



# Patents Act 1990

## Act No. 83 of 1990 as amended

This compilation was prepared on 8 July 2010  
taking into account amendments up to Act No. 96 of 2010

The text of any of those amendments not in force  
on that date is appended in the Notes section

The operation of amendments that have been incorporated may be  
affected by application provisions that are set out in the Notes section

Prepared by the Office of Legislative Drafting and Publishing,  
Attorney-General's Department, Canberra



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# An Act relating to patents of inventions

## Chapter 1—Introductory

### 1 Short title [see Note 1]

This Act may be cited as the *Patents Act 1990*.

### 2 Commencement [see Note 1]

- (1) Subject to subsection (2), this Act commences on a day to be fixed by Proclamation.
- (2) If this Act does not commence under subsection (1) within the period of 6 months beginning on the day on which it receives the Royal Assent, it commences on the first day after the end of that period.

### 3 Definitions

The following expressions are defined, for the purposes of this Act or of a particular Chapter of this Act, in the dictionary in Schedule 1:

Section 3

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application  
approved form  
associated  
    technology  
Australia  
Australian continental shelf  
Australian Register of Therapeutic Goods  
authority  
basic application  
Budapest Treaty  
certified  
claim  
commencing day  
Commissioner  
compensable person  
complete specification  
compulsory licence  
Convention applicant  
Convention application  
Convention country  
deposit requirements  
depository institution  
Deputy Commissioner  
Designated Manager  
Director  
eligible person  
employee  
examination  
exclusive licensee  
exploit  
Federal Court  
file  
foreign aircraft  
foreign land vehicle  
foreign patent office  
foreign vessel  
formalities check  
infringement proceedings  
innovation patent  
interested party  
international application

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international depositary authority  
international filing date  
invention  
legal practitioner  
legal representative  
licence  
main invention  
modified examination  
nominated person  
non-infringement declaration  
*Official Journal*  
patent  
patent application  
patent area  
patent of addition  
Patent Office  
patent request  
patentable invention  
patented process  
patented product  
patentee  
PCT  
PCT application  
permit  
pharmaceutical substance  
prescribed court  
prescribed depositary institution  
prior art base  
prior art information  
Professional Standards Board  
prohibition order  
provisional specification  
receiving Office  
re-examination  
Register  
registered  
registered patent attorney  
relevant authority  
relevant international application  
relevant proceedings  
rules relating to micro-organisms

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Section 3

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Safeguards Act  
sealed  
specification  
standard patent  
State  
Statute of Monopolies  
supply  
Territory  
therapeutic use  
this Act  
work  
1952 Act  
1989 Amending Act

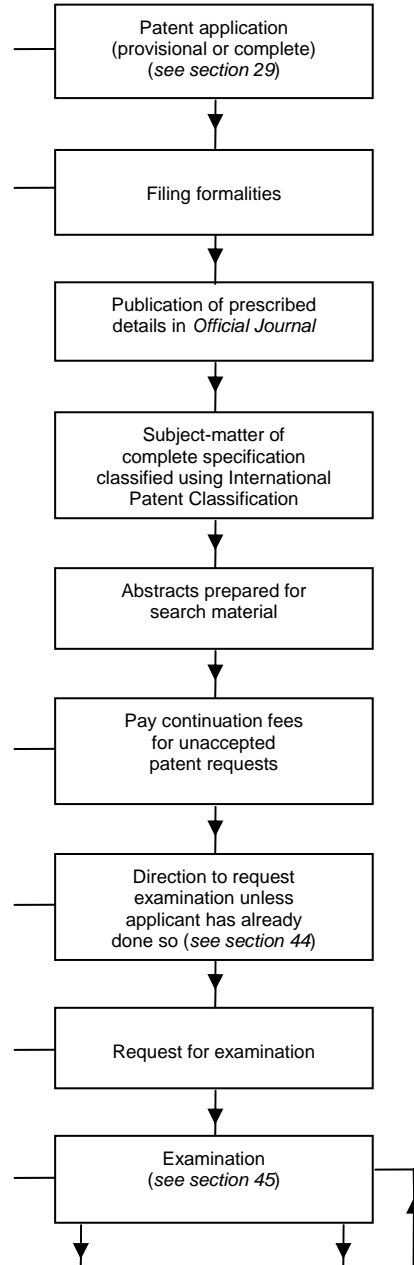


**4 What are the typical steps in getting and maintaining a standard patent?**

The following diagram shows most of the typical steps involved in getting and maintaining a standard patent. The diagram is intended for use only as a general introductory illustration and is not intended to have any other effect. If there is an inconsistency between any matter contained in the diagram and a provision of this Act or the regulations, the provision prevails.

TABLE 1—GETTING AND MAINTAINING A STANDARD PATENT

Fee payable.  
 A complete application must be associated with a provisional application within the prescribed period.  
 Provisionals which lapse at this stage are not published.  
 Applicant may be required to correct deficiencies. Application will lapse if applicant does not comply.

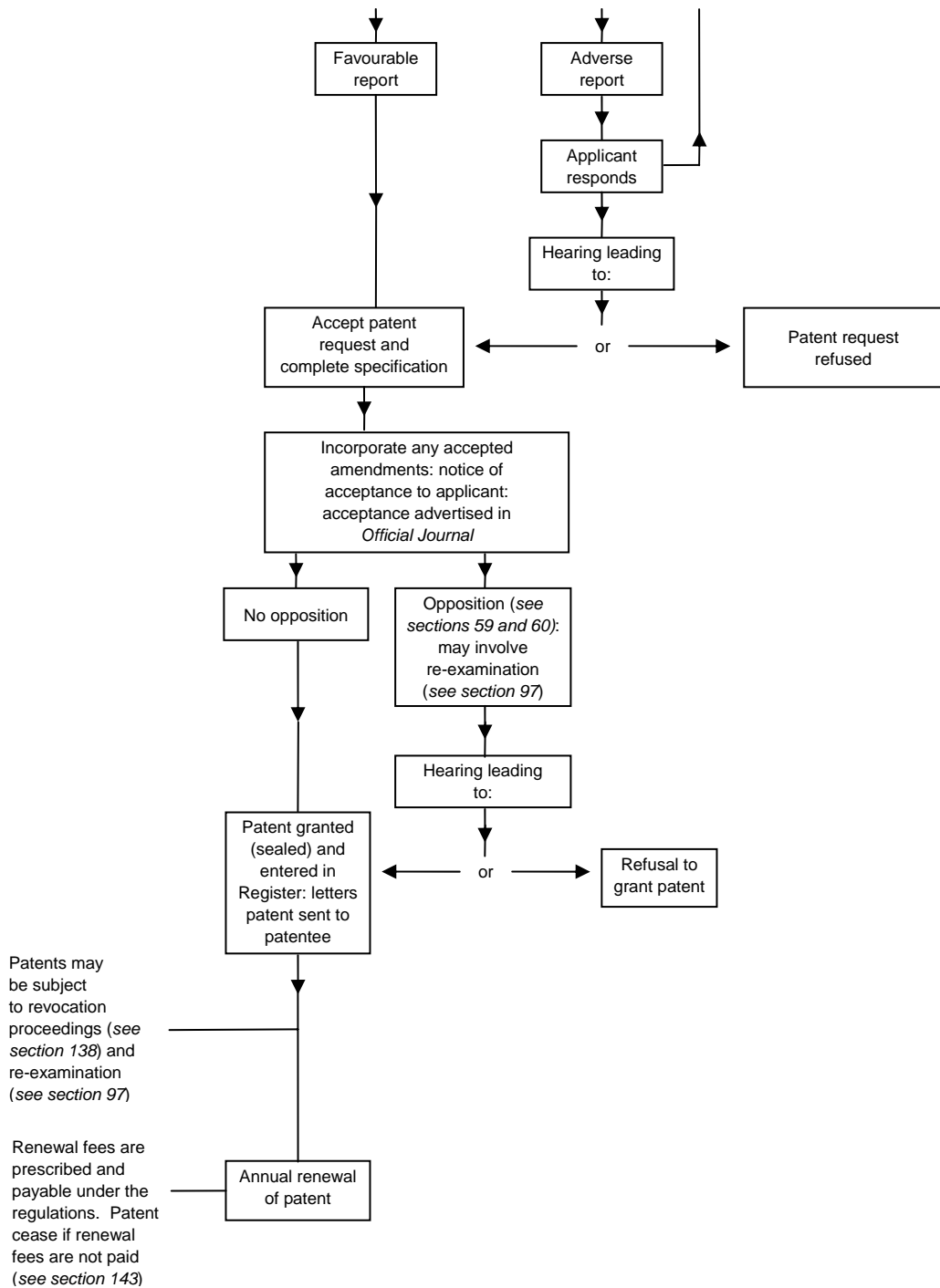


Continuation fees are prescribed and payable under the regulations.  
 Applications lapse if continuation fees are not paid (see section 142).

Applicant must request examination as directed or application will lapse (see section 142).

Fee payable.

Application lapses if patent request and complete specification not accepted within the prescribed period (see section 142).



## 5 Associated applications

For the purposes of this Act, a complete application is to be taken to be associated with a provisional application if, and only if, the patent request filed in respect of the complete application identifies the provisional application and contains a statement to the effect that the applications are associated.

[*Note: see sections 29 and 38*]

## 6 Deposit requirements

For the purposes of this Act, the deposit requirements are to be taken to be satisfied in relation to a micro-organism to which a specification relates if, and only if:

- (a) the micro-organism was, on or before the date of filing of the specification, deposited with a prescribed depository institution in accordance with the rules relating to micro-organisms; and
- (b) the specification includes, at that date, such relevant information on the characteristics of the micro-organism as is known to the applicant; and
- (c) at all times since the end of the prescribed period, the specification has included:
  - (i) the name of a prescribed depository institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and
  - (iii) the file, accession or registration number of the deposit given by the institution; and
- (d) at all times since the date of filing of the specification, samples of the micro-organism have been obtainable from a prescribed depository institution as provided by those rules.

[*Note: see sections 41 and 42*]

## 7 Novelty and inventive step

### *Novelty*

- (1) For the purposes of this Act, an invention is to be taken to be novel when compared with the prior art base unless it is not novel in the

light of any one of the following kinds of information, each of which must be considered separately:

- (a) prior art information (other than that mentioned in paragraph (c)) made publicly available in a single document or through doing a single act;
- (b) prior art information (other than that mentioned in paragraph (c)) made publicly available in 2 or more related documents, or through doing 2 or more related acts, if the relationship between the documents or acts is such that a person skilled in the relevant art would treat them as a single source of that information;
- (c) prior art information contained in a single specification of the kind mentioned in subparagraph (b)(ii) of the definition of **prior art base** in Schedule 1.

*Inventive step*

- (2) For the purposes of this Act, an invention is to be taken to involve an inventive step when compared with the prior art base unless the invention would have been obvious to a person skilled in the relevant art in the light of the common general knowledge as it existed in the patent area before the priority date of the relevant claim, whether that knowledge is considered separately or together with the information mentioned in subsection (3).
- (3) The information for the purposes of subsection (2) is:
  - (a) any single piece of prior art information; or
  - (b) a combination of any 2 or more pieces of prior art information;

being information that the skilled person mentioned in subsection (2) could, before the priority date of the relevant claim, be reasonably expected to have ascertained, understood, regarded as relevant and, in the case of information mentioned in paragraph (b), combined as mentioned in that paragraph.

*Innovative step*

- (4) For the purposes of this Act, an invention is to be taken to involve an innovative step when compared with the prior art base unless the invention would, to a person skilled in the relevant art, in the light of the common general knowledge as it existed in the patent area before the priority date of the relevant claim, only vary from

the kinds of information set out in subsection (5) in ways that make no substantial contribution to the working of the invention.

- (5) For the purposes of subsection (4), the information is of the following kinds:
- (a) prior art information made publicly available in a single document or through doing a single act;
  - (b) prior art information made publicly available in 2 or more related documents, or through doing 2 or more related acts, if the relationship between the documents or acts is such that a person skilled in the relevant art would treat them as a single source of that information.
- (6) For the purposes of subsection (4), each kind of information set out in subsection (5) must be considered separately.

[Notes: (1) For the meaning of **document** see section 25 of the Acts Interpretation Act 1901.

(2) See also the definitions of **prior art base** and **prior art information** in Schedule 1: see also paragraph 18(1)(b) and subsection 98(1).]

## 8 Disclosure in basic applications

Subject to the regulations, account must not be taken, for the purposes of this Act, of a disclosure in a specification or other document filed in respect of, and at the same time as, a basic application unless the following documents are filed within the prescribed period:

- (a) a copy of the specification or document;
- (b) if the specification or document is not in English—a translation of the specification or document into English.

[Note: **basic application** is defined in Schedule 1: see also Part 2 of Chapter 8.]

## 9 Secret use

For the purposes of this Act, the following acts are not to be taken to be secret use of an invention in the patent area:

- (a) any use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her

predecessor in title to the invention, for the purpose of reasonable trial or experiment only;

- (b) any use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her predecessor in title to the invention, being use occurring solely in the course of a confidential disclosure of the invention by or on behalf of, or with the authority of, the patentee, nominated person, or predecessor in title;
- (c) any other use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her predecessor in title to the invention, for any purpose other than the purpose of trade or commerce;
- (d) any use of the invention by or on behalf of the Commonwealth, a State, or a Territory where the patentee or nominated person, or his or her predecessor in title to the invention, has disclosed the invention, so far as claimed, to the Commonwealth, State or Territory.

*[Note: See also paragraph 18(1)(d)]*

## **10 Certain international applications to be taken to have been given an international filing date**

- (1) Where:
  - (a) an international application specifies Australia as a designated State under Article 4(1)(ii) of the PCT; and
  - (b) the receiving Office does not give the application an international filing date; and
  - (c) the Commissioner is satisfied that the application should, under Article 25(2)(a) of the PCT, be treated as if it had been given an international filing date;the application is to be taken, for the purposes of this Act, to have been given an international filing date under Article 11 of the PCT.
- (2) This section does not apply to an international application that was not filed in the receiving Office in English unless a translation of the application into English, verified in accordance with the regulations, has been filed.
- (3) Where this section applies, the international filing date of the application is to be taken to be the date that, in the opinion of the

Section 11

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Commissioner, should have been given to the application as its international filing date under the PCT.

[*Note: international filing date is defined in Schedule 1: see also Chapter 8.*]

**11 Act binds the Crown**

- (1) This Act binds the Crown in right of the Commonwealth, of each of the States, of the Australian Capital Territory, of the Northern Territory and of Norfolk Island.
- (2) Nothing in this Act makes the Crown liable to be prosecuted for an offence.

**12 Application of Act**

This Act extends to:

- (a) each external Territory; and
- (b) the Australian continental shelf; and
- (c) the waters above the Australian continental shelf; and
- (d) the airspace above Australia, each external Territory and the Australian continental shelf.

**12A Application of the *Criminal Code***

Chapter 2 of the *Criminal Code* applies to all offences created by this Act.

Note: Chapter 2 of the *Criminal Code* sets out the general principles of criminal responsibility.



## **Chapter 2—Patent rights, ownership and validity**

### **Part 1—Patent rights**

#### **13 Exclusive rights given by patent**

- (1) Subject to this Act, a patent gives the patentee the exclusive rights, during the term of the patent, to exploit the invention and to authorise another person to exploit the invention.
- (2) The exclusive rights are personal property and are capable of assignment and of devolution by law.
- (3) A patent has effect throughout the patent area.

#### **14 Assignment of patent**

- (1) An assignment of a patent must be in writing signed by or on behalf of the assignor and assignee.
- (2) A patent may be assigned for a place in, or part of, the patent area.

## **Part 2—Ownership**

### **15 Who may be granted a patent?**

- (1) Subject to this Act, a patent for an invention may only be granted to a person who:
  - (a) is the inventor; or
  - (b) would, on the grant of a patent for the invention, be entitled to have the patent assigned to the person; or
  - (c) derives title to the invention from the inventor or a person mentioned in paragraph (b); or
  - (d) is the legal representative of a deceased person mentioned in paragraph (a), (b) or (c).
- (2) A patent may be granted to a person whether or not he or she is an Australian citizen.

### **16 Co-ownership of patents**

- (1) Subject to any agreement to the contrary, where there are 2 or more patentees:
  - (a) each of them is entitled to an equal undivided share in the patent; and
  - (b) each of them is entitled to exercise the exclusive rights given by the patent for his or her own benefit without accounting to the others; and
  - (c) none of them can grant a licence under the patent, or assign an interest in it, without the consent of the others.
- (2) Where a patented product, or a product of a patented method or process, is sold by any of 2 or more patentees, the buyer, and a person claiming through the buyer, may deal with the product as if it had been sold by all the patentees.
- (3) This section does not affect the rights or obligations of a trustee or of the legal representative of a deceased person, or rights or obligations arising out of either of those relationships.

### **17 Directions to co-owners**

- (1) Where there are 2 or more patentees, the Commissioner may, on the application of any of them, give such directions in accordance with the application as the Commissioner thinks fit, being directions about:
  - (a) a dealing with the patent or an interest in it; or
  - (b) the grant of licences under the patent; or
  - (c) the exercise of a right under section 16 in relation to the patent.
- (2) If a patentee fails to do anything necessary to carry out a direction under subsection (1) within 14 days after being asked in writing to do so by one of the other patentees, the Commissioner may, on the application of one of those other patentees, direct a person to do it in the name and on behalf of the defaulting patentee.
- (3) Before giving a direction, the Commissioner must give an opportunity to be heard:
  - (a) in the case of an application by a patentee or patentees under subsection (1)—to the other patentee or patentees; and
  - (b) in the case of an application under subsection (2)—to the defaulting patentee.
- (4) The Commissioner must not give a direction that:
  - (a) affects the rights or obligations of a trustee or of the legal representative of a deceased person, or rights or obligations arising out of either of those relationships; or
  - (b) is inconsistent with the terms of an agreement between the patentees.

## Part 3—Validity

### Division 1—Validity

#### 18 Patentable inventions

*Patentable inventions for the purposes of a standard patent*

- (1) Subject to subsection (2), an invention is a patentable invention for the purposes of a standard patent if the invention, so far as claimed in any claim:
- (a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and
  - (b) when compared with the prior art base as it existed before the priority date of that claim:
    - (i) is novel; and
    - (ii) involves an inventive step; and
  - (c) is useful; and
  - (d) was not secretly used in the patent area before the priority date of that claim by, or on behalf of, or with the authority of, the patentee or nominated person or the patentee's or nominated person's predecessor in title to the invention.

*Patentable inventions for the purposes of an innovation patent*

- (1A) Subject to subsections (2) and (3), an invention is a patentable invention for the purposes of an innovation patent if the invention, so far as claimed in any claim:
- (a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and
  - (b) when compared with the prior art base as it existed before the priority date of that claim:
    - (i) is novel; and
    - (ii) involves an innovative step; and
  - (c) is useful; and

- (d) was not secretly used in the patent area before the priority date of that claim by, or on behalf of, or with the authority of, the patentee or nominated person or the patentee's or nominated person's predecessor in title to the invention.
- (2) Human beings, and the biological processes for their generation, are not patentable inventions.

*Certain inventions not patentable inventions for the purposes of an innovation patent*

- (3) For the purposes of an innovation patent, plants and animals, and the biological processes for the generation of plants and animals, are not patentable inventions.
- (4) Subsection (3) does not apply if the invention is a microbiological process or a product of such a process.

[Note: see also sections 7 and 9.]

## **19 Certificate of validity**

- (1) In any proceedings in a court in which the validity of a patent, or of a claim, is disputed, the court may certify that the validity of a specified claim was questioned.
- (2) If a court issues a certificate, then, in any subsequent proceedings for infringement of the claim concerned, or for the revocation of the patent so far as it relates to that claim, the patentee, or any other person supporting the validity of the claim is, on obtaining a final order or judgment in his or her favour, entitled to full costs, charges and expenses as between solicitor and client, so far as that claim is concerned.
- (3) Subsection (2) has effect subject to any direction by the court trying the proceedings.

## **20 Validity of patent not guaranteed**

- (1) Nothing done under this Act or the PCT guarantees the granting of a patent, or that a patent is valid, in Australia or anywhere else.

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- (2) The Commonwealth, the Commissioner, a Deputy Commissioner, or an employee, is not liable because of, or in connection with, doing any act under this Act or the PCT, or any proceedings consequent on doing any such act.

**21 Validity not implied by making or refusal of non-infringement declaration**

The making of, or refusal to make, a non-infringement declaration in respect of a claim of a patent does not imply that the claim is valid.

## **Division 2—Matters not affecting validity**

### **22 Invalidity in relation to one claim not to affect validity in relation to other claims**

The invalidity of a patent in relation to a claim does not affect its validity in relation to any other claim.

### **23 Validity not affected by publication etc. after priority date**

A patent is not invalid, so far as the invention is claimed in any claim, merely because of:

- (a) the publication or use of the invention, so far as claimed in that claim, on or after the priority date of that claim; or
- (b) the grant of another patent which claims the invention, so far as claimed in the first-mentioned claim, in a claim of the same or a later priority date.

### **24 Validity not affected by certain publication or use**

- (1) For the purpose of deciding whether an invention is novel or involves an inventive step or an innovative step, the person making the decision must disregard:
  - (a) any information made publicly available, through any publication or use of the invention in the prescribed circumstances, by or with the consent of the nominated person or patentee, or the predecessor in title of the nominated person or patentee; and
  - (b) any information made publicly available without the consent of the nominated person or patentee, through any publication or use of the invention by another person who derived the information from the nominated person or patentee or from the predecessor in title of the nominated person or patentee;but only if a patent application for the invention is made within the prescribed period.

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- (2) For the purpose of deciding whether an invention is novel or involves an inventive step or an innovative step, the person making the decision must disregard:
- (a) any information given by, or with the consent of, the nominated person or the patentee, or his or her predecessor in title, to any of the following, but to no other person or organisation:
    - (i) the Commonwealth or a State or Territory, or an authority of the Commonwealth or a State or Territory;
    - (ii) a person authorised by the Commonwealth or a State or Territory to investigate the invention; and
  - (b) anything done for the purpose of an investigation mentioned in subparagraph (a)(ii).

