



Patents Amendment Regulations 2001 (No. 1)¹

Statutory Rules 2001 No. 98²

I, WILLIAM PATRICK DEANE, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following Regulations under the *Patents Act 1990* and the *Patents Amendment (Innovation Patents) Act 2000*.

Dated 16 May 2001

WILLIAM DEANE
Governor-General

By His Excellency's Command

WARREN ENTSCH
Parliamentary Secretary to the Minister for Industry,
Science and Resources

1 Name of Regulations

These Regulations are the *Patents Amendment Regulations 2001 (No. 1)*.

2 Commencement

These Regulations commence on the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

3 Amendment of *Patents Regulations 1991*

Schedule 1 amends the *Patents Regulations 1991*.

Schedule 1 Amendments

(regulation 3)

[1] Subregulation 1.3 (1), definition of *acceptance*, paragraph (b)

substitute

- (b) in relation to a patent request and complete specification relating to an application for an innovation patent — acceptance of the patent request and complete specification under section 52 of the Act.

[2] Subregulation 1.3 (4)

substitute

- (4) Subject to subregulation (5), if the Commissioner or the Patent Office gives a document to a person, 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, unless the contrary intention appears.
- (5) If:
 - (a) the Commissioner or the Patent Office makes a document available electronically for a person; and
 - (b) sends a notice to the person telling them that the document is available for them to collect electronically;
the document is taken to have been given to the person on the day on which the notice is dated by Commissioner or the Office, unless the contrary intention appears.
- (6) A requirement in these Regulations to give information to the Commissioner or to another person (whether the expression ‘give’, ‘tell’, ‘inform’ or another expression is used) is a requirement to give the information in writing, unless the contrary intention appears.
- (7) For these Regulations, a period expressed in months is to be worked out in the way described in rule 80.2 of the Regulations under the Patent Cooperation Treaty set out in Schedule 2A.

[3] Regulation 1.5

substitute

1.5 Deposit requirements: prescribed period

- (1) For paragraph 6 (c) of the Act, the prescribed period is:
 - (a) if the Commissioner makes a declaration under subsection 42 (1) of the Act in relation to the specification concerned — the period mentioned in subregulation (2); or
 - (b) in any other case:
 - (i) for a complete specification in respect of a standard patent application — the period mentioned in subregulation (3); or
 - (ii) for a complete specification in respect of an innovation patent application — the period mentioned in subregulation (4).
- (2) For paragraph (1) (a), the period begins on the filing date of the application to which the specification relates and ends 3 months from the date taken to be the date of filing of the specification under paragraph 42 (2) (b) of the Act.
- (3) For subparagraph (1) (b) (i), the period begins on the filing date of the application to which the specification relates and ends:
 - (a) at the end of the day immediately before the day on which the application becomes open to public inspection; or
 - (b) if the application is accepted before the end of the day first mentioned in paragraph (a) — immediately before acceptance.
- (4) For subparagraph (1) (b) (ii), the period begins on the filing date of the application to which the specification relates to and ends immediately before acceptance.
- (5) 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 by a person to whom the Commissioner has granted the certification under regulation 3.25 in respect of the deposit:
 - (a) after the period mentioned in subregulation (1) for the specification to which the application relates; and
 - (b) from the prescribed depository institution with which the micro-organism is deposited.

[4] Subregulation 1.6 (1)

after

Convention application

insert

for a standard patent

[5] After subregulation 1.6 (1A)

insert

(1B) For section 8 of the Act, the prescribed period for a Convention application for an innovation patent is:

(a) for documents to which paragraph 8 (a) of the Act applies — the period from the date of making the application based on the basic application to immediately before the Commissioner decides to certify the patent; or

(b) for documents to which paragraph 8 (b) of the Act applies:

(i) if the patent has been certified — 3 months from the date on which the Commissioner requests the translation; or

(ii) if the patent has not been certified — the period from the date on which the Commissioner requests the translation to immediately before the Commissioner decides to certify the patent.

[6] Subregulation 2.2 (3)

substitute

(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) 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) if the first disclosure of the invention during the exhibition did not take place on that date — the date of that disclosure.

(4) For paragraph (3) (b), the statement must be filed:

(a) for an application for a standard patent — before the complete specification in respect of the application is open to public inspection; or

(b) for an application for an innovation patent — within 6 months from the filing date of the complete specification in respect of the application.

[7] **Regulations 2.6 and 2.7**

substitute

2.6 Prescribed period: notification of assertion of invalidity of innovation patent

For subsection 28 (2) of the Act, the prescribed period for an innovation patent is the period from the date that the complete specification for the patent becomes open to public inspection to immediately before the Commissioner decides to certify the patent.

2.7 Documents to accompany notice of assertion of invalidity

Notice of an assertion under subsection 27 (1) or 28 (1) of the Act must, if the assertion is based on a document, have with it:

- (a) a copy of the document; and
- (b) if the document is not in English, a copy of:
 - (i) a translation of the document into English; and
 - (ii) a related certificate of verification; and
- (c) evidence of the date and place of publication of the document.

[8] **Subregulation 3.1 (2)**

after

complete application

insert

for a standard patent

[9] **Paragraph 3.1 (2) (f)**

omit

subsection 36 (3) of the Act (“other applications by eligible persons”)

insert

subsection 36 (4) of the Act

[10] **After regulation 3.1**

insert

3.1A Applicant taken to be nominated person

For an application for a standard patent or an innovation patent, the applicant is taken to be the nominated person.

[11] **Regulation 3.2**

substitute

3.2 Provisional specifications

A provisional specification must be in the approved form.

3.2A Specifications: standard patents

- (1) A complete specification for a standard patent must:
 - (a) be in the approved form; and
 - (b) be in English; and
 - (c) comply substantially with the requirements of Schedule 3.
- (2) If the Commissioner treats a complete specification for a standard patent as having been filed, the Commissioner may, within 1 month from the date of filing of the specification, direct the applicant to do anything necessary to ensure that the specification complies with the requirements mentioned in subregulation (1).

Note See regulation 3.5 for what happens if certain information required for an application is not filed.

- (3) 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 before:
 - (a) if subregulation (4) applies — the end of the period specified in the direction under paragraph (4) (b); or
 - (b) in any other case — the later of:
 - (i) the end of 3 months from the day on which the direction was given; and
 - (ii) the day on which the specification becomes open to public inspection.
- (4) This subregulation applies if:
 - (a) the direction is given to assist the Commissioner in deciding whether a filed abstract is in accordance with these Regulations; and
 - (b) the Commissioner has specified in the direction a period of not less than 1 month within which the applicant must comply with the direction.

- (5) If an application lapses under subregulation (3), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) tell the applicant of the lapse.

3.2B Specifications: formalities check for innovation patents

- (1) For section 52 of the Act, a complete application for an innovation patent passes the formalities check only if the application meets all of the following requirements:
 - (a) the complete specification for the application must:
 - (i) be in the approved form; and
 - (ii) be in English; and
 - (iii) comply substantially with the requirements of Schedule 3;
 - (b) the patent request must be in the approved form;
 - (c) if the applicant is an eligible person under section 34 of the Act — a copy of the court order declaring that the applicant is an eligible person in relation to the invention must be filed with the complete application;
 - (d) the complete application must comply with regulation 3.8, 3.10, 6A.1 or subregulation 8.5 (2), or subsection 79C (2) of the Act, if applicable;
 - (e) if the applicant is relying on section 41 of the Act — the receipts mentioned in paragraph 3.1 (2) (c) must be filed with the complete application;
 - (f) the complete specification must not be a cross-reference to an earlier patent application filed in Australia or in a Convention country;
 - (g) the complete specification must not contravene subsection 18 (2) or (3) of the Act.
- (2) If the application does not meet a requirement mentioned in paragraph (1) (a), (b), (c), (d), (e) or (f), the Commissioner must direct the applicant to do anything necessary to ensure that the application meets the requirement.
- (3) If an applicant to whom a direction under subregulation (2) has been given does not comply with the direction within 2 months from the date of the direction, the application lapses.
- (4) If the application does not meet the requirement mentioned in paragraph (1) (g), the Commissioner must direct the applicant to ensure that the application meets the requirement.
- (5) If an applicant to whom a direction under subregulation (4) has been given does not respond to the direction within 2 months from the date of the direction, the application lapses.

- (6) If an applicant to whom a direction under subregulation (4) has been given does not comply with the direction within 4 months from the date of the direction, the application lapses.
- (7) If an application lapses under subregulation (3), (5) or (6), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) tell the applicant of the lapse.

