



Summary | Patent Co-Design Feasibility Study 2024

Highlights

- The Patent Co-Design Feasibility Study looked at whether the patenting process could be updated to include a more collaborative approach between applicants, attorneys, and examiners.
- In the initial Baseline Stage, 30 stakeholders (15 inventors/applicants, 7 IP attorneys, and 8 IP Australia staff) were interviewed. Selected interviewees participated in group discussions to identify current tensions and develop possible solutions together.
- During the Concept stage, 19 workshop participants (5 inventors/applicants, 2 IP attorneys, and 12 IP Australia staff) agreed a focus on early stages of patent claim development would be most effective, specifically in translating inventive characteristics and prior art searching.
- Study findings will be used to inform improvement of our patent services and public education and awareness, including by IP Australia's Innovation lab, IPAventures.

Background

IP Australia is committed to investing in innovation to improve products and services and ensure Australians benefit from great ideas. As part of this investment, in 2022-23, IP Australia commissioned a team of researchers to investigate whether the patenting process could be updated to include a collaborative approach between applicants, attorneys, and examiners. Such a collaborative process is envisaged to use computer-assisted tools for rapid drafting and prior art searching.

The patenting process is a key part of technology commercialisation and ensures that Australians benefit from great ideas. However, taking an innovation from idea to granted patent can be lengthy, costly, and uncertain, with iterative exchanges between patent examiner, applicant, and IP attorney.

Methodology

Two research cycles of stakeholder engagement and analysis were completed. The Baseline Stage set out to define the current state. The Concept Stage built on the Baseline Stage, with a collaborative, iterative approach to envisioning options for a co-designed patent process.

The applicants, attorneys, and examiners each brought a distinct perspective. Since applicants are often represented by an attorney in their interactions with IP Australia, this was an opportunity to hear directly from applicants.

Baseline Stage methodology

Participants were experienced, senior decision-makers from IP attorney firms, businesses, and IP Australia. The cohort included broad representation across business and research sectors. The researchers conducted semi-structured individual online interviews with 30 stakeholders about their experience of, and suggestions for improving, the patenting system in Australia.

The research questions addressed by the Baseline Stage interviews were:

- How do core stakeholders in the Australian patenting regime experience the current process?
- How can the process be improved for core stakeholder interests to be met better?

Interviewees were asked to discuss three questions:

1. What is your experience of the current patenting process?
2. How can the patenting process be improved, from your perspective?
3. What challenges would the core stakeholders (inventors, attorneys, and examiners) have to address if they were to engage in co-designing the transformation of the patenting process?

Overarching themes were explored in two subsequent facilitated focus groups. The groups identified the key issues to address in the Concept Stage of the research.

Concept Stage methodology

The Concept Stage included three facilitated workshops. These explored options to co-design aspects of a patenting process, addressing the issues identified in the Baseline Stage.

This stage included one workshop with patent examiners and two workshops with patent attorneys, applicants, and patent examiners together. Based on the Baseline Stage findings, the focus was on identifying collaborative ways to improve the patent process, particularly for Australian innovators and small-to-medium enterprises.

Findings

If you think about patents relative to other intangibles, patents probably have the highest discomfort threshold, the least amount of foreseeable guarantee, and the highest cost. (Applicant, Baseline Stage)

Baseline Stage findings

Three themes dominated the Baseline Stage interview data. Most stakeholders:

- viewed the current process of taking an idea, developing a patent specification, progressing through examination, and being granted a patent as being slow, expensive, and uncertain
- expressed interest in a co-designed patenting process while identifying major challenges to its creation such as conflict of interest, disruption and return on investment
- viewed the leadership of a co-designed patenting process as critical to its efficacy and to the realization of the strategic intent to enhance Australia's innovation capabilities.

All stakeholder groups considered that applicants, including those represented by an attorney, experience the least transparency and most frustration with the current patenting process and could be assisted more.

The patent system could be much more informative about an applicant's invention. Applicants can be assisted to understand what they've got, what others have done in this space, and how they could improve the invention. (IP Attorney, Baseline Stage)

Streamlining the process in any way, shape or form would help. There could be opportunities to do this by using things like AI in the front end of the process. (Applicant, Baseline Stage)

The first Baseline Focus Group discussed whether the process the applicant goes through prior to filing a patent application should receive more attention, such as education and transparency or searching as a service, and the implications of 'institutional' problems such as the fiduciary duty of attorneys in listed corporations is to shareholders rather than customers. The focus group explored stakeholders' views on collaborative ways of getting to a granted patent as efficiently as possible.

The second Baseline Focus Group discussion strongly endorsed the need for better education and greater transparency of the existing process. The group saw artificial intelligence (AI) and other new technologies as offering potential enhancement of the patenting process by providing faster outcomes, with technology-facilitated augmentation. With the help of AI and associated

technologies, changes could streamline the current process, and especially the pre-filing stages of the patenting process.

Concept Stage findings

Four design areas emerged from the Baseline Stage, focussed on streamlining the patenting process.

1. Reviewing the process the applicant goes through before filing a patent application, and making it easier to navigate with better education, early facilitated discussion with examiners, and digital tools including AI.
2. Identifying collaborative ways to get to grant as efficiently as possible.
3. Clarifying the purpose of the patenting process and ensuring that each step in the process is underpinned by good policy rationale regarding what it is meant to achieve.
4. Education towards shared understanding of the purpose of each step from preparing a patent application through to grant.

Of these four design areas, the participants agreed on a specific problem to solve: that broad claims are currently 'tested' through the examination and acceptance process, creating frictions in the system, adding resource-intensive iterations, and creating a lack of certainty. The primary source of tension identified by workshop participants was that there is no collaboration in characterising inventive features, which can fail to properly capture the essence of inventor's idea.

Participants agreed that focusing on the earliest stages of patent claim development would be most effective, specifically in translation of inventive characteristics and prior art searching. Participants agreed this would require:

- An opt-in collaborative process to be completed prior to filing a patent application
- Inventor's input and involvement throughout the process
- A collective pre-assessment of 'key inventive' characteristics before patent filing.
- A digital collaboration platform for users to develop invention characteristics, market relevance, and prior art searching.

The Concept Stage workshops concluded by identifying requirements for, and risks of, this process.

Next steps

The study has heard directly from applicants and attorneys about their experience of the IP system, capturing valuable information. This is insightful and provides perspectives that added to established patent attorney consultation and feedback mechanisms. The workshops provided improved understanding of the tensions in the patent process, which are not necessarily captured through traditional consultation routes.

The research outcomes will be used by IP Australia to inform:

- Development of education and outreach activities
- Stakeholder engagement and consultation approaches
- Continuous development of patents services
- Development of new service offerings.

The study's problem statement and findings will also be considered by IP Australia's Innovation lab, IPAVentures, which focuses on customer needs, new services, and opportunities for the IP system.