



A guide to applying for your international patent

PATENTS

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Email	assist@ipaaustralia.gov.au
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This application guide aims to provide a simple introduction to the Patent Cooperation Treaty (PCT) system for gaining patent protection. It complements IP Australia's other patent publications and we encourage you to read them. This guide is designed to help you prepare and file an international patent application under the PCT. It does not cover every issue that may come up and you should not regard this guide as an authoritative statement on the relevant law and procedure. You should also note that the requirements may change from time to time and while we make every effort to ensure the information presented is accurate, you should check the World Intellectual Property Organization's (WIPO) PCT Applicant's Guide before making your application. You can view this guide at www.wipo.int/pct/en.

I have an invention and I want the world to know about it!

If you are considering making an international application you need to be aware that there is no such thing as a 'world patent'.

An Australian patent provides protection only within Australia. To obtain similar protection in other countries you generally have two choices:

- File separate patent applications in each country. This can be cost effective when you file in only a few countries.
- File a single international application under the Patent Cooperation Treaty (PCT) which is administered by the World Intellectual Property Organization (WIPO). This path gives your application automatic effect in over 180 countries and allows you further time to decide whether you want to pursue patent protection and in which countries.

Whichever option you choose, you will still end up with separate patent applications in each country. The PCT is simply a method of facilitating the **filing** of a patent application in a number of countries simultaneously and all patent rights are granted by national or regional patent systems. This application guide outlines the process of applying for international patents through the PCT. It is a matter of balancing the cost of patent protection in particular markets with your business strategies for those markets.

When you make a PCT application your application will automatically designate all the countries that are signatory to the treaty on the date of your application. You still need to meet the national requirements in each country where you want patent protection but the costs of registration can be deferred for a significant period. You may be able to defer your national filing costs for up to 30 months for most countries and 31 months for Australia. This gives you extra time to assess the value of your invention and its export potential before committing to the high costs involved. This is a substantial, tangible benefit if you are just starting out with a new piece of technology and a new business.

What is the Patent Cooperation Treaty?

The PCT is an international treaty administered by the International Bureau (IB) of the WIPO, with headquarters in Geneva, Switzerland. The main purpose of the PCT system is to provide a unified, simple patent application procedure for filing in multiple countries.

The PCT enables you to file a single international application that has the same effect as a separate filing in all of the PCT member countries. The international application is filed with a Receiving Office (RO), which checks and processes your application according to the Treaty and Regulations.

WHO IS ELIGIBLE TO FILE A PCT APPLICATION?

To file an international application at least one applicant or inventor must be a national or resident of a PCT Contracting State. Australia is a PCT Contracting State and IP Australia is the RO for international applications made by Australian nationals or residents. For an up-to-date list of Contracting States please see www.wipo.int/members/en

After the international application is processed under the PCT system, the IB sends a notification to all of the PCT countries. Eventually, if you choose to continue your application for separate patents, your application will be examined according to the national patent laws of each country.

Why should I choose the PCT system?

Filing an international application under the PCT has the following advantages:

- A single application is filed which has effect in all the member countries of the PCT.
- You only need to comply with one set of formalities.
- You do not initially need to provide a translation of your application into the languages of the countries you select for patent protection.
- After filing a PCT application you receive an International Search Report (ISR) and an examination report called a Written Opinion of the International Searching Authority (WOISA) or otherwise called an International Search Opinion (ISO)* which should give you an indication as to the strength of your patent application before you decide whether you want to pursue patent protection.
- The option for an International Preliminary Examination (IPE) is available to you to further evaluate the chances of getting a patent before incurring the expenses involved in obtaining separate patents in different countries.
- The PCT system gives you extra time to reassess the value of the invention and its export potential before committing to high costs.
- As there is no requirement for you to request an IPE or to enter the national phase for any country, you may stop the process of the international application at any time to avoid incurring further expense.

*Note: This is published by the IB at 30 months after the earliest priority date as an International Preliminary Report on Patentability (Chapter II) (IPRPI), which is communicated to all designated offices unless you opt for IPE.

HOW DOES A PCT APPLICATION DIFFER FROM OTHER PATENT APPLICATIONS MADE OVERSEAS?

There are two ways of filing for an application overseas:

- You can apply directly to the Office of each country.
- You can file an application using the PCT.

Filing directly to the national office of each country requires you to...	Filing a PCT application to the Receiving Office requires you to...
<ul style="list-style-type: none"> • fill in the form(s) required by that Office 	<ul style="list-style-type: none"> • fill in a PCT Request form or lodge your application electronically using PCT-SAFE.
<ul style="list-style-type: none"> • pay the fees for each application in foreign currencies 	<ul style="list-style-type: none"> • pay the relevant PCT fees in Australian dollars
<ul style="list-style-type: none"> • meet the formality standards set by each country 	<ul style="list-style-type: none"> • meet the formality standards of the PCT
<ul style="list-style-type: none"> • provide an address for service in each country 	
<ul style="list-style-type: none"> • if required, provide a translation into the local language 	
<ul style="list-style-type: none"> • provide a description — including drawings, if necessary 	<ul style="list-style-type: none"> • provide a description — including drawings, if necessary
<ul style="list-style-type: none"> • provide a claim or claims 	<ul style="list-style-type: none"> • provide a claim or claims
<ul style="list-style-type: none"> • provide a certified copy of your Australian application if claiming priority 	<ul style="list-style-type: none"> • provide a certified copy of your Australian application if claiming priority

First in, best dressed

PRIORITY DATES

All patent applications (including international applications) have a priority date. Priority dates are extremely important when considering whether an invention claimed in a patent application is new (the technical term is novel). If two applicants file two patent applications (on separate occasions) claiming the same invention, the patent will be given to the application with the earlier priority date, all other matters being equal.