[12] Regulations 3.5 and 3.6

substitute

3.5 Filing date

- (1) Subject to this regulation, the filing date of a patent application is the date on which the following information is filed:
 - (a) information in English that indicates that what is filed is intended to be an application for a patent;
 - (b) information that allows the identity of the applicant to be established or allows the applicant to be contacted by the Patent Office;
 - (c) information that appears to be a description.
- (2) For paragraph (1) (c), a description:
 - (a) does not have to be in English; and
 - (b) may be a drawing; and
 - (c) may be a reference, in English, to an earlier patent application filed in Australia or in a Convention country.
- (3) For paragraph (2) (c), the earlier patent application does not have to be in English.
- (4) If all of the information mentioned in subregulation (1) is not filed in respect of an application, the Commissioner must give the applicant notice in writing:
 - (a) telling the applicant that all of the information mentioned in subregulation (1) was not filed in respect of the application; and
 - (b) asking the applicant to file the additional information required.
- (5) If an applicant to whom a notice under subregulation (4) has been given does not file the additional information within 2 months from the date of the notice, the application is taken not to have been filed.
- (6) Subregulation (7) applies if an applicant to whom a notice under subregulation (4) has been given files the additional information within 2 months from the date of the notice.

- (7) For section 30 of the Act, the filing date of the patent application is the date on which the additional information is filed.

3.5A Filing date: incomplete specifications

- (1) This regulation applies if the information mentioned in subregulation 3.5 (1) has been filed in respect of a patent application but a part of the patent specification is missing.
- (2) If the Commissioner notices that a part of the specification is missing, the Commissioner must give the applicant notice in writing:
- (a) telling the applicant that a part of the specification is missing; and
 - (b) asking the applicant to file the missing part.
- (3) The missing part must be incorporated into the specification if, within the period applying under subregulation (4), the applicant:
- (a) files the missing part; or
 - (b) if the applicant claims priority from an earlier basic application or associated provisional application — files:
 - (i) the missing part; and
 - (ii) a copy of the earlier application that contains, and indicates the location of, the missing part; and
 - (iii) a translation of the earlier application if it is not in English.
- (4) For subregulation (3), the period is:
- (a) if a notice is given under subregulation (2) — 2 months from the date of the notice; or
 - (b) in any other case — 2 months from the filing date.
- (5) For section 30 of the Act, the filing date of the application is:
- (a) if paragraph (3) (a) applies — the date on which the missing part is filed; and
 - (b) if paragraph (3) (b) applies — the date that would have been the filing date if the missing part had not been incorporated.
- (6) If paragraph (5) (a) applies, the Commissioner must tell the applicant of the new filing date.
- (7) Despite paragraph (5) (a), if within 1 month after being told of the new filing date, the applicant withdraws the missing part from the specification, the filing date of the application, for section 30 of the Act, is the date that would have been the filing date if the missing part had not been incorporated.

3.5B Filing of documents outside business hours

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.

3.6 Requests to make determinations between interested parties

For section 32 of the Act, a request must:

- (a) be in the approved form; and
- (b) have with it a notice, by the person making the request, stating the grounds on which the request is made.

[13] Paragraph 3.8 (a)

substitute

- (a) in the case of an application of the kind described in section 33 of the Act — within 3 months of the decision of the Commissioner referred to in paragraph 33 (1) (c), (2) (c), (3) (c) or (4) (b) of the Act, as the case requires; or

[14] Regulation 3.9

substitute

3.9 Prescribed period: treatment of complete application as provisional

For subsection 37 (1) of the Act, the prescribed period is:

- (a) for an application for a standard patent — the period from the date of filing of the complete application until the earlier of:
 - (i) the end of 12 months from the filing date of the complete application; and
 - (ii) the day that is 3 weeks before the due date for publishing a notice under section 54 of the Act; and
- (b) for an application for an innovation patent — 12 months from the filing date of the complete application.

[15] Regulation 3.11

Omit

[16] Paragraph 3.12 (1) (c)

substitute

- (c) if the specification is a complete specification filed in respect of a divisional application under section 79B of the Act and the claim is fairly based on matter disclosed in the specification referred to in paragraph 79B (1) (a) of the Act — the date mentioned in subregulation (2C);
- (d) if the specification is a complete specification filed in respect of a divisional application under section 79C of the Act and:
 - (i) the claim is fairly based on matter disclosed in the specification referred to in subsection 79C (1) of the Act; and
 - (ii) examination of the divisional application is requested within 2 months from the date of the grant of the divisional application;
the date mentioned in subregulation (2D).

[17] Subregulation 3.12 (3)

substitute

- (2C) The date for a specification to which paragraph 3.12 (1) (c) applies is the date that would have been the priority date of the claim if it had been included in the specification referred to in paragraph 79B (1) (a) of the Act.
- (2D) The date for a specification to which paragraph 3.12 (1) (d) applies is the date that would have been the priority date of the claim if it had been included in the specification referred to in subsection 79C (1) of the Act.
- (3) For paragraphs 3.12 (1) (c) and (d), a claim is not fairly based on the specification referred to in paragraph 79B (1) (a) or the specification of the first patent referred to in subsection 79C (1) of the Act if, in order to comply with paragraph 40 (2) (a) of the Act, 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 is not satisfied in relation to the specification referred to in paragraph 79B (1) (a) or the specification of the first patent referred to in subsection 79C (1) of the Act; or
 - (b) the period prescribed in subregulation 1.5 (1) has ended and the requirements of paragraph 6 (c) of the Act are not satisfied in relation to the specification referred to in paragraph 79B (1) (a) or the specification of the first patent referred to in subsection 79C (1) of the Act.

[18] Regulation 3.13

substitute

3.13 Priority dates: certain persons and applications

- (1) This regulation applies if, under subsection 36 (1) of the Act:

- (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.
- (2) 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) (c) of the Act and referred to in the declaration, is:
- (a) 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
 - (b) if that specification is a provisional specification — the date of filing of the provisional specification.

[19] Paragraph 3.16 (1) (c)

omit

consideration of an application for a petty patent.

insert

examination of an innovation patent.

[20] Subregulation 3.18 (1)

omit

[21] Subregulation 3.18 (2)

omit

paragraph 45 (1) (c) or 48 (1) (b)

insert

paragraph 45 (1) (d) or 48 (1) (c)

[22] Subparagraph 3.18 (2) (a) (iv)

substitute

(iv) section 79B (divisional applications prior to grant of patent);

[23] Paragraph 3.18 (2) (c)

omit

section 51

insert

section 50

[24] Subregulation 3.18 (3)

omit

paragraph 48 (1) (b)

insert

paragraph 48 (1) (c)

[25] Regulation 3.19, heading

substitute

3.19 Conduct of examination: standard patents

[26] Subregulation 3.19 (3)

omit

section 45 (“examination”) or section 48 (“modified examination”)

insert

section 45 or 48

[27] Regulation 3.22

omit

[28] Subregulation 3.23 (1)

omit

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

insert

section 41 of the Act, the following documents must be filed in relation to an application that has been accepted under section 49 or 52 of the Act

[29] Subregulation 3.25 (3)

substitute

(3) If the application is for a standard patent, the applicant 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 in a period mentioned in subregulation (3A) to a person who is:

- (a) a skilled addressee without an interest in the invention; and
 - (b) nominated by the person who made the request.
- (3A) For subregulation (3), the period is:
- (a) before the patent is granted on that application; or
 - (b) before the application has lapsed or been withdrawn or refused.

[30] Subparagraphs 3.25 (4) (c) (i) and (ii)

substitute

- (i) opposition proceedings under Chapter 5 of the Act in relation to the grant of a standard patent on that application; or
- (ii) opposition proceedings under section 101M of the Act in relation to an innovation patent; or

[31] Paragraph 4.2 (2) (c)

omit

subregulation 3.2 (4) (“specifications”)

insert

subregulation 3.2A (2)

[32] Subparagraphs 5.1 (a) (iii) and (iv)

substitute

- (iii) section 101M (opposition to innovation patent);
- (iv) subsection 104 (4) (amendments by applicants and patentees), unless the request for leave to amend is in response to a direction of the Commissioner under section 106 (amendments directed by Commissioner: patents) or section 107 (amendments directed by Commissioner: applications for standard patents);
- (v) subsection 223 (6) (extensions of time); or

[33] Regulation 5.2, definition of *applicant*

substitute

applicant means:

- (a) in relation to an opposition under section 101M of the Act — the patentee of the innovation patent; and

- (b) in relation to another opposition — a person who has filed an application or request in respect of which another person has filed a notice of opposition.

