

**Via E-mail Only**[ip.policy@mbie.govt.nz](mailto:ip.policy@mbie.govt.nz)

9 July 2019

Business Law Team  
Building, Resources and Markets  
Ministry of Business, Innovation & Employment  
PO Box 1473  
Wellington 6140  
New Zealand**Re:** Discussion Paper - Intellectual Property Laws Amendment  
Bill - Patents Act 2013, Trademarks Act 2002,  
Designs Act 1953

Dear Business Law Team,

I refer to the discussion paper published in May 2019 seeking comments in relation to a number of law reform proposals put forward by the Ministry of Business, Innovation & Employment (MBIE). The submission below is limited to the proposals relating to the Patents Act 2013 that appear as items 1.3 and 1.4 of the discussion paper. These proposals are put forward to address problems caused by provisions in the Patents Act 2013 that only allow a claim to have a single priority date. Before commenting on the proposals, I make the following brief comments in relation to my background and interest in the Paris Convention, and more particularly, multiple and partial priorities.

**Background**

I have been a Partner/Principal of Davies Collison Cave Pty Ltd since 1998, and I am currently the President of the Institute of Patent and Trademark Attorneys of Australia (IPTA), where I have been a member of the Council since 2001. Earlier this year, I was also appointed the Vice President of the Study & Work Commission (CET) of International Federation of Intellectual Property Attorneys (FICPI) for a period of three years.

During my time on the IPTA Council I have been Convenor of the International Patents Committee and Convenor of the Patents Legislation Committee. During my time as Convenor of the International Patents Committee I had responsibility for monitoring developments in patent law and practice in New Zealand. I have maintained my interest in New Zealand law and practice since that time and remain a member of the International Patents Committee. I am also an active member of the more recently established New Zealand Committee of IPTA.

In the lead-up to the Raising the Bar Act I provided IP Australia with an analysis of previous Section 96 of the Patents Act 1990, in which I explained how it failed to implement effectively provisions corresponding to Article 4C(4) of the Paris Convention. As a result of my analysis and submissions, the provisions of Section 96 were amended and are now in conformity with Article 4C(4) of the Paris Convention. This initial work in relation to Article

4C(4) of the Paris Convention sparked my interest, more generally, in the Paris Convention.

During my time on the IPTA Council between 2004 and 2006, and when Neville Harris was the Commission of Patents of IPONZ, I served as a member of the Client Liaison Board of IPONZ. This involved travelling to New Zealand and meeting with IPONZ and representatives of the Ministry. I have also maintained since that time a keen interest in the development of patent law in New Zealand and have monitored closely such developments. I reviewed in detail an exposure draft of a New Zealand Patents Bill released for consultation on 20 December 2004. When I carried out that review, I immediately noticed that the draft Bill did not include a provision that allowed a single claim to enjoy more than one priority date. My submission of 10 March 2005 addressed to the attention of Warren Hassett, Regulatory and Competition Policy Branch, made a recommendation to amend the Bill to allow a claim to enjoy more than one priority date. I made particular reference to Section 43(3) of the Patents Act 1990 which was an example of such a provision.

In addition to my role on the Council of IPTA, I have also been an active member of the International Federation of Intellectual Property Attorneys (FICPI), becoming a member of the international patents group of FICPI's study and work commission in 2001. As a member of that group, I conducted a survey of the law of 25 different countries and regions to better understand the ways different countries had implemented the provisions of Article 4C(4) of the Paris Convention. I published the results of my study in 2010<sup>1</sup>, and published a number of articles and gave a number of presentations in 2011 and 2012<sup>2</sup>. In 2012 I published an Article 4C(4) in the Journal of the Chartered Institute of Patent Attorneys (UK)<sup>3</sup>. Since then I have consulted with many companies in relation to Paris Convention issues, including avoiding problems associated with relying on Article 4C(4) to reset a priority period.

