

PATENTS REGULATIONS

In force under the Patents Act 1990
Reprinted as at 31 January 1994

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SCHEDULE 1

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COSTS, EXPENSES AND ALLOWANCES

PATENTS REGULATIONS

In force under the *Patents Act 1990*

CHAPTER 1—INTRODUCTORY

Citation

1.1 These Regulations may be cited as the Patents Regulations.¹

Commencement

1.2 These Regulations commence on 30 April 1991.

Interpretation

1.3

(1) In these Regulations, unless the contrary intention appears:

“**abstract**” means abstract of a complete specification;

“**acceptance**” means:

- (a) in relation to a patent request and complete specification relating to an application for a standard patent—acceptance of the patent request and complete specification under section 49 of the Act (“acceptance of patent request: standard patent”); and
- (b) in relation to a patent request and complete specification relating to an application for a petty patent—acceptance of the patent request and complete specification under section 50 of the Act (“consideration and acceptance of patent request: petty patent”);

“**basic documents**” means documents filed in a Convention country in respect of a basic application;

“**certificate of verification**” means a statement:

- (a) that a document to which the statement relates is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and
- (b) that is dated and signed;

“**former attorneys Regulations**” means the Patent Attorneys Regulations in force immediately before the commencing day under the 1952 Act;

“**former patents Regulations**” means the Patents Regulations in force immediately before the commencing day under the 1952 Act;

“**International Bureau**” means the International Bureau of the World Intellectual Property Organization and, as long as it subsists, the United International Bureaux for the Protection of Intellectual Property (BIRPI);

“**patent attorney**” means:

- (a) a person:
 - (i) who is, immediately before the commencement of these Regulations, registered as a patent attorney under the former attorneys Regulations; and
 - (ii) whose registration has not ceased under these Regulations; or
- (b) a person who is registered as a patent attorney under these Regulations;

“**the Act**” means the *Patents Act 1990*;

“**the Tribunal**” means the Administrative Appeals Tribunal.

- (2) A reference in these Regulations to:
- (a) the giving of a notice or other document; or
 - (b) the making of a request or an application;

to the Commissioner or the Patent Office includes a reference to the filing of the document.

(3) A reference in these Regulations to a document that is open to public inspection is a reference to a document that may be inspected by the public at the Patent Office.

(4) Unless the contrary intention appears, if a document is given to a person by the Commissioner or the Patent Office, the document is taken to have been given to the person on the day on which the document is dated by the Commissioner or the Office.

English text of Treaties

1.4.

(1) The English text of the Budapest Treaty as in force for Australia on the commencing day is the text set out in Schedule 1.

(2) The English text of the PCT as in force for Australia on 1 January 1994 is the text set out in Schedule 2.

Prescribed periods: deposit requirements

1.5

(1) For the purposes of paragraph 6 (c) of the Act (“deposit requirements”), the prescribed period is from the filing date of the application to which the specification relates to:

- (a) if the Commissioner makes a declaration under subsection 42 (1) of the Act (“micro-organisms ceasing to be reasonably available”) in relation to the specification—to the end of the period of 3 months from the date taken to be the date of filing of the specification under paragraph 42 (2) (b) of the Act; and
- (b) in any other case:
 - (i) the end of the day immediately before the day on which the application becomes open to public inspection; or
 - (ii) immediately before acceptance;whichever happens first.

(2) If a matter mentioned in paragraph 6 (c) of the Act has been included in the specification, the applicant or patentee is taken to consent to a micro-organism being obtained:

- (a) after the period prescribed in subregulation (1) in respect of the specification to which the application relates; and
- (b) from the prescribed depositary institution with which the micro-organism is deposited; by a person to whom the Commissioner has granted the certification under regulation 3.25 (“request for Commissioner’s certificate authorising release of sample of a micro-organism”) in respect of the deposit.

Disclosure

1.6

(1) For the purposes of section 8 of the Act (“disclosure in basic applications”), the prescribed period is from the date of making the application relating to the basic application to the end of the day immediately before acceptance.

(2) A matter that was claimed or disclosed in a disclaimer or acknowledgement of prior art in a basic application or in a specification or other document filed in respect of, and at the same time as, the basic application is not taken to have been disclosed.

Verification of translations of international applications

1.7 For the purposes of subsection 10 (2) of the Act (“certain international applications to be taken to have been given an international filing date”), the translation of an international application that was not filed in the receiving Office in English must have with it a related certificate of verification.

CHAPTER 2—PATENT RIGHTS, OWNERSHIP AND VALIDITY

Applications by co-owners for directions

2.1

- (1) An application under section 17 of the Act (“directions to co-owners”) must be in the approved form.
- (2) A person making an application under that section must:
 - (a) file with the application a notice stating the facts on which the application is based; and
 - (b) serve a copy of the application and notice on the other patentee or patentees.

Publication or use: prescribed circumstances and periods

2.2

- (1) In this regulation:

“**Paris Convention**” means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force for Australia on the commencing day;

“**recognised exhibition**” means:

 - (a) an official or officially recognised international exhibition within the meaning of Article 11 of the Paris Convention or Article 1 of the Convention relating to International Exhibitions done at Paris on 22 November 1928, as in force for Australia on the commencing day; or
 - (b) an international exhibition recognised by the Commissioner by a notice published in the *Official Journal* before the beginning of the exhibition.
- (2) For the purposes of section 24 of the Act (“validity not affected by certain publication or use”), the following circumstances are prescribed:
 - (a) the showing or use of the invention at a recognised exhibition;
 - (b) the publication of the invention during a recognised exhibition at which the invention was shown or used;
 - (c) the publication of the invention in a paper written by the inventor and:
 - (i) read before a learned society; or
 - (ii) published with the inventor’s consent by or on behalf of a learned society; or
 - (d) the working in public of the invention within the period of 12 months before the priority date of a claim for the invention:
 - (i) for the purposes of reasonable trial; and
 - (ii) if, because of the nature of the invention, it is reasonably necessary for the working to be in public.
- (3) Paragraphs 2 (a) and (b) are prescribed circumstances only if:
 - (a) at the time the application is made for a patent for the invention, the applicant has filed a notice stating that the invention has been exhibited; and
 - (b) before the complete specification in respect of that application is open to public inspection, the applicant has filed a statement issued by the authority responsible for the exhibition in which:
 - (i) the invention and the exhibition are identified; and

- (ii) the date of the opening of the exhibition is given; and
- (iii) where the first disclosure of the invention during the exhibition did not take place on that date—the date of that disclosure.

Prescribed period: publication or use affecting validity

2.3

(1) For the purposes of section 24 of the Act (“validity not affected by certain publication or use”), the prescribed period is:

(a) in the case of a circumstance mentioned in paragraph 2.2 (2) (a) or (b) (“publication or use: prescribed circumstances and periods”):

- (i) if the application claims priority from a basic application made within 6 months of the date of the first showing or use of the invention at a recognised exhibition—12 months from the making of the basic application; and
- (ii) in any other case—6 months after the first showing or use of the invention at the exhibition; and

(b) in the case of the circumstance mentioned in paragraph 2.2 (2) (c):

- (i) if the application claims priority from a basic application made within 6 months of the date of the first reading or publication referred to in that paragraph—12 months from the making of the basic application; and
- (ii) in any other case—6 months after the first reading or publication; and

(c) in the case of the circumstance mentioned in paragraph 2.2 (2) (d)—12 months from the start of the first public working of the invention referred to in that paragraph.

(2) For the purposes of paragraph 24 (1) (b) of the Act, the prescribed period is 12 months from the day when the information referred to in that paragraph became publicly available.

Prescribed period: patents of addition

2.4 For the purposes of section 25 of the Act (“validity: patents of addition”), the prescribed period is from the priority date of the claim of the specification of the main invention, being the claim:

- (a) defining that main invention; or
- (b) if there are 2 or more claims defining the main invention—that has the earlier or earliest priority date;

to the end of the day that is the priority date of the relevant claim of the specification of the patent of addition or of the application for a patent of addition.

Prescribed period: assertion that invention is not patentable

2.5 For the purposes of subsection 27 (1) of the Act (“notice of matters affecting validity of standard patents”), the prescribed period is from the day when the complete specification filed in relation to an application for a standard patent becomes open to public inspection to immediately before acceptance.

Prescribed period: notification of assertion of invalidity of petty patent

2.6 For the purposes of subsection 28 (1) of the Act (“notice of matters affecting validity of petty patents”), the prescribed period is 11 months from the day on which the petty patent is granted under subsection 62 (1) (“grant and publication of petty patent”).

Documents to accompany notice of assertions of invalidity

2.7 Notice of an assertion under subsection 27 (1) (“notice of matters affecting validity of standard patents”) or 28 (1) (“notice of matters affecting validity of petty patents”) of the Act must, where the assertion is based on a document, have with it:

- (a) if the document is not available in the Patent Office—a copy of the document; and
- (b) if the document is not in English—a translation of the document into English and a related certificate of verification; and
- (c) evidence of the date and place of publication of the document.

CHAPTER 3—FROM APPLICATION TO ACCEPTANCE

PART 1—INVENTIONS GENERALLY

Prescribed documents: patent applications

3.1

(1) For the purposes of subsection 29 (1) of the Act (“application for patent”), an abstract, and a copy of the abstract are required to be filed with a patent request made in relation to a complete application.

(2) For the purposes of subsection 29 (1) of the Act, if a complete application is made, the following documents are required to be filed before acceptance:

- (a) a notice by the applicant stating the entitlement of the nominated person to the grant of the patent; and
- (b) if the applicant claims priority from another application—a notice by the applicant stating the entitlement of the nominated person to claim that priority;
- (c) if a micro-organism is deposited with a prescribed depositary institution:
 - (i) if the deposit is an original deposit within the meaning of Rule 7.3 of the Budapest Treaty or a new deposit within the meaning of Rule 7.4 of that Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty; and
 - (ii) if samples of the micro-organism were transferred to that institution under Rule 5.1 (a) (i) of the Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty; and
 - (iii) if a receipt referred to in subparagraph (i) or (ii) is not in English—a translation of the receipt into English and a related certificate of verification; and
- (d) if the application relies on section 6 of the Act (“deposit requirements”)—a notice by the applicant stating the entitlement of the nominated person to rely on the deposit for the purposes of the Act; and
- (e) if the application is an application to which subsection 34 (2) of the Act (“applications by eligible persons arising out of court proceedings”) applies—a copy of the court order declaring the applicant to be an eligible person in relation to the invention so far as claimed in a claim of the specification; and
- (f) if the application is an application to which subsection 36 (3) of the Act (“other applications by eligible persons”) applies—a copy of the declaration of the Commissioner that the applicant is an eligible person in relation to the invention as disclosed in the specification; and
- (g) if the request is for a patent of addition and is made by a person authorised by the applicant or patentee—a statement authorising the person that is signed by the applicant or patentee.

(3) For the purposes of subsection 29 (1) of the Act, if a PCT application claims the priority from a basic application:

- (a) a copy of the relevant basic documents; and

- (b) if those basic documents are not in English—translations of the documents into English and related certificates of verification;
must be filed before acceptance.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Specifications

3.2

- (1) A provisional specification must be in the approved form.
- (2) A complete specification must:
 - (a) be in the approved form; and
 - (b) comply substantially with the requirements of Schedule 3; and
 - (c) have with it a copy of the specification:
 - (i) marked on the first page as a true copy; and
 - (ii) if the specification includes drawings—marked on the reverse side of each sheet of drawings as a true copy; and
- (3) If a complete specification is not in accordance with the Act or these Regulations, the Commissioner may:
 - (a) treat the complete application to which the specification relates as not having been filed; and
 - (b) return that specification to the applicant with:
 - (i) a written statement of the reasons for the return; and
 - (ii) any other document filed in respect of the application.
- (4) If the Commissioner treats a complete specification as having been filed, he or she may, within 1 month from the date of filing of the specification, direct the applicant to do such as are necessary to ensure that the specification complies with those requirements.
- (5) The complete application to which the complete specification relates lapses if an applicant to whom a direction has been given does not comply with the direction within:
 - (a) 3 months after the day on which that direction was given or the specification becomes open to public inspection, whichever happens later; or
 - (b) if:
 - (i) the direction is given to assist the Commissioner in relation to subregulation 3.4 (1) (“substitute abstracts”) in deciding whether a filed abstract is in accordance with these Regulations; and
 - (ii) the Commissioner has specified in the direction a period of not less than 1 month within which the applicant must comply with the direction;the period referred to in subparagraph (ii).
- (6) If an application lapses under subregulation (5), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) advise the applicant of the lapse.

Abstracts

3.3

- (1) An abstract must consist of:
 - (a) a summary of the disclosure as contained in the description, the claims and any drawings, being a summary:
 - (i) that indicates the technical field to which the invention pertains; and
 - (ii) that is drafted in a way that allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention; and

- (b) if applicable, any chemical formula that, among all the formulas contained in the specification, best characterises the invention; and
- (c) if applicable, the number of any drawing that the applicant recommends should accompany the abstract.
- (2) An abstract must be as concise as the disclosure permits, preferably 50 to 150 words.
- (3) An abstract must not contain statements on the alleged merits or value of the claimed invention or on its speculative application.
- (4) Each main technical feature mentioned in the abstract and illustrated by a drawing in the specification must be followed by a reference sign placed between parentheses.
- (5) An abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art, especially by assisting in the formulation of an opinion on whether there is a need to consult the specification itself for those purposes.

Substitute abstracts

3.4

- (1) If a filed abstract is not in accordance with these Regulations, the Commissioner may prepare a draft of a new abstract in substitution for the filed abstract.
- (2) A copy of the draft of a new abstract must be given to the applicant who may give the Commissioner written comments on the draft within 1 month of the draft being given to him or her.
- (3) The Commissioner must take the comments into account in the final preparation of the new abstract.
- (4) If the Commissioner prepares a new abstract, the new abstract is taken to be the abstract of the specification to which it relates.
- (5) If an abstract is not filed with a complete specification within 1 month from the date of filing of the specification, the Commissioner may direct the applicant to file an abstract within 1 month from the day on which the direction was given.
- (6) If an abstract is not filed within 1 month from the day on which the direction was given, the application lapses.
- (7) If an application lapses under subregulation (6), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) advise the applicant of the lapse.
- (8) An abstract is not taken into account in construing the nature of the invention that is the subject of the specification to which the abstract relates.

Filing date

3.5

- (1) For the purposes of section 30 of the Act (“filing date”), the filing date of a patent application is the date on which a patent request in relation to the application that is accompanied by a specification is filed.
- (2) The Patent Office and each sub-office of the Patent Office may provide facilities for the filing of documents when the Office or sub-office is not open to the public for business.
- (3) A document filed under subregulation (2) is taken to have been filed on the day on which the Office or sub-office was last open for business before the document was filed.

Requests to make determinations between applicants

3.6

- (1) For the purposes of section 32 of the Act (“disputes between applicants etc.”), a request must be in the approved form.

(2) A party making a request must serve a copy of that request on each other interested party as soon as practicable after the request is made.

(3) The Commissioner must publish a notice of the request in the *Official Journal*.

(4) If a party wishes to be heard by the Commissioner, the party must notify the Commissioner accordingly within 2 months of the publication of the notice.

(5) If, as a result of a request, the Commissioner determines under section 32 of the Act to change the name of a nominated person, notice of the determination must be published in the *Official Journal*.

Form of certain applications

3.7 For the purposes of paragraphs 35 (1) (b) (“applications by eligible persons following revocation by Commissioner”) and 36 (1) (b) (“other applications by eligible persons”) of the Act, an application must:

(a) be in the approved form; and

(b) have with it a notice by the applicant stating the grounds on which the application is made.

Applications to be made before certain decisions and declarations

3.8 An application under section 29 of the Act (“application for patent”) of the kind described in:

(a) section 33 (“applications by opponents etc.”); or

(b) section 34 (“applications by eligible persons arising out of court proceedings”); or

(c) section 35 (“applications by eligible persons following revocation by Commissioner”); or

(d) section 36 (“other applications by eligible persons”); of the Act must be made within 3 months from the date of:

(e) if paragraph (a) applies—the decision of the Commissioner under subsection 33 (1) or (2) of the Act; or

(f) if paragraph (b) applies—the declaration of a court under subsection 34 (1) of the Act; or

(g) if paragraph (c) or (d) applies—the declaration of the Commissioner under subsection 35 (1) or 36 (1) of the Act, respectively.

Prescribed period: treatment of complete application as provisional

3.9 For the purposes of subsection 37 (1) of the Act (“complete application may be treated as provisional”), the period of 12 months from the filing date of the complete application is prescribed.

Prescribed period: making of complete applications

3.10 For the purposes of section 38 of the Act (“time for making complete application”), the period of 12 months from the filing date of the provisional application is prescribed.

Making divisional applications

3.11

(1) For the purposes of subsections 39 (1) and (2) of the Act (“divisional applications”), a divisional application must be made under section 29 of the Act (“application for patent”).

(2) A divisional application for a patent under subsection 39 (1) of the Act must be made before the date of the grant of a patent on the first-mentioned application in that subsection.

(3) A divisional application for a patent under subsection 39 (2) of the Act must be made before the end of 3 months after the date of the grant of the petty patent first mentioned in that subsection.

Priority dates generally

3.12

(1) Subject to regulations 3.13 (“priority dates: certain persons and applications”) and 3.14 (“priority dates: certain amended claims”) and subregulation (2), the priority date of a claim of a specification is the earliest of the following dates:

- (a) the date of filing of the specification;
- (b) if the claim is fairly based on matter disclosed in 1 or more relevant applications—the date of making the relevant application in which the matter was first disclosed;
- (c) if:
 - (i) the specification is a complete specification filed in respect of a divisional application; and
 - (ii) the claim is fairly based on matter disclosed in the specification referred to in paragraph 39 (1) (a) or subsection 39 (2) of the Act (“divisional applications”);the date that would have been the priority date of the claim if it had been included in the last-mentioned specification.

(2) In paragraph (1) (b), “**relevant application**” means:

- (a) a provisional application that is associated with a complete application in accordance with section 38 of the Act (“time for making complete application”); or
- (b) if the application is a Convention application, a basic application, a specification or another document filed in respect of, and at the same time as, a basic application that is related to the Convention application; or
- (c) if the application is a PCT application that claims priority under Article 8 of the PCT of an earlier application that is:
 - (i) an application made in Australia not more than 12 months before the international filing date of the PCT application; or
 - (ii) a basic application that is:
 - (A) the first application made in a Convention country in respect of the invention; and
 - (B) made not more than 12 months before the international filing date of the PCT application; or
 - (iii) a basic application made after a basic application referred to in subparagraph (ii); that earlier application; or
- (d) a specification filed in relation to:
 - (i) a basic application referred to in paragraph (b); or
 - (ii) the earlier application referred to in paragraph (c);after the making of the application.

(3) For the purposes of paragraph (1) (c) (ii), a claim is not fairly based on the specification referred to in paragraph 39 (1) (a) or subsection 39 (2) of the Act if, in order to comply with paragraph 40 (2) (a) of the Act (“specifications”), the deposit requirements must be satisfied and on the date of making the divisional application:

- (a) the requirement specified in paragraph 6 (a) of the Act (“deposit requirements”) is not satisfied; or
- (b) the period prescribed in subregulation 1.5 (1) (“prescribed periods: deposit requirements”) has ended and the requirements of paragraph 6 (c) of the Act are not satisfied; in relation to the specification referred to in paragraph 39 (1) (a) or subsection 39 (2) of the Act.

(4) If a PCT application claims priority from a basic application, a specification or other document filed in respect of, and at the same time as, a basic application, section 96 of the Act (“withdrawn, abandoned or refused applications”) is taken to apply to the PCT application as if it were a Convention application.

Note: The text of the PCT is set out in Schedule 2.

Priority dates: certain persons and applications

3.13 If, under subsection 36 (1) of the Act (“other applications by eligible persons”):

- (a) the Commissioner declares a person to be an eligible person; and
- (b) the person makes a complete application under section 29 of the Act (“application for patent”); the priority date of a claim of the specification in respect of that application, being a claim that is fairly based on matter disclosed in the specification referred to in paragraph 36 (1) (b) of the Act and referred to in the declaration is:
- (c) if that specification is a complete specification—the priority date of the claim or the date that would have been the priority date of the claim if the claim had been a claim of the specification; and
- (d) if that specification is a provisional specification—the date of filing of the specification.

Priority dates: certain amended claims

3.14 If subsection 114 (1) of the Act (“priority date of certain amended claims”) applies to a claim of a specification, the priority date of the claim is:

- (a) in the case of an amendment to which subsection 89 (4) or (5) of the Act (“modified application of Act”) applies—the date on which the amendment is taken to have been made under that subsection; and
- (b) in any other case—the date of filing of the statement of proposed amendments that resulted in the disclosure referred to in subsection 114 (1) of the Act.

Prescribed period and form of request for examination

3.15

(1) For the purposes of subsection 44 (1) of the Act (“request for examination”), the period of 5 years from the filing date of the complete application is prescribed.

(2) For the purposes of subsection 44 (1) of the Act, a request for an examination of a patent request and complete specification must be in the approved form.

Prescribed grounds and period for examination

3.16

(1) For the purposes of subsection 44 (2) of the Act (“request for examination”), the following grounds are prescribed:

- (a) that the Commissioner reasonably considers it expedient to give the direction having regard to the progress made in the examination of applications filed before the filing date of the application concerned;
- (b) that the Commissioner reasonably considers it to be in the public interest to give the direction;
- (c) that the Commissioner reasonably considers it expedient to give the direction, having regard to the examination of another application for a standard patent or the consideration of an application for a petty patent.

(2) For the purposes of subsection 44 (2) of the Act, the prescribed period is 6 months from the day on which the direction was given.

(3) A direction must be given in writing and state the grounds on which it is given.

Requirement for Commissioner to direct or expedite examination

3.17

(1) For the purposes of subsection 44 (3) of the Act (“request for examination”), a person may, in the approved form, request the Commissioner to direct an applicant for a standard patent to ask for an examination of the patent request and complete specification under subsection 44 (2) of the Act.

(2) If an applicant has asked for an examination of the patent request and complete specification to be expedited, the Commissioner may do so if he or she is reasonably satisfied that:

- (a) it is in the public interest; or
- (b) there are special circumstances that make it desirable.

Report of Commissioner: examination

3.18

(1) In reporting for the purposes of paragraph 45 (1) (b) (“examination”) or 48 (1) (a) (“modified examination”) of the Act, the Commissioner must not have regard to information made publicly available only through the doing of an act anywhere in the patent area.

