



PATENTS CONSULTATION GROUP - MEETING SUMMARY

13 November 2024

The **Patents Consultation Group (PCG)** met on Wednesday, 13 November 2024 in Melbourne, and via Microsoft Teams. The Chair opened the meeting, performed an Acknowledgement of Country, and welcomed all participants, including a guest Supervising Patent Examiner. Attendances and apologies were noted. Members endorsed the Minutes of the meeting held on 7 August 2024 with several amendments requested.

The Chair reviewed the agenda, noting the Boeing Australia site visit later in the day, policy updates, and other items. The **Fee Review** changes, effective from 1st October 2024, will be assessed with feedback welcomed for future reviews. No major issues were noted, though a spike in examination requests occurred in September before the new fees came into effect. For the first 6 months, customers requesting expedited examinations will be informed about excess claim fees and assisted during the transition.

An **Indigenous Knowledge** update was provided on the new WIPO treaty on Intellectual Property, Genetic Resources, and Traditional Knowledge, which concluded in May and establishes a framework for patent disclosure of source requirements. The treaty will move to signature and ratification following domestic legal processes. IP Australia is considering options to add a disclosure requirement to the Patents Act and will consult further. A new pilot Indigenous Knowledge panel with three Aboriginal and Torres Strait Islander experts will be established within IP Australia to advise on applications involving Indigenous Knowledge and broader policy work. Discussions with the Intellectual Property Office New Zealand (IPONZ) have occurred previously to learn from New Zealand's approach, which includes Māori Advisory Panels, though adaptations will be made for Australia's context.

In the **Free Trade Agreement (FTA) policy update**, negotiations with the United Arab Emirates (UAE) on a new Comprehensive Economic Partnership Agreement concluded. The agreement, available on the DFAT website, promotes cooperation, information exchange, and IP protection and enforcement. It also includes a standalone First Nations chapter, recognizing the contributions of First Nations people and businesses. Further details will be provided to members out of session.

Text of new WIPO GRATK Treaty - [GRATK/DC/7 Prov.](#)

AU-UAE Agreement DFAT webpage - [Australia-UAE Comprehensive Economic Partnership Agreement \(CEPA\)](#)

The **Group B+ Substantive Patent Law Harmonisation (SPLH)** Working Group (WG) is exploring options for implementing a grace period, prior user rights, and addressing conflicting applications. The WG issued a questionnaire to stakeholders, receiving forty responses. An initial draft summarizing these consultations is currently under review by WG members. The next steps involve identifying areas for consensus. The next WG meeting is scheduled for late December 2024, with another meeting planned for February 2025.

The **Client Attorney Privilege (CAP)** Core Group met in September to discuss IP Australia's work plan for the next 12 months. Feedback indicated that the original plan didn't allow enough time for stakeholder responses, so consultation times have been extended. The goal is to have a summary ready for the Group B+ plenary in July 2025, where approval for any changes to the agreement or explanatory report will be sought. Stakeholder consultations will continue as the work progresses.

An update was provided on **Computer Implemented Inventions (CII)**, and noted the commissioned research comparing IP Australia's approach to computer-implemented inventions with other key jurisdictions has been finalised and published on the [IP Australia website](#). A targeted consultation on CII remains underway, to gather evidence which will assist in understanding if change is required. The delay is due to late stakeholder requests, but responses to contributing stakeholders will be sent out soon, and de-identified for privacy. The research, consultation responses, and key takeaways will be discussed at the next PCG meeting in 2025. IP Australia appreciates stakeholder engagement and invites queries to the Chief Economist Group at: ChiefEconomist@ipaustalia.gov.au.

An update was provided on the potential impact of **Issue Estoppel** from post-Raising the Bar opposition appeals and the observed decrease in filed oppositions. The Law Council of Australia's paper on Issue Estoppel prompted a review of IP Australia's data, revealing fewer oppositions and appeals, an increase in third-party re-examinations, and no clear pattern in section 27 notices. The high cost of oppositions and other commercial factors may influence these trends. Discussions highlighted the complexities

of opposition versus revocation, with no single issue standing out as a key factor. The data on re-examination requests and section 27 notices may be skewed by specific factors.

The discussion of the standing agenda item “**Examination Practice**” covered examination topics, including approach and consistency among examiners and technology streams at IP Australia. A recent in-person training event on Computer Implemented Inventions aimed to improve examiners' report writing and objection articulation skills. Online materials were also developed to update examiners on the latest case law. "Best Practice" refresher training will be provided across all technologies, with a focus on providing clear reasoning in reports and guidance about raising common general knowledge. IP Australia's Customer Insights and Improvement Team will survey patent customers in early 2025 for feedback on IP Australia processes. PCG discussions highlighted differences in examination approaches between Australia and the US, the impact of late objections, and the potential benefits of Quality Workshops to address issues in examination reports.

The next PCG meeting is scheduled for 10 April 2025 in Canberra and via MS Teams.

Meeting Summaries of our Consultation Groups can be found on our website: [Consultation Groups | IP Australia](#). For further information, please contact mdb-patents-consultation-group@ipaustralia.gov.au.