

## Modified Examination of Patents

### What is Modified Examination?

A patent may be granted in Australia for an invention first patented elsewhere. However, the specification for the Australian patent application may need to be amended to bring it into conformity with that of the patent granted in the prescribed country.

Modified examination means that the Examiner must report on whether the application complies with the requirements of the Patents Act 1990, whether the Australian specification conforms with the granted patent, and whether the invention claimed is novel.

### How does it differ from Ordinary Examination?

Ordinary examination of an Australian patent application requires the Examiner to examine the application and specification for compliance with the provisions of the Act, especially for compliance with Section 40, i.e. the fair basis of the claims, the clarity of the claim language and whether the claims fully define the invention, as well as for the novelty and inventiveness of the claims.

In modified examination, the Examiner cannot object that the application claims more than one invention, and is not empowered to examine the claims for compliance with Section 40.

Although the Examiner is not required to examine the specification for compliance with Section 40, once the application has been accepted all grounds of opposition to the application and revocation of a patent granted on that application will apply. Non-compliance of a specification with the provision of Section 40 is a ground of both opposition and revocation.

### Problems with Modified Examination

In view of the differences between Australian patent laws and those of other countries, it is often undesirable to obtain an Australian patent with a specification which is based on foreign requirements, particularly those of the United States or the European Patent Office.

For example, it can be undesirable to include in the specification an American-style introduction, which includes object statements directed to preferred aspects of the invention, as this may result in a narrow interpretation being placed on the invention. This may, in turn, result in broad claims of the patent being held invalid on the ground that they are not fairly based on the matter set forth in the specification.

Furthermore, United States claims may include limitations which are undesirable under Australian practice. If modified examination is requested, it is necessary to include these limitations in the Australian claims.

Modified examination can cause particular problems in chemical and pharmaceutical cases. US requirements regarding unity of invention are very different to those in Australia; if claims have been cancelled in response to a restriction requirement in the US, they can only be reinstated during normal examination. Claims for methods of medical or veterinary treatment are not allowable in European or British patents, and "second medical use" claims are allowable only in a very restricted form. Treatment claims are allowable in Australia and, again, such claims can only be reinstated or inserted during ordinary examination.



The amendments allowable under the modified examination procedure are very limited in nature. They can therefore make it difficult to overcome any novelty or inventive step objection which arises if the Examiner locates prior art that is more relevant than that raised in the granted case. In such cases, it is often necessary to withdraw the request for modified examination and request ordinary examination to provide better scope for amending the claims to distinguish from the prior art and still obtain worthwhile protection.

If you do wish to request modified examination, we suggest that it be based on a patent granted in the United Kingdom, since the UK specification and claims are more likely to conform with Australian practice, subject to the limitations referred to above.

**For more information please visit our website  
[www.griffithhack.com.au](http://www.griffithhack.com.au)**