[34] **Regulation 5.3, heading**

substitute

5.3 Filing of opposition (except under section 101M of the Act)

[35] **After regulation 5.3**

insert

5.3AA Filing of opposition under section 101M of Act

- (1) The Minister or other person who intends to oppose an innovation patent under section 101M of the Act must file a notice of opposition in the approved form.
- (2) The notice may be filed at any time after the innovation patent is certified.
- (3) The opponent must file with the notice of opposition a statement that sets out the grounds of opposition and the particulars relating to each ground.
- (4) Within 7 days of filing the notice and the statement, the opponent must serve a copy of the notice and statement on the applicant.

[36] **Regulation 5.3A, heading**

substitute

5.3A Amendment of notice of opposition: correction of error or mistake

[37] **After regulation 5.3A**

insert

5.3B Amendment of notice of opposition: change of opponent

- (1) This regulation applies if a person files a notice of opposition and the right or interest on which he or she relied to file the notice is subsequently vested in another person (the *new opponent*).
- (2) The new opponent may give to the Commissioner notice, in writing, that the right or interest is vested in him or her and request the Commissioner, in writing, to amend the notice of opposition to record his or her name.
- (3) The Commissioner may grant the request on the terms (if any) that the Commissioner specifies by written notice to the new opponent.
- (4) The Commissioner must give to the parties to the opposition the opportunity to make representations concerning the proposed amendment.
- (5) If the Commissioner allows the amendment:

- (a) he or she must give the applicant a copy of the notice of opposition as amended; and
- (b) the opposition is to proceed in the name of the new opponent.

[38] Regulation 5.4

substitute

5.4 Filing of statement

An opponent (except an opponent under section 101M of the Act) must:

- (a) within 3 months of filing the notice of opposition, serve on the applicant a copy of a statement that sets out the grounds of opposition, and 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.

[39] Paragraph 5.5 (1) (a)

omit

subregulation 5.4 (1) (“filing of statement”)

insert

paragraph 5.4 (a)

[40] After subregulation 5.5 (3)

insert

- (4) Without limiting subregulation (3), the Commissioner may dismiss the opposition:
 - (a) for an opposition under section 101M of the Act — if the statement of grounds and particulars is not filed with the notice of opposition; or
 - (b) for another opposition — if the statement of grounds and particulars is not served within the period prescribed in paragraph 5.4 (a).

[41] Paragraph 5.7 (a)

omit

subregulation 5.4 (1) (“filing of statement”)

insert

paragraph 5.4 (a)

[42] Subregulation 5.8 (1)

substitute

(1) 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:
 - (i) for an opposition under section 101M of the Act — at the same time as the opponent serves on the applicant the notice of opposition and the statement of grounds and particulars; or
 - (ii) for another opposition — within the period mentioned in subregulation (1A); 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.

(1A) For subparagraph (1) (a) (ii), the period is within 3 months from whichever of the following occurs last:

- (a) the day when the opponent served on the applicant:
 - (i) a copy of the statement referred to in paragraph 5.4 (a); or
 - (ii) if a substitute statement has been served on the applicant under regulation 5.7 — a copy of that statement;
- (b) if the Commissioner has re-examined the complete specification in relation to the opposed application under subsection 97 (1) of the Act — the day when re-examination is completed under regulation 9.5;
- (c) if dismissal of the opposition has been requested under subregulation 5.5 (1) — a decision of the Commissioner not to dismiss the opposition;
- (d) if determination of the opposition has been requested under subregulation 5.6 (1) — a decision of the Commissioner not to determine the opposition.

[43] Paragraph 5.8 (2) (a)

omit

referred to in subregulation 5.4 (2) or paragraph (1) (a)

[44] Paragraph 5.8 (3) (a)

substitute

- (a) serve on the opponent a copy of any evidence in answer to the opposition within 3 months from:
 - (i) for an opposition under section 101M of the Act — the day the notice of opposition was served on the applicant; or
 - (ii) for another opposition — the end of the period that applies under subparagraph (1) (a) (ii); and

[45] Paragraphs 5.9 (1) (a), (b) and (c)

omit

subregulation 5.4 (1)

insert

regulation 5.4

[46] Paragraph 5.10 (1) (b)

substitute

- (b) determine that a period prescribed in this Chapter (except in regulation 5.3 or 5.3AA, paragraph 5.4 (a) or subparagraph 5.8 (1) (a) (i)) is to be extended by such further period as the Commissioner reasonably allows.

[47] Subregulation 5.10 (2)

substitute

- (2) The Commissioner may 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 5.3AA, paragraph 5.4 (a) or subparagraph 5.8 (1) (a) (i)):
 - (a) on the application of a party in the approved form; and
 - (b) on such reasonable terms (if any) as the Commissioner specifies; and
 - (c) after the party has served the application on the other party.

[48] Subregulation 5.11 (3)

substitute

- (3) In subregulation (2), *document* does not include a document filed under regulation 5.3AA, 5.4 or 5.8, or further evidence referred to in subregulation 5.10 (4).

[49] Regulations 5.12, 5.13 and 5.14

substitute

5.12 Hearing of opposition

- (1) This regulation applies if the relevant periods prescribed in regulation 5.8 have ended, unless:
 - (a) the opposition has been dismissed or determined; or
 - (b) the notice has been withdrawn.
- (2) The Commissioner must, if he or she receives a request by a party to hold a hearing:
 - (a) give a notice of a hearing into the opposition; and
 - (b) hold the hearing.
- (3) The Commissioner may, on his or her own motion:
 - (a) give a notice of a hearing into the opposition; and
 - (b) hold the hearing.

5.13 Representations to Commissioner

A representation mentioned in any of the following provisions may be made to the Commissioner in writing or by any other means approved by the Commissioner:

- (a) subregulation 5.3A (3);
- (b) subregulation 5.3B (4);
- (c) subregulation 5.9 (3);
- (d) subparagraph 5.10 (5) (c) (i);
- (e) paragraph 5.11 (2) (c).

5.14 Commissioner not required to hold hearing

If the Commissioner believes, on reasonable grounds, that no party wishes to be heard in a matter arising under regulation 5.12 or 5.13, the Commissioner is not required to hold a hearing.

[50] Regulation 6.3

substitute

6.3 Date of patent

- (1) For paragraph 65 (b) of the Act, the date of a patent is as set out in this regulation.

- (2) For a patent granted under subsection 33 (1) or (2) of the Act, the date of the patent is the date that would have been the date of the patent if the patent had been granted on the application for a standard patent the grant of which was opposed under section 59 of the Act.
- (3) For a patent granted under subsection 33 (3) or (4) of the Act, the date of the patent is the date of the innovation patent that was opposed under section 101M of the Act.
- (4) For a patent granted under subsection 34 (2) of the Act, the date of the patent is the date of the patent referred to in subsection 34 (1) of the Act.
- (5) For a patent granted under section 35 of the Act, the date of the patent is the date of the revoked patent.
- (6) For a patent granted as a result of a declaration under section 36 of the Act, the date of the patent is:
 - (a) if the declaration is made in respect of a complete application — the date that would have been the date of the patent if the patent had been granted on that application; or
 - (b) if the declaration is made in respect of a provisional application — the earlier of:
 - (i) the date 12 months from the date of filing of the provisional specification in respect of that application; and
 - (ii) the date of filing of the complete application referred to in subsection 36 (4) of the Act.
- (7) For a patent granted on a divisional application made under subsection 79B (1) of the Act, the date of the patent is:
 - (a) if the date of the patent was recorded in the Register before 1 January 2000 — the date recorded in the Register; or
 - (b) if the Commissioner determined a date of the patent and told the applicant in writing before 1 January 2000 — the date determined by the Commissioner; or
 - (c) in any other case — the earliest of:
 - (i) the date of the patent of the first-mentioned application referred to in subsection 79B (1) of the Act; and
 - (ii) the date that would be the date of the patent if a patent had been granted on that first-mentioned application; and
 - (iii) if that first-mentioned application was itself a divisional application or was amended to be a divisional application before filing the later application — the date that would be the date of the patent if a patent had been granted on the divisional application.
- (8) For an innovation patent granted on a divisional application made under subsection 79C (1) of the Act, the date of the patent is the date of the first patent mentioned in subsection 79C (1).

- (9) If, under section 223 of the Act, the Commissioner has extended the time for making, under section 38 of the Act, a complete application associated with a provisional application, the date of the patent is the date 12 months from the date of making the first provisional application with which the complete application is associated.
- (10) If, under section 223 of the Act, the Commissioner has extended the time for making, under section 94 of the Act, a Convention application in relation to a basic application, the date of the patent is the date 12 months from the date of making the first basic application to which the Convention application relates.