THE PARIS CONVENTION AND HOW IT PROTECTS YOU

There is an international agreement called the Paris Convention, which allows patent applicants to use the date of their first patent application in one country as the priority date for their applications in other countries. This situation applies only if the applicants make their subsequent applications within 12 months of the date of the first patent application.

An international application can claim priority from:

- an earlier overseas application in a country which is party to the Paris Convention
- a provisional application
- a standard application
- an earlier PCT application
- an innovation patent.

Priority may be claimed on more than one patent application.

Care should be taken to check the national requirements of those countries in which you wish your PCT application to proceed. You may be able to proceed in a limited number of countries even if the invention has been published but a patent has not been granted. In these circumstances it would be wise to seek professional assistance. See the Yellow Pages for a listing of patent attorneys and IP professionals in your area.

How does the PCT work?

The PCT system has two distinct phases (stages) of patent procedure — the international phase followed by the national phase.

The international phase provides you with:

- Recognition of the priority date in all member countries of the PCT.
- Access to an International Search Report (ISR), an examination report called a WO of the International Searching Authority (ISA) and, optionally, an additional examination report called an International Preliminary Report on Patentability (IPRP) which allows you to assess the patentability of your invention.
- A WIPO publication number and PCT application number. These numbers are useful when commercialising your invention because they prove you have applied for a patent.
- The opportunity to amend your application — taking into account any reports or searches.

The national phase:

- Allows you to pursue your patent application in separate countries that you select, either directly or through a regional patent office such as the European Patent Office (EPO).
- May be quicker because possible barriers to patentability have been identified in the international phase.

An international application consists of the request form and the same documents (a description, claims, drawings, where required, and an abstract) as a standard patent application. The same documents are required because upon entry into the national phase your application is considered in the same way as a standard patent application. For more information on the criteria for patents please visit www.ipaustralia.gov.au or request free of charge from our Customer Contact Centre on 1300 651 010.

The provisions of the PCT and the drafting and prosecution of patent applications are all complex matters. You are strongly advised to obtain professional advice from patent attorneys or IP professionals before filing an international application.

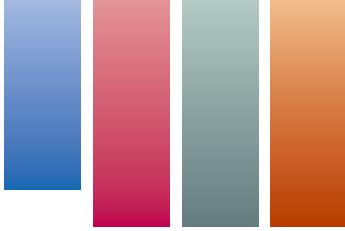
The international phase

In Australia, IP Australia acts as a RO, ISA and International Preliminary Examining Authority (IPEA) under the PCT.

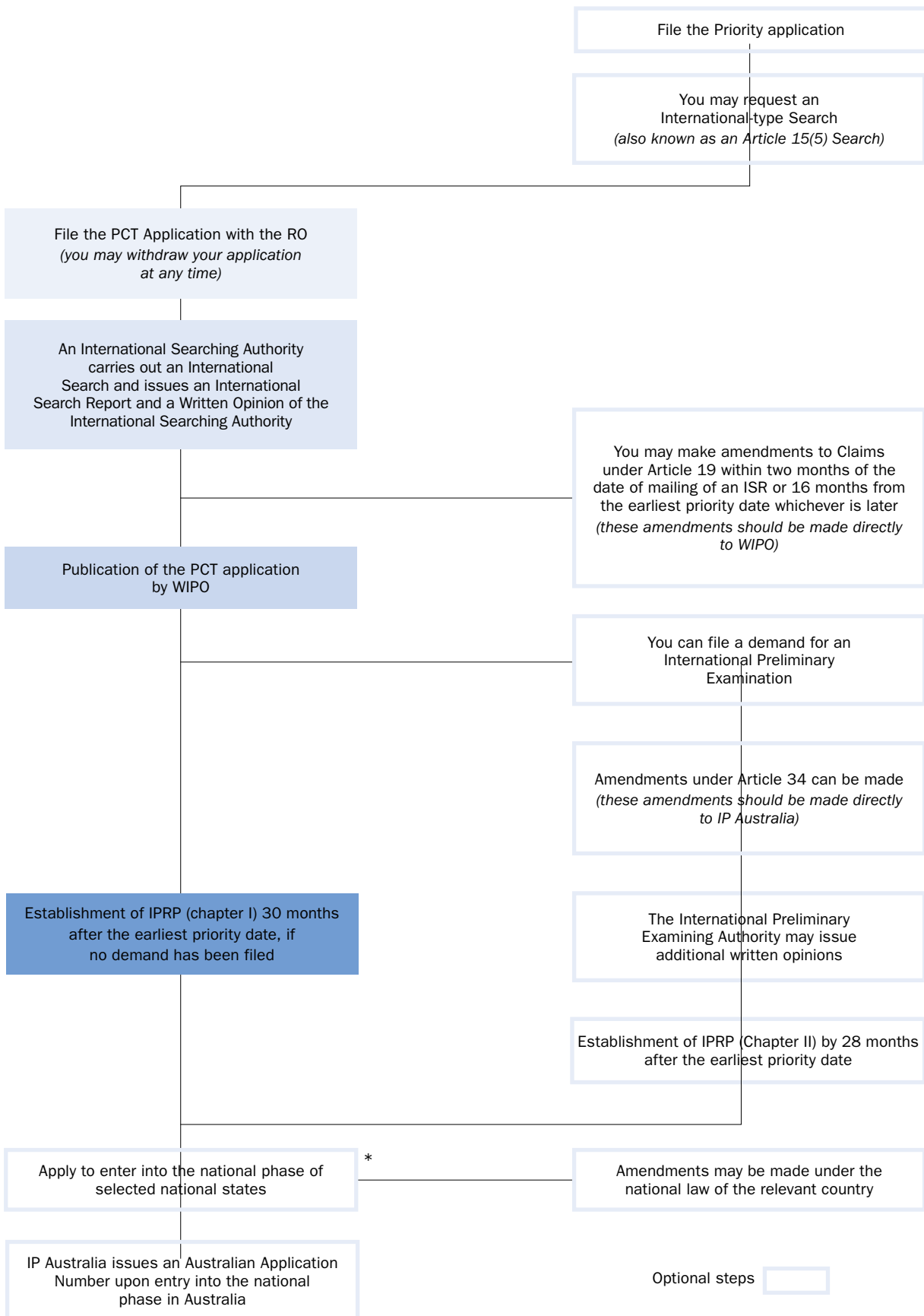
MIND THE STEPS

The international phase consists of four main stages.

