



## Changes to Patents Excess Claims Information

### Frequently Asked Questions

#### **Q1: When will the excess claims fee process come into effect?**

Fee changes come into effect from 1 October 2024. A new excess claims fee process will apply to applications with an examination request filed on or after this commencement date.

For applications with an exam request filed before the new fee commencement date, the old excess claims fee process will apply, with fees payable only at acceptance stage.

#### **Q2: How will the proposed change to excess claims fee operate in practice?**

IP Australia will issue an invitation to pay (ITP) immediately after the completion of the first report, and where there are more than 20 claims on file for consideration. The fee will be payable within 1 month of the date that the first report was issued.

If the fee is not paid within 1 month of the date the first report was issued, the application will lapse. The application can only be revived if the payment of the fee is made prior to the final date of acceptance (which is 12 months from the date that the first report was issued, or a later date extended by s223). No late payment or extension fees apply in the situation where fees are paid within the 12 month period.

A further invitation to pay (ITP) will be issued for excess claims after acceptance, if the number of claims before the examiner has increased beyond the number considered at first report and beyond 20 claims.

For details, please refer to the proposed excess claims fee flow chart (Figure 1) and typical use case scenarios below.

#### **Q3: How will the applicant know when an examination report will be issued?**

IP Australia endeavours to commence examination within 12 months of an examination request date. However, we are currently experiencing examination delays in some subject areas. Please refer to our [website](#) for the current response times for each area of technology.

Applicants or their nominated agents on file will be notified approximately six months prior to the expected commencement of examination proceedings for their application. This notification will provide an opportunity for an applicant, or their agent, to amend their specifications prior to examination.

Expedited examinations, including those filed through the Patent Prosecution Highway Route, are exceptions to the above notification process. Under our current service level commitments, we endeavour to examine expedited examination requests within 8 weeks of the date of request.

Given that expedited requests are applicant initiated, there is an expectation that the applicant will provide amendments, as required, at the time the request is submitted in order to reduce, or avoid, any excess claims liability.

**Q4: Will there be correspondence or reminders for applicants regarding the excess claims fee?**

From the commencement date of the new fees, the following correspondence will contain information pertaining to excess claims fees:

- A filing receipt notice
- The Commissioner's direction to request examination notice
- An examination request acknowledgement notice
- A notification on the expected commencement of examination – issued six months prior to expected commencement of examination
- An exam response reminder notice – issued where no response is received with three months of the final date for acceptance

Applicants can seek leave to amend their specification at any stage prior to the commencement of an examination, in order to reduce or avoid any excess claims fees that may apply.

**Q5: Will there be a cost to amend the number of claims on file?**

Amendments filed in anticipation of examination are free of charge. Any voluntary amendments, filed under s104, requiring consideration prior to examination will attract fees as per the fee schedule.

**Q6: How will divisional applications be treated?**

Divisional applications will be subject to this new excess claims fee process. Divisional applicants are typically directed to request an immediate examination however, noting the above, those examination timeframes will vary depending on the respective technology area.

**Q7: Will the excess claims fee will be refunded for claims not examined?**

An excess claims fee is payable based on the number of claims an applicant puts forward for consideration by IP Australia. A refund will not apply in an instance where an opinion is reserved. We will endeavour to assess all claims on file where practical to do so and provide clear, succinct, and useful detail in the report.

