

Adam Law

Patent & Trade Mark Attorneys
Mechanical Engineering
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Physics Sciences

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PATENTS

Overview

A patent registration in Australia will allow you to prevent competitors from manufacturing, using and patenting your invention. Filing a patent application will provide provisional protection before the application is examined and granted. After grant letters of demand can be sent and action can be taken in court.

In addition, filing a patent application will allow you to mark your product with a patent number and properly engage in investment negotiations. Licensing, confidentiality and other agreements can be structured around the patent application.

Non-Disclosure Agreements

A patent application will serve to define your invention in explicit terms. Often non-disclosure agreements do not adequately define the invention. Also a non-disclosure agreement will not provide continuing protection for an invention once the invention has been made publicly available.

Requirements

In order to sustain a patent, the invention as defined in the patent must be new and inventive.

To be new, the invention must not have been shown to a member of the public in non-confidential circumstances or otherwise have been made publicly available in documentary form. This includes digital recordings.

Australia and the US provide a twelve month grace period for prior disclosures. Many jurisdictions such as Europe do not provide a grace period except in some limited circumstances. For this reason it is strongly recommended that you file a patent application before you disclose your invention to a member of the public in non-confidential circumstances. If you have disclosed your invention then you must speak to a patent attorney as an exemption may apply.

To be inventive, the invention must not have been obvious to a person skilled in the art at the time the application for the patent was filed. In considering whether an invention is inventive, examiners are able to combine the common general knowledge attributed to the person skilled in the art with one or more documents. Courts have generally found that a 'scintilla of inventiveness' is all that is required to sustain a patent.

Different legal tests have been developed regarding whether an invention is new and inventive. It is strongly recommended that you obtain the opinion of a patent attorney before concluding whether or not your invention meets these requirements.

In many countries, including Australia, the newness and inventiveness of an invention will be examined against disclosures and publications on a worldwide basis.

Types of Patent

The Australian patent system provides both standard and innovation patents. An innovation patent has a lower threshold of inventiveness and may be useful in particular circumstances. An innovation patent is a particular form of utility patent.

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Term of Protection

When a patent application is filed in Australia, twelve months of provisional protection is provided in all convention countries.

For a standard patent, the term of protection in Australia is twenty years. For an innovation patent, the term of protection in Australia is eight years. Renewal fees are payable on an ongoing basis.

Overseas Applications

Australia is a member of the Patent Cooperation Treaty. This allows for a centralised preliminary examination procedure before proceeding into designated patent cooperation countries including the US, Europe and China.

Otherwise applications can be filed directly with individual convention countries up to twelve months after first filing a patent application in Australia. Priority from the earlier filing in Australia is maintained. Further information regarding filing applications overseas is available upon request.

There is no such thing as a worldwide patent.

Patent Preparation

A patent is a legal document that will be scrutinized with as much care as any other legal document defining a legal right (*Decor Corporation Pty Ltd and Another v Dart Industries Inc* (1988) 13 IPR 385). Drafting a patent application is a complex task requiring much attention to detail and many years of experience. For these reasons it is strongly recommended that you do not attempt to prepare a patent application yourself. Additionally, by law in Australia, only a registered patent attorney or a legal practitioner instructed by a registered patent attorney can prepare a patent specification for someone else.

Books on preparing patent applications, such as Patent It Yourself by David Pressman, should only be used as a guide to gain an appreciation of the work performed by your patent attorney.

What is a patent claim?

A patent claim is a sentence that defines the legal boundary of an invention. The scope of a patent claim can be visualised by considering each of the features of the claim in terms of one of the preferred embodiments described in the patent. Notably, however, it is the wording of the claims that defines the monopoly and not the embodiment. This is of course subject to the patent specification providing adequate support to the claim. The rules of patent claim construction vary in different jurisdictions.

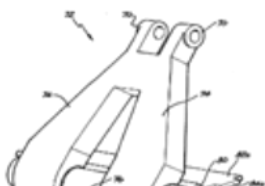
What can a patent protect?

A patent is able to protect the utility of a particular product, a new compound, a computer system, a business method, a method of manufacture, a method of operation as well as a multitude of other systems and methods.

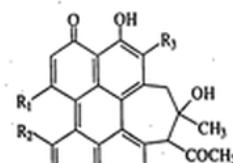
Whilst we do not specialise in chemical or pharmacological inventions we are able to recommend patent attorneys who specialise in these areas.

Several examples are provided below

A product

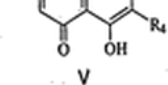


A compound





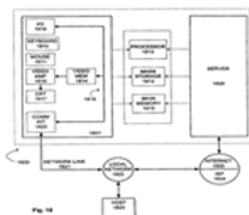
(WO2003/062541)



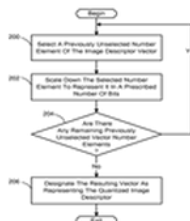
(WO2003/064755)

A computer system

Software



(WO2008/089077)



(WO2009/126427)

(These examples are not associated with our practice. Please see our disclaimer)

How much information must I provide?

The extent of the information that should be provided will depend on the invention. Generally a patent specification must contain all the information required for persons of suitable skill and knowledge to put the best method of the invention into effect. Failure to disclose important information could be fatal to the validity of the application as a whole.

Please see our example of a client information brief for : (i) a [mechanical invention](#) and (ii) a [software invention](#).

Should a search be conducted before filing an application?

The links on our [Searching Page](#) provide access to several Patent Office databases.

The benefit of conducting either a cursory or professional search before filing a patent application is that the patent application can be tailored in view of the documents raised by the search. Generally documents raised by the search are likely to be cited during examination and an alleged infringer may also raise the documents in court.

Professional searching firms often use commercial databases such as [Derwent](#) for searching. A professional searching firm may charge between A\$2000-\$5,000 or more, depending on the requirements of the search.

If a cursory search is performed at least the [US database](#) and [European database](#) should be searched as a minimum using the links provided below. The Internet should also be searched to determine whether similar products are already on the market.

It is important to recognise that all searching is based on keywords and patent classes. Therefore no search can be considered to be fully conclusive. Also, patent applications are often only searchable by title before publication. Publication may occur more than 18 months after first filing an application.

The decision whether to perform a professional search before filing an application depends on all the surrounding circumstances including the likelihood of the commercial success of the invention.

Should drawings be prepared before filing an application?