[51] Regulations 6.5 and 6.6

omit

[52] Subregulation 6.11 (3)

omit

beginning on

insert

from

[53] After Chapter 6

insert

Chapter 6A Divisional applications

6A.1 Divisional applications: standard patents

For section 79B of the Act, a divisional application must be made:

- (a) under section 29 of the Act; and
- (b) before the date of the grant of a patent on the first-mentioned application in section 79B of the Act.

6A.2 Divisional applications: innovation patents

- (1) For section 79C of the Act, a divisional application must be made under section 29 of the Act.
- (2) For subsection 79C (2) of the Act, the prescribed period is 1 month from the date on which the certification of the first patent mentioned in subsection 79C (1) is advertised.

[54] Subregulation 7.1 (1)

substitute

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

[55] Paragraph 8.1 (3) (b)

substitute

- (b) subregulation 3.1 (1) and regulation 3.2A;

[56] Subregulation 8.2 (4)

substitute

- (4) The Commissioner must not, in relation to a PCT application that is treated as an application under the Act for a standard patent, give a direction under section 44 of the Act, unless the applicant has complied with the requirements of subsection 89 (3) of the Act.

[57] Subregulation 8.3 (2)

substitute

- (2) Section 141:

omit the section, substitute:

‘141 Withdrawal of applications

- (1) Subject to subsection (3), a patent application may be withdrawn at any time except during a period prescribed for the purposes of this section.
- (2) A patent application is to be treated as having been withdrawn if, and only if, the applicant lodges a written notice of withdrawal signed by the applicant.
- (3) 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.’.

[58] Subregulation 8.6 (2)

substitute

- (2) For subsection 95 (3) of the Act, 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 is made must be filed:
 - (a) for a standard patent — within the period from the day on which the application is made to immediately before acceptance; or

- (b) for an innovation patent — within the period from the day on which the application is made to immediately before the Commissioner decides to certify the patent.

[59] Subregulation 9.1 (1)

omit

subregulation 5.4 (1) (“filing of statement”)

insert

regulation 5.4

[60] Subregulations 9.2 (1) and (2)

substitute

- (1) For subsections 97 (2) and 101G (1) of the Act, a request for re-examination of a complete specification must be in the approved form.
- (2) A request must 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 before the priority date of that claim, is not novel, and:
 - (a) for a standard patent — does not involve an inventive step; or
 - (b) for an innovation patent — does not involve an innovative step.
- (2A) A request must state the relevance of each of the documents mentioned in subregulation (2).

[61] Subregulation 9.2 (4)

substitute

- (4) If the request does not comply with subregulations (2), (2A) and (3), the Commissioner must not re-examine the complete specification.

[62] Subregulation 9.2 (5)

omit

section 98 of the Act (“report on re-examination”).

insert

section 98 or subsection 101G (2) of the Act.

[63] Subregulation 9.2 (7)

omit

subsection 97 (2) of the Act

insert

subsection 97 (2) or 101G (1) of the Act

[64] Subregulation 9.3 (1)

omit

section 98 of the Act (“report on re-examination”)

insert

section 98 or subsection 101G (2) of the Act

[65] Subregulation 9.4 (1)

substitute

- (1) For subsection 99 (1) or 101H (1) of the Act, the prescribed period is the period of 2 months from the day when the Commissioner reports under section 98 or subsection 101G (2) of the Act.

[66] Subregulation 9.4 (2)

after

subsection 99 (1)

insert

or subsection 101H (1)

[67] Regulation 9.5

omit

or (2)

insert

Chapter 9A Examination of innovation patents

9A.1 Request for examination

- (1) A request for examination of a complete specification relating to an innovation patent must be in the approved form.
- (2) If the Commissioner decides, under paragraph 101A (a) of the Act, to examine a complete specification, the Commissioner must tell the patentee about the decision.
- (3) If a request is made under paragraph 101A (b) of the Act by a person other than the patentee, the Commissioner must tell the patentee about the request.
- (4) A request for examination of a complete specification can be withdrawn only:
 - (a) by the person who made the request; and
 - (b) before examination of the complete specification has begun; and
 - (c) if the Commissioner is satisfied, on reasonable grounds, that the request was made in error.
- (5) If examination of a complete specification has begun, no further requests for examination of the specification can be made.

9A.2 Examination of complete specification

For section 101B of the Act, the Commissioner may examine a complete specification relating to an innovation patent only if the patent has been granted.

9A.3 Conduct of examination

- (1) If the Commissioner believes, on reasonable grounds, that there are lawful grounds for revocation of the innovation patent, the Commissioner must state the grounds for revocation in reporting on an examination.
- (2) The patentee may contest a ground for revocation in writing or ask for leave to amend the complete specification in accordance with Chapter 10.
- (3) If the patentee asks for leave to amend a complete specification in response to, or in anticipation of, a report under section 101B of the Act, the Commissioner must examine the specification and report as if each proposed amendment had been made.
- (4) If the patentee contests a ground for revocation, the Commissioner must examine the specification and take note of the matters raised by the applicant.
- (5) If the request for examination was made by a person other than the patentee, the Commissioner must send a copy of the report to the person who requested the examination.

9A.4 Period for examination

For paragraph 101C (b) of the Act, the examination of a complete specification for an innovation patent must be completed before the end of whichever of the following periods ends latest:

- (a) the period of 6 months from the date on which the first report is issued under section 101B of the Act;
- (b) the period mentioned in paragraph 13.4 (1) (d);
- (c) if an appeal has been made to a prescribed court in relation to the patent — the period of 3 months from the date on which the appeal is withdrawn, finally dealt with or determined, or such longer period as the court allows;
- (d) if the Commissioner requests a document under paragraph 1.6 (1B) (b) — the period of 5 months from the date on which the request is made.

9A.5 Validity of innovation patent

For the purposes of examination, if a notice has been filed under subsection 28 (1) of the Act, the Commissioner must consider a matter stated in the notice that addresses a claim that an invention does not comply with paragraph 18 (1A) (b) of the Act.

[69] Subregulations 10.1 (1A) and (2)

substitute

(1A) If an applicant proposes to amend a patent request, complete specification or other filed document for a reason mentioned in subregulation (1B), the applicant is taken to have complied with subregulation (1) if a written statement of the proposed amendments is filed.

(1B) For subregulation (1A), the reasons are:

- (a) to remove a lawful ground of objection or revocation raised in an examination report; or
- (b) for an application for a standard patent — in anticipation of examination of the patent request and complete specification; or
- (c) for an innovation patent — in anticipation of examination of the complete specification.

(2) If:

- (a) a proposed amendment is to be made by means of substituting a document or part of a 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 document or part that is to be substituted for a document or part; and

- (d) on 1 of the copies, an indication, in a manner approved by the Commissioner, of the nature and location of the proposed amendment.

[70] Paragraph 10.2 (1) (b)

omit

section 102 of the Act (“what amendments are not allowable?”)

insert

section 102 or 103 of the Act

[71] Subregulations 10.2 (6) and (7)

substitute

- (6) Subregulation (6A) applies if:
 - (a) either:
 - (i) the grant of a standard patent is opposed under section 59 of the Act; or
 - (ii) an innovation patent is opposed under section 101M of the Act; and
 - (b) the applicant or patentee has requested leave to amend the patent request or complete specification concerned.
- (6A) The Commissioner must:
 - (a) give a copy of the request for leave to amend and the statement of proposed amendments to the opponent as soon as practicable after the request for leave to amend has been filed; and
 - (b) invite the opponent to comment on the request and statement.
- (7) The opponent may file comments within 21 days, or any longer period (up to 2 months) allowed by the Commissioner, after being given the copy of the request for leave to amend and the statement under paragraph (6A) (a).

[72] Paragraph 10.3 (3) (a)

omit

section 49 (“acceptance of patent request: standard patent”) or 50 (“consideration and acceptance of patent request: petty patent”)

insert

section 49 or 52

[73] Subparagraphs 10.3 (3) (b) (i) and (ii)

omit each mention of

a petty

insert

an innovation

[74] After subregulation 10.3 (4)

insert

- (5) Subregulation (6) applies if a request for leave to amend the patent request for a standard patent is filed within 3 weeks before the date on which a notice is due to be published in the *Official Journal* under section 54 of the Act in respect of the specification, and the amendment would:
 - (a) convert the patent application from an application for a standard patent to an application for an innovation patent; or
 - (b) change the priority date of the application to a date that is later than the priority date that is currently recorded for the application.
- (6) The proposed amendment is not allowable until after the date on which the notice is published.
- (7) A proposed amendment of a complete specification for an application for an innovation patent, other than an amendment proposed in response to a direction under regulation 3.2B, is not allowable until after the patent has been granted.
- (8) A proposed amendment of a complete specification for an innovation patent is not allowable if the amendment would result in the specification claiming:
 - (a) a thing mentioned in subsection 18 (2) of the Act; or
 - (b) a thing mentioned in subsection 18 (3) of the Act (other than a thing mentioned in subsection 18 (4) of the Act).
- (9) A proposed amendment of a patent request is not allowable after the patent has been granted.

