



THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS  
FICPI AUSTRALIA

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To: Nathan Madsen  
Supervising Examiner of Patent Examination Practice

Dear Mr Madsen

**Seeking views on IP Australia's patent search and examination products**

FICPI Australia welcomes the opportunity to respond to the PCG: Seeking views on IP Australia's patent search and examination products.

**About FICPI Australia**

As you may be aware, FICPI Australia is an organisation whose members are all registered Patent Attorneys, Trade Marks Attorneys, or registered Patent and Trade Marks Attorneys who have senior roles in IP firms conducting business in Australia.

**Response**

We provide our response using the headings provided in the request for views in respect of the following four key areas of current patent examination practices:

**1. First office actions and searches**

- a) For example... are you satisfied with our International search products such as PCT and Article 15(5) searches?**  
**b) Do our first examination reports meet your needs?**

**FICPI Response to key area 1 a)**

- 1) On balance our members are satisfied by the AU Originating ISR and WO reports. Due to the diversity of comments received I have provided below paraphrased versions of selected comments by members.
- i. For the vast majority of cases I have handled quite ok.*
  - ii. Some searches are not as good (details included such as the search strategy and relevance of citations) as the product of other IP Offices.*
  - iii. It is not uncommon for another IP Office to cite relevant prior art that was not identified in an AU originating ISR.*
  - iv. It is not uncommon for even the Australian 1<sup>st</sup> Report to cite new prior art that is far more relevant than that cited in the originating ISR where Australia was the ISA*

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### **FICPI Response to key area 1 b)**

- 1) An examination report is a document relating to a purported inventive or innovative technology that may deal with complex legal issues. Attempts to simplify the terminology used can defeat the purpose of the document and ultimately confuse applicants, and disadvantage the legal rights of self-filers seeking to self-prosecute.
- 2) 1<sup>st</sup> Report without citing overseas prosecution  
First reports that do not rely on a report issued in respect to a corresponding application overseas are considered to be of adequate quality by members, although some reports are still being issued, wherein:
  - i. the citations are less relevant than those located by other IP Offices;
  - ii. argument regarding “manner of manufacture” which is formulaic in relation to the citation of recent case law, but absent detailed consideration and cogent argument of the claim language in the context of the field of the invention which is likely different to the facts relied on in the cited case;
  - iii. unsupported statements which contend that a feature or a combination of features are merely common general knowledge or mere design choices.
- 3) 1<sup>st</sup> Report citing overseas prosecution  
First reports that rely on a report issued in relation to a corresponding application are considered to be of adequate quality by members, although some reports are still being issued, wherein:
  - i. simply cross referencing to USPTO / IPRP/WO or EP exam reports or written opinions is pointless in particular for the current Australian law as to inventive step or irrelevant in respect to the claims on file;
  - ii. citations where those same citations have been successfully argued against (based on the same claim set) indicates that the citation has not been fully or properly considered since the objection is likely moot;
  - iii. clarity / conciseness issues, particularly in claims drafted originally in a different language, are not being raised.
- 4) 1<sup>st</sup> Report based on an ISR and WO and an IPRP2, where Australia was the ISA and IPEA.

It would be fundamental that there be consistency between the ISR/WO and IPRP2 on the one hand and the 1<sup>st</sup> Report. There have been recent instances where there have been clear originating IPRP1 or IPRP2 reports issued in relation to all or some claims, and then subsequent Australian 1<sup>st</sup> Reports raising new objections based on manner of manufacture, novelty and inventive step, only to have these subsequent objections overcome without amendment

### **2. The detail and legal rigor of our reports**

***Are objections in reports well-reasoned and do reports contain enough citations?***

### **FICPI Response to key area 2**

- 1) On balance our members are satisfied by the quality of reports and the number of citations, although some reports are still being issued, wherein:
  - a. not all relevant prior art is raised (as determined from corresponding overseas reports);
  - b. refer to 2) ii in key area 1 b);
  - c. refer to 2) iii in key area 1 b);
  - d. an absence of reasoning or inadequate reasoning, particularly where the reasoning relies on overseas law;
  - e. an objection that claims 2 to 5 of an Innovation Patent are not innovative based on common general knowledge.(All the above types of objections add unnecessary cost to the process for applicants)

It would be useful for the report to provide a positive indication (whether binding or not), that section 40 matters have been actively considered and commented on where necessary.

In the context of clarity/conciseness (see for example 3) iii above in relation to area 1 b)) it would help if the 1<sup>st</sup> examination report raised such issues, even if by way of example, in referencing only one claim, identifying the particular issue/s and then generically referring to one or more of the dependent claims having similar issues.

- 2) In relation to the examination of computer-related inventions, there is a trend that seems to be an office directive, for examiners to raise manner of manufacture objections by default in any specification that makes any reference to software to perform the methodology, without due consideration to the invention and the case law. In such instances there is little, or no reasoning provided, just the citation of the latest case. As is seen in jurisdictions such as Europe and USA, there is considerable attention given by the examiner to applying a want of subject matter objection. We consider that applicants of Australian applications deserve the same level of treatment if an examiner considers it appropriate to apply such an objection in this area of technology that is peculiar to Australian case law, especially recent case law. Indeed, applying appropriate rigour by the examiner would actually result in an inappropriate objection not being raised in the first place, or the provision of helpful feedback or suggestion as to what could be done to overcome the objection.