Generally it is recommended that line drawings be prepared. In the case of a provisional specification sketches will suffice in most circumstances.

How can I estimate costs?

We will provide you with detailed cost estimates. In addition to these cost estimates we will write to associates to obtain cost estimates at the time of entering the national phase of an International Application. You can obtain comparative national phase estimates using online services such as the [Global IP Estimator](#), [IP Forecaster](#) and [Inovia Cost Calculator](#).

Patent Links



IPAustralia: Australian Patent Office

<http://www.ipaustralia.gov.au>

Info date: 28/10/2009

The Australian Patent Office website provides information on patents, trade marks and designs in Australia. The website allows searching of the Australian patents, trade marks and designs databases. Full text patent document searching is presently not available.



SIPO: Chinese Patent Office

<http://www.sipo.gov.cn>

Info date: 28/10/2009

The Chinese Patent Office website is available in both Chinese and English. The website allows searching of the Chinese patents database. The website automatically translates Chinese patents using a machine translator.



EPO: European Patent Office

<http://www.epo.org>

Info date: 28/10/2009

The European Patent Office website provides information on the European patent application procedure. European patent database records are accessible through EpOnline/RegisterPlus. European patent documents are accessible through Espacenet.



JPO: Japanese Patent Office

<http://www.jpo.go.jp>

Info date: 28/10/2009

The Japanese Patent Office website is available in both Japanese and English. The website allows searching of the Japanese patents database. The website automatically translates Japanese patents using a machine translator.

The New Zealand Patent Office website provides information on patents, trade marks and designs in New Zealand. The website allows searching of the New Zealand patents, trade marks and designs databases. Full text patent document searching is presently not available.

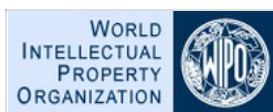


USPTO: United States Patent Office

<http://www.uspto.gov>

Info date: 28/10/2009

The United States Patent Office website provides information on patents, trade marks and designs (design patents). The website allows searching of the US patents and trade marks databases. Full text patent document searching is available for patents granted after 1976.



WIPO: World Intellectual Property Office

<http://www.wipo.int>

Info date: 28/10/2009

The World Intellectual Property Office website provides information on the PCT patent application procedure. The website allows full text searching of published patent applications. Limited national phase information is available.

Further patent links are provided on our [Searching Page](#), [Entitlement Page](#), [Links Page](#) and [FAQ Page](#)

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PATENT SEARCHING

Overview

Conducting either a cursory or professional search before filing a patent application will allow tailoring of the patent application in view of the documents raised by the search. These documents are likely to be cited during examination and an alleged infringer may also raise the documents in court.

Search Limitations

It is important to recognise that all searching is based on keywords and patent classes. Therefore no search can be considered to be fully conclusive. Also, patent applications are often only searchable by title before publication. Publication may occur more than 18 months after first filing an application.

One example of a patent search is provided by [ITS searching services](#) (requires Internet Explorer). While this example is a simple one, it does serve to illustrate some of the difficulties associated with searching.

Cursory Searches

If a cursory search is performed at least the [US database](#) and [European database](#) should be searched using the links provided below. The Internet should also be searched to determine whether similar products are already on the market.

Cost

Professional searching firms often use commercial databases such as [Derwent](#). A professional searching firm may charge between A\$2000-\$5,000 or more, depending on the requirements of the search.

The decision whether to perform a professional search before filing an application depends on all the surrounding circumstances including the likelihood of the commercial success of the invention.

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Patent Searching Links



Espacenet: Espacenet Database Service
<http://ep.espacenet.com>
Info date: 28/10/2009

Espacenet is a website developed by the European Patent Office. The aim of Espacenet is to provide the public with free access to worldwide patent information. The website allows searching of European and other patent documents. Full text searching extends only to the titles and abstracts

of the patent documents. Patent documents can be downloaded automatically in PDF format.



Google: Google Patents

<http://www.google.com/patents>

Info date: 28/10/2009

Google Patents provides another method of searching the US patents database. Search results can be shown as thumbnails of patent document images. US patent documents can be downloaded automatically in PDF format.



PatentScope: WIPO PatentScope Service

<http://www.wipo.int/>

Info date: 28/10/2009

The PatentScope database allows full text searching of published international patent applications filed through WIPO. International patent applications are later divided into national phase applications. Notably, there is no such thing as an international patent.



USPTO: Patent Full Text Searching (PAFT)

<http://patft.uspto.gov>

Info date: 28/10/2009

The US patent database allows full text searching of granted patents and published applications. Full text searching is limited to patents granted after 1976.



WIPO: World Intellectual Property Office

<http://www.wipo.int>

Info date: 28/10/2009

The World Intellectual Property Office website provides information on the PCT patent application procedure. The website allows full text searching of published patent applications. Limited national phase information is available.

Australian Search Firms



Intellectual Technology Services: Search Provider

<http://www.patent-searcher.com>

Info date: 28/10/2009

An Australian patent search firm.



R.E. Kemp & Co. Pty. Limited: Search Provider

<http://www.kemp.com.au/patser.html>



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An Australian patent search firm.



King Search: Search Provider
<http://www.kingsearch.com.au/>
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An Australian patent search firm.

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Patent Downloading Software.

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PATENT ENTITLEMENT

Overview

It is advisable to discuss the matter of entitlement with your patent attorney. This should be done before filing a patent application.

In some jurisdictions incorrectly stating the reasons for entitlement can result in the patent being invalidated in full.

Inventors

Inventors have an original right of entitlement. Nonetheless what constitutes an inventor differs in different jurisdictions.

Generally an inventor must have made a 'material contribution' to the invention and not have merely been following instructions.

Employment

An employer may or may not be entitled to his or her employee's invention. Whether this is the case depends largely on whether the inventor invented the invention during the ordinary course of his or her employment.

The fact that the employee used his or her employer's resources to design or make the invention is not of itself determinative of the employer's right to entitlement. Neither is the fact that the employee allowed his or her employer to use the invention.

Any issues relating to the employment of an inventor should be discussed with your patent attorney.

Assignment

Entitlement to an invention can be assigned to another party. When this occurs there is a transfer of rights.

A written assignment is one manner in which a transfer of rights can be formally recorded.