<p>Stage One Application</p>	<ul style="list-style-type: none"> • The RO assigns the application a filing number. • The RO checks the application for mistakes in the formalities of the application. • This part of the process usually takes one to two weeks.
<p>Stage Two Searching</p>	<ul style="list-style-type: none"> • An international search is carried out by the ISA to look for any relevant documents describing similar inventions related to the one you have claimed in your PCT application. • The findings of the search are compiled in a search report called an ISR. An examination report called a WOISA is also produced. WOISA is also known as ISO • These reports are sent to your agent and the IB. • You can amend your claims (under Article 19 — see <i>In more depth</i>) based on the findings of your ISR and ISO – amendments must be made within two months of receiving the ISR and ISO or within 16 months of the earliest priority date whichever is later. • As a PCT requirement, the ISR and ISO must be issued within three months of the application's lodgment date, or nine months of the earliest priority date, whichever is later. • Within 19 months of the priority date, you can ask for a Supplementary International Search (SIS) to be done in addition to the search carried out by your “usual” International Searching Authority (ISA). At the moment there are six Supplementary International Search Authorities (SISA) –Russia, the Nordic Patent Institute, Sweden, Finland, the European Patent Office and Austria. Australia does not offer this service. Each SISA sets its own fees and decides the scope of the searches it offers.
<p>Stage Three The application is published by the IB</p>	<ul style="list-style-type: none"> • 18 months from the earliest priority date, the IB publishes the application and the ISR. • There is no provision for delay in publishing the application — it can be published without the completed ISR if necessary. • At this point, if the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the IB before the completion of the technical preparations for international publication — this must be done no later than 15 working days before it is due to be published. • At 30 months from the earliest priority date the IB uses the ISO to establish the IPRP (Chapter 1), if the applicant has not opted for an IPE which is communicated to all designated offices.
<p>Stage Four — Optional An International Preliminary Examination is requested</p>	<ul style="list-style-type: none"> • You can request an optional IPE of the application — this request is called a demand and should be filed within 22 months of the earliest priority date. • The IPE is based on the ISO and any amendments you file and helps you refine your application before you decide to proceed with the national phase. • If you have requested an IPE, and the international preliminary examiner considers that there are still deficiencies in your application, you will be given a WO otherwise the examiner will establish an IPRP (Chapter II). • The IPEO, like the ISO, explains why documents have been cited and alerts you to any problems your application may have in relation to novelty, inventiveness, and industrial applicability, as well as to any problems of clarity in your specification. • You can then file amendments to your application (under Article 34 — see <i>In more depth</i>) at the time of filing the demand or in response to an International Preliminary Examination Opinion (IPEO) any time up to the establishment of the IPRP (Chapter II). • The examiner must in any event establish the IPRP (Chapter II) by 28 months after the earliest priority date. This will be an adverse report if you have not overcome all deficiencies. • Please note – the decision on granting a patent remains the task of the national or regional offices where you enter the national phase — the IPRP (Chapter II) is authoritative but it is not binding in these offices.



IP AUSTRALIA INTERNATIONAL PATENT APPLICATION GUIDE



* **Please note** that from 1 April 2002 changes to the PCT rules extended the time for national phase entry to 30 months from the priority date (31 months for Australia and some other countries) irrespective of whether a demand has been filed. However, not all countries have the change in place and you should seek advice about the countries where you request patent protection. For further information please visit the WIPO website www.wipo.int/pct/en

AMENDING YOUR PCT SPECIFICATION DURING THE INTERNATIONAL PHASE

You are able to amend your PCT specification at three points during the international phase of the process.

Requests to correct application errors

Corrections of obvious errors in the specification can be requested at any stage up until entry into the national phase. An obvious error is one where both the error and the correction should be obvious on the face of the documents.

Article 19 amendments

You have two months from the date of mailing of the ISR or 16 months from the earliest priority date, whichever is later, in which to lodge amendments to the **claims** under Article 19. Article 19 amendments **MUST** be sent directly to the IB.

Article 34 amendments

As part of the IPE process you can also request an amendment under Article 34 of the PCT. The amendment can be to any part of the PCT specification. These amendments should be sent to IP Australia. An examiner will consider the amendments during the examination.

Under the PCT system, once the IPRP (Chapter II) is issued, no further amendment of the international specification is allowed. Thus, any further amendments to the specification must occur after the specification has entered the national phase with each of the relevant national offices.

Changes of name or assignments of the application or changes to the address for service can be made during the international process provided the request is received by the IB within 30 months from the earliest priority date.

The national phase

Usually by the end of 30 months from the priority date, you will have to ask for the international application to proceed separately as a standard patent application in the countries that have been selected by you for patent protection. As the applicant, you need to take certain actions in order for the application to enter the national phase and these actions must be completed before the relevant deadline. Most countries allow 30 months from the priority date in which to enter the national phase, although some, like Australia, allow 31 months. A small number of countries still require you to request entry to the national phase before 20 months from the priority date unless you have filed a demand (request) for an IPE that was lodged within 19 months of your priority date.

You should check the timing requirements of each individual country for entering the national phase.