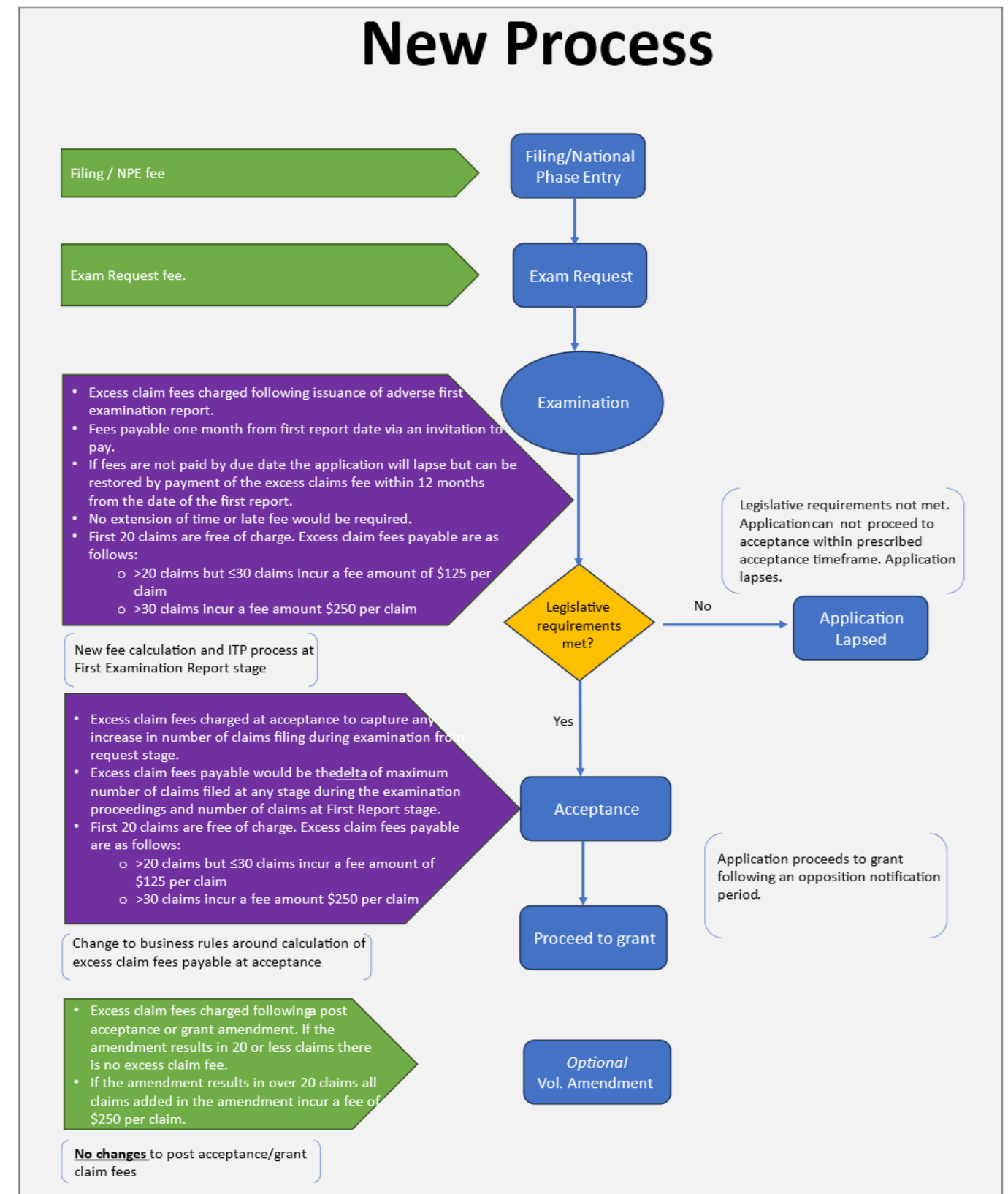
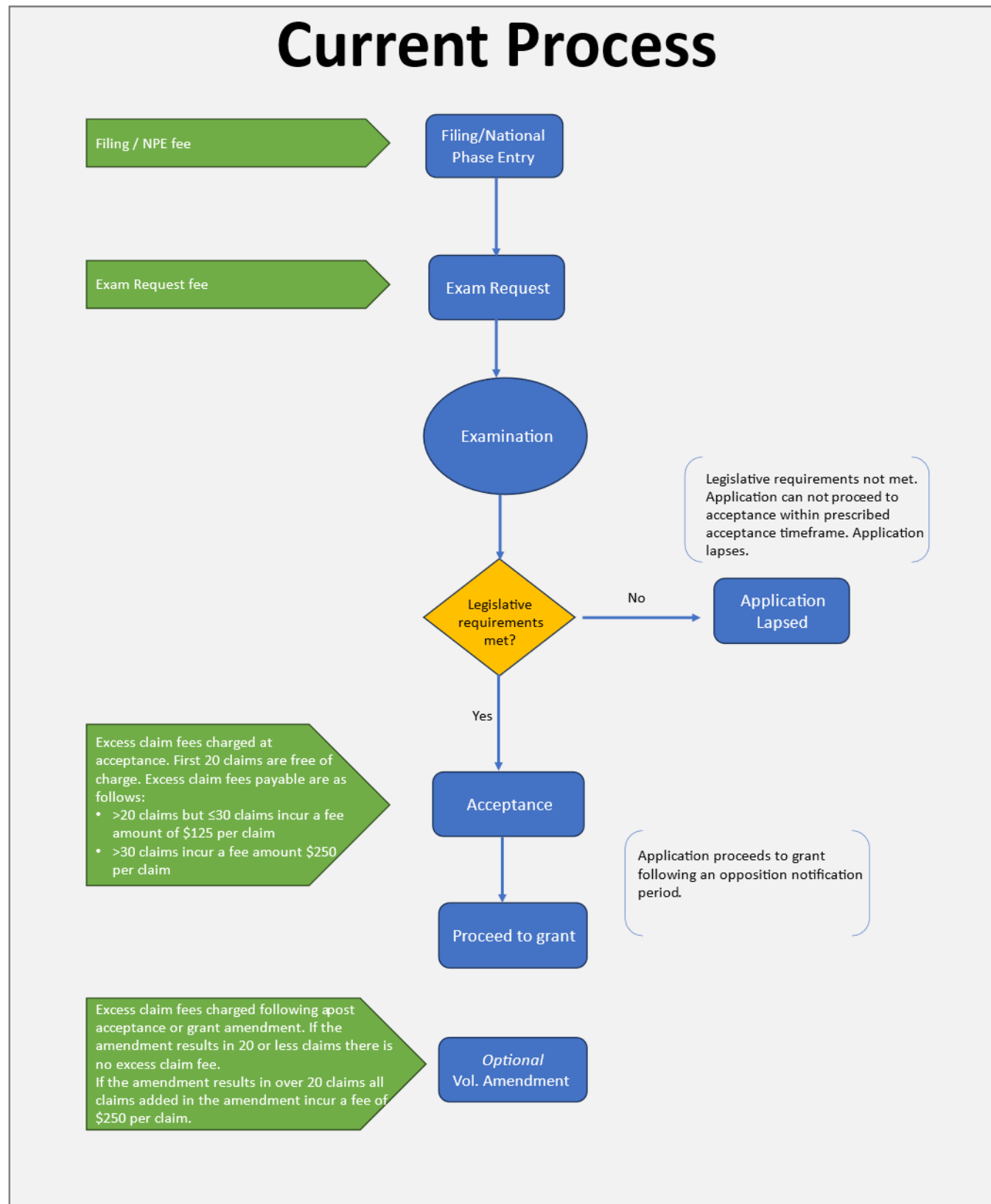
**Q8: What happens if the excess claims fee is not paid?**

