

Article Information

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Service: Corporate & Commercial, Dispute Resolution & Litigation, Intellectual Property, Intellectual Property & Technology, Intellectual Property Litigation

Sector: Energy & Resources, Infrastructure

The NOCO Company v Brown and Watson International Pty Ltd: Revisiting the Best Method and Relevant Date Requirements for Divisional Patents

In the recent Federal Court decision of *The NOCO Company v Brown and Watson International Pty Ltd*,^[1] Moshinsky J provided welcome clarification regarding the 'relevant date' from which to assess the 'best method' requirement for divisional patents.

Introduction

To maintain validity in Australian patent law, there is a requirement for a patent application to disclose the 'best method' of performing an invention. Section 40(2)(aa) of the *Patents Act 1990* (Cth) requires a patent application to specify 'the best method known to the applicant of performing the invention'.^[2] A patent can be revoked if it does not conform with this requirement. As such, it is a powerful and popular ground for parties to utilise when seeking to revoke a patent.

Dometic Australia v Houghton Leisure Products Pty Ltd [2018] FCA 1573^[3] is at the forefront of this 'best method principle.' There, Justice White concluded that the relevant date for disclosing the best method is the filing date of the divisional patent application. This suggested that any improvement to an invention which occurred between the filing date of a parent application and the divisional application needed to be highlighted upon filing the divisional application. Otherwise, the best method requirement would not be met. Practically, this approach can be troublesome for patent applicants and patent attorneys.

However, *The NOCO Company v Brown and Watson International Pty Ltd* [2025] FCA 887^[4] may have clarified this approach. The case concerned three divisional Australian patents owned by The NOCO Company ('**NOCO**') titled 'portable vehicle battery jump starter apparatus with safety protection'.^[5] NOCO alleged that Brown and Watson International Pty Ltd's ('**B&W**') products infringed these patents. However, B&W cross-claimed for invalidity. Issues such as lack of novelty^[6] and an inventive step^[7] were discussed at length. However, the most topical invalidity ground asserted was that of a failure to disclose the 'best method.'^[8]

The below analysis considers the changing legal landscape around the 'best method' peculiarity in Australian patent law, as well as the prosecution of divisional patent applications.

Background Facts

The applicant, NOCO, is an American company that designs and markets consumer electronics, automotive chemicals and parts, and a range of electrical components. The respondent, B&W, is an Australian automotive accessories wholesaler.

As the patentee, NOCO filed three patents^[9] relating to jump starter apparatus for boosting depleted or discharged batteries.^[10] These patents were filed as a series of divisional applications;^[11] however, they were from the same family. Each patent claimed an earliest priority date of 3 July 2014, based on the filing date of the patents under the Patent Cooperation Treaty application process ('**PCT Application**').^[12]

Crucially, however, the filing dates of the patents was much later; namely, 2020, 2021 and 2022.^[13] Thus, the seminal question of the case was spurred: what is the 'relevant date' at which the 'best method' known to the patentee should be

assessed? Here, the two possible dates were:

- The filing date of the initial PCT application, being 3 July 2014; or
- The filing date of each individual divisional patent.

NOCO argued that this knowledge requirement concerning best method should be assessed at the filing date of the PCT Application, with this being *'the first filed application in the claim of divisional applications and the date from which the term of each patent runs'*.^[14] In doing so, NOCO submitted that the court's approach in *Dometic* was *'plainly wrong'*.^[15]

B&W contended that that the 'relevant date' had been the filing date of each divisional patent application.^[16] Thus, NOCO would have failed to disclose the best method known at these dates, due to better methods having been developed between 2014 and 2022.

Decision

Ultimately, Justice Moshinsky found that the divisional patents lacked an inventive step. Thus, the decision of the case did not turn on the issue of 'best method.' However, His Honour considered the best method ground for completeness and, consequently, provided much needed clarity.