Inventive Concepts

Whether a contribution is material or not requires a full consideration of the 'inventive concepts' involved. In court, these 'inventive concepts' will generally be considered with reference to the patent specification in full. This includes a consideration of the patent claims defining the invention.

After isolating one or more of the 'inventive concepts', a court will consider the contribution made by each inventor and whether the contribution made was a 'material contribution'.

Level of Contribution

In Australia, several different tests have been developed for the purpose of considering whether a person involved has made a 'material contribution'.

One such test is known as the 'but for' test. This test requires that the invention would not have come about 'but for' the contribution of each inventor. The 'but for' test is not a universally applied test. Neither does the test extend to mere financial or managerial involvement. The 'but for' test has however found application in instances such as those involving preliminary research which subsequently led to a discovery.

It is not possible to articulate a universally applied test. All that can be said is that each

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inventor's contribution must fall within the scope of the expression 'material contribution'. Such a consideration necessarily depends on all the surrounding circumstances.

When a person constructs a prototype, that person will generally only be an inventor when the actions of that person go beyond merely following instructions to the provision of a 'material contribution'.

When considering inventorship, courts generally have regard to the invention as a whole and the relationship between the various persons involved including instances of collaboration.

Overseas Jurisdictions

It is conceivable that courts in overseas jurisdictions will require different thresholds of 'material contribution' in similar sets of circumstances. For this reason it is important to discuss the different contributions made by each inventor, with your patent attorney.

A link to a tabular summary of the similarities between US, Australian and European entitlement is provided in our comments section below. The tabular summary is provided along with several examples.

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CLIENT BRIEF

The following hypothetical client information brief shows the type of information that should be provided to your patent attorney in the case of a mechanical type invention.

Providing such information in written form will ensure that your patent attorney appreciates all the important features of your invention. Often, however, such a detailed written disclosure is not strictly required provided that you can readily have a face to face meeting with your patent attorney and that your patent attorney fully understands your invention.

As with software, business method and electronic inventions, a client is best advised to fully describe the advantages of his or her invention as well as the structure that provides those advantages.

HYPOTHETICAL BRIEF

1. Invention Disclosure



I have drawn a sketch of my invention below.

As you can see my invention is a collapsible golf club.

2. Advantages

My invention has many advantages including:

1. Allowing a player to complete a relatively full golf swing while practising underneath an 8 foot ceiling.
2. Allowing a player to hit a training ball into the air when the training ball is positioned on or slightly above the ground.
3. Allowing strength training between the club and a table leg without substantially damaging either the club or the table leg.
4. Allowing a person to practice a swing action that would not be possible with a normal club.

3. Provision of Advantages

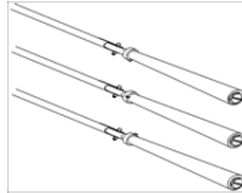
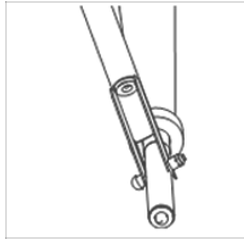
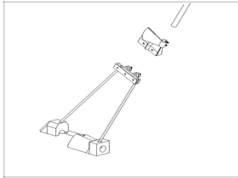
First Advantage

1. My golf club has a flexible top portion and a relatively rigid handle portion. The flexible top portion includes a head portion, two flexible rods and a rubber mount. The rigid handle portion includes a break-away portion and a biased

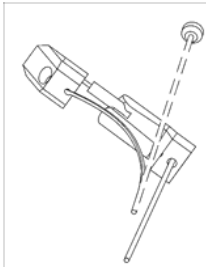
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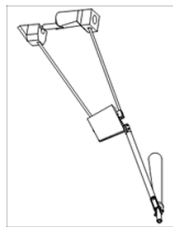
rotatable handle. Please let me know if you require any further drawings or information.



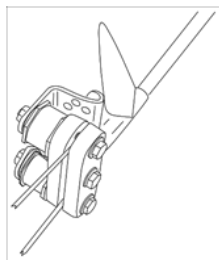
2. It is important to understand that the head portion has been specifically designed to cause twisting when the club contacts the ceiling on the follow through. The reverse may occur to a lesser degree on the back swing.



3. The rotatable handle must be able to rotate about 90 degrees in each direction. Rotation in one direction allows the head to fall downwardly behind a person's shoulder after the golf club collapses. Rotation in the other direction allows the head to hang downwardly when the golf club is held at waist level. The images below show: (1) a starting position; (2) a collapsed position, after the golf club contacts the ceiling and breaks away; (3) a rotated position with the golf club hanging over the player's shoulder; and (4) a returned position with the handle of the club at waist level. I will e-mail some photos so that you fully understand how the golf club works. The handle is biased to return to the central position.

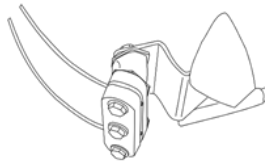
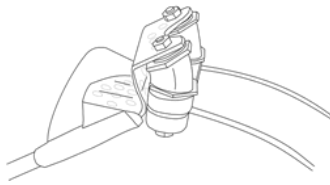


4. The mount portion is very important because it takes a great deal of the shock and protects the flexible rods and head. I have sketched our first prototype below. We are currently working on how to reduce the size and weight of the mount.



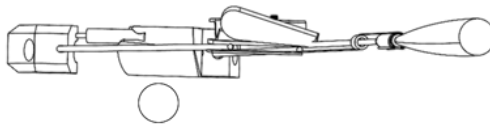
5. The mount must be able to bend over a relatively large range. I will email details of the preferred angles shortly. No existing clubs can bend over these angles. You can

get an idea of the preferred range from the images below.



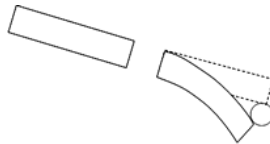
Second Advantage

1. The club is intended to be used with a plastic or foam golf ball under an 8 foot ceiling. The head has been designed to encourage twisting and force the rigid portion to break away. The head has also been designed to provide an actual club face at ground level. One of our preliminary golf club designs is shown below.



Third Advantage

1. If made sufficiently strong the club can also be used for strength training against a table leg. This is shown below.

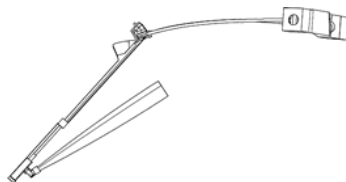


Other Advantages

1. I use a full length club with a flexible portion. This allows a person to practice hitting into the ground as would be the case with a sand iron.

