



Patents Amendment Regulations 2003 (No. 2)¹

Statutory Rules 2003 No. 213²

I, PHILIP MICHAEL JEFFERY, 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 14 August 2003

P. M. JEFFERY
Governor-General

By His Excellency's Command

JOE HOCKEY
Minister for Small Business and Tourism

1 Name of Regulations

These Regulations are the *Patents Amendment Regulations 2003 (No.2)*.

2 Commencement

These Regulations commence as follows:

- (a) on gazettal — regulations 1 to 3, and Schedule 1;
- (b) on the commencement of Part 1 of Schedule 2 to the *Intellectual Property Laws Amendment Act 2003* — Schedule 2.

3 Amendment of *Patents Regulations 1991*

Schedule 1 and Schedule 2 amend the *Patents Regulations 1991*.

**Schedule 1 Amendments commencing on gazettal
(regulation 3)****[1] Schedule 3, paragraph 2 (f)**

omit

subject to subparagraph 3.2 (2) (c) (ii) of these Regulations,

[2] Schedule 3, subclause 5 (1)

substitute

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

- (a) patent request;
- (b) description of the invention, other than any sequence listing part of the description;
- (c) claim or claims;
- (d) abstract;
- (e) drawing or drawings;
- (f) sequence listing part of the description, if applicable.

Schedule 2 Amendments commencing on the commencement of Part 1 of Schedule 2 to the Intellectual Property Laws Amendment Act 2003
(regulation 3)

[1] **After regulation 1.3**

insert

1.3A Meaning of *completed* in relation to a search

For these regulations:

A search is *completed* on the earliest of:

- (a) the date, if any, specified in the report as the date that the report was issued; and
- (b) the date, if any, specified in the report as the date that the search was completed; and
- (c) the date that the search results were issued to the applicant or patentee by the foreign patent office.

[2] **Regulation 3.17A**

substitute

3.17A Results of documentary searches — foreign patent office

- (1) For subsection 45 (3) of the Act, an applicant informs the Commissioner of the results of documentary searches by or on behalf of a foreign patent office, other than the European Patent Office or the UK Patent Office, by providing:
 - (a) a list of documents, cited by the foreign patent office; or
 - (b) a copy of the search report issued by the foreign patent office.
- (2) For paragraph (1) (a), it is not necessary to refer in a list to a document that has been included in a list or report in relation to the application, previously provided to the Commissioner for the Act or these Regulations.
- (3) For subsection 45 (3) of the Act, an applicant informs the Commissioner of the results of documentary searches by or on behalf of the European Patent Office or the UK Patent Office:
 - (a) by providing:
 - (i) a list of the documents cited by the patent office; and
 - (ii) for a list provided on or after 26 August 2003 — the symbols used by the patent office to indicate the relevance of the documents; or
 - (b) by providing a copy of the search report issued by the patent office.
- (4) The applicant must inform the Commissioner of the results of a documentary search by the latest of:

- (a) the day 6 months after the search is completed; and
 - (b) the day 6 months after the applicant asks for an examination under section 44 of the Act; and
 - (c) 1 February 2004.
- (5) However:
- (a) if an applicant applies for an extension of time:
 - (i) after the day applicable to the applicant under subregulation (4); and
 - (ii) on or before the day 3 months after the date on which a notice of acceptance is published under paragraph 49 (5) (b) of the Act;

the period within which the applicant must inform the Commissioner of the results of a documentary search is taken to end on the date on which the application is filed in accordance with subregulation (6); and
 - (b) the applicant may inform the Commissioner of the results of the documentary search on that date.
- (6) An application under subregulation (5) must be filed:
- (a) in the approved form; and
 - (b) with:
 - (i) the search results; and
 - (ii) the relevant fee in item 239 in Schedule 7.
- (7) If a single application under subregulation (5) relates to more than 1 set of search results:
- (a) the applicant needs to pay only one fee in respect of all the search results; and
 - (b) the fee is calculated by reference to the search results that require the longest period of extension.
- (8) For subsection 45 (5) of the Act, *completed*, in relation to a search, has the meaning given by regulation 1.3A.

3.17B Prescribed documentary searches by or on behalf of a foreign patent office

For paragraph 45 (3) (a) of the Act, the following documentary searches by or on behalf of a foreign patent office are prescribed (so that information need not be given to the Commissioner):

- (a) for any application — a search that produces a nil result;
- (b) if the application is a PCT application — a search that results in an International Search Report and any additional search conducted during the international preliminary examination;

- (c) if the application (**application A**) is an application which the applicant is permitted to make under subsection 79B (1) of the Act (**a divisional application**):
 - (i) a search, the result of which was disclosed under subsection 45 (3) of the Act in relation to the first-mentioned application for application A under subsection 79B (1) of the Act (**application B**); and
 - (ii) if application B is also a divisional application — a search, the result of which was disclosed under subsection 45 (3) of the Act in relation to the first-mentioned application under subsection 79B (1) of the Act for application B.