(2) For the purposes of paragraph 45 (1) (c) or 48 (1) (b) of the Act, the following matters are prescribed:

- (a) whether, to the best of the knowledge of the Commissioner, the request and specification comply with the following provisions of the Act:
 - (i) section 15 (“who may be granted a patent?”);
 - (ii) section 29 (“application for patent”);
 - (iii) section 38 (“time for making complete application”);
 - (iv) section 39 (“divisional applications”);
 - (v) section 81 (“grant of patent of addition”);
 - (vi) section 94 (“Convention applicants may make Convention applications”);
 - (vii) section 95 (“manner of making Convention applications”);
- (b) whether, to the best of the knowledge of the Commissioner, the request and specification comply with paragraph 3.1 (2) (c), (e) or (h) (“prescribed documents: patent applications”) or regulation 3.11 (“making divisional applications”);
- (c) whether acceptance of the request and specification should be refused under section 51 of the Act (“application or grant may be refused in certain cases”);
- (d) whether the invention is not a patentable invention because of subsection 18 (2) of the Act (“patentable inventions”);
- (e) whether a patent cannot be granted on the application because of subsection 64 (2) of the Act (“grant: multiple applications”);
- (f) whether the applicant is entitled to ask that any action be taken, or that he or she be allowed to take any action, because of subsection 89 (3) of the Act (“modified application of Act”).

(3) For the purposes of paragraph 48 (1) (b) of the Act, the Act, the following matters are prescribed:

- (a) in the case of an invention to which section 6 of the Act (“deposit requirements”) applies—whether, to the best of the knowledge of the Commissioner, the requirements of that section 6 of the Act are satisfied;
- (b) whether the specification under modified examination is the same as the copy of the specification (in this regulation called “**foreign specification**”) filed under subregulation 3.20 (6) (“requests for deferment of examination or modified examination”), apart from:
 - (i) matters of form; or
 - (ii) the omission of a claim that is made in the foreign specification; or
 - (iii) an amendment of a claim that is consequential on an omission referred to in subparagraph (ii); or
 - (iv) an obvious mistake in the foreign specification; or

- (v) if the micro-organism deposited in respect of the foreign specification is the same micro-organism as that deposited in respect of the specification, a difference relating to matter referred to in paragraph 6 (c) of the Act that is necessary for the application to comply with the deposit requirements.

(4) For the purposes of examination, if a notice has been filed under subsection 27 (1) of the Act (“notice of matters affecting validity of standard patents”), the Commissioner must consider a matter stated in the notice that addresses a claim that an invention does not comply with paragraph 18 (1) (b) of the Act.

Conduct of examination

3.19

(1) If the Commissioner reasonably believes that there are lawful grounds of objection to the patent request or complete specification, he or she must state the grounds of objection in reporting on an examination.

(2) The applicant may contest the objection in writing or ask for leave to amend the patent request or complete specification in accordance with Chapter 10 (“amendments”).

(3) If the applicant asks for leave to amend a patent request or complete specification in response to, or in anticipation of, a report under section 45 (“examination”) or section 48 (“modified examination”) of the Act, the Commissioner must examine the request and specification and report as if each proposed amendment had been made.

(4) If the applicant contests the objection, the Commissioner must examine the request and specification and take note of the matters raised by the applicant.

Requests for deferment of examination or modified examination

3.20

(1) In this regulation:

“**prescribed foreign country**” means a country prescribed in regulation 3.21 (“prescribed foreign countries: requests for deferment of examination and modified examination”).

(2) For the purposes of paragraph 46 (1) (b) (“request for deferment of examination”) of the Act, the following applications are prescribed:

- (a) a basic application in relation to the complete application;
- (b) an application for a patent that claims the priority of the complete application or a provisional application associated with the complete application under section 38 of the Act (“time for making complete application”);
- (c) an application for a patent made in a prescribed foreign country that claims the priority of the application that is a basic application in relation to that complete application.

(3) For the purposes of paragraph 47 (1) (b) of the Act (“request for modified examination”), an application prescribed for the purposes of paragraph 46 (1) (b) of the Act in relation to which a patent in English has been granted in a prescribed foreign country is prescribed.

(4) For the purposes of paragraph 46 (1) (d) of the Act, the prescribed ground is that the Commissioner reasonably considers it expedient to give the direction, having regard to the progress made in the examination of applications filed before the filing date of the application concerned.

(5) For the purposes of subsection 46 (2) and subsection 47 (1) of the Act, a request for each action must be in the approved form.

(6) The applicant must file a copy of the specification relating to the patent referred to in paragraph 47 (1) (b) of the Act that is:

- (a) certified by the official chief or head of the Patent Office of the prescribed foreign country by which the patent was granted; or
 - (b) otherwise verified to the reasonable satisfaction of the Commissioner;
- before acceptance, unless the applicant makes a request under subsection 47 (2) of the Act.

Prescribed foreign countries: requests for deferment of examination and modified examination

3.21 For the purposes of paragraphs 46 (1) (b) (“request for deferment of examination”) and 47 (1) (b) of the Act (“request for modified examination”), the following countries are prescribed:

- (a) a country that is a signatory to the treaty done at Munich on 5 October 1973 entitled the Convention on the Grant of European Patents, as in force from time to time;
- (b) Canada;
- (c) New Zealand (excluding the Cook Islands, Niue and Tokelau);
- (d) United States of America (including all territories and possessions and the Commonwealth of Puerto Rico).

Consideration of petty patent application

3.22

(1) In considering the complete application for a petty patent under subsection 50 (1) of the Act (“consideration and acceptance of patent request: petty patent”), the Commissioner must:

- (a) not have regard to information made publicly available only through the doing of an act anywhere in the patent area; and
- (b) have regard to:
 - (i) the matters prescribed in paragraphs 3.18 (2) (a) to (f) (inclusive) (“report of Commissioner: examination”); and
 - (ii) whether the abstract is finally completed; and
 - (iii) whether, to the best of the knowledge of the Commissioner, the invention, so far as claimed in any claim, satisfies paragraphs 18 (1) (a) and (b) of the Act (“patentable inventions”); and
 - (iv) whether the specification complies with section 40 of the Act (“specifications”).

(2) If the applicant asks for leave to amend a patent request or complete specification in response to, or in anticipation of, a notice under paragraph 50 (2) (a) of the Act, the Commissioner must consider the request and specification as if each proposed amendment had been made.

(3) If the applicant contests the objection, the Commissioner must consider the request and specification and take note of the matters raised by the applicant.

PART 2—INVENTIONS THAT ARE MICRO-ORGANISMS

Documents in accepted applications and patents involving micro-organisms

3.23

(1) Where a micro-organism is deposited with a prescribed depositary institution for the purposes of section 41 of the Act (“specifications: micro-organisms”), the following documents must be filed in relation to an application that has been accepted under section 49 (“acceptance of patent request: standard patent”) or 50 (“consideration and acceptance of patent request: petty patent”) of the Act or a patent in respect of the micro-organism:

- (a) if the deposit is an original deposit within the meaning of Rule 7.3 of the Budapest Treaty or a new deposit within the meaning of Rule 7.4 of that Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty;
- (b) if samples of the micro-organism were transferred to that institution under Rule 5.1 (a) (i) of the Treaty—a copy of a receipt issued by the institution under Rule 7 of the Treaty;
- (c) if a receipt referred to in paragraph (a) or (b) is not in English—a translation of the receipt into English and a related certificate of verification.

(2) The documents referred to in subregulation (1) must be filed within 3 months from the date of receipt of the micro-organism by the prescribed depository institution.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Commissioner may request samples and viability statement

3.24

(1) If, in relation to a patent application or patent in respect of a micro-organism, the micro-organism is deposited with a prescribed depository institution, the Commissioner:

(a) on the order of a court in Australia, must; or

(b) on his or her own motion or on application in writing by another person, may;

for the purposes of proceedings before the Commissioner or any other legal proceedings in Australia:

(c) make to that institution a request referred to in Rule 11.1 of the Budapest Treaty for a sample of that micro-organism; and

(d) in relation to that micro-organism, make the declaration referred to in that Rule.

(2) Before making a request, the Commissioner must give the applicant or patentee concerned, and any other person who apparently has an interest in the request, an opportunity to be heard, unless the request is made on the order of a court.

(3) If the Commissioner decides to make, or to refuse to make, a request, he or she must inform the applicant or patentee concerned, and any other person who apparently has an interest in the request, of the decision, and of the reasons for the decision, by notice in writing as soon as practicable after the decision.

(4) The Commissioner may make a request referred to in Rule 10.2 (a) (iii) of the Budapest Treaty for a statement concerning the viability of a micro-organism if a sample of the micro-organism has been given to the Commissioner in accordance with a request under subregulation (1).

Note: The text of the Budapest Treaty is set out in Schedule 1.

Request for Commissioner's certificate authorising release of sample of a micro-organism

3.25

(1) If a micro-organism is deposited with a prescribed depository institution, a person may, in the approved form, request the Commissioner to grant the certification referred to in Rule 11.3 (a) of the Budapest Treaty in respect of the deposit.

(2) As soon as practicable after receiving a request, the Commissioner must decide whether to:

(a) comply with the request; or

(b) impose such conditions as are reasonable, including a condition that the person give security for damages for any breach of the undertaking referred to in paragraph (4) (c) given by:

(i) the person; or

(ii) another person who has been nominated as a skilled addressee; or

(c) refuse that request.

(3) The applicant for the patent may, at any time before the specification relating to the application is open for public inspection, notify the Commissioner that a sample of the deposited micro-organism is only to be provided before:

(a) the patent is granted on that application; or

(b) the application has lapsed or been withdrawn or refused; to a person who is:

(c) a skilled addressee without an interest in the invention; and

(d) nominated by the person who made the request.

(4) The Commissioner must comply with a request in respect of a patent application or patent:

(a) if the specification relating to that application or patent is open to public inspection; and

(b) unless the Commissioner is reasonably satisfied that the nominated person is not entitled to rely on the deposit for the purposes of the Act; and

- (c) if the person making the request or the person nominated as a skilled addressee has undertaken to use that micro-organism only for experimental purposes or in relation to:
 - (i) opposition proceedings under Chapter 5 of the Act (“opposition”) in relation to the grant of a standard patent on that application; or
 - (ii) a notice under section 28 of the Act (“notice of matters affecting validity of petty patents”) in relation to the petty patent; or
 - (iii) relevant proceedings in relation to the patent;and not to make that micro-organism, or a culture derived from that micro-organism, available to another person; and
- (d) unless the Commissioner is reasonably satisfied that the undertaking given by the person making the request or the person nominated as a skilled addressee was not given in good faith; and
- (e) if:
 - (i) the Commissioner has been notified under subregulation (3); and
 - (ii) the patent referred to in that subregulation has not been granted; and
 - (iii) the application referred to in that subregulation has not lapsed or been withdrawn or refused; and
 - (iv) the Commissioner is reasonably satisfied that the person nominated as a skilled addressee is a skilled addressee without an interest in the invention; and
- (f) if:
 - (i) the request is in respect of a patent; and
 - (ii) the person making that request is a person to whom the patentee has granted a licence under section 133 of the Act (“compulsory licences”); and
 - (iii) the Commissioner is reasonably satisfied that the licence provides that the person making the request has a right to obtain a sample of that micro-organism; and
- (g) if:
 - (i) the request is in respect of a patent; and
 - (ii) the person making that request is a person who may exploit the invention under section 163 of the Act (“exploitation of inventions by Crown”); and
 - (iii) the Commissioner is reasonably satisfied that the terms for the exploitation of the invention provide that the person making the request has a right to obtain a sample of that micro-organism.

(5) Before making a decision under subregulation (2), the Commissioner must give the person making the request, the applicant or patentee concerned and any other person who apparently has an interest in the request, an opportunity to be heard.

(6) If the Commissioner makes a decision under subregulation (2), he or she must inform the person who made the request, the applicant or patentee concerned and any other person who apparently has an interest in the request, of the decision, and the reasons for the decision, by notice in writing given as soon as practicable after the date of the decision.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Breach of undertakings given in respect of micro-organisms

3.26

(1) Where the micro-organism is deposited with a prescribed depository institution, proceedings for breach of an undertaking referred to in paragraph 3.25 (4) (c) (“request for Commissioner’s certificate authorising release of sample of a micro-organism”) may be instituted in a prescribed court by a person who is:

- (a) if a patent has not been granted on that patent application—the applicant; or

- (b) if:
 - (i) a patent has been granted on that patent application; or
 - (ii) the deposit is effected in relation to a patent;
the patentee of, or an exclusive licensee under, that patent.
- (2) In proceedings by an exclusive licensee, the patentee must be a party to the proceedings.
- (3) A patentee joined as a defendant in the proceedings by an exclusive licensee is not liable for costs unless the patentee enters an appearance and takes part in the proceedings.
- (4) It is a defence in proceedings for breach of the undertaking given in respect of a micro-organism to which a specification filed in respect of a patent application or patent relates, that when the matters complained of took place the specification did not comply with the requirements referred to in paragraph 6 (c) or (d) of the Act (“deposit requirements”).
- (5) A defendant may not plead a defence referred to in subregulation (4) unless:
 - (a) the defendant, before becoming a defendant in the proceedings, notified the Commissioner under paragraph 3.29 (1) (“notification that a deposit requirement has ceased to be satisfied”) of the deposit requirement that has ceased to be satisfied; and
 - (b) the applicant for the patent or the patentee fails to take the steps referred to in paragraph 41 (4) (b) of the Act (“specifications: micro-organisms”) within the appropriate period prescribed by subregulation 3.30 (1) (“prescribed period: deposit requirements taken to be satisfied”) for the purposes of that paragraph.

Procedure in proceedings for breach of an undertaking

3.27 In proceedings referred to in subregulation 3.26 (1) (“breach of undertakings given in respect of micro-organisms”) for breach of an undertaking:

- (a) the plaintiff must deliver particulars of the breaches complained of:
 - (i) with the statement of claim or declaration; or
 - (ii) by order of the court, at a later time; and
- (b) the defendant must deliver particulars of any objections on which the defendant relies:
 - (i) with the statement of defence or plea; or
 - (ii) by order of the court, at a later time.

Relief in proceedings for breach of undertakings

3.28

(1) In proceedings referred to in subregulation 3.26 (1) (“breach of undertakings given in respect of micro-organisms”), the court may:

- (a) make an order for inspection; and
- (b) impose terms and give directions with respect to the inspection.

(2) In proceedings referred to in subregulation 3.26 (1), the court may grant such relief as it thinks fit, including:

- (a) an injunction on such terms as it thinks fit; or
- (b) an order for damages; or
- (c) an order for an account of profits; or
- (d) an order with respect to any security given under paragraph 3.25 (2) (b) (“request for Commissioner’s certificate authorising release of sample of a micro-organism”); or
- (e) an order on such terms as it thinks fit to deliver to such person as it thinks fit the micro-organism or any substance or thing derived directly or indirectly from that micro-organism as a result of the breach of the undertaking, including:
 - (i) any products made by using that micro-organism; and
 - (ii) any other micro-organisms derived from that micro-organism; and

- (iii) any products made by using those other micro-organisms.

Notification that a deposit requirement has ceased to be satisfied

3.29

(1) If a deposit requirement ceases to be satisfied in relation to a micro-organism to which a specification filed in respect of a patent application or patent relates, a person other than the applicant or patentee may, after the specification has become open to public inspection, notify the Commissioner in the approved form of the requirement referred to in paragraph 6 (c) or (d) of the Act (“deposit requirements”) that has ceased to be satisfied.

(2) As soon as practicable after receiving a notice under subregulation (1), the Commissioner must give a copy of the notice to the applicant or patentee.

(3) If the Commissioner learns, otherwise than by a notice referred to in subregulation (1), of facts that may establish that a requirement referred to in that subregulation has ceased to be satisfied, the Commissioner must cause a notice setting out those facts to be given to the applicant or patentee.

(4) As soon as practicable after the Commissioner receives a notice under subregulation (1) or gives a notice under subregulation (3), a notice of the receipt or giving of that notification must be published in the *Official Journal*.

(5) The terms of a notice under subregulation (1) or (3) need not be published, but the notice must be open to public inspection.

(6) The applicant or patentee may file a written reply setting out the facts relied upon to establish that the requirement referred to in subregulation (1) is satisfied.

(7) If a reply filed under subregulation (6) is in answer to a notification under subregulation (1) by a person, the Commissioner must, as soon as practicable after receiving the reply, give a copy of the reply to that person.

(8) As soon as practicable after a reply is filed under subregulation (6), a notice of the filing must be published in the *Official Journal*.

(9) The terms of a reply filed under subregulation (6) need not be published, but the reply must be open to public inspection.

Prescribed period: deposit requirements taken to be satisfied

3.30 For the purposes of paragraph 41 (4) (b) of the Act (“specifications: micro-organisms”), if, in relation to a patent application or patent relating to a micro-organism:

- (a) that micro-organism is deposited with a prescribed depositary institution; and
- (b) a requirement referred to in paragraph 6 (c) or (d) of the Act (“deposit requirements”) ceases to be satisfied in relation to the micro-organism;

the prescribed period is from the day when the requirement ceases to be so satisfied to the end of:

- (c) where the step referred to in paragraph 41 (4) (b) of the Act is the making of a new deposit of a sample of the micro-organism:
 - (i) if the Commissioner has given under subregulation 3.29 (2) (“notification that a deposit requirement has ceased to be satisfied”) the applicant or patentee a copy of a notice of that requirement—the period of 3 months after the copy was given; or
 - (ii) if the Commissioner has given under subregulation 3.29 (3) to the applicant or patentee a notice of the requirement—the period of 3 months after the notice was given; or
 - (iii) if under Article 4 (1) of the Budapest Treaty the authority has notified the depositor of its inability to furnish samples of the micro-organism and the Commissioner has not, before the notification, given to the applicant or patentee under subregulation 3.29 (2) or (3) a copy of the notice, or the notice, as the case may be, of the requirement—the period of 3 months after the depositor received that notification under Article 4 (1) (d) of the Treaty; or

- (iv) in any other case—the day when that new deposit is so made; or
- (d) where the step referred to in paragraph 41 (4) (b) of the Act is an amendment of the specification in respect of that patent application or patent—the date of the allowance of the amendment, unless:
 - (i) the Commissioner has given the applicant or patentee a copy of a notice under subregulation 3.29 (2) or a notice under subregulation 3.29 (3); and the applicant or patentee has not asked for leave to amend the specification within the period of 3 months after the copy or the notice was given; or
 - (ii) the authority has notified the depositor under Article 4 (1) of the Budapest Treaty of its inability to furnish samples of the micro-organism and:
 - (A) the Commissioner has not, before the notification, given to the applicant or patentee under subregulation 3.29 (2) or (3) the notice, or a copy of the notice, as the case may be, of the requirement; and
 - (B) the applicant or patentee has not asked for leave to amend the specification within the period of 3 months after the depositor received the notification under Article 4 (1) (d) of the Treaty.

Note: The text of the Budapest Treaty is set out in Schedule 1.

Application for declaration that deposit requirements are not satisfied

3.31

(1) An application under section 42 of the Act (“micro-organisms ceasing to be reasonably available”) for a declaration that a specification does not comply with section 40 of the Act (“specifications”) unless the deposit requirements are satisfied in relation to a micro-organism, must:

- (a) be made in the approved form to a prescribed court or the Commissioner; and
- (b) be lodged at the court or filed.

(2) A person who applies for a declaration under section 42 of the Act must give a copy of the application:

- (a) to the applicant or patentee; and
- (b) to such other person as the court or Commissioner directs.

(3) If the Commissioner on his or her own motion proposes to declare under section 42 of the Act that the specification in respect of a patent application or patent does not comply with the requirements of section 40 of the Act unless the deposit requirements are satisfied in relation to a micro-organism, he or she must give to the applicant or patentee a statement of the facts relied upon to justify the making of that declaration.

(4) A person to whom:

- (a) a copy of an application under subregulation (2); or
- (b) a statement under subregulation (3);

has been given:

- (c) may, within 3 months, give to the court to which the application is made or to the Commissioner a reply to that application or statement; and
- (d) must give a copy of the reply to the applicant or patentee and to such other persons as the court or the Commissioner directs.

(5) As soon as practicable after:

- (a) a copy of a declaration by a court under subsection 42 (1) of the Act is given to the Commissioner under subsection 42 (6) of the Act; or
- (b) the making of a decision of the Commissioner under subsection 42 (1) of the Act; notice of the making of the declaration or decision must be published in the *Official Journal*.

(6) The terms of a declaration or decision referred to in subregulation (5) need not be published, but the declaration or decision must be open to public inspection.

CHAPTER 4—PUBLICATION

Prescribed information: applicants and applications

4.1 For the purposes of section 53 of the Act (“publication of certain information about applicants etc.”), the following information is prescribed:

- (a) the number allocated to the application by the Commissioner;
- (b) the name of the applicant;
- (c) in the case of a complete application—the name of the nominated person;
- (d) the title, or an abbreviated title, of the invention;
- (e) the date on which the application was filed;
- (f) in the case of a complete application, other than a PCT application—particulars of priority documents.

Notice that specification is open to public inspection

4.2

(1) A request under subsection 54 (1) of the Act (“notice of publication”) must be in the approved form.

(2) For the purposes of subsection 54 (1) of the Act, the Commissioner must publish the notice as soon as practicable after:

- (a) being asked by the applicant to publish the notice; and
- (b) the relevant abstract is finally completed; and
- (c) if a direction has been given under subregulation 3.2 (4) (“specifications”)—the direction has been complied with.

(3) For the purposes of paragraph 54 (3) (b) of the Act, the prescribed period is from the day of filing of the specification to the end of 18 months after:

- (a) that day; or
- (b) the date of making the earliest relevant application referred to in regulation 3.12 (“priority dates generally”);

whichever is earlier.

Prescribed documents: public inspection

4.3 For the purposes of subsection 55 (1) of the Act (“documents open to public inspection”), the following documents, including those documents as amended, are prescribed:

- (a) the patent request;
- (b) any document filed, including a specification, in relation to any provisional application associated with the complete application;
- (c) any basic document that has been filed and, if the document is not in English, a translation of the document into English and a related certificate of verification;
- (d) any documents filed under section 6 (“deposit requirements”), section 41 (“specifications: micro-organisms”) or section 42 (“micro-organisms ceasing to be reasonably available”) of the Act;
- (e) a notice and a statement filed under subregulation 2.2 (3) (“publication or use: prescribed circumstances and periods”);
- (f) a document prescribed in subregulation 3.1 (1) (“prescribed documents: patent applications”).

