

Improving the linkage between the international and national phases of the PCT procedure.

National phase examination at IP Australia is based on a set of principals which make up our best practice guidelines (section 2.1 of the Australian Patent Office [Manual of Practice and Procedure \(M.P.P.\)](#)). One of the guiding principles for best practice is the effective use of Foreign Examination Reports (FERs)¹ and search results. IP Australia considers that by utilising work previously performed on related family members by IP Australia and other IP Offices this can provide a higher level of quality, as well as considerable efficiencies for both IP Australia and the applicant.

Accordingly, IP Australia encourages its examiners to efficiently utilise the work products of the international phase and the work products established by other Offices in the national phase. In doing so, examiners must verify that positive or negative novelty/inventive step findings in a FER or earlier search are applicable under Australian law. Examiners check that the reasoning in the FER is both accurate with regard to the citation and relevant to the claims under consideration. Any findings on other examination issues such as sufficiency or clarity is also considered and assessed for relevance and correspondence to Australian law (M.P.P. 2.1.9.3.3).

In relation to the provision of international work products, IP Australia encourages its examiners to use earlier search results wherever they are deemed as appropriate and applicable to the application under consideration. The process requires a careful comparison of present and earlier applications in order to identify efficiencies in search strategy, for example an ability to limit the current search to a top up search of the earlier search or a minor extension of the search into additional IPC, ECLA, or US classification areas (M.P.P. 1.1.8.1).

Under our Patent Prosecution Highway (PPH) pilot arrangement with the USPTO, Examiners also review the conclusions of the USPTO/ISA/IPEA in accordance with the procedures for using FERs (M.P.P. 2.13.4.4 & M.P.P. 2.1.9).

Examiners at IP Australia need to have due regard to FERs at all stages of examination. It is the responsibility of examiners to ensure that the FERs being considered are up to date and relevant (e.g. closest family member) at both first and further report stages (M.P.P. 2.1.9.2).

Finally, in the interests of efficiency, when an application is due to be examined at the Australian Patent Office and a particular examiner has already had substantial involvement with the application, for example during the International Phase, the application is allocated to the examiner who was previously involved with the earlier application (M.P.P. 2.2.5).

¹FERs include IPRPI/IPRPIIs, Supplementary International Search Reports, PCT Third Party Observations, national search and examination reports prepared by IP Australia (e.g. reports on (grand)parent applications), and foreign national search and examination reports prepared by the International Authorities or other foreign offices.