4. Notes

I am working on further images of the break-away. Here is an image of a version with a different form of break-away. This break-away was intended to provide a smooth 'break-away' action. I don't think that this form of break-away is really practicable.



5. Variations

I have thought of a few variations. I would like to cover these as possibly being individually patentable.

1. Variations that are just used for strength training with no break-away.

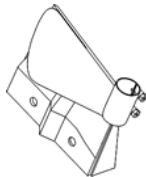




2. Variations where the break-away tension is adjustable by turning a base plate system. I'll send some more detail about this shortly.



3. Variations where the break-away angle on contact with the ceiling can be adjusted by rotating the head mount about the shaft.



4. Variations where the head portion and the flexible rods are made from one piece of material.

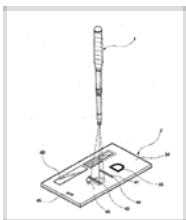
6. Advantages and Operation of Variations

I would be pleased to discuss the advantages and operation of the variations by telephone. At the moment I am still working on the detail of these variations.

7. Cursory Searching (Optional)

I have done a bit of searching on [Google Patents](#), [Espacenet](#), [WIPO](#) and the [USPTO](#). I have located the following documents.

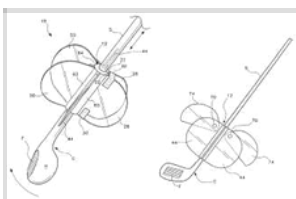
KR20020017906 'Machine for Practicing Golf Swing' March 7, 2002 (LEE DONG IK)



KR20020017906 appears to use a shortened club with a light source where the light source passes over a light plate sensor. This invention is nothing like mine because there is no contact with a real ball. Also a player is provided with no information as to whether the club would hit the ground before hitting the ball.

**Image taken from [KR20020017906](#)*

US 6,881,156 'Golf Training Aid' April 19, 2005 (PHILLIPS PHILIP S)

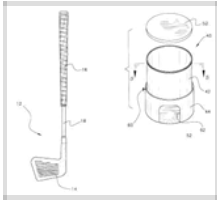


This practice device is supposed to be a training aid. While resistance is provided there is no contact with a table leg as there could be with my invention. I could also provide for increased resistance by replacing the two rods with a single sheet of flat flexible plastics material.

US4911450 provides a similar system.

**Image taken from [US6881156](#)*

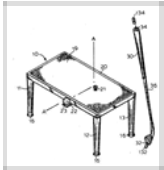
US 5,947,830 'Golf Practice System' September 7, 2009 (O'NEILL WILLIAM T)



This is simply a shortened golf club. My golf club is a full length golf club. My golf club allows a normal person to stand upright and for a full swing to be taken from underneath a ceiling.

**Image taken from [US5947830](#)*

US 4,432,552 'Golf Practice Apparatus' February 21, 1984 (SAVERINO BENNETT J)



This system uses a shortened club together with a table. As noted my club is a full length club. There is no need for a table using my club.

US3975024 and GB2365783 provide similar systems.

**Image taken from [US4432552](#)*

8. Website Searching

I did a quick web search and located a number of clubs. Each of these is basically a telescopic golf club. Here are a couple of them.

The 'All in One Golf Club' - <http://www.allinonegolfclub.com/>

The 'DivotClub' - <http://www.divotmat.com/DivotClub-Collapsible-Travel-Club-p9.html>

9. Further Searching

At this time I don't want to proceed with a professional search as I would like to get a patent application in place as quickly as possible. Basically I am going to show my invention to someone on . . .

10. Development

I am in the process of developing a special way of biasing the handle into position. I know I could include details of this in my patent application but really have to fully work things out before it makes any sense. Also I have some other ideas that I am thinking of including in the specification. I would like to discuss with you whether I should include these details.

11. Inventors

I am the sole inventor. No one else made any kind of contribution to the invention. My friend who understood that my invention was always to be kept strictly confidential came up with the idea of having a collapsible club but didn't come up with the break-away or the flexible portion. I would like to discuss this with you in more detail as all

the ideas are really mine.

12. Prior Disclosure

Besides my friend, I showed my invention to some industrial designers. I did this about two months ago and we all signed a standard confidentiality agreement.

Client Information Brief Observations

The invention may not have been the most commercially practical, nor have made it to the market. Nonetheless the hypothetical invention disclosure serves to highlight some important points.

Firstly, the advantages and operation of the invention have been described along with details of possible variations. Should the inventor have failed to disclose the variation without the break-away, the variation may not have been covered by the patent application.

The inventor has done some of his own searching on [Google Patents](#), [Espacenet](#), [WIPO](#) and the [USPTO](#). This has highlighted some of the important differences between the invention and the prior art.

The inventor has brought inventorship and prior disclosure issues to the attention of his or her patent attorney.

The inventor has provided line drawings. Sketches would have been adequate for a provisional application. Line drawings and sketches could always have been prepared by the inventor's patent attorney.

For another example, please see our [client information brief](#) for a software type invention.

*As with all information provided by this website, the content of this webpage is subject to our [disclaimer](#). The material provided is not to be relied upon under any circumstances.



CLIENT BRIEF

Preparing a client information brief for a software type invention is similar to preparing a client information brief for a [mechanical type invention](#). Providing detailed information in written form will ensure that your patent attorney appreciates all the important features of your invention. Often, however, such a detailed written disclosure is often not strictly required provided that you can readily have a face to face meeting with your patent attorney and your patent attorney fully understands your invention.

As with mechanical type inventions, a client is best advised to fully describe the advantages of his or her invention as well as the structure that provides those advantages.

The following client information brief provides an example of a brief for a software type invention. The brief makes use of images and text from several existing patents and patent applications. As such the brief provides an overview of the type of information that is considered useful in the preparation of an application for a software type invention.

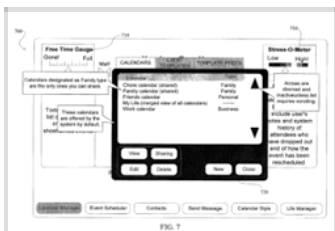
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HYPOTHETICAL BRIEF

I have provided a number of screenshots and drawings to illustrate my invention. I have also provided access to my website at https://www.adamlaw.com.au/alpha_version/login.php. The login details are username: patent_at and password: J8%F3r4bc.