CHAPTER 5—OPPOSITION

Application of this Chapter

5.1 This Chapter applies if a notice of opposition has been filed for the purposes of:

- (a) the following sections of the Act:
 - (i) section 59 (“opposition to grant of standard patent”);
 - (ii) section 74 (“opposition to extension”);
 - (iii) subsection 104 (4) (“amendments by applicants and patentees”), unless the request for leave to amend is made under regulation 9.5 (“completion of re-examination”) or is in response to a direction of the Commissioner under section 107 (“amendments directed by Commissioner: patent applications”) or 108 (“amendments directed by Commissioner: extensions of term of petty patents”);
 - (iv) subsection 223 (6) (“extensions of time”); or
- (b) subregulation 22.21 (4) (“protection or compensation of certain persons”) or 10.7 (4) (“amendment of documents by Commissioner”).

Interpretation

5.2 In this Chapter:

“**applicant**” means a person who has filed an application or request in respect of which another person has filed a notice of opposition;

“**opponent**” means a person who has filed a notice of opposition;

“**party**” means applicant or opponent.

Filing of opposition

5.3

(1) The Minister or other person who intends to oppose the grant of a patent under section 59 of the Act (“opposition to grant of standard patent”) must file a notice of opposition in the approved form within 3 months of publication in the *Official Journal* of the notice of acceptance under section 49 of the Act (“acceptance of patent request: standard patent”).

(2) The Minister, the Secretary to the Department of Community Services and Health or an interested person who intends to oppose the grant of an extension of the term of a patent under section 74 of the Act (“opposition to extension”) must file a notice of opposition in the approved form within 3 months of the publication in the *Official Journal* of a notice under section 73 of the Act (“advertisement of application for extension”).

(3) The Minister or other person who intends to oppose allowing an amendment under subsection 104 (4) of the Act (“amendments by applicants and patentees”) must file a notice of opposition in the approved form within 3 months of publication in the *Official Journal* of a notice referred to in subregulation 10.5 (2) (“Commissioner to grant leave to amend”) or 10.7 (3) (“correction of Register or patent”).

(4) A person must not oppose the allowance of a proposed amendment of a complete specification, except on the grounds that the amendment is not allowable under section 102 of the Act (“what amendments are not allowable?”).

(5) A person who intends to oppose the grant of an application for an extension of time under subsection 223 (6) of the Act (“extensions of time”) must file a notice of opposition in the approved form within 1 month of the advertisement of the application in the *Official Journal*.

(6) A person:

- (a) on whom a copy of an application for a licence in accordance with subregulation 22.21 (3) (“protection or compensation of certain persons”) has been served; and

(b) who intends to oppose the grant of the licence;

must file a notice of opposition to the grant of the licence in the approved form within 1 month from the day on which the copy was served on him or her.

(7) As soon as practicable after a notice of opposition is filed, the opponent must serve a copy of the notice on the applicant.

Filing of statement

5.4

(1) An opponent must:

(a) within 3 months of filing the notice of opposition serve on the applicant a copy of a statement that sets out:

- (i) the grounds of opposition; and
- (ii) the particulars relating to each ground; and

(b) as soon as practicable after the copy of the statement has been served on the applicant, file the statement.

(2) If a notice of opposition is filed for the purposes of section 74 of the Act (“opposition to extension”), the statement and the copy of the statement must each have with it evidence in support of the opposition (if any) and a copy of that evidence.

Dismissal of opposition

5.5

(1) An applicant may:

- (a) within 1 month of being served with a copy of a statement by an opponent under subregulation 5.4 (1) (“filing of statement”); or
- (b) if the complete specification in relation to an opposed application is re-examined under subsection 97 (1) of the Act (“re-examination of complete specifications”)—within 1 month from the day when the re-examination is completed under regulation 9.5 (“completion of re-examination”);

request the Commissioner in the approved form to dismiss the opposition.

(2) As soon as practicable after a request is made, the Commissioner must inform the opponent of the request having been made.

(3) The Commissioner may dismiss the opposition whether or not the applicant has requested dismissal of the opposition.

Determination of opposition

5.6

(1) If the complete specification in relation to an opposed application is re-examined under subsection 97 (1) of the Act (“re-examination of complete specifications”), the opponent may, within 1 month from the day when the re-examination is completed under regulation 9.5 (“completion of re-examination”), request the Commissioner in the approved form to determine the opposition.

(2) As soon as practicable after a request is made, the Commissioner must inform the applicant of the request having been made.

(3) The Commissioner may determine the opposition whether or not the opponent has requested determination of the opposition.

Opponent to serve copy of substitute statement

5.7 If the specification in relation to the opposed application is re-examined under subsection 97 (1) of the Act (“re-examination of complete specifications”):

- (a) the opponent may, within 1 month from the day when the re-examination is completed under regulation 9.5 (“completion of re-examination”), serve on the applicant a copy of a statement in substitution for the statement to which subregulation 5.4 (1) (“filing of statement”) relates; and
- (b) if a copy of a substituted statement is served on the applicant, the opponent must, as soon as practicable after the copy of the statement has been so served, file that statement.

Time for giving of evidence

5.8

(1) Subject to subregulation (5), if an opponent intends to rely on evidence in support of the opposition, the opponent must:

- (a) serve on the applicant a copy of any evidence in support of the opposition within:
 - (i) 3 months of serving the applicant with:
 - (A) a copy of the statement referred to in subregulation 5.4 (1) (“filing of statement”);
or
 - (B) if a substitute statement has been served on the applicant under regulation 5.7 (“opponent to serve copy of substitute statement”)—a copy of that statement;
 - (ii) if the Commissioner has re-examined the complete specification in relation to the opposed application under subsection 97 (1) of the Act (“re-examination of complete specifications”)—3 months from the day when re-examination is completed under regulation 9.5 (“completion of re-examination”); or
 - (iii) if dismissal of the opposition has been requested under subregulation 5.5 (1) (“dismissal of opposition”)—3 months of a decision of the Commissioner not to dismiss the opposition; or
 - (iv) if determination of the opposition has been requested under subregulation 5.6 (1) (“determination of opposition”)—3 months of a decision of the Commissioner not to determine the opposition;

whichever happens last; and

- (b) file the evidence in support of the opposition as soon as practicable after the copy of the evidence has been served on the applicant.

(2) Subject to subregulation (3), if an applicant intends to rely on evidence in answer to the evidence in support of the opposition, the applicant must:

- (a) serve on the opponent a copy of any evidence in answer to the evidence in support of the opposition referred to in paragraph (1) (a) within 3 months after the end of the period prescribed in that paragraph; and
- (b) file the evidence in answer as soon as practicable after the copy of the evidence has been served on the opponent.

(3) If an opponent has not served on an applicant a copy of evidence in support of the opposition and the applicant intends to rely on evidence in answer to the opposition, the applicant must:

- (a) serve on the opponent a copy of any evidence in answer to the opposition within 3 months of the end of the period prescribed in paragraph (1) (a); and
- (b) file the evidence in answer as soon as practicable after the copy of the evidence has been served on the opponent.

(4) Subject to subregulation (5), if an opponent intends to rely on evidence in reply to the evidence referred to in paragraph (2) (a) or (3) (a), the opponent must:

- (a) within 1 month of being served by the applicant with a copy of the evidence under paragraph (2) (a) or (3) (a), serve on the applicant a copy of:
 - (i) the evidence in reply; and
 - (ii) any notice of intention to file evidence in reply; and
- (b) if the applicant has been served with a copy of a notice of intention to file evidence in reply, serve the applicant with a copy of the evidence within 3 months of being served with a copy of the evidence under paragraph (2) (a) or (3) (a); and
- (c) file the evidence in reply and any notice of intention as soon as practicable after the copy of the evidence in reply or notice has been served on the applicant.

(5) Subregulations (1) and (4) do not apply if a notice of opposition has been filed under section 74 of the Act (“opposition to extension”).

Amendment of statement

5.9

(1) The Commissioner, on the written request of an opponent and subject to such terms as the Commissioner may specify:

- (a) if the Commissioner reasonably believes that an amendment of a statement referred to in subregulation 5.4 (1) (“filing of statement”) corrects an error or omission by the opponent or by his or her agent—may amend the grounds of opposition set out in the statement; or
- (b) if the Commissioner reasonably believes that an amendment of the grounds set out in a statement referred to in subregulation 5.4 (1) results from an amendment of a patent request or complete specification—must amend those grounds; or
- (c) must amend particulars relating to a ground referred to in subregulation 5.4 (1).

(2) The Commissioner must not allow an amendment requested under subregulation (1), if:

- (a) an application for dismissal of opposition is being considered; or
- (b) an application for determination of opposition is being considered; or
- (c) in the case of opposition under section 59 of the Act (“opposition to grant of standard patent”)—a specification relating to the opposed application is being re-examined; or
- (d) he or she does not reasonably believe that the applicant has been notified of the proposed amendment; or
- (e) he or she reasonably believes that a person will be unduly prejudiced by the amendment.

(3) The Commissioner must give the parties an opportunity to make representations concerning the proposed amendment.

(4) If the Commissioner allows an amendment, he or she must give the applicant a copy of the statement as amended.

Conduct of proceedings to which this Chapter applies

5.10

(1) The Commissioner may, on his or her own motion or on the application of a party:

- (a) give a direction that is not inconsistent with the Act or these Regulations for the conduct of proceedings to which this Chapter applies; or
- (b) determine that a period prescribed in this Chapter (except in regulation 5.3 (“filing of opposition”) or paragraph 5.4 (1) (a) (“filing of statement”)), is to be extended by such further period as the Commissioner reasonably allows.

(2) The Commissioner may:

- (a) on the application of a party in the approved form; and

(b) on such reasonable terms (if any) as the Commissioner specifies;
extend the time within which the party may take a step prescribed in this Chapter, not being a step that is taken under regulation 5.3 or paragraph 5.4 (1) (a).

(3) If section 107 of the Act (“amendments directed by Commissioner: patent applications”) applies to an opposed application, the time within which a party may take a step prescribed in this Chapter is extended by a period that is equal to the period from the day when the applicant is given an opportunity to be heard that is referred to in subsection 107 (2) of the Act to the end of the day when the decision is made under 107 (4) of the Act whether or not the amendment is allowed.

(4) The Commissioner may:

- (a) on the application of a party; and
- (b) on such reasonable terms (if any) as the Commissioner specifies;
permit the party to serve further evidence on the other party.

(5) The Commissioner must not give a direction under subregulation (1) or grant an application under subregulation (2) or (4) unless the Commissioner:

- (a) if he or she proposes to grant an application by a party—is reasonably satisfied that the other party has been notified of the application; and
- (b) if he or she proposes to act on his or her own motion—ensures that the parties are notified of the proposed action; and
- (c) in either case:
 - (i) gives the parties a reasonable opportunity to make representations concerning the application or proposed action; and
 - (ii) is reasonably satisfied that a direction, an extension of time or the serving of further evidence is appropriate in all the circumstances.

Commissioner may inform himself or herself

5.11

(1) The Commissioner may inform himself or herself of a fact by reference to a document available in the Patent Office.

(2) If the Commissioner proposes to refer to a document under subregulation (1), he or she must:

- (a) notify the parties accordingly; and
- (b) give the parties a copy of, or access to, the document; and
- (c) give the parties an opportunity to give evidence or make representations with respect to the fact or document.

(3) In subregulation (2), “**document**” does not include a document filed under regulation 5.4 (“filing of statement”), 5.8 (“time for giving of evidence”) or further evidence referred to in subregulation 5.10 (4) (“conduct of proceedings to which this Chapter applies”).

Hearing of opposition

5.12 The Commissioner must if he or she receives a request by a party to hold a hearing, or may, on his or her own motion:

- (a) give a notice of a hearing into the opposition; and
- (b) hold the hearing;

if the relevant periods prescribed in regulation 5.8 (“time for giving of evidence”) have ended, unless:

- (c) the opposition has been dismissed or determined; or
- (d) the notice has been withdrawn.

Representations to Commissioner

5.13 A representation referred to in subregulation 5.9 (3) (“amendment of statement”), subparagraph 5.10 (5) (c) (i) (“conduct of proceedings to which this Chapter applies”) or paragraph 5.11 (2) (c) (“Commissioner may inform himself or herself”) may be made to the Commissioner in writing or by telephone.

Commissioner not required to hold hearing

5.14 If the Commissioner reasonably believes that no party wishes to be heard in a matter arising under regulation 5.12 (“hearing of opposition”) or 5.13 (“representations to Commissioner”), the Commissioner is not required to hold a hearing.

Withdrawal of opposition

5.15 An opponent may at any time withdraw opposition by:

- (a) filing a written notice of withdrawal that is signed by him or her; and
- (b) serving a copy of the notice on the applicant.

CHAPTER 6—GRANT AND TERM OF PATENTS

Publication of notice of grant of standard patent

6.1 If a standard patent is granted under section 61 of the Act (“grant of standard patent”), the Commissioner must publish a notice that the patent has been granted in the *Official Journal*.

Prescribed period: grant of standard patent

6.2

(1) For the purposes of subsection 61 (2) of the Act (“grant of standard patent”), the prescribed period is from 3 months after publication under paragraph 49 (5) (b) of the Act (“acceptance of patent request: standard patent”) of the notice of the acceptance of the request and complete specification to:

- (a) 6 months after that publication; or
- (b) such later day as:
 - (i) in the case of proceedings before a court or the Tribunal—the court or Tribunal directs; or
 - (ii) in any other case—the Commissioner reasonably directs;being satisfied that the grant of the patent should be postponed.

(2) A person may request the Commissioner in the approved form to give a direction referred to in subparagraph (1) (b) (ii).

Date of patent

6.3 For the purposes of paragraph 65 (b) of the Act (“date of patent”), the date of a patent is as follows:

- (a) in the case of a patent granted under subsection 33 (1) of the Act (“applications by opponents etc.”)—the date of filing of the complete specification in respect of the application of which the grant of a standard patent is opposed;
- (b) in the case of a petty patent granted under subsection 33 (2) of the Act—the date of the patent referred to in paragraph 33 (2) (b) of the Act;

- (c) in the case of a patent granted under subsection 34 (2) of the Act (“applications by eligible persons arising out of court proceedings”)—the date of the patent referred to in subsection 34 (1) of the Act;
- (d) in the case of a patent granted under section 35 of the Act (“applications by eligible persons following revocation by Commissioner”)—the date of the revoked patent;
- (e) in the case of a patent granted as a result of a declaration under section 36 of the Act (“other applications by eligible persons”), if the declaration is made in respect of:
 - (i) a complete application—the date that would have been the date of the patent if the patent had been granted on that application; or
 - (ii) a provisional application:
 - (A) the date 12 months after the date of filing of the provisional specification in respect of that application; or
 - (B) the date of filing of the complete application referred to in subsection 36 (3) of the Act;whichever is earlier;
- (f) in the case of a patent granted on a divisional application—the date of filing of the complete specification in which the invention that is the subject of the application was first disclosed.

Form of application for sealing of duplicate of patent

6.4 An application for the sealing of a duplicate of a patent under section 66 of the Act (“sealing of duplicate of patent”) must be in the approved form.

Application for extension of term of petty patent

6.5

(1) For the purposes of subsection 69 (1) of the Act (“extension of term of petty patent”), an application for an extension of the term of a petty patent must:

- (a) be in the approved form; and
- (b) be made within 11 months of the date of sealing of the patent.

(2) If a patentee applies for an extension of the term of a petty patent, the Commissioner must publish in the *Official Journal* a notice stating that the application has been made.

Deciding an application for extension of term of petty patent

6.6

(1) For the purposes of subsection 69 (2) of the Act (“extension of term of petty patent”), in deciding an application for an extension of the term of a petty patent, the Commissioner must consider:

- (a) any notice under subsection 28 (1) of the Act (“notice of matters affecting validity of petty patents”) in relation to the petty patent; and
- (b) any matter of which the Commissioner has informed the patentee under subsection 28 (3) of the Act.

(2) If the Commissioner is satisfied that a ground mentioned in subsection 28 (1) of the Act is made out, the Commissioner may refuse to grant an extension of the term of the petty patent.

(3) If the Commissioner is satisfied that no ground mentioned in subsection 28 (1) of the Act is made out, the Commissioner must grant the extension of the term of the petty patent.

Prescribed period: lapse of applications for extension of term

6.7

(1) For the purposes of section 71 of the Act (“application for extension to lapse in certain circumstances”), the prescribed period is 1 month, or such longer period as the Commissioner reasonably allows, from the date of:

- (a) the making of the application mentioned in that section; or
- (b) the giving to the patentee of the certificate mentioned in paragraph (a) of that section; whichever happens later.

(2) If an application has lapsed because of that section, the Commissioner must publish in the *Official Journal* a notice to that effect.

CHAPTER 7—PATENTS OF ADDITION

Form of application for grant of patent of addition etc.

7.1

(1) For the purposes of paragraph 81 (1) (c) of the Act (“grant of patent of addition”), an application for a further patent must be made under section 29 of the Act (“application for patent”).

(2) The Commissioner must not grant a patent of addition under subsection 81 (1) of the Act unless the date that would be the date of the patent if that patent of addition were granted is the same as, or later than, the date of the patent for the main invention.

Form of application for revocation of patent and grant of patent of addition instead

7.2 An application under section 82 of the Act (“revocation of patent and grant of patent of addition instead”) must be in the approved form.

CHAPTER 8—PCT APPLICATIONS AND CONVENTION APPLICATIONS

PART 1—PCT APPLICATIONS

International applications taken to be applications under the Act

8.1

(1) In this regulation:

“**priority date**”, in relation to an international application, has the same meaning as in the PCT.

(2) Where:

- (a) the receiving Office has declared that an international application that specifies Australia as a designated State under Article 4 (1) (ii) of the PCT is taken to be withdrawn; or
- (b) the International Bureau has made a finding under Article 12 (3) of the PCT; the application is taken to be a PCT application as if a declaration or finding had not been made, if:
- (c) the applicant has made a request referred to in Article 25 (1) (a) of the PCT within the time limit specified in Rule 51.1 of the PCT; and
- (d) the Commissioner has received within the time limit specified in Rule 51.3 of the PCT:
 - (i) fees prescribed for the purposes of paragraph 89 (3) (b) (“modified application of Act”); and
 - (ii) if the application is not in English—a translation of the application into English and a related certificate of verification; and

- (e) the Commissioner reasonably believes that:
 - (i) the declaration was the result of an error or omission on the part of the receiving Office; or
 - (ii) the finding was the result of an error or omission on the part of the International Bureau.
- (3) For the purposes of subsection 89 (1) of the Act:
 - (a) the requirements of subsection 29 (4) of the Act (“application for patent”); and
 - (b) subregulation 3.1 (1) (“prescribed documents: patent applications”) and regulation 3.2 (“specifications”);are prescribed.
- (4) The applicant must meet the requirements of subsection 89 (3) of the Act within the period of:
 - (a) if the application is an application in respect of which Australia has been elected under Chapter II of the PCT within the period specified in Article 39 of the PCT—31 months from the priority date of that application; or
 - (b) in any other case—21 months from the priority date of that application.

Note: The text of the PCT is set out in Schedule 2.

Prescribed documents: PCT application

8.2

- (1) In this regulation:

“**PCT application**” includes an amendment under Article 19 or 34 of the PCT.

- (2) For the purposes of paragraph 89 (3) (a) of the Act (“modified application of Act”), if:
 - (a) a PCT application is not filed in English; and
 - (b) the PCT application has been published in English under Article 21 of the PCT; and
 - (c) a translation of the application into English has not been filed before the date of publication under Article 21 of the PCT;

the publication under Article 21 of the PCT is taken to be the translation referred to in paragraph 89 (3) (a) of the Act and to have been verified in accordance with these Regulations.

- (3) For the purposes of paragraph 89 (3) (b) of the Act, each of the following documents is prescribed:

- (a) a document setting out an address for service of documents in Australia;
- (b) if a PCT application has not been published under Article 21 of the PCT—a copy of the application;
- (c) if a PCT application is not filed in English and has not been published in English under Article 21 of the PCT—a translation of the application into English together with a related certificate of verification.

- (4) The Commissioner must not, in relation to a PCT application that is treated as an application under the Act for:

- (a) a standard patent—give a direction under section 44 of the Act (“request for examination”); or
- (b) a petty patent—act under section 50 of the Act (“consideration and acceptance of patent request: petty patent”);

unless the applicant has complied with the requirements of subsection 89 (3) of the Act.

- (5) In a PCT application, the applicant is taken to be the nominated person in respect of the application.

Note: The text of the PCT is set out in Schedule 2.

Modification of Act to apply to PCT applications

8.3

(1) For the purposes of paragraph 228 (2) (t) of the Act (“regulations”), the Act is modified in accordance with this regulation.

(2) Section 141 (“withdrawal of applications”):

Omit the section, substitute:

Withdrawal of applications

“141.

(1) Subject to subsection (2), a patent application is to be treated as having been withdrawn if, and only if, the applicant files a written notice of withdrawal signed by the applicant.

“(2) A PCT application is to be treated as having been withdrawn if Article 11 (3) of the PCT ceases to have effect in Australia in relation to the application under Article 24 (1) (i) of the PCT.”.

(3) Subsection 142 (2) (“lapsing of applications”):

Add at the end:

“; or (f) Article 11 (3) of the PCT ceases to have effect in Australia in relation to the application under Article 24 (1) (ii) or (iii) or Article 39 (2) of the PCT”.

(4) Section 223 (“extensions of time”):

After subsection (1) insert:

“(1A) If, because of an error or omission by the receiving Office or the International Bureau, a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Commissioner must extend the time for doing the act.”.

Note: The text of the PCT is set out in Schedule 2.

Form of request and prescribed documents: PCT applications

8.4

(1) A request under subsection 92 (1) of the Act (“notice of publication”) must be in the approved form.

(2) For the purposes of subsection 92 (4) of the Act, the following documents are prescribed:

- (a) the documents specified in paragraphs 4.3 (c), (d) and (e) (“prescribed documents: public inspection”);
- (b) any International Search Report or Preliminary Examination Report made under the PCT and filed;
- (c) if the PCT application claims priority under Article 8 of the PCT of a provisional or complete application—a document referred to in regulation 4.3, and a specification, in respect of that application.

Note: The text of the PCT is set out in Schedule 2.

PART 2—CONVENTION APPLICATIONS

Convention countries

8.5

(1) Each of the countries specified in Schedule 4 is declared to be a Convention country for the purposes of the definition of “Convention country” in the Act.

(2) For the purposes of section 94 of the Act (“Convention applicants may make Convention applications”), the period of 12 months from the day on which a basic application is first made in a Convention country in respect of the invention is prescribed.

Particulars required for Convention application

8.6

(1) For the purposes of paragraph 95 (2) (a) of the Act (manner of making Convention application”), the following particulars are prescribed:

- (a) the name of the applicant;
- (b) the country in which the application was made;
- (c) the number allocated to the application by the official chief or head of the Patent Office of the Convention country in which the application was made;
- (d) the date on which the application was made;
- (e) if the application is not the first made in a Convention country in respect of the invention—the particulars specified in paragraphs (a) to (d) (inclusive) in respect of that first made application.

