



## 1. Grace period

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Beware of the grace period trap in Australia. It requires the filing of an Australian complete (convention filing or PCT application designating Australia) 12 months after the pre-filing disclosure. A post-disclosure priority date provided by a US provisional or other non-Australian filing will not suffice. In addition, it may not be possible to rely on extension of time provisions to extend the grace period under these circumstances.

## 2. Divisional applications

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Filing divisional applications is easy in Australia. One or more divisional applications may be filed while an application remains pending and up to 3 months after advertisement of its acceptance. Double patenting will not be an issue provided that the claims on a divisional application are not identical to those on a parent case.

## 3. Excess claim fees

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A new claim fee procedure applies to applications where examination is requested on or after 1 October 2024. Excess claim fees of US\$100 for each claim over 20 and US\$200 for each claim over 30 will apply to applications having:

- more than 20 claims at the time the first examination report is issued; and
- more than 20 claims at acceptance where the number of claims increases after the first examination report is issued.

## 4. Accelerating examination

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While Australia is a party to the Global Patent Prosecution Highway that can leverage a positive prosecution result from certain counterpart applications, Australia has a unique process to accelerate examination on the basis of commercial need, without requiring a corresponding allowed or granted case. This process has no official fees and can shorten the time frame from requesting examination to issuance of a first examination report from 24 months to 4 weeks.

## 5. Claim language

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Australian courts can construe words like 'comprises' and 'contains' in an exhaustive sense in certain circumstances. We understand that the Japanese term 'fukumu' (含む in kanji and ふくむ in kana) can be translated into various English terms such as 'comprising', 'containing' or 'including'. If an inclusive construction is intended, then in order to avoid any difficulty in Australia with an unintended construction, we recommend that the English translation of the specification be prepared so that any instance of 'comprises' or 'contains' is replaced by 'including' or 'includes'. In Australia, the words 'including' and 'includes' are both construed in an inclusive sense.