If the excess claims fee is not paid within 1 month of the date the first report was issued, the application will lapse. The application can only be revived if the payment of the fee is made prior to the final date of acceptance (which is 12 months from the date that the first report was issued, or a later date extended by s223).

**Q9: Will IP Australia process a response to first examination report if the excess claims fee is not paid?**

No. Where applicable, excess claims fees must be paid before a response to the first examination report will be considered by an examiner. IP Australia endeavours to reply to a response to a first examination report within 20 working days from the date of receiving the response however, the non-payment of any relevant excess claims fee will extend this timeframe.

# Patents Excess Claims Fee – Comparison of current and new process – Figure 1



**NOTE:**

- Excess claims fees under the new process will apply to applications with examination requests filed **on or after commencement** of the new regulations.
- The current process for excess claims fee consideration will continue to apply for applications with exam request filed **before commencement date**.

## **Current Process Use Case Scenarios**

### **Scenario 1**

Applicant files 100 claims. This carries through examination proceedings. 100 claims are examined and during the examination process the applicant amends to 20 claims in order to overcome the examiner's objections. There is no excess claim fee payable at acceptance stage.

### **Scenario 2**

Applicant files 100 claims. During examination proceedings an additional 100 claims are introduced. Further, during examination the applicant amends the number of claims down to 50 claims. A total of 50 claims are accepted. Excess claim fee is payable on 30 claims (i.e. 50-20, at \$125 each for the first 10 and \$250 each for the next 20).

## **New Process Use Case Scenarios**

### **Scenario 1 (Adverse First Report)**

Applicant files 100 claims. Prior to examination they opt to file an amendment in anticipation reducing the total number of claims to 20. There is no excess claim fee payable at First Examination Report stage. The application is examined on the basis of the 20 claims and proceeds to acceptance. The total number of claims has not changed. No excess claim fees payable.

### **Scenario 2 (Adverse First Report)**

Applicant files 20 claims. Prior to examination they opt to file an amendment in anticipation increasing the total number of claims to 100. The excess fee payable at First Examination Report stage would be for 80 claims ((i.e. 10 claims at \$125 each and the remaining 70 claims at \$250 each). During examination they amend the specification to 20 claims. The application is accepted with 20 claims. No further excess fees payable at acceptance.

### **Scenario 3 (Adverse First Report)**

Applicant files 100 claims. Prior to examination they opt to file an amendment in anticipation reducing the total number of claims to 20. There is no excess claim fee payable at First Examination Report stage. During examination they introduce an additional 20 claims. Examination proceeds with 40 claims. The application is accepted with 40 claims. A further excess claim fee is charged based on additional 20 claims (i.e. 10 claims at \$125 each and the remaining 10 claims at \$250 each.)

### **Scenario 4 (Adverse First Report)**

Applicant files 100 claims. Prior to examination they opt to file an amendment in anticipation reducing the total number of claims to 20. There is no excess claim fee payable at First Examination Report stage. During examination they introduce additional claims taking the total to 100 claims. Prior to acceptance, they reduce the total number of claims to 20. An excess claim fee is charged based on the maximum number of claims examined. The first 20 claims are 'free', and a fee charged on the additional 80 claims (i.e. 10 claims at \$125 each and the remaining 70 claims at \$250 each.)

**Scenario 5 (Adverse First report)**

Applicant files 100 claims. Prior to examination they opt to maintain the claim numbers at 100 claims. The excess fee payable at First Examination Report stage would be for 80 claims ((i.e. 10 claims at \$125 each and the remaining 70 claims at \$250 each). During examination and at acceptance stage, the total number of claims remain at 100 claims. No additional excess claim fee is payable at acceptance stage.

**Scenario 6 (Clear First Report)**

Applicant files 100 claims. Prior to examination they opt to maintain the claim numbers at 100 claims. Following initial examination, the application is considered to be in order for acceptance. The excess fee payable at acceptance stage would be for 80 claims ((i.e. 10 claims at \$125 each and the remaining 70 claims at \$250 each).

**Scenario 7 (Adverse First Report)**

Applicant files 100 claims. Prior to examination they opt to maintain the claim numbers at 100 claims. The excess fee payable at First Examination Report stage would be for 80 claims ((i.e. 10 claims at \$125 each and the remaining 70 claims at \$250 each). During examination, they introduce an additional 50 claims. At acceptance there are 150 claims in total. An excess claim fee is payable based on the additional 50 claims at \$250 each.