(2) For the purposes of subsection 95 (3) of the Act, the following documents are prescribed:

- (a) a copy of the specification relating to the basic application that is certified by the official chief or head of the Patent Office of the Convention country in which the basic application was made;
- (b) if that specification is not in English—a translation of the specification into English and a related certificate of verification.

(3) For the purposes of subsection 95 (3) of the Act, the period from the day on which the application is made to immediately before acceptance is prescribed.

Form of request in relation to withdrawn, abandoned or refused applications

8.7 A request under section 96 of the Act (“withdrawn, abandoned or refused applications”) must be in the approved form.

CHAPTER 9—RE-EXAMINATION

Commissioner may re-examine complete specification when grant opposed

9.1

(1) The Commissioner may, within 1 month of the filing of a statement under subregulation 5.4 (1) (“filing of statement”), decide to re-examine under subsection 97 (1) of the Act (“re-examination of complete specifications”) a complete specification in respect of the application in respect of which the grant of a patent is opposed.

(2) The Commissioner must notify an applicant and an opponent under Chapter 5 (“opposition”) of his or her decision to re-examine a complete specification under subsection 97 (1) of the Act.

Request for re-examination of complete specification

9.2

(1) For the purposes of subsection 97 (2) of the Act (“re-examination of complete specifications”), a request for re-examination of a complete specification must be in the approved form.

- (2) A request must:
 - (a) identify the documents on which an assertion is based that the invention, so far as claimed in any claim and when compared with the prior art base as it existed immediately before the priority date of that claim:
 - (i) is not novel; and
 - (ii) does not involve an inventive step; and
 - (b) state the relevance of each of those documents.
- (3) The request must have with it:
 - (a) if the document is not available in the Patent Office—a copy of the document; and
 - (b) if the document is not in English—a translation of the document into English and a related certificate of verification; and
 - (c) evidence of the date and place of publication of the document.
- (4) If the request does not:
 - (a) identify the documents on which the assertion is based; and
 - (b) state the relevance of each document; and
 - (c) have with it the documents referred to in subregulation (3);the Commissioner may not re-examine the complete specification.
- (5) A person who has made a request may, by filing a notice in writing, amend or withdraw the request before the Commissioner reports under section 98 of the Act (“report on re-examination”).
- (6) If the person who made the request is not the patentee, the Commissioner must notify the patentee of his or her decision to re-examine the complete specification.
- (7) A patentee or another person who has requested re-examination of the complete specification under subsection 97 (2) of the Act must give notice to the Commissioner of any relevant proceedings in relation to the patent of which he or she is aware.

Copy of report on re-examination

9.3

- (1) If a person who asked for the re-examination is not the patentee, a copy of the report under section 98 of the Act (“report on re-examination”) must be given to the person by the Commissioner.
- (2) The Commissioner must give an opponent under Chapter 5 of the Act (“opposition”) a copy of the report in respect of a complete specification in relation to the application in respect of which the grant of a patent is opposed.

Prescribed period: statement disputing report by Commissioner

9.4

- (1) For the purposes of subsection 99 (1) of the Act (“statement by applicant or patentee”), the period of 2 months after the day on which the Commissioner reports under section 98 of the Act (“report on re-examination”) is prescribed.
- (2) The Commissioner must give a copy of a statement filed under subsection 99 (1) of the Act to:
 - (a) an opponent under Chapter 5 of the Act (“opposition”) in respect of the re-examined complete specification in relation to the application in respect of which the grant of a patent is opposed; and
 - (b) if the person who asked for the re-examination is not the patentee—that person.

Completion of re-examination

9.5 If the Commissioner makes an adverse report on a re-examination under subsection 97 (1) or (2) of the Act (“re-examination of complete specifications”) and:

- (a) a statement is filed under section 99 of the Act (“statement by applicant or patentee”) and:
 - (i) the Commissioner gives the applicant an opportunity to be heard that is referred to in subsection 107 (2) of the Act (“amendments directed by Commissioner: patent applications”) within 3 months from the day when the Commissioner reports under section 98 of the Act (“report on re-examination”); or
 - (ii) the applicant or patentee asks for leave to amend the complete specification to remove any lawful grounds of objection specified in a report on re-examination within 3 months from the day referred to in subparagraph (i);the re-examination is completed when the decision is made whether or not the amendment is allowed; or
- (b) a statement is filed under section 99 of the Act and subparagraphs (a) (i) and (ii) do not apply—the re-examination is completed 2 months from the day when the Commissioner reports under section 98 of the Act; or
- (c) a statement is not filed under section 99 of the Act and:
 - (i) the Commissioner gives the applicant an opportunity to be heard that is referred to in subsection 107 (2) of the Act within 2 months from the day when the Commissioner reports under section 98 of the Act; or
 - (ii) the applicant or patentee asks for leave to amend the complete specification to remove any lawful grounds of objection specified in a report on re-examination within 2 months from the day when the Commissioner reports under section 98 of the Act;the re-examination is completed when the decision is made whether or not the amendment is allowed; or
- (d) a statement is not filed under section 99 of the Act and subparagraphs (c) (i) and (ii) do not apply—the re-examination is completed 2 months from the day when the Commissioner reports under section 98 of the Act.

CHAPTER 10—AMENDMENTS

Form of amendments

10.1

(1) For the purposes of subsection 104 (1) of the Act (“amendments by applicants and patentees”), an applicant or a patentee may ask the Commissioner for leave to amend a patent request or complete specification or another filed document by filing a request for leave to amend in the approved form together with a statement of proposed amendments.

(2) If:

- (a) a proposed amendment is to be made by means of substituting 1 page or document for another page or document; or
- (b) the Commissioner requires the applicant or patentee to make a proposed amendment by that means;

the applicant or patentee must file:

- (c) 2 copies of each page or document that is to be substituted for a page of the request or document; and
- (d) 3 copies of each page that is to be substituted for a page of the complete specification; and
- (e) on 1 of the copies, an indication of the nature and location of the proposed amendments.

(3) The Commissioner may require an applicant or a patentee to file, within 3 months of being asked to do so, a statement of the reasons for the request being made and any evidence in support of the request.

(4) The Commissioner may, before granting leave to amend, require a patentee to file within 1 month of being asked to do so, a statement that, to the best of his or her knowledge, relevant proceedings are not pending in relation to the patent.

(5) For the purposes of this Chapter, a statement of proposed amendments may be amended by filing a statement of proposed amendments of the first-mentioned statement before allowance of those amendments.

Commissioner to consider and deal with requests for leave to amend

10.2

(1) For the purposes of subsection 104 (2) of the Act (“amendments by applicants and patentees”), the Commissioner must report on whether:

- (a) the request for leave to amend and the statement of proposed amendments do not comply with regulation 10.1 (“form of amendments”) and Schedule 3; and
- (b) any proposed amendment of a complete specification is not allowable under section 102 of the Act (“what amendments are not allowable?”); and
- (c) the proposed amendments are not allowable under regulation 10.3 (“amendments not allowable”) or, if made, would not otherwise be allowable under the Act or these Regulations.

(2) The Commissioner must give a copy of each report made under subregulation (1) to the applicant or patentee.

(3) The applicant or patentee may contest in writing the report or file a statement of proposed amendments of the statement referred to in paragraph (1) (a).

(4) If a statement of proposed amendments referred to in subregulation (3) is filed, the Commissioner must report under subregulation (1) as if the proposed amendments had been made.

(5) If, under subregulation (3), the applicant or patentee contests the report, the Commissioner must report under subregulation (1) and take notice of the matters raised by the applicant or patentee.

(6) If:

- (a) the grant of a standard patent is opposed under section 59 of the Act (“opposition to grant of standard patent”); or
- (b) a person has given the Commissioner a notice under section 28 of the Act (“notice of matters affecting validity of petty patents”) and the Commissioner has not decided the application under section 69 of the Act (“extension of term of petty patent”);

and the applicant or patentee has requested leave to amend the patent request or complete specification concerned, the Commissioner must:

- (c) give a copy of the request for leave to amend and the statement of proposed amendments to the opponent or person referred to in paragraph (b) as soon as practicable after the request for leave to amend has been filed; and
- (d) invite that opponent or person to comment on the request and statement.

(7) The opponent or person may file comments within 2 months of being given the copy of the request for leave to amend and the statement under paragraph (6) (c).

(8) If:

- (a) a person has, under subregulation 3.25 (1) (“request for Commissioner’s certificate authorising release of sample of a micro-organism”), requested the Commissioner to grant the certification referred to in that subregulation; and
- (b) the Commissioner has not made a decision under subregulation 3.25 (2); and
- (c) the applicant or patentee has filed a request for leave to amend the complete specification in respect of a matter mentioned in paragraph 6 (c) of the Act (“deposit requirements”);

the Commissioner must, as soon as practicable after the request for leave to amend has been filed, give a copy of that request and the statement of proposed amendments to the person referred to in paragraph (a).

(9) If a request for leave to amend a complete specification in respect of a micro-organism is made for the purpose of including in the specification a matter in respect of which a notice has been filed by a person under subregulation 3.29 (1) (“notification that a deposit requirement has ceased to be satisfied”), the Commissioner must, as soon as practicable after the request for leave to amend has been filed, give the person a copy of the request and the statement of proposed amendments.

Amendments not allowable

10.3

(1) A proposed amendment of a provisional specification is not allowable if it would materially alter the meaning or scope of the specification.

(2) A proposed amendment of a complete specification is not allowable if:

- (a) it is in respect of a matter mentioned in paragraph 6 (c) of the Act (“deposit requirements”); and
- (b) after the amendment were made the specification would not include each of the matters specified in that paragraph.

(3) A proposed amendment of a patent request is not allowable if:

- (a) the patent request has been accepted under section 49 (“acceptance of patent request: standard patent”) or 50 (“consideration and acceptance of patent request: petty patent”) of the Act; and
- (b) it would convert the patent application from:

- (i) an application for a standard patent to an application for a petty patent; or
- (ii) an application for a petty patent to an application for a standard patent.

(4) The Commissioner must not allow a proposed amendment of a complete specification if he or she has:

- (a) under subregulation 10.2 (8) or (9) (“Commissioner to consider and deal with requests for leave to amend”) given a person a copy of the request for leave to amend and the statement of proposed amendments; and
- (b) not given the person a reasonable opportunity to be heard.

Commissioner to refuse request for leave to amend

10.4 The Commissioner must refuse the request for leave to amend, if:

- (a) he or she reasonably believes that a proposed amendment is not allowable, other than for the reasons mentioned in subregulation 10.3 (4) (“amendments not allowable”); or
- (b) the applicant or patentee has not complied with a request of the Commissioner under subregulation 10.1 (3) (“form of amendments”); or
- (c) in the case of a proposed amendment of a complete specification relating to a patent—the patentee has not complied with a request of the Commissioner under subregulation 10.1 (4).

Commissioner to grant leave to amend

10.5

(1) The Commissioner must grant leave to amend a patent request, complete specification or another filed document, if:

- (a) a report under subregulation 10.2 (“Commissioner to consider and deal with requests for leave to amend”) is not an adverse report; and
- (b) in the case of proposed amendments of a patent request or complete specification made in anticipation of, or response to, a report relating to an examination or a notice relating to a consideration of a complete application for a petty patent under section 50 of the Act

(“consideration and acceptance of patent request: petty patent”)—the Commissioner reasonably believes that the amendments would remove all lawful grounds of objection to the patent request or specification.

(2) If the Commissioner grants leave to amend, he or she must publish a notice of that fact in the *Official Journal*, where:

- (a) the patent request and complete specification to which the leave to amend relates have been accepted under section 49 (“acceptance of patent request: standard patent”) or 50 of the Act; and
- (b) the proposed amendments are in respect of:
 - (i) the complete specification; or
 - (ii) the patent request or another filed document and the proposed amendments would materially alter the meaning or scope of the request or document.

(3) The Minister or another person may oppose allowance of an amendment if a notice is published under subregulation (2).

(4) For the purposes of paragraph (2) (b), if:

- (a) a request for leave to amend is filed before a patent is granted on an application under section 61 (“grant of standard patent”) or 62 (“grant and publication of petty patent”) of the Act; and
- (b) the proposed amendments relate to the name or address of an applicant for the patent; the proposed amendments are not taken to materially alter the meaning or scope of the patent request or other filed document.

Allowance of amendments

10.6

(1) If, under subregulation 10.5 (1) (“Commissioner to grant leave to amend”), the Commissioner grants leave to amend a patent request or complete specification and the request or specification has not been accepted under section 49 (“acceptance of patent request: standard patent”) or 50 (“consideration and acceptance of patent request: petty patent”) of the Act, he or she must, subject to any conditions, allow the amendments forthwith.

(2) If the Commissioner grants leave to amend a patent request or complete specification to which paragraph 10.5 (1) (b) applies and:

- (a) the proposed amendments do not relate to a matter mentioned in section 5 of the Act (“associated applications”); or
- (b) the proposed amendments of the complete specification would include matters mentioned in paragraph 6 (c) of the Act (“deposit requirements”);

the Commissioner must allow the amendments immediately before acceptance.

(3) Subject to subregulation (4), if under subregulation 10.5 (1):

- (a) the Commissioner grants leave to amend a patent request or complete specification; and
- (b) publishes a notice of that fact under subregulation 10.5 (2);

the Commissioner must allow the proposed amendments:

- (c) where a person has not opposed allowance of the amendments; or
- (d) subject to the terms of any decision of a prescribed court, the Tribunal or the Commissioner in respect of the opposition.

(4) If the Commissioner requires the patentee to file a statement that, to the best of the knowledge of the patentee, relevant proceedings are not pending, the patentee must file the statement within 1 month.

Correction of Register or patent

10.7

- (1) The Commissioner may, on a request being made in the approved form, amend:
 - (a) an entry in the Register for the purposes of:
 - (i) correcting a clerical error or an obvious mistake; or
 - (ii) if a name or an address entered in the Register has been changed—changing the name or address; or
 - (b) a patent for the purposes of correcting a clerical error or an obvious mistake.
- (2) The Commissioner may, if he or she proposes to amend a patent or an entry in the Register, give notice to a person whose name is entered in the Register as having an interest in the patent.
- (3) If a proposed amendment would materially alter the meaning or scope of an entry in the Register or a patent, the Commissioner must publish in the *Official Journal* a notice of the request to amend the entry or the patent.
- (4) If a notice is published, a person may oppose the making of the amendment.
- (5) If the Commissioner publishes a notice of the request to amend, he or she must amend the patent or the entry in the Register:
 - (a) where a person has not opposed allowance of the amendments; or
 - (b) subject to the terms of any decision of a prescribed court, the Tribunal or the Commissioner in respect of the opposition.
- (6) The Commissioner may, of his or her own motion, amend a patent or an entry in the Register to correct a clerical error or an obvious mistake.

Prescribed decisions: appeal to Federal Court

10.8 For the purposes of subsection 104 (7) of the Act (“amendments by applicants and patentees”), a prescribed decision is a decision to grant leave to amend a patent request or complete specification to which paragraph 10.5 (1) (b) applies (“Commissioner to grant leave to amend”).

Pending proceedings: amendments relating to micro-organisms

10.9 The Commissioner must not amend a complete specification relating to a patent if the amendment would include matters mentioned in paragraph 6 (c) of the Act (“deposit requirements”) while relevant proceedings are pending.

Prescribed period: filing of court order

10.10 For the purposes of subsection 105 (5) of the Act (“amendments directed by court”), the period of 14 days from the date of the order of the court is prescribed.

Form of direction by Commissioner: patents

10.11 A direction of the Commissioner under subsection 106 (1) of the Act (“amendments directed by Commissioner: patents”):

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that the patent relating to the direction is invalid; and
- (c) must specify the time within which the patentee must file a relevant statement of proposed amendments.

Form of direction by Commissioner: applications

10.12 A direction of the Commissioner under subsection 107 (1) of the Act (“amendments directed by Commissioner: patent applications”):

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that there are lawful grounds of objection to the patent request or complete specification; and
- (c) must specify the time within which the applicant must file a relevant statement of proposed amendments.

Form of direction by Commissioner: extension of petty patent term

10.13 A direction of the Commissioner under subsection 108 (1) of the Act (“amendments directed by Commissioner: extensions of term of petty patents”):

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that the petty patent relating to the direction is invalid; and
- (c) must specify the time within which the patentee must file a relevant statement of proposed amendments.

Form of request: claim under assignment or agreement

10.14 A request under subsection 113 (1) of the Act (“persons claiming under assignment or agreement”) for a direction of the Commissioner must be in the approved form.

CHAPTER 11—INFRINGEMENT

Infringement exemptions: prescribed foreign countries

11.1 For the purposes of the definitions of “foreign aircraft”, “foreign land vehicle” and “foreign vessel” in the Act, each of the foreign countries specified in Part 1 in Schedule 4 is prescribed.

CHAPTER 12—COMPULSORY LICENCES AND REVOCATION OF PATENTS

Lodgment of applications for compulsory licences

12.1

(1) For the purposes of subsection 133 (1) of the Act “compulsory licences”), the period of 3 years after the date of sealing of the patent to which the application relates is prescribed.

(2) An applicant must lodge with the Registrar of the prescribed court to which the application is made:

- (a) a copy of the application that includes:
 - (i) the name and address of the applicant; and
 - (ii) the address for service in relation to the application; and
 - (iii) the identity of the patent; and
 - (iv) facts supporting the assertion that the reasonable requirements of the public with respect to the patented invention have not been satisfied; and

- (b) a declaration by the applicant to the effect that the facts in the statement are true to the best of the knowledge of the applicant.
- (3) The applicant must:
 - (a) serve a copy of the application and declaration on the patentee and any other person who claims an interest in the patent as soon as practicable after lodgment; and
 - (b) lodge with the Registrar notice of the date when, and the place where, he or she complied with paragraph (a).

Prescribed period: revocation of standard patent

12.2

(1) For the purposes of subsection 134 (1) of the Act (“revocation of standard patent after grant of compulsory licence”), the period of 2 years after the date of the grant of the first compulsory licence in respect of a standard patent is prescribed.

(2) A prescribed court may, as a preliminary issue, hear and determine the question of the right of the person concerned to apply for revocation of a patent in respect of which a compulsory licence has been ordered.

Form of notice: offer to surrender patent

12.3

(1) A notice under subsection 137 (1) of the Act (“revocation on surrender of patent”) must be in the approved form.

(2) Notice of an offer to surrender under subsection 137 (2) of the Act must be published in the *Official Journal*.

(3) An interested person must, not later than 1 month after the publication, give the Commissioner notice of his or her wish to be heard under subsection 137 (3) of the Act.

(4) The Commissioner may, as a preliminary issue, hear and determine the question of the right of the person concerned to be heard.

Applications to revoke patents

12.4

(1) An applicant to a prescribed court for an order to revoke a patent under subsection 138 (1) of the Act (“revocation of patents in other circumstances”) must include in:

- (a) the pleading; or
- (b) another document disputing the validity of the patent;
particulars of the grounds on which he or she relies.

(2) If 1 of those grounds is that the invention is not a patentable invention because of information about the invention in a document or through the doing of an act, the particulars must specify:

- (a) in the case of a document—the time when, and the place where, the document is alleged to have become publicly available; and
- (b) in the case of an act:
 - (i) the name of the person alleged to have done the act; and
 - (ii) the period in which, and the place where, the act is alleged to have been done publicly;
and
 - (iii) a description that is sufficient to identify the act; and
 - (iv) if the act relates to apparatus or machinery—whether the apparatus or machinery exists
and, if so, where it can be inspected.

- (3) Except by leave of the court:
 - (a) evidence is not admissible to prove a ground of invalidity that has not been disclosed in the particulars in relation to that ground; and
 - (b) evidence as to apparatus or machinery that exists at the date of lodgment of the particulars is not admissible unless it is proved that the party relying on the evidence:
 - (i) if the apparatus or machinery is in his or her possession—has offered the opportunity to inspect it; or
 - (ii) in any other case—has used reasonable endeavours to obtain its inspection; to, or by, each other party to the hearing of the application.
- (4) The court may:
 - (a) extend the time for giving particulars; and
 - (b) allow the amendment of particulars.

CHAPTER 13—WITHDRAWAL AND LAPSING OF APPLICATIONS AND CEASING OF PATENTS

Publication of notice of withdrawal of application

13.1 The Commissioner must publish notice in the *Official Journal* of the withdrawal of a patent application under section 141 of the Act (“withdrawal of applications”).

Prescribed period: request for examination of applications

13.2 The period of 9 months from the date on which the request for deferment of the examination was filed is prescribed for the purposes of paragraph 142 (2) (c) of the Act (“lapsing of applications”).

Prescribed period: continuation fees

13.3

(1) Subject to this regulation, for the purposes of paragraph 142 (2) (d) of the Act (“lapsing of applications”), the period of 12 months ending at the end of an anniversary of the date (being an anniversary specified in column 2 of item 8 of Part 2 in Schedule 7) that would be the date of the patent if a patent were granted on the application is prescribed for the payment of a continuation fee.

(2) In the case of an application to which section 33 (“applications by opponents etc.”), 34 (“applications by eligible persons arising out of court proceedings”), 35 (“applications by eligible persons following revocation by Commissioner”), 36 (“other applications by eligible persons”) or 39 (“divisional applications”) of the Act applies, a continuation fee that is payable before 12 months after the date of filing of the application is taken to have been paid.

(3) If a continuation fee is not paid in the period referred to in subregulation (1), but is paid within 6 months after the anniversary concerned, the prescribed period is extended to the day on which the fee is paid.

Prescribed period: acceptance of request and specification

13.4 The period prescribed for the purposes of paragraph 142 (2) (e) of the Act (“lapsing of applications”) is:

- (a) whichever is the later of:
 - (i) if examination is requested under subsection 47 (2) of the Act (“request for modified examination”) after the Commissioner first reported under section 48 of the Act

- (“modified examination”)– the period of 12 months from the date of the first report on the examination under section 45 of the Act (“examination”); or
- (ii) the period of 21 months from the date of the first report under section 48 of the Act; or
- (b) if paragraph (a) does not apply–the period of 21 months from the date of the first report under section 45 of the Act; or
- (c) if:
- (i) if the Commissioner has reported that the patent request or complete specification relates to an invention that, so far as claimed, is not novel in view of information of the kind described in subparagraph (b) (ii) of the definition of “prior art base” in the Act–the period of 3 months from the date of publication of the specification containing that information or its lapsing, refusal or withdrawal, whichever is the earlier; or
 - (ii) the patent request and complete specification relate to an application to which subsection 36 (3) of the Act (“other applications by eligible persons”) applies–the period 3 months from the date of the declaration of the Commissioner under subsection 36 (1) of the Act; or
 - (iii) in the case of an appeal to a prescribed court or an application for review to the Tribunal in relation to the patent request or complete specification–the period of 3 months from the day when the appeal or application is withdrawn or finally dealt with or determined, or such further period as the court or Tribunal allows; or
 - (iv) in the case of an application for a patent of addition, if an appeal to a prescribed court or an application for review to the Tribunal in respect of the application for a patent for the main invention has been instituted–the period of 3 months from the day when the appeal or application is withdrawn or finally dealt with or determined, or such further period as the court or Tribunal allows;
- whichever ends later.