For further information please visit the WIPO website www.wipo.int/pct/en

To proceed in the national phase you must indicate to each office that you are entering the national phase in that country. You are required to pay the necessary national fees to those offices and supply any translations that may be required. The national offices will examine the application under their domestic law and grant or refuse a patent, according to their own national patent law.

You do not have to enter the national phase in all countries. You should use the time between filing and national phase entry to check the commercial importance of your application.

IP Australia cannot advise you whether you should enter the national phase in any particular country. Please be aware that most countries will require you to provide either an address for service or the name of an IP professional registered in that country on national phase entry. IP Australia requires an address for service in Australia. This must be a street address in Australia where legal documents can be served.

WHAT REQUIREMENTS DO I NEED TO MEET TO ENTER THE NATIONAL PHASE IN AUSTRALIA?

To enter the national phase in Australia you should:

- Write to IP Australia requesting entry of your PCT application (quoting your PCT application number) and pay the required fee.
- Provide an address for service in Australia (this must be a street address in Australia for legal service).
- If the PCT application is in a language other than English, you must provide a verified English translation of the PCT specification.

If you wish to enter the national phase before IP Australia has received the PCT published specification you will need to provide in addition to the above:

- A copy of the PCT specification as lodged with the RO.
- A copy of the completed request form lodged with the RO.

Searches

INTERNATIONAL-TYPE SEARCHES: ARTICLE 15 (5)

If you have filed an Australian provisional application you can get a patentability search carried out by IP Australia on your invention before you file a PCT application. This is called an international-type search or an Article 15 (5) search. It is designed to assist you to decide at an early stage whether you should seek protection through the PCT route.

An international-type search is essentially similar to a PCT international search and similar conditions apply. The search is made on the basis of claims, the description or a search statement. If your application has no claims, the international-type search is based on the description (and drawings). This type of search is necessarily limited because the inventive concept may not be clearly defined. After having an international-type search carried out, you may decide to file either a national or a PCT application. Alternatively you may decide not to proceed and your provisional application will lapse and will not be published.

Normally, you should ask IP Australia to perform an international-type search within 10 months of filing your provisional application. However, we can perform the search as early as possible to ensure you have sufficient time to consider the search results before the 12 month priority expires. You should receive your international-type search report about five weeks after you pay the fees and ask IP Australia to conduct the search. The report is prepared in a similar format to a PCT International Search Report.

When you file your PCT application you must pay the full international search fee. However if IP Australia has conducted an international-type search for you for the same invention you may request a partial refund of the international search fee. The amount of the refund will depend on how much additional searching the IP Australia examiner will need to do on your PCT application.

In more depth

INTERNATIONAL SEARCH REPORT (ISR)

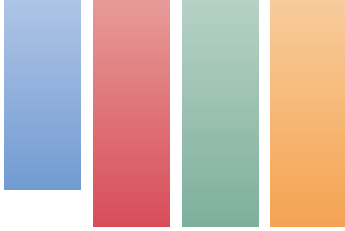
Soon after you pay the fees and file an international application with IP Australia it will be forwarded to an examination section in the relevant technology and allocated to an examiner for the conduct of an international search. The search examiner will carry out a comprehensive search of the PCT minimum documentation which includes national, regional and PCT patent documents published after 1920 from all major countries and certain non-patent literature. Search examiners employ a range of tools and techniques to access patent and non-patent databases to identify those documents that are most relevant to the patentability of your claims. It is therefore vitally important that your claims are focused on what you consider to be the essential features of your invention. An example of an ISR (main parts only) is shown on page 21.

Boxes A & B indicate the technology areas, databases searched and the keyword strategies that were used by the examiner in performing the search. This information is provided for users of the search report to understand the scope of the international search. It helps national offices to ascertain the relevance of the search during national examination when the claims are possibly in amended form.

Box C identifies the most relevant documents found by the search examiner and indicates their relevance to the claims in the application.

- The middle column identifies the publication details for each document, including the name of the applicant or patentee and the publication date.
- The column on the left indicates a category for the cited document by means of a letter (whose significance is explained in detail in a box underneath Box C). For example, the “X” category indicates that the document alone raises doubt about the novelty and/or inventiveness of the invention.
- The column on the right identifies claims for which the category indication is relevant.

An Annex to the ISR lists known “family members” of the citations that are identified in the search report. Family members are related applications in other countries made by the applicant of the citation for the same or closely related inventions.



The ISR may also contain other important information depending on the circumstances. For example it may indicate that the application claims several different inventions (called lack of unity) and if so which of these inventions are covered by the search report. If you have several inventions within your application that cannot be covered by a single search, you will be given an opportunity to have those invention(s) searched on payment of extra fees. The search report may also show that some claims have not been searched because they are not regarded as covering patentable subject matter or where a meaningful search is not possible because it is impossible to work out what the invention is. However, a search is done when practicable.

The ISR thus identifies any relevant citations at an early stage during the patenting process, allowing you to assess the commercial worth of your invention and helping you in the process of making important decisions.

Copies of patent citations can be purchased from IP Australia or alternatively accessed via the Internet from the relevant patent office site.

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (ISO)

After completing the search, the examiner will also perform an examination and produce a report ISO that explains why documents have been cited in the ISR and alerts you to any problems your application may have in relation to novelty, inventiveness, and industrial applicability, as well as to any problems of clarity in your application's specification and description.

An example of ISO is shown on page 22.

Box V indicates which claims satisfy the criteria of novelty, inventive step and industrial applicability and which claims do not. It provides an explanation of the documents cited in the ISR and their relevance to the invention. An adverse observation under novelty and/or inventive step would indicate that the examiner considers that the invention as claimed is not new or is non-inventive or obvious in the light of the citations and/or the knowledge which skilled persons in the relevant technology would possess.