**25 Validity: patents of addition**

Objection cannot be taken to a patent request or complete specification in respect of an application for a patent of addition, and a patent of addition is not invalid, merely because the invention, so far as claimed, does not involve an inventive step, having regard to the publication or use of the main invention during the prescribed period.

**26 Validity not affected in certain cases involving amendments**

- (1) Objection cannot be taken to a patent request and specification that have been accepted, and a patent is not invalid, merely because the specification claims an invention that was not the subject of the request, or that was not described or claimed in the specification as filed.
- (2) Except in the case of an amendment made in contravention of section 112, objection cannot be taken to a patent request and specification that have been accepted, and a patent is not invalid, merely because an amendment of the specification has been made that was not allowable.



## **Division 3—Notice of matters affecting validity**

### **27 Notice of matters affecting validity of standard patents**

- (1) A person may, within the prescribed period after a complete specification filed in relation to an application for a standard patent becomes open to public inspection, notify the Commissioner, in accordance with the regulations, that the person asserts, for reasons stated in the notice, that the invention concerned is not a patentable invention because it does not comply with paragraph 18(1)(b).
- (2) The Commissioner must inform the applicant for the patent in writing of any matter of which the Commissioner is notified and send the applicant a copy of any document accompanying the notice.
- (3) The Commissioner must otherwise consider and deal with a notice in accordance with the regulations.
- (4) A notice and any document accompanying it are open to public inspection.

### **28 Notice of matters affecting validity of innovation patents**

#### *Person may give notice of invalidity of an innovation patent*

- (1) A person may notify the Commissioner that the person asserts, for reasons stated in the notice, that an innovation patent is invalid because the invention concerned does not comply with paragraph 18(1A)(b).

#### *When notice may be given*

- (2) A notice may only be given to the Commissioner under subsection (1) in respect of an innovation patent within the prescribed period after an innovation patent has been granted.

#### *How notice must be given*

- (3) Notice must be given in accordance with the regulations.

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*Commissioner must inform patentee of notice given*

- (4) If the Commissioner receives a notice in respect of an innovation patent, the Commissioner must inform the patentee, in writing, of any matter of which the Commissioner is notified and send the patentee a copy of any document accompanying the notice.

*Commissioner to deal with notice in accordance with regulations*

- (5) The Commissioner must otherwise consider and deal with a notice in accordance with the regulations.

## **Chapter 3—From application to acceptance**

### **Part 1—Patent applications**

#### **Division 1—Applications**

##### **29 Application for patent**

- (1) A person may apply for a patent for an invention by filing, in accordance with the regulations, a patent request and such other documents as are prescribed.
- (2) An application may be a provisional application or a complete application.
- (3) A patent request in relation to a provisional application must be in the approved form and accompanied by a provisional specification.
- (4) A patent request in relation to a complete application must be in the approved form and accompanied by a complete specification.
- (5) In this section:

*person* includes a body of persons, whether incorporated or not.

[*Note: see also section 5 for requirements relating to associated applications.*]

##### **30 Filing date**

A patent application is to be taken to have been made on the filing date determined under the regulations.

##### **31 Joint applicants**

2 or more persons (within the meaning of section 29) may make a joint patent application.

##### **32 Disputes between applicants etc.**

If a dispute arises between any 2 or more interested parties in relation to a patent application whether, or in what manner, the

application should proceed, the Commissioner may, on a request made in accordance with the regulations by any of those parties, make any determinations the Commissioner thinks fit for enabling the application to proceed in the name of one or more of the parties alone, or for regulating the manner in which it is to proceed, or both, as the case requires.

### **33 Applications by opponents etc.**

*Opposition to standard patent if a person other than nominated person eligible for grant of patent*

- (1) If:
- (a) an application has been made for a standard patent; and
  - (b) the grant of the standard patent is opposed under section 59 by one or more persons; and
  - (c) the Commissioner decides, under section 60, that:
    - (i) one or more opponents are eligible persons in relation to the invention, so far as claimed in any claim of the opposed patent application (the *original claim*); and
    - (ii) the nominated person in respect of the application is not an eligible person in relation to the invention; and
    - (iii) there is no other reason that a patent should not be granted; and
  - (d) a complete application is made under section 29 by one or more of the eligible persons for a patent in relation to the invention;

the Commissioner may grant those eligible persons a patent jointly for the invention, so far as so claimed.

*Opposition to standard patent if nominated person eligible for grant of patent with other persons*

- (2) If:
- (a) an application has been made for a standard patent; and
  - (b) the grant of the patent is opposed under section 59 by one or more persons; and
  - (c) the Commissioner decides, under section 60:
    - (i) that both the nominated person and one or more of the opponents are eligible persons in relation to the

invention, so far as claimed in any claim of the opposed patent application (the *original claim*); and

(ii) that there is no other reason that a patent should not be granted; and

(d) a complete application is made by one or more of the eligible persons under section 29 for a patent in relation to the invention;

the Commissioner may grant a patent for the invention, so far as so claimed, to those eligible persons jointly.

*Opposition to innovation patent if patentee not entitled to grant of patent but another person is*

(3) If:

(a) an innovation patent is opposed under section 101M by one or more persons;

(b) the Commissioner decides, under section 101N, that the patentee is not entitled to the grant of the patent; and

(c) the Commissioner decides that one or more of the opponents are eligible persons in relation to the invention the subject of the patent, so far as claimed in any claim of the patent (the *original claim*); and

(d) a complete application is made by one or more of the eligible persons under section 29 for a patent in relation to the invention;

the Commissioner may grant an innovation patent for the invention, so far as so claimed, to those eligible persons.

*Opposition to innovation patent if patentee entitled to grant of patent with other person*

(4) If:

(a) an innovation patent is opposed under section 101M by one or more persons; and

(b) the Commissioner decides that one or more of the opponents and the original patentee are eligible persons in relation to the invention the subject of the patent, so far as claimed in any claim of the patent (the *original claim*); and

(c) a complete application is made by one or more of the eligible persons under section 29 for a patent in relation to the invention;

the Commissioner may grant an innovation patent for the invention, so far as so claimed, to those eligible persons jointly.

- (5) If the Commissioner grants a patent under subsection (1), (2), (3) or (4), the claims of that patent granted have the same priority date as that of the original claim referred to in the respective subsection.

### **34 Applications by eligible persons arising out of Court proceedings**

- (1) If, in any proceedings in a court relating to a patent (the *first patent*), the court is satisfied either:
- (a) that one or more persons are eligible persons in relation to an invention so far as claimed in any claim of the patent (the *original claim*) but that the patentee is not an eligible person; or
  - (b) that the patentee and another person or persons are eligible persons in relation to an invention so far as claimed in any claim of the first patent (the *original claim*);

the court, in addition to any other order it may make in the proceedings, may, by order, declare that the persons who it is satisfied are eligible persons are eligible persons in relation to that invention so far as so claimed.

- (2) Subject to subsection (3), if a complete application is made under section 29 by one or more declared persons, the Commissioner may grant a patent for the invention, so far as claimed in the original claim, to those declared persons jointly.
- (3) If the Commissioner grants a patent under subsection (2), the claims of that patent have the same priority date as that of the original claim.

### **35 Applications by eligible persons following revocation by Commissioner**

- (1) If the Commissioner:
- (a) revokes a patent under section 137; and
  - (b) is satisfied:
    - (i) on application made by one or more persons in accordance with the regulations, that the persons are eligible persons in relation to the invention concerned, so far as so claimed in any claim of the revoked patent

(the *original claim*) and that the former patentee is not such an eligible person; or

- (ii) on application made by one or more persons in accordance with the regulations, that the persons and the former patentee are eligible persons in relation to the invention concerned, so far as is claimed in any claim of the revoked patent (the *original claim*);

the Commissioner may declare in writing that the eligible persons are such eligible persons.

- (1A) If a complete application is made under section 29 by one or more of the declared persons, the Commissioner may grant a patent for the invention, so far as so claimed, to those declared persons jointly.
- (1B) If the Commissioner grants a patent under subsection (1A), the claims of that patent have the same priority date as that of the original claim as referred to in subsection (1).
- (2) The Commissioner must not make a declaration without first giving the former patentee a reasonable opportunity to be heard.
- (3) An appeal lies to the Federal Court against a decision of the Commissioner making, or refusing to make, a declaration.

### **36 Other applications by eligible persons**

- (1) If:
  - (a) a patent application has been made and, in the case of a complete application, the patent request and complete specification have not been accepted; and
  - (b) an application for a declaration by the Commissioner is made by one or more persons (the *section 36 applicants*) in accordance with the regulations; and
  - (c) the Commissioner is satisfied, in relation to an invention disclosed in the specification filed in relation to the application for the patent:
    - (i) that the nominated person is not an eligible person, but that the section 36 applicants are eligible persons; or
    - (ii) that the nominated person is an eligible person, but that the section 36 applicants are also eligible persons;

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the Commissioner may declare in writing that the persons who the Commissioner is satisfied are eligible persons are eligible persons in relation to the invention as so disclosed.

- (2) The Commissioner may make a declaration under subsection (1) whether or not the patent application lapses or is withdrawn.
- (3) The Commissioner must not make a declaration under subsection (1) without first giving the nominated person a reasonable opportunity to be heard.
- (4) If a complete application is made under section 29 by one or more of the declared persons, the priority date of the claims of a patent for the invention granted to the person, or persons, as the case may be, must be determined under the regulations.
- (5) An appeal lies to the Federal Court against a decision by the Commissioner under this section.

**37 Complete application may be treated as provisional**

- (1) Where a complete application is made, the applicant may, at any time during the prescribed period, by written request, ask the Commissioner to direct that the application be treated as a provisional application.
- (2) A person is not entitled to make a request if the patent request and specification filed in respect of the application have been accepted or have become open to public inspection.
- (3) On receiving a request, the Commissioner must give a direction as asked.
- (4) Where the Commissioner gives a direction, the complete application is to be taken, for the purposes of this Act, to be, and to have always been, a provisional application.

**38 Time for making complete application**

- (1) If an applicant makes a provisional application, the applicant may make one or more complete applications associated with the provisional application at any time within the prescribed period.



(2) In this section:

*applicant* includes a person entitled to make a request under section 113 in relation to the relevant patent application.

[*Note: see also section 5 for requirements relating to associated applications.*]

## **Division 2—Specifications**

### **40 Specifications**

- (1) A provisional specification must describe the invention.
- (2) A complete specification must:
  - (a) describe the invention fully, including the best method known to the applicant of performing the invention; and
  - (b) where it relates to an application for a standard patent—end with a claim or claims defining the invention; and
  - (c) where it relates to an application for an innovation patent—end with at least one and no more than 5 claims defining the invention.
- (3) The claim or claims must be clear and succinct and fairly based on the matter described in the specification.
- (4) The claim or claims must relate to one invention only.

### **41 Specifications: micro-organisms**

- (1) To the extent that an invention is a micro-organism, the complete specification is to be taken to comply with paragraph 40(2)(a), so far as it requires a description of the micro-organism, if the deposit requirements are satisfied in relation to the micro-organism.
  - (2) Where:
    - (a) an invention involves the use, modification or cultivation of a micro-organism, other than the micro-organism mentioned in subsection (1); and
    - (b) a person skilled in the relevant art in the patent area could not reasonably be expected to perform the invention without having a sample of the micro-organism before starting to perform the invention; and
    - (c) the micro-organism is not reasonably available to a person skilled in the relevant art in the patent area;the specification is to be taken to comply with paragraph 40(2)(a), so far as it requires a description of the micro-organism, if, and only if, the deposit requirements are satisfied in relation to the micro-organism.
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- (3) For the purposes of this section, a micro-organism may be taken to be reasonably available to a person even if it is not so available in the patent area.
- (4) Where:
- (a) the requirements specified in paragraph 6(c) or (d) cease to be satisfied in relation to a micro-organism; and
  - (b) steps are taken at a later time within the prescribed period in accordance with such provisions (if any) of the regulations as are applicable; and
  - (c) as a result of those steps, if the period during which those requirements are not satisfied is disregarded, those requirements would be satisfied at that later time;
- those requirements are to be taken to have been satisfied during the period mentioned in paragraph (c), and such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention during that period.

*[Note: see also section 6 in relation to satisfaction of deposit requirements.]*

#### **42 Micro-organisms ceasing to be reasonably available**

- (1) Where:
- (a) a complete application has been made for a patent, or a patent has been granted for an invention of a kind mentioned in paragraph 41(2)(a); and
  - (b) the relevant micro-organism was, at the date of filing of the complete specification, reasonably available (within the meaning of section 41) to a skilled person working in the relevant art in the patent area; and
  - (c) the micro-organism has ceased to be so available;
- a prescribed court or the Commissioner, on application made in accordance with the regulations, or the Commissioner, on his or her own motion, may declare that the specification does not comply with section 40 unless the deposit requirements are satisfied in relation to the micro-organism.

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- (2) Where a declaration is made under subsection (1):
  - (a) this Act has effect in relation to the specification accordingly; and
  - (b) section 6 applies as if the references in that section to the date of filing of the specification were references to a date specified in the declaration for the purposes of this subsection.
- (3) Subsection (2) does not limit the operation of section 223.
- (4) Where:
  - (a) an application is made under subsection (1); or
  - (b) the Commissioner proposes to make a declaration under that subsection on his or her own motion;the applicant for the patent, or the patentee, as the case may be, must be notified, in accordance with the regulations, of the application or proposal and is entitled to appear and be heard.
- (5) A declaration by the Commissioner must be made in accordance with the regulations.
- (6) An office copy of a declaration by a prescribed court must be served on the Commissioner by the Registrar or other appropriate officer of the court.
- (7) An appeal lies to the Federal Court against a decision of the Commissioner under subsection (1).

*[Note: see also section 6 in relation to satisfaction of deposit requirements.]*

## Division 3—Priority dates

### 43 Priority dates

- (1) Each claim of a specification must have a priority date.
- (2) The priority date of a claim is:
  - (a) the date of filing of the specification; or
  - (b) where the regulations provide for the determination of a different date as the priority date—the date determined under the regulations.
- (3) Where a claim defines more than one form of an invention, then, for the purposes of determining the priority date of the claim, it must be treated as if it were a separate claim for each form of the invention that is defined.
- (4) The priority date of a claim of a specification may be different from the priority date of any other claim of the specification.

*Priority date if claim arises from further application for an innovation patent provided for in section 79C*

- (5) If:
  - (a) an innovation patent has been granted following an application provided for in section 79C; and
  - (b) a request for the examination of the patent has been made within the period prescribed in the regulations;the priority date of each claim in the specification is the date determined under the regulations.
- (6) If:
  - (a) an innovation patent has been granted following an application provided for in section 79C; and
  - (b) a request for the examination of the patent has not been made within the period prescribed in the regulations;the priority date of each claim in the specification must not be a date earlier than the date of filing of the application provided for in section 79C.

## **Part 2—Examination of standard patent requests and specifications**

### **Division 1—Examination**

#### **44 Request for examination**

- (1) Where a complete application for a standard patent has been made, the applicant may, within the prescribed period and in accordance with the regulations, ask for an examination of the patent request and specification relating to the application.
- (2) Where a complete application has been made for a standard patent, the Commissioner may, on one or more of the prescribed grounds and in accordance with the regulations, direct the applicant to ask, within the prescribed period, for an examination of the patent request and complete specification relating to the application.
- (3) Where the patent request and specification relating to a complete application for a standard patent are open to public inspection, a person may, in accordance with the regulations, require the Commissioner to direct the applicant to ask, within the prescribed period, for an examination of the request and specification.
- (4) Where required under subsection (3), the Commissioner must give a direction accordingly, unless the applicant has already asked, or been directed to ask, for an examination of the patent request and specification.

#### **45 Examination** [*see also* Table B]

- (1) Where an applicant asks for an examination of a patent request and complete specification relating to an application for a standard patent, the Commissioner must examine the request and specification and report on:
  - (a) whether the specification complies with section 40; and
  - (b) whether, to the best of his or her knowledge, the invention, so far as claimed, satisfies the criterion mentioned in paragraph 18(1)(a); and

- (c) whether, to the best of his or her knowledge, 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:
    - (i) is novel; and
    - (ii) involves an inventive step; and
  - (d) such other matters (if any) as are prescribed.
- (1A) For the purposes of paragraph (1)(c), the prior art base is to be taken not to include information made publicly available only through the doing of an act (whether in or out of the patent area).
- (2) The examination must be carried out in accordance with the regulations.
- (3) The applicant must inform the Commissioner, in accordance with the regulations, of the results of the following searches carried out for the purpose of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside Australia:
- (a) any documentary searches by, or on behalf of, a foreign patent office, other than searches prescribed by the regulations;
  - (b) the documentary searches prescribed by the regulations.
- (4) Subsection (3) only applies to searches completed before the grant of the patent.
- (5) In subsection (4):
- completed*, in relation to a search, has the meaning prescribed by the regulations.

#### **46 Request for deferment of examination**

- (1) Where:
- (a) a complete application for a standard patent has been made; and
  - (b) a prescribed application for a patent has been made in a prescribed foreign country; and
  - (c) a patent has not been granted in respect of the prescribed application; and

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- (d) the applicant has been directed by the Commissioner to ask for an examination of the patent request and specification relating to the application mentioned in paragraph (a), being a direction given on a ground prescribed for the purposes of this paragraph;  
the applicant may, instead of asking for an examination as directed, ask for deferment of the examination.
- (2) A request for deferment must be made in accordance with the regulations.
- (3) Where a request for deferment is made:
  - (a) the examination of the patent request and specification must be deferred accordingly; and
  - (b) the application does not lapse merely because of failure by the applicant to ask for an examination in accordance with the Commissioner's direction.



## **Division 2—Modified examination**

### **47 Request for modified examination**

- (1) Where:
  - (a) a complete application for a standard patent has been made; and
  - (b) a patent has been granted in a prescribed foreign country in respect of a prescribed application made in that country;the applicant may, instead of asking for an examination, ask for a modified examination of the patent request and specification relating to the application.
- (2) The applicant may withdraw a request for a modified examination at any time before acceptance of the patent request and specification and ask for an examination under section 44 instead.

### **48 Modified examination** [*see also* Table B]

- (1) When an applicant asks for a modified examination of a patent request and complete specification relating to an application for a standard patent, the Commissioner must examine the request and specification and report on:
    - (a) whether, to the best of his or her knowledge, the invention, so far as claimed, satisfies the criterion mentioned in paragraph 18(1)(a); and
    - (b) whether, to the best of his or her knowledge, 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:
      - (i) is novel; and
      - (ii) involves an inventive step; and
    - (c) such other matters (if any) as are prescribed.
  - (1A) For the purposes of paragraph (1)(b), the prior art base is to be taken not to include information made publicly available only through the doing of an act (whether in or out of the patent area).
  - (2) The modified examination must be carried out in accordance with the regulations.
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## Part 3—Acceptance

### Division 1—Acceptance of standard patents

#### 49 Acceptance of patent request: standard patent

- (1) Subject to section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent, if:
  - (a) the Commissioner is satisfied that the invention, so far as claimed, satisfies the criteria mentioned in paragraph 18(1)(b); and
  - (b) the Commissioner considers that:
    - (i) there is no lawful ground of objection (other than a ground in respect of paragraph 18(1)(b)) to the request and specification; or
    - (ii) any such ground of objection has been removed.
- (2) If subsection (1) does not apply, the Commissioner may refuse to accept the request and specification.
- (3) The Commissioner must, if asked to do so by the applicant in writing, postpone acceptance of a patent request and complete specification until such day as the applicant specifies.
- (4) The applicant cannot, for the purposes of subsection (3), specify a day that is after the end of the period prescribed for the purposes of paragraph 142(2)(e).
- (5) Where the Commissioner accepts a patent request and complete specification relating to an application for a standard patent, the Commissioner must:
  - (a) notify the applicant in writing of the acceptance; and
  - (b) publish a notice of the acceptance in the *Official Journal*.
- (6) The notice mentioned in paragraph (5)(b) must:
  - (a) if the patent request and complete specification have been subjected to a modified examination—include a statement to the effect that the acceptance has resulted from a modified examination; and

- (b) if the patent request and complete specification have not already become open to public inspection—include a statement to the effect that the patent request and specification are open to public inspection.
- (7) Where the Commissioner refuses to accept a patent request and complete specification relating to an application for a standard patent, the Commissioner must notify the applicant in writing of the reasons for the refusal and publish a notice of the refusal in the *Official Journal*.

## **50 Application or grant may be refused in certain cases**

- (1) The Commissioner may refuse to accept a request and specification relating to a standard patent, or to grant a standard patent:
  - (a) for an invention the use of which would be contrary to law;  
or
  - (b) on the ground that the specification claims as an invention:
    - (i) a substance that is capable of being used as food or medicine (whether for human beings or animals and whether for internal or external use) and is a mere mixture of known ingredients; or
    - (ii) a process producing such a substance by mere admixture.
- (2) The Commissioner may refuse to accept a specification relating to a standard patent containing a claim that includes the name of a person as the name, or part of the name, of the invention so far as claimed in that claim.

## **51 Appeal**

An appeal lies to the Federal Court against a decision of the Commissioner under this Division.

## **Division 2—Acceptance of innovation patents**

### **52 Formalities check and acceptance of innovation patents**

- (1) If a complete application for an innovation patent is made, the Commissioner must undertake a formalities check in respect of the application.
- (2) If satisfied that the application passes the formalities check, the Commissioner must accept the patent request and complete specification.

## Chapter 4—Publication

### 53 Publication of certain information about applicants etc.

[see also Table B]

Where a patent application is made, the Commissioner must publish in the *Official Journal* the prescribed information about the applicant and the application.