In 2012 I became the Chair of the international patents study group of FICPI's Study & Work Commission (CET-3), and carried out research in relation to Article 4 of the Paris Convention. In particular, I carried out a detailed study of the way different countries have interpreted Article 4A(1) of the Paris Convention, particularly in relation to the transfer of priority rights and the meaning of the expression "successor in title". The study allowed me to produce a set of guidelines for FICPI members and their clients to assist them in avoiding problems associated with the ineffective transfer of priority rights<sup>4</sup>. I have also published articles in relation to Article 4A(1) of the Paris Convention<sup>5</sup>. Also during my time as Chair of CET-3, we needed to formulate FICPI's response to the poisonous priority and poisonous divisional problem that had arisen in Europe. This involved preparing and filing an Amicus Brief with the Enlarged Board of Appeal of the European Patent Office. The Enlarged Board of Appeal found that the complete solution to the problem of poisonous priority and poisonous divisionals is to be found in Article 88(2) EPC (second sentence), which states "where appropriate, multiple priorities may be claimed for any one claim". This provision of the EPC was actually proposed by FICPI in 1972 in an official memorandum entitled "Memorandum C", which was referred to by the Enlarged Board of Appeal in confirming that there are no restrictions on the ability of a claim to claim multiple priorities under the EPC<sup>6</sup>.

When I first saw the New Zealand Patents Act 2013, I noticed that it did not include a provision that allowed a single claim to enjoy more than one priority date. Given New Zealand had implemented a whole of contents novelty approach to "secret" prior art I knew

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<sup>1</sup> <https://dcc.com/app/uploads/2019/06/FICPI-Report-on-Article-4C4.pdf>

<sup>2</sup> <https://dcc.com/patents/paris-convention-traps-for-patentees-the-hidden-dangers-of-claiming-priorit>

<sup>3</sup> <https://dcc.com/app/uploads/2018/12/When-is-it-safe-to-refile-priority-application.pdf>

<sup>4</sup> [https://ficpi.org/\\_uploads/gonzo/Guidelines\\_For\\_Transferring\\_Priority\\_Rights.pdf](https://ficpi.org/_uploads/gonzo/Guidelines_For_Transferring_Priority_Rights.pdf)

<sup>5</sup> <https://dcc.com/patents/guidelines-for-transferring-priority-rights>

<sup>6</sup> <http://www.dvarim.fr/law-practice/Memorandum.pdf>

immediately that New Zealand would have a significant poisonous priority problem, not to mention problems providing the protection required under Article 4B of the Paris Convention. This prompted me to write an article explaining how the problem arises<sup>7</sup>. I am very familiar with the way whole of contents novelty can apply to applications that are related through sharing a priority.

In 2018, I carried out a detailed study of the history of prior claiming and whole of contents novelty, and the work I carried out has been utilised by FICPI, IPTA and other organisations to assist them in adopting positions in relation to the best approach to dealing with conflicting applications. I have summarised the results of my study in a paper entitled "The Problem with Secret Prior Art".<sup>8</sup> In that paper I concluded that whole of contents novelty, without protection against self-collision, is the best approach to dealing with conflicting applications in a first to file system, "provided it is possible to fully recognise multiple and partial priorities within a single claim". FICPI agreed with this assessment and my paper is included in a position paper published by FICPI setting out FICPI's position in relation to conflicting applications<sup>9</sup>. Interestingly, at its World Congress in Cancun in September 2018, the International Association for the Protection of Intellectual Property (AIPPI) passed a resolution that also promoted whole of contents novelty, without protection against self-collision, as the preferred approach for dealing with conflicting applications<sup>10</sup>. The resolution includes the following statement in its resolving clause:

"There should not be provisions to avoid self-collision for examining novelty, but only **provided that there is full recognition of multiple and partial priority rights for individual claims.**" (emphasis added)

Accordingly, AIPPI also appreciates the need to allow a single claim to have more than one priority date.

I am also very familiar with the AstraZeneca patents which were the subject of the decision of the Full Federal Court in *AstraZeneca AB v Apotex Pty Ltd* [2014] FCAFC 99 (12 August 2014)<sup>11</sup>. I was responsible for prosecuting these patents to grant and worked with the legal team defending the patents, particularly in relation to the multiple and partial priority issues raised in that case. Unfortunately, since the Full Federal Court was focused primarily on the inventive step issues, upon which the case was ultimately decided, insufficient consideration was given to interpretation of Section 43(3) of the Patents Act 1990. As with Article 88(2) EPC second sentence, this provision should be sufficient to avoid any possibility of poisonous priority arising under Australian law.