In formulating its argument, NOCO relied on previous authorities from the Federal Court and Full Federal Court, which were adopted by Justice Moshinsky.^[17] The starting point for His Honour's reasoning was *Rescare*,^[18] in which Justice Gummow found that the relevant date at which to assess best method was the international filing date.^[19] This principle was mirrored throughout *Pfizer*,^[20] which was also considered by Justice Moshinsky^[21].

Unlike White J in the *Dometic* decision, Justice Moshinsky considered the Full Federal Court in *Mont Adventure Equipment*. The differences in these two decisions is perhaps attributable to this additional consideration. Justice Moshinsky found further support for the principle derived from *Rescare* and *Pfizer* through evaluating *Mont Adventure Equipment*.^[22] There, the filing date of a complete divisional patent application was regarded as the filing date of the parent application.^[23]

Therefore, Justice Moshinsky ultimately found that the relevant date for assessing the best method was the filing date of the earliest application in the patent family. His Honour was seemingly unable to find good reason as to why best method should not be assessed at the date of filing for the parent application.

Key Takeaways

The *Dometic* decision shifted the practical approach to divisional patents in Australia, creating apparent confusion and unrest surrounding the 'relevant date' of best method assessment. Whilst Justice Moshinsky did not *explicitly* state that the *Dometic* decision was wrong, his Honour's reasoning quite plainly infers it. Consequently, *NOCO v B&W* may provide some relief for Australian patent attorneys and patentees. The *NOCO v B&W* decision is arguably a more pragmatic approach as it would relieve patentees from being fearful of their patents being invalidated due to their knowledge having grown since the date of filing their divisional patent application. This itself lends to greater predictability and efficiency in regard to filing.

However, it remains to be seen whether the principle from *NOCO v B&W* will be upheld by a higher court. Importantly, this decision is from a single judge. In addition, despite being the most important aspect of this case from a judicial growth perspective, some may argue that Justice Moshinsky's guidance on this matter was only obiter. whereas Justice White's decision in *Dometic* clearly comprised part of the ratio. Without an appeal court's reinforcement, the 'best method issue' surrounding divisional patent applications remains in limbo. Nonetheless, *NOCO v B&W* provides divisional patent owners some scope for avoiding a successful best method revocation.

[1] [2025] FCA 887 (Moshinsky J) (*'NOCO v B&W'*).

[2] For a detailed discussion of this principle see *Sandvik Intellectual Property AB v Quarry Mining & Construction Equipment Pty Ltd* [2017] 126 IPR 427, [93]-[115] (Greenwood, Rares and Moshinsky JJ).

[3] (White J) (*'Dometic'*).

[4] *NOCO v B&W* (n 1).

[5] *Dometic* (n 3) [1].

[6] *NOCO v B&W* (n 1) [56].

[7] *Ibid* [306].

[8] *Patents Act 1990* (Cth) s 40(2)(aa).

[9] *Ibid* [6].

[10] *Ibid* [2].

[11] *Ibid* [196].

[12] Specifically, a single international patent application filed under the Patent Cooperation Treaty.

[13] *NOCO v B&W* (n 1) [6].

[14] *Ibid* [375].

[15] *Ibid*.

[16] *Ibid* [371].

[17] See generally, *Rescare Ltd v Anaesthetic Supplies Pty Ltd* (1992) 25 IPR 119 (Gummow J) ('*Rescare*'); *Pfizer Overseas Pharmaceuticals v Eli Lilly & Co* [2005] FCAFC 224 (French, Lindgren and Crennan JJ); *Mont Adventure Equipment Pty Ltd v Phoenix Leisure Group Pty Ltd* [2009] FCAFC 84 (Emmett, Bennett and Jagot JJ) ('*Mont Adventure Equipment*').

[18] *Rescare* (n 17) 135.

[19] *Ibid*.

[20] *Pfizer* (n 17).

[21] *NOCO v B&W* (n 1) [375].

[22] *Ibid*.

[23] *Mont Adventure Equipment* (n 17) [14], [18].