Notably, as detailed in the section entitled 'prior disclosure' below, the invention has been kept secret and my web development company understands that my idea is confidential. I would however like to discuss the possible [implications](#) of prior disclosures when convenient.



My invention relates to an improved calendar system.

** Image taken from*

US2002/131565

2. Advantages

My invention has a number of advantages including providing a calendar system that:

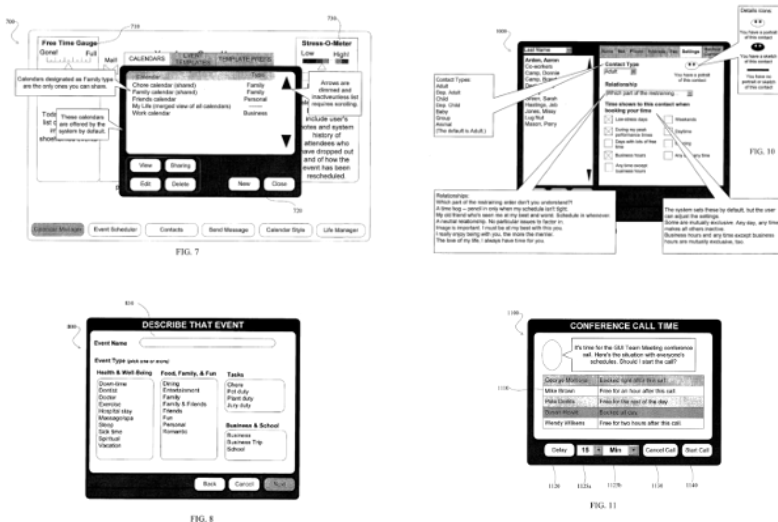
1. Automatically calculates travel times and alerts the user if the calculated travel time conflicts with a start time of a scheduled appointment.
2. Generates alternate travel routes if a selected travel route is determined to have a travel time conflicting with a scheduled appointment.

**Advantages taken from US5790974*

3. Provision of Advantages

First Advantage

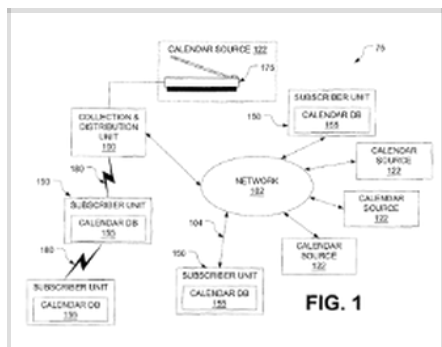
1. The best way to gain an understanding of how my invention works is to look at my website using the access details provided above. I have however also included a number of screenshots below .
As shown a user creates a new calendar task in his or her calendar. The system then ... The user is also able to use a travel time toolbar to ... The toolbar includes ... On activating ... The calendar contains ...



etc ...

*Images taken from US2002/0131565

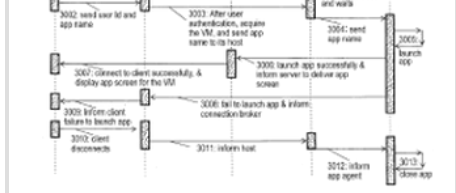
2. The basic system layout is illustrated below. As shown there is a primary server and a ... The primary server serves a ... number of ... The primary server is connected to ... and receives information from ... This allows ...



*Image taken from US7752188

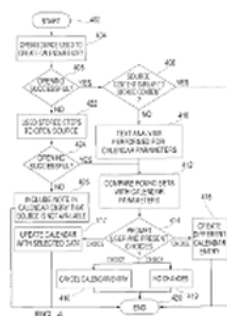
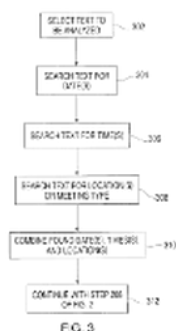
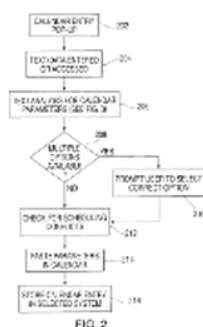
3. The following diagram shows a sequence of communication steps that advantageously ... As shown in the diagram ...





*Image taken from US2010/146504

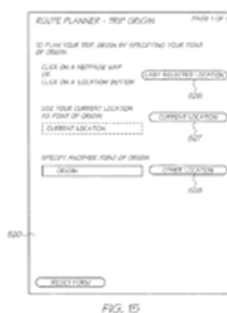
4. I understand that you will prepare the necessary flowcharts based on the wording of the application. I have nonetheless included some flowcharts of my own. As you can see the steps involve ... This advantageously allows ...



*Images taken from US7475021

Second Advantage

1. In the case of the second advantage I have included some sketches. As shown a user can ... This advantageously ...



etc... *Images taken from US7421337

*Images taken from US7565155

Other Advantages

I am in the process of preparing a description of the other advantages of my invention. I will forward the description to you shortly.

4. Variations

I have thought of a few variations that I would like to cover including:

1. Systems that are primarily for air travel rather than car travel.
2. Systems that provide a plugin for existing calendar systems.
3. Systems that are able to estimate travel costs over a particular period of time.

5. Cursory Searching (Optional)

I have done a bit of cursory patent searching on [Google Patents](#), [Espacenet](#), [WIPO](#) and the [USPTO](#). I was not able to readily locate any documents that seemed to be particularly relevant. There were documents that related to route planning but none that related to conflicting calendar entries.

6. Website Searching

I also did a bit of searching on [Google](#) and located the following software product.

'AJL Travel Planner Addin for Outlook' <http://ajltravelpartneraddin.com.au>

The AJL Travel Planner Addin allows distance and route time information to be entered into a calendar item. The software product is quite different to my invention as my system automatically estimates travel distances and also determines different travel routes to accommodate scheduled appointments. Also with my system a user can simply copy a Google Map URL to the clipboard and the system will automatically add the map to the calendar item and then use the map to display a travel route. The AJL Travel Planner Addin for Outlook is much simpler than this and really only modifies the duration of a calendar item.

7. Further Searching

I would like to you to perform a professional search so that I have a better idea as to whether my invention is new. I would like however to have the search completed and protection in place by ... I hope to show my invention to an investor on ... but will refrain from doing so until you have confirmed that protection is in place.