### 54 Notice of publication

- (1) Where a complete specification filed in respect of an application for a standard patent (other than a PCT application) has not become open to public inspection, the Commissioner must, if asked to do so by the applicant, publish, in accordance with the regulations, a notice in the *Official Journal* that the complete specification is open to public inspection.
- (2) If subsection 41(2) applies to a specification, the applicant cannot make a request under subsection (1) in relation to the specification unless the specification includes the particulars mentioned in paragraph 6(c).
- (3) Where:
  - (a) a complete specification has been filed in respect of an application for a standard patent (other than a PCT application); and
  - (b) the prescribed period has ended; and
  - (c) the specification is not open to public inspection;the Commissioner must publish a notice in the *Official Journal* that the specification is open to public inspection, unless the application has lapsed or been refused or withdrawn.
- (4) Where:
  - (a) a divisional application for a standard patent provided for in section 79B (other than a PCT application) is made in respect of an original application, whether a PCT application or not; and

- (b) the complete specification filed in respect of the original application was open to public inspection when the divisional application was made;  
the Commissioner must publish a notice in the *Official Journal* that the complete specification filed in respect of the divisional application is open to public inspection.
- (5) Where a divisional application for a standard patent provided for in section 79B (other than a PCT application) is made in respect of an original application that is not a PCT application and:
  - (a) a notice is published in the *Official Journal* that the complete specification filed in respect of the original application is open to public inspection; or
  - (b) a notice is published in the *Official Journal* that the complete specification filed in respect of the divisional application is open to public inspection;the Commissioner must also publish in the *Official Journal* a notice that:
  - (c) where paragraph (a) applies—the complete specification filed in respect of the divisional application is open to public inspection; or
  - (d) where paragraph (b) applies—the complete specification filed in respect of the original application is open to public inspection.
- (6) Where:
  - (a) a divisional application for a standard patent provided for in section 79B (other than a PCT application) is made in respect of an original application that is a PCT application; and
  - (b) a notice is published in the *Official Journal* that the complete specification filed in respect of the original application is open to public inspection;the Commissioner must also publish in the *Official Journal* a notice that the complete specification filed in respect of the divisional application is open to public inspection.

### **55 Documents open to public inspection**

- (1) Where a notice is published under section 54 or under subsection 62(3), the specification concerned, and such other documents (if any) as are prescribed, are open to public inspection.

- (2) Where a notice is published under paragraph 49(5)(b) in relation to an application for a standard patent, or under subsection 62(2) in relation to the grant of an innovation patent, the following documents are open to public inspection:
- (a) all documents (other than prescribed documents) filed in relation to the application or the patent, whether before or after the acceptance or grant;
  - (b) all documents (other than prescribed documents) filed, after the patent ceases, expires or is revoked, in relation to the former patent;
  - (c) copies of all documents relating to the application or patent (other than prescribed documents) given by the Commissioner to the applicant or patentee, or the former applicant or patentee;
- being documents that have not already become open to public inspection.
- (3) Subject to section 90, a specification, or other document, is to be taken to have been published on the day on which it becomes open to public inspection unless it has been published otherwise before that day.

### **56 Certain documents not to be published**

- (1) Except as otherwise provided by this Act, documents of the kind mentioned in section 55:
- (a) must not be published or be open to public inspection; and
  - (b) are not liable to be inspected or produced before the Commissioner or in a legal proceeding unless the Commissioner, court, or any person having power to order inspection or production, directs that the inspection or production be allowed.
- (2) Notice of an application for the production in legal proceedings of a document of the kind mentioned in section 55 must be given to the Commissioner, who is entitled to be heard on the application.

### **57 Effect of publication of complete specification**

- (1) After a complete specification relating to an application for a standard patent has become open to public inspection and until a patent is granted on the application, the applicant has the same

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rights as he or she would have had if a patent for the invention had been granted on the day when the specification became open to public inspection.

- (3) Subsection (1) does not give the applicant a right to start proceedings in respect of the doing of an act unless:
  - (a) a patent is granted on the application; and
  - (b) the act would, if done after the grant of the patent, have constituted an infringement of a claim of the specification.
- (4) It is a defence to proceedings under subsection (1) in respect of an act done:
  - (a) after the complete specification became open to public inspection; and
  - (b) before the patent request was accepted:  
if the defendant proves that a patent could not validly have been granted to the applicant in respect of the claims (as framed when the act was done) that are alleged to have been infringed by the doing of the act.

**58 Result of search may be disclosed**

The Commissioner may disclose the result of any search made for the purpose of making a report under this Act.



## **Chapter 5—Opposition to grant of standard patent**

### **59 Opposition to grant of standard patent**

The Minister or any other person may, in accordance with the regulations, oppose the grant of a standard patent on one or more of the following grounds, but on no other ground:

- (a) that the nominated person is either:
  - (i) not entitled to a grant of a patent for the invention; or
  - (ii) entitled to a grant of a patent for the invention but only in conjunction with some other person;
- (b) that the invention is not a patentable invention;
- (c) that the specification filed in respect of the complete application does not comply with subsection 40(2) or (3).

### **60 Hearing and decision by Commissioner**

- (1) Where the grant of a standard patent is opposed, the Commissioner must decide the case in accordance with the regulations.
- (2) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding a case.
- (3) The Commissioner may, in deciding a case, take into account any ground on which the grant of a standard patent may be opposed, whether relied upon by the opponent or not.
- (4) The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

## **Chapter 6—Grant and term of patents**

### **Part 1—Grant**

#### **61 Grant of standard patent**

- (1) Subject to section 100A, the Commissioner must grant a standard patent, by sealing a standard patent in the approved form, if:
  - (a) there is no opposition to the grant; or
  - (b) in spite of opposition, the Commissioner's decision, or the decision on appeal, is that a standard patent should be granted.
- (2) A standard patent must be granted within the prescribed period.

#### **62 Grant and publication of innovation patent**

- (1) If:
  - (a) the Commissioner accepts a patent request and complete specification filed in respect of an application for an innovation patent; and
  - (b) a prohibition order is not in force under subsection 152(3) or 173(1) in relation to the application;the Commissioner must grant the innovation patent by sealing an innovation patent in the approved form.
- (2) If an innovation patent is granted, the Commissioner must publish a notice in the *Official Journal* stating that:
  - (a) the innovation patent has been granted; and
  - (b) the patent request and complete specification are open to public inspection.
- (3) If:
  - (a) a divisional application provided for in section 79B is made for an innovation patent; and

- (b) a notice is published in the *Official Journal* that the complete specification filed in respect of the divisional application is open to public inspection;

the Commissioner must also publish in the *Official Journal* a notice that the complete specification filed in respect of the original application on which the divisional application is based is open to public inspection.

### **63 Joint patentees**

A patent may be granted to 2 or more nominated persons jointly.

### **64 Grant: multiple applications**

- (1) Subject to this section, where there are 2 or more applications for patents for identical, or substantially identical, inventions, the granting of a patent on one of those applications does not prevent the granting of a patent on any of the other applications.
- (2) Where:
- (a) an application for a standard patent claims an invention that is the same as an invention that is the subject of a patent and is made by the same inventor; and
  - (b) the relevant claim or claims in each of the complete specifications have the same priority date or dates;
- a standard patent cannot be granted on the application.

### **65 Date of patent**

The date of a patent is:

- (a) the date of filing of the relevant complete specification; or
- (b) where the regulations provide for the determination of a different date as the date of a patent—the date determined under the regulations.

### **66 Sealing of duplicate of patent**

- (1) The Commissioner may seal a duplicate of a patent if satisfied that the patent is lost, stolen, damaged or destroyed.

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- (2) If:
- (a) the Commissioner is satisfied that particulars on a patent are incorrect because of an error or omission by the Commissioner; and
  - (b) the patent is returned to the Commissioner;
- the Commissioner may seal a duplicate of the patent.

## **Part 2—Term**

### **67 Term of standard patent**

The term of a standard patent is 20 years from the date of the patent.

### **68 Term of innovation patent**

The term of an innovation patent is 8 years from the date of the patent.

## Part 3—Extension of term of standard patents relating to pharmaceutical substances

### 70 Applications for extension of patent

- (1) The patentee of a standard patent may apply to the Commissioner for an extension of the term of the patent if the requirements set out in subsections (2), (3) and (4) are satisfied.
- (2) Either or both of the following conditions must be satisfied:
  - (a) one or more pharmaceutical substances *per se* must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification;
  - (b) one or more pharmaceutical substances when produced by a process that involves the use of recombinant DNA technology, must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification.
- (3) Both of the following conditions must be satisfied in relation to at least one of those pharmaceutical substances:
  - (a) goods containing, or consisting of, the substance must be included in the Australian Register of Therapeutic Goods;
  - (b) the period beginning on the date of the patent and ending on the first regulatory approval date for the substance must be at least 5 years.

Note: Section 65 sets out the date of a patent.
- (4) The term of the patent must not have been previously extended under this Part.
- (5) For the purposes of this section, the *first regulatory approval date*, in relation to a pharmaceutical substance, is:
  - (a) if no pre-TGA marketing approval was given in relation to the substance—the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, the substance; or

- (b) if pre-TGA marketing approval was given in relation to the substance—the date of the first approval.
- (6) For the purposes of this section, *pre-TGA marketing approval*, in relation to a pharmaceutical substance, is an approval (however described) by a Minister, or a Secretary to a Department, to:
  - (a) market the substance, or a product containing the substance, in Australia; or
  - (b) import into Australia, for general marketing, the substance or a product containing the substance.

## **71 Form and timing of an application**

### *Form of application*

- (1) An application for an extension of the term of a standard patent must:
  - (a) be in the approved form; and
  - (b) be accompanied by such documents (if any) as are ascertained in accordance with the regulations; and
  - (c) be accompanied by such information (if any) as is ascertained in accordance with the regulations.

For this purpose, *document* includes a copy of a document.

### *Timing of application*

- (2) An application for an extension of the term of a standard patent must be made during the term of the patent and within 6 months after the latest of the following dates:
  - (a) the date the patent was granted;
  - (b) the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, any of the pharmaceutical substances referred to in subsection 70(3);
  - (c) the date of commencement of this section.

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**72 Notification and public inspection of application**

If a patentee makes an application for an extension of the term of a standard patent, the Commissioner must publish in the *Official Journal* a notice that the application has been made and is open to public inspection.

**73 Withdrawal of application**

- (1) A patentee who has applied for an extension of the term of a standard patent may, by notice in writing to the Commissioner, withdraw the application.
- (2) If an application for an extension of the term of a standard patent is withdrawn, the Commissioner must publish in the *Official Journal* a notice stating that the application has been withdrawn.

**74 Acceptance or refusal of application**

*Acceptance*

- (1) If a patentee of a standard patent makes an application for an extension of the term of the patent, the Commissioner must accept the application if the Commissioner is satisfied that the requirements of sections 70 and 71 are satisfied in relation to the application.
- (2) If the Commissioner accepts the application, the Commissioner must:
  - (a) notify the applicant in writing of the acceptance; and
  - (b) publish a notice of the acceptance in the *Official Journal*.

*Refusal*

- (3) The Commissioner must refuse to accept the application if the Commissioner is not satisfied that the requirements of sections 70 and 71 are satisfied in relation to the application.
- (4) If the Commissioner refuses to accept the application, the Commissioner must:
  - (a) notify the applicant in writing of the reasons for the refusal; and
  - (b) publish a notice of the refusal in the *Official Journal*.



### **75 Opposition to grant of extension**

- (1) The Minister or any other person may, in accordance with the regulations, oppose the grant of an extension of the term of a standard patent on the ground that one or more of the requirements of sections 70 and 71 are not satisfied in relation to the application for the extension. The Minister or other person may not oppose the grant of the extension on any other ground.
- (2) If the grant of an extension of the term of a standard patent is opposed, the Commissioner must decide the case in accordance with the regulations.
- (3) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding a case.
- (4) The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

### **76 Grant of extension**

- (1) The Commissioner must grant an extension of the term of a standard patent if:
  - (a) there is no opposition to the grant; or
  - (b) in spite of opposition, the Commissioner's decision, or the decision on appeal, is that the extension should be granted.
- (2) If the Commissioner grants an extension, the Commissioner must notify the applicant in writing of the grant and publish a notice of the grant in the *Official Journal*.

### **76A Notification of extension to the Secretary, Health and Family Services**

In respect of each application for an extension approved by the Commissioner under section 76 in a financial year, the patent holder must lodge with the Secretary of the Department, before the end of the following financial year, a return setting out the following information:

- (a) details of the amount and origin of any Commonwealth funds spent in the research and development of the drug which was the subject of the application; and

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- (b) the name of any body:
  - (i) with which the applicant has a contractual agreement; and
  - (ii) which is in receipt of Commonwealth funds; and
- (c) the total amount spent on each type of research and development, including pre-clinical research and clinical trials, in respect of the drug which was the subject of the application.

**77 Calculation of term of extension**

- (1) If the Commissioner grants an extension of the term of a standard patent, the term of the extension is equal to:
  - (a) the period beginning on the date of the patent and ending on the earliest first regulatory approval date (as defined by section 70) in relation to any of the pharmaceutical substances referred to in subsection 70(2);reduced (but not below zero) by:
  - (b) 5 years.

Note: Section 65 sets out the date of a patent.

- (2) However, the term of the extension cannot be longer than 5 years.

**78 Exclusive rights of patentee are limited if extension granted**

If the Commissioner grants an extension of the term of a standard patent, the exclusive rights of the patentee during the term of the extension are not infringed:

- (a) by a person exploiting:
  - (i) a pharmaceutical substance *per se* that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification; or
  - (ii) a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology, that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification;for a purpose other than therapeutic use; or

- (b) by a person exploiting any form of the invention other than:
  - (i) a pharmaceutical substance *per se* that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification; or
  - (ii) a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology, that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification.

### **79 Rights of patentee if extension granted after patent expires**

If:

- (a) a patentee applies for an extension of the term of a standard patent; and
- (b) the term of the patent expires before the application is determined; and
- (c) the extension is granted;

the patentee has, after the extension is granted, the same rights to start proceedings in respect of the doing of an act during the period:

- (d) commencing on the expiration of the term of the patent; and
- (e) ending on the day on which the extension was granted;

as if the extension had been granted at the time when the act was done.

### **79A Commissioner not to make decision if court proceedings pending**

If:

- (a) a patentee of a standard patent applies for an extension of the term of the patent; and

- (b) relevant proceedings in relation to the patent are pending;

the Commissioner must not make any decision under this Part in relation to the patent without the leave of the court.

## Chapter 6A—Divisional applications

### 79B Divisional applications prior to grant of patent

- (1) If a complete patent application for a patent is made (but has not lapsed or been refused or withdrawn), the applicant may, in accordance with the regulations, 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.
- (1A) The reference to a complete patent application first-mentioned in subsection (1) does not include a reference to a divisional application for an innovation patent provided for in section 79C.
- (2) In this section:

*applicant* has the same meaning as in section 38.

### 79C Divisional applications for innovation patents may be made after grant of an innovation patent

*Applications may be made*

- (1) A patentee of an innovation patent (the *first patent*) may, in accordance with the regulations, make a complete application for another innovation patent for a further invention disclosed in the first patent if the invention was disclosed in the complete specification filed in respect of the application on which the first patent was sealed.
- (2) The patentee may make the further complete application only during the period:
  - (a) starting when an examination of the first patent begins; and

- (b) ending when any of the following happens:
  - (i) the term of the first patent ends;
  - (ii) the first patent is revoked;
  - (iii) the first patent ceases;
  - (iv) a period prescribed by the regulations for the purposes of this subparagraph ends.

*When does an examination begin?*

- (3) For the purposes of subsection (2), an examination of the patent begins:
  - (a) if the examination has been requested under paragraph 101A(b)—on the day the request was made; or
  - (b) if the Commissioner decided to examine the patent under paragraph 101A(a)—on the day the Commissioner made that decision.

## Chapter 7—Patents of addition

### 80 Chapter does not apply to innovation patents

This Chapter does not apply in relation to innovation patents.

### 81 Grant of patent of addition

- (1) Where:
  - (a) a patent for an invention (in this Chapter called *the main invention*) has been applied for or granted; and
  - (b) the applicant or patentee (or a person authorised by the applicant or patentee) applies for a further patent for an improvement in, or modification of, the main invention; and
  - (c) the application for that further patent is made in accordance with the regulations;the Commissioner may, subject to this Act and the regulations, grant a patent of addition for the improvement or modification.
- (2) A patent request and complete specification relating to an application for a patent of addition must not be examined before a request is made for the examination of the patent request and complete specification relating to the application for the patent for the main invention.
- (3) A patent of addition must not be sealed before the patent for the main invention is sealed.
- (4) An appeal lies to the Federal Court against a decision of the Commissioner under this section.

### 82 Revocation of patent and grant of patent of addition instead

- (1) Where:
  - (a) an invention that is an improvement in, or modification of, a main invention is the subject of an independent patent; and

- (b) the patentee of the independent patent is also the patentee of the patent for the main invention;  
the Commissioner may, on an application made by the patentee, revoke the independent patent and grant a patent of addition for the improvement or modification.
- (2) A patent of addition granted under this section must be given the same date as the date of the independent patent that is revoked.
- (3) An appeal lies to the Federal Court against a decision of the Commissioner refusing an application under this section.

### **83 Term of patent of addition**

#### *Usual term*

- (1) The general rule is that a patent of addition remains in force for so long as the patent for the main invention remains in force. However, this rule is subject to the exceptions set out in subsections (3) and (4).
- (2) The term of a patent of addition may be extended under Part 3 of Chapter 6, even though the patent for the main invention is not extended under that Part.

#### *Patent of addition extended*

- (3) If the term of a patent of addition is extended under Part 3 of Chapter 6:
- (a) the extension begins at the end of the unextended term of the patent for the main invention; and
- (b) when the extension begins, the patent of addition becomes an independent patent.

#### *Patent for main invention extended*

- (4) If:
- (a) the term of the patent for the main invention is extended under Part 3 of Chapter 6; and
- (b) the term of the patent of addition is not extended under that Part;
- the term of the patent of addition expires at the end of the unextended term of the patent for the main invention.

### **85 Revocation of patent for main invention**

- (1) If the patent for the main invention is revoked by a prescribed court, or by the Commissioner under section 101 or 137, the patent of addition becomes an independent patent unless otherwise ordered by:
  - (a) where the patent is revoked by a prescribed court—that court; or
  - (b) in any other case—the Commissioner.
- (2) Where a patent of addition becomes an independent patent under this section, its term cannot be more than the unexpired part of the term of the patent for the main invention.

### **86 Renewal fees not payable**

A fee is not payable for the renewal of a patent of addition.

### **87 Fees payable where patent of addition becomes an independent patent**

The fees payable after a patent of addition becomes an independent patent, and the dates when they become payable, are to be determined by reference to the date of the independent patent.



## **Chapter 8—PCT applications and convention applications**

### **Part 1—PCT applications**

#### **88 PCT applications**

- (1) Subject to this section, a PCT application must, for the purposes of this Act other than this Part, be treated as a complete application under this Act for a standard patent.
- (3) The description, drawings and claims contained in a PCT application must be treated as a complete specification filed in respect of the application.
- (4) The filing date of a PCT application is to be taken to be its international filing date.
- (5) For the purposes of this Act, an indication, in relation to a deposited micro-organism furnished under Rule 13 *bis.* 4, in relation to a PCT application, is to be taken to be included in the description contained in the PCT application even if the indication is contained in another document.
- (6) The reference in subsection (5) to Rule 13 *bis.* 4 is a reference to Rule 13 *bis.* 4 of the Regulations mentioned in the definition of *PCT* in Schedule 1.

[*Note: international filing date is defined in Schedule 1: see also section 10.*]

#### **89 Modified application of Act** [*see also* Table B]

- (1) A PCT application is to be taken to comply with the prescribed requirements of this Act and the regulations that relate to patent applications for standard patents but is not to be taken, merely because of section 88, to comply with any other such requirements that apply to it.

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- (2) The description, drawings and claims contained in a PCT application are not to be taken, merely because of section 88, to comply with the requirements of section 40.
- (3) An applicant is not entitled to ask that any action be taken, or that he or she be allowed to take any action, under this Act in relation to a PCT application unless:
  - (a) if the application was not filed in the receiving Office in English—a translation of the application into English, verified in accordance with the regulations, has been filed; and
  - (b) in any case—the prescribed documents have been filed and the prescribed fees paid.
- (4) If a translation of a PCT application has been filed, being a translation of the kind mentioned in paragraph (3)(a), the description and claims, and any matter associated with the drawings, contained in the application are to be taken to have been amended, on the day on which the translation was filed, by substituting the translation of the description, claims and matter for the original.
- (5) Where:
  - (a) a PCT application has been amended under Article 19 of the PCT; or
  - (b) a PCT application in respect of which Australia has been elected under Chapter II of the PCT within the period specified in Article 39 of the PCT has been amended under Article 34 of the PCT; or
  - (c) a PCT application has been rectified under Rule 91 of the Regulations mentioned in the definition of *PCT* in Schedule 1; the description, drawings and claims contained in the application are, for the purposes of this Act, to be taken to have been amended on the day on which that amendment or rectification was made.

**90 Publication of PCT applications** [*see also* Table B]

A PCT application is to be taken to have become open to public inspection, and to have been published in Australia:

- (a) where a notice in relation to the application is published under subsection 92(1) or (2)—on the day on which the notice is so published; or

- (b) where a notice in relation to the application is published under subsection 92(3)—on the day on which a copy of the application, as so published, is received in the Patent Office.

### **91 Application of certain provisions to PCT applications**

For the purposes of applying section 57 to a PCT application, references to the complete specification becoming open to public inspection are references to the PCT application being taken to have become open to public inspection under section 90.

