



# PATENTS AMENDMENT REGULATIONS 2007 (NO. 1)<sup>1</sup>

## Select Legislative Instrument 2007 No. 357

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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 17 October 2007

P. M. JEFFERY  
Governor-General

By His Excellency's Command

IAN MACFARLANE  
Minister for Industry, Tourism and Resources

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**1 Name of Regulations**

These Regulations are the *Patents Amendment Regulations 2007 (No. 1)*.

**2 Commencement**

These Regulations commence on 22 October 2007.

**3 Amendment of *Patents Regulations 1991***

Schedule 1 amends the *Patents Regulations 1991*.

## Schedule 1      Amendments

(regulation 3)

### [1]      Regulation 2.5

*substitute*

#### 2.5      Prescribed period: assertion that invention is not a patentable invention

For subsection 27 (1) of the Act, the prescribed period is the period:

- (a) beginning immediately after the complete specification filed in relation to the application for a standard patent becomes open to public inspection; and
- (b) ending 3 months after the date of publication in the *Official Journal* of the notice of acceptance under paragraph 49 (5) (b) of the Act.

### [2]      Regulation 3.17B

*omit*

For paragraph 45 (3) (a)

*insert*

- (1) For paragraph 45 (3) (a)

### [3]      Regulation 3.17B

*insert*

- (2) If:

- (a) under subsection 45 (3) of the Act, an applicant was required to inform the Commissioner of the result of a documentary search by or on behalf of a foreign patent office in relation to a patent request; and
- (b) the applicant did not inform the Commissioner of the result before 22 October 2007; and
- (c) the latest of the following dates had not occurred before 22 October 2007:
  - (i) the day 6 months after the documentary search is completed within the meaning of regulation 1.3A;
  - (ii) the day 6 months after the applicant asked for the examination in accordance with section 44 of the Act;
  - (iii) if the patent request and complete specification relating to the application were accepted (whether before or after 22 October 2007) — the day 3 months after the notice of acceptance was published in the *Official Journal* under paragraph 49 (5) (b) of the Act;

the documentary search is prescribed (so that information need not be given to the Commissioner).

- (3) If:
- (a) an applicant asked, in accordance with section 44 of the Act, for an examination of the patent request and complete specification relating to the application for a standard patent; and
  - (b) the applicant asked for the examination on or after 22 October 2007;
- all documentary searches by, or on behalf of, a foreign patent office are prescribed (so that information need not be given to the Commissioner).

**[4] Subregulation 3.18 (4)**

*substitute*

- (4) If a notice is filed under subsection 27 (1) of the Act before the patent request and complete specification to which the notice relates have been accepted under subsection 49 (1) of the Act, in examining the patent request and complete specification under section 45 or 48 of the Act, the Commissioner must consider a matter stated in the notice that addresses a claim that the invention concerned does not comply with paragraph 18 (1) (b) of the Act.

**[5] Regulation 9A.2B**

*omit*

For paragraph 101D (1) (a)

*insert*

- (1) For paragraph 101D (1) (a)

**[6] Regulation 9A.2B**

*insert*

*Commissioner's decision to examine complete specification*

- (2) If:
- (a) the Commissioner decided to examine the complete specification relating to an innovation patent; and
  - (b) under subsection 101D (1) of the Act, the patentee was required to inform the Commissioner of the result of a documentary search in relation to the patent request; and
  - (c) the patentee did not inform the Commissioner of the result before 22 October 2007; and
  - (d) the later of the following dates had not occurred before 22 October 2007:
    - (i) the day 3 months after the documentary search is completed within the meaning of regulation 1.3A;
    - (ii) the day 3 months after the Commissioner told the patentee about the decision in accordance with subregulation 9A.1 (2);
- the documentary search is prescribed (so that information need not be given to the Commissioner).

- (3) If the Commissioner decides, on or after 22 October 2007, to examine the complete specification relating to an innovation patent, all documentary searches by, or on behalf of, a foreign patent office are prescribed (so that information need not be given to the Commissioner).

*Request for examination of complete specification*

- (4) If:
- (a) a patentee, or another person, asked, in accordance with section 101A of the Act, for an examination of the complete specification relating to an innovation patent; and
  - (b) under subsection 101D (1) of the Act, the patentee was required to inform the Commissioner of the result of a documentary search in relation to the patent request; and
  - (c) the patentee did not inform the Commissioner of the result before 22 October 2007; and
  - (d) if the patentee asked for the examination — the day 3 months after the documentary search is completed, within the meaning of regulation 1.3A, had not occurred before 22 October 2007; and
  - (e) if a person other than the patentee asked for the examination — the later of the following dates had not occurred before 22 October 2007:
    - (i) the day 3 months after the documentary search is completed within the meaning of regulation 1.3A;
    - (ii) the day on which the patentee paid the fee mentioned in paragraph (b) of item 208 of Schedule 7;
- the documentary search is prescribed (so that information need not be given to the Commissioner).
- (5) If:
- (a) a patentee, or another person, asks, in accordance with section 101A of the Act, for an examination of the complete specification relating to an innovation patent; and
  - (b) that person asked for the examination on or after 22 October 2007;
- all documentary searches by, or on behalf of, a foreign patent office are prescribed (so that information need not be given to the Commissioner).

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**Note**

1. All legislative instruments and compilations are registered on the Federal Register of Legislative Instruments kept under the *Legislative Instruments Act 2003*. See [www.frli.gov.au](http://www.frli.gov.au).
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