[75] Subregulation 10.5 (1)

substitute

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

- (a) if the report on the proposed amendments under subregulation 10.2 (1) is not an adverse report; and
- (b) in the case of amendments that are proposed in anticipation of, or in response to, a report relating to an examination under section 45 or 48 of the Act and that do not relate to matters mentioned in paragraph 6 (c) of the Act — if the Commissioner believes on reasonable grounds that the proposed amendments would remove all lawful grounds of objection to the patent request and complete specification; and
- (c) in the case of amendments that are proposed in anticipation of, or in response to, a report relating to an examination under section 101B of the Act — if the Commissioner believes on reasonable grounds that the proposed amendments would remove all lawful grounds for revocation of the innovation patent.

[76] Paragraph 10.5 (2) (a)

substitute

- (a) the patent request and complete specification to which the leave to amend relates have been accepted under section 49 of the Act, or a decision to certify has been made under section 101E of the Act; and

[77] Paragraph 10.5 (4) (a)

omit

(“grant of standard patent”) or 62 (“grant and publication of petty patent”)

[78] Regulation 10.8

substitute

10.8 Prescribed decisions: appeal to Federal Court

For subsection 104 (7) of the Act, a prescribed decision is a decision to grant leave to amend a patent request or complete specification to which paragraph 10.5 (1) (b) or (c) applies.

[79] Regulation 10.9

omit

[80] Regulation 10.13

omit

[81] After subparagraph 12.1 (2) (a) (iv)

insert

- (v) for an innovation patent — the date that the patent was certified; and

[82] Regulation 12.2, heading

substitute

12.2 Prescribed period: revocation of patent

[83] Subregulation 12.2 (1)

substitute

- (1) For subsection 134 (1) of the Act, the prescribed period is 2 years from the date of the grant of the first compulsory licence in respect of a patent.

[84] Subregulation 12.4 (1)

substitute

- (1) An applicant to a prescribed court for an order to revoke a patent under subsection 138 (1) of the Act must include, in the pleading or another document disputing the validity of the patent:
 - (a) particulars of the grounds on which the applicant relies; and
 - (b) for an innovation patent — the date on which the patent was certified.

[85] After regulation 13.1

insert

13.1A Period in which standard patent applications may not be withdrawn

- (1) For subsection 141 (1) of the Act, the prescribed period for a standard patent is:
 - (a) 3 weeks before the date on which a notice is due to be published in the *Official Journal* under section 54 of the Act in respect of the specification; or
 - (b) 3 weeks before the date on which a notice of acceptance is due to be published in the *Official Journal* under paragraph 49 (5) (b) of the Act.
- (2) Subregulation (1) does not apply if an order made under subsection 152 (3) or 173 (1) of the Act is in force.

[86] Paragraph 13.3 (1A) (b)

substitute

- (b) the continuation fee includes the additional fee stated in column 3 of item 7 of Part 2 of Schedule 7; and
- (c) the additional fee is payable from the first day of the 6 month period.

[87] Subregulation 13.3 (2)

substitute

- (2) In the case of an application to which section 33, 34, 35, 36 or 79B 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.

[88] Subregulation 13.4 (1)

omit each mention of

commencing on

insert

from

[89] Subregulation 13.4 (2)

omit

the longer or longest period so worked out.

insert

whichever period ends latest.

[90] Regulation 13.6, heading

substitute

13.6 Time for payment of renewal fee for patent

[91] Subregulation 13.6 (1)

substitute

(1) For paragraphs 143 (a) and 143A (d) of the Act:

- (a) a renewal fee for a patent is payable for a relevant anniversary at the last moment of the anniversary; and
- (b) the period in which the renewal fee must be paid is the period ending at the last moment of the anniversary.

[92] Paragraph 13.6 (2) (b)

substitute

- (b) the renewal fee includes the additional fee mentioned in subregulation (2A); and
- (c) the additional fee is payable from the first day of the 6 month period.

[93] After subregulation 13.6 (2)

insert

(2A) For paragraph (2) (b), the additional fee is:

- (a) for a standard patent — the fee stated in column 3 of item 7 of Part 2 of Schedule 7; and
- (b) for an innovation patent — the fee stated in column 3 of item 7A of Part 2 of Schedule 7.

[94] Subregulation 13.6 (5)

after

section 143

insert

or 143A

[95] Subregulation 13.6 (6)

substitute

(6) In this regulation, *relevant anniversary*, for a patent, means an anniversary of the date of the patent that is mentioned:

- (a) for a standard patent — in column 2 of item 7 of Part 2 of Schedule 7; or
- (b) for an innovation patent — in column 2 of item 7A of Part 2 of Schedule 7.

Note For the date of a patent, see section 65 of the Act and regulation 6.3.

[96] Regulation 15.1

substitute

15.1 Time for restoration of application for patent

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

[97] Subregulation 15.2 (1)

substitute

- (1) For paragraph 151 (4) (c) of the Act, the prescribed period is 3 months from the revocation of a direction under section 149 of the Act.

[98] Regulation 15.3

substitute

15.3 Prescribed period: order relating to standard patent

For subsection 153 (3) of the Act, the prescribed period is 1 month from the revocation of the order under subsection 152 (3) of the Act that relates to the application.

[99] Regulation 17.1

substitute

17.1 Application for declaration: exploitation of innovation patent

An application under subsection 169 (1) of the Act for a declaration that an innovation patent has been exploited by the Crown under section 163 of the Act must include the date on which the innovation patent was certified.

17.1A Prescribed period: order relating to standard patent

For subsection 174 (2) of the Act, the prescribed period is 1 month from the revocation of an order under subsection 173 (1) of the Act that relates to the application.

[100] Subregulation 19.1 (1)

omit

For the purposes of section 187 of the Act (“registration of particulars of patents etc.”),

insert

For subsections 187 (1) and (2) of the Act,

[101] Paragraph 19.1 (1) (d)

omit

standard

[102] Subregulations 22.2 (2) and (3)

substitute

- (2) The fees are payable as follows:
 - (a) the fee for filing an application, request or other document is payable when the application, request or other document is filed;
 - (b) the fee for appearing at a hearing is payable immediately before the hearing;
 - (c) the fee for making a representation mentioned in item 11 of Part 2 is payable when the representation is made.

- (3) If an item specifies the person by whom a fee is payable, the fee is payable by that person.
- (4) For paragraph 89 (3) (b) of the Act:
 - (a) if a PCT application is to be treated as an application for a standard patent:
 - (i) the fees specified in item 3 of Part 2 of Schedule 7 are payable in respect of the application for a standard patent; and
 - (ii) if the PCT application was filed in the Patent Office as a receiving office for the purposes of the PCT — the fees specified in item 1 of Part 3, and items 1 to 4 of Part 4, of Schedule 7 are payable in respect of the PCT application; and
 - (b) the fees specified in item 3 of Part 2 of Schedule 7 are not payable in respect of a PCT application.

[103] Regulation 22.2A

substitute

22.2A Failure to pay: patent attorneys fees

The Designated Manager or the Board must not process an application mentioned in Part 1 of Schedule 7 if the fee payable for the application has not been paid.

22.2B Failure to pay: filing fees for patent requests

- (1) This regulation applies if:
 - (a) a fee mentioned in item 1, 2 or 3 of Part 2 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 2 months after the date of the invitation; and
 - (c) the fee is not paid within the 2 month period.
- (2) The application lapses, or the patent ceases, at the end of the 2 month period.

22.2C Failure to pay: certain other filing fees etc

- (1) This regulation applies if:
 - (a) a fee mentioned in item 4, paragraph (a) of item 4B, item 5, 6, 8, 9, 10, 11, paragraph (a) or (c) of item 15, item 16, 17, 19, 27, 29, 30 or 32 of Part 2 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and

- (c) the fee is not paid within the 1 month period.
- (2) The application, representation, request or other relevant document is taken not to have been filed or made.

Act **22.2D Failure to pay: fees payable by patentee for requests under s 101A (b) of the**

- (1) Subregulation (2) applies if:
 - (a) a fee mentioned in item 4A of Part 2 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the patentee to pay the fee within 1 month after the date of the invitation; and
- (c) the fee is not paid within the 1 month period.
- (2) The innovation patent ceases at the end of the 1 month period.
- (3) Subregulation (4) applies if:
 - (a) a fee mentioned in paragraph (b) of item 4B of Part 2 of Schedule 7 (the *paragraph (b) fee*) is not paid when it is payable; and
 - (b) within 1 month after the fee mentioned in paragraph (a) of that item is paid for the request to which the paragraph (b) fee relates, the Commissioner invites the patentee to pay the paragraph (b) fee within 2 months after the date of the invitation; and
- (c) the fee is not paid within the 2 month period.
- (4) The innovation patent ceases at the end of the 2 month period.

