



# PATENTS CONSULTATION GROUP - MEETING SUMMARY

7 August 2024

The **Patents Consultation Group (PCG)** met on Wednesday, 7 August 2024 via Microsoft Teams and in Sydney. The Chair opened the meeting, performed an Acknowledgement of Country, and welcomed everyone. Attendances and apologies were noted. Members endorsed the Minutes of the meeting held on 10 April 2024 with several amendments noted.

The Chair highlighted the successful outcome of the **WIPO Diplomatic Conference**. Thanks were given to the Law Council of Australia for their Information Paper on Estoppel. The ongoing **Fee Review** was discussed. An information pack will be provided to stakeholders before the changes are introduced.

An **Indigenous Knowledge** update was provided on the Treaty on Intellectual Property, Genetic Resources, and Associated Traditional Knowledge. This treaty establishes international rules for disclosing the source of Indigenous peoples' genetic resources and traditional knowledge in patents. The treaty will undergo signature and ratification processes, including domestic legal and parliamentary procedures. IP Australia is considering how to incorporate a disclosure requirement into the Patents Act, with consultations to follow once domestic processes are completed.

In the **Free Trade Agreement (FTA) policy update**, Australia is negotiating an FTA with the United Arab Emirates (UAE). Concerns were noted relating to the high costs of legalisation and apostille of documentation, particularly for patents requiring a Deed of Assignment. A workaround involves filing outside the UAE in the first instance. The issue will be raised with FTA negotiators, aiming to conclude negotiations by 2024. The notarisation requirement for Australian assignment documents has also been removed, reducing costs for clients. Members are encouraged to provide further comments on the UAE FTA negotiations via email.

An update on the **Group B+ Substantive Patent Law Harmonisation (SPLH)** efforts was provided. The Working Group is exploring options for implementing a grace period, prior user rights, and addressing conflicting applications. A questionnaire was sent to stakeholders, receiving approximately 40 responses. The Working Group presented their findings at a plenary meeting in July 2024, and the next steps include analysing the questionnaire results and conducting further stakeholder meetings, with a focus on prior user rights. The next meeting is scheduled for September 2024.

Regarding **Client Attorney Privilege (CAP)**, IP Australia has taken up the lead role in this area following the July Group B+ plenary meeting. The Core Group will next discuss a 12-month work plan to summarize consultations, propose necessary changes to the text or explanatory report, and seek support at the next Group B+ plenary meeting. IP Australia's goal is to make progress to an outcome, for example without reopening old discussions or expanding the scope.

At the WIPO General Assemblies, the **PCT Union** adopted amendments to PCT regulations, including accepting electronic filings only, expanding official languages to 10, and broadening the definition of relevant prior art to include non-written disclosures. Discussions with the EPO about the Unified Patent Court revealed over 200 cases resolved within an average time of 6 months. The next Meeting of International Authorities of the PCT in October will cover topics such as reappointment of International Authorities processes, PCT Minimum documentation, PCT online services, and improving international search and opinion report templates. The Standing Committee on the Law of Patents will also meet in October to discuss AI-related patent issues, Standard Essential Patents, and FRAND licensing.

The **Computer Implemented Inventions (CII)** project has experienced some delays due to finalising research. Thirteen stakeholder submissions were received, offering diverse views currently under consideration. The research compares outcomes in Australia, Europe, and the U.S., including court decision impacts. Due to confidentiality, submission content will be shared at a high level. Evidence gathering continues. IP Australia's Chief Economist highlighted the research as a starting point, complemented by U.S. studies. Discussions covered the application of law, IP Australia's court involvement, and public interest considerations. IP Australia adheres to legal advice and the Patents Act, and the Chair assured impartiality in following the law.

**Examination practice** was discussed, focussing on the examination approach and consistency among examiners and between technology streams. Concerns about numbering amendment items and missing international phase documents in national phase filings are being addressed, with improvements since October 2023. Feedback highlighted inconsistencies and increased objections in patent prosecution highway cases. The Chair emphasised the quality management system in place and the use of quality campaign reviews to identify systemic issues. Feedback from members on various examination issues is being considered.

Additionally, feedback received about the incidence of specification assembly errors following acceptance will be passed on to administration staff to consider.

Further discussion was held regarding **AI Assisted Inventions**, where suggested edits were made regarding content in a draft paper that discussed the inventive contribution of human inventors when AI is involved for further discussion at the next PCG meeting. It was also suggested that IPTA review the draft and further international developments be monitored, with ongoing WIPO discussions noted by the Chair.

The next PCG meeting is scheduled for 13 November 2024, in Melbourne 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](mailto:mdb-patents-consultation-group@ipaustralia.gov.au).