In the example, the examiner considers that claims 1-6, 9 and 10 are not novel and the explanation indicates where the features of the invention have been disclosed in the citations. The examiner also considers that claims 1-7 and 9-11 lack an inventive step. The report explains that all the features of those claims are either disclosed in the documents cited or are minor features, which are not enough to make those claims inventive. The report also indicates that the examiner considers that the remaining claim, that is claim 8, is novel and inventive.

The examiner will establish the ISR and ISO and will send them to you. You then have a number of options:

1. Take no further action until you need to enter the national phase. The ISO will be used by the IB to establish the IPRP (Chapter 1) and sent to all designated offices at 30 months from earliest priority date if you do not opt for IPE. Prior to establishing the IPRP (Chapter I), the ISO will be confidential.
2. Provide written comments to the IB. These comments (including translations if required) will be sent to all designated offices unless an IPRP (Chapter II) has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.
3. File a Demand for Preliminary Examination. The demand must be filed within 22 months of the priority date or three months from the date of the ISR, whichever is later. (Note however page 14).

ARTICLE 19 AMENDMENTS

After you have received the ISR and before the application is published, the PCT process provides you with an opportunity to amend the claims of your international application under Article 19 of the PCT.

For example, if there are X or Y category documents cited in the ISR, you may wish to amend the claims to distinguish them from the citations before proceeding with the application in the national phase. This may increase the likelihood of your application proceeding directly to grant, when your application enters the national phase.

INTERNATIONAL PRELIMINARY EXAMINATION AND ARTICLE 34 AMENDMENTS

Before entering the national phase, you can choose to have an IPE of the application done by IP Australia in its capacity as an IPEA. This also gives you the opportunity (under Article 34 of the PCT) to amend any part of your application to overcome problems and have an examination report IPRP (Chapter II) issued on the amended application before you enter the national phase in different countries.

An IPE commences at 22 months when you file a Demand and pay the appropriate fee, within the time period indicated above, together with any submissions or amendments that you would like to make in response to the ISR and ISO. An IP Australia examiner will examine your application and may issue one or more opinions before the IPRP (Chapter II) report is issued. You will have the opportunity to file (within certain time limits) a response to each opinion, which may include submissions, or amendments or both.

An example of an IPRP (Chapter II) (significant parts only) is shown in the example on page 23.

Box V has the same meaning as box V of the ISO.

Box VIII makes other relevant observations in relation to significant issues, which may impact, on the validity of any potential patent grant. In the example, the examiner considers that claim 10 should include a feature that is necessary for the invention to function properly and that a feature defined in claim 15 does not correspond to what is described in the body of the specification.

The IPE opinion/report may also contain other information such as whether there were any restrictions on the scope of the examination or whether there are any other defects in the international application.

For more detail on the interpretation of ISRs, ISOs and IPRP (Chapter II), please refer to the WIPO Guidelines for International Searches and the WIPO Guidelines for IPE, which you can download from www.wipo.int

SUPPLEMENTARY INTERNATIONAL SEARCH (SIS)

The main international search by the ISA is intended to be a high quality product, but one of the main problems in finding relevant prior art is that the number of languages is constantly increasing. As a result there is an increasing risk of new citations being raised during the national phase once you have already incurred significant costs. The SIS service was introduced as a way to reduce this risk.

Requesting a SIS is a strategic decision, taken after consideration of:

- (i) the results of the main international search;
- (ii) the commercial importance of the particular application; and/or
- (iii) the amount of prior art in the particular technical field which is known to be published in a language in which the main ISA is not skilled.

It is up to you to decide whether it would be worthwhile to incur additional expense to get some extra information. Your request for a SIS must be given to the IB before 19 months from the priority date.

At the moment there are six Supplementary International Search Authorities (SISA) –Russia, the Nordic Patent Institute, Sweden, Finland, the European Patent Office and Austria. **Australia does not offer this service.**

Some SISA specialise in searching in a particular language, while others offer a full search as if they were conducting a “normal” (main) international search. Each SISA sets its own fees and each SISA will only search one invention. You can ask for more than one SIS to be done on the same international application.

The SISA will produce a supplementary search report which is in the same format as the ISR, but not a supplementary written opinion. Please note that amendments made under Article 19 or Article 34 will not be taken into account by the SISA when preparing the SIS report.

EXAMPLE: INTERNATIONAL SEARCH REPORT

1

INTERNATIONAL SEARCH REPORT

A. CLASSIFICATION OF SUBJECT MATTER
 Int. Cl. **G01F 11/00** (2006.01) **G01F 15/14** (2006.01)
 According to International Patent Classification (IPC) or to both national classification

B. FIELDS SEARCHED
 Minimum documentation searched (classification system followed by classification symbols)
 Documentation searched other than minimum documentation to the extent that such documents are available

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 3207388 A (WADDINGTON) 21 September 1965 column 2 lines 30-49 column 2 line 45 to column 3 line 15	
Y	AU 30349/77 A1 (IBM CORP) 4 November 1977 page 4 lines 5-26 page 9 line 2 to page 10 line 15	
X	AU 9914/53 (202914) B1 (SIMBA AG) 22 December 1997 See page 3	
Y	DE 2947734 A1 (CIBA-GEIGY AG) 12 June 1980 See Figs. 5 and 6	

Further documents are listed in the continuation of B

* Special categories of cited documents:
 "A" document defining the general state of the art which is not considered to be of particular relevance
 "E" earlier application or patent but published on or after the international filing date
 "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
 "O" document referring to an oral disclosure, use, exhibition or other means
 "P" document published prior to the international filing date but later than the priority date claimed
 "T" later document underlying
 "X" document or continuation
 "Y" document involved
 "Z" document

