



Patents Amendment Regulations 2004 (No. 3)¹

Statutory Rules 2004 No. 250²

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 19 August 2004

P. M. JEFFERY
Governor-General

By His Excellency's Command

IAN MACFARLANE
Minister for Industry, Tourism and Resources

1 Name of Regulations

These Regulations are the *Patents Amendment Regulations 2004 (No.3)*.

2 Commencement

These Regulations commence on the date of their notification in the *Gazette*.

3 Amendment of *Patents Regulations 1991*

Schedule 1 amends the *Patents Regulations 1991*.

Schedule 1 Amendments (regulation 3)

[1] After subregulation 5.9

insert

5.9A Amendment of statement: additional ground as a result of amendments of the Act by the *US Free Trade Agreement Implementation Act 2004*

- (1) This regulation applies to a statement mentioned in regulation 5.4, a copy of which is served on an applicant before the end of the period ending 3 months after the commencement of Schedule 8 to the *US Free Trade Agreement Implementation Act 2004*.
- (2) Subject to subregulation (3), the Commissioner on the written request of an opponent must amend a statement to add:
 - (a) a ground that the invention is not a patentable invention because it does not comply with paragraph 18 (1) (c) or (d) of the Act; and
 - (b) the particulars relating to the ground.
- (3) The Commissioner must not amend a statement under subregulation (2) unless the opponent has:
 - (a) filed a written request to amend the statement by the earlier of:
 - (i) the end of the period ending 3 months after the commencement of Schedule 8 to the *US Free Trade Agreement Implementation Act 2004*; and
 - (ii) the date on which a patent whose grant is being opposed, and to which the written request relates, is sealed under section 61 of the Act; and
 - (b) at the same time as the written request is filed:
 - (i) applied to the Commissioner in writing, under subregulation 5.10 (4), for permission to serve a copy of further evidence (if any) on which the opponent intends to rely in support of an additional ground mentioned in subparagraph (2) (a); or

- (ii) given to the Commissioner a statement that the opponent does not intend to rely on any further evidence in relation to the additional ground.

- (4) The Commissioner must give the applicant a copy of the statement as amended under subregulation (2).

[2] Paragraph 5.10 (1) (b)

omit

(except in regulation 5.3 or 5.3AA, paragraph 5.4 (a) or subparagraph 5.8 (1) (a) (i))

insert

(except in regulation 5.3 or 5.3AA, paragraph 5.4 (a), subparagraph 5.8 (1) (a) (i) or regulation 5.9A)

[3] Subregulation 5.10 (2)

omit

(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))

insert

(not being a step that is taken under regulation 5.3 or 5.3AA, paragraph 5.4 (a), subparagraph 5.8 (1) (a) (i) or regulation 5.9A)

[4] Paragraph 22.11 (4) (a)

substitute

(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), subparagraph 5.8 (1) (a) (i) or regulation 5.9A;

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 Nos. 71, 213 and 316; 2004 Nos. 23 and 193.
 2. Notified in the *Commonwealth of Australia Gazette* on 20 August 2004.
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