The real purpose for the introduction of Section 43(3) was not mentioned in the decision, and it is unclear whether it was brought to the attention of the court. Prior to the commencement of the Patents Act 1969 (which amended the Patents Act 1952) Section 44(2) required applicants to insert a priority date against each claim of a set of claims. Prior to 1969, if an applicant wanted to rely on multiple or partial priorities as provided for under Article 4G of the Paris Convention, it was necessary for the applicant to split the claims into parts to which the earlier priority dates could be attached. Because this requirement was unusual to Australia, it became the role of the designated Australian patent attorney to analyse priority applications and determine which parts of the claims were entitled to which priority date, and then to prepare a set of claims in which each claim could be designated a single priority date. This practice caused difficulties for both patent attorneys and

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<sup>7</sup> <https://dcc.com/patents/publicationspoisonous-priority-arrives-in-australia-and-new-zealand/>

<sup>8</sup> <https://dcc.com/app/uploads/2018/10/Article-The-problem-with-secret-prior-art.pdf>

<sup>9</sup> [https://ficpi.org/\\_uploads/gonzo/FICPI-WP-2018-001-Patent\\_Law\\_Harmonization.pdf](https://ficpi.org/_uploads/gonzo/FICPI-WP-2018-001-Patent_Law_Harmonization.pdf)

<sup>10</sup> [https://aippi.org/wp-content/uploads/2018/10/Resolution\\_Conflicting-patent-applications\\_English.pdf](https://aippi.org/wp-content/uploads/2018/10/Resolution_Conflicting-patent-applications_English.pdf)

<sup>11</sup> <http://www8.austlii.edu.au/cgi-bin/viewdoc/au/cases/cth/FCAFC/2014/99.html>

examiners, and much time and money was wasted splitting claims and setting out the priority dates next to the claims. In order to remove this wasteful practice, the Institute of Patent Attorneys of Australia (as it was then called) made a submission to the effect that the requirement to list a priority date next to each claim be removed, and that a provision be introduced to clarify that several priority dates could apply to a single claim.

Accordingly, the provision that required a priority date to be designated for each claim, Section 44(2), was replaced with a new Section 44(2) that specified that a single claim could enjoy multiple priority dates. In the Patents Act 1990, the equivalent provision is now Section 43(3). Unfortunately, the Full Federal Court does not appear to have been made aware of this background to Section 43(3). While the comments made by the Full Federal Court of Australia in relation to Section 43(3) represents *obiter dicta* (the patent being revoked due to lack of inventive step) the fact that five judges of the Full Federal Court expressed this view gives their comments more weight than would otherwise be attributed to *obiter dicta*. It is important to note that the interpretation of Section 43(3) by the Full Federal Court does allow multiple and partial priorities to be recognised in a single claim when the claim clearly sets out the alternative forms within its scope, for example where the word "or" is used or where Markush groups are presented.

Through my role as Convenor of the Patents Legislation Committee, and more recently as President of IPTA, I have been working with IP Australia to propose a legislative amendment that will allow Section 43(3) to achieve its intended purpose. For example, Section 43(3) might be amended to refer to "form or variant", rather than just form. In this regard, it appears that the Full Federal Court took the view that "variants" of an invention were not to be equated with "forms" of an invention. The issue is currently on IP Australia's policy register with Policy ID 18<sup>12</sup>. Although the title and description of the item on the register refers to self-collision, the work being done to address the problem is focussed on making Section 43(3) work in the way that was intended. Not only will this address the poisonous priority issues, but also ensure that multiple and partial priorities are fully recognised, as they are now recognised in Europe.

