Submission of Information by Third Parties

Australia

Section 27 of the Patents Act 1990 states that:

Notice of matters affecting validity of standard patents

> (1) A person may, within the prescribed period after a complete specification filed in relation to an application for a standard patent becomes open to public inspection, notify the Commissioner, in accordance with the regulations, that the person asserts, for reasons stated in the notice, that the invention concerned is not a patentable invention because it does not comply with paragraph 18(1)(b).
> (2) The Commissioner must inform the applicant for the patent in writing of any matter of which the Commissioner is notified and send the applicant a copy of any document accompanying the notice.
> (3) The Commissioner must otherwise consider and deal with a notice in accordance with the regulations.
> (4) A notice and any document accompanying it are open to public inspection.

Section 27 enables any person to file a notice asserting that the invention in a standard patent application is not patentable due to a lack of novelty and/or inventive step. This notice must be filed between the date the application was opened for public inspection and three months after publication of the acceptance of the application. The notice must include reasoning as to why there is a lack of novelty and/or inventive step, accompanied by prior art documents used to support this contention. Section 28 of the Patents Act provides analogous procedures for innovation patents to allow any person to allege a lack of compliance with paragraph 18(1A) (b) due to lack of novelty and/or innovative step.[1]

[1] It is no longer possible to file a new application for an innovation patent. However, an applicant who has filed a patent application before 26 August 2021 (the effective date of Sch 1 Pt 2 of the Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2020 (Cth)) may file an amendment to convert that application to an application for an innovation patent or use that application to file a divisional application for an innovation patent.