### **92 Notice of publication** [*see also* Table B]

- (1) Where, in relation to a PCT application that has not lapsed, or been withdrawn or refused:
  - (a) the applicant complies with subsection 89(3); and
  - (b) the applicant asks the Commissioner in writing to publish a notice in the *Official Journal* that the application is open to public inspection; and
  - (c) the application is not already open to public inspection;  
the Commissioner must publish a notice in the *Official Journal* stating that a copy of the application is open to public inspection.
- (2) Where:
  - (a) a PCT application that has not lapsed, or been withdrawn or refused, is to be treated as an application for a standard patent under this Act; and
  - (b) the applicant complies with subsection 89(3); and
  - (c) the period of 18 months after the priority date of the application has ended; and
  - (d) the application is not already open to public inspection;  
the Commissioner must publish a notice in the *Official Journal* stating that a copy of the application is open to public inspection.
- (3) Where:
  - (a) a copy of a PCT application, as published under Article 21 of the PCT, is received in the Patent Office; and
  - (b) the application has not lapsed, or been withdrawn or refused;  
and

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- (c) a notice has not been published under subsection (1) or (2); the Commissioner must publish a notice in the *Official Journal* specifying the date on which the copy was so received and stating that the copy is open to public inspection.
- (4) Where a notice is published in the *Official Journal* under this section, a copy of the relevant application and of any other prescribed document is open to public inspection.

**93 Evidence of matters arising under PCT**

A certificate signed by the Commissioner in relation to an international application, certifying that:

- (a) any matter or thing required or permitted by or under this Act or the PCT to be made or done has been made or done; or
- (b) any matter or thing required by or under this Act or the PCT not to be made or done has not been made or done;
- is *prima facie* evidence of the matters contained in the certificate.

## **Part 2—Convention applications**

### **94 Convention applicants may make Convention applications**

- (1) A Convention applicant in relation to a basic application may make a Convention application, or 2 or more such applicants may make a joint Convention application, within the prescribed period.
- (2) Where 2 or more basic applications for protection in respect of inventions have been made in one or more Convention countries, one Convention application may be made within the prescribed period by a Convention applicant in relation to those basic applications, or by 2 or more such entitled applicants jointly, in respect of the inventions disclosed in the basic applications.

### **95 Manner of making Convention application**

- (1) Subject to this section, a Convention application must be made and dealt with in the same way as any other patent application.
- (2) A patent request relating to a Convention application must:
  - (a) include the prescribed particulars relating to the relevant basic application; and
  - (b) be accompanied by a complete specification.
- (3) In addition to the complete specification, the prescribed documents must be filed within the prescribed period.

### **96 Withdrawn, abandoned or refused applications**

- (1) Where, at the time when a Convention application is made in respect of an invention:
  - (a) an application has been made for protection in respect of the invention in a Convention country; and
  - (b) the application has been withdrawn, abandoned or refused without becoming open to public inspection; and
  - (c) the application has not been used as the basis of claiming a right of priority in a Convention country under a law of that country corresponding to this Part; and

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- (d) a later application has been made by the same applicant for protection in respect of the invention in the Convention country in which the earlier application was made; the applicant may ask the Commissioner to disregard the earlier application for the purposes of this Part.
- (2) Where an applicant makes a request under subsection (1):
  - (a) the earlier application must be disregarded; and
  - (b) neither the applicant nor any other applicant may use the earlier application as a basic application for the purposes of this Part.

## **Chapter 9—Re-examination of standard patents**

### **96A Chapter does not apply to innovation patents**

This Chapter does not apply in relation to innovation patents.

### **97 Re-examination of complete specifications**

- (1) Subject to this section and the regulations, if:
  - (a) a request and complete specification relating to an application for a patent has been accepted; and
  - (b) the patent has not been granted;the Commissioner may re-examine the complete specification.
- (2) Subject to this section and the regulations, where a patent has been granted, the Commissioner may, and must if asked to do so by the patentee or any other person, re-examine the complete specification.
- (3) Where the validity of a patent is disputed in any proceedings before a prescribed court under this Act, the court may direct the Commissioner to re-examine the complete specification and the Commissioner must re-examine the specification accordingly.
- (4) Where relevant proceedings in relation to a patent are pending, the Commissioner must not re-examine the complete specification relating to the patent under subsection (2).
- (5) Where:
  - (a) the Commissioner has started to re-examine a complete specification relating to a patent under subsection (2); and
  - (b) relevant proceedings in relation to the patent are started;the Commissioner must not continue the re-examination.

### **98 Report on re-examination**

- (1) On re-examining a complete specification, the Commissioner must ascertain and report whether, to the best of his or her knowledge, 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:
  - (a) is not novel; and
  - (b) does not involve an inventive step.
- (2) For the purposes of subsection (1), the prior art base is to be taken not to include information made publicly available only through the doing of an act (whether in or out of the patent area).

[*Note: see also section 7.*]

### **99 Statement by applicant or patentee**

- (1) Where the Commissioner reports adversely on a complete specification, the applicant or patentee may, within the prescribed period, file a statement, in accordance with the regulations, disputing the whole or any part of the report.
- (2) The applicant or patentee may file a statement whether or not the applicant or patentee takes steps to amend the complete specification, or files a statement of amendments in accordance with a direction under section 106 or 107.

### **100 Copies of report to be given to court**

A copy of a report under section 98, and of any statement filed under section 99 in relation to the report, must, where the re-examination was directed under subsection 97(3), be given to the court that gave the direction.

### **100A Refusal to grant patent—re-examination before grant**

- (1) Where the Commissioner makes an adverse report on a re-examination under subsection 97(1), the Commissioner may refuse to grant the patent (see subsection 61(1)).



- (2) The Commissioner cannot refuse to grant a patent under this section unless the Commissioner:
  - (a) has given the applicant a reasonable opportunity to be heard; and
  - (b) has, where appropriate, given the applicant a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the applicant has failed to do so.
- (3) The applicant may appeal to the Federal Court against a decision of the Commissioner under this section.

**101 Revocation of patent—re-examination after grant**

- (1) Where the Commissioner makes an adverse report on a re-examination under subsection 97(2), the Commissioner may, by notice in writing, revoke the patent, either wholly or so far as it relates to a particular claim, as the case requires.
- (2) The Commissioner must not revoke a patent under this section unless the Commissioner:
  - (a) has given the patentee a reasonable opportunity to be heard; and
  - (b) has, where appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the patentee has failed to do so.
- (3) The Commissioner must not revoke a patent under this section while relevant proceedings in relation to that patent are pending.
- (4) The patentee may appeal to the Federal Court against a decision of the Commissioner under this section.

## **Chapter 9A—Examination, re-examination and opposition-innovation patents**

### **Part 1—Examination of innovation patents**

#### **101A Examination may be requested or Commissioner may decide to examine**

After the grant of an innovation patent, the Commissioner:

- (a) may, if the Commissioner decides to do so; and
- (b) must, if asked to do so, in writing, by the patentee or any other person;

examine the complete specification relating to an innovation patent.

#### **101B Examination of an innovation patent**

*What the Commissioner must do in examining a patent*

- (1) If the Commissioner examines an innovation patent under section 101A, the Commissioner must:
  - (a) examine the complete specification relating to the patent to determine if the patent is invalid and should be revoked because a ground set out in subsection (2), (4), (5), (6) or (7) is made out; and
  - (b) report on the grounds set out in those subsections.These are the only grounds for revocation under this section.

*Grounds for revocation relating to validity*

- (2) The grounds for revocation under subsection (1) include the following:
  - (a) that the specification does not comply with section 40;
  - (b) that the invention, so far as claimed, does not comply with paragraph 18(1A)(a) or (b);
  - (c) that the invention is not a patentable invention under subsection 18(2) or (3);
  - (d) that the use of the invention would be contrary to law.

- (3) For the purposes of working out whether the invention does not comply with paragraph 18(1A)(b), the prior art base (referred to in that paragraph) is to be taken not to include information made publicly available only through the doing of an act (whether in or out of the patent area).

*Revocation on ground that invention claims a substance capable of being used as food or medicine etc.*

- (4) A further ground for revocation is that the patent claims as an invention:
- (a) a substance that is capable of being used as food or medicine (whether for human beings or animals and whether for internal or external use) and is a mere mixture of known ingredients; or
  - (b) a process producing such a substance by mere admixture.

*Revocation on ground that patent includes a name*

- (5) A further ground for revocation is that the patent contains a claim that includes the name of a person as the name, or part of the name, of the invention so far as it is claimed in that claim.

*Revocation on grounds of multiple patents for one invention*

- (6) A further ground for revocation is that:
- (a) the innovation patent claims an invention that is the same as an invention that is the subject of a patent and is made by the same inventor; and
  - (b) the relevant claim or claims in respect of each patent have the same priority date or dates.

*Revocation for grounds set out in the regulations*

- (7) A further ground for revocation is that the complete specification does not comply with such other matters (if any) as are prescribed.

### **101C How and when examination to be carried out**

The examination under section 101B must be carried out:

- (a) in accordance with the regulations; and
- (b) within the period prescribed.

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**101D Commissioner to be given information on searches**

- (1) The patentee must inform the Commissioner, in accordance with the regulations, of the results of the following searches carried out for the purpose of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside Australia:
  - (a) any documentary searches by, or on behalf of, a foreign patent office, other than searches prescribed by the regulations;
  - (b) the documentary searches prescribed by the regulations.
- (2) Subsection (1) only applies to searches completed before the issue of a certificate of examination in respect of the patent.
- (3) In subsection (2):

*completed*, in relation to a search, has the meaning prescribed by the regulations.

**101E Certificate of examination**

If:

- (a) after examining a patent under section 101B, the Commissioner decides in writing that he or she is satisfied that the invention, so far as claimed, complies with paragraph 18(1A)(b); and
- (aa) after so examining the patent, the Commissioner also decides in writing that he or she considers that:
  - (i) a ground for the revocation of the patent (other than a ground in respect of paragraph 18(1A)(b)) has not been made out; or
  - (ii) any such ground has been removed; and
- (b) the patent has not ceased under section 143A;

the Commissioner must:

- (c) notify the patentee and the person who requested the examination (if that person is not the patentee) that the patent has been examined and that a certificate of examination is to be issued; and
- (d) publish a notice of the examination having occurred in the *Official Journal*; and

- (e) issue a certificate of examination to the patentee in the form approved by the Commissioner; and
- (f) register the issue of the certificate.

**101F Revocation of innovation patents following examination under section 101B**

- (1) If:
  - (a) the Commissioner considers that, after examining a patent under section 101B, a ground for the revocation of a patent has been made out and that the ground has not been removed; and
  - (b) the patent has not ceased under section 143A;  
the Commissioner must revoke the patent.
- (2) If the Commissioner revokes the patent:
  - (a) the Commissioner must notify the patentee and the person who requested the examination (if that person is not the patentee) of the revocation; and
  - (b) register the revocation of the patent.
- (3) The Commissioner must not revoke a patent under this section unless the Commissioner:
  - (a) has given the patentee a reasonable opportunity to be heard; and
  - (b) has, if appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purposes of removing a ground for the revocation of the patent and the patentee has failed to do so.
- (4) An appeal lies to the Federal Court against a decision of the Commissioner revoking a patent.

## **Part 2—Re-examination of innovation patents**

### **101G Re-examination of complete specifications of innovation patents**

- (1) Subject to subsections 101K(2) and (3) and the regulations, after an innovation patent has been certified, the Commissioner:
  - (a) may, if the Commissioner decides to do so; and
  - (b) must, if asked to do so, in writing, by the patentee or any other person;re-examine the complete specification relating to the patent.
- (2) If the Commissioner re-examines an innovation patent under subsection (1):
  - (a) the Commissioner must re-examine the complete specification relating to the patent to determine if the patent is invalid and should be revoked because a ground set out in subsection (3) is made out; and
  - (b) the Commissioner must report on the grounds set out in subsection (3).
- (3) The grounds for the revocation of the patent under subsection (2) are whether 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:
  - (a) is not novel; and
  - (b) does not involve an innovative step.
- (4) There are no other grounds for the revocation of a patent under subsection (2).
- (5) For the purposes of subsection (3), the prior art base is to be taken not to include information made publicly available only through the doing of an act (whether in or out of the patent area).

### **101H Patentee statements**

- (1) If the Commissioner reports that, after re-examining a patent under section 101G, a ground for the revocation of the patent has been

made out, the patentee may, within the prescribed period, file a statement, in accordance with the regulations, disputing the whole or any part of the report.

- (2) The patentee may file a statement whether or not the patentee takes steps to amend the complete specification, or files a statement of amendments in accordance with a direction under section 106.

### **101J Revocation of innovation patent following re-examination**

- (1) If the Commissioner makes an adverse report on a re-examination under section 101G, the Commissioner may, by notice in writing, revoke the patent, either wholly or so far as it relates to a particular claim, as the case requires.
- (2) If the Commissioner revokes the patent:
  - (a) the Commissioner must notify the patentee and the person who requested the examination (if that person is not the patentee) of the revocation; and
  - (b) register the revocation of the patent.
- (3) The Commissioner must not revoke a patent under this section unless:
  - (a) the Commissioner has given the patentee a reasonable opportunity to be heard; and
  - (b) the Commissioner has considered the statement made by the patentee under section 101H (if any); and
  - (c) the Commissioner has, if appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any ground for revocation and the patentee has failed to do so.
- (4) The Commissioner must not revoke a patent under this section while relevant proceedings in relation to that patent are pending.
- (5) The patentee may appeal to the Federal Court against a decision of the Commissioner under this section.

### **101K Relevant proceedings and re-examination**

- (1) If the validity of an innovation patent is disputed in any proceedings before a prescribed court under this Act, the court may direct the Commissioner to re-examine the complete specification

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relating to the patent. If so directed, the Commissioner must re-examine the specification accordingly.

- (2) If relevant proceedings in relation to an innovation patent are pending, the Commissioner must not re-examine the complete specification relating to the patent.
- (3) If:
  - (a) the Commissioner has started to re-examine a complete specification relating to an innovation patent; and
  - (b) relevant proceedings in relation to the patent are started;the Commissioner must not continue the re-examination.

**101L Copies of report to be given to court**

A copy of a report under paragraph 101G(2)(b), and of any statement filed under section 101H in relation to the report, must, if the re-examination was directed under subsection 101K(1), be given to the court that gave the direction.



## **Part 3—Opposition to innovation patents**

### **101M Opposition to innovation patent**

The Minister, or any other person, may, in accordance with the regulations, oppose an innovation patent that has been certified and seek the revocation of it, on one or more of the following grounds of invalidity, but on no other:

- (a) that the patentee is either:
  - (i) not entitled to the patent; or
  - (ii) entitled to the patent but only in conjunction with some other person;
- (b) that the invention is not a patentable invention because it does not comply with paragraph 18(1A)(a) or (b);
- (c) that the invention is not a patentable invention under subsection 18(2) or (3);
- (d) that the complete specification does not comply with subsection 40(2) or (3).

### **101N Hearing and decision by the Commissioner**

- (1) If an innovation patent has been opposed under section 101M, the Commissioner must decide the case in accordance with the regulations.
- (2) The Commissioner must give the opponent and the patentee a reasonable opportunity to be heard before deciding the case.
- (3) The Commissioner may, in deciding whether to revoke the patent, take into account any ground on which the grant of an innovation patent may be opposed, whether relied upon by the opponent or not.
- (4) Subject to subsection (6), if the Commissioner is satisfied that a ground exists for the revocation of an innovation patent, the Commissioner may revoke the patent in writing either wholly or so far as it relates to a particular claim.

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- (5) If the Commissioner revokes the patent:
  - (a) the Commissioner must notify the patentee and the opponent of the revocation; and
  - (b) register the revocation of the patent.
- (6) The Commissioner must not revoke a patent under this section unless the Commissioner has, where appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any ground for revocation and the patentee has failed to do so.
- (7) The patentee, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

**101P Relevant proceedings and opposition**

If relevant proceedings in relation to an innovation patent are pending, the Commissioner must not make a decision under this Part in relation to the patent without the leave of the court.

## Chapter 10—Amendments

### Part 1—Amendments that are not allowable

#### 102 What amendments are not allowable?

*Amendment of complete specification not allowable if amended specification would claim matter not in substance disclosed in the filed specification*

- (1) An amendment of a complete specification is not allowable if, as a result of the amendment, the specification would claim matter not in substance disclosed in the specification as filed.

*Certain amendments of complete specification are not allowable after relevant time*

- (2) An amendment of a complete specification is not allowable after the relevant time if, as a result of the amendment:
  - (a) a claim of the specification would not in substance fall within the scope of the claims of the specification before amendment; or
  - (b) the specification would not comply with subsection 40(2) or (3).

*Meaning of relevant time<sup>1</sup>*

- (2A) For the purposes of subsection (2), **relevant time** means:
  - (a) in relation to an amendment proposed to a complete specification relating to a standard patent—after the specification has been accepted; or
  - (b) in relation to an amendment proposed to a complete specification relating to an innovation patent—after the Commissioner has made decisions under paragraphs 101E(a) and (aa) in respect of the patent.

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<sup>1</sup> This heading has been placed in the correct position.

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*Amendment of innovation patent request not allowable in certain circumstances*

- (2B) An amendment to a patent request relating to an innovation patent application is not allowable if:
- (a) the patent application was provided for in section 79C; and
  - (b) the effect of the proposed amendment would be to convert the application from an application for an innovation patent to an application for a standard patent.

*Amendments not allowable if information not provided*

- (2C) An amendment of a complete specification relating to a patent is not allowable if:
- (a) the patentee or the patentee's predecessor in title failed to ensure the provision to the Commissioner of the information required by subsection 45(3) or section 101D in relation to the patent; and
  - (b) the effect of the proposed amendment would be to remove a lawful ground of objection under paragraph 18(1)(b) or 18(1A)(b) to the specification arising from the existence of some or all of the information not provided.
- (3) This section does not apply to an amendment for the purpose of correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification.

**103 Consent of mortgagee or exclusive licensee needed**

- (1) Where a person is registered as the mortgagee or exclusive licensee of a patent, an amendment of the complete specification is not allowable unless the mortgagee or licensee has consented, in writing, to the amendment.
- (2) If a mortgagee or licensee refuses to consent to a proposed amendment, the Commissioner may, on the application of the applicant or patentee, if satisfied that the consent has been unreasonably refused, direct that the consent of the mortgagee or licensee is not necessary.

## **Part 2—Amendments of patent requests, specifications and other filed documents**

### **104 Amendments by applicants and patentees**

- (1) An applicant for a patent or a patentee, may, subject to this Act, and subject to and in accordance with the regulations, ask the Commissioner for leave to amend the relevant patent request or complete specification, or any other filed document, for any purpose including either or both of the following:
  - (a) removing a lawful ground of objection to the request or specification, whether that objection is raised in the course of an examination or re-examination or otherwise;
  - (b) correcting a clerical error or an obvious mistake.
- (2) Where an applicant or patentee asks for leave to amend a patent request or complete specification, or any other filed document, the Commissioner must consider and deal with the request in accordance with the regulations.
- (4) The Minister or any other person may, subject to and in accordance with the regulations, oppose allowing an amendment.
- (5) The Commissioner must not allow an amendment that is not allowable under section 102.
- (6) On the allowance of an amendment, the amendment is to be taken to have been made.
- (7) An appeal lies to the Federal Court, against a decision of the Commissioner allowing, or refusing to allow, a requested amendment, other than a prescribed decision.

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**105 Amendments directed by court**

- (1) In any relevant proceedings in relation to a patent, the court may, on the application of the patentee, by order direct the amendment of the patent, the patent request or the complete specification in the manner specified in the order.
- (2) An order may be made subject to such terms (if any) as to costs, advertisements or otherwise, as the court thinks fit.
- (3) The patentee must give notice of an application for an order to the Commissioner, who is entitled to appear and be heard, and must appear if the court directs.
- (4) A court is not to direct an amendment that is not allowable under section 102.
- (5) The patentee must file a copy of an order within the prescribed period.
- (6) On the filing of a copy of an order, the patent, patent request or complete specification is to be taken to have been amended in the manner specified in the order.

**106 Amendments directed by Commissioner: patents**

- (1) Where:
  - (a) a patent has been granted; and
  - (b) the Commissioner is satisfied that the patent is invalid on grounds that could be removed by appropriate amendments of the specification following:
    - (i) in the case of a standard patent—re-examination of the patent; or
    - (ii) in the case of an innovation patent—examination of, re-examination of, or opposition to, the patent;the Commissioner may, in accordance with the regulations, direct the patentee to file, within such time as the Commissioner allows, a statement of proposed amendments of the specification for the purpose of removing those grounds.
- (2) The Commissioner must not give a direction without first giving the patentee a reasonable opportunity to be heard.

- (3) A patentee may, in accordance with the regulations, amend a statement of amendments.
- (4) If the Commissioner is satisfied that the amendments set out in a statement (or an amended statement) are allowable and would, if made, remove the grounds on which the patent is invalid, the Commissioner must allow the amendments.
- (5) On the allowance of an amendment, the amendment is to be taken to have been made.

### **107 Amendments directed by Commissioner: applications for standard patents**

- (1) Where:
  - (a) a complete application for a standard patent has been made; and
  - (b) the Commissioner is satisfied that there are lawful grounds of objection to the patent request or complete specification, but that those grounds of objection could be removed by appropriate amendments of the request or specification; and
  - (c) the applicant has not taken action to amend the request or specification so as to remove those grounds of objection;the Commissioner may, in accordance with the regulations, direct the applicant to file, within such time as the Commissioner allows, a statement of proposed amendments of the request or specification for the purpose of removing those grounds of objection.
- (2) The Commissioner must not give a direction without first giving the applicant a reasonable opportunity to be heard.
- (3) An applicant may, in accordance with the regulations, amend a statement of amendments.
- (4) If the Commissioner is satisfied that the amendments set out in a statement (or an amended statement) are allowable and would, if made, remove all lawful grounds of objection to the patent request and complete specification, the Commissioner must allow the amendments.
- (5) On the allowance of an amendment, the amendment is to be taken to have been made.

**Chapter 10** Amendments

**Part 2** Amendments of patent requests, specifications and other filed documents

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**109 Appeal**

An appeal lies to the Federal Court against a direction of the Commissioner under section 106 or 107.



