

ABOLITION OF THE SEARCH DISCLOSURE REQUIREMENTS IN AUSTRALIA

In recent times, Australian patent law introduced a requirement that all applicants requesting regular examination of a patent application notify the Australian Patent Office of the results of all official novelty searches carried out by overseas Patent Offices on corresponding overseas applications.

The law was beset by many problems right from the start:

- There was widespread confusion over what searches needed to be disclosed;
- The date of implementation of the law was delayed several times;
- The substantive provisions of the law had to be changed shortly after the introduction of the new law;
- The penalty fees for the late disclosure of prior art was high;
- The cost of complying with the requirements was perceived to be very high; and
- The benefits of the system were limited once Patent Office examination reports were published on the internet by a number of Patent Offices.

This led to a review of the search disclosure laws and ultimately this resulted in the abolition of the law effective from 22 October 2007.

Consequently there is no need to disclose any search results on applications for which examination was requested on or after 22 April 2007.

However, caution needs to be applied in the application of the law to existing pending cases. The duty to disclose search results still applies to applications where examination was requested before 22 April 2007 where the relevant search result was carried out and dated before 22 April 2007.

The sanction for non-compliance with the law still applies to search results that should have been but were not disclosed to the Australian Patent Office. In particular, a claim cannot be amended to remove a ground of invalidity arising as a result of a search result that has not been disclosed. Accordingly, care needs to be exercised in analyzing pending cases.

We believe that the changes to the law are beneficial as they will lead to cost savings, in some cases significant cost savings, to Applicants for patents in Australia.

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