### **3. *Our ability to maintain objections during prosecution***

***Do examiners maintain/rescind objections at further report stages in a manner that instils confidence in the validity of accepted patents?***

#### **FICPI Response to key area 3**

- 1) On balance our members are satisfied that the Australian examination process in the main results in confidence in the validity of accepted patent applications, although some experiences of a robust prosecution process are negative, illustrated by the following comments:
  - a. refer to 2) ii in key area 1 b), the outcome of which in a few cases is ultimately overturned, but only by those applicants that can afford to take the matter to a hearing or other appeal procedure. For applicants who cannot afford to appeal abandonment of rights occurs, leaving the examiner with the impression their stance was correct.Some comments supplied by members follow:
  - i. This situation is improving which is ultimately a good thing as regards more 'robust' granted IP rights;
  - ii. Some examiners argue for the sake of arguing not recognising the cost implication for applicants;
  - iii. Perhaps some guidance like that contained in the USPTO MPEP might alleviate matters (the Examiner's manual is not helpful for all Examiners or applicants, as much as it could be);
  - iv. Sometimes I wish Examiners sought help from Senior Examiners sooner.

### **4. *Our practices of finding further citations during prosecution***

***a) Are we raising additional citations at further stages during prosecution in a manner comparable to other jurisdictions?***

#### **FICPI Response to key area 4**

- 1) On balance our members are satisfied that the Australian examination process raises additional citations in a manner comparable to other jurisdictions, although some experiences are less than ideal, wherein for example:

- a. at times objections based on prior art should be raised earlier, when e.g. the AU examiner is aware that a corresponding application has had more than 1 Office Action (OA) issued. Often they only cross-reference to the 1<sup>st</sup> OA citation/s to raise an objection to similar claims (but not always as is the case when the claims are the same). It is our submission it would be better practice for Examiners to be 'proactive' by indicating that they are aware of all the citations raised in the prosecution history of a corresponding case;
- b. in contrast to the general view outlined above, it may be considered that the citation of additional prior art references at further stages during prosecution is not in a manner comparable to other jurisdictions. This is because of the limited time frame Australian applicants are allowed for achieving acceptance, contrasted by the system of other IP Offices, wherein responding to a report containing a new citation is allowed within a new period of time. The Australian requirement for finalising the prosecution by a fixed due date regardless of when the additional citation is raised, has the potential to cause significant difficulty for Australian patent applicants, in that late citation of new references may not allow adequate time for consideration and response which is sufficient to overcome any newly raised objections. An applicant encountered this exact situation. The relevant dates and actions are provided below:
  - i. 1st report issued 17 August 2016 setting a 17 August 2017 DFA;
  - ii. Response to 1st report filed 19 June 2017;
  - iii. 2nd report issued 14 July 2017;
  - iv. Response to 2nd report filed 7 August 2017;
  - v. 3rd report issued 9 August 2017 citing a new reference D3 which was located in an original search conducted (no original search previously conducted as the Examiner likely relied on a corresponding examination);
  - vi. The attorney devised an amendment which the client hoped would overcome the new objections based on the new D3 reference;
  - vii. 10 August 2017 attorney telephoned the Examiner to discuss, and was advised that the amendment would require a further complete search that had little chance of being completed by the DFA;
  - viii. Other than requesting a Hearing and filing a divisional (both costly for the local client), the client's options were limited and regrettably a decision was made to abandon.

Raising citations at the earliest possible time is considered essential.

**In terms of these 4 key areas of examination, we would also like to know:**

- a) **What you would consider a high quality product looks like; and**
- b) **Which overseas offices produce particularly high quality products and what is it about their work that leads to this view?**

**FICPI Response to the final request a)**

- 1) Our members provided the following elements:
  - a. Clear type face;
  - b. Clear section identification;
  - c. Logical ordering of topics e.g.
    - i. Administrative details (report number, date of issue of the examination, response by date, identification of application and applicant, etc.) all on separate page;
    - ii. Identification of amendment history to claims, specification and any other related information amended to the date of examination
    - iii. Identification of allowable and objected to claims with separate identification of claims specifically lacking patentable subject matter,

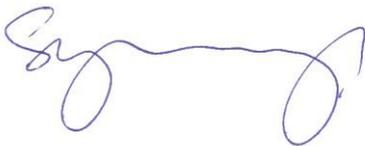
- novelty, and lack of inventive/innovative step (no lumping of novelty and inventive step);
- iv. Listing of cited documents and relevance to which claims;
- v. Section 40 issues clearly supported by argument in respect to each claim with separate analysis on an claim element by element approach, and separate support of objections to novelty and inventive/innovative step;
- vi. Identification of the Examiner and Supervising Examiner.
- d. Less boiler plate phrases than the US report;
- e. Thorough analysis of each element of the claims as opposed to lumping elements of the claim language together;
- f. Lack of paraphrasing the claim language to make it sound like the cited documents' language;
- g. Converse to the previous point is the repetition of the exact claim language interspersed with assumed elements to illustrate that the element/s are the same as a cited element.

**FICPI Response to the final request b)**

- 1) Our members provided a variety of responses but overwhelmingly the US and EP reports were considered of particularly high quality, mainly because they do include items d. to g. of the prior listing of elements.

If further explanation is required of the above or further comment sought on any particular aspect, FICPI Australia welcomes any request for such. Please contact our Secretary, Bill McFarlane or myself in relation to this matter.

Yours sincerely



President – FICPI Australia

cc: FICPI Australia Councillors