## **Part 3—Miscellaneous**

### **110 Advertisement of amendment of complete specification**

An amendment of a complete specification that is open to public inspection must be notified in the *Official Journal*.

### **112 Pending proceedings**

A complete specification relating to a patent must not be amended, except under section 105, while relevant proceedings in relation to the patent are pending.

### **113 Persons claiming under assignment or agreement**

- (1) Where, before a patent is granted, a person would, if the patent were then granted, be entitled under an assignment or agreement, or by operation of law, to:
  - (a) the patent or an interest in it; or
  - (b) an undivided share in the patent or in such an interest;the Commissioner may, on a request made by the person in accordance with the regulations, direct that the application proceed in the name of the person, or in the name of the person and the applicant or the other joint applicant or applicants, as the case requires.
- (2) Where the Commissioner gives a direction:
  - (a) the person is to be taken to be the applicant, or a joint applicant, as the case requires; and
  - (b) the patent request is to be taken to have been amended so as to request the grant of a patent to the person, either alone or as a joint patentee, as the case requires.

### **114 Priority date of certain amended claims**

- (1) Where a claim of a complete specification claims matter that was in substance disclosed as a result of amending the specification, the priority date of the claim must be determined under the regulations.

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**114A Objection cannot be taken to certain amended claims**

- (1) This section applies if:
  - (a) a complete specification (the *original specification*) has been amended; and
  - (b) after the amendment, the amended specification claims matter that was in substance disclosed as a result of the amendment; and
  - (c) after the filing date of the original specification there is a publication or use of the invention as described in the original specification.
- (2) If this section applies, objection cannot be taken to the amended specification, and a patent is not invalid, on the ground that the invention, so far as claimed in the amended specification and having regard to the publication or the use of the invention described in the original specification, does not involve:
  - (a) in the case of a standard patent—an inventive step; or
  - (b) in the case of an innovation patent—an innovative step.

**115 Restriction on recovery of damages etc.**

- (1) Where a complete specification is amended after becoming open to public inspection, damages shall not be awarded, and an order shall not be made for an account of profits, in respect of any infringement of the patent before the date of the decision or order allowing or directing the amendment:
  - (a) unless the court is satisfied that the specification without the amendment was framed in good faith and with reasonable skill and knowledge; or
  - (b) if the claim of the specification that was infringed is a claim mentioned under subsection 114(1).
- (2) Subsection (1) has effect subject to subsections 57(3) and (4).

**116 Interpretation of amended specifications**

The Commissioner or a court may, in interpreting a complete specification as amended, refer to the specification without amendment.

## **Chapter 11—Infringement**

### **Part 1—Infringement and infringement proceedings**

#### **117 Infringement by supply of products**

- (1) If the use of a product by a person would infringe a patent, the supply of that product by one person to another is an infringement of the patent by the supplier unless the supplier is the patentee or licensee of the patent.
- (2) A reference in subsection (1) to the use of a product by a person is a reference to:
  - (a) if the product is capable of only one reasonable use, having regard to its nature or design—that use; or
  - (b) if the product is not a staple commercial product—any use of the product, if the supplier had reason to believe that the person would put it to that use; or
  - (c) in any case—the use of the product in accordance with any instructions for the use of the product, or any inducement to use the product, given to the person by the supplier or contained in an advertisement published by or with the authority of the supplier.

#### **118 Infringement exemptions: use in or on foreign vessels, aircraft or vehicles**

The rights of a patentee are not infringed:

- (a) by using the patented invention on board a foreign vessel, in the body of the vessel, or in the machinery, tackle, apparatus or other accessories of the vessel, if the vessel comes into the patent area only temporarily or accidentally and the invention is used exclusively for the needs of the vessel; or
- (b) by using the patented invention in the construction or working of a foreign aircraft or foreign land vehicle, or in the accessories of the aircraft or vehicle, if the aircraft or vehicle comes into the patent area only temporarily or accidentally.

### 119 Infringement exemptions: prior use

- (1) A person may, without infringing a patent, do an act that exploits a product, method or process and would infringe the patent apart from this subsection, if immediately before the priority date of the relevant claim the person:
- (a) was exploiting the product, method or process in the patent area; or
  - (b) had taken definite steps (contractually or otherwise) to exploit the product, method or process in the patent area.

Note 1: This section applies in relation to a patent granted as a result of an application filed on or after the commencement of Schedule 6 to the *Intellectual Property Laws Amendment Act 2006* (which repealed and substituted this section).

Note 2: Section 119 of this Act as in force before the commencement of that Schedule continues to apply in relation to patents granted as a result of earlier applications.

- (2) Subsection (1) does not apply if, before the priority date, the person:
- (a) had stopped (except temporarily) exploiting the product, method or process in the patent area; or
  - (b) had abandoned (except temporarily) the steps to exploit the product, method or process in the patent area.

#### *Limit for product, method or process derived from patentee*

- (3) Subsection (1) does not apply to a product, method or process the person derived from the patentee or the patentee's predecessor in title in the patented invention unless the person derived the product, method or process from information that was made publicly available:
- (a) by or with the consent of the patentee or the patentee's predecessor in title; and
  - (b) through any publication or use of the invention in the prescribed circumstances mentioned in paragraph 24(1)(a).

#### *Exemption for successors in title*

- (4) A person (the *disposer*) may dispose of the whole of the disposer's entitlement under subsection (1) to do an act without infringing a patent to another person (the *recipient*). If the disposer does so, this

section applies in relation to the recipient as if the references in subsections (1), (2) and (3) to the person were references to:

- (a) the disposer; or
- (b) if the disposer's entitlement arose because of one or more previous applications of this subsection—the first person:
  - (i) who was entitled under subsection (1) (applying of its own force) to do an act without infringing the patent; and
  - (ii) to whom the disposer's entitlement is directly or indirectly attributable.

*Definition*

(5) In this section:

*exploit* includes:

- (a) in relation to a product:
  - (i) make, hire, sell or otherwise dispose of the product; and
  - (ii) offer to make, hire, sell or otherwise dispose of the product; and
  - (iii) use or import the product; and
  - (iv) keep the product for the purpose of doing an act described in subparagraph (i), (ii) or (iii); and
- (b) in relation to a method or process:
  - (i) use the method or process; and
  - (ii) do an act described in subparagraph (a)(i), (ii), (iii) or (iv) with a product resulting from the use of the method or process.

**119A Infringement exemptions: acts for obtaining regulatory approval of pharmaceuticals**

- (1) The rights of a patentee of a pharmaceutical patent are not infringed by a person exploiting an invention claimed in the patent if the exploitation is solely for:
  - (a) purposes connected with obtaining the inclusion in the Australian Register of Therapeutic Goods of goods that:
    - (i) are intended for therapeutic use; and
    - (ii) are not medical devices, or therapeutic devices, as defined in the *Therapeutic Goods Act 1989*; or

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- (b) purposes connected with obtaining similar regulatory approval under a law of a foreign country or of a part of a foreign country.
- (2) Subsection (1) does not apply to the export from Australia of goods for purposes described in paragraph (1)(b) unless the term of the patent has been extended under Part 3 of Chapter 6 and the goods consist of or contain:
- (a) a pharmaceutical substance *per se* that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification; or
  - (b) a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology, that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification.

Note: Part 3 of Chapter 6 provides for the extension of the term of standard patents claiming pharmaceutical substances.

- (3) In this section:

***pharmaceutical patent*** means a patent claiming:

- (a) a pharmaceutical substance; or
- (b) a method, use or product relating to a pharmaceutical substance, including any of the following:
  - (i) a method for producing a raw material needed to produce the substance;
  - (ii) a product that is a raw material needed to produce the substance;
  - (iii) a product that is a pro-drug, metabolite or derivative of the substance.

## 120 Infringement proceedings

- (1) Subject to subsection (1A), infringement proceedings may be started in a prescribed court, or in another court having jurisdiction to hear and determine the matter, by the patentee or an exclusive licensee.
- (1A) Infringement proceedings in respect of an innovation patent cannot be started unless the patent has been certified.

- (2) If an exclusive licensee starts infringement proceedings, the patentee must be joined as a defendant unless joined as a plaintiff.
- (3) A patentee joined as a defendant is not liable for costs unless the patentee enters an appearance and takes part in the proceedings.
- (4) Infringement proceedings must be started within:
  - (a) 3 years from the day on which the relevant patent is granted;  
or
  - (b) 6 years from the day on which the infringing act was done;  
whichever period ends later.

### **121 Counter-claim for revocation of patent**

- (1) A defendant in infringement proceedings may apply by way of counter-claim in the proceedings for the revocation of the patent.
- (2) The provisions of this Act relating to proceedings for the revocation of a patent apply, with the necessary changes, to a counter-claim.

### **121A Burden of proof—infringement of patent for a process**

- (1) This section applies only to a patent for a process for obtaining a product.
- (2) If, in proceedings for infringement of a patent started by the patentee or the exclusive licensee:
  - (a) the defendant alleges that he or she has used a process different from the patented process to obtain a product (*defendant's product*) identical to the product obtained by the patented process; and
  - (b) the court is satisfied that:
    - (i) it is very likely that the defendant's product was made by the patented process; and
    - (ii) the patentee or exclusive licensee has taken reasonable steps to find out the process actually used by the defendant but has not been able to do so;then, in the absence of proof to the contrary the onus for which is on the defendant, the defendant's product is to be taken to have been obtained by the patented process.

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- (3) In deciding how the defendant is to adduce evidence for the purposes of subsection (2), the court is to take into account the defendant's legitimate interests in having business and manufacturing secrets protected.

**122 Relief for infringement of patent**

- (1) The relief which a court may grant for infringement of a patent includes an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.
- (1A) A court may include an additional amount in an assessment of damages for an infringement of a patent, if the court considers it appropriate to do so having regard to:
  - (a) the flagrancy of the infringement; and
  - (b) the need to deter similar infringements of patents; and
  - (c) the conduct of the party that infringed the patent that occurred:
    - (i) after the act constituting the infringement; or
    - (ii) after that party was informed that it had allegedly infringed the patent; and
  - (d) any benefit shown to have accrued to that party because of the infringement; and
  - (e) all other relevant matters.
- (2) On the application of either party, the court may make such order for the inspection of any thing in or on any vehicle, vessel, aircraft or premises, and may impose such terms and give such directions about the inspection, as the court thinks fit.

**123 Innocent infringement**

- (1) A court may refuse to award damages, or to make an order for an account of profits, in respect of an infringement of a patent if the defendant satisfies the court that, at the date of the infringement, the defendant was not aware, and had no reason to believe, that a patent for the invention existed.



- (2) If patented products, marked so as to indicate that they are patented in Australia, were sold or used in the patent area to a substantial extent before the date of the infringement, the defendant is to be taken to have been aware of the existence of the patent unless the contrary is established.
- (3) Nothing in this section affects a court's power to grant relief by way of an injunction.

## Part 2—Non-infringement declarations

### 124 Interpretation

In this Part:

*patentee* includes an exclusive licensee.

### 125 Application for non-infringement declaration

- (1) A person who wishes to exploit an invention may apply to a prescribed court for a declaration that the exploitation of the invention would not infringe a claim of a particular complete specification.
- (2) An application may be made:
  - (a) at any time after the complete specification has become open to public inspection; and
  - (b) whether or not the nominated person or patentee has made any assertion to the effect that the exploitation of the invention would infringe the claim.
- (3) The nominated person or patentee must be joined as a respondent in the proceedings.

### 126 Proceedings for non-infringement declarations

- (1) A prescribed court must not make a non-infringement declaration unless a patent has been granted in respect of the relevant invention and:
  - (a) the applicant for the declaration:
    - (i) has asked the nominated person or patentee in writing for a written admission that the proposed exploitation would not infringe a claim of the complete specification; and
    - (ii) has given the nominated person or patentee full written particulars of the proposed exploitation; and

- (iii) has undertaken to pay a reasonable sum for the nominated person's or patentee's expenses in obtaining advice about whether the proposed exploitation would infringe the claim; and
  - (b) the nominated person or patentee has refused or failed to make the admission; and
  - (c) if the patent is an innovation patent—the patent has been certified.
- (2) The validity of a claim cannot be questioned in proceedings for a non-infringement declaration.
- (3) The costs of all parties in proceedings for a non-infringement declaration must be paid by the applicant for the declaration unless the court otherwise orders.

### **127 Effect of non-infringement declarations**

If:

- (a) a nominated person or patentee has given a person a written admission that the exploitation of an invention would not infringe a claim, or a prescribed court has made a non-infringement declaration in respect of an invention; and
- (b) the patentee later gets an injunction restraining the person from exploiting the invention as specified in the admission, or the declaration is revoked;

the person is not liable:

- (c) to account to the patentee for any profits, made by the person before the date on which the injunction was granted or the declaration was revoked, from the exploitation of the invention as specified in the admission or declaration; or
- (d) to pay damages for any loss suffered by the patentee before that date as a result of that exploitation.

## **Part 3—Unjustified threats of infringement proceedings**

### **128 Application for relief from unjustified threats**

- (1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with infringement proceedings, or other similar proceedings, a person aggrieved may apply to a prescribed court, or to another court having jurisdiction to hear and determine the application, for:
  - (a) a declaration that the threats are unjustifiable; and
  - (b) an injunction against the continuance of the threats; and
  - (c) the recovery of any damages sustained by the applicant as a result of the threats.
- (2) Subsection (1) applies whether or not the person who made the threats is entitled to, or interested in, the patent or a patent application.

### **129 Court's power to grant relief if threats related to a standard patent or standard patent application**

If an application under section 128 for relief relates to threats made in respect of a standard patent or an application for a standard patent, the court may grant the applicant the relief applied for unless the respondent satisfies the court that the acts about which the threats were made infringed, or would infringe:

- (a) a claim that is not shown by the applicant to be invalid; or
- (b) rights under section 57 in respect of a claim that is not shown by the applicant to be a claim that would be invalid if the patent had been granted.

**129A Threats related to an innovation patent application or innovation patent and court's power to grant relief**

*Certain threats of infringement proceedings are always unjustifiable*

- (1) If:
- (a) a person:
    - (i) has applied for an innovation patent, but the application has not been determined; or
    - (ii) has an innovation patent that has not been certified; and
  - (b) the person, by means of circulars, advertisements or otherwise, threatens a person with infringement proceedings or other similar proceedings in respect of the patent applied for, or the patent, as the case may be;

then, for the purposes of an application for relief under section 128 by the person threatened, the threats are unjustifiable.

*Courts power to grant relief in respect of threats made by the applicant for an innovation patent or the patentee of an uncertified innovation patent*

- (2) If an application under section 128 for relief relates to threats made in respect of an innovation patent that has not been certified or an application for an innovation patent, the court may grant the applicant the relief applied for.

*Courts power to grant relief in respect of threats made by the patentee of a certified innovation patent*

- (3) If an application under section 128 for relief relates to threats made in respect of a certified innovation patent, the court may grant the applicant the relief applied for unless the respondent satisfies the court that the acts about which the threats were made infringed, or would infringe, a claim that is not shown by the applicant to be invalid.

### **130 Counter-claim for infringement**

- (1) The respondent in proceedings under section 128 may apply, by way of counter-claim, for relief to which the respondent would be entitled in separate proceedings for an infringement by the applicant of the patent to which the threats relate.
- (2) Where the respondent applies by way of counter-claim, the applicant may, without making a separate application under Chapter 12, apply in the proceedings for the revocation of the patent.
- (3) The provisions of this Act relating to infringement proceedings apply, with the necessary changes, to a counter-claim.

Note: Infringement proceedings cannot be commenced in respect of an innovation patent unless the patent has first been certified (see subsection 120(1A)).

- (4) The provisions of this Act relating to proceedings under section 138 for the revocation of a patent apply, with the necessary changes, to an application under subsection (2).

Note: Revocation proceedings under section 138 cannot be commenced in respect of an innovation patent unless the patent has first been certified (see subsection 138(1A)).

### **131 Notification of patent not a threat**

The mere notification of the existence of a patent, or an application for a patent, does not constitute a threat of proceedings for the purposes of section 128.

### **132 Liability of legal practitioner or patent attorney**

A legal practitioner or a registered patent attorney is not liable to proceedings under section 128 in respect of an act done in his or her professional capacity on behalf of a client.

## **Chapter 12—Compulsory licences and revocation of patents**

### **133 Compulsory licences**

- (1) Subject to subsection (1A), a person may apply to the Federal Court, after the end of the prescribed period, for an order requiring the patentee to grant the applicant a licence to work the patented invention.
- (1A) A person cannot apply for an order in respect of an innovation patent unless the patent has been certified.
- (2) After hearing the application, the court may, subject to this section, make the order if satisfied that:
  - (a) all the following conditions exist:
    - (i) the applicant has tried for a reasonable period, but without success, to obtain from the patentee an authorisation to work the invention on reasonable terms and conditions;
    - (ii) the reasonable requirements of the public with respect to the patented invention have not been satisfied;
    - (iii) the patentee has given no satisfactory reason for failing to exploit the patent; or
  - (b) the patentee has contravened, or is contravening, Part IV of the *Trade Practices Act 1974* or an application law (as defined in section 150A of that Act) in connection with the patent.
- (3) An order must direct that the licence:
  - (a) is not to give the licensee, or a person authorised by the licensee, the exclusive right to work the patented invention; and
  - (b) is to be assignable only in connection with an enterprise or goodwill in connection with which the licence is used;and may direct that the licence is to be granted on any other terms specified in the order.

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- (3B) If the patented invention cannot be worked by the applicant without his or her infringing another patent:
- (a) the court is to make the order only if the court is further satisfied that the patented invention involves an important technical advance of considerable economic significance on the invention (*other invention*) to which the other patent relates; and
  - (b) the court must further order that the patentee of the other invention:
    - (i) must grant to the applicant a licence to work the other invention insofar as is necessary to work the patented invention; and
    - (ii) is to be granted, if he or she so requires, a cross-licence on reasonable terms to work the patented invention; and
  - (c) the court must direct that the licence granted by the patentee of the other invention may be assigned by the applicant:
    - (i) only if he or she assigns the licence granted in respect of the patented invention; and
    - (ii) only to the assignee of that licence.
- (4) An order operates, without prejudice to any other method of enforcement, as if it were embodied in a deed granting a licence and executed by the patentee and all other necessary parties.
- (5) The patentee is to be paid in respect of a licence granted to the applicant under an order:
- (a) such amount as is agreed between the patentee and the applicant; or
  - (b) if paragraph (a) does not apply—such amount as is determined by the Federal Court to be just and reasonable having regard to the economic value of the licence and the desirability of discouraging contraventions of Part IV of the *Trade Practices Act 1974* or an application law (as defined in section 150A of that Act).
- (6) The patentee or the Federal Court may revoke the licence if:
- (a) the patentee and the licensee are agreed, or the court on application made by either party finds, that the circumstances that justified the grant of the licence have ceased to exist and are unlikely to recur; and



- (b) the legitimate interests of the licensee are not likely to be adversely affected by the revocation.

### **134 Revocation of patent after grant of compulsory licence**

- (1) Where a compulsory licence relating to a patent is granted, an interested person may apply to the Federal Court, after the end of the prescribed period, for an order revoking the patent.
- (2) After hearing the application, the court may make the order if satisfied that:
  - (a) both:
    - (i) the reasonable requirements of the public with respect to the patented invention have not been satisfied; and
    - (ii) the patentee has given no satisfactory reason for failing to exploit the patent; or
  - (b) the patentee is contravening Part IV of the *Trade Practices Act 1974* or an application law (as defined in section 150A of that Act) in connection with the patent.

### **135 Reasonable requirements of the public**

- (1) For the purposes of sections 133 and 134, the reasonable requirements of the public with respect to a patented invention are to be taken not to have been satisfied if:
  - (a) an existing trade or industry in Australia, or the establishment of a new trade or industry in Australia, is unfairly prejudiced, or the demand in Australia for the patented product, or for a product resulting from the patented process, is not reasonably met, because of the patentee's failure:
    - (i) to manufacture the patented product to an adequate extent, and supply it on reasonable terms; or
    - (ii) to manufacture, to an adequate extent, a part of the patented product that is necessary for the efficient working of the product, and supply the part on reasonable terms; or
  - (iii) to carry on the patented process to a reasonable extent; or
  - (iv) to grant licences on reasonable terms; or

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- (b) a trade or industry in Australia is unfairly prejudiced by the conditions attached by the patentee (whether before or after the commencing day) to the purchase, hire or use of the patented product, the use or working of the patented process; or
  - (c) if the patented invention is not being worked in Australia on a commercial scale, but is capable of being worked in Australia.
- (2) If, where paragraph (1)(c) applies, the court is satisfied that the time that has elapsed since the patent was sealed has, because of the nature of the invention or some other cause, been insufficient to enable the invention to be worked in Australia on a commercial scale, the court may adjourn the hearing of the application for the period that the court thinks sufficient for that purpose.

**136 Orders to be consistent with international agreements**

An order must not be made under section 133 or 134 that is inconsistent with a treaty between the Commonwealth and a foreign country.

**136A Dealing with allegation of contravention of application law**

Proceedings under section 133 or 134 involving an allegation of contravention of an application law that is a law of a State must be dealt with as if the law were a law of the Commonwealth.

Note: Those proceedings are in the Federal Court, which can only exercise the judicial power of the Commonwealth. This section lets the court deal comprehensively with the proceedings without the need for a court of the State to determine whether the application law has been contravened.

**137 Revocation on surrender of patent**

- (1) A patentee may, at any time, by written notice to the Commissioner, offer to surrender the patent.
- (2) The Commissioner must give notice of an offer in accordance with the regulations.
- (3) After hearing all interested persons who notify the Commissioner in accordance with the regulations of their wish to be heard, the Commissioner may accept the offer and revoke the patent.

- (4) Where relevant proceedings in relation to a patent are pending, the Commissioner must not accept an offer to surrender the patent without either the leave of the court or the consent of the parties to the proceedings.
- (5) Where a compulsory licence is in force in relation to a patent, the Commissioner must not accept an offer to surrender the patent.