Finally, in relation to my experience with the Paris Convention, I mention that earlier in the year I was invited to give a presentation on priority entitlement at a meeting organised by FICPI Sweden in Stockholm. I will also be giving a presentation on priority entitlement in October at a FICPI forum to be held in Vienna. In May next year I will be giving presentations in New York, Washington DC, Boston and Philadelphia on Paris Convention priority issues, including multiple and partial priorities. I have also recently prepared a questionnaire for FICPI which will be distributed to national delegates to gather information in relation to the way multiple and partial priorities are recognised to help FICPI determine, among other things, whether there are countries other than New Zealand and Australia that have laws that can give rise to poisonous priority and poisonous divisionals.

### Submissions

Against this background, I would like to make the following comments in relation to the proposals set out in the discussion paper.

The problems raised under section 1.3 (poisonous priorities and poisonous divisionals) and section 1.4 (multiple priority dates for claims) all stem from the fact that the Patent Act 2013 gives priority dates to claims themselves, rather than to subject matter within the scope of the claims. As a result, the Patents Act 2013 fails to accord the protection a patent or patentee is entitled to under Article 4B of the Paris Convention in respect of claims that rely on multiple and partial priorities as provided for in Article 4G of the Paris Convention.

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<sup>12</sup> <https://www.ipaustralia.gov.au/policy-register/amend-rules-determining-priority-patent-claims-prevent-self-collision-poisonous>

Under the Patents Act 2013 multiple and partial priorities are only recognised when claims are split into their component parts, such that each part claims subject matter first disclosed in a single priority source. In other words, the Patents Act 2013 requires claim splitting in order to recognise multiple and partial priorities. As explained above, in connection with Australian patent law as it was prior to 1969, claim splitting is a wasteful and costly exercise, particularly when a simple legislative solution is available to avoid it. However, because there is usually very little examination of priority entitlement by applicants and their agents when filing and prosecuting applications before IPONZ, the need for claim splitting to obtain the benefit of multiple and partial priorities is rarely recognised.

It is important to note that Article 4 of the Paris Convention does not stipulate that claims must have a priority date. In fact, it is clear from the wording of Article 4 of the Paris Convention, and in particular Article 4B, that priority dates attach to matter and not claims. Accordingly, where a patent law attaches priority dates to claims, rather than subject matter within the claims, it is important that the law also allows different subject matter included within the claim to have different priority dates.

In order to demonstrate that the Patents Act 2013 can never allow a claim relying on multiple or partial priorities to obtain the benefit of the protection that should be afforded by Article 4B of the Paris Convention, please consider the following scenario:

- A priority application P describes a widget with a part M made of copper is filed on 1 June 2016.
- New Zealand application A filed on 1 June 2017, claims priority from P and describes a widget where part M can be made of any metal (including copper).
- New Zealand application A contains a claim C for a widget with a part M made of any metal (including copper).

According to Section 60(2), the single priority date that would apply to claim C is 1 June 2017, this being the filing date of the application in New Zealand in which the full breadth of claim C is supported. This is despite the fact that part of the subject matter of claim C, namely the widget with part M made of copper, was first disclosed in a priority application P filed on 1 June 2016.

According to Article 4B of the Paris Convention, certain acts occurring between the filing of the priority application and the filing of the convention application should not be invalidating. These Acts include "another filing" and "the publication or exploitation of the invention". However, consider the consequence of a third party independently publishing a widget with part M made of copper during the priority year, for example on 1 May 2017. Since this will be one month prior to the priority date accorded under Section 60(2), the publication will destroy the novelty of claim C. Accordingly, for claim C, the applicant will not obtain the benefit of Article 4B of the Paris Convention. The same will be the case if, instead of publishing the widget with part M made of copper, the third party filed a patent application with effect in New Zealand on 1 May 2017. This will also invalidate claim C as a result of the application of whole of contents novelty.

Under the Patents Act 2013, the only way the applicant can obtain the benefit of the partial priority claim to priority application P is to split claim C into two claims, C<sup>a</sup> and C<sup>b</sup>:

Claim C<sup>a</sup> - directed to a widget with part M made of copper.

Claim C<sup>b</sup> - directed to a widget with a part M made of any metal other than copper.

