</p>	<p>3 May 2010</p>
<p>1.1.13 <a href="#">Reissued, Amended or Corrected ISRs and ISOs</a></p>	<p>Amended/Corrected ISR and ISOs should be placed in the out tray with a note to the PCT unit.</p>	<p>3 May 2010</p>
<p>2.7.2.1 <a href="#">General Requirements of the Description</a></p> <p>2.13 <a href="#">Annex A - Procedural Outline to Full Examination of a Standard Patent Application</a></p> <p>2.14 <a href="#">Annex A - Procedural Outline to Modified Examination of a Standard Patent Application</a></p>	<p>Correction of references to the Patents Act.</p>	<p>3 May 2010</p>
<p>1.1.19 <a href="#">Annex Z - USPTO kind codes</a></p>	<p>Corrected link to USPTO website</p>	<p>3 May 2010</p>

<p><a href="#">1.3.8.6 Box V Reasoned Statement Regarding Novelty, Inventive Step &amp; Industrial Applicability</a></p> <p><a href="#">1.8.7.3 Examination Opinion/Report Completion</a></p>	<p>Links to PCT Annexes have been added, and noted that examiners must follow the style requirements as detailed in MPP 1.3.8.6 while completing Singapore and PCT opinion/report forms.</p>	<p>3 May 2010</p>
<p><a href="#">2.4.8.4 Materially Affects the Way the Invention Works</a></p>	<p>Clarification of the circumstances in which a feature should be regarded as essential.</p>	<p>1 April 2010</p>
<p><a href="#">2.2.7 Reports</a></p>	<p>Minor clarification.</p>	<p>1 April 2010</p>
<p><a href="#">2.2.4.4 Clear Cases of Lack of Unity</a></p> <p><a href="#">2.11.8.1 Reporting on Lack of Unity</a></p> <p><a href="#">2.13.9.5 Reserving the Search</a></p>	<p>Clarification of procedures for using FERs when there is a lack of unity.</p>	<p>1 April 2010</p>
<p><a href="#">2.4.4.6.1 Exhibitions</a></p> <p><a href="#">2.20.8 Use of IPER/IPRP</a></p>	<p>Correction of links.</p>	<p>1 April 2010</p>
<p><a href="#">2.5.1.6 Assessing Inventive Step in Examination</a></p>	<p>Clarifying that the use of the problem/solution approach is not mandatory when taking an inventive step objection. However the approach is the preferred one to use in order to reduce the risk of ex-post facto analysis.</p>	<p>1 April 2010</p>

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