



Patents Amendment Regulations 2002 (No. 1)¹

Statutory Rules 2002 No. 59²

I, PETER JOHN HOLLINGWORTH, 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*.

Dated 27 March 2002

PETER HOLLINGWORTH
Governor-General

By His Excellency's Command

IAN MACFARLANE
Minister for Industry, Tourism and Resources

1 Name of Regulations

These Regulations are the *Patent Amendment Regulations 2002 (No. 1)*.

2 Commencement

These Regulations commence on 1 April 2002.

3 Amendment of *Patents Regulations 1991*

Schedule 1 amends the *Patents Regulations 1991*.

4 Transitional

- (1) The amendment made by item [3] of Schedule 1 applies to information made publicly available on or after 1 April 2002.
- (2) The amendment made by item [19] of Schedule 1 does not apply to an application that has lapsed because of paragraph 142 (2) (f) of the Act.
- (3) The amendment made by item [28] of Schedule 1 applies to an application made on or after 1 April 2002.

Schedule 1 Amendments
(regulation 3)**[1] Subregulation 1.4 (2)**

omit

1 January 2002

insert

1 April 2002

[2] Regulation 2.2, heading

substitute

2.2 Publication or use: prescribed circumstances

[3] After subregulation 2.2 (1)

insert

- (1A) For paragraph 24 (1) (a) of the Act, the circumstance that there was a publication or use of the invention within 12 months before the filing date of the complete application, is a prescribed circumstance.

[4] **Subregulation 2.2 (2)**

omit

For the purposes of paragraph 24 (1) (a) of the Act, the following circumstances are prescribed:

insert

For paragraph 24 (1) (a) of the Act the following are also prescribed circumstances:

[5] **Regulation 2.3, heading**

substitute

2.3 Publication or use: prescribed periods

[6] **Before subregulation 2.3 (1)**

insert

(1A) For information of the kind referred to in paragraph 24 (1) (a) of the Act, if the applicant relies on the circumstance in subregulation 2.2 (1A), the prescribed period is the period of 12 months after the information was first made publicly available.

[7] **Subregulation 2.3 (1)**

omit

For the purposes of subsection 24 (1) of the Act, in the case of information of the kind referred to in paragraph 24 (1) (a) of the Act, the prescribed period is:

insert

For information of the kind referred to in paragraph 24 (1) (a) of the Act, if the applicant relies on a circumstance in subregulation 2.2 (2), the prescribed period is:

[8] **After subregulation 2.3 (2)**

insert

(3) Subregulation (4) applies:

(a) if an application for a patent is a divisional application:

(i) under section 79B of the Act for an invention disclosed in the specification filed with a previous application for a standard patent (the *original application*); or

(ii) under section 79C of the Act for an invention disclosed in the specification filed in respect of an application for an innovation patent (the *original application*); and

(b) only to information disclosed in the divisional application that was disclosed in the original application.

(4) For determining the prescribed period for subsection 24 (1) of the Act, the filing date of the divisional application is taken to be the filing date of the original application.

[9] Paragraph 3.2B (1) (d)

omit

6A.1

insert

6A.1, 6A.2

[10] Paragraph 3.2B (1) (g)

omit

Act.

insert

Act;

[11] After paragraph 3.2B (1) (g)

insert

(h) if the application is a divisional application made under section 79B of the Act in relation to an original application that is a PCT application, the complete specification for the PCT application must be open to public inspection.

[12] Subregulation 3.2B (2)

omit

(e) or (f),

insert

(e), (f) or (h),

[13] After subregulation 3.3 (5)

insert

(6) 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.

(7) Information in an abstract filed with the complete application may be taken into account in determining, for subsection 102 (1) of the Act, whether a matter was in substance disclosed in the specification as filed.

[14] Subregulation 3.4 (8)

omit

[15] Paragraph 3.5A (4) (b)

substitute

- (b) in any other case — the period ending on the earlier of:
 - (i) 2 months after the filing date; and
 - (ii) the time of acceptance.

[16] After regulation 3.17

insert

3.17A Results of documentary searches — standard patent

- (1) For subsection 45 (3) of the Act, an applicant informs the Commissioner of the results of documentary searches by providing the following:
 - (a) if a patent office has conducted a search and has prepared a report of the search — the report;
 - (b) if a patent office has conducted a search but has not prepared a report of the search — a list of the documents cited by the patent office;
 - (c) if the applicant or another party has conducted a search — a list of documents that are the result of the search.
- (2) The applicant must inform the Commissioner of the results of any documentary searches by the latest of:
 - (a) the time the applicant asks, under section 44 of the Act, for an examination of the patent request and specification relating to the application; and
 - (b) 6 months after the search is completed; and
 - (c) 1 January 2003.
- (3) In this regulation, the date a search is completed is:
 - (a) for a search conducted by the applicant — the date when the applicant completed the search; or
 - (b) for a search conducted by another party — the date when the other party informed the applicant or the applicant's representative of the results of the search.

[17] Subregulation 5.8 (1A)*substitute*

(1A) For subparagraph (1) (a) (ii), the period is within 3 months after the day when the opponent served on the applicant a copy of the statement mentioned in paragraph 5.4 (a).

[18] Paragraph 5.10 (2) (c)*after*

served

insert

a copy of

[19] Subregulation 8.1 (4)*substitute*

(4) The applicant must meet the requirements of subsection 89 (3) of the Act within the period of 31 months after the priority date of the application.