22.2E Failure to pay: response fee

- (1) This regulation applies if:
 - (a) the fee mentioned in item 22 of Part 2 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
- (c) the fee is not paid within the 1 month period.
- (2) The application to which the response relates lapses.

22.2F Consequence if Commissioner does not invite payment

- (1) This regulation applies if:

- (a) a fee mentioned in regulation 22.2B, 22.2C, 22.2D or 22.2E is not paid when it is payable; and
 - (b) the Commissioner does not give the invitation mentioned in the relevant regulation within the time allowed.
- (2) The application, representation, request or other relevant document is to be treated as if the fee had been paid when the application, representation, request or other document was filed or made.
- (3) Despite subregulation (2), the fee remains payable and can be recovered as a debt due to the Commonwealth.

22.2G Failure to pay: hearing fees

- (1) Subregulation (2) applies if:
- (a) the fee mentioned in paragraph (b) of item 20 of Part 2 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person making the request to pay the fee within 1 month after the date of the invitation or before the date of the hearing, whichever is earlier; and
 - (c) the fee is not paid within the earlier of the periods mentioned in paragraph (b).
- (2) The request is taken not to have been made.
- (3) A hearing cannot be held if the fee mentioned in paragraph (b) of item 20 of Part 2 of Schedule 7 has not been paid for the hearing.
- (4) A person cannot appear at a hearing if the fee mentioned in item 21 of Part 2 of Schedule 7 has not been paid for the appearance.

22.2H Failure to pay: certain fees for actions by Commissioner

- (1) This regulation applies to a fee mentioned in item 14, paragraph (b) of item 15, paragraph (a) of item 20, item 23, 24, 25, 26, 28 or 31 of Part 2 of Schedule 7.
- (2) The Commissioner must not process a request or application for which such a fee is payable if the fee has not been paid.
- (3) If the fee mentioned in paragraph (b) of item 15 of Part 2 of Schedule 7 is paid for a request, the request is taken to have been made on the date on which the fee was paid.
- (4) If:
- (a) the fee is not paid when it is payable; and
 - (b) the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
 - (c) the fee is not paid within the 1 month period;
- the request or application is taken not to have been made.

[104] Paragraph 22.5 (a)

substitute

- (a) must be paid into a Special Account established under section 20 of the *Financial Management and Accountability Act 1997*; and

[105] Paragraph 22.5 (b)

omit

Fund

insert

Special Account

[106] Subregulation 22.6 (2)

substitute

- (2) If acceptance of a patent request and complete specification for a standard patent has been delayed because of an error or omission on the part of an employee, the period mentioned in subregulation (3) is not, for the purposes of ascertaining the amount of a fee, to be taken into account.
- (3) For subregulation (2), the period is the period that the Commissioner believes, on reasonable grounds, is equal to the period of delay that resulted from the error or omission.

[107] After subregulation 22.8 (2)

insert

- (2A) A party to proceedings may request taxation of an amount awarded under subregulation (2).

[108] Subregulation 22.8 (3)

omit

An amount referred to in subregulation (2)

insert

If a request for taxation is made, the amount

[109] Before regulation 22.9

insert

22.8A Filing of documents

For section 214 of the Act, fax is a prescribed means of filing documents.

[110] Subregulation 22.10 (3)

omit

regulation 5.3 (“filing of opposition”)

insert

regulation 5.3 or 5.3AA

[111] After regulation 22.10

insert

22.10A Address for correspondence

- (1) If provision is made in an approved form to state an address for correspondence, the person completing the form may state an address to which all correspondence from the Commissioner can be sent.
- (2) A person may file notice of a change of his or her address for correspondence.
- (3) The address for correspondence need not be in Australia.

[112] After subregulation 22.11 (1)

insert

- (1A) Subregulation (1B) applies if:
 - (a) an application for an extension of time for doing a relevant act is made under subsection 223 (2) of the Act; and
 - (b) the relevant act has not been done; and
 - (c) a notice of opposition to the grant of the application is filed.
- (1B) If the Commissioner grants the application, the Commissioner must extend the time to include the period from the day on which the notice of opposition 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.

[113] Subregulation 22.11 (3)

substitute

- (3) For subsection 223 (4) and paragraph 223 (9) (b) of the Act:
 - (a) the payment of a continuation fee or a renewal fee within the 6 month period mentioned in subregulation 13.3 (1A) or 13.6 (2) is a prescribed relevant act; and
 - (b) the prescribed circumstances are that the fee is not paid within that 6 month period mentioned in subregulation 13.3 (1A) or 13.6 (2).
- (4) For 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, other than an action or step taken under regulation 5.3 or 5.3AA, paragraph 5.4 (a) or subparagraph 5.8 (1) (a) (i);
 - (b) filing, during the term of a standard patent as required by subsection 71 (2) of the Act, an application under subsection 70 (1) of the Act for an extension of the term of the patent.

[114] Subregulation 22.21 (1)

substitute

- (1) The following provisions of this regulation are prescribed for subsections 41 (4), 150 (4) and 223 (9) of the Act.

[115] Subregulation 23.4 (2)

substitute

- (2) If provisions specified in subregulation (1) continue to apply, the following provisions do not apply to the opposition referred to in that subregulation:
 - (a) sections 104 and 223 of the Act;
 - (b) Chapter 5 and regulations 22.21, 22.22 and 22.23 of these Regulations.

[116] After regulation 23.31

insert

23.32 Transitional: priority date and date of patent for innovation patent application that is a divisional application of a petty patent or petty patent application

- (1) For an innovation patent that is a divisional application of a petty patent or a petty patent application under section 39 of the old Act:
 - (a) the priority date of the innovation patent is the date that would have been the priority date of the application under paragraph 3.12 (1) (c) of the old Regulations if the innovation patent application had been filed as a divisional application under section 39 of the old Act; and
 - (b) the date of the innovation patent is the date that would have been the date of the patent under paragraph 6.3 (1) (f) or (g) of the old Regulations if the innovation patent application had been filed as a divisional application under section 39 of the old Act.
- (2) In this regulation:

old Act means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

old Regulations means the *Patents Regulations 1991* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

23.33 Transitional: examination of innovation patents converted from petty patent applications

- (1) This regulation applies if:
 - (a) an innovation patent has been granted; and
 - (b) the application for the innovation patent was converted from an application for a petty patent; and
 - (c) the Commissioner had begun to consider the petty patent application, or had begun to make any investigations in relation to the petty patent application, under section 50 of the old Act; and
 - (d) the innovation patent is to be examined under Part 1 of Chapter 9A of the Act.
- (2) In examining the innovation patent, the Commissioner is not required to consider the results of:
 - (a) the consideration of the petty patent application; or
 - (b) any investigations made in relation to the petty patent application.

- (3) In this regulation:

old Act means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

23.34 Transitional: certain PCT applications

- (1) This regulation applies to a PCT application that:

- (a) is made on or after the commencement day; and
- (b) would, if the old Act applied to the application, be an application to which paragraph 88 (2) (a) of the old Act applied.

- (2) The application is to be treated as an application for a standard patent.

- (3) In this regulation:

commencement day means the day the *Patents Amendment (Innovation Patents) Act 2000* commences.

old Act means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

23.35 Transitional: payment of fees for petty patents

- (1) This regulation makes provision in respect of the payment of fees payable for petty patents to which the old Act applies under Part 1 of Schedule 2 to the *Patents Amendment (Innovation Patents) Act 2000*.

- (2) Subregulations (3) and (4) apply to an application for which the fee mentioned in item 13 of Part 2 of Schedule 7 to the old Regulations is payable.

- (3) If:

- (a) the fee is not paid when the application is made; and
- (b) within 1 month after the application is made, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and

- (c) the fee is not paid within the 1 month period;

the application is taken not to have been made.

- (4) If the fee is paid, the application is taken to have been made on the date on which the fee was paid.

- (5) Subregulations (6), (7) and (8) apply to a request for which the fee mentioned in paragraph (b) of item 15 of Part 2 of Schedule 7 to the old Regulations is payable.

- (6) The Commissioner must not process the request if the fee has not been paid.

- (7) If:

- (a) the fee is not paid when the request is made; and
- (b) within 1 month after the request is made, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
- (c) the fee is not paid within the 1 month period;

the request is taken not to have been made.

(8) If the fee is paid, the request is taken to have been made on the date on which the fee was paid.