### **138 Revocation of patents in other circumstances**

- (1) Subject to subsection (1A), the Minister or any other person may apply to a prescribed court for an order revoking a patent.
- (1A) A person cannot apply for an order in respect of an innovation patent unless the patent has been certified.
- (2) At the hearing of the application, the respondent is entitled to begin and give evidence in support of the patent and, if the applicant gives evidence disputing the validity of the patent, the respondent is entitled to reply.
- (3) After hearing the application, the court may, by order, revoke the patent, either wholly or so far as it relates to a claim, on one or more of the following grounds, but on no other ground:
  - (a) that the patentee is not entitled to the patent;
  - (b) that the invention is not a patentable invention;
  - (d) that the patent was obtained by fraud, false suggestion or misrepresentation;
  - (e) that an amendment of the patent request or the complete specification was made or obtained by fraud, false suggestion or misrepresentation;
  - (f) that the specification does not comply with subsection 40(2) or (3).

### **139 Parties to proceedings**

- (1) The patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, are parties to any proceedings under section 133, 134 or 138.

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- (2) In any proceedings under section 133, 134 or 138:
- (a) the applicant must serve a copy of the application on the Commissioner; and
  - (b) the Commissioner may appear and be heard in the proceedings.

**140 Commissioner to be given copies of orders**

An office copy of an order made under this Chapter must be served on the Commissioner by the Registrar or other appropriate officer of the court that made the order.

## **Chapter 13—Withdrawal and lapsing of applications and ceasing of patents**

### **141 Withdrawal of applications** [*see also* Table B]

- (1) 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.

### **142 Lapsing of applications** [*see also* Table B]

- (1) A provisional application for a patent lapses at the end of the period prescribed for the purpose of section 38 or, if that period is extended, at the end of the period as so extended.
- (2) A complete application for a standard patent lapses if:
  - (a) the applicant does not ask for an examination of the patent request and complete specification within the relevant period prescribed for the purposes of subsection 44(1), (2) or (3), as the case requires; or
  - (c) the examination of the patent request and complete specification has been deferred under section 46 and the applicant does not ask for an examination within the period prescribed for the purposes of this paragraph; or
  - (d) the applicant does not pay a continuation fee for the application within the period prescribed for the purposes of this paragraph; or
  - (e) the patent request and complete specification are not accepted within the period prescribed for the purposes of this paragraph.

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- (3) A complete application for a standard patent lapses if the applicant does not comply with a direction of the Commissioner under section 107 within the time allowed by the Commissioner under that section.

**143 Ceasing of patents**

A standard patent ceases if the patentee:

- (a) does not pay a renewal fee for the patent within the prescribed period; or
- (b) does not file the prescribed documents (if any) within the prescribed period.

**143A Ceasing of innovation patents**

An innovation patent ceases if:

- (a) the fee for filing the request and accompanying specification relating to an application for an innovation patent is not paid in accordance with the regulations; or
- (b) after an examination of the patent has been requested under paragraph 101A(b), the patentee does not pay the prescribed fee for the examination within the prescribed period; or
- (c) the Commissioner does not make decisions under paragraphs 101E(a) and (aa) within the period prescribed for the purposes of this paragraph; or
- (d) the patentee does not pay a renewal fee for the patent within the prescribed period; or
- (e) the patentee does not comply with a direction of the Commissioner under section 106 within the time allowed by the Commissioner under that section.

**143B Payment of fees**

To avoid doubt, a reference in this Chapter to the payment of a continuation fee or renewal fee by the applicant or patentee is taken to include a reference to the payment of that fee by a person other than the applicant or patentee.

## Chapter 14—Contracts

### 144 Void conditions

- (1) A condition in a contract relating to the sale or lease of, or a licence to exploit, a patented invention is void if the effect of the condition would be:
  - (a) to prohibit or restrict the buyer, lessee or licensee from using a product or process (whether patented or not) supplied or owned by a person other than the seller, lessor or licensor, or a nominee of the seller, lessor or licensor; or
  - (b) to require the buyer, lessee or licensee to acquire a product not protected by the patent from the seller, lessor or licensor, or a nominee of the seller, lessor or licensor.
- (1A) A condition in a contract relating to the sale or lease of, or a licence to exploit, an invention the subject of an innovation patent is void if the effect of the condition would be to:
  - (a) prohibit the buyer, lessee or licensee from applying for examination of the patent; or
  - (b) impose restrictions on the circumstances in which the buyer, lessee or licensee may apply for examination of the patent.
- (2) Subsection (1) does not apply if:
  - (a) the seller, lessor or licensor proves that, at the time the contract was made, the buyer, lessee or licensee had the option of buying the product, or obtaining a lease or licence, on reasonable terms without the condition; and
  - (b) the contract entitles the buyer, lessee or licensee to be relieved of the liability to comply with the condition on giving the other party 3 months' notice in writing and paying, in compensation for the relief:
    - (i) in the case of a sale—such sum as is fixed by an arbitrator appointed by the Minister; or
    - (ii) in the case of a lease or licence—such rent or royalty as is so fixed for the rest of the term of the contract.

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- (3) A person is not stopped from applying for or obtaining relief in any proceedings under this Act merely because of an admission made by the person about the reasonableness of terms offered to the person as mentioned in paragraph (2)(a).
- (4) It is a defence to proceedings for infringement of a patent that the patented invention is, or was when the proceedings were started, the subject of a contract containing a provision, inserted by the patentee, that is void under this section.
- (5) If the patentee offers the other parties to a contract mentioned in subsection (4) a new contract that does not contain the void condition but that otherwise gives the parties the same rights as the existing contract, then, whether or not the other parties accept the new contract in place of the existing contract, subsection (4) ceases to apply, but the patentee is not entitled to damages or an account of profit for an infringement of the patent committed before the offer of the new contract.

**145 Termination of contract after patent ceases to be in force**

- (1) A contract relating to the lease of, or a licence to exploit, a patented invention may be terminated by either party, on giving 3 months' notice in writing to the other party, at any time after the patent, or all the patents, by which the invention was protected at the time the contract was made, have ceased to be in force.
- (2) Subsection (1) applies despite anything to the contrary in that contract or in any other contract.

**146 Effect of Chapter**

Nothing in this Chapter:

- (a) affects a condition in a contract that prohibits a person from selling products other than those of a particular person; or
- (b) validates a contract that would otherwise be invalid; or
- (c) affects a right to terminate a contract, or to terminate a condition of a contract, being a condition exercisable independently of this section; or



- (d) affects a condition in a contract for the lease of, or a licence to exploit, a patented product, that reserves to the lessor or licensor the right to supply new parts of the patented product that are required to put or keep it in repair.

## Chapter 15—Special provisions relating to associated technology

### 147 Certificate by Director as to associated technology

- (1) Where the Commissioner considers that a specification in respect of an application may contain information of a kind referred to in the definition of *associated technology* in subsection 4(1) of the Safeguards Act, the Commissioner must give the Director written notice to that effect together with a copy of the patent request and specification.
- (2) On receiving a notice, the Director may, if satisfied that the specification contains information of that kind, issue a certificate to that effect.
- (3) Where the Director is satisfied that:
  - (a) the possession by the applicant or the nominated person of the associated technology containing the information was not in accordance with a permit; or
  - (b) the communication of the information involved in making the application was not in accordance with an authority;the Director may include in the certificate:
  - (c) if the application is not a relevant international application—a direction that the application should lapse; or
  - (d) if the application is a relevant international application—a direction that the application should not be treated as an international application.
- (4) Where the Director issues a certificate, the Director must give a copy of it to the Commissioner who must give a copy to the applicant.

### 148 Lapsing etc. of applications

- (1) Where:
  - (a) the Commissioner receives a copy of a certificate under subsection 147(2) in relation to an application; and

- (b) the certificate includes a direction under subsection 147(3); then, upon receipt by the Commissioner of that copy:
  - (c) if the application is not a relevant international application—the application lapses; or
  - (d) if the application is a relevant international application—the application must cease to be treated as an international application.
- (2) Where an application has lapsed under this section, the Commissioner must publish a notice to that effect in the *Official Journal*.

### **149 Revocation of direction**

Where under section 148 an application has lapsed, or has ceased to be treated as an international application, because of a direction by the Director under section 147, the applicant may apply in writing to the Director for the revocation of the direction and the Director may revoke the direction.

### **150 Restoration of lapsed application**

- (1) Where an application has lapsed under section 148, the applicant may, in writing, ask the Commissioner to restore it.
- (2) On receiving a request, the Commissioner must restore the application if satisfied that:
- (a) the relevant direction of the Director is no longer in force; and
  - (b) there is no other reason not to do so.
- (3) Where the Commissioner restores an application, the Commissioner must publish a notice to that effect in the *Official Journal*.
- (4) Where an application is restored under this section, such provisions as are prescribed have effect for the protection or compensation of persons who exploited (or took definite steps by contract or otherwise to exploit) the relevant invention after the lapse of the application and before the day on which its restoration was notified in the *Official Journal*.

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- (5) Proceedings cannot be started under section 57 in respect of anything done during the period from and including the day on which the application lapsed to and including the day on which its restoration was notified in the *Official Journal*.

**151 Reinstatement of application as an international application**

- (1) Where a relevant international application has ceased to be treated as an international application under section 148, the applicant may ask the Commissioner in writing to reinstate it.
- (2) On receiving a request, the Commissioner must reinstate the application as an international application if satisfied that:
  - (a) the relevant direction of the Director is no longer in force; and
  - (b) there is no other reason not to do so.
- (3) Where the Commissioner reinstates an application as an international application, the application must be treated as an international application.
- (4) Where:
  - (a) the relevant international application specifies Australia as a designated State; and
  - (b) the Commissioner cannot reinstate the application merely because, under the PCT, it is to be considered as having been withdrawn; and
  - (c) the applicant files, within the prescribed period, a written request signed by the applicant that the application be treated as an application under this Act for a standard patent; and
  - (d) the applicant files any prescribed documents and pays the prescribed fee;then, except as otherwise prescribed:
  - (e) the application must be treated as requested; and
  - (f) the description, claims and drawings in the application must be treated as a complete specification filed in respect of the application; and
  - (g) the application and complete specification must be treated as having been filed on the date on which the relevant international application was filed.

**152 Notice of prohibitions or restrictions on publication**

- (1) Where the Director issues a certificate under section 147 in relation to an application, the Director may give written notice to the Commissioner of any prohibitions or restrictions on the publication or communication of the information in the specification, or in a relevant abstract, that the Director considers appropriate.
- (2) On receiving a notice, the Commissioner must take such steps as are necessary or expedient to give effect to it.
- (3) Without limiting the generality of subsection (2), the Commissioner may, by written order, prohibit or restrict the publication or communication of information about the subject-matter of the application, whether generally or in relation to a particular person or class of persons.
- (4) A person must not, except in accordance with the written consent of the Commissioner, publish or communicate information in contravention of an order.

Penalty: Imprisonment for 2 years.

**153 Effect of order**

- (1) Where an order is in force in relation to an application for a standard patent, the application may proceed up to the acceptance of the patent request and complete specification, but the complete specification must not be made open to public inspection, the acceptance must not be notified in the *Official Journal* and a patent must not be granted on the application.
- (2) While an order is in force in relation to an application for an innovation patent, the application may proceed up to the acceptance of the patent request and complete specification but a patent must not be granted on the application.
- (3) Where an order in relation to an application for a standard patent has been revoked after the acceptance of the patent request and complete specification, the acceptance must be notified in the *Official Journal* within the prescribed period.

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- (4) Nothing in this Act prevents disclosing information about an invention to the Director for the purpose of obtaining advice on whether an order should be made, amended or revoked.

## **Chapter 16—Jurisdiction and powers of courts**

### **154 Jurisdiction of Federal Court**

- (1) The Federal Court has jurisdiction with respect to matters arising under this Act.
- (2) The jurisdiction of the Federal Court to hear and determine appeals against decisions or directions of the Commissioner is exclusive of the jurisdiction of any other court except the jurisdiction of the High Court under section 75 of the Constitution.
- (3) A prosecution for an offence against this Act must not be started in the Federal Court.

### **155 Jurisdiction of other prescribed courts**

- (1) Each prescribed court (other than the Federal Court) has jurisdiction with respect to matters arising under this Act in respect of which proceedings may, under this Act, be started in a prescribed court.
- (2) The jurisdiction conferred by subsection (1) on the Supreme Court of a Territory is conferred:
  - (a) in the case of proceedings for the infringement of a patent or proceedings under subsection 125(1) or section 128, or a matter arising under this Act that may be heard and determined in the course of such proceedings—to the extent that the Constitution permits; and
  - (b) in any other case—only in relation to proceedings instituted by a natural person who is resident in the Territory, or a corporation that has its principal place of business in the Territory, at the time the proceedings are started.

### **156 Exercise of jurisdiction**

The jurisdiction of a prescribed court under section 154 or 155 is to be exercised by a single judge.

### **157 Transfer of proceedings**

- (1) A prescribed court in which proceedings under this Act have been started may, on the application of a party made at any stage in the proceedings, by order, transfer the proceedings to another prescribed court having jurisdiction to hear and determine the proceedings.
- (2) Where a court transfers proceedings to another court:
  - (a) all documents of record relevant to those proceedings filed in the transferring court shall be sent to the other court by the Registrar or other appropriate officer of the transferring court; and
  - (b) the other court shall proceed as if the proceedings had been started in the other court and as if the same steps in the proceedings had been taken there as had been taken in the transferring court.

### **158 Appeals**

- (1) An appeal lies to the Federal Court against a judgment or order of:
  - (a) another prescribed court exercising jurisdiction under this Act; or
  - (b) any other court in proceedings under subsection 120(1) or section 128.
- (2) Except with the leave of the Federal Court, an appeal does not lie to the Full Court of the Federal Court against a judgment or order of a single judge of the Federal Court in the exercise of its jurisdiction to hear and determine appeals from decisions or directions of the Commissioner.
- (3) With the special leave of the High Court, an appeal lies to the High Court against a judgment or order referred to in subsection (1).
- (4) Except as otherwise provided by this section, an appeal does not lie against a judgment or order referred to in subsection (1).

### **159 Commissioner may appear in appeals**

The Commissioner may appear and be heard at the hearing of an appeal to the Federal Court against a decision or direction of the



Commissioner even if the Commissioner is not a party to the appeal.

**160 Powers of Federal Court**

On hearing an appeal against a decision or direction of the Commissioner, the Federal Court may do any one or more of the following:

- (a) admit further evidence orally, or on affidavit or otherwise;
- (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence before the Commissioner;
- (c) order an issue of fact to be tried as it directs;
- (d) affirm, reverse or vary the Commissioner's decision or direction;
- (e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;
- (f) order a party to pay costs to another party.

## **Chapter 17—The Crown**

### **Part 1—Introductory**

#### **161 Nominated persons and patentees**

A reference in this Chapter to a nominated person or to a patentee includes a reference to the successor in title of the nominated person or patentee or an exclusive licensee of the nominated person or patentee.

#### **162 Commonwealth and State authorities**

A reference in this Chapter to the Commonwealth includes a reference to an authority of the Commonwealth and a reference to a State includes a reference to an authority of a State.

## **Part 2—Exploitation by the Crown**

### **163 Exploitation of inventions by Crown**

- (1) Where, at any time after a patent application has been made, the invention concerned is exploited by the Commonwealth or a State (or by a person authorised in writing by the Commonwealth or a State) for the services of the Commonwealth or the State, the exploitation is not an infringement:
  - (a) if the application is pending—of the nominated person's rights in the invention; or
  - (b) if a patent has been granted for the invention—of the patent.
- (2) A person may be authorised for the purposes of subsection (1):
  - (a) before or after any act for which the authorisation is given has been done; and
  - (b) before or after a patent has been granted for the invention; and
  - (c) even if the person is directly or indirectly authorised by the nominated person or patentee to exploit the invention.
- (3) Subject to section 168, an invention is taken for the purposes of this Part to be exploited for services of the Commonwealth or of a State if the exploitation of the invention is necessary for the proper provision of those services within Australia.

### **164 Nominated person or patentee to be informed of exploitation**

As soon as practicable after an invention has been exploited under subsection 163(1), the relevant authority must inform the applicant and the nominated person, or the patentee, of the exploitation and give him or her any information about the exploitation that he or she from time to time reasonably requires, unless it appears to the relevant authority that it would be contrary to the public interest to do so.

### **165 Remuneration and terms for exploitation**

- (2) The terms for the exploitation of the invention (including terms concerning the remuneration payable to the nominated person or the patentee) are such terms as are agreed, or determined by a method agreed, between the relevant authority and the nominated person or the patentee or, in the absence of agreement, as are determined by a prescribed court on the application of either party.
- (3) For the purposes of subsection (2), the terms, or the method, may be agreed before, during or after the exploitation.
- (4) When fixing the terms, the court may take into account any compensation that a person interested in the invention or the patent has received, directly or indirectly, for the invention from the relevant authority.

### **165A Exploitation of invention to cease under court order**

- (1) A prescribed court may, on the application of the nominated person or the patentee, declare that the exploitation of the invention by the Commonwealth or the State is not, or is no longer, necessary for the proper provision of services of the Commonwealth or of the State if the court is satisfied that, in all the circumstances of the case, it is fair and reasonable to make the declaration.
- (2) The court may further order that the Commonwealth or the State is to cease to exploit the invention:
  - (a) on and from the day specified in the order; and
  - (b) subject to any conditions specified in the order.

In making the order, the court is to ensure that the legitimate interests of the Commonwealth or of the State are not adversely affected by the order.

### **166 Previous agreements inoperative**

An agreement or licence (whether made or given before or after the commencement of this Act) fixing the terms on which a person other than the Commonwealth or a State may exploit an invention is inoperative with respect to the exploitation, after the commencement of this Act, of the invention under subsection 163(1), unless the agreement or licence has been approved:

- (a) if the relevant authority is the Commonwealth—by the Minister; or
- (b) if the relevant authority is a State—by the Attorney-General of the State.

### **167 Sale of products**

- (1) The right to exploit an invention under subsection 163(1) includes the right to sell products made in exercise of that right.
- (2) Where under subsection 163(1) the sale of products is not an infringement of:
  - (a) a patent; or
  - (b) a nominated person's rights in the products;the buyer, and any person claiming through the buyer, is entitled to deal with the products as if the relevant authority were the patentee or the nominated person.

### **168 Supply of products by Commonwealth to foreign countries**

Where the Commonwealth has made an agreement with a foreign country to supply to that country products required for the defence of the country:

- (a) the use of a product or process by the Commonwealth, or by a person authorised in writing by the Commonwealth, for the supply of that product is to be taken, for the purposes of this Chapter, to be use of the product or process by the Commonwealth for the services of the Commonwealth; and
- (b) the Commonwealth or the authorised person may sell those products to the country under the agreement; and
- (c) the Commonwealth or the authorised person may sell to any person any of the products that are not required for the purpose for which they were made.

### **169 Declarations that inventions have been exploited**

- (1) Subject to subsection (4), a patentee who considers that the patented invention has been exploited under subsection 163(1) may apply to a prescribed court for a declaration to that effect.

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- (2) In proceedings under subsection (1):
  - (a) the alleged relevant authority is the defendant; and
  - (b) the alleged relevant authority may apply by way of counter-claim in the proceedings, for the revocation of the patent.
- (3) The provisions of this Act relating to the revocation of patents apply, with the necessary changes, to a counter-claim.
- (4) An application under subsection (1) in respect of an innovation patent cannot be made unless the patent has been certified.

**170 Sale of forfeited articles**

Nothing in this Chapter affects the right of the Commonwealth or a State, or of a person deriving title directly or indirectly from the Commonwealth or a State, to sell or use an article forfeited under a law of the Commonwealth or the State.

## **Part 3—Acquisitions by and assignments to the Crown**

### **171 Acquisition of inventions or patents by Commonwealth**

- (1) The Governor-General may direct that a patent, or an invention that is the subject of a patent application, be acquired by the Commonwealth.
- (2) When a direction is given, all rights in respect of the patent or the invention are, by force of this subsection, transferred to and vested in the Commonwealth.
- (3) Notice of the acquisition must be:
  - (a) given to the applicant and the nominated person, or the patentee; and
  - (b) published in the *Official Journal* and the *Gazette* unless, in the case of the acquisition of an invention that is the subject of an application for a patent, a prohibition order, or an order under section 152, is in force in respect of the application.
- (4) The Commonwealth must pay a compensable person such compensation as is agreed between the Commonwealth and the person or, in the absence of agreement, as is determined by a prescribed court on the application of either of them.

### **172 Assignment of invention to Commonwealth**

- (1) An inventor, or an inventor's successor in title, may assign the invention, and any patent granted or to be granted for the invention, to the Commonwealth.
- (2) The assignment and all covenants and agreements in the assignment are valid and effectual, even if valuable consideration has not been given for the assignment, and may be enforced by proceedings in the name of the Minister.

## Part 4—Prohibition orders

### 173 Prohibition of publication of information about inventions

- (1) Subject to any directions of the Minister, the Commissioner may, if it appears to the Commissioner to be necessary or expedient to do so in the interests of the defence of the Commonwealth, by written order:
  - (a) prohibit or restrict the publication of information about the subject-matter of an application for a patent (including an international application); or
  - (b) prohibit or restrict access to a micro-organism deposited for the purposes of section 41 with a prescribed depository institution situated in Australia.
- (2) A person must not contravene a prohibition order except in accordance with the written consent of the Commissioner.

Penalty: Imprisonment for 2 years.
- (3) A reference in subsection (1) to giving access to a micro-organism includes a reference to giving a sample of the micro-organism.