Note Under subsection 79B (1) of the Act, if a complete patent application for a patent is made, the applicant may make a further complete application for a patent for an invention:

- (a) disclosed in the specification filed in respect of the first-mentioned application; and
- (b) where the first-mentioned application is for a standard patent and at least 3 months have elapsed since the publication of a notice of acceptance of the relevant patent request and specification in the *Official Journal* — falling within the scope of the claims of the accepted specification.

In paragraph (c), application A is the ‘further complete application’ mentioned in subsection 79B (1) of the Act. It is described in paragraph (c) as a ‘divisional application’. Application B is the ‘first-mentioned application’ in relation to application A. If results of searches have been disclosed in the course of application B, the results do not need to be disclosed again in the course of application A.

However, it is possible under subsection 79B (1) of the Act that application B may also be a divisional application in relation to another application. In that case, there will also be a first-mentioned application for application B. If results of searches have been disclosed in the course of that first-mentioned application, the results do not need to be disclosed again in the course of application A.

- (d) if the application is an application for a patent of addition under Chapter 7 of the Act — a search, the result of which was disclosed under subsection 45 (3) of the Act in relation to the application for the main invention;
- (e) a search, other than a search by or on behalf of the European Patent Office or the UK Patent Office, the result of which:
 - (i) has already been given to the Commissioner under subsection 45 (3) of the Act in relation to the application; or
 - (ii) was contained in the International Search Report;
- (f) a search, the result of which was not received by the applicant.

[3] After regulation 8.1A

insert

8.1B Amendments to a PCT application under Article 34

If:

- (a) a PCT application has been amended under Article 34 of the PCT; and
- (b) the applicant meets the requirements in subsection 89 (3) of the Act after the international preliminary examination report is established;

the description, drawings and claims contained in the application are taken to have been amended for the purposes of the Act on the day on which the amendment under Article 34 of the PCT was made.

Note Subsection 89 (5) of the Act relates to amendments made under Article 34 of the PCT if Australia was elected within the period provided for in Article 39 of the PCT. This regulation applies to amendments made under Article 34 if Australia was elected after the period provided for in Article 39.

[4] Subregulation 9A.2A (1)

substitute

- (1) For subsection 101D (1) of the Act, a patentee informs the Commissioner of the results of documentary searches by or on behalf of a foreign patent office, other than the European Patent Office or the UK Patent Office, by providing:
 - (a) a list of documents, cited by the foreign patent office; or
 - (b) a copy of the search report issued by the foreign patent office.
- (1A) For paragraph (1) (a), it is not necessary to refer in a list to a document that has been included in a list or report in relation to the patent, previously provided to the Commissioner for the Act or these Regulations.
- (1B) For subsection 101D (1) of the Act, a patentee informs the Commissioner of the results of documentary searches by or on behalf of the European Patent Office or the UK Patent Office:
 - (a) by providing:
 - (i) a list of the documents cited by the patent office; and
 - (ii) for a list provided on or after 26 August 2003 — the symbols used by the patent office to indicate the relevance of the documents; or
 - (b) by providing a copy of the search report issued by the patent office.

[5] **Subregulation 9A.2A (3)**

substitute

- (3) For subsection 101D (3) of the Act, ***completed***, in relation to a search, has the meaning given by regulation 1.3A.

[6] **After regulation 9A.2A**

insert

9A.2B Prescribed documentary searches by or on behalf of a foreign patent office

For paragraph 101D (1) (a) of the Act, the following documentary searches by or on behalf of a foreign patent office are prescribed (so that information need not be given to the Commissioner):

- (a) a search that produces a nil result;
- (b) if the application for the patent was converted to an innovation patent application from a standard patent application by an amendment under section 104 of the Act:
 - (i) a search, the result of which was disclosed under subsection 45 (3) of the Act in relation to the standard patent application; and
 - (ii) a search prescribed in regulation 3.17B in relation to the standard patent application;
- (c) if the application for the patent was an application which the patentee was permitted to make under subsection 79B (1) or 79C (1) of the Act (***a divisional application***) — a search, the result of which was disclosed under subsection 45 (3) or 101D (1) of the Act in relation to the first-mentioned application in subsection 79B (1) of the Act or the first patent in subsection 79C (1) of the Act for the divisional application;
- (d) a search, other than a search by or on behalf of the European Patent Office or the UK Patent Office, the result of which has already been given to the Commissioner under subsection 101D (1) of the Act in relation to the patent;
- (e) a search, the result of which was not received by the patentee.

[7] **Paragraph 22.2C (1) (a)**

omit

237 or 238

insert

237, 238 or 239

[8] Subregulation 22.15 (2)*substitute*

- (2) Any other document that is filed must be in English, other than:
- (a) a document that has been translated into English and that has with it a related certificate of verification; or
 - (b) a document containing search results filed under subsection 45 (3) or 101D (1) of the Act.

[9] Schedule 7, after item 238*insert*

- 239 Filing an application to the Commissioner, for an extension of time under subregulation 3.17A (5):
- (a) if the application is filed on or before the date on which notice of acceptance is published \$100 per month or part of a month
 - (b) if the application is filed after the date on which notice of acceptance is published \$150 per month or part of a month

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; 2002 Nos. 59, 100, 173, 263 and 317; 2003 No. 71.
 2. Notified in the *Commonwealth of Australia Gazette* on 21 August 2003.
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