Accordingly, if the claims were split, claims C<sup>a</sup> will retain its priority claim to application P and have a priority date of 1 June 2016, thereby predating the publication or filing by the third party. However, the priority date for claim C<sup>b</sup> will be the date of filing of application A, that is 1 June 2017. This does not predate the filing by the third party. In the case of the

publication by the third party, claim C will be novel over the publication, but it will need to be assessed as to whether claim C<sup>b</sup> possesses an inventive step over the publication. If the third party, instead, filed a patent application with effect in New Zealand on 1 May 2017, it would not be citable against C<sup>b</sup>, because it is not relevant to novelty and cannot be cited for inventive step.

However, the third party will not obtain the grant of a claim directed to the widget with part M made of copper, because that subject matter was disclosed in application A which has an earlier priority date in respect of that subject matter. Accordingly, application A (in view of its earlier priority date) will be a whole of contents novelty citation against the application filed by the third party.

The scenario described above can be equally applied to any claim currently existing in a New Zealand application or patent which seeks to rely on multiple or partial priorities. The applicant is forced to split the claims in order to achieve the benefit.

In my view, the solution to all the problems identified in Sections 1.3 and 1.4 of the discussion paper can be addressed by introducing a provision which allows claims to enjoy multiple or partial priorities. Anything less than this, for example introducing protection against self-collision between parents and divisionals, will only treat a symptom of the problem and not address the underlying cause. Even with protection against self-collision, the Patents Act 2013 will still fail to provide the protection required by Article 4B of the Paris Convention without requiring applicants to split claims.

I would now like to make a few comments in relation to some parts of the discussion paper.

In the analysis provided in paragraph 126, the priority date of claim C is 1 June 2017 when assessed under the Patents Act 2013. While correct, this analysis is completely inconsistent with the analysis provided in paragraph 160. Similarly, the analysis provided in paragraph 145 under the Patents Act 2013 is correct, but is also completely inconsistent with the analysis set out in paragraph 160.

Paragraph 160 erroneously states that claim C has a single priority date that is earlier than the date in which some of the matter included within claim C was disclosed. There is either a typographical error in this paragraph, or the authors of this paragraph have misinterpreted Section 60(2).

In paragraph 128 it is suggested that the applicant should be required to either delete claim C or amend it so that it does not include the invention described in P. It is unclear why the applicant should not be entitled to claim C, particularly since in the scenario described no third party has disclosed the widget where part M can be made of any metal (including copper).

In fact, paragraph 128 includes the suggestion that claim C should be amended to delete the invention that was described in its priority application. Again, why should the applicant delete the subject matter for which priority is being claimed? Unfortunately, under current New Zealand law, the only way the applicant can obtain full protection for the invention is to split claim C into two claims, the first claim directed to the widget with a part M made of copper, and a second claim directed to the widget with part M made of any metal other than copper. If the applicant splits the claims, then the claim directed to the widget where part M is made of copper will be entitled to claim priority from application P, whereas the claim specifying that part M can be made of any metal other than copper will have a priority date of the filing date of application A.

In paragraph 136 it is suggested that the means for avoiding a conflict between the PCT application and a New Zealand application filed under the Patents Act 2013 is to formally abandon one of the applications before they are published. However, it is unclear why the

applicant should be required to withdraw one of their applications. If the Patents Act 2013 was amended to allow a claim to enjoy more than one priority date, there would be no need for the applicant to withdraw either of its applications. Similar comments apply to paragraph 138.

In paragraph 140 it is suggested that poisonous priority could not occur under the (now repealed) 1953 Act. I am not convinced that this is the case. In particular, I refer you to New Zealand Patent Nos. 516911 and 519774. In comparing the claims of these patents I note that claim 1 of 519774 was amended during prosecution to exclude the salts that were claimed in the other patent. However, if this disclaimer was not introduced, it is difficult to see why claim 1 of the '911 patent would not prior claim claim 1 of the '774 patent. In this regard, claim 1 of the '911 patent would have a priority date of 26 January 2000 while claim of the '744 patent would have a patent date of 4 August 2000. I also do not believe that, ignoring the proviso, the protection against self-collision provisions set out in Section 11 of the 1953 Act would assist in saving claim 1 of the '744 patent since prior claiming is not "publication or use of the invention" and the other patent has an "earlier" priority date and not the "same or later priority date". Poisonous priority could only be avoided if there was a mechanism for attributing the earlier priority date of 26 January 2000 to the embodiments within the scope of the claim that were disclosed in the UK priority application.