If applications lapse

13.5 If a complete application lapses under section 142 (“lapsing of applications”), the Commissioner must advertise that fact in the *Official Journal*.

Time for payment of renewal fee for standard patent

13.6

(1) For the purposes of paragraph 143 (a) of the Act (“ceasing of patents”), subject to subregulation (2), the period of 12 months ending at the end of an anniversary of the date of the patent (being an anniversary specified in column 2 of item 8 or 9 of Part 2 in Schedule 7) is prescribed for the payment of renewal fee.

(2) If a continuation fee is paid in respect of an anniversary, the renewal fee in respect of that anniversary is taken to have been paid.

(3) Subject to subregulation (4), if a renewal fee is not paid in the period referred to in subregulation (1), but is paid within 6 months after the anniversary concerned, the prescribed period is extended to the day on which the fee is paid.

(4) If:

- (a) an extension of the term of a patent is applied for under subsection 70 (1) of the Act (“application for extension of term of patent relating to a pharmaceutical substance”); and
 - (b) a renewal fee in respect of 1 or more anniversaries of the date of the patent (being an anniversary specified in column 2 of item 8 or 9 of Part 2 in Schedule 7) is payable before an extension is granted under subsection 75 (2) or (4) of the Act (“determination of application for extension”); and
 - (c) the fee is paid within 6 months of the day when the extension is granted;
- the prescribed period is extended to the day on which the fee is paid.

(5) The Commissioner must publish notice in the *Official Journal* of a patent that ceases under section 143 of the Act.

CHAPTER 15—SPECIAL PROVISIONS RELATING TO ASSOCIATED TECHNOLOGY

Time for restoration of application for patent

15.1 A request under subsection 150 (1) of the Act (“restoration of lapsed application”) must be filed within 3 months after the revocation under section 149 of the Act (“revocation of direction”) of a direction in respect of the application to which the request relates.

Requirements for reinstatement of international applications

15.2

(1) For the purposes of paragraph 151 (4) (c) of the Act (“reinstatement of application as an international application”), the period of 3 months after the revocation of a direction under section 149 of the Act (“revocation of direction”) is prescribed.

(2) For the purposes of paragraph 151 (4) (d) of the Act, the patent request, the specification to which the request relates and such other documents as are prescribed for the purposes of subsection 29 (1) of the Act (“application for patent”) are prescribed.

(3) For the purposes of paragraph 151 (4) (d) of the Act, the fee that would have been payable if the application had been filed under section 29 of the Act is prescribed.

Prescribed period: order relating to a standard patent

15.3 For the purposes of subsection 153 (3) of the Act (“effect of order”), the period of 1 month from the revocation of the order under subsection 152 (3) of the Act (“notice of prohibitions or restrictions on publication”) that relates to the application.

CHAPTER 17—THE CROWN

Prescribed period: order relating to a standard patent

17.1 For the purposes of subsection 174 (2) of the Act (“effect of prohibition orders”), the period of 1 month from the revocation of an order under subsection 173 (1) of the Act (“prohibition of publication of information about inventions”) that relates to the application is prescribed.

Prescribed period, document and fee: filing of international applications

17.2

(1) For the purposes of paragraph 176 (c) of the Act (“international applications treated as applications under this Act”), the period of 3 months from the date on which an international application is considered to be withdrawn under Article 12 of the PCT is prescribed.

(2) For the purposes of paragraph 176 (d) of the Act, the patent request, the specification relating to the request and such other documents as are prescribed for the purposes of subsection 29 (1) of the Act (“application for patent”) are prescribed.

(3) For the purposes of paragraph 176 (d) of the Act, the fee that would have been payable if the application had been filed under section 29 of the Act is prescribed.

Note: The text of the PCT is set out in Schedule 2.

CHAPTER 19—THE REGISTER AND OFFICIAL DOCUMENTS

Particulars to be registered

19.1

(1) For the purposes of section 187 of the Act (“registration of particulars of patents etc.”), the following particulars are prescribed, that is, particulars of:

- (a) an entitlement as mortgagee, licensee or otherwise to an interest in a patent;
- (b) a transfer of an entitlement to a patent or licence, or to a share in a patent or licence;
- (c) an extension of the term of a patent;
- (d) a restoration of a standard patent;
- (e) an order of a court a copy of which is filed under subsection 105 (5) of the Act (“amendments directed by court”);
- (f) an order of a prescribed court that has been served on the Commissioner under section 140 of the Act (“Commissioner to be given copies of orders”);
- (g) an order of a prescribed court made on appeal in relation to a patent, being an order of which an office copy has been served on the Commissioner;
- (h) a decision of the Commissioner to revoke a patent under Chapter 9 of the Act (“re-examination”);
- (i) the acquisition of a patent by the Commonwealth under Part 3 (“acquisitions by and assignments to the Crown”) of Chapter 17 (“the Crown”) of the Act;
- (j) the cessation of a patent.

(2) A request for registration of particulars referred to in paragraph (1) (a) or (b) must be in the approved form and have with it proof to the reasonable satisfaction of the Commissioner of the entitlement of the person making the request.

Request for information from Commissioner

19.2

(1) A request made to the Commissioner under paragraph 194 (c) of the Act (“information obtainable from the Commissioner”) must be in the approved form.

(2) A request under Article 15 (5) of the PCT for an international-type search to be carried out must be made by the applicant referred to in that Article within 3 months of the making of the application referred to in the Article.

Note: The text of the PCT is set out in Schedule 2.

CHAPTER 20—PATENT ATTORNEYS

PART 1—INTRODUCTORY

Interpretation

20.1 In this Chapter, unless the contrary intention appears:

“**Board**” means the Patent Attorneys Professional Standards Board established by subregulation 20.32 (1);

“**candidate**” means a person who proposes or proposed to sit, or has sat, for an examination;

“**Disciplinary Tribunal**” means the Patent Attorneys Disciplinary Tribunal established by regulation 20.41;

“**examination**” means an examination held under regulation 20.6;

“**former attorney**” means a patent attorney whose registration has been suspended or cancelled under Part 4 (“discipline”);

“**Institute**” means the Institute of Patent Attorneys of Australia incorporated under the law of Victoria;

“**member**” means a member of the Board other than the Commissioner;

“**Register of Patent Attorneys**” means the register kept under section 198 of the Act (“registration of patent attorneys”); “unprofessional conduct” means conduct on the part of a patent attorney whereby he or she can be regarded as committing a gross failure to comply with the standards that, in the circumstances, it is reasonable to require the patent attorney to observe;

“**unqualified**”, in relation to a particular time, means lacking a qualification required for registration at that time by these Regulations or the former attorneys Regulations;

“**unsatisfactory conduct**” means not having attained or sustained a professional standard that is consistent with the standard of practice of patent attorneys.

How to make an application

20.2

(1) An application under this Chapter, other than an application under regulation 20.4 (“procedure for registration”) or 20.19 (“restoration of patent attorney’s name to the Register”), may be made by sending it to the Patent Office addressed to the Secretary to the Board.

(2) An application under regulation 20.4 or 20.19 may be made by sending it to the Patent Office addressed to the Commissioner and marked for the attention of the Secretary to the Board.

PART 2—OBTAINING REGISTRATION FOR THE FIRST TIME

Division 1—Generally

Requirements for registration

20.3 For the purposes of subsection 198 (2) of the Act (“registration of patent attorneys”):

- (a) the prescribed subjects that a person must have passed are those specified in column 2 of Schedule 5; and
- (b) the prescribed qualifications that a person must have are that the person:
 - (i) is of good fame and character; and
 - (ii) has satisfied the Board that he or she has been awarded, or is entitled to be awarded, a qualification referred to in column 2 of Schedule 6; and
- (c) the prescribed employment is employment as a technical assistant in the conduct of the practice of a patent attorney in matters arising under the Act or the 1952 Act; and
- (d) the prescribed period of that employment is:
 - (i) 1 continuous period of not less than 1 year; or
 - (ii) periods within a continuous period of 2 years that total not less than 1 year.

Procedure for registration

20.4 A person may apply for registration as a patent attorney in the approved form together with:

- (a) evidence that the person is an Australian citizen; and
- (b) evidence of the person’s age; and
- (c) a certificate issued to the person under regulation 20.16 (“certificate of completion of examinable subjects and of academic qualifications”); and

- (d) evidence that the person has been employed as required by regulation 20.3 (“requirements for registration”); and
- (e) certificates in the approved form by 3 persons to whom the person has been known for not less than 12 months immediately before the certificates are given that the applicant is of good fame and character.

Certificate of registration

20.5 When the Commissioner registers a person as a patent attorney the Commissioner must give to the person a certificate of registration in the approved form.

Division 2—Prescribed subjects and academic qualifications

Examination to be conducted

20.6

- (1) The Board is to hold an examination in the subjects specified in Schedule 5.
- (2) The Board may appoint examiners for the purposes of the examinations and give them instructions about the setting and marking of papers.
- (3) Examiners appointed under this regulation are entitled to be paid the fees that the Minister determines in writing.

Time for holding examinations

20.7

- (1) An examination must be held in October, November or December each year.
- (2) The Board must arrange to publish in the *Official Journal* adequate notice of:
 - (a) the time of each examination and the place where it is to be held; and
 - (b) the deadline for applications for admission to sit for each examination.
- (3) Subregulations (1) and (2) do not apply to a supplementary examination under regulation 20.12 (“supplementary examination”).

Particulars of subjects

20.8 From time to time the Board must arrange to publish in the *Official Journal* particulars of:

- (a) the scope of the subjects specified in column 2 of Schedule 5; and
- (b) the books it recommends to candidates.

Admission to sit for an examination

20.9

- (1) An application by a person to sit for an examination must be in the approved form.
- (2) A person is not eligible to sit for an examination in a subject mentioned in item 5, 6, 7 or 8 in Schedule 5 unless the person has passed, or been exempted from having to pass, the subjects mentioned in items 1, 2, 3 and 4 in that Schedule.

Notification of results

20.10 As soon as practicable after an examination, the Board must give to each candidate who sat for the examination his or her results in the examination.

Reasons for failure

20.11 The Board may give a report of the reasons for the failure to a candidate who failed an examination if the candidate applies to the Board for a report of the reasons for that failure in the approved form within 1 month of being informed of the failure.

Supplementary examination

20.12

- (1) An application by a person to sit for a supplementary examination must be in the approved form.
- (2) The Board may let a candidate sit for a supplementary examination if the candidate:
 - (a) failed an examination and applies to the Board to sit for the supplementary examination within 1 month of being told of the failure; or
 - (b) did not sit for the examination because of illness or another reason that the Board reasonably considers sufficient and he or she applies to the Board to sit for the supplementary examination within 1 month of the examination.

Exemption from examination

20.13

- (1) The Board may exempt a person from having to pass an examination.
- (2) The Board must not give an exemption to a person unless:
 - (a) the person makes an application in the approved form; and
 - (b) the Board is satisfied that the person has passed, at a satisfactory level, an examination in a subject covering the same, or a similar, field of knowledge.
- (3) If the Board exempts a person, it must give to the person a certificate of exemption in the approved form.

Approval of courses and examinations

20.14

- (1) The Board may approve a course mentioned in item 1 or 2 of Schedule 6.
- (2) In approving a course, the Board must:
 - (a) have regard to the syllabus for the course; and
 - (b) in the case of a course mentioned in item 2 of Schedule 6—reasonably believe that the standard of the course is at least equal to the standard of a degree, diploma or postgraduate diploma of an Australian tertiary educational institution in a branch of engineering or science.
- (3) The Board may approve an examination mentioned in item 3 of Schedule 6.
- (4) In approving an examination referred to in subregulation (3), the Board must have regard to the syllabus for any course undertaken by a person preparing for the examination.
- (5) For the purposes of item 3 of Schedule 6, the Board may approve a professional institution.

Certificate of academic qualifications

20.15 The Board must give to a person a certificate that the person has a qualification specified in Schedule 6 if:

- (a) the person makes an application in the approved form; and
- (b) the application has with it evidence that the person has that qualification; and
- (c) the Board is reasonably satisfied that the person has the qualification.

Certificate of completion of examinable subjects and of academic qualifications

20.16 The Board must give to a person a certificate in the approved form that the person:

- (a) has passed or is exempt under regulation 20.13 (“exemption from examination”) the subjects specified in Schedule 5; and
- (b) has a qualification specified in Schedule 6;

if:

- (c) the person applies in the approved form for the certificate; and
- (d) the application has with it a copy of each of the certificates referred to in regulations 20.13 and 20.15 (“certificate of academic qualifications”).

Division 3—Rights of Patent Attorneys

Lien

20.17 A patent attorney has the same right of lien over documents and property of a client as a solicitor.

PART 3—RENEWAL OF REGISTRATION: PAYMENT OF ANNUAL FEE

Annual registration fee

20.18

- (1) An annual registration fee is payable by a patent attorney on 1 July in each year.
- (2) The Commissioner must give to each patent attorney no later than 1 June in each year notice of the fee that is payable.
- (3) If a patent attorney does not pay the fee within 14 days after it is payable, the Commissioner must:
 - (a) remove the name of the attorney from the Register of Patent Attorneys; and
 - (b) notify the attorney of that removal.

Restoration of patent attorney’s name to the Register

20.19 The Commissioner may restore a person’s name to the Register of Patent Attorneys if:

- (a) the person pays the fee referred to in regulation 20.18 (“annual registration fee”); and
- (b) applies in the approved form;

within 6 weeks after the end of the period mentioned in subregulation 20.18 (3) (“annual registration fee”) or such further period as the Commissioner reasonably allows.

PART 4—DISCIPLINE

Division 1—Complaints, decisions of the Disciplinary Tribunal and consequential action

Complaints

20.20

- (1) The Institute or a person who alleges that his or her interests are affected by the unprofessional conduct of a patent attorney may make a written complaint to the Board about that conduct.
- (2) The Institute or a person may complain in writing to the Board:
 - (a) that a patent attorney was unqualified at the time of his or her registration; or
 - (b) that the patent attorney obtained his or her registration by fraud.
- (3) A complaint must:
 - (a) state the name of the patent attorney complained about and the address of the attorney, if known to the complainant; and
 - (b) state the nature of the complaint; and
 - (c) state the name and address of the complainant; and
 - (d) be signed by the complainant; and
 - (e) have with it a statutory declaration stating the facts on which the complainant relies to support the complaint.
- (4) If the complaint is made by the Institute, the statutory declaration must be made by an officer of the Institute.
- (5) The Board must give to the patent attorney a copy of the complaint and statutory declaration and ask the attorney to give to the Board a written statement replying to the complaint.
- (6) The statement must be given to the Board within the period specified by the Board, being a period of not less than 21 days from the day on which the patent attorney was asked to give a statement.
- (7) The Board may request the Commissioner, the complainant or the patent attorney to give it further information not less than 21 days after the day on which the request was given.
- (8) The period of 21 days for giving further information may be extended by the Board before or after that period.

Authorisation to bring proceedings against a patent attorney

20.21

- (1) A person may not bring proceedings against a patent attorney before the Disciplinary Tribunal unless the person is authorised under this regulation.
- (2) The Board must give written authority to a complainant to bring proceedings against a patent attorney:
 - (a) charging the attorney with unsatisfactory conduct or unprofessional conduct; or
 - (b) charging that the attorney was unqualified at the time of his or her registration or obtained his or her registration by fraud;if it appears to the Board, after considering the complaint and any reply and any further information given under regulation 20.20 ("complaints"), that the attorney may be guilty of conduct of that kind or may have been unqualified, as the case may be.
- (3) If the Board authorises a complainant to bring proceedings, it must inform the complainant that he or she may ask the Board to bring those proceedings on the complainant's behalf.
- (4) If a person authorised to bring proceedings:
 - (a) informs the Board that he or she wants the Board to bring the proceedings—the Board must bring the proceedings on behalf of the complainant; or
 - (b) does not bring the proceedings within 21 days after the day on which the authority is sent to him or her—the Board may bring the proceedings on its own behalf.
- (5) If a person has begun proceedings but fails to continue them, the Board may continue the proceedings on its own behalf.
- (6) If the Board authorises proceedings against a patent attorney, the Board must:
 - (a) give the Disciplinary Tribunal copies of the complaint and all other documents it holds that relate to the complaint; and
 - (b) notify the attorney, in writing, of that authorisation.

(7) If the Board, after considering a complaint and any reply and any further information given under regulation 20.20, decides not to authorise proceedings against a patent attorney, it must give written notice of its decision to the complainant and the attorney.

Bringing of proceedings

20.22

(1) Proceedings against a patent attorney arising from a complaint are to be brought before the Disciplinary Tribunal by lodging with that Tribunal:

- (a) a copy of the complaint; and
- (b) if the proceedings are to be brought by the complainant—a copy of the authorisation of the Board to bring proceedings.

(2) If proceedings are brought against a patent attorney, the Disciplinary Tribunal must fix a time and place for the hearing and notify:

- (a) if the proceedings have been brought by a complainant—the complainant; and
 - (b) the attorney; and
 - (c) the Board;
- of that time and place.

(3) The time of hearing must not be less than 21 days after the day on which the patent attorney is told of the time and place.

Decision of Disciplinary Tribunal

20.23

(1) If the Disciplinary Tribunal has heard a charge of:

- (a) unsatisfactory conduct against a patent attorney—that Tribunal may find the attorney guilty of unprofessional conduct; or
- (b) unprofessional conduct against a patent attorney—that Tribunal may find the attorney guilty of unsatisfactory conduct.

(2) If the Disciplinary Tribunal finds a patent attorney guilty of unsatisfactory conduct or unprofessional conduct, that Tribunal may:

- (a) reprimand the attorney; or
- (b) suspend the attorney's registration for not more than 12 months; or
- (c) where the attorney is guilty of unprofessional conduct—cancel his or her registration.

(3) In deciding what to do about a patent attorney under subregulation (2), the Disciplinary Tribunal may take into account the findings about the conduct of the attorney in any other proceedings:

- (a) brought before that Tribunal; or
- (b) brought before the Patent Attorneys Disciplinary Tribunal under the former attorneys Regulations.

(4) If the Disciplinary Tribunal has heard a charge against a patent attorney that the attorney was unqualified at the time of his or her registration and finds the charge proved, that Tribunal may:

- (a) if the attorney has, since that time, obtained that qualification or the qualification is no longer required for registration—reprimand the attorney; or
- (b) in any other case—cancel his or her registration.

(5) If the Disciplinary Tribunal finds that a patent attorney obtained his or her registration by fraud, that Tribunal must cancel the registration of the attorney.

(6) If the Disciplinary Tribunal reprimands a patent attorney or suspends or cancels the attorney's registration, that Tribunal must give a written notice of finding of the Tribunal against the attorney that sets out particulars of the reprimand, suspension or cancellation to:

- (a) if the proceedings were brought by a complainant—the complainant; and

- (b) the attorney; and
- (c) the Board; and
- (d) the Commissioner.

(7) If the registration of a patent attorney is suspended the Commissioner must note the suspension and its duration in the Register of Patent Attorneys.

(8) If the registration of a patent attorney is cancelled the Commissioner must remove the name of the attorney from the Register of Patent Attorneys.

(9) If the Disciplinary Tribunal does not find a charge proved, that Tribunal must notify the patent attorney concerned, the complainant and the Board accordingly.

Publication of decision

20.24 If directed by the Disciplinary Tribunal, the Commissioner must publish in the *Official Journal* a copy of a notice under subregulation 20.23 (6) (“decision of Disciplinary Tribunal”) or an extract of that notice.

Completion of outstanding business

20.25

(1) The Disciplinary Tribunal may appoint a patent attorney who has consented to carry on the practice of a former patent attorney:

- (a) if the registration of the former attorney has been suspended—for the period of the suspension or, if a shorter period is specified in the appointment, for that shorter period; or
- (b) if the name of the former attorney has been removed from the Register of Patent Attorneys under subregulation 20.23 (8) (“decision of Disciplinary Tribunal”)—until all outstanding matters are disposed of or, if a shorter period is specified in the appointment, for that shorter period.

(2) This regulation does not allow a patent attorney to act as a patent attorney on behalf of a person without the consent of the person.

(3) A patent attorney appointed to carry on the practice of a former attorney may give a written notice requiring the former attorney to make available to the attorney so appointed:

- (a) any information about the practice that he or she may reasonably require; or
- (b) any books, accounts or other documents concerning the practice that he or she may reasonably require; or
- (c) any moneys held by the former attorney:
 - (i) on behalf of a client; or
 - (ii) that have been paid by a client in respect of services not yet performed for the client.

(4) A former attorney who has been given a notice under subregulation (3) must not, without reasonable excuse, fail or refuse to comply with a requirement in the notice.

Penalty: \$500.

Division 2—Procedure etc. relating to the Disciplinary Tribunal

Procedure of Disciplinary Tribunal

20.26

(1) Subject to this Part, the Disciplinary Tribunal may determine its procedure.

(2) Proceedings before the Disciplinary Tribunal are to be conducted quickly and informally while allowing for proper consideration of the matter before that Tribunal.

(3) The Disciplinary Tribunal is not bound by the rules of evidence but may be informed on any matter in the manner it chooses.

(4) The Disciplinary Tribunal may take evidence on oath and, for that purpose, may administer an oath.

Hearings to be public except in special circumstances

20.27

(1) Subject to subregulation (2), a hearing before the Disciplinary Tribunal is to be in public.

(2) If the Disciplinary Tribunal is reasonably satisfied that it is desirable to do so in the public interest or because of the confidential nature of any evidence or matter, that Tribunal may:

- (a) direct that a hearing, or a part of a hearing, is to take place in private and give directions as to the persons who may be present; and
- (b) give directions restricting or prohibiting the publication or disclosure:
 - (i) of evidence given before the Tribunal, whether in public or in private; or
 - (ii) of any matters contained in documents lodged with the Tribunal or received in evidence by it; or
 - (iii) of any finding or decision of the Tribunal.

(3) A person must not contravene a direction under this regulation that is applicable to him or to her.

Penalty: \$500.