(9) In this regulation:

old Act means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

old Regulations means the *Patents Regulations 1991* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

[117] Schedule 3, heading

substitute

Schedule 3 Formal requirements for documents to be filed

(paragraph 3.2A (1) (c), subparagraph 3.2B (1) (a) (ii), paragraph 10.2 (1) (a) and subregulation 22.16 (2))

[118] Schedule 3, subclause 5 (2)

omit

the sheets of a specification

insert

if a specification is numbered in accordance with subclause 6 (2), the sheets of the specification

[119] Schedule 3, clause 6

substitute

6 Numbering of lines or paragraphs

- (1) A specification must be numbered in accordance with subclause (2) or (3).
- (2) Every fifth line on each sheet of the specification must be numbered:
 - (a) in arabic numerals beginning with '1'; and
 - (b) on the left side of the sheet to the right of the margin.
- (3) The paragraphs of the specification must be numbered:

- (a) sequentially from the first paragraph of the description of the specification;
and
- (b) in arabic numerals beginning with '1'; and
- (c) on the left side of the sheet to the right of the margin; and
- (d) on the first line of each paragraph.

[120] Schedule 3, after clause 12

insert

13 Electronic documents

A document that is filed in electronic form must be in the approved form.

14 Scandalous matter

A complete application must not contain or consist of scandalous matter.

[121] Schedule 7, Part 1, item 3

omit

A report

insert

Applying for a report

[122] Schedule 7, Part 2, item 2

substitute

2 On filing a request for an innovation patent accompanied by a complete specification:

- (a) for online filing; or \$150
- (b) for filing by another means \$180

[123] Schedule 7, Part 2, item 4, column 2

before

patent request

insert

standard

[124] Schedule 7, Part 2, after item 4

insert

4A	On filing a request under paragraph 101A (b) of the Act, by the patentee of an innovation patent, for examination of the complete specification relating to the innovation patent	\$290
4B	On filing a request under paragraph 101A (b) of the Act, by a person other than the patentee of the innovation patent, for examination of the complete specification relating to the innovation patent:	
	(a) payable by the person making the request; and	\$145
	(b) payable by the patentee	\$145

[125] Schedule 7, Part 2, item 6, column 2

after

97 (2)

insert

or paragraph 101G (1) (b)

[126] Schedule 7, Part 2, after item 7

insert

7A	Renewal fee under paragraph 143A (d) of the Act for:	
	(a) the second anniversary	\$100
	(b) the third anniversary	\$100
	(c) the fourth anniversary	\$100
	(d) the fifth anniversary	\$165
	(e) the sixth anniversary	\$200
	(f) the seventh anniversary	\$235
	plus:	
	if paid within 6 months after the anniversary	in addition to any other fee payable in relation to this item — \$65 for each month, or part of a month, in the period between the anniversary and the day when the fee is paid

[127] Schedule 7, Part 2, item 8, column 2

after

5.3

insert

or 5.3AA

[128] Schedule 7, Part 2, item 11, column 2

after

5.3A

insert

or 5.3B

[129] Schedule 7, Part 2, item 13

omit

[130] Schedule 7, Part 2, item 15

substitute

15 On filing a request for leave to amend:

- (a) a complete specification relating to an application for a standard patent before a request for examination is filed or after the complete specification is accepted; or \$105
- (b) a patent request for an innovation patent to make it a patent request for a standard patent; or \$105
- (c) an innovation patent: \$105
 - (i) after the patent is granted but before a request for examination is filed; or
 - (ii) after the patent is certified

[131] Schedule 7, Part 2, item 18

omit

[132] Schedule 7, Part 2, items 23 and 24, column 2

omit

For supply

insert

On requesting the supply

[133] Schedule 7, Part 2, item 28, column 2

omit

or 48

insert

, 48 or 101B

[134] Schedule 7, Part 2, item 29, column 2

omit

3.2 (4)

insert

3.2A (2)

[135] Schedule 7, Part 2, item 31, column 2

omit

For taxing costs

insert

On requesting the taxing of costs

[136] Schedule 7, Part 2, items 33 and 34

omit

[137] Further amendments — removal of certain references

<i>Provision</i>	<i>omit</i>
Regulation 1.3, definition of <i>acceptance</i> , paragraph (a)	(“acceptance of patent request: standard patent”)
Regulation 1.7	(“certain international applications to be taken to have been given an international filing date”)
Subregulation 2.1 (1)	(“directions to co-owners”)
Subregulation 2.2 (2)	(“validity not affected by certain publication or use”)
Subregulation 2.3 (1)	(“validity not affected by certain publication or use”)
Paragraph 2.3 (1) (a)	(“publication or use: prescribed circumstances and periods”)
Subregulation 2.4 (1)	(“validity: patents of addition”)
Regulation 2.5	(“notice of matters affecting validity of standard patents”)
Subregulation 3.1 (1)	(“application for patent”)
Paragraph 3.1 (2) (d)	(“deposit requirements”)
Paragraph 3.1 (2) (e)	(“applications by eligible persons arising out of court proceedings”)
Regulation 3.7	(“applications by eligible persons following revocation by

<i>Provision</i>	<i>omit</i>
	Commissioner”)
Regulation 3.7	(“other applications by eligible persons”)
Regulation 3.8	(“application for patent”)
Paragraph 3.8 (b)	(“applications by eligible persons arising out of court proceedings”)
Paragraph 3.8 (c)	(“applications by eligible persons following revocation by Commissioner”)
Paragraph 3.8 (d)	(“other applications by eligible persons”)
Regulation 3.10	(“time for making complete application”)
Subregulation 3.12 (1)	(“priority dates: certain persons and applications”)
Subregulation 3.12 (1)	(“priority dates: certain amended claims”)
Paragraph 3.12 (2) (a)	(“time for making complete application”)
Subregulation 3.12 (2B)	(“withdrawn, abandoned or refused applications”)
Subregulation 3.12 (4)	(“withdrawn, abandoned or refused applications”)
Regulation 3.14	(“priority date of certain amended claims”)
Paragraph 3.14 (a)	(“modified application of Act”)
Subregulation 3.15 (1)	(“request for examination”)
Subregulation 3.16 (1)	(“request for examination”)
Subregulation 3.17 (1)	(“request for examination”)
Paragraph 3.18 (3) (a)	(“deposit requirements”)
Paragraph 3.18 (3) (b)	(“requests for deferment of examination or modified examination”)
Subregulation 3.18 (4)	(“notice of matters affecting validity of standard patents”)
Subregulation 3.19 (2)	(“amendments”)
Subregulation 3.20 (1), definition of <i>prescribed foreign country</i>	(“prescribed foreign countries: requests for deferment of examination and modified examination”)
Subregulation 3.20 (2)	(“request for deferment of examination”)
Paragraph 3.20 (2) (b)	(“time for making complete application”)
Subregulation 3.20 (3)	(“request for modified examination”)
Regulation 3.21	(“request for deferment of examination”)
Regulation 3.21	(“request for modified examination”)
Subparagraph 3.25 (4) (f) (ii)	(“compulsory licences”)
Subparagraph 3.25 (4) (g) (ii)	(“exploitation of inventions by Crown”)
Subregulation 3.26 (1)	(“request for Commissioner’s certificate authorising release of sample of a micro-organism”)
Subregulation 3.26 (4)	(“deposit requirements”)
Paragraph 3.26 (5) (a)	(“notification that a deposit requirement has ceased to be satisfied”)

<i>Provision</i>	<i>omit</i>
Paragraph 3.26 (5) (b)	("specifications: micro-organisms")
Paragraph 3.26 (5) (b)	("prescribed period: deposit requirements taken to be satisfied")
Regulation 3.27	("breach of undertakings given in respect of micro-organisms")
Subregulation 3.28 (1)	("breach of undertakings given in respect of micro-organisms")
Paragraph 3.28 (2) (d)	("request for Commissioner's certificate authorising release of sample of a micro-organism")
Subregulation 3.29 (1)	("deposit requirements")
Regulation 3.30	("specifications: micro-organisms")
Paragraph 3.30 (b)	("deposit requirements")
Subparagraph 3.30 (c) (i)	("notification that a deposit requirement has ceased to be satisfied")
Subregulation 3.31 (1)	("micro-organisms ceasing to be reasonably available")
Subregulation 3.31 (1)	("specifications")
Regulation 4.1	("publication of certain information about applicants etc.")
Subregulation 4.2 (1)	("notice of publication")
Paragraph 4.2 (3) (b)	("priority dates generally")
Subregulation 5.3 (1)	("opposition to grant of standard patent")
Subregulation 5.3 (1)	("acceptance of patent request: standard patent")
Subregulation 5.3 (2)	(opposition to grant of extension)
Subregulation 5.3 (2)	(acceptance or refusal of application)
Subregulation 5.3 (3)	("amendments by applicants and patentees")
Subregulation 5.3 (3)	("Commissioner to grant leave to amend")
Subregulation 5.3 (4)	("what amendments are not allowable?")
Subregulation 5.3 (5)	("extensions of time")
Subregulation 5.3 (5A)	("correction of Register or patent")
Paragraph 5.3 (6) (a)	("protection or compensation of certain persons")
Paragraph 5.5 (1) (b)	("re-examination of complete specifications)
Paragraph 5.5 (1) (b)	("completion of re-examination")
Subregulation 5.6 (1)	("re-examination of complete specifications")
Subregulation 5.6 (1)	("completion of re-examination")
Regulation 5.7	("re-examination of complete specifications")
Paragraph 5.7 (a)	("completion of re-examination")
Paragraph 5.9 (1) (a)	("filing of statement")
Paragraph 5.9 (2) (c)	("opposition to grant of standard patent")
Subregulation 5.10 (3)	("amendments directed by Commissioner: patent applications")
Regulation 6.1	("grant of standard patent")