### 174 Effect of prohibition orders

- (1) While a prohibition order is in force in relation to an application for a standard patent, the application may proceed up to the acceptance of the patent request and complete specification, but the complete specification must not be made open to public inspection, the acceptance must not be notified in the *Official Journal* and a patent must not be granted on the application.
- (2) Where a prohibition order in relation to an application for a standard patent is revoked after the acceptance of the patent request and complete specification, the acceptance must be notified in the *Official Journal* within the prescribed period.
- (3) While a prohibition order is in force in relation to an application for an innovation patent, the application may proceed up to the acceptance of the patent request and complete specification, but a patent must not be granted on the application.



### **175 Disclosure of information to Commonwealth authority**

Nothing in this Act prevents disclosing information about an invention, or giving access to, or a sample of, a micro-organism to a department or authority of the Commonwealth for the purpose of obtaining advice on whether a prohibition order should be made, amended or revoked.

### **176 International applications treated as applications under this Act**

Where:

- (a) an international application specifies Australia as a designated State; and
- (b) as a result of a prohibition order or of anything done in reliance on section 175, the application is, under the PCT, to be considered as having been withdrawn; and
- (c) the applicant files, within the prescribed period, a written request signed by the applicant that the application be treated as an application under this Act for a standard patent; and
- (d) the applicant files any prescribed documents and pays the prescribed fee;

then, except as otherwise prescribed:

- (e) the application must be treated as requested; and
- (f) the description, claims and drawings in the application must be treated as a complete specification filed in respect of the application; and
- (g) the application and specification must be treated as having been filed on the date on which the international application was filed.

## Chapter 18—Miscellaneous offences

### 177 False representations about the Patent Office

- (1) A person must not use, in connection with his or her business, words that would reasonably lead to the belief that his or her office is, or is officially connected with, the Patent Office.

Penalty: \$3,000.

- (2) Without limiting subsection (1), a person who:

- (a) places, or allows to be placed, on the building in which his or her office is situated; or
- (b) uses when advertising his or her office or business; or
- (c) places on a document, as a description of his or her office or business;

the words “Patent Office” or “Office for obtaining patents”, or words of similar import, whether alone or together with other words, is guilty of an offence against that subsection.

### 178 False representations about patents or patented articles

- (1) A person must not falsely represent that he or she, or another person, is the patentee of an invention.

Penalty: \$6,000.

- (1A) A person must not falsely represent that he or she, or another person, is the patentee of an innovation patent that has been certified.

Penalty: 60 penalty units.

- (2) A person must not falsely represent that an article sold by him or her is patented in Australia, or is the subject of an application for a patent in Australia.

Penalty: \$6,000.

- (3) Without limiting subsection (2):
- (a) a person is to be taken to represent that an article is patented in Australia if the word “patent” or “patented”, the words “provisional patent”, or any other word or words implying that a patent for the article has been obtained in Australia, are stamped, engraved or impressed on, or otherwise applied to, the article; and
  - (b) a person is to be taken to represent that an article is the subject of an application for a patent in Australia if the words “patent applied for” or “patent pending”, or any other word or words implying that an application for a patent for the article has been made in Australia, are stamped, engraved or impressed on, or otherwise applied to, the article.
- (4) A prosecution must not be started for an offence against subsection (1) or (2) without the consent of the Minister, or a person authorised by the Minister.

### **179 Failure to comply with summons**

- (1) A person who:
- (a) is summoned by the Commissioner to appear as a witness; and
  - (b) has been offered payment of reasonable expenses;
- must not fail to comply with the summons.

Penalty: \$1,000.

- (2) Subsection (1) does not apply if the person has a lawful excuse.

Note: A defendant bears an evidential burden in relation to the matter in subsection (2), see subsection 13.3(3) of the *Criminal Code*.

### **180 Refusal to give evidence**

- (1) A person who appears before the Commissioner must not refuse:
- (a) to be sworn or to make an affirmation; or
  - (b) to answer questions that the person is lawfully required to answer.

Penalty: \$3,000.

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- (2) Subsection (1) does not apply if the person has a lawful excuse.

Note: A defendant bears an evidential burden in relation to the matter in subsection (2), see subsection 13.3(3) of the *Criminal Code*.

**181 Failure to produce documents or articles**

- (1) A person who:
- (a) is required by the Commissioner to produce a document or article; and
  - (b) has been offered payment of reasonable expenses;
- must not fail to produce it.

Penalty: \$3,000.

- (2) Subsection (1) does not apply if the person has a lawful excuse.

Note: A defendant bears an evidential burden in relation to the matter in subsection (2), see subsection 13.3(3) of the *Criminal Code*.

**182 Officers not to traffic in inventions**

- (1) The Commissioner, a Deputy Commissioner or an employee must not buy, sell, acquire or traffic in:
- (a) an invention or patent, whether granted in Australia or anywhere else; or
  - (b) a right to, or licence under, a patent, whether granted in Australia or anywhere else.

Penalty: \$6,000.

- (2) A purchase, sale, acquisition, assignment or transfer made or entered into in contravention of this section is void.
- (3) This section does not apply to the inventor or to an acquisition by bequest or devolution by law.

**183 Unauthorised disclosure of information by employees etc.**

The Commissioner, each Deputy Commissioner and each employee must not disclose information about a matter that has been or is being dealt with under this Act or the 1952 Act unless required or authorised to do so by this Act, a written direction of the Commissioner or an order of a court.

**184 Other unauthorised disclosures of information**

A person to whom section 71 of the Safeguards Act applies must not disclose information about a matter that has been or is being dealt with under this Act or the 1952 Act unless required or authorised to do so by the Safeguards Act, this Act, a written direction of the Director or an order of a court.

Penalty: Imprisonment for 2 years.

**185 Commissioner etc. not to prepare documents or search records**

The Commissioner, a Deputy Commissioner or an employee must not:

- (a) prepare, or help to prepare:
  - (i) a specification; or
  - (ii) any other document relating to a specification (other than a document which is in an approved form);unless the Commissioner, Deputy Commissioner or the employee is the inventor in respect of the specification; or
- (b) search the records of the Patent Office otherwise than in his or her official capacity.

Penalty: 10 penalty units.

## Chapter 19—The Register and official documents

### 186 Register of Patents

- (1) A Register of Patents is to be kept at the Patent Office. The Register is to contain 2 parts as follows:
  - (a) a part dealing with standard patents; and
  - (b) a part dealing with innovation patents.
- (2) The Register may be kept wholly or partly by use of a computer.
- (3) If the Register is kept wholly or partly by use of a computer:
  - (a) references in this Act to an entry in the Register are to be read as including references to a record of particulars kept by use of the computer and comprising the Register or part of the Register; and
  - (b) references in this Act to particulars being registered, or entered in the Register, are to be read as including references to the keeping of a record of those particulars as part of the Register by use of the computer; and
  - (c) references in this Act to the rectification of the Register are to be read as including references to the rectification of the record of particulars kept by use of the computer and comprising the Register or part of the Register.

### 187 Registration of particulars of patents etc.

- (1) Particulars of standards patents in force, and other prescribed particulars relating to standard patents (if any), must be registered in that part of the Register dealing with standard patents.
- (2) Particulars of innovation patents in force, and other prescribed particulars relating to innovation patents (if any), must be registered in that part of the Register dealing with innovation patents.

**188 Trusts not registrable**

Notice of any kind of trust relating to a patent or licence is not receivable by the Commissioner and must not be registered.

**189 Power of patentee to deal with patent**

- (1) A patentee may, subject only to any rights appearing in the Register to be vested in another person, deal with the patent as the absolute owner of it and give good discharges for any consideration for any such dealing.
- (2) This section does not protect a person who deals with a patentee otherwise than as a purchaser in good faith for value and without notice of any fraud on the part of the patentee.
- (3) Equities in relation to a patent may be enforced against the patentee except to the prejudice of a purchaser in good faith for value.

**190 Inspection of Register**

- (1) The Register must be available for inspection at the Patent Office by any person during the hours that it is open for business.
- (2) If a record of particulars is kept by use of a computer, subsection (1) is to be taken to be complied with, to the extent that the Register consists of those particulars, by giving members of the public access to a computer terminal which they can use to inspect the particulars, either on a screen or in the form of a computer printout.

**191 False entries in Register**

A person must not:

- (a) make a false entry in the Register; or
- (b) cause a false entry to be made in the Register; or
- (c) tender in evidence a document that falsely purports to be a copy of or extract from an entry in the Register.

Penalty: Imprisonment for 2 years.

### **192 Orders for rectification of Register**

- (1) A person aggrieved by:
  - (a) the omission of an entry from the Register; or
  - (b) an entry made in the Register without sufficient cause; or
  - (c) an entry wrongly existing in the Register; or
  - (d) an error or defect in an entry in the Register;may apply to a prescribed court for an order to rectify the Register.
- (2) On hearing an application, the court may:
  - (a) decide any question which it is necessary or expedient to decide in connection with the rectification of the Register; and
  - (b) make any order it thinks fit for the rectification of the Register.
- (3) The Commissioner:
  - (a) must be given notice of an application; and
  - (b) may appear and be heard in the proceedings; and
  - (c) must appear if directed to do so by the court.
- (4) An office copy of an order must be served on the Commissioner by the Registrar or other appropriate officer of the court.
- (5) On receiving an office copy of an order, the Commissioner must rectify the Register accordingly.

### **193 Inspection of documents**

All documents filed in connection with the registration of prescribed particulars under section 187 must be available for inspection at the Patent Office by any person during the hours when it is open for business.

### **194 Information obtainable from Commissioner**

The Commissioner may give any person information about:

- (a) a patent; or
- (b) an application for a patent that is open to public inspection; or
- (c) any prescribed document or matter.



**195 Evidence—the Register**

- (1) The Register is *prima facie* evidence of any particulars registered in it.
- (2) If the Register is wholly or partly kept by use of a computer, a document signed by the Commissioner reproducing in writing all or any of the particulars comprising the Register, or that part of it, is admissible in any proceedings as *prima facie* evidence of those particulars.

**196 Evidence—unregistered particulars**

A document in respect of which particulars have not been entered in the Register is not admissible in any proceedings in proof of the title to a patent or to an interest in a patent unless:

- (a) the court or tribunal before which the proceedings are brought otherwise directs; or
- (b) the proceedings are:
  - (i) for an order under section 192; or
  - (ii) to enforce equities in relation to a patent or licence.

**197 Evidence—certificate and copies of documents**

- (1) A signed certificate to the effect that:
  - (a) anything required or permitted by this Act or the 1952 Act to be done or not to be done had or had not been done on a date specified in the certificate; or
  - (b) a document in the Patent Office or its library was available for public inspection on a date specified in the certificate;is *prima facie* evidence of the matters in the certificate.
- (2) A signed copy of or signed extract from the Register is admissible in any proceedings as if it were the original.
- (3) A signed copy of or signed extract from a document in the Patent Office or its library is admissible in any proceedings as if it were the original.
- (4) In this section:  
*signed* means signed by the Commissioner.

## Chapter 20—Patent Attorneys

### Part 1—Registration, privileges and professional conduct

#### 198 Registration of patent attorneys

- (1) A Register of Patent Attorneys is to be kept by the Designated Manager.

Note: *Designated Manager* is defined by section 200A.

- (2) The Register of Patent Attorneys may be kept wholly or partly by use of a computer.
- (3) If the Register of Patent Attorneys is kept wholly or partly by use of a computer, references in this Act to an entry in the Register of Patent Attorneys are to be read as including references to a record of particulars kept by use of the computer and comprising the Register of Patent Attorneys or part of the Register of Patent Attorneys.
- (4) The Designated Manager must register as a patent attorney a person who:
  - (a) is ordinarily resident in Australia; and
  - (b) holds such qualifications as are specified in, or ascertained in accordance with, the regulations; and
  - (c) has been employed as prescribed for not less than the prescribed period; and
  - (d) is of good fame, integrity and character; and
  - (e) has not been convicted of a prescribed offence during the previous 5 years; and
  - (f) is not under sentence of imprisonment for a prescribed offence.

The registration is to consist of entering the person's name in the Register of Patent Attorneys.

- (5) A qualification specified in, or ascertained in accordance with, regulations made for the purposes of paragraph (4)(b) may consist

of passing an examination conducted by the Professional Standards Board. This subsection does not limit paragraph (4)(b).

- (6) Paragraphs (4)(e) and (f) do not limit paragraph (4)(d).
- (7) For the purposes of this section, a person is taken to be *ordinarily resident* in Australia if:
  - (a) the person has his or her home in Australia; or
  - (b) Australia is the country of his or her permanent abode even though he or she is temporarily absent from Australia;but the person is taken not to be ordinarily resident in Australia if he or she resides in Australia for a special or temporary purpose only.
- (8) A reference in this section to conviction of an offence includes a reference to the making of an order under section 19B of the *Crimes Act 1914*, or a corresponding provision of a law of a State or a Territory, in relation to the offence.

### **199 Deregistration**

The name of a person registered as a patent attorney may be removed from the Register of Patent Attorneys in the prescribed manner and on the prescribed grounds.

### **200 Privileges**

- (1) A registered patent attorney:
  - (a) is entitled to prepare all documents, transact all business and conduct all proceedings for the purposes of this Act; and
  - (b) has such other rights and privileges as are prescribed.
- (2) A communication between a registered patent attorney and the attorney's client in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client.
- (3) Nothing in this section authorises a registered patent attorney to prepare a document to be issued from or filed in a court or to transact business, or conduct proceedings, in a court.

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(4) In this section:

*intellectual property matters* means:

- (a) matters relating to patents; or
- (b) matters relating to trade marks; or
- (c) matters relating to designs; or
- (d) any related matters.

**200A Designated Manager**

For the purposes of this Act, a person is the Designated Manager if the person occupies, or is acting in, a position that:

- (a) is usually occupied by an SES employee; and
- (b) has been declared by the Secretary to the Department, in writing, to be the position of Designated Manager.

## **Part 2—Offences**

### **201 Offences: unregistered persons etc.**

- (1) A person must not carry on business, practise or act as a patent attorney unless the person is a registered patent attorney or a legal practitioner.

Penalty: \$3,000.

- (2) The members of a partnership must not carry on business, practise or act as patent attorneys unless at least one member is a registered patent attorney or a legal practitioner.

Penalty: \$3,000.

- (3) A person must not describe himself or herself, or hold himself or herself out, or permit himself or herself to be described or held out, as a patent attorney, or agent for obtaining patents unless the person is a registered patent attorney.

Penalty: \$3,000.

- (4) The members of a partnership must not describe the partnership, or hold the partnership out, or permit the partnership to be described or held out, as patent attorneys, or agents for obtaining patents, unless at least one member is a registered patent attorney.

Penalty: 30 penalty units.

- (5) A company must not carry on business, practise, act, describe itself or hold itself out, or permit itself to be described or held out, as a patent attorney or agent for obtaining patents.

Penalty: \$15,000.

- (6) It is not an offence against subsection (1), (2) or (5) if the legal representative of a deceased patent attorney:

- (a) carries on the patent attorney's business for not more than 3 years after the patent attorney's death or for any further period allowed by a prescribed court; and

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- (b) is a registered patent attorney, or employs a registered patent attorney to manage the business on his or her behalf.
- (7) For the purposes of this section, a person or company is taken to carry on business, practise or act as a patent attorney if, and only if, the person or company does, or undertakes to do, on behalf of someone else, any of the following in Australia for gain:
  - (a) applying for or obtaining patents in Australia or anywhere else;
  - (b) preparing specifications or other documents for the purposes of this Act or the patent law of another country;
  - (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.
- (8) A person does not commit an offence against subsection (1) in respect of anything done, or undertaken to be done, by the person in the capacity of employee for:
  - (a) in any case—the person’s employer; or
  - (b) if the person’s employer is a member of a related company group—another member of the group.
- (9) A company that is a member of a related company group does not commit an offence against subsection (5) in respect of anything done, or undertaken to be done, by the company for another member of the group.
- (10) In this section:

***related company group*** means a group of 2 or more companies, where each member of the group is related to each other member of the group.
- (11) For the purposes of this section, the question of whether a company is related to another company is to be determined in the same manner as that question is determined under the *Corporations Act 2001*.

## 202 Documents prepared by legal practitioners

A legal practitioner must not prepare a specification, or a document relating to an amendment of a specification, unless:

- (a) the practitioner is acting under the instructions of a registered patent attorney; or

- (b) the amendment has been directed by an order under section 105.

Penalty: \$3,000.

### **202A Documents prepared by a member of a partnership**

A person who is:

- (a) a member of a partnership; and
- (b) not a registered patent attorney;

must not prepare a specification, or a document relating to an amendment of a specification, unless:

- (c) the person is acting under the instructions or supervision of a registered patent attorney; or
- (d) the amendment has been directed by an order under section 105.

Penalty: 30 penalty units.

### **203 Attendance at patent attorney's office**

A registered patent attorney must not practise, act, or hold himself or herself out as practising or acting, as a patent attorney, at an office or place of business where specifications or other documents are prepared for the purposes of this Act, unless he or she, or another registered patent attorney, is in regular attendance at, and in continuous charge of, that office or place.

Penalty: \$3,000.

### **204 Time for starting prosecutions**

Despite section 15B of the *Crimes Act 1914*, a prosecution for an offence against subsection 201(1), (2), (3), (4) or (5), or section 202, 202A or 203, may be started at any time within 5 years after the offence was committed.

## **Chapter 21—Administration**

### **205 Patent Office and sub-offices**

- (1) For the purposes of this Act, there is to be an office called the Patent Office.
- (2) There is to be a sub-office of the Patent Office in each State.

### **206 Patent Office seal**

There is to be a seal of the Patent Office and impressions of the seal must be judicially noticed.

### **207 Commissioner of Patents**

- (1) There is to be a Commissioner of Patents.
- (2) The Commissioner has such powers and functions as are conferred on him or her under this Act or any other Act.

### **208 Deputy Commissioner of Patents**

- (1) There is to be at least one Deputy Commissioner of Patents.
- (2) Subject to any direction by the Commissioner, a Deputy Commissioner has all the powers and functions of the Commissioner under this Act or any other Act, except the Commissioner's powers of delegation under section 209.
- (3) A power or function of the Commissioner under this Act or any other Act, when exercised by a Deputy Commissioner, is to be taken, for the purposes of this Act or any other Act, to have been exercised by the Commissioner.
- (4) The exercise of a power or function of the Commissioner under this Act or any other Act by a Deputy Commissioner does not prevent the exercise of the power or function by the Commissioner.



- (5) Where, under this Act or any other Act, the exercise of a power or function by the Commissioner, or the operation of a provision of this Act or any other Act, is dependent on the opinion, belief or state of mind of the Commissioner in relation to a matter, that power or function may be exercised by a Deputy Commissioner, and that provision may operate, as the case may be, on the opinion, belief or state of mind of the Deputy Commissioner in relation to that matter.

**209 Delegation of Commissioner's powers and functions**

- (1) The Commissioner may, by instrument, signed by him or her, delegate all or any of the Commissioner's powers or functions under this Act or any other Act to a prescribed employee, or a prescribed class of employees.
- (2) A delegate must, if so required by the instrument of delegation, exercise or perform a delegated power or function under the direction or supervision of the Commissioner or an employee specified in the instrument.

**210 Commissioner's powers**

The Commissioner may, for the purposes of this Act:

- (a) summon witnesses; and
- (b) receive written or oral evidence on oath or affirmation; and
- (c) require the production of documents or articles; and
- (d) award costs against a party to proceedings before the Commissioner.

**211 Recovery of costs awarded by Commissioner**

Costs awarded by the Commissioner against a party are recoverable as a debt.

## **Chapter 22—Miscellaneous**

### **212 Copies of examination reports to be communicated**

A copy of each report relating to an examination or a re-examination under this Act must, subject to Chapters 15 and 17, be given to the applicant or patentee, as the case requires.

### **213 Making and signing applications etc.**

An application, notice or request required or permitted under this Act to be made or signed by a person may be made or signed, on behalf of that person, by a registered patent attorney.

### **214 Filing of documents**

A document may be filed with the Patent Office by delivering the document to a sub-office of the Patent Office either personally or by post or by any other prescribed means.

### **215 Death of applicant or nominated person**

- (1) If an applicant dies before a patent is granted on the application, his or her legal representative may proceed with the application.
- (2) If a nominated person dies before a patent is granted on the application, the patent may be granted to his or her legal representative.
- (3) Where, at any time after a patent is granted, the Commissioner is satisfied that the patentee had died (or, in the case of a body corporate, had ceased to exist) before the patent was granted, the Commissioner may amend the patent by substituting for the name of the patentee the name of the person to whom the patent should have been granted.
- (4) An amendment by the Commissioner has effect, and is to be taken always to have had effect, accordingly.

**216 Exercise of discretionary power by Commissioner**

- (1) The Commissioner must not exercise a discretionary power under this Act adversely to any person applying for the exercise of that power without first giving that person a reasonable opportunity to be heard.
- (2) Subsection (1) does not apply in relation to the Commissioner's power to direct an applicant to request an examination.

**217 Assessors**

A prescribed court may, if it thinks fit, call in the aid of an assessor to assist it in the hearing and trial or determination of any proceedings under this Act.

**218 Costs where patent invalid in part**

In any proceedings in which the validity of a patent is disputed, the court may, if it is satisfied that some of the claims in the complete specification which are alleged to be invalid are not invalid but that other claims are invalid, apportion the costs between the parties to the proceedings as it thinks just.

**219 Security for costs**

If a person who neither resides nor carries on business in Australia:

- (a) gives notice of opposition under this Act; or
- (b) appeals to the Federal Court;

the Commissioner or the Federal Court, as the case may be, may require the person to give security for the costs of the proceeding or appeal and, where such security is not given to the satisfaction of the Commissioner or the Federal Court, as the case may be, may dismiss the proceeding or appeal.

**220 Costs of attendance of patent attorney**

Where, at the hearing of proceedings under this Act, a registered patent attorney attends in court for the purpose of assisting a party in the conduct of the hearing and an order is made for payment of the costs of that party, those costs may include an allowance for that attendance.

**221 Service of documents**

Where this Act provides for a document to be served on, or given or sent to, a person and the person has given the Commissioner an address in Australia for service of documents, the document may be served on, or given or sent to, the person by post to that address.