[20] Regulation 9.1*substitute***9.1 Notice of Commissioner's decision to re-examine complete specification**

If the Commissioner decides, under subsection 97 (1) of the Act, to re-examine a complete specification relating to an application for a patent, the Commissioner must tell:

- (a) the applicant; and
- (b) if the application is opposed under section 59 of the Act — each opponent.

[21] After regulation 9A.2*insert***9A.2A Results of documentary searches — innovation patent**

- (1) For section 101D of the Act, a patentee informs the Commissioner of the results of documentary searches by providing the following:
 - (a) if a patent office has conducted a search and has prepared a report of the search — the report;
 - (b) if a patent office has conducted a search but has not prepared a report of the search — a list of the documents cited by the patent office;

- (c) if the patentee or another party has conducted a search — a list of documents that are the result of the search.
- (2) The patentee must inform the Commissioner of the results of any documentary searches by the latest of:
- (a) if the Commissioner decides, under paragraph 101A (a) of the Act, to examine the complete specification relating to an innovation patent — 3 months after the Commissioner tells the patentee under subregulation 9A.1 (2); and
 - (b) if the patentee asks, under paragraph 101A (b) of the Act, for an examination of the complete specification relating to an innovation patent — that time; and
 - (c) if another person asks for an examination under paragraph 101A (b) of the Act — when the patentee pays the fee mentioned in paragraph (b) of item 4B of Part 2 of Schedule 7; and
 - (d) 3 months after the search is completed.
- (3) In this regulation, the date a search is completed is:
- (a) for a search conducted by the patentee — the date when the patentee completed the search; or
 - (b) for a search conducted by another party — the date when the other party informed the patentee or the patentee's representative of the results of the search.

[22] Paragraph 9A.4 (d)

omit

made.

insert

made;

[23] After paragraph 9A.4 (d)*insert*

- (e) if:
 - (i) the Commissioner has informed the patentee of a notice under subsection 28 (1) of the Act; or
 - (ii) the patentee has informed the Commissioner, under section 101D of the Act, of the results of any documentary searches;

and a ground for revocation is raised based on information in the notice or the search results — the period of 3 months from the date of the report that first mentions the ground for revocation.

[24] Subregulation 13.3 (2)*omit***[25] Paragraph 13.4 (1) (k)***omit*

request.

insert

request;

[26] After paragraph 13.4 (1) (k)*insert*

- (l) if:
 - (i) the Commissioner has informed the applicant of a notice under subsection 27 (1) of the Act; or
 - (ii) the applicant has informed the Commissioner, under subsection 45 (3) of the Act, of the results of any documentary searches;

and an objection is raised based on information in the notice or the search results — the period of 3 months from the date of the report that first mentions the objection.

[27] Subregulation 13.4 (2)*omit*

(k)

insert

(l)

[28] After subregulation 13.6 (3)*insert*

- (4) If an application for an innovation patent is made under section 79B or 79C of the Act, a renewal fee that is payable within 1 month after the grant of the patent is taken to have been paid.

[29] After regulation 13.6*insert***13.7 Prescribed period: ceasing of innovation patents**

For paragraph 143A (c) of the Act, the prescribed period is the period mentioned in regulation 9A.4 that applies to the patent.

[30] Subregulation 19.2 (2)*omit*

3

insert

10

[31] Paragraph 22.2C (1) (a)*after*

19,

insert

19A,

[32] Subregulation 22.11 (1)*after*

subsection 223 (2)

insert

or (2A)

[33] After subregulation 22.11 (1B)*insert*

(1C) For paragraph 223 (2A) (b) of the Act the prescribed period is 2 months after the circumstance that prevented the person from doing the relevant act within the time required ceases to exist.

(1D) For subsection 223 (2B) of the Act the prescribed period is 12 months after the end of the time within which the act is required to be done.

[34] Schedule 2, Patent Cooperation Treaty*omit*

Done at Washington June 19, 1970
amended on October 2, 1979 and modified on February 3, 1984

insert

Done at Washington June 19, 1970,
amended on October 2, 1979
and modified on February 3, 1984 and on October 3, 2001.

[35] Schedule 2, Article 22 (1)*omit each mention of*

20 months

insert

30 months

[36] Schedule 2A, Adoption and amendment dates*omit*

2000 and on October 3, 2000.

insert

2000, on October 3, 2000 and on October 3, 2001.

[37] Schedule 2A, paragraph 90^{bis.1} (a)*substitute*

(a) The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.

[38] Schedule 2A, paragraph 90^{bis}.2 (a)*substitute*

- (a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90^{bis}.4.

[39] Schedule 2A, paragraph 90^{bis}.3 (a)*substitute*

- (a) The applicant may withdraw a priority claim, made in the international application under Article 8 (1), at any time prior to the expiration of 30 months from the priority date.

[40] Schedule 7, Part 2, after item 19*insert*

- 19A For an application for an extension of time under subsection 223 (2A) of the Act:
- | | |
|---------------------------------------|------|
| (a) on filing | \$90 |
| and | |
| (b) for each month or part of a month | \$65 |
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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; 2001 Nos. 98, 184 and 345.
 2. Notified in the *Commonwealth of Australia Gazette* on 28 March 2002.
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