Representation before Disciplinary Tribunal

20.28

(1) At the hearing of proceedings before the Disciplinary Tribunal, a party to the proceedings may appear in person or be represented by a legal practitioner.

(2) The Disciplinary Tribunal may allow a person to be represented by a person who is not a legal practitioner.

(3) A party to proceedings before the Disciplinary Tribunal, or his or her representative, may request that Tribunal to summon witnesses.

Summoning of witnesses

20.29

(1) For the purposes of the hearing of a charge against a patent attorney before the Disciplinary Tribunal, that Tribunal may, by writing signed by the person constituting the Tribunal:

- (a) summon any person, other than the attorney, to appear before the Tribunal to give evidence about the charge and to produce any documents mentioned in the summons; or
- (b) summon the attorney to appear before the Tribunal:
 - (i) to produce any documents mentioned in the summons; and
 - (ii) to give evidence to identify those documents.

(2) A patent attorney summoned under this regulation must appear in person.

Offences by persons appearing before Disciplinary Tribunal

20.30

(1) A person summoned to appear before the Disciplinary Tribunal must not, without reasonable excuse:

- (a) fail to appear as required by the summons; or

- (b) fail to produce documents or articles as required by the summons; or
- (c) fail to appear and report to that Tribunal from day to day, unless excused by the Tribunal.

Penalty: \$1,000.

(2) A person appearing as a witness before the Disciplinary Tribunal, not being a patent attorney to whom subregulation (3) applies, must not, after being paid expenses and allowances determined by that Tribunal in accordance with Part 2 in Schedule 8, without reasonable excuse:

- (a) refuse or fail to be sworn or to make an affirmation; or
- (b) refuse or fail to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: \$1,000.

(3) A patent attorney against whom proceedings have been instituted who is summoned to appear at a hearing before the Disciplinary Tribunal in respect of those proceedings must not, without reasonable excuse:

- (a) refuse or fail to be sworn or to make an affirmation; or
- (b) refuse or fail to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: \$1,000.

(4) It is a reasonable excuse for a person referred to in subregulation (2) or (3) to refuse or fail to answer a question or to produce a document or article, if the answer to the question, or the document or article, may tend to prove that he or she has committed an offence against a law of the Commonwealth or of a State or Territory.

Protection of person constituting Disciplinary Tribunal, witnesses etc.

20.31

(1) A person:

- (a) constituting or acting as the Disciplinary Tribunal; or
- (b) appointed under subregulation 20.45 (2) (“disclosure of interest”);

has, in the exercise of the powers and the performance of the functions of that Tribunal under this Part, the same protection and immunity as a Justice of the High Court.

(2) A member of the Board has, in considering complaints under this Part and authorizing the institution of proceedings before the Disciplinary Tribunal, the same protection and immunity as a Justice of the High Court.

(3) A legal practitioner or other person appearing before the Disciplinary Tribunal has the same protection and immunity as a barrister has in appearing for a party in proceedings in the High Court.

(4) Subject to this Part, a person summoned to attend or appearing before the Disciplinary Tribunal as a witness has the same protection, and is, in addition to the penalties provided by this Part, subject to the same liabilities, as a witness in proceedings in the High Court.

PART 5—ADMINISTRATION

Division 1—The Patent Attorneys Professional Standards Board

Establishment of Board

20.32

- (1) The Patent Attorneys Professional Standards Board is established.
- (2) The Board is constituted by:
 - (a) the Commissioner; and

- (b) 2 members who are patent attorneys elected by patent attorneys in accordance with directions published under subregulation 20.33 (1) (“election of Board members”); and
- (c) no fewer than 2 members appointed by the Minister.
- (3) The Commissioner is the Chairperson of the Board.

Election of Board members

20.33

- (1) An election of members of the Board or a replacement member of the Board must be held in the manner that the Minister directs by notice published in the *Official Journal*.
- (2) As soon as practicable after the result of an election is known, the Minister is to declare the result by notice published in the *Official Journal*.

Term of office of Board members

20.34

- (1) An elected member holds office for 3 years commencing on publication of the notice under subregulation 20.33 (2) (“election of Board members”) of the member’s election.
- (2) An appointed member holds office for a period of not more than 3 years that is specified in the instrument of appointment.
- (3) A member of the Board is eligible for re-election.
- (4) A person who turns 65 may not be elected or appointed as a member and a person may not be elected or appointed as a member for a period that extends beyond the date on which he or she turns 65.
- (5) In subregulation (4), “**elected**” includes re-elected.

Resignation and removal from office as Board mem

20.35

- (1) A member may resign in writing given to the Minister.
 - (2) The Minister may remove a member from office for inefficiency, misbehaviour or incapacity.
 - (3) If a member:
 - (a) becomes bankrupt, applies to take the benefit of a law for the relief of bankrupt or insolvent debtors, compounds with his or her creditors or makes an assignment of his or her remuneration for their benefit; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for 12 months or longer; or
 - (c) is absent without leave granted by the Chairperson from 3 consecutive meetings of the Board; or
 - (d) in the case of an elected member—ceases to be a registered patent attorney;
- the Minister is to remove the member from office.

Replacement of elected Board members failing to serve their full term

20.36

- (1) If an elected member ceases to hold office more than 6 months before the end of the period that applies to him or her under subregulation 20.34 (1) (“term of office of Board members”), another patent attorney must be elected in accordance with directions given under subregulation 20.33 (1) (“election of Board members”) to replace that member.
- (2) A patent attorney elected to replace an elected member is a member until the end of the period that applied to that member under subregulation 20.34 (1) unless the replacement member ceases to hold office sooner.

(3) If an elected member (in this subregulation called “**the original member**”) is replaced by a person who ceases to hold office more than 6 months before the end of the period that applied to the original member under subregulation 20.34 (1), another patent attorney must be elected in accordance with directions under subregulation 20.33 (1) to replace that person.

Meetings of Board

20.37

- (1) The Board must hold as many meetings as are necessary for the performance of its functions.
- (2) The Commissioner may, at any time, by notice in writing to the members, call a meeting of the Board at the time and place specified in the notice.

Member presiding at meetings of Board

20.38

- (1) The Commissioner must preside at all meetings of the Board at which he or she is present.
- (2) In the absence of the Commissioner from a meeting, the members present must appoint 1 of themselves to preside.
- (3) The Commissioner or a member who presides at a meeting has a deliberative vote and, in the event of an equality of votes, also has a casting vote.

Quorum for meetings of Board

20.39 At a meeting of the Board:

- (a) the Commissioner and 3 members; or
 - (b) in the absence of the Commissioner—4 members;
- constitute a quorum.

Secretary to Board

20.40

- (1) The Minister may in writing appoint an employee to be the Secretary to the Board.
- (2) The Secretary to the Board must record minutes of the business transacted at meetings of the Board and perform the other duties directed by the Board.
- (3) The Secretary to the Board may resign in writing given to the Minister.

Division 2—The Patent Attorneys Disciplinary Tribunal

Establishment of Disciplinary Tribunal

20.41 The Patent Attorneys Disciplinary Tribunal is established.

Disciplinary Tribunal: substantive appointments

20.42

- (1) The Minister may in writing appoint a person to constitute the Disciplinary Tribunal.
- (2) A copy of the instrument of appointment must be published in the *Official Journal*.
- (3) A person so appointed holds the office for the period specified in the instrument.
- (4) A person so appointed may resign in writing given to the Minister.

- (5) The Minister may remove a person so appointed from office for inefficiency, misbehaviour or incapacity.
- (6) If a person so appointed:
- (a) becomes bankrupt, applies to take the benefit of a law for the relief of bankrupt or insolvent debtors, compounds with his or her creditors or makes an assignment of his or her remuneration for their benefit; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for 12 months or longer; or
 - (c) fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.45 (“disclosure of interest”);
- the Minister is to remove the person from office.

Disciplinary Tribunal: acting appointments

20.43

- (1) The Minister may in writing appoint a person to act as Disciplinary Tribunal:
- (a) during a vacancy in the office, whether or not an appointment has been previously made to the office; or
 - (b) during any period, or during all periods, when the holder of the office is, or is expected to be, absent from duty or from Australia or is, for any reason, unable to perform the functions of the office;
- but a person appointed to act during a vacancy must not continue to act for more than 12 months.
- (2) A copy of the instrument of appointment must be published in the *Official Journal*.
- (3) The Minister:
- (a) may terminate the appointment at any time; and
 - (b) is to terminate the appointment if the person appointed fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.45 (“disclosure of interest”).
- (4) Anything done by or in relation to a person purporting to act under the appointment is not invalid only because:
- (a) the need for the appointment had not arisen;
 - (b) there was a defect or irregularity in connection with the appointment;
 - (c) the appointment had ceased to have effect; or
 - (d) the need to act had not arisen or had ceased.

Qualifications for holding, or acting as, Disciplinary Tribunal

20.44 A person is not qualified to be appointed under subregulation 20.42 (1) (“Disciplinary Tribunal: substantive appointments”), 20.43 (1) (“Disciplinary Tribunal: acting appointments”) or 20.45 (2) (“disclosure of interest”) unless he or she is enrolled, and has for not fewer than 7 years been enrolled, as a legal practitioner.

Disclosure of interest

20.45

- (1) If a person constituting or acting as the Disciplinary Tribunal has or acquires an interest that could conflict with the proper performance of his or her functions in relation to proceedings he or she is to hear, the person:
- (a) must tell the parties to the proceedings about the interest; and
 - (b) must not perform those functions without the consent of the parties.

(2) If such a person is unable to perform his or her functions because of a conflict of interest, the Minister may in writing appoint another person to be the Disciplinary Tribunal for the purpose of conducting or completing those proceedings.

(3) A copy of the instrument of appointment must be published in the *Official Journal*.

(4) A person so appointed may exercise all the powers and must perform all of the functions of the Disciplinary Tribunal in relation to those proceedings.

CHAPTER 21—ADMINISTRATION

Patent Office and sub-offices

21.1 The hours of business of the Patent Office and each sub-office of the Patent Office are from 10 a.m. to 4 p.m. on each day other than:

(a) a Saturday or a Sunday; or

(b) a public holiday:

(i) where the Office or sub-office is located; or

(ii) for the purposes of the Australian Public Service in that place.

CHAPTER 22—MISCELLANEOUS

PART 1—FEES AND COSTS

Division 1—Fees

Fees generally

22.1

(1) A fee must be paid at the Patent Office or a sub-office of the Patent Office in such a manner as the Commissioner reasonably directs.

(2) If the Commissioner has directed that a complete application is to be treated as a provisional application, the amount by which the fee payable on the filing of a complete application exceeds the fee payable on the filing of a provisional application must be credited towards the payment of the fee payable on the next filing of a complete application associated with the provisional application by the applicant concerned.

(3) For the purposes of subsection 227 (5) of the Act (“fees”), the Commissioner must give notice of the failure to pay the fee to the person or his or her patent attorney in writing within 7 days after the filing of the document, or the doing of the act, for which the fee is payable.

General fees

22.2

(1) “For the purposes of subsection 227 (1) of the Act (“fees”), there is payable to the Commissioner in respect of a matter specified in column 2 of an item of Part 1 or 2 in Schedule 7 a fee of the amount specified in column 3 of that item.

(2) In order to ascertain the amount of a fee payable under item 28 of Part 2 in Schedule 7, the period from the day on which a notice of opposition to the grant of an application for an extension of time is filed to the end of:

(a) if an application is made to the Tribunal for a review of a decision of the Commissioner—the day when the application is withdrawn or finally dealt with or determined; or

- (b) in any other case—21 days after the end of the day on which the Commissioner decides the application;

must not be taken into account.

- (3) For the purposes of paragraph 89 (3) (b) of the Act (“modified application of Act”):

- (a) if a PCT application is treated as an application:

(i) for a petty patent—the amount of the fee specified in item 2 of Part 2 in Schedule 7; or

(ii) for a standard patent—the amounts of the fees specified in item 3 of that Part;

is, or are, payable in respect of the application; and

- (b) the fee specified in item 2 or 3 of Part 2 in Schedule 7 is not payable in respect of a PCT application.

(4) Item 21 of Part 2 in Schedule 7 does not apply to a request for correction that is made only because of an error or omission on the part of an employee.

General fees for international applications

22.3

- (1) If:

- (a) for the purposes of the PCT, the Commissioner or the Patent Office is:

(i) a receiving Office; or

(ii) an International Searching Authority; or

(iii) an International Preliminary Examining Authority; and

- (b) the Commissioner or the Patent Office is empowered by the PCT to charge a fee, other than a fee for the benefit of the International Bureau;

for the purposes of subsection 227 (1) of the Act (“fees”), the amount of the fee payable to the Commissioner in respect of a matter specified in column 2 of an item of Part 3 in Schedule 7 is the amount specified in column 3 of that item.

(2) The fees specified in items 1 and 2 of Part 3 in Schedule 7 are payable to the Commissioner within 1 month of filing an international application.

(3) The fee specified in item 4 of Part 3 in Schedule 7 is payable to the Commissioner on filing a demand for a preliminary examination under Article 31 of the PCT.

Note: The text of the PCT is set out in Schedule 2.

Fees for international applications payable for the benefit of the International Bureau

22.4

- (1) If, for the purposes of the PCT, the Commissioner or the Patent Office is:

(a) a receiving Office; or

(b) an International Searching Authority; or

(c) an International Preliminary Examining Authority;

in relation to an international application, the amount of the fee payable to the Commissioner in accordance with the PCT in respect of a matter specified in column 2 of an item of Part 4 in Schedule 7 is the amount specified in column 3 of that item.

(2) The Commissioner must, in accordance with the PCT, determine the currency in which a fee payable under this regulation is payable and the exchange rate between Swiss currency and the currency so determined.

(3) The Commissioner must give notice of a determination in the *Official Journal*.

(4) A determination has effect on the date specified in the determination for that purpose or on the date of notification of the determination in the *Official Journal*, whichever is later.

Note: The text of the PCT is set out in Schedule 2.

PCT Fund

22.5 Money paid as a fee to the Commissioner under subregulation 22.4 (1) (“fees for international applications payable for the benefit of the International Bureau”):

- (a) must be paid into the Trust Fund kept under section 60 of the *Audit Act 1901* (“Trust Fund”); and
- (b) may be expended from the Fund for the purposes of the PCT, including the making of refunds and the remission of fees to the International Bureau.

Note: The text of the PCT is set out in Schedule 2.

Exemption from fees

22.6

(1) The Commissioner may exempt a person from the payment of the whole or any part of a fee if the Commissioner is reasonably satisfied that the action is justified, having regard to all the circumstances.

(2) If acceptance of a patent request and complete specification has been delayed because of an error or omission on the part of an employee, the period that is, in the reasonable opinion of the Commissioner, equal to the period of delay that resulted from the error or omission is not, for the purposes of ascertaining the amount of a fee, to be taken into account.

Refund of certain fees

22.7

(1) Subject to subregulation (2), if:

- (a) a complete application for a standard patent has been filed; and
 - (b) the application is withdrawn before the specification becomes open to public inspection;
- so much of the fee paid on the filing of the application as the Commissioner reasonably thinks fit may, on written application made to him or her, be refunded.

(2) If the PCT requires a fee paid to the Commissioner to be refunded in whole or in part, that fee or that part of the fee must be refunded.

(3) If:

- (a) a search fee or a preliminary examination fee is payable to an International Searching Authority or an International Preliminary Examining Authority; and
- (b) the PCT provides for the refund of the fee in whole or in part; and
- (c) that fee has been paid to the Commissioner;

he or she must determine in accordance with the PCT to what extent that fee is to be refunded to the applicant and the fee must be refunded accordingly.

Note: The text of the PCT is set out in Schedule 2.

Division 2—Costs

Proceedings to which this Division applies

22.7A This Division applies to proceedings before the Commissioner.

Costs

22.8

(1) The Commissioner must not award costs in proceedings to which this Division applies, other than costs specified in Schedule 8, unless each party to the proceedings has had the reasonable opportunity to make a submission on the matter of the award of those costs.

(2) The Commissioner may award an amount:

- (a) for costs in respect of a matter specified in column 2 of an item of Part 1 in Schedule 8; or
- (b) in respect of the expenses or allowances of a person in relation to proceedings to which this Division applies.

(3) An amount referred to in subregulation (2) must be taxed, allowed and certified, by an employee appointed by the Commissioner for that purpose, in accordance with:

- (a) the amount specified in column 3 of that item; or
- (b) Part 2 in Schedule 8;

as the case may be.

(4) A taxation is subject to review by the Commissioner.

PART 2—OTHER MATTERS

Death of applicant or nominated person

22.9 The legal representative of a deceased applicant, nominated person or patentee who wishes:

- (a) in accordance with subsection 215 (1) of the Act (“death of applicant or nominated person”) to proceed with the application; or
- (b) in accordance with subsection 215 (2) of the Act to have the patent granted to him or her; or
- (c) in accordance with subsection 215 (3) of the Act to have the patent amended by substituting for the name of the patentee the name of the person to whom the patent should have been granted;

must file the approved form and such other documents as the Commissioner reasonably considers necessary to support the request.

Address for service

22.10

(1) If provision is made in an approved form to state an address for service, the person completing the form must state an address in Australia at which a document under the Act or these Regulations may be given to him or her personally or to the person specified in the form as his or her representative.

(2) A person may file notice of a change of his or her address for service.

(3) If a notice of opposition is filed under regulation 5.3 (“filing of opposition”), a person who has filed notice under subregulation (2) must serve a copy of the notice on each person interested in the opposition proceedings.

(4) If a person serves a document on a person other than the Commissioner, the first-mentioned person must, as soon as practicable after serving the document on the other person, file a notice of the service in the approved form together with a copy of the document served.

Extension of time

22.11

(1) For the purposes of subsection 223 (2) of the Act (“extensions of time”), an application for an extension of time must be in the approved form and have with it a declaration setting out the grounds on which the application is made.

- (2) Notice of the grant of an extension of time must be published in the *Official Journal*.
- (3) For the purposes of the definition of “relevant act” in subsection 223 (11) of the Act, each of the following actions is prescribed:
 - (a) an action or step prescribed in Chapter 5 (“opposition”), not being an action or step taken under regulation 5.3 (“filing of opposition”) or paragraph 5.4 (1) (a) (“filing of statement”);
 - (b) paying a fee in a period that is extended because of subregulation 13.3 (3) (“prescribed period: continuation fees”) or subregulation 13.6 (4) (“time for payment of renewal fee for standard patent”).

Evidence

22.12

- (1) If evidence is given in writing to the Commissioner or to the Patent Attorneys Disciplinary Tribunal for the purposes of the Act or these Regulations, the evidence must be in the form of a declaration.
- (2) The Commissioner may:
 - (a) require a person who has made a declaration to appear before him or her to give evidence orally on oath in substitution for, or addition to, the evidence contained in the declaration; and
 - (b) allow the person to be cross-examined on the declaration.

Declarations

22.13

- (1) In this regulation:
“**diplomatic or consular officer**” means a person who holds or performs the duties of any of the following offices of the Commonwealth in a country other than Australia:
 - (a) ambassador;
 - (b) high commissioner;
 - (c) minister;
 - (d) charge d’affaires;
 - (e) counsellor or second or third secretary at an embassy, high commission or other post;
 - (f) consul-general;
 - (g) consul;
 - (h) vice-consul.
- (2) A declaration required by the Act or these Regulations to be given to the Commissioner must:
 - (a) be headed with the title of the matter in respect of which the declaration is made; and
 - (b) be expressed in the first person; and
 - (c) state the description and actual place of business or residential address and occupation of the declarant; and
 - (d) be divided into paragraphs, each of which must be numbered consecutively and, as far as practicable, be confined to 1 subject; and
 - (e) show the name and address of the person making the declaration and, if appropriate, the name of the person on whose behalf it is made.
- (3) A declaration may be made before:
 - (a) a magistrate; or
 - (b) a justice of the peace; or
 - (c) a commissioner for affidavits; or
 - (d) a commissioner for declarations; or
 - (e) a notary public; or
 - (f) a person before whom a statutory declaration may be made under the law of the State, Territory or foreign country where the declaration is made; or

(g) a diplomatic or consular officer.

(4) The name and title of the person before whom the declaration is made and the date when and the place where it was made must be stated in the declaration.

Directions not otherwise prescribed

22.14 If the Commissioner reasonably believes that it is necessary for the proper prosecution or completion of proceedings for a person to perform an act, file a document or produce evidence that is not provided for by the Act or these Regulations, the Commissioner may give notice to the person requiring him or her to perform the act, file the document or produce the evidence, specified in the notice.

Documents to be in English

22.15

(1) Subject to subregulation (2):

- (a) an abstract or approved form or a specification; and
- (b) another filed document, other than a document that has been translated into English and has with it a related certificate of verification;

must be in English.

(2) If, for the purposes of the PCT, the Commissioner or the Patent Office is:

- (a) a receiving Office; or
- (b) an International Searching Authority; or
- (c) an International Preliminary Examining Authority;

subject to the PCT, an international application or a demand for an international preliminary examination under Article 31 of the PCT must be filed in English.

Note: The text of the PCT is set out in Schedule 2.

Documents other than specifications and abstracts

22.16

(1) In this regulation:

“**document**” does not include a specification or an abstract.

(2) If a document received at the Patent Office does not substantially comply with Schedule 3 or is not in accordance with whichever approved form is applicable, the Commissioner may treat the document:

- (a) as not having been filed and return it to the person from whom it was received with a statement indicating how the document or form does not so comply or accord; or
- (b) as having been filed, but direct the person from whom it was received to do such things as are necessary to ensure that the document will so comply or accord.

(3) If the Commissioner returns a document under paragraph (2) (a), he or she must return with the document any other document filed with it.

(4) If the Commissioner gives a direction under paragraph (2) (b) and the person to whom the direction was given does not comply with that direction within 3 months from the day when it was given, the Commissioner must treat the document as not having been filed.

(5) Chapter 10 (“amendments”) does not apply to a document to which this regulation applies.

Incapacity of certain persons

22.17

(1) In this regulation:

“**mental dysfunction**” means a disturbance or defect, to a severely disabling degree, of perceptual interpretation, comprehension, reasoning, learning, judgment, memory, motivation, or emotion.

(2) If a person is incapable of doing anything required or permitted by the Act or these Regulations to be done because of infancy or of mental dysfunction or physical disability or disease, a court may, on the application of a person acting on behalf of the incapable person or of another person interested in the doing of the thing:

- (a) do that thing; or
- (b) appoint a person to do the thing;
in the name, and on behalf, of the incapable person.

(3) A thing done in the name of, and on behalf of, an incapable person is taken to have been done by that person as if the person had not been incapable when the thing was done.