8. Development

I am in the process of developing a special way of allowing travel expenses to be automatically calculated based on particular models of car. As I am still having such functionality programmed, I would like to discuss whether I should include details at this time.

9. Inventors

The invention has been developed by myself with the assistance of a web design company. I was the driving force behind the invention and the web design company hasn't, in my opinion, made any real contribution.

10. Prior Disclosure

Although the web design company has not signed a confidentiality agreement, they did understand that the invention was to be kept secret. My website has not been released to the public.

Client Information Brief Observations

The hypothetical client information brief serves to highlight some important points.

Firstly, the advantages and operation of the invention have been described along with details of possible variations. Should the inventor have failed to disclose the variation concerning air travel, the patent application may have been limited to say car travel. By noting the variation, it can be assured that the patent attorney will give due weight to the variation.

The inventor has done some of his or her own searching using [Google](#) and several patent websites including [Google Patents](#), [Espacenet](#), [WIPO](#) and the [USPTO](#). Although no prior patent documents were located the inventor did find an existing software product. The existing software product advantageously serves to highlight some of the important features of the invention.

The inventor has brought inventorship and prior disclosure issues to the attention of his or her patent attorney.

The inventor has provided several screenshots. Sketches would have been adequate

for a provisional application. Line drawings and sketches could always have been prepared by the inventor's patent attorney.

For another example, please see our [client information brief for a mechanical type invention](#).

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TRADE MARKS

Overview

Trade mark registration in Australia will allow you to prevent competitors from using and registering your trade mark.

A trade mark registration generally provides legal rights across Australia.

Overseas Applications

It is possible to file a trade mark application in a [convention country](#) up to six months after first filing a trade mark application in Australia and to claim priority from the Australian trade mark application.

Australia is a member of the Madrid Protocol. This allows for the centralised filing of overseas applications and the centralised renewal of overseas registrations in a number of [Madrid Protocol countries](#) including the US, Europe and China. Further information regarding filing applications overseas is available on request.

Ownership

The first person to use a trade mark in Australia is generally the owner of the trade mark. Ownership extends to goods and services of the 'same kind of thing' in respect of which the trade mark has been used.

Registering a trade mark is considered to be use of the trade mark and prima facie evidence of ownership of the trade mark. In some cases there may be more than one registered honest concurrent owner of a trade mark, where each owner has a registration in respect of the same or similar goods and services. To be an honest concurrent owner you must have adopted the mark in good faith and have substantial use of the mark.

Term of Protection

When a trade mark application is filed in Australia, 6 months of provisional trade mark protection is provided in all convention countries.

Trade mark renewal fees for an Australian trade mark registration are payable every ten years.

Representations

Trade marks usually comprise word marks or device marks. There are other types of marks such as certification, sound, scent and colour marks. These other types of marks have much more onerous registration requirements.

It is advisable to always file a word mark and optionally to file a device mark. Each application should cover the goods and services in connection with which the mark is intended to be used.

Goods and Services

It is possible to protect both goods and services. For example, a baker who makes speciality cakes may apply for a registration covering goods comprising cakes as well as services comprising selling cakes. In this manner a registration will protect the mark

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applied to cakes as well as franchises and retail outlets using the mark as part of their name.

Is evidence of use required?

Evidence of use may be required if there is already similar trade mark registered in respect of goods of the same description or closely related services. Evidence of use may also be required if the mark has a descriptive character.

How involved is the process?

The process usually involves conducting a preliminary search, filing an application, responding to an examination report and attending to registration fees. Please contact us if you require a flowchart with cost estimates.

How much information is required?

In order to provide a trade mark filing strategy we require sufficient details of your business to allow us to formulate a specification of goods and services. In addition, we require details of the marks and packaging used along with any slogans. This information will allow us to prepare a trade mark filing strategy.

Why should I use a trade mark attorney?

A trade mark attorney will be familiar with the types of objections that could be raised during examination and will be able to respond appropriately to ensure that your rights are not prejudiced.

In addition a trade mark attorney will be able to provide a filing strategy covering such matters as: (i) whether applications should be filed in plain or graphical font with or without a logo; (ii) whether the specification should cover both goods and services; (iii) whether objections are likely to be raised during examination; (iv) whether evidence of use is likely to be required; and (v) whether it is advisable to perform a preliminary trade mark search. A trade mark attorney will also be able to provide advice covering the various procedures available and issues involved with extending your application to overseas jurisdictions.

What could happen if I don't register my trade mark?- Best Case Scenario

Assuming a best case scenario, no one copies your trade mark or uses a similar trade mark in Australia or anywhere else in the world. As a result, you can advertise and use your trade mark in Australia and extend your operations to overseas countries as your business expands without having to change your trade mark.

What could happen if I don't register my trade mark? - Worst Case Scenario

Assuming a worst case scenario, another party is already using your trade mark or a trade mark similar to it in Australia and has a trade mark registration. The other party sees you using your trade mark and sends you a 'cease and desist letter' demanding that you stop using the trade mark and pay for damages to the other party's business. By this time you have invested considerable sums in branding and advertising and could lose revenue if you change your trade mark.

Unfortunately, your only options are to ignore the letter (which could result in the other party taking you to court) or to change your trade mark. The first option is generally not advisable as it is likely to involve court costs in addition to you ultimately having to change your trade mark. The other party may have also registered several domain names that are presently driving clients away from your website. In addition, the other party may have registered their trade mark in overseas countries thereby limiting expansion of your business.

What could happen if I don't register my mark? - Better Case Scenario

A better case scenario is that you were using your trade mark well before the other party registered their trade mark and sent you a 'cease and desist letter'. In such a case you could defend any legal action taken by the other party on the basis that you are

the true owner of the mark in that jurisdiction or, at least, are a prior user of the trade mark. In such a case the other party would most likely oppose any action you take to jointly register your mark and may even still take legal action. Removing the other party's registration will typically be difficult and costly due to concurrent user provisions. Notably, some countries such as China do not recognise prior user rights.

Trade Mark Links



IPAustralia: Australian Patent Office

<http://www.ipaustralia.gov.au>

Info date: 28/10/2009

The Australian Patent Office website provides information on Australian trade marks and the Madrid Protocol. The website provides access to the trade marks database. The trade marks database can be searched by owner, trade mark, kind and date.



