

Modified examination: the risks.

We generally recommend requesting normal examination rather than modified examination. Here's why.

Modified examination may lead to the grant of an Australian patent which fails to provide adequate protection under our national laws. Modified examination may also lead to patents being granted that are vulnerable to revocation in part or as a whole. Some relevant issues are:

1. With modified examination, the costs of making word for word amendments (with minor formality exceptions) where differences exist between the specifications, may alone off-set any cost savings that modified examination procedures may provide when compared to normal examination.
2. Modified examination is confined to an assessment of the novelty and inventive step of the invention defined in the claims. While novelty standards may be practically similar in most countries, the same cannot be said for the question of whether an invention is obvious or not. Limitations present or introduced during prosecution of the claims of the granted foreign patent may unnecessarily restrict the scope of the claims in Australia.
3. Because of the limited extent of examination under modified examination, there is risk that the claims, while otherwise perfectly acceptable under foreign patent laws, may fail Australian statutory requirements of clarity and fair basis.
4. Because, under modified examination, the claims have to be amended to agree with the claims granted in the corresponding foreign patent, it is not possible to change their wording to allow for specific drafting practices used in Australia that have evolved with case law. In this regard, there have been Court decisions in Australia interpreting the word "comprises" or "comprising", when used in a patent specification to mean: "consists of", "is made up of", "is composed of" or "is constituted by".

Thus the words "comprises" or "comprising" may be interpreted in Australian Courts as far more limiting than the overseas draftsman of the specification intended.

The procedures associated with modified examination can potentially provide cost savings in two cases only:

- where the text of the Australian patent specification as filed is identical with the text of the English language patent as granted by the overseas patent office, with the possible exception of the claims; or
- where the application is susceptible to an objection of lack of unity of invention and the relevant granted patent covers more than one invention. In this case, the costs associated with filing one or more divisional patent applications that might have been required under normal examination could be avoided by utilising modified examination.

On the other hand, even if cost savings are available with modified examination in any particular case, it may still lead to the grant of a patent which may have validity problems or may be interpreted by Courts more narrowly than might have been expected.

If you are satisfied that the scope of the claims granted on the corresponding overseas patent is adequate for your needs and you are contemplating modified examination of the Australian case, we suggest you seek our assistance in assessing whether the Australian application is suitable for modified examination or whether it might be preferable to request normal examination. In such a case it would be helpful if you could identify the changes, if any, between the granted overseas patent and the specification existing in the Australian case.

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