Destruction of documents

22.18

(1) The Commissioner may order the destruction of documents relating to applications filed not less than 25 years before the date of the order.

(2) Subregulation (1) does not authorise the destruction of:

- (a) the Register; or
- (b) documents relating to patents in force; or
- (c) documents considered by the Commissioner, or the Director-General of the Australian Archives, to be of legal or historical interest.

Copies of certain documents to be supplied

22.19 A copy of a document that:

- (a) affects the ownership of a patent or licence; and
- (b) has been witnessed;

must be filed by a person who seeks to have the Commissioner consider the document for the purposes of the Act or these Regulations.

International applications and the Patent Office

22.20 If, for the purposes of the PCT, the Patent Office is:

- (a) a receiving Office; or
- (b) an International Searching Authority; or
- (c) an International Preliminary Examining Authority;

the Commissioner and the Patent Office may perform the functions under the PCT of a receiving Office, an International Searching Authority or an International Preliminary Examining Authority, as the case requires, in relation to an international application.

Note: The text of the PCT is set out in Schedule 2.

Protection or compensation of certain persons

22.21

(1) The following provisions of this regulation are prescribed for the purposes of subsections 41 (4) (“specifications: micro-organisms”), 150 (4) (“restoration of lapsed application”) and 223 (9) (“extensions of time”) of the Act.

(2) Persons who availed themselves of or exploited, or took definite steps by contract or otherwise to avail themselves of or exploit, inventions:

- (a) in the case of inventions to which subsection 41 (4) of the Act applies—in the period mentioned in paragraph 41 (4) (c) of the Act; and
- (b) in the case of inventions to which subsection 150 (4) of the Act applies—after the lapse of the applications and before the day on which their restoration was notified in the *Official Journal*; and
- (c) in the case of inventions to which subsection 223 (9) of the Act applies—within the period of time extended under that subsection;

may apply, in the approved form, to the Commissioner for the grant of licences to exploit the inventions.

(3) An applicant for a licence must serve a copy of the application on a person whose application or patent:

- (a) was so restored; or
 - (b) is referred to in subsection 41 (4) of the Act;
- and to such other persons as the Commissioner reasonably directs.

(4) A person on whom a copy of an application has been served may oppose the grant of the licence.

(5) The Commissioner, if reasonably satisfied that the application should be granted, must grant a licence to the applicant on such terms as the Commissioner thinks reasonable.

Exercise by Commissioner of certain powers

22.22

(1) The Commissioner must, before exercising a discretionary power under the Act or these Regulations adversely to a person, give the person at least 10 days notice of the time when, and the place where, that person may be heard in relation to the exercise of the power.

- (2) The Commissioner may exercise that power, if the person:
- (a) informs the Commissioner that he or she does not wish to be heard; or
 - (b) does not attend the hearing; or
 - (c) being an applicant or patentee, requests the Commissioner to exercise the power of the Commissioner without the applicant or patentee being heard.
- (3) A request:
- (a) must be in the approved form; and
 - (b) may be accompanied by written submissions.
- (4) The Commissioner must, after hearing the person, notify him or her of the decision.

Hearings

22.23

(1) The Commissioner must give notice of the date, time and place of a hearing before him or her to each party to the hearing at least 10 days before the day when the hearing is to begin.

(2) The Commissioner may adjourn a hearing from time to time or from place to place by notifying the parties to the hearing accordingly.

- (3) The Commissioner may hold a hearing:
- (a) at which the parties appear before him or her in person; or
 - (b) in which a party participates by telephone or such other means of telecommunication as the Commissioner reasonably allows.

(4) If a party to a hearing does not intend to appear at the hearing, the party may make a submission in writing to the Commissioner before the hearing begins to which the Commissioner must have regard in reaching his or her decision on the matter being heard as if:

- (a) the party were present or otherwise participating in the hearing; and
 - (b) the matter of the submission were presented by the party in the presence of the Commissioner.
- (5) The Commissioner must, after hearing the person, notify him or her of the decision.

Practice and procedure other than for opposition proceedings

22.24

(1) Subject to these Regulations:

- (a) if the Act or these Regulations authorise the Commissioner to hear and decide an application or matter that is not an opposition; or
 - (b) in a matter being decided on the motion of the Commissioner;
- the practice and procedure to be followed for the purposes of enabling the application or matter to be decided is to be determined by him or her.

(2) A person to be heard at a hearing may apply to the Commissioner in respect of the practice and procedure in relation to the hearing to be determined by the Commissioner.

Requirements cannot be complied with for reasonable cause

22.25 If, under these Regulations, a person is required to:

- (a) sign a document, make a declaration or file or give the Commissioner a document or evidence; and
- (b) the Commissioner is reasonably satisfied that the person cannot comply with the requirement; the Commissioner may, subject to such conditions as he or she reasonably directs, dispense with the requirement.

Review of decisions

22.26

(1) In this regulation:

“**decision**” has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

(2) Application may be made to the Tribunal for review of a decision of:

- (a) the Commissioner under the following provisions:
 - (i) paragraph 3.24 (1) (b) (“Commissioner may request samples and viability statement”);
 - (ii) subregulation 3.25 (2) (“request for Commissioner’s certificate authorising release of sample of a microorganism”);
 - (iii) subregulation 5.5 (3) (“dismissal of opposition”);
 - (iv) subregulation 5.6 (3) (“determination of opposition”);
 - (v) subparagraph 6.2 (1) (b) (ii) (“prescribed period: grant of standard patent”);
 - (vi) subregulation 22.21 (5) (“protection or compensation of certain persons”);
- (b) the Patent Attorneys Professional Standards Board under subregulation 20.21 (7) (“authorisation to bring proceedings against a patent attorney”); or
- (c) the Patent Attorneys Disciplinary Tribunal under subregulation 20.23 (2), (4) or (5) (“decision of Disciplinary Tribunal”).

(3) If the Commissioner gives a person affected by a decision referred to in subregulation (2) written notice of the making of the decision, the notice must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Tribunal for review of that decision by or on behalf of the person whose interests are affected by it.

(4) Failure to comply with subregulation (3) in relation to a decision does not affect the validity of the decision.

(5) If the Tribunal reviews a decision of the Commissioner under subsection 224 (1) of the Act (“review of decisions”) and the decision is not affirmed, the Commissioner must publish a notice of the decision of the Tribunal in the *Official Journal*.

CHAPTER 23—TRANSITIONAL AND SAVINGS PROVISIONS

Saving: prohibition orders

23.1 Subsection 4 (2) of the 1952 Act continues in force.

Delegation: certain matters referred to in this Chapter

23.2 Section 11 of the 1952 Act continues on and after the commencing day in respect of the exercise by the Commissioner of his or her powers and functions in relation to the operation of:

- (a) subsection 234 (3) of the Act (“applications under 1952 Act”); or
- (b) a following provision of this Chapter.

Opposition to grant: practice and procedure

23.3

(1) Division 1 of Part XIV and regulations 82 and 83A of the former patents Regulations continue to apply in relation to opposition to the grant of a standard patent on an application:

- (a) to which subsection 234 (3) of the Act (“applications under 1952 Act”) refers; and
- (b) acceptance of which has been advertised under the 1952 Act.

(2) Chapter 5 of these Regulations (“opposition”) does not apply to opposition to an application to which subregulation (1) applies.

Certain opposition: practice and procedure

23.4

(1) If, before the commencing day:

- (a) a matter is advertised in the *Official Journal*; or
- (b) a document is served on a person;

to enable opposition proceedings to be taken, other than in relation to the grant of a standard patent:

(c) the following provisions of the 1952 Act continue to apply:

- (i) sections 82, 83, 84 and 85;
- (ii) subsections 106 (5) and (6); and

(d) the following provisions of the former patents Regulations continue to apply:

- (i) regulations 36, 39B, 39C, 39D, 48, 49, 50, 51, 52, 82, 83A and 92;
- (ii) Divisions 1 and 2 of Part XIV.

(2) If provisions specified in subregulation (1) continue to apply:

- (a) sections 74 (“opposition to extension”), 104 (“amendments by applicants and patentees”) and 223 (“extensions of time”) of the Act; and
- (b) Chapter 5 (“opposition”) and regulations 22.21 (“protection or compensation of certain persons”), 22.22 (“exercise by Commissioner of certain powers”) and 22.23 (“hearings”) of these Regulations;

do not apply to the opposition referred to in that subregulation.

Fees payable for certain matters relating to opposition

23.5 The fee payable in respect of opposition proceedings of the kind mentioned in regulation 23.3 (“opposition to grant: practice and procedure”) or 23.4 (“certain opposition: practice and procedure”) is the fee that would have been payable if these Regulations applied to those proceedings.

Certain delegations: opposition

23.6 The delegation of a person who, before the commencing day, was:

- (a) the delegate of the Commissioner under the 1952 Act; and
- (b) exercising the powers of the Commissioner in relation to a matter to which regulation 23.3 (“opposition to grant: practice and procedure”) or 23.4 (“certain opposition: practice and procedure”) applies;

continues in relation to the matter.

Certain undertakings

23.7 If an undertaking referred to in paragraph 3.25 (4) (c) (“request for Commissioner’s certificate authorising release of sample of a micro-organism”) is given in respect of an application lodged under the 1952 Act, the reference to Chapter 5 of the Act (“opposition”) in subparagraph 3.25 (4) (c) (i) includes a reference to Part V of the 1952 Act.

Restoration of lapsed applications or ceased patents

23.8

(1) If, before the commencing day:

- (a) an application lapses under:
 - (i) section 47C or 47D of the 1952 Act; or
 - (ii) subregulation 7B (4) or (5) of the former patents Regulations; or
- (b) a patent ceases because of failure to pay a prescribed fee within the prescribed time; and an application is made for the restoration of the lapsed application or ceased patent, as the case may be, under:

(c) subsection 47E (2) or 97 (1) of the 1952 Act; or

(d) subregulation 7B (6) of the former patents Regulations;

section 47E, subsection 97 (2) or (3) or section 98 of the 1952 Act or the prescribed provisions of the former patents Regulations, as the case requires, continues to apply in relation to that lapsed application or ceased patent and the corresponding provisions of the Act and these Regulations do not so apply.

(2) There is payable to the Commissioner in respect of a lapsed application or ceased patent to which subregulation (1) applies a fee of the amount specified in column 3 of item 8 of Part 1 in Schedule 2 to the former patents Regulations.

(3) In subregulation (1), “**prescribed regulations**” means:

- (a) regulations 16D, 16E, 16F, 41, 42, 43, 44, 82, 83A, 92; or
- (b) Division 1 of Part XIV.

Certain continuation and renewal fees

23.9

(1) If, before the commencing day:

- (a) the second year after lodgment of a complete specification ends; and
- (b) the continuation fee prescribed in respect of that year in relation to the specification is payable but has not been paid;

item 8 of Part 2 in Schedule 7 is taken to include a fee of \$75 in respect of the second anniversary.

(2) If, before the commencing day:

- (a) the second year of a patent ends; and
- (b) the renewal fee prescribed in respect of that year in relation to the patent is payable but has not been paid;

item 8 of Part 2 in Schedule 7 is taken to include a fee of \$75 in respect of the second anniversary.

Fee taken to have been paid

23.10 If:

- (a) in respect of the lodging of an application for an extension of time, a fee specified in item 27 of Part 1 in Schedule 2 to the former patents Regulations is paid in respect of a period referred to in section 54 (1B) of the 1952 Act; and
- (b) the application has not been accepted before the commencing day; and
- (c) the applicant is required to pay the fee specified in item 32 of Part 2 in Schedule 7 to these Regulations in relation to the application;

the fee under item 32 is taken to have been paid in respect of the period referred to in paragraph (a).

Supply of product referred to in section 117 of the Act

23.11

(1) If:

- (a) a product to which section 117 of the Act (“infringement by supply of products”) applies is supplied by a person to another person before the commencing day; and
- (b) the supply would not have infringed a patent under the 1952 Act before the commencing day; and
- (c) the first-mentioned person supplies the product to another person after the commencing day; section 117 of the Act does not apply to the supply referred to in paragraph (c).

(2) In subregulation (1), a reference to the first-mentioned person includes:

- (a) on the death of the person—the legal personal representative of the estate of the person who has died; or
- (b) if the person becomes bankrupt—the person who becomes, under the *Bankruptcy Act 1966*, the trustee in bankruptcy of the estate of the first-mentioned person; or
- (c) if a body corporate is being wound up—the person appointed to be the liquidator of the body corporate; or
- (d) if the person agrees to dispose of a business relating to the supply of the product—the person who acquires that business.

Certain withdrawn, abandoned or refused applications

23.12

(1) On and after the commencing day, section 142AA of the 1952 Act continues to apply to an application referred to in subsection 234 (2) of the Act (“applications under 1952 Act”).

(2) Section 96 of the Act (“withdrawn, abandoned or refused applications”) does not apply to an application to which subregulation (1) applies.

Certain certificates of validity

23.13 If:

- (a) a court certifies under section 169 of the 1952 Act in relation to the validity of a patent or of a claim; and
 - (b) the validity of the patent or claim is disputed on or after the commencing day;
- the certificate referred to in paragraph (a) is taken to have been issued under subsection 19 (1) of the Act (“certificate of validity”).

Certain action under the 1952 Act

23.14 If:

- (a) a provision of the Act requires an act to be done under that or another particular provision of the Act; and
 - (b) the act was done under a corresponding provision of the 1952 Act;
- that act is taken to have been done under the provision of this Act referred to in paragraph (a).

Amendment of petty patents

23.15 The complete specification of a petty patent granted under section 62A of the 1952 Act cannot be amended under the Act so as to include more than 1 claim.

Certain applications under 1952 Act: time for acceptance

23.16

(1) This regulation applies to an invention referred to in paragraph 45 (1) (b) (“examination”) or 48 (1) (a) (“modified examination”) of the Act that is, so far as claimed in any claim, the subject of:

- (a) a claim of the complete specification in relation to an application for a standard patent referred to in subparagraph 48 (3) (a) (i) of the 1952 Act; or
- (b) the claim of the complete specification in relation to an application for a petty patent referred to in subparagraph 48 (3) (a) (ii) of the 1952 Act;

the priority date of which is earlier than the priority date of the first-mentioned claim.

(2) If, under paragraph 45 (1) (b) or 48 (1) (a) of the Act, the Commissioner reports that the first-mentioned claim in subregulation (1) is a claim the priority date of which is later than the priority date of the claim referred to in paragraph (1) (a) or (b), he or she may defer acceptance of the application and complete specification until the end of 3 months after:

- (a) the date on which a patent was sealed on the application referred to in paragraph (1) (a) or (b); or
- (b) the date on which that application lapsed or was withdrawn or refused.

PCT applications to which subsection 89 (5) of the Act does not apply

23.17 Subsection 89 (5) of the Act (“modified application of Act”) does not apply to an application:

- (a) to which subsection 234 (2) of the Act (“applications under 1952 Act”) applies; and
- (b) that is a PCT application in respect of which Australia has been elected under Chapter II of the PCT within the period specified in Article 39 of the PCT; and

- (c) in respect of which a filed Preliminary Examination Report made under the PCT reports that an amendment to the application goes beyond the disclosure in the relevant international application that has been filed.

Note: The text of the PCT is set out in Schedule 2.

Certain priority dates: saving

23.18 In the case of a claim of a specification:

- (a) relating to a further application for a standard patent or for a petty patent under section 51 of the 1952 Act in respect of an invention disclosed in a provisional specification under that Act; or
- (b) to which subsections 45 (2), (3), (3A) and (4A) of the 1952 Act apply; or
- (c) to which subsection 191 (8) of the *Statute Law (Miscellaneous Amendments) Act (No. 1) 1982* applies;

the priority date is determined under section 45 of the 1952 Act or subsection 191 (8) of the *Statute Law (Miscellaneous Amendments) Act (No. 1) 1982*, as the case requires.

Appointment of certain examiners

23.19 A person appointed under subregulation 16 (1) of the former attorneys Regulations as an examiner is taken to have been appointed under subregulation paragraph 20.6 (2) of these Regulations (“examination to be conducted”) as an examiner.

Patent attorneys: continued application of certain provisions

23.20

(1) In this regulation:

“**prescribed person**”, in relation to a person who has, before the commencing day:

- (a) passed the examination in a subject specified in subregulation 10 (2) of the former attorneys Regulations—that person; or
- (b) been issued with a certificate of under regulation 20A or 22 of the former attorneys Regulations—that person; or
- (c) met the requirements of regulation 21 of the former attorneys Regulations—that person.

(2) Despite the repeal of the former attorneys Regulations, regulation 18 of the Patent Attorneys Regulations (Amendment), being Statutory Rules 1989 No. 25, continues to apply to persons referred to in that regulation.

(3) Regulation 15 of the former attorneys Regulations continues to apply to a person who is a prescribed person as if the reference to having passed the examination in a subject included a reference to being exempted under subregulation 10A (1) of those Regulations from having to pass the examination in that subject.

(4) Regulations 20A and 22 of the former attorneys Regulations continue to apply to a prescribed person as if the reference to a certificate in those regulations were a reference to the certificates referred to in regulation 20.15 and 20.16.

(5) If a prescribed person was employed continuously on or after 1 May 1989 and before the commencing day for not less than 1 year, or for periods within a continuous period of 2 years together that total not less than 1 year, by a patent attorney as a technical assistant in the conduct of the practice of a patent attorney, the prescribed person is taken to have been employed for the prescribed period of employment for the purposes of paragraph 20.3 (d) (“requirements for registration”) of these Regulations.

Patent Attorneys Professional Standards Board: continuation of appointments

23.21

(1) A person elected under paragraph 5 (1) (b) of the former attorneys Regulations as a member of the Patent Attorneys Professional Standards Board established under those Regulations is taken to have been elected under paragraph 20.32 (2) (b) of these Regulations (“establishment of Board”) as a member of the Patent Attorneys Professional Standards Board established under these Regulations.

(2) A person appointed under paragraph 5 (1) (c) of the former attorneys Regulations as a member of the Patent Attorneys Professional Standards Board established under those Regulations is taken to have been appointed under paragraph 20.32 (2) (c) of these Regulations as a member of the Patent Attorneys Professional Standards Board established under these Regulations.

(3) A member referred to in subregulation (1) or (2) holds office as a member of the Patent Attorneys Professional Standards Board under these Regulations for the period that is, immediately before the commencing day, the remainder of the period of his or her office as a member of the Patent Attorneys Professional Standards Board under the former attorneys Regulations.

Secretary to Patent Attorneys Professional Standards Board: continuation of appointment

23.22 The person appointed to be the Secretary to the Patent Attorneys Professional Standards Board under subregulation 9 (1) of the former attorneys Regulations is taken to have been appointed to be the Secretary to the Patent Attorneys Professional Standards Board under subregulation 20.40 (1) of these Regulations (“Secretary to Board”).

Patent Attorneys Disciplinary Tribunal: continuation

23.23 The person constituting the Patent Attorneys Disciplinary Tribunal under subregulation 26 (1) of the former attorneys Regulations is taken to constitute the Patent Attorneys Disciplinary Tribunal under subregulation 20.42 (1) of these Regulations (“Disciplinary Tribunal: substantive appointments”).

Matters begun under the former attorneys Regulations not finally dealt with before the commencing day

23.24 These Regulations apply on and after the commencing day to a matter that was not finally dealt with before that day under the former attorneys Regulations as if the matter had started under a corresponding provision of these Regulations.

Fees

23.25

(1) In this regulation:

“**continuation fee**” means a continuation fee for the purposes of section 47D of the 1952 Act;

“**renewal fee**” means a renewal fee for the purposes of subsection 68 (2) of that Act.

(2) Subregulation 22.2 (1) (“general fees”) does not apply in respect of:

- (a) a continuation fee in respect of a year; or
- (b) a renewal fee in respect of a year of a patent;

that ends on or after the commencing day, if the fee became payable, and was paid, before that day.

Certain actions and proceedings

23.26

(1) The 1952 Act applies to an action or proceeding made or started under that Act and not finally dealt with or determined before the commencing day:



- (a) in which the validity of a patent is disputed: or
- (b) concerning infringement of a patent.
- (2) The 1952 Act applies to an action or proceeding in which the validity of a patent granted under the *Patents Act 1990* on an application made under the 1952 Act is disputed.



Subregulation 1.4(1)

SCHEDULE 1
Budapest Treaty on the International Recognition of the Deposit of
Microorganisms for the purposes of Patent Procedure

[not reproduced here]

Subregulation 1.4(2)

SCHEDULE 2
PATENT COOPERATION TREATY

[not reproduced here] Paragraphs 3.2 (2) (b) and 10.2 (1) (a) and subregulation 22.16 (2)

SCHEDULE 3 FORMAL REQUIREMENTS FOR DOCUMENTS TO BE FILED

Terminology and signs

1. In a document:

- (a) units of description must be expressed in terms of the metric system or, if first expressed in other terms, must be expressed also in terms of that system; and
- (b) temperatures must be expressed in degrees Celsius or, if first expressed in another manner, must be expressed also in degrees Celsius; and
- (c) to indicate units of measurement, the rules of international practice must be observed; and
- (d) in chemical formulas, the symbols, atomic weights and molecular formulas in general use must be employed; and
- (e) other terms, signs and symbols that are generally accepted in the art to which the document principally relates must be employed; and
- (f) if the document is expressed in English—the beginning of any decimal fraction must be marked by a period; and
- (g) units, signs, symbols and other terms must be used consistently.

Fitness for reproduction

2. Each sheet comprising a document or part of a document:

- (a) must be presented in a manner that allows any number of copies of the sheet to be reproduced directly by means of photography, an electrostatic or photo-offset process and microfilming; and
- (b) must not be folded, creased or cracked; and
- (c) subject to subclause 8 (4) (“drawings, formulas and tables in textual matter”) and subclause 11 (14) (“special requirements for drawings”), must be presented in a vertical format; and
- (d) must be durable, flexible, smooth, strong, white and have a matt finish; and
- (e) must be international sheet size A4.

Separate sheets

3.—

(1) The patent request, the description of the invention, the claim or claims, any drawing, and an abstract, must each commence on a separate sheet.

(2) The sheets comprising a document must be connected so that they may be readily:

- (a) turned to be read; and
- (b) separated for the purposes of reproduction and then rejoined.

Margins

4.—

(1) Subject to subclause (2), each sheet of a specification, or an abstract, must have a margin that is not less than:

- (a) at the top—2 cm; and

- (b) on the left—2.5 cm; and
 - (c) on the right—2 cm; and
 - (d) at the bottom—2 cm.
- (2) A sheet of drawings:
- (a) must have a margin that is not less than:
 - (i) at the top—2.5 cm; and
 - (ii) on the left—2.5 cm; and
 - (iii) on the right—1.5 cm; and
 - (iv) at the bottom—1 cm; and
 - (b) must not contain a frame surrounding the drawings.