**222 Publication of *Official Journal* etc.**

- (1) The Commissioner shall issue periodically an official journal containing such matters as are prescribed and such other matters (if any) as the Commissioner thinks fit.
- (2) The Commissioner must make arrangements for selling copies of the *Official Journal*, and of complete specifications which are open to public inspection.
- (3) The Commissioner may prepare, publish and sell such documents relating to inventions and patents as the Commissioner thinks fit.

**222A Doing act when Patent Office reopens after end of period otherwise provided for doing act**

- (1) If the last day of a period provided by this Act (except this section) for doing an act is a day when the Patent Office, or a sub-office of the Patent Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.
- (2) For the purposes of this section, the Patent Office, or a sub-office of the Patent Office, is taken not to be open for business on a day:
  - (a) declared by regulations to be a day on which the office or sub-office is not open for business; or
  - (b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office or sub-office is not open for business.

*Declarations*

- (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.

- (4) A declaration mentioned in paragraph (2)(b):
  - (a) may be made before, on or after the day; and
  - (b) is not a legislative instrument.

*Relationship with other law*

- (5) This section has effect despite the rest of this Act.
- (6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

*Exception for prescribed act*

- (7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

**223 Extensions of time** [*see also* Table B]

- (1) The Commissioner must extend the time for doing a relevant act that is required to be done within a certain time if the act is not, or cannot be, done within that time because of an error or omission by:
  - (a) the Commissioner or a Deputy Commissioner; or
  - (b) an employee; or
  - (c) a person providing, or proposing to provide, services for the benefit of the Patent Office.
- (2) Where, because of:
  - (a) an error or omission by the person concerned or by his or her agent or attorney; or
  - (b) circumstances beyond the control of the person concerned;a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Commissioner may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.
- (2A) If:
  - (a) a relevant act that is required to be done within a certain time is not done within that time; and

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- (b) the Commissioner is satisfied that the person concerned took due care, as required in the circumstances, to ensure the doing of the act within that time;

the Commissioner must, on application made by the person concerned in accordance with the regulations and within the prescribed period, extend the time for doing the act.
- (2B) An extension of time under subsection (2A) cannot exceed the period prescribed for the purposes of this subsection.
- (3) The time allowed for doing a relevant act may be extended, whether before or after that time has expired.
- (3A) Despite subsection (3), the time allowed for doing a relevant act may be extended under subsection (2A) only after that time has expired.
- (4) The Commissioner must advertise in the *Official Journal*:
  - (a) an application made for an extension of time for more than 3 months; or
  - (b) an application made for an extension of time for doing a prescribed relevant act in prescribed circumstances.
- (6) Subject to subsection (6A), a person may, as prescribed, oppose the granting under subsection (2) or (2A) of the application.
- (6A) If the Commissioner is satisfied that an application under subsection (2) or (2A) would not be granted even in the absence of opposition under subsection (6):
  - (a) the Commissioner need not advertise the application in accordance with subsection (4); and
  - (b) the application cannot be opposed, despite subsection (6); and
  - (c) the Commissioner must refuse to grant the application.
- (7) Where:
  - (a) a patent application lapses, or a patent ceases, because of a failure to do one or more relevant acts within the time allowed; and
  - (b) the time for doing that act or those acts is extended;

the application or patent must be treated as having been restored.

- (8) Where:
- (a) a provisional patent application lapses under subsection 142(1) at the end of the period prescribed for the purposes of section 38; and
  - (b) that period is extended;
- the application must be treated as if it had not lapsed.
- (9) Where the Commissioner grants:
- (a) an extension of more than 3 months for doing a relevant act; or
  - (b) an extension of time for doing a prescribed relevant act in prescribed circumstances;
- the prescribed provisions have effect for the protection or compensation of persons who, before the day on which the application for extension of time is advertised under subsection (4), exploited (or took definite steps by way of contract or otherwise to exploit) the invention concerned because of the failure to do the relevant act within the time allowed, the lapsing of the patent application or the ceasing of the patent, as the case may be.
- (10) Infringement proceedings cannot be brought in respect of an infringement committed:
- (a) between the day on which the patent application lapses and the day on which it is restored; or
  - (b) between the day on which the patent ceases and the day on which it is restored.
- (11) In this section:
- relevant act* means an action (other than a prescribed action) in relation to a patent, a patent application, or any proceedings under this Act (other than court proceedings), and includes the making of a Convention application within the time allowed for making such applications.

## 224 Review of decisions

- (1) Application may be made to the Administrative Appeals Tribunal for review of:
- (a) a decision of the Commissioner under section 10, 17, 32, 33, 52 or 66, subsection 74(3) or 103(2), section 113, subsection

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137(3), paragraph 142(2)(b), subsection 150(2), 151(2), 152(2) or 152(3), or section 173, 215 or 223; or

- (b) a decision of the Designated Manager under section 198 not to register a person as a patent attorney; or
  - (c) a decision of the Director under subsection 147(2) or (3), section 149 or subsection 152(1).
- (2) Where a person who makes a decision mentioned in subsection (1) gives the person or persons affected by the decision written notice of the making of the decision, the notice must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for review of the decision to which the notice relates by or on behalf of the person or persons whose interests are affected by the decision.
- (3) Failure to comply with subsection (2) in relation to a decision does not affect the validity of the decision.
- (4) In this section:

*decision* has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

**225 Conduct of employees and agents of natural persons**

- (3) Where it is necessary to establish, for the purposes of a prosecution for an offence under this Act, the state of mind of a person other than a company in relation to particular conduct, it is sufficient to show:
- (a) that the conduct was engaged in by a servant or agent of the person within the scope of his or her actual or apparent authority; and
  - (b) that the servant or agent had the state of mind.
- (4) Any conduct engaged in on behalf of a person other than a company by the person's servant or agent within the scope of his or her actual or apparent authority is to be taken, for the purposes of a prosecution for an offence under this Act, to have been engaged in also by the person, unless the person establishes that he or she took reasonable precautions and exercised due diligence to avoid the conduct.



- (5) A reference in this section to an offence under this Act includes a reference to an offence created by:
- (a) section 6 of the *Crimes Act 1914* that relates to this Act or the regulations; or
  - (b) section 11.1, 11.2, 11.2A, 11.4 or 11.5 of the *Criminal Code* that relates to this Act or the regulations.
- (6) Where:
- (a) a person other than a company is convicted of an offence under this Act; and
  - (b) the person would not have been convicted of the offence but for subsections (3) and (4);
- the person is not liable to be punished by imprisonment for that offence.
- (7) A reference in subsection (3) to the state of mind of a person includes a reference to:
- (a) the knowledge, intention, opinion, belief or purpose of the person; and
  - (b) the person's reasons for the intention, opinion, belief or purpose.
- (9) A reference in this section to engaging in conduct includes a reference to failing or refusing to engage in conduct.

Note: For provisions relating to proof of offences by bodies corporate, see Part 2.5 of the *Criminal Code*.

## **226 Reproduction of published specifications does not infringe copyright**

The reproduction in 2 dimensions of the whole or part of a provisional or complete specification that is open to public inspection does not constitute an infringement of any copyright subsisting under the *Copyright Act 1968* in any literary or artistic work.

## **227 Fees**

- (1) The prescribed fees are payable in accordance with the regulations.

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- (2) Without limiting subsection (1), different fees may be prescribed in respect of the doing of an act according to the time when the act is done.
- (3) The regulations may provide for the consequences (for the purposes of this Act) of failing to pay a fee in accordance with the regulations.

Note: Some provisions of this Act provide expressly or implicitly for the consequences of failing to pay a fee (for example, see subsections 89(3) and 142(2), section 143, subsection 151(4) and section 176). Regulations cannot provide for consequences inconsistent with those provisions.
- (4) In particular, the regulations may provide that, for the purposes of this Act:
  - (a) an act is not to be done, or is taken not to have been done, if the fee for doing the act is not paid in accordance with the regulations; or
  - (b) a document is not filed, or is taken not to have been filed, if the fee for filing the document is not paid in accordance with the regulations; or
  - (c) a patent application lapses, or is taken to have lapsed, if the fee for filing the request and accompanying specification is not paid in accordance with the regulations.
- (5) Subsection (4) does not limit subsection (3).

**227A Professional Standards Board for Patent and Trade Marks Attorneys**

- (1) The Professional Standards Board for Patent and Trade Marks Attorneys is established.
- (2) The Professional Standards Board has the following functions:
  - (a) such functions as are conferred on the Professional Standards Board by this Act or the *Trade Marks Act 1995*;
  - (b) such functions as are conferred on the Professional Standards Board by regulations made for the purposes of any of the following provisions:
    - (i) paragraph 198(4)(b) of this Act (which deals with the qualifications of patent attorneys);
    - (ii) section 199 of this Act (which deals with the deregistration of patent attorneys);

- (iii) paragraph 228(2)(r) of this Act (which deals with the professional conduct of patent attorneys);
  - (iv) paragraph 228A(4)(a) of the *Trade Marks Act 1995* (which deals with the qualifications of trade marks attorneys);
  - (v) section 228B of the *Trade Marks Act 1995* (which deals with the deregistration of trade marks attorneys);
  - (vi) paragraph 231(2)(ha) of the *Trade Marks Act 1995* (which deals with the professional conduct of trade marks attorneys);
- (c) to do anything incidental to or conducive to the performance of any of the above functions.
- (3) The regulations may make provision for and in relation to:
- (a) the constitution and membership of the Professional Standards Board; and
  - (b) the manner in which the Professional Standards Board is to perform its functions; and
  - (c) the procedure to be followed at or in relation to meetings of the Professional Standards Board, including (but not limited to) matters with respect to:
    - (i) the convening of meetings of the Board; and
    - (ii) the number of members of the Board who are to constitute a quorum; and
    - (iii) the selection of a member of the Board to preside at a meeting of the Board; and
    - (iv) the manner in which questions arising at a meeting of the Board are to be decided.
- (4) A member of the Professional Standards Board is to be paid such remuneration as is determined by the Remuneration Tribunal. If no determination of that remuneration by the Tribunal is in operation, the member is to be paid such remuneration as is prescribed.
- (5) A member of the Professional Standards Board is to be paid such allowances as are prescribed.
- (6) Subsections (4) and (5) have effect subject to the *Remuneration Tribunal Act 1973*.

## 228 Regulations

- (1) The Governor-General may make regulations, not inconsistent with this Act:
    - (a) prescribing matters required or permitted by this Act to be prescribed; and
    - (b) prescribing matters necessary or convenient to be prescribed for carrying out or giving effect to this Act; and
    - (c) prescribing matters necessary or convenient to be prescribed for the conduct of any business relating to the Patent Office; and
    - (d) for the purpose of carrying out or giving effect to the Budapest Treaty; and
    - (e) for the purpose of carrying out or giving effect to the PCT, whether in relation to PCT applications or otherwise.
  - (2) Without limiting subsection (1), that subsection includes the power to make regulations:
    - (a) making provision for and in relation to the procedures for the examination of a patent request and complete specification and the re-examination of a complete specification; and
    - (b) making provision for and in relation to the reports to be made in relation to an examination and a re-examination; and
    - (c) making provision for and in relation to the amendment of patent requests, provisional and complete specifications, and other filed documents:
      - (i) to correct a clerical error or obvious mistake; or
      - (ii) to remove a lawful ground of objection, whether the objection is raised in the course of examination or re-examination or otherwise; or
      - (iii) for any other purpose; and
    - (e) making provision for and in relation to the amendment of an entry in the Register to correct a clerical error or an obvious mistake, or for any other purpose; and
    - (f) making provision for and in relation to the amendment of a patent to correct a clerical error or an obvious mistake; and
    - (g) making provision for and in relation to the preparation, filing and publication of abstracts of complete specifications; and
    - (h) making provision for and in relation to opposition proceedings; and
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- (ha) setting out the formalities checking process for innovation patents including, in particular, the following matters:
  - (i) specifying the formalities requirements (including compliance with the requirements of subsections 18(2) and (3)) that must be met in respect of an application for an innovation patent; and
  - (ii) empowering the Commissioner to direct an applicant for an innovation patent to do such things as are necessary to ensure that the application is in accordance with the requirements of the regulations relating to the preparation of documents for filing; and
  - (iii) providing for the lapsing of the application if such a direction is not complied with within a time specified in the regulations; and
  - (iv) providing for the restoration of an application that has so lapsed; and
- (j) empowering the Commissioner to direct an applicant for a standard patent to do such things as are necessary to ensure that the complete specification is in accordance with the requirements of the regulations relating to the preparation of documents for filing and:
  - (i) providing for the lapsing of the application if such a direction is not complied with within a time specified in the regulations; and
  - (ii) providing for the restoration of an application that has so lapsed; and
- (k) empowering the Commissioner to hear and determine the question whether a person is an interested person for the purpose of doing any act permitted to be done under this Act by an interested person; and
- (m) providing for appeals against decisions of the Commissioner made under the regulations; and
- (n) making provision for and in relation to the practice and procedure of prescribed courts in proceedings under this Act, including provision prescribing the time within which any proceeding may be started or anything else may be done, and providing for the extension of any such time; and

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- (p) requiring persons to make statutory declarations in relation to patent applications or patents or in proceedings under this Act (not being court proceedings); and
- (q) making provision for and in relation to the making of a declaration, or the doing of an act, under this Act on behalf of a person who, because of infancy or physical or mental disability, is unable to make the declaration or do the act; and
- (r) for the control of the professional conduct of registered patent attorneys and the practice of the profession and, for that purpose, making provision for and in relation to all or any of the following:
  - (i) making complaints, and hearing charges, against registered patent attorneys about their professional conduct;
  - (ii) imposing penalties on registered patent attorneys, including issuing a reprimand and suspending or cancelling registration;
  - (iii) summoning witnesses;
  - (iv) requiring persons to give evidence on oath (whether orally or otherwise);
  - (v) administering oaths to persons giving evidence (whether orally or otherwise);
  - (vi) requiring persons to produce documents or articles; and
- (s) making provision for and in relation to:
  - (i) the deposit for the purposes of this Act, the Budapest Treaty, or both, of micro-organisms with prescribed depositary institutions and the storage and testing of, and furnishing of samples of, micro-organisms by those institutions; and
  - (ii) the charging of fees by prescribed depositary institutions situated in Australia in relation to the matters described in subparagraph (i); and
  - (iii) the making of reports by prescribed depositary institutions situated in Australia in relation to those matters; and
  - (iv) the powers and functions of the Commissioner in relation to prescribed depositary institutions with respect to those matters; and

- (t) modifying the operation of this Act in relation to PCT applications that are treated as patent applications under this Act by excluding, varying, or substituting different provisions for, specified provisions of this Act; and
  - (u) making provision for and in relation to the destruction of documents relating to applications for patents filed not less than 25 years before the time of destruction; and
  - (w) making provision for and in relation to the refund, in specified circumstances, of the whole or part of a fee paid in respect of the filing of a document; and
  - (y) making provision for and in relation to the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a fee; and
  - (z) prescribing penalties for offences against the regulations not exceeding a fine of \$1,000; and
  - (za) making such transitional and savings provisions as are necessary or convenient as a result of the repeal of the 1952 Act and the enactment of this Act.
- (3) The regulations may make provision for matters referred to in paragraph (2)(s) by empowering the Commissioner, on behalf of the Commonwealth, to enter into agreements with prescribed depositary institutions with respect to those matters.
- (4) Regulations made under paragraph (2)(s) and subsection (3) may make different provision with respect to different matters dealt with by or under those regulations, but this subsection shall not be taken to limit a power to make regulations conferred by any other provision of this Act.
- (5) The Governor-General is to make regulations setting out the English texts of the Budapest Treaty and the PCT as in force for Australia on the commencing day, and afterwards such regulations as are necessary to keep those English texts in an up-to-date form.
- (6) The Governor-General may make regulations setting out the English text of a treaty relating to the protection of inventions to which Australia is a party (other than the Budapest Treaty or the PCT), being the English text of the treaty as in force for Australia when the regulations are made, and afterwards such regulations as are necessary to keep that English text in an up-to-date form.
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- (7) Despite the repeal of the 1952 Act by this Act, regulations made under paragraph (2)(za) may provide for the continued operation of specified provisions of the 1952 Act in relation to prescribed persons or matters, or in prescribed circumstances.

**229 Consequential amendments**

The Acts specified in Schedule 2 are amended as set out in that Schedule.

**230 Repeal**

The *Patents Act 1952* is repealed.



## **Chapter 23—Transitional and savings provisions**

### **231 Application of Part III of 1989 Amending Act**

Nothing in this Act affects the continued operation of Part III of the 1989 Amending Act.

### **233 Patents granted under 1952 Act**

- (1) Subject to this Chapter and the regulations, this Act applies in relation to a standard patent or a petty patent granted under the 1952 Act as if the patent had been granted under this Act.
- (2) A patent mentioned in subsection (1) does not have effect in any place in which it did not have effect immediately before the commencing day.
- (3) Chapter 9 of this Act does not apply in relation to a patent mentioned in subsection (1).
- (4) Objection cannot be taken to a patent mentioned in subsection (1), and such a patent is not invalid, so far as the invention is claimed in any claim, on any ground that would not have been available against the patent under the 1952 Act.

### **234 Applications under 1952 Act**

- (1) Where, before the commencing day:
  - (a) a patent application and provisional specification had been lodged under the 1952 Act; and
  - (b) a complete specification had not been lodged under that Act in respect of the application; and
  - (c) the application had not been withdrawn;then, subject to this Chapter and the regulations, this Act applies in relation to the application on and after that day as if it were a provisional application under this Act.

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- (2) Where, before the commencing day:
  - (a) a patent application had been lodged under the 1952 Act; and
  - (b) a complete specification, or a petty patent specification, had been lodged under that Act in respect of the application; and
  - (c) the application had not been withdrawn or finally dealt with;then, subject to this Chapter and the regulations, this Act applies on and after that day:
  - (d) in relation to the application as if it were a complete application made under this Act; and
  - (e) in relation to the petty patent specification as if it were a complete specification filed under this Act in respect of the application.
- (3) Chapter 5 of this Act does not apply in relation to an application mentioned in subsection (2), but Part V of the 1952 Act, as in force immediately before the commencing day, continues to apply in relation to such an application.
- (4) Chapter 9 of this Act does not apply in relation to:
  - (a) an application mentioned in subsection (2); or
  - (b) a patent granted on such an application.
- (5) Objection cannot be taken to:
  - (a) an application mentioned in subsection (2); or
  - (b) a patent granted on such an application;and such a patent is not invalid, so far as the invention is claimed in any claim, on any ground that would not have been available against the application or patent, as the case may be, under the 1952 Act.
- (6) A petty patent specification to which subsection (2) applies cannot be amended under this Act so as to include more than one claim.

**235 Other applications and proceedings under 1952 Act**

- (1) Subject to this Chapter and the regulations, this Act applies, on and after the commencing day, to any application, request, action or proceeding made or started under the 1952 Act and not finally dealt with or determined under that Act before that day as if the application, request, action or proceeding had been made or started under a corresponding provision of this Act.

- (2) Subsection (1) does not apply in relation to an application covered by section 234 of this Act.

**236 Micro-organisms**

Sections 41 and 42 of this Act do not apply in relation to a specification lodged before 7 July 1987.

**237 Orders, directions etc. under 1952 Act**

Any report, order or direction made or given under the 1952 Act and in force immediately before the commencing day continues to have effect on and after that day as if it had been made or given under a corresponding provision of this Act.

**238 The Commissioner and Deputy Commissioner**

The persons holding office as Commissioner of Patents and Deputy Commissioner of Patents immediately before the commencing day continue to hold those respective offices on and after that day.

**239 The Register of Patents and Register of Patent Attorneys**

- (1) On and after the commencing day, the Register of Patents under the 1952 Act is to be taken to form part of the Register of Patents under this Act.
- (2) On and after the commencing day, the Register of Patent Attorneys under the 1952 Act is to be taken to form part of the Register of Patent Attorneys under this Act.

**240 Registered patent attorneys**

This Act applies, on and after the commencing day, in relation to a person who was, immediately before that day, a registered patent attorney under the 1952 Act as if the person had been registered as a patent attorney under this Act.

## Schedule 1—Dictionary [see also Table B]

### Section 3

In this Act, unless the contrary intention appears:

**application**, in Chapter 15, means a patent application, and includes a relevant international application.

**approved form** means a form approved by the Commissioner for the purposes of the provision in which the expression appears.

**associated technology** has the same meaning as in the Safeguards Act.

**Australia** includes each external Territory.

**Australian continental shelf** means the continental shelf, within the meaning of the *Seas and Submerged Lands Act 1973*, adjacent to the coast of Australia (including the coast of any island forming part of a State or Territory).

**Australian Register of Therapeutic Goods** means the register maintained under section 9A of the *Therapeutic Goods Act 1989*.

**authority**, in Chapter 15, has the same meaning as in the Safeguards Act.

**basic application** means an application for protection in respect of an invention, being an application made in a Convention country.

**Budapest Treaty** means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure signed at Budapest on 28 April 1977, as that treaty is in force for Australia from time to time, together with the Regulations annexed to that treaty, as those Regulations are in force for Australia from time to time.

**certified**, in respect of an innovation patent other than in section 19, means a certificate of examination issued by the Commissioner under paragraph 101E(e) in respect of the patent.

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***claim*** means:

- (a) when used as a noun in relation to a patent—a claim (including a dependent claim) of the specification relating to the complete application on which the patent was granted; and
- (b) when used as a noun otherwise than in relation to a patent—a claim (including a dependent claim) of a complete specification; and
- (c) when used as a verb—to claim in a claim (including a dependent claim) of a complete specification.

***commencing day*** means the day on which this Act commences.

***Commissioner*** means the Commissioner of Patents.

***compensable person*** means:

- (a) in relation to a patent acquired by the Commonwealth—the patentee and any person recorded in the Register as having an interest in the patent; and
- (b) in relation to an invention that is the subject of a patent application and is so acquired—the nominated person in relation to the application.

