



PATENTS CONSULTATION GROUP - MEETING SUMMARY

10 April 2024

The **Patents Consultation Group (PCG)** met on Wednesday, 10 April 2024 via Microsoft Teams. The Chair opened the meeting and welcomed everyone. Attendances and apologies were noted, with two new representatives attending from AIPPI and IPSANZ. Members endorsed the Minutes of the meeting held on 23 November 2023.

The Fee Review has been sent for Ministerial approval. If approved, new fees will take effect in October 2024. All submitted member views were taken into consideration during the development of this proposal and further details will be provided once approvals have been obtained.

A new database platform, Australian Patent Search, similar to AusPat with a fresh interface however, has been launched. Members' input on the new interface was gratefully appreciated. Both search platforms are running in parallel until AusPat is retired at the start of the new financial year.

Ongoing enhancements are taking place regarding **file format for Sequence Listings** alignment with WIPO ST.26. It is now possible to upload large files in zip format.

Direct Contact with Patent Examiners is encouraged via phone, however, if unable to reach examiners, speak to a section head, assistant general manager or the Chair. There was concern that the time difference between the location of examiners could impact contacts. Re-examination cases may not necessarily need to be file noted into correspondence unless they are materially relevant to the case. This will be communicated to the examination team to ensure the difference between simple queries and complex issues are recognised.

An update was provided on **Free Trade Agreements & Indigenous Knowledge**, noting that the focus continues on finalising a treaty on patent disclosure with text having been provided from FICPI clarifying information required during the patent life cycle, remedies for "failure to disclose," and guidance for applicants. Feedback on the WIPO Diplomatic Conference can be submitted via the website (<https://consultation.ipaustralia.gov.au/policy/igc-dip-con-patent-disclosure/>) or directly to Edwina Lewis. Discussions have commenced regarding a **Free Trade Agreement (FTA)** with the United Arab Emirates (UAE). Members may provide further comments on the UAE FTA negotiations via email to UAECEPA@dfat.gov.au.

A questionnaire will be released seeking preferences on different issues surrounding the **Patent Law Harmonisation Proposals**, with further meetings planned for mid-June 2024 to discuss feedback. Currently a document has been produced which summarises the work completed to date, noting pros and cons of each option.

The **WIPO PCT Working Group** met in Switzerland in February 2024 and approved amendments to the rules to include allowing receiving officers to require electronic filing. Paper-based applications may still be filed through the international bureau. Work is still ongoing regarding electronic processing and a proposal for colour drawings.

Research and consultation around **Computer Implemented Inventions** continues. The focus is on comparing outcomes in Australia with other jurisdictions, and the propensity of applicants to file in Australia. This information will be assessed by the Executive team at IP Australia and a decision will be made accordingly as to if additional policy work is warranted in this area.

Several observations were made regarding the patenting of **Computer Implemented Inventions (CII)**, including a suggestion as to if a broad review of the manner of manufacture test is warranted. Further discussion will be ongoing in this forum.

The United States Patent and Trademark Office (USPTO) released practical guidance on AI-created inventions. IP Australia will consider if additional guidance on inventorship relating to **Artificial Intelligence Assisted Inventions** may be required if case law is not sufficient. Unless AI is named as an inventor, IP Australia take a Prima Facie approach to inventorship. A query raised by members was the extent of human ingenuity and whether third-party AI needs to be disclosed, which could cause many challenges investigating this in patent applications. Further discussion about AI assisted inventorship will continue at this forum.

Recent discussions have occurred within the IPTA council meeting regarding the **Patent Case Management Service**, where concerns were raised about the perception that IP Australia is providing advice through this service. Further discussions will continue within IPTA and feedback will be shared with IP Australia.

The next PCG meeting is tentatively scheduled for 7 August 2024, in Sydney and via MS Teams.