In paragraph 141 the authors of the discussion paper point out that there has only been one case in Australia where poisonous priority has been an issue since the Patents Act 1990 entered into force in 1991. While it is true that there has only been one significant case dealing with this issue, the AstraZeneca case mentioned above, the issue has been raised in a number of other cases since the AstraZeneca decision was handed down. Up until that time, it was not believed that poisonous priority or poisonous divisionals could exist in Australia in view of Section 43(3). However, if the decision in AstraZeneca is correct, there will be many claims in parents and divisionals that are invalid.

The summary of the Australian decision relating to poisonous priority is incomplete. It also refers to the amendment made after filing which is irrelevant to the poisonous priority issue. The Court conceded that even if that post filing amendment did not shift the priority date, the application would still be anticipated by the other application.

### **Question P6**

In response to question P6, I believe that poisonous priority is a significant issue in New Zealand. I also believe that with increased awareness of the issue amongst patent practitioners and litigators, poisonous priority could become a regular mechanism for invalidating patents otherwise claiming perfectly patentable and worthy inventions. Under the Patents Act 2013 it is possible to use the applicant's own related applications as prior art against one another, making it possible to invalidate patents when inventions would be otherwise patentable.

### **Question P7**

The discussion paper treats poisonous divisionals separately from the situation where two or more applications are filed at the same time claiming the same priority. However, in view of the practice of anti-dating divisionals to the filing date of the original parent, there is very little difference between these application types.

I do not believe that introduction of the proposed anti-self-collision provisions will be sufficient to address the problems inherent in the Patents Act 2013. The introduction of such a provision will not prevent conflict between patents such as New Zealand Patent Nos. 516911 and 519774, if filed under the Patents Act 2013. These are two patents of which I am aware, however I am sure there are many other patents and patent applications in New Zealand that share a priority date. Also, as discussed above, it does not deal with the real

problem, which is that the Patents Act 2013 does not allow a single claim to enjoy multiple or partial priorities.

It is difficult to comment on the section dealing with multiple priority dates for claims, because the analysis set out in Section 160 is flawed. However, I believe that the failure of the Patents Act 2013 to recognise multiple and partial priorities is a significant problem which should be addressed.

Although I do not have data to hand, from my personal experience I believe that an extremely high percentage of Convention applications and PCT applications filed into New Zealand will have claims which seek to rely on multiple and partial priorities. As mentioned above, not one of these claims will receive the protection that is intended to be provided according to Article 4B of the Paris Convention. Since applicants and attorneys are not required to assign priority dates to claims when filing the application, the agents handling the applications will not be aware of which, if any, claims in an application are seeking to rely on multiple and partial priorities. It may not be until there is an opposition or litigation that the importance of the multiple or partial priority claims come to light. At that stage it is likely to be too late to split the claims to restore priority entitlement. As mentioned above, reviewing claims and priority applications and splitting claims into sub-claims which enjoy single priority dates is a time-consuming and costly task, which can be easily avoided by the introduction of a provision which allows a single claim to enjoy more than one priority date.

The statement in paragraph 162 is not completely correct, since the splitting of claims is an absolute requirement in New Zealand if an applicant wishes to take advantage of their multiple or partial priority claims.

The authors of the discussion paper seem to be more concerned that amending the Patents Act 2013 to conform with the Paris Convention will lead to unintended consequences, than concerned for ensuring that the Patents Act 2013 is consistent with the Paris Convention. The authors also refer to the Australian decision in AstraZeneca mentioned above, which, unfortunately, interpreted Section 43(3) incorrectly without taking into account its intended purpose. With knowledge of this incorrect interpretation of Section 43(3), it will be possible for the MBIE to devise a wording which is unlikely to be misinterpreted. For example, in Australia IPTA has proposed that Section 43(3) could be re-worded as follows:

“Where a claim defines more than one form or variant of an invention, then, for the purposes of determining the priority date of the claim, it must be treated as if it were a separate claim for each form or variant of the invention that is defined.”