OHIM: Office for Harmonization in the Internal Market

<http://oami.europa.eu>

Info date: 28/10/2009

OHIM is the official trade marks and designs registration office of the European Union. The OHIM website provides information on the Community Trade Mark (CTM) covering 27 member states of the European Union. The website allows searching of the CTM database.



USPTO: US Patent Office

<http://www.uspto.gov/>

Info date: 28/10/2009

The United States Patent Office website provides information on US trade marks. The website allows searching of the US trade marks database.



Wikipedia: Trade Marks

http://en.wikipedia.org/wiki/Trade_marks

Info date: 28/10/2009

The Wikipedia section on trade marks provides some useful information.

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DESIGNS

Overview

A design registration will allow you to protect the visual appearance of a product. Unlike a patent, there is no requirement that a design registration be inventive. A design registration can be a very effective form of protection for this reason. It is quite common for a design application and a patent application to be filed together.

Requirements

In Australia, a design registration must be new and distinctive. If the design exists in a relatively cluttered field then relatively small differences can provide the design with distinctiveness.

In Australia, a design application must be filed before the design is disclosed to a member of the public in non-confidential circumstances. Australia generally provides no period of grace for prior disclosures except in exceptional circumstances. Comparatively, the US and Europe provide a twelve month period of grace for prior disclosures. Further information is available on request.

Most countries including Australia examine design applications with regard to disclosures and publications on a worldwide basis.

Term of Protection

When a design application is filed in Australia, 6 months of provisional design protection is provided in all [convention countries](#).

The term of protection in Australia for a design registration is ten years. A single renewal fee is payable after five years.

Overseas Applications

It is possible to file a design application in a [convention country](#) up to six months after first filing a design application in Australia. Further information is available on request.

There is no such thing as a worldwide design registration.

Representations

The number of representations that are required to show a design will depend on the complexity of the design.

It is advisable to file formal line drawings to maintain a relatively broad scope of protection. Filing a specific statement of newness and distinctiveness is also often useful.

At a minimum the following representations are recommended:

- i) perspective view;
 - ii) front view;
 - iii) side view;
 - iv) top view; and
 - v) bottom view.
-

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Design Links



IP Australia: Australian Patent Office

<http://www.ipaustralia.gov.au/>

Info date: 28/10/2009

The Australian Patent Office website provides information on Australian designs. The website provides access to the designs database. The design database can be searched by owner, article, and date.



OHIM: Office for Harmonization in the Internal Market

<http://oami.europa.eu>

Info date: 28/10/2009

OHIM is the official trade marks and designs registration office of the European Union. The OHIM website provides information on the Registered Community Design (RCD) covering 27 member states of the European Union.



USPTO: US Patent Office

<http://www.uspto.gov/>

Info date: 28/10/2009

The United States Patent Office website provides information on US design (design patents). The website allows searching of the US patents database.



Wikipedia: Trade Marks

http://en.wikipedia.org/wiki/Design_patent

Info date: 28/10/2009

The Wikipedia section on design provides some useful information.

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FREQUENTLY ASKED QUESTIONS

Overview

Our frequently asked questions page is divided into a number of sections. If you have any further questions, please contact us [here](#).

General Questions

What is the ethos behind your practice?

Our practice has been established with the aim of providing clients with a high quality of personal service. Further information is available [here](#).

What are your fees and charges?

Our fees and charges are competitive in comparison to other attorney firms based in Perth, Western Australia. We do not charge for a first consultation.

Please [contact](#) us directly for our schedule of fees and charges and terms of engagement.

Why are patent attorney qualifications important?

A patent attorney can be thought of as the interface between the law and engineering, science (and other disciplines). In preparing a patent application (a legal document) it is important that the person drafting the application fully understands the invention and the legal requirements.

What should I look for in a patent attorney?

You should choose a patent attorney who demonstrates a good interest in and understanding of your invention. You should choose a patent attorney who is candid about the costs of the patenting procedure and has solid technical qualifications. Importantly, you should choose a patent attorney who shows an in depth attention to detail.

Must my patent attorney keep my invention confidential?

Yes, your patent attorney must keep your invention confidential. A fiduciary relationship exists between patent attorneys and their clients.

In Australia, the [Professional Standards Board for Patent and Trade Mark Attorneys](#) provides a [code of conduct](#). Among other things, the code of conduct provides a framework for fair and equitable dealing between attorneys and their clients. In general, attorneys are bound by confidentiality and have a [right of privilege](#) on intellectual property matters.

The [Institute of Patent & Trade Mark Attorneys](#) provides a page on the role of your patent attorney.

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Why is the patenting process expensive?

In terms of the patent specification, the document is a legal document that must fully define and describe the invention in explicit terms. Defining and describing an invention in explicit terms is a complicated task and requires a number of hours of work. Preparing a patent specification properly at the beginning of the process is crucial to adequately protect an invention.

In terms of filing your application globally, there is no such thing as a global patent. This means that experienced associates must be used in each jurisdiction to handle corresponding applications. Legal requirements and the need for experience with the patent system in each jurisdiction mean that it is necessary to engage patent attorneys qualified in those jurisdictions. Responses to examination reports need to be prepared in accordance with the specific legal framework of the particular jurisdiction. Deadlines must also be monitored.

In terms of conducting a patent search, a search strategy needs to be prepared. Patent classes and keywords need to be identified to limit the risk of missing an important document. Also, it is not possible to read every published document in the world nor is it possible to search every patent office database independently. The use of commercial search databases and searching expertise is accordingly required. If a relevant search record is identified using the search strategy the associated document needs to be downloaded or ordered. For the reasons above, engaging a specialist search firm is generally the most cost effective option for a patent attorney and his or her client. Of course, at your request, your patent attorney can always perform a cursory search.

Intellectual Property Questions

What is a provisional application?

A provisional application is an application that allows for further applications to be filed in the following 12 months before a full patent application is required. The advantage of a provisional application is that it allows for unknowns associated with an invention to be accommodated where those unknowns come to light within the twelve month period. The disadvantage of a provisional application is that generally no grace period in Australia, the US or a number of other jurisdictions attaches to the provisional application for prior disclosures. There are however a number of special circumstances. Furthermore, this disadvantage only applies if you have disclosed your invention.

What is an innovation patent?