Numeration

5.—

(1) The parts of a patent application referred to in this subclause must be presented in the following order:

- (a) patent request;
- (b) description of the invention;
- (c) claim or claims;
- (d) drawing or drawings;
- (e) abstract.

(2) Subject to subclause (3), the sheets of a specification must be numbered consecutively in arabic numerals beginning with “1” that are placed at the top, and in the middle, of the sheet, but not within the margins of the sheet.

(3) The sheets of a specification that contain drawings must be numbered by means of sets of 2 arabic numerals separated by an oblique stroke, the first numeral in each set being the consecutive number of each sheet, beginning with the arabic number “1”, and the second being the total number of the sheets containing the drawings.

(4) If there is more than 1 claim referred to in a complete specification, the claims must be numbered consecutively in arabic numerals beginning with “1”.

Numbering of lines

6. Every fifth line on each sheet of the specification must be numbered:

- (a) in arabic numerals; and
- (b) on the left of the sheet to the right of the margin.

Writing of textual matter

7.—

(1) Subject to subclause (2), except with the consent of the Commissioner, a patent request, specification and any abstract relating to a patent application must be typewritten or printed.

(2) If necessary, symbols relating to graphic matter, or chemical or mathematical formulas, may be handwritten or drawn, as the case may be.

(3) The lines of text in a typewritten document must be 1½ spaced or double spaced.

(4) The text in a document must be presented in letters the capitals of which are not less than 0.21 cm high, in a dark colour and be indelible.

Drawings, formulas and tables in textual matter

8.–

- (1) A patent request must not include a drawing.
- (2) The description of an invention or an abstract:
 - (a) must not include a drawing; and
 - (b) may include chemical or mathematical formulas or tables.
- (3) A claim:
 - (a) must not include a drawing; and
 - (b) may include chemical or mathematical formulas; and
 - (c) if, in the reasonable opinion of the Commissioner, the subject matter of the claim makes the use of a table desirable—may include tables.
- (4) A table or a chemical or mathematical formula may be presented in a horizontal format if it cannot be presented in a vertical format in a satisfactory manner.
- (5) If a table or a chemical or mathematical formula is presented in a horizontal format, the top of the table or formula must be placed on the left side of the paper.

Words in drawings

9. A drawing must not include text, other than a word or words indispensable to the understanding of the drawing.

Alterations

10.–

- (1) Subject to subclause (2), document must be free from erasures, alterations, overwritings and interlineations.
- (2) If, in the reasonable opinion of the Commissioner, failure to comply with subclause (1) would not:
 - (a) compromise the authenticity; or
 - (b) jeopardise the likelihood of clear reproduction;of a document, the Commissioner may excuse it from compliance with subclause (1).

Special requirements for drawings

11.–

- (1) A drawing must be executed in durable, black, dense, dark, uniformly thick and well-defined, lines and strokes without colouring.
- (2) A cross-section must be indicated by oblique hatching that does not impede the clear reading of reference letters, numbers or signs and leading lines.
- (3) The scale of a drawing and the distinctness of its execution must enable all the details to be distinguished without difficulty on a photographic reproduction of the drawing with a two-thirds linear reduction in size.
- (4) If the scale of a drawing is given on the drawing, it must be represented graphically.
- (5) A letter, number or reference line that is shown on a drawing must be presented simply and be clear.
- (6) Brackets, braces, circles or inverted commas must not be used in association with letters or numbers.
- (7) A line in a drawing must ordinarily be drawn with the aid of drafting instruments.
- (8) A sheet of drawings may include more than 1 drawing.



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- (9) Each element of a drawing must be shown in proper proportion to each other element of the drawing, other than where the use of a different proportion is indispensable for the clarity of the drawing.
- (10) The height of a letter or a number in a drawing must not be less than 0.32 cm.
- (11) For the lettering of a drawing, the Latin or, if customary, the Greek alphabet must be used.
- (12) If drawings on 2 or more sheets of drawings form in effect a single drawing, the drawings must be so arranged that the single drawing can be assembled without concealing any part of the other drawings.
- (13) Subject to subclause (14), if there is more than 1 drawing on a sheet of drawings, the drawings must be presented on the sheet of drawings in a vertical format and separate from each other.
- (14) If the drawings on a sheet of drawings cannot be presented in a vertical format, they must be presented in a horizontal format with the tops of the drawings on the left of the sheet of drawings.
- (15) The drawings must be numbered consecutively in arabic numerals beginning with "1".
- (16) A reference sign that is not mentioned in the description of the invention must not be referred to in a drawing.
- (17) A reference sign that is not mentioned in a drawing must not be referred to in the description.
- (18) A feature of a drawing that is denoted by a reference sign must be so denoted consistently.



SCHEDULE 4

CONVENTION COUNTRIES

PART 1

CONVENTION COUNTRIES THAT ARE PRESCRIBED FOREIGN COUNTRIES

Algeria
Argentina
Austria
Bahamas
Bangladesh
Barbados
Belarus
Belgium
Benin
Bolivia
Brazil
Bulgaria
Burkina Faso
Burundi
Cameroon
Canada
Central African Republic
Chad
Chile
China
Congo
Cote d'Ivoire
Croatia
Cuba
Cyprus
Czech Republic
Denmark (including Faroe Islands)
Dominican Republic
Egypt
Finland
France (including all Overseas Departments and Territories)
Gabon
Gambia
Germany
Ghana
Greece
Guinea
Guinea-Bissau
Haiti
Holy See
Hungary
Iceland
Indonesia
Iran, Islamic Republic of
Iraq
Ireland



Israel
Italy
Japan
Jordan
Kazakhstan
Kenya
Korea, Democratic People's Republic of
Korea, Republic of
Latvia
Lebanon
Lesotho
Libyan Arab Jamahiriya
Liechtenstein
Luxembourg
Madagascar
Malawi
Malaysia
Mali
Malta
Mauritania
Mauritius
Mexico
Moldova
Monaco
Mongolia
Morocco
Netherlands (including the Netherlands Antilles and Aruba)
New Zealand (excluding the Cook Islands, Niue and Tokelau)
Niger
Nigeria
Norway
Philippines
Poland
Portugal
Romania
Russian Federation
Rwanda
San Marino
Senegal
Slovak Republic
Slovenia
South Africa
Spain
Sri Lanka
Sudan
Suriname
Swaziland
Sweden
Switzerland
Syrian Arab Republic
Togo
Trinidad and Tobago
Tunisia
Turkey
Uganda
Ukraine
United Kingdom (including Hong Kong and the Isle of Man)
United Republic of Tanzania



United States of America (including all territories and possessions, including the Commonwealth of Puerto Rico)
Uruguay
Uzbekistan
Viet Nam
Yugoslavia
Zaire
Zambia
Zimbabwe

**PART 2 CONVENTION COUNTRIES THAT ARE NOT PRESCRIBED
FOREIGN COUNTRIES**

India



Regulations 20.3, 20.6, 20.8, 20.9 and 20.16

SCHEDULE 5

PRESCRIBED SUBJECTS

Column 1 Item	Column 2 Subject
1	Legal Process
2	Patent Law of Australia and the Practice of the Patent Office
3	Trade Marks Law of Australia and the Practice of the Trade Marks Office
4	Designs Law and Related Intellectual Property Laws of Australia and the Practice of the Designs Office
5	Preparation of Specifications
6	Interpretation and Criticism of Specifications
7	Patent, Trade Marks and Designs Law and Practice of Countries other than Australia
8	Patent Attorneys' Practice

<R level=Note>

Regulations 20.3, 20.14, 20.15 and 20.16

SCHEDULE 6

PRESCRIBED QUALIFICATIONS

Column 1 Item	Column 2 Qualification
1	A degree, diploma or post-graduate diploma of an Australian tertiary institution in a course approved under subregulation 20.14 (1) in a branch of engineering or science
2	An award of an overseas education institution in a course approved under subregulation 20.14 (1) in a branch of engineering or science
3	A pass in an examination in a branch of engineering or science approved under subregulation 20.14 (3) that qualifies for corporate membership of The Institution of Engineers, Australia, The Royal Australian Chemical Institute or another professional institution approved under subregulation 20.14 (5)



SCHEDULE 7 FEES

PART 1—PATENT ATTORNEYS

Column 1 Item	Column 2 Matter	Column 3 Fee \$
1	On making an application for admission to sit for an examination—per subject	50
2	On making an application for grant of a supplementary examination—per subject	55
3	On making an application for a report of reasons for failure—per subject	45
4	On making an application for a certificate of the Board under regulation 20.16	40
5	On making an application for registration as a patent attorney	200
6	Annual registration fee payable by a patent attorney	320
7	On making an application under regulation 20.19	160

PART 2—GENERAL FEES

Column 1 Item	Column 2 Matter	Column 3 Fee \$
1	On filing a request for a patent accompanied by a provisional specification	\$80
2	On filing a request for a petty patent accompanied by a complete specification	\$165
3	On filing a request for a standard patent accompanied by a complete specification:	
	(a) filing; and	\$195
	(b) if the number of sheets comprising the specification, including any drawings contained in the specification, exceeds 30—for each sheet in excess of 30; and	\$14
	(c) if the number of claims exceeds 10—for each claim in excess of 10	\$8
4	On filing a request for an examination of a patent request and complete specification:	
	(a) if the request was not preceded by a direction of the Commissioner under subsection 44 (2) or (4) of the Act:	
	(i) in the case of a request for an examination to be made in accordance with section 45 of the Act	\$390
	(ii) in the case of a request for a modified examination	\$325
	(b) if the request was preceded by a direction of the Commissioner under subsection 44 (2) or (4) of the Act (whether or not the applicant had, before the request was made, requested deferment of the examination under section 46 of the Act):	
	(i) in the case of a request for an examination to be made in accordance with section 45 of the Act	\$335
	(ii) in the case of a request for a modified examination	\$280
5	On filing a request under subsection 44 (3) of the Act requiring the Commissioner to direct an applicant to request examination	\$90



Column 1 Item	Column 2 Matter	Column 3 Fee\$
6	On filing a copy of the specification referred to in subregulation 3.20 (6): (a) if filed between 1 month and 2 months after filing of the request for modified examination (b) if filed after 2 months after filing of the request for modified examination	\$50 \$160
7	On filing a request under subsection 97 (2) of the Act for re-examination of a complete specification	\$1050
8	Continuation fee under paragraph 142 (2) (d) of the Act, or renewal fee under paragraph 143 (a) of the Act, for: (a) the third anniversary (b) the fourth anniversary (c) the fifth anniversary (d) the sixth anniversary (e) the seventh anniversary (f) the eighth anniversary (g) the ninth anniversary (h) the tenth anniversary (i) the eleventh anniversary (j) the twelfth anniversary (k) the thirteenth anniversary (l) the fourteenth anniversary (m) the fifteenth anniversary plus: if paid within 6 months after the anniversary	\$115 \$140 \$165 \$200 \$235 \$270 \$305 \$345 \$385 \$430 \$475 \$525 \$575 \$55 for each month, or part of a month, in the period between the anniversary and the day when the fee is paid
9	Renewal fee under paragraph 143 (a) of the Act, if an extension of the term of a standard patent has been granted under subsection 75 (2) or (4) of the Act, for: (a) the sixteenth anniversary (b) the seventeenth anniversary (c) the eighteenth anniversary (d) the nineteenth anniversary plus: if paid within 6 months after the anniversary	\$630 \$680 \$730 \$790 \$55 for each month, or part of a month, in the period between the anniversary and the day when the fee is paid
10	On filing a notice of opposition under regulation 5.3	\$100
11	On filing a request under subregulation 5.5 (1) for dismissal of opposition	\$50
12	On filing an application under subregulation 5.10 (2) for an extension of time, for each month, or part of a month, for which the extension is sought	\$55
13	On filing an application under subregulation 5.10 (4) to lodge further evidence in opposition proceedings	\$75



Column 1 Item	Column 2 Matter	Column 3 Fee\$
14	On making a representation to the Commissioner: (a) under subregulation 5.9 (3) objecting to a proposed amendment; or (b) under subparagraph 5.10 (5) (c) (i) objecting to an application or proposed action.	\$100 \$100
15	For sealing a standard patent under section 61 of the Act	\$260
16	On filing an application for the grant of an extension of the term of a petty patent under section 69 of the Act	\$350
17	On filing an application under section 70 of the Act for the extension of the term of a patent relating to a pharmaceutical substance	\$685
18	On filing an application under section 66 of the Act for a duplicate of a patent to be sealed	\$50
19	On filing a request for leave to amend: (a) a complete specification under section 104 of the Act, before a request for examination has been filed or after the complete specification has been accepted; or (b) a patent request for a petty patent to make it a patent request for a standard patent	\$100 \$100
20	On filing a request for leave to amend a patent request or another filed document under section 104 of the Act (other than a request for change of address or a request to which the fee under paragraph (b) of item 19 applies) before a request for examination has been filed or after the patent request has been accepted	\$50
21	On filing: (a) a request to amend a patent or an entry in the Register under subregulation 10.7 (1), other than: (i) a request for a change of address; or (ii) a request to which the fee under paragraph (b) applies (b) simultaneously, 2 or more requests under subregulation 10.7 (1), each of which is to make the same amendment to the name entered in the Register	\$55 \$55, plus \$25 for each request after the first
22	On filing: (a) a request under subregulation 19.1 (2) for registration of particulars referred to in paragraph 19.1 (1) (a) or (b) other than a request to which the fee under paragraph (b) applies (b) simultaneously, 2 or more requests under subregulation 19.1 (2), if the devolution of title or interest is the same in respect of all the patents to which the requests relate	\$50 \$50, plus \$25 for each request after the first
23	On filing a request under subsection 17 (1) or (2), section 46, subsection 49 (3), 54 (1), 82 (1), 92 (1) or 113 (1) or section 215 of the Act	\$50
24	On filing a document or documents referred to in subregulation 8.6 (2), more than 3 months after filing the application: (a) if filed before or at the time of filing a request for examination (b) if filed after filing a request for examination	\$50 \$160
25	On filing any translation or translations referred to in paragraph 3.1 (3) (b), more than 3 months after complying with the requirements of subsection 89 (3) of the Act: (a) if filed before or at the time of filing a request for examination (b) if filed after filing a request for examination	\$50 \$160



Column 1 Item	Column 2 Matter	Column 3 Fee\$
26	On filing a request under subsection 150 (1) of the Act to restore a lapsed application	\$90
27	On filing an application under subsection 223 (2) of the Act for an extension of time on a ground specified in paragraph 223 (2) (a) of the Act: (a) for each month, or part of a month, for which the application is made; and (b) if the application is filed after the end of the time to be extended	\$55 \$85
28	For granting an extension of time, on a ground specified in paragraph 223 (2) (a) of the Act, greater than that applied for by the applicant—for each month, or part of a month, of extension granted	\$55 less any amount paid under paragraph (a) of item 27
29	On filing an application under subsection 223 (2) of the Act for an extension of time on the ground specified in paragraph 223 (2) (b) of the Act	\$55
30	On filing: (a) a request under regulation 22.22 for the exercise of discretionary power; or (b) a request for a hearing	\$100 \$100
31	On appearing at a hearing	\$100 less any amount paid under item 30 in relation to the hearing
32	On filing a response to the Commissioner's report under section 45 or 48 of the Act, if filed more than 12 months, but within 21 months, after the date of the first report on the examination—for each month, or part of a month, after the 12 months, other than a month in respect of which a fee has been paid under this item in relation to that examination	\$55
33	For supply of an uncertified copy of: (a) a patent specification; or (b) a document other than a patent specification; or (c) if more than 6 documents of the kind mentioned in paragraph (b) are sought from a single source and supplied at the same time	\$15 \$10 \$60 plus 30 cents per page for each document in excess of 6 documents
34	For supply of: (a) a certificate by the Commissioner; and (b) for each additional certificate that is the same, and supplied at the same time, as the first certificate	\$75 \$55
35	On filing a request for information under subregulation 19.2 (1), other than a request referred to in item 36 or 37—for each application, patent or document	\$50
36	On filing a request for a computer print-out of information under subregulation 19.2 (1) about a patent or a patent application	\$10
37	On filing a request under subregulation 19.2 (2) for information that requires an international-type search	\$750
38	On filing a request under section 58 of the Act for the result of a search made under section 45 or 48 of the Act	\$50
39	On filing a substitute page or pages in compliance with a direction under subregulation 3.2 (4): (a) within 3 months after the day when the direction was given	\$50



Column 1 Item	Column 2 Matter	Column 3 Fee\$
	(b) after the time specified in paragraph (a) but before the application becomes open to public inspection	\$95
40	For filing an abstract after the day when a direction was given under subregulation 3.4 (5)	\$50
41	For taxing costs under subregulation 22.8 (3)	\$50

PART 3—GENERAL FEES FOR INTERNATIONAL APPLICATIONS

Column 1 Item	Column 2 Matter	Column 3 Fee
1	Transmittal fee under Rule 14 of the PCT	\$55
2	Search fee under Rule 16 of the PCT	\$750
3	Additional fee for search under Article 17 (3) (a) of the PCT	\$750
4	Preliminary examination fee under Rule 58 of the PCT	\$400
5	Additional fee for international preliminary examination under Article 34 (3) (a) of the PCT	\$400
6	For copy of a document in accordance with Rules 44.3 (b) or 71.2 (b) of the PCT	\$15
7	Confirmation fee under Rule 15.5 (a) of the PCT	50% of the sum of the designation fees payable under item 2 (b) of Part 4 in this Schedule

Note: The text of the PCT is set out in Schedule 2.

PART 4—FEES FOR INTERNATIONAL APPLICATIONS PAYABLE FOR THE BENEFIT OF THE INTERNATIONAL BUREAU

Column 1 Item	Column 2 Matter	Column 3 Fee
1	Basic fee under Rule 15.2 (a) of the PCT: (a) if the international application contains not more than 30 sheets (b) if the international application contains more than 30 sheets	762 Swiss francs 762 Swiss francs, plus 15 Swiss francs for each sheet in excess of 30 sheets
2	Designation fee under Rule 15.2 (a) of the PCT (a) for designations made under Rule 4.9 (a) (b) for designations made under Rule 4.9 (b) and confirmed under Rule 4.9 (c)	185 Swiss francs per designation, provided that any designation made under Rule 4.9 (a) in excess of 10 shall not require the payment of a designation fee 185 Swiss francs per designation



Column 1 Item	Column 2 Matter	Column 3 Fee
3	Handling fee under Rule 57.2 (a) of the PCT	233 Swiss francs

Note: The text of the PCT is set out in Schedule 2.



SCHEDULE 8 COSTS, EXPENSES AND ALLOWANCES

PART 1—COSTS

Column 1 Item	Column 2 Matter	Column 3 Amount
1	Notice of opposition	\$170
2	Evidence in support	\$460
3	Receiving and perusing notice of opposition	\$85
4	Receiving and perusing evidence in support	\$200
5	Evidence in answer	\$460
6	Receiving and perusing evidence in answer	\$135
7	Evidence in reply	\$230
8	Receiving and perusing evidence in reply	\$85
9	Preparation of case for hearing	\$345
10	Attendance at hearing by patent attorney or solicitor without counsel	\$170 per hour or \$765 per day
11	Attendance at hearing by patent attorney or solicitor instructing counsel	\$135 per hour or \$610 per day
12	Counsel fees	\$230 per hour or \$1,035 per day

PART 2—EXPENSES AND ALLOWANCES

Division 1—Expenses

1. A person who has paid a fee prescribed in these Regulations in relation to proceedings before the Commissioner or the Patent Attorneys Disciplinary Tribunal may be paid the amount of the fee.

2. A person attending proceedings before the Commissioner or the Patent Attorneys Disciplinary Tribunal must be paid:

- (a) a reasonable amount for allowances for transport between the usual place of residence of the person and the place that he or she attends for that purpose; and
- (b) if the person is required to be absent overnight from his or her usual place of residence—a reasonable amount for allowances up to a daily maximum of \$390 for meals and accommodation.

Division 2—Allowances

3. A person who, because of his or her professional, scientific or other special skill or knowledge, is summoned to appear before the Commissioner or the Patent Attorneys Disciplinary Tribunal as a witness must be paid:

- (a) if the person is remunerated in his or her occupation by wages, salary or fees—an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; or
- (b) in any other case—an amount of not less than \$95, or more than \$475, for each day on which he or she so attends.

4. A person summoned to appear before the Commissioner or the Patent Attorneys Disciplinary Tribunal as a witness, other than a witness referred to in clause 3, must be paid:

- (a) if the person is remunerated in his or her occupation by wages, salary or fees—an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; or
- (b) in any other case—an amount of not less than \$54, or more than \$89, for each day on which he or she so attends.

NOTE

1. The Patents Regulations (in force under the *Patents Act 1990*) as shown in this reprint comprise Statutory Rules 1991 No. 71 amended as indicated in the Tables below.

Table of Statutory Rules

Year and number	Date of notification in <i>Gazette</i>	Date of commencement	Application, saving or transitional provisions
1991 No. 71	26 Apr 1991	30 Apr 1991	
456	19 Dec 1991	Rr. 3, 5 and 7: 1 Jan 1992 Remainder: 19 Dec 1991	—
1992 No. 148	9 June 1992	R. 5: 9 June 1992 Remainder: 1 July 1992	R. 7
1993 No. 113	3 June 1993	1 July 1993	R. 9
227	26 Aug 1993	Rr. 3.1, 4.1 and 4.4: 1 Oct 1992 Remainder: 1 Jan 1993	—
340	10 Dec 1993	10 Dec 1993	R. 8
341	10 Dec 1993	1 Jan 1994	—

Table of Amendments

ad. = added or inserted am.=amended rep.=repealed rs.=repealed and substituted

Provision affected	How affected
R. 1.4	am. 1991 No. 456; 1992 No. 148; 1993 Nos. 227 and 341



Provision affected	How affected
R. 5.4	am. 1993 No. 113
R. 5.10	am. 1993 Nos. 113 and 340
R. 22.2	am. 1991 No. 456; 1993 No. 113
R. 22.7A	ad. 1993 No. 340
R. 22.8	am. 1993 No. 340
R. 22.11	am. 1993 No. 113
Schedule 2	am. 1991 No. 456 rs. 1992 No. 148 am. 1993 Nos. 227 and 341
Schedule 4	rs. 1991 No. 456 am. 1992 No. 148 rs. 1993 No. 340
Schedule 7	am. 1991 No. 456 rs. 1992 No. 148 am. 1993 Nos. 113 and 340
Schedule 8	am. 1992 No. 148 rs. 1993 No. 113 am. 1993 No. 340

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