Date of the actual completion of the international search
 18 January 2008

Name and mailing address of the ISA/AU
 AUSTRALIAN PATENT OFFICE
 PO BOX 200, WODEN ACT 2606, AUSTRALIA
 E-mail address: pct@ipaustralia.gov.au
 Facsimile No. +61 2 6283 7999

Form PCT/ISA/210 (second sheet) (April 2007)

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INTERNATIONAL SEARCH REPORT

DOCUMENTS CONSIDERED TO BE RELEVANT

International application No. **PCT/AU2008/123456**

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
Y	WO 1981/001617 A1 (BOLINDEN AB) 11 June 1981 See page 3 lines 7-28	7, 11
Y	Patent Abstracts of Japan, P-136, page 150, JP 50-14535 A (NCR CORPORATION) 28 May 1985 See English abstract	7, 11

3

INTERNATIONAL SEARCH REPORT

This Annex lists the known "A" publication level patent family members relating to the patent documents cited in the above-mentioned international search report. The Australian Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

International application No. **PCT/AU2008/123456**

Patent Document Cited in Search Report	Patent Family Member
US 3207388	CH 440006
AU 30349/77	AU 30349/77
	GB 1044517
	BE 860359
	CA 1075831
	CH 623685
	ES 464680
	FR 2379162
	JP 53070668
	NL 7713449
	US 4137103
AU 9914/55	NONE
DE 2947734	CA 1149815
	JP 55085576
	FR 2442840
WO 1981/01617	AU 65760/80
	DK 304381
	BR 8008935
	EP 0030218
JP 50-14535	NO 812565
	SE 7909875
	GB 2038803
	CA 1161900
	FI 812349
	US 4492924
	BR 7707919
	DE 2752439
	GB 1536618
	SE 7713736

Due to data integration issues this family listing may not include 10 digit Australian applications filed since May 2001.

END OF ANNEX

Form PCT/ISA/210 (patent family annex) (April 2007)

EXAMPLE: WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

1

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/2008/123456

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims 7,8,11	
Inventive step (IS)	Claims 1-6,9,10	YES
	Claims 8	NO
Industrial applicability (IA)	Claims 1-7,9-11	YES
	Claims 1-11	NO
	Claims	YES
		NO

2. Citations and explanations:

1. US 3207388
2. AU 30349/77
3. AU 9914/55
4. DE 2947734
5. WO 1981/001617
6. JP 50-14535

Novelty (N) claims 1-6,9,10

Citation 1 explicitly discloses all of the features of claims 1-6. For example see:

- control processor col 2 lines 31-35, item 8 of Fig. 2
- flow sensor col 2 lines 32-39, item 6 of Fig. 2
- flow regulator col 2 lines 40-45, item 2 of Fig. 2 and Fig. 6
- pH sensor col 2 lines 42-49, item 4 of Fig. 2

Citation 2 discloses all of the features of claims 1-4. In particular, it discloses the control processor, flow sensor and flow regulator, as part of the heat exchanger, at page 4 lines 5-26 and in figure 9 at items 7, 9 and 11.

Citation 3 discloses all of the features of claims 1-5 and 9-10. In particular, figures 5 and 6 show all of the features of the above citations, being similar disclosures, with the extra features of the bracket and exhaust pipe being found at items 52 and 99 of these figures.

The features of the remaining claim are not found in any single document published before the earliest priority date of the claims.

Inventive Step (IS) claims 1-7, 9-11

Claims 1-6,9,10 as above.

Claims 7 and 11.

Citations 1 and 2 do not individually disclose all of the features of the claims 7 and 11, but when combined with either one of the citations 4 - 6, as would be obvious to a person skilled in the art, disclose all of their features.

The features of claim 8, in particular the reverberating reed switch and corona discharge, were not found in any other document that would be regarded, by a person skilled in the art, as being obvious to combine with any of the above citations.

Form PCT/ISA/237 (Box No. V) (April 2007)

EXAMPLE: INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

1

International application No.
PCT/AU2008/123458

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims 1-9,11-15,21-26	YES
	Claims 10	NO
Inventive step (IS)	Claims 23-26	YES
	Claims 1-15,21,22	NO
Industrial applicability (IA)	Claims 1-15,21-26	YES
	Claims	NO

2. Citations and explanations (Rule 70.7)

Novelty (N) Claim 10

(a) AU 21113/77 (498847)
(b) AU 84276/75 (496972)

Citations (a) and (b) each (figs 3 and 4 in the case of (b)) disclose an element conforming exactly with the element defined by the claim. Further, the explicit teaching of each citation is to employ the element as instantly claimed.

The features of the remaining claims are not found in any single document published before the earliest priority date of the claims.

Inventive Step (IS) claims 1-15, 21,22

Claim 10 as above.

(c) AU 31026/63 (263908)

Claim 10 also lacks inventive step as the element of citation (c) is described in terms of use in a cross arm assembly in accordance with the manner defined. It has a symmetrical configuration whereas the element of the claim has a body portion and an integral top portion which are not symmetrical. However, this difference is a mere variation in shape and, as such, is not seen to reflect an inventive step.

Claim 1-9: Restricting the element to porcelain is not considered to make an inventive step over either of citations (a) or (c).

Claims 11-15: The features added by these claims are disclosed in the citations so that these claims are anticipated by the obvious combination of the disclosures of the citations.

Claims 21,22: The minor features added by these claims to the cross-arm assembly of claim 15, to which they are appended, do not involve an inventive step.

Claims 23-26: The features of these claims were not disclosed in any obvious combination in any of the citations.

Form PCT/APEA/409 (Box No. V) (April 2007)

2

International application No.
PCT/AU2008/123458

PATENTABILITY

tion

scription, and drawings in on the question whether the claims

some the major prior art problem discussed on pages 1 and 2, could be prone to the problems which the invention allegedly

tive of the form of head described, such as illustrated in Fig.

does not define a pole.