An innovation patent has a lower threshold of inventiveness and a shorter term of eight years compared to a twenty year term for a standard patent. The possible advantage of a lower threshold of inventiveness is an important consideration in any patent filing strategy. Further information is available [here](#).

Is there such a thing as an international patent?

No, there is no such thing as an international patent. There is however a procedure, known as the PCT application procedure, that allows for a preliminary search before you have to file in each jurisdiction of interest. The application procedure serves to both delay costs and provide an initial search report on patentability. Further information is available [here](#).

What is a divisional application?

A divisional application is an independent application filed because there is more than one invention defined in the original application. Notably, filing a divisional application could effectively double your costs in terms of examination, grant and renewal charges. For this reason one should always consider whether filing a divisional application is justified or whether it is an unnecessary expense.

Can I rely on a non-disclosure agreement?

The short answer is that a patent application is usually much better protection than a non-disclosure agreement. A longer answer is available [here](#).

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OUR PEOPLE



Adam Law - Principal

Adam has first class honours degrees in both physics and mechanical engineering from the University of Western Australia. Before starting his own practice in 2009, he worked for a number of top tier patent attorney firms in Melbourne, Perth and Sydney. As a result, Adam has over 10 years experience in the industry.

Adam specialises in mechanical, physics, electronics, software and business method patents. He is a Fellow of the Institute of Patent and Trade Mark Attorneys. He also regularly assists clients with trade mark and design matters.

Adam assists a broad base of clients including large corporations and sole inventors. Adam prepares and prosecutes applications in all major jurisdictions including Australia, Canada, China, Europe, Japan and the US. He regularly consults to patent firms in Melbourne and Sydney particularly with regard to software, semiconductors and electronic circuits. Adam also consults on general mechanical, mining and oil and gas matters.

Adam's experience extends to freedom to operate, infringement and revocation opinions as well as general due diligence. He also assists companies with licensing, commercialisation and strategy advice.

Adam is a member of a number of organisations including the Institute of Patent & Trade Mark Attorneys and the Licensing and Executives Society. Outside of work Adam enjoys playing golf, squash and tennis.



Rohan Wallace - Consultant

Rohan is the principal of ROHANWALLACE Patent & Trade Mark Services. Rohan is a qualified Australia patent and trade mark attorney.

Rohan is co-located at our premises and our firms provide reciprocal support.

Ashley Lee - Assistant

Ashley is completing a LLB and BE at UWA

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PATENT TESTIMONIALS

Phil Harman



Media:

Technology Analyst - Venture West Enterprises Pty Ltd

I've been involved in the patenting process for new inventions, both as an inventor and developer of other inventor's technologies, for over 20 years.

In my opinion the quality of the advice and services provided by Adam are without parallel. His ability to grasp complex technical concepts and document them in the required formats is simply outstanding.

In the past, due to the technical nature of the inventions I have worked on, I've needed to draft much of the patent applications myself. This has not been required when using Adam's services. The depth and breadth of his technical background has simply required me to explain the principles behind the invention and Adam has been able to progress to the necessary applications from that starting point.

I have also used Adam's services to investigate existing prior art, either prior to or during the preparation of patent applications. In all cases he has found relevant documents and provided a comprehensive, and concise, overview of the documents and their implications.

I highly recommend Adam's services and will most certainly be using them again in the future.

March 2013

Frank Sotzik, PhD



Media:

Former University Lecturer

Adam is a very capable patent attorney who demonstrates the highest standard of professional ethics. In June 2012, Adam filed an Australian standard patent for me and two colleagues. His charges were fair and all costs and patenting options were made clear upfront. Adam was efficient and all necessary guidance was provided. All relevant legal and ethical issues were clarified. In October 2012, Adam was proactive in solving a patent filing dispute which was not our fault. He had suggested a competent intellectual property lawyer who drafted confidentiality agreements, when seeking an overseas business partner for the patented invention. Adam has done all this with great patience and a sense of

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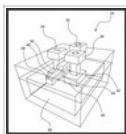
humour. It has been a pleasure to associate with him and I recommend him to all who require the services of a patent attorney..

Thank you for your assistance, Adam!

March 2013

Dac Thong Bui

Doctor



Media:

Adam has been very helpful in assisting me in preparing for my PCT application and the Australian application (AU2011308098) which has been accepted without any modification.

US and European patent applications have also been lodged and are undergoing assessment.

Adam showed a great interest in his work as well as provided the extra energy required to ensure the application would pass the application process.

I highly recommend Adam Law to anyone considering applying for a patent.

March 2013

Colin Ayres



Media:

Managing Director at Ayres

Adam has been most helpful to our company, in our pursuit of patent opportunities. His advice has been invaluable - whether to proceed with a patent application, or whether not to proceed. I can thoroughly recommend Adam to anyone who may be seeking patent assistance.

March 2013

Jonathan Noal



Media:

Managing Director at iDeal League

We hired Adam to create some cascading patents around our new social media platform. Adam was great to work with and he immediately saw areas that we needed to protect and put structure around. He also worked hard and quickly to understand additional areas we could create future value from.

We now have a patent that is both thorough and scaleable for future additions.

Adam is also an absolute pleasure to work - he is always available, has great integrity and puts the hours in to get the job done right. He has even provided us with some interesting networking.

We look forward to an ongoing relationship with Adam and I would have no hesitation in recommending him for any start up / technical product that is looking for patent advice.

December 2012

Wayne Phillips

Managing Director Engineering R&D



We are a small family company using our resources to develop machinery for bio dynamic broad acre cereal application. We would like to thank Adam for his professional services and advice.

We have developed new agricultural technology that we are now commercialising. Anybody that has made this kind of commitment will understand the many unknowns and inherent financial risks that need to be navigated along the way. We have found the process very much lightened by Adam's upfront disclosure of costs and his generosity in allowing an investment of his own time for discussions. Adam has extended his services in introducing us to others specializing in product commercialisation. Adam's support has allowed us to feel confident and secure with our investments.

August 2011

TRADE MARK TESTIMONIALS

Paul Cook

Director

I had the pleasure of dealing with Adam recently as he registered my company trademark for our business. Adam has a great understanding of the area and throughout the whole process was completely professional and courteous.

He kept me informed during each stage of the process and made it very simple for me to understand and

monitor. He took care of the application from start to finish with little effort required on my part. Needless to say the application was successfully approved and I have no hesitation in recommending Adam Law to anyone who requires his services in the future.

Next



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