<i>Provision</i>	<i>omit</i>
Subregulation 6.2 (1)	("grant of standard patent")
Subregulation 6.2 (1)	("acceptance of patent request: standard patent")
Regulation 6.4	("sealing of duplicate of patent")
Regulation 7.2	("revocation of patent and grant of patent of addition instead")
Subparagraph 8.1 (2) (d) (i)	("modified application of Act")
Paragraph 8.1 (3) (a)	("application for patent")
Subregulation 8.2 (2)	("modified application of Act")
Subregulation 8.3 (3)	("lapsing of applications")
Subregulation 8.3 (4)	("extensions of time")
Subregulation 8.4 (1)	("notice of publication")
Paragraph 8.4 (2) (a)	("prescribed documents: public inspection")
Subregulation 8.5 (2)	("Convention applicants may make Convention applications")
Subregulation 8.6 (1)	("manner of making Convention application")
Regulation 8.7	("withdrawn, abandoned or refused applications")
Subregulation 9.1 (1)	("re-examination of complete specifications")
Subregulation 9.1 (2)	("opposition")
Subregulation 9.3 (2)	("opposition")
Paragraph 9.4 (2) (a)	("opposition")
Regulation 9.5	("re-examination of complete specifications")
Paragraph 9.5 (a)	("statement by applicant or patentee")
Subparagraph 9.5 (a) (i)	("amendments directed by Commissioner: patent applications")
Subparagraph 9.5 (a) (i)	("report on re-examination")
Subregulation 10.1 (1)	("amendments by applicants and patentees")
Subregulation 10.2 (1)	("amendments by applicants and patentees")
Paragraph 10.2 (1) (a)	("form of amendments")
Paragraph 10.2 (1) (c)	("amendments not allowable")
Paragraph 10.2 (8) (a)	("request for Commissioner's certificate authorising release of sample of a micro-organism")
Paragraph 10.2 (8) (c)	("deposit requirements")
Subregulation 10.2 (9)	("notification that a deposit requirement has ceased to be satisfied")
Paragraph 10.3 (2) (a)	("deposit requirements")
Paragraph 10.3 (4) (a)	("Commissioner to consider and deal with requests for leave to amend")
Paragraph 10.4 (a)	("amendments not allowable")
Paragraph 10.4 (b)	("form of amendments")

<i>Provision</i>	<i>omit</i>
Regulation 10.10	("amendments directed by court")
Regulation 10.11	("amendments directed by Commissioner: patents")
Regulation 10.12	("amendments directed by Commissioner: patent applications")
Regulation 10.14	("persons claiming under assignment or agreement")
Subregulation 12.1 (1)	("compulsory licences")
Subregulation 12.3 (1)	("revocation on surrender of patent")
Regulation 13.1	("withdrawal of applications")
Regulation 13.2	("lapsing of applications")
Subregulation 13.4 (1)	("lapsing of applications")
Paragraph 13.4 (1) (a)	("request for modified examination")
Paragraph 13.4 (1) (a)	("examination")
Paragraph 13.4 (1) (b)	("modified examination")
Paragraph 13.4 (1) (c)	("request for modified examination")
Paragraph 13.4 (1) (e)	("disputes between applicants etc.")
Subparagraphs 13.4 (1) (f) (i) and (g) (i)	("other applications by eligible persons")
Regulation 13.5	("lapsing of applications")
Subregulation 15.2 (2)	("application for patent")
Subregulation 17.2 (1)	("international applications treated as applications under this Act")
Subregulation 17.2 (2)	("application for patent")
Paragraph 19.1 (1) (e)	("amendments directed by court")
Paragraph 19.1 (1) (f)	("Commissioner to be given copies of orders")
Paragraph 19.1 (1) (h)	("re-examination")
Paragraph 19.1 (1) (i)	("acquisitions by and assignments to the Crown")
Paragraph 19.1 (1) (i)	("the Crown")
Subregulation 19.2 (1)	("information obtainable from the Commissioner")
Regulation 20.1, definition of <i>former attorney</i>	("discipline")
Regulation 20.1, definition of <i>Register of Patent Attorneys</i>	("registration of patent attorneys")
Paragraph 20.4 (d)	("requirements for registration")
Subregulation 20.7 (2)	(Supplementary Board examination)
Subparagraph 20.19 (a) (i)	(annual registration fee)
Regulation 20.19	("annual registration fee")
Subregulation 20.21 (2)	("complaints")

<i>Provision</i>	<i>omit</i>
Regulation 20.24	("decision of Disciplinary Tribunal")
Paragraph 20.25 (1) (b)	("decision of Disciplinary Tribunal")
Paragraph 20.31 (1) (b)	("disclosure of interest")
Paragraph 20.42 (6) (c)	("disclosure of interest")
Paragraph 20.43 (3) (b)	("disclosure of interest")
Regulation 20.44	("Disciplinary Tribunal: substantive appointments")
Regulation 20.44	("Disciplinary Tribunal: acting appointments")
Regulation 20.44	("disclosure of interest")
Subregulation 22.2 (1)	("fees")
Subregulation 22.3 (1)	("fees")
Regulation 22.5	("fees for international applications payable for the benefit of the International Bureau")
Paragraph 22.5 (a)	("Trust Fund")
Paragraph 22.9 (a)	("death of applicant or nominated person")
Subregulation 22.11 (1)	("extensions of time")
Subregulation 22.16 (5)	("amendments")
Subregulation 22.26 (5)	("review of decisions")
Paragraphs 23.2 (a) and 23.3 (1) (a)	("applications under 1952 Act")
Subregulation 23.3 (2)	("opposition")
Regulation 23.5	("opposition to grant: practice and procedure")
Regulation 23.5	("certain opposition: practice and procedure")
Paragraph 23.6 (b)	("opposition to grant: practice and procedure")
Paragraph 23.6 (b)	("certain opposition: practice and procedure")
Regulation 23.7	("request for Commissioner's certificate authorising release of sample of a micro-organism")
Regulation 23.7	("opposition")
Paragraph 23.11 (1) (a)	("infringement by supply of products")
Subregulation 23.12 (1)	("applications under 1952 Act")
Subregulation 23.12 (2)	("withdrawn, abandoned or refused applications")
Regulation 23.13	("certificate of validity")
Subregulation 23.16 (1)	("examination")
Subregulation 23.16 (1)	("modified examination")
Regulation 23.17	("modified application of Act")
Paragraph 23.17 (a)	("applications under 1952 Act")

<i>Provision</i>	<i>omit</i>
Regulation 23.19	(“examination to be conducted”)
Subregulation 23.20 (5)	(“requirements for registration”)
Subregulation 23.21 (1)	(“establishment of Board”)
Regulation 23.22	(“Secretary to Board”)
Regulation 23.23	(“Disciplinary Tribunal: substantive appointments”)
Subregulation 23.25 (2)	(“general fees”)
Subregulation 23.25 (4)	(“prescribed period: continuation fees”)

Notes

1. These Regulations amend Statutory Rules 1991 No. 71, as amended by 1991 No. 456; 1992 No. 148; 1993 Nos. 113, 227, 340 and 341; 1994 Nos. 182, 317 and 387; 1995 Nos. 16, 20, 82 and 427; 1996 No. 271; 1997 Nos. 192 and 345; 1998 Nos. 45, 56, 141, 241, 257, 264, 291, 319, 342 and 345; 1999 Nos. 154, 184, 261 and 349; 2000 No. 317.
2. Notified in the *Commonwealth of Australia Gazette* on 23 May 2001.