Form PCT/APEA/409 (Supplemental Box (2)) (April 2007)

PCT timeline

MONTHS

1	First Filing (eg Provisional) gives PRIORITY DATE and TIMELINE START	Foreign Filing decision period (12 months) Convention or PCT application
2		
3		
4		
5		
6		
7		
8		
9		
10		
11		
12	Final date for PCT Application to be filed	Time for International Search Report and written opinion of the International Searching Authority to be established three months
13	PCT FEES TO BE PAID. An applicant has one month from filing to pay PCT fees without penalty. A second month is available but a penalty fee applies.	
14		
15		
16	Applicant has two months from mailing date of ISR or 16 months from priority date to amend claims – to WIPO	
17		
18	International Application published by WIPO	
19	Request filed if applicant wants a Supplementary International Search (SIS)	
20		
21	Demand filed if applicant wishes International Preliminary Examination	
22		
23		International Preliminary Examination Process (applicant may file amendments)
24		
25		
26		
27		Final date for SIS to issue.
28		
29		
30	30 month deadline to enter national phase in some countries *	
31	31 month deadline to enter national phase in some countries (Australia)	

* Please note that from 1 April 2002 changes to the PCT rules extended the time for national phase entry to 30 months from the priority date (31 months for Australia and some other countries) irrespective of whether a demand has been filed. However, not all countries have the change in place and you should seek advice about the countries where you request patent protection. For further information please visit the WIPO website www.wipo.int/pct/en

A bit of advice

Although our staff cannot give you advice about your particular circumstances, we can answer general questions that you may have about the Australian patent and PCT systems.

Patent protection, particularly international protection, is expensive and you need to balance your required level of protection against the cost of that protection. It is a valuable investment as well as a significant expense and should be treated as such.

Obtaining a commercially useful patent requires a high level of expertise and therefore we recommend that you seek professional help before seeking international patent protection.

If you do proceed without professional help you should bear in mind that your patent application is a legal document, and as such should be drafted carefully so that it can be upheld against legal challenge. You will also need to ensure that competitors cannot easily work around your patent and use your ideas without you having any legal recourse.

PCT Online Electronic Filing

IP Australia's PCT Online service is a faster, cheaper way to file international patent applications under the PCT.

PCT applications filed electronically are eligible for a discount and can be transmitted to WIPO faster because there is no paper or postage involved. For more information regarding fees please see page 28.

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To receive the maximum electronic filing discount, the text of the description, claims and abstract for your application must be in a character coded format (e.g. XML) and must be lodged using IP Australia's PCT Online service. You can obtain the XML specification for PCT documents from the WIPO website. You can use WIPO's PCT-SAFE Editor to prepare your application documents in WIPO's XML format. Alternatively you can use PDF documents and upload these to PCT-SAFE.

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Once you have prepared your application using PCT-SAFE and saved it as a "WASP" (.zg1) file, it is ready for submission through the online services section of IP Australia's website.

Once you have uploaded your files, they will be checked for viruses and the validity of your digital signature, and you will be presented with your pre-filing number and an electronic lodgement receipt.



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If you have access to the internet, please go to www.wipo.int/pct/en/forms and download the PCT 101 Request form.

If you do not have access to the internet you can request a PCT 101 Request form by contacting IP Australia's Customer Contact Centre on 1300 651 010. The form will be sent to you free of charge.

Completed forms should be sent to IP Australia, contact details are on page 33.

Fees

To view the current PCT application fees visit www.ipaustralia.gov.au or contact IP Australia's Customer Contact Centre on 1300 651 010.

Notes

1. If an examiner determines that there is more than one invention claimed in an application you may be invited to pay additional fees.
2. Fees are payable to the RO. For Australia, the RO is IP Australia.
3. Although the fees are not required to be paid at the time of filing the international application, the international search will not be performed until the fees are paid. If no fees, or insufficient fees, are paid you will be invited to pay the fees within one month of filing. If the fees are not paid within the first month, a second letter requesting payment, plus a penalty payment (50% of the unpaid fee or the whole of the transmittal fee (whichever is greater) but not more than 50% of the international filing fee) will be sent to you. If fees are not paid within the second month then the application will be withdrawn.
4. You will also need to pay various national fees in each country where you choose to begin the national phase. In Australia these will include filing, examination, and maintenance fees.
5. The Patents Act has various fees that are required to be paid during the prosecution of an application. Failure to pay a fee can have serious consequences for the protection of your rights. If you choose to pursue patent protection without professional advice you should take extreme care to understand the fees you will be required to pay and when you are required to pay them.

Glossary of terms

Address for Correspondence	An address in Australia where we can write to you. You should notify IP Australia if this address changes.
Address for service Australia	An address for legal service, that is, an address in Australia where documents may be served on someone personally. You should notify IP Australia if the address changes.
Applicant	The person(s) or organisation(s) making the application.
Article 19 amendment	An optional amendment that is applied to the claims of the international application. You should make these amendments directly to WIPO after the receipt of the ISR, and WO of the ISA.
Article 34 amendment	An optional amendment to the international application which can cover all documents of the PCT application (excluding the Request form). Article 34 amendments happen during preliminary examination and should be sent to IP Australia.
Article(s)	These are the clauses of the PCT that govern how the Treaty will operate. They equate to sections of an Act.
Contracting State	A country that is a party to the PCT. For an up to date list of contracting States please see www.wipo.int/pct/en/index.html
Demand	An application for IPE. This form is separate from the PCT Request (or application) form.
Digital Certificate	Digital certificates are required for ensuring the validity and security of PCT applications filed electronically. Applicants can use a digital certificate issued by WIPO (free of charge) or the ABN-DSC certificate for their business.
Elected Office	The national patent office or government body acting for the elected State.
Elected State	A country that the IB sends the IPRP (Chapter II) to after International Preliminary Examination. Your demand will automatically elect all the countries that are signatory to the treaty on the date of your application.
IB	International Bureau of the World Intellectual Property Organization.
Infringement	Infringement occurs when someone willingly or unwillingly uses your intellectual property without your permission.

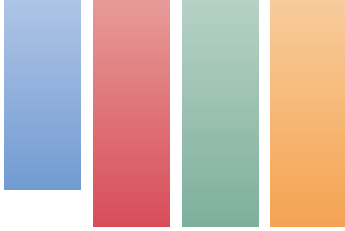
IP AUSTRALIA INTERNATIONAL PATENT APPLICATION GUIDE

International Search	A patentability search, not an infringement search, and accordingly should not be relied upon to identify patents which may be infringed by the claimed invention.
Inventor	Anyone whose involvement and contribution was essential to the development of a new process, appliance, machine or article.
IPEA	International Preliminary Examining Authority conducts the International Preliminary Examination.
IPE	International Preliminary Examination.
IPEO	International Preliminary Examination Opinion. The International Preliminary Examiner may issue one or more written opinions before the International Preliminary Report on Patentability (Chapter II) is issued.
IPRP (Chapter II)	International Preliminary Report on Patentability (Chapter II). Report helps you to assess the invention and decide whether or not to enter the national phase in each of the designated countries. After receiving an ISR and Written Opinion of the ISA, you also have the opportunity to ask for a non-binding preliminary examination. This will alert you to any significant problems with your application.
ISO	International Search Opinion. It is issued automatically with the ISR and covers all issues under IPE. WIPO refers to this as the Written Opinion of the Searching Authority (WOSA).
ISA	International Searching Authority carries out the international search and Written Opinion of the ISA.
ISR	International Search Report contains no comments on the value of your invention but lists citations of prior art relevant to the claims of your international patent application and gives an indication of the possible relevance of the citations to its patentability. This enables you to evaluate your chances of obtaining patents in the countries you have designated.
PCT	Patent Cooperation Treaty.
PCT-EASY	Uses features of the PCT-SAFE software to help you prepare and file your PCT application. The PCT-SAFE software can be operated in PCT-EASY mode where applications are filed on paper, accompanied by request form data and abstract on diskette or other physical medium (CD-R, DVD-R).
PCT-SAFE	Free software provided by WIPO to help you prepare and file your PCT application. It is designed to simplify the process, save you time and provide you with cost savings.

PCT-SAFE Editor	Free software provided by WIPO to help you prepare the specifications for your PCT application in WIPO's preferred XML format. The maximum electronic filing discount will apply to applications filed electronically with XML specifications.
PCT Online	IP Australia's electronic lodgement facility for PCT applications, which can be accessed from the online service section of the IP Australia website. To use PCT Online you will need the PCT-SAFE software from WIPO and a digital certificate.
Request	An application form for PCT.
RO	The national office where the international application is filed then checked and processed is called the Receiving Office. The original of the application is sent to the IB of WIPO and a copy to the ISA who will conduct the international search.
RO/AU	The Receiving Office in Australia is IP Australia.
Rule(s)	The PCT term that refers to the details of the Treaty. In Australia they equate to the Regulations.
SIS	Supplementary International Search is a search performed by an ISA other than the ISA that produced the ISR. The SIS may list citations that do not appear in the International Search Report (ISR). The SIS is an optional service and allows you an opportunity to have documents that may not have been found and listed in the ISR to be located before national phase entry."
SISA	Supplementary International Search Authority carries out the Supplementary International Search
WIPO	World Intellectual Property Organization.
WOISA	Written Opinion of the International Searching Authority.

Contacting WIPO

Address	34 chemin des Colombettes, PO Box 18 1211 Geneva 20, Switzerland
Telephone	General PCT enquiries: (+41-22) 338 83 38 PCT-SAFE help desk: (+41-22) 338 95 23 Opening hours from 08.30–16.00 Central European Time
Email	General PCT enquiries: informationcentre@wipo.int PCT-SAFE help desk: pctsafefirst@wipo.int Multilingual staff are always on hand to answer your questions via email
Website	www.wipo.int For information and tools relating to the PCT



Contacting IP Australia

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Fax	(02) 6283 7999 Business Transactions Fax —for lodgements, filings and business related correspondence such as financial and confidential material. Faxes received at this secure number are receipted at Australian Eastern Standard/ Daylight Saving time.
Email	assist@ipaaustralia.gov.au —for general enquiries. However filing of documents is not available through this address.
Website	www.ipaustralia.gov.au —for information relating to intellectual property, to submit online applications, and to download forms and other documents.

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The date which you provide information to IP Australia can be critical to the certainty of your intellectual property rights.

IP Australia has implemented a set of business rules which establish that when you communicate with us electronically (eg email, fax or online) using our preferred contact numbers and methods, the date and time of communication will be Australian Eastern Standard/Daylight Saving time.

Our preferred means of communication are:

- the IP Australia website—**www.ipaustralia.gov.au**
- our business transactions fax number—**(02) 6283 7999**
- email—**assist@ipaustralia.gov.au**

Communication sent to other contact points electronically will be processed in accordance with the date and time at the place of receipt. These communications will not gain the benefits provided by the *Electronic Transactions Act* such as security and certainty of receipt.

The *Electronic Transactions Act* business rules address a range of issues including:

- identifying the appropriate form of electronic communication to use for different types of correspondence
- choosing electronic payment options
- receiving notifications
- utilising supported electronic formats.

Further details on IP Australia's electronic communication business rules can be found at **www.ipaustralia.gov.au**

ipaaustralia.gov.au

May 2012