Paragraph 174 states that the intended outcome is that applicant AA should not be granted a patent for claim C. How can this may be the intended outcome, when the outcome is completely contrary to the Paris Convention, resulting in the applicant not achieving the benefit of Article 4B?

Claim C includes within its scope widget W with part M made of copper, and the application with this claim claimed priority from priority application P which describes such a widget. According to Article 4B of the Paris Convention, any publication of widget W with part M made of copper in the priority year should not be invalidating. Accordingly, why should the publication of such a widget after the priority date, or the filing of a patent application by a different applicant in respect of such a widget after the priority date, destroy the novelty of the claim? The answer is that it should not.

In this scenario, with notional claim splitting, the priority date of claim C with respect to widgets with part M made of a metal other than copper is 1 June 2017. The earlier publication of description D of widget W with a part M made of copper is made by a third party and not subject to a grace period, and therefore could be cited for inventive step against this part of claim C. This is because the priority date of the claim insofar as it



encompasses widgets with part M made of metals rather than copper is later than the publication date of D. However, for the claim to lack an inventive step it would have to be shown that it would be obvious as at 1 June 2017 to modify the disclosed widget and make part M out of a metal other than copper.

Referring to paragraph 175, if claim C was split into two claims, which is currently required in order to obtain the benefit of multiple or partial priority claims, then the sub-claim directed to widget W made of copper would be clearly valid. The sub-claim directed to widget W with a part M made of a metal other than copper would be novel over description D and patent application B, but description D would be citable against this sub-claim for inventive step. Whether or not the sub-claim is obvious would need to be assessed by applying the normal test for obviousness.

There appears to be a typographical error in paragraph 176, since notional splitting C into separate claims would not be sufficient, actual splitting would be required.

The conclusion in paragraph 177 is incorrect. Using a notional splitting approach, claim C would enjoy a priority date of 1 June 2016 for widgets with part M made of copper, and a priority date of 1 June 2017 for widgets having part M made of any metal other than copper (including aluminium). The application filed by applicant BB is the first to disclose the widget with part M made of aluminium, and it has a filing date of 1 December 2016, that is prior to the priority date of claim C insofar as it encompasses widgets with part M made of aluminium. Accordingly, claim C will not be able to encompass widgets in which part M made of aluminium. In the scenario described, applicant BB will be able to obtain a claim to widget W with a part made of aluminium while applicant AA will be able to obtain a claim to widget W with part M made of metals other than aluminium. It is difficult to see why this would not be the intended outcome.

Referring to paragraph 178, it is difficult to see why applicant BB should not be able to obtain the grant of claim BC, directed to a widget W with a part M made of aluminium. Yes, claim BC is novel and applicant BB should be able to obtain the grant of that claim. There will be no overlap with the claims granted to applicant AA, because applicant AA will need to exclude widgets with part M made of aluminium from their claims.

For the reasons explained above, the conclusion set out in paragraph 179 is incorrect.

### **Question P8**

In answer to question P8, I do not agree with the MBIE's assessment that there is no need to amend the 2017 Act to provide that patent claims can have more than one priority date. For the reasons explained above, I believe that amending the 2013 Act to provide that patent claims can have more than one priority date will address all of the problems discussed in Sections 1.3 and 1.4 of this discussion paper.

Although not mentioned in the two sections dealing with multiple and partial priorities, I would like to point out that the MBIE could inadvertently introduce a new mechanism for producing poisonous divisionals. In the discussion paper in Section 1.1 there is a proposal to make divisionals of 1953 Act cases subject to the Patents Act 2013 law. While not necessarily agreeing that this is a good proposal, it will be very important to ensure that, if this is done, the priority assessment of parents and divisionals will be according to the same test. If not, a parent could poison its divisional and vice versa even allowing for recognition of multiple and partial priorities. It will be important that the priority test for any divisional that has a 1953 Act parent, or grandparent etc is a fair basis test.

I am very happy to answer any questions you may have in relation to my submissions above.

Yours faithfully

**DAVIES COLLISON CAVE PTY LTD**



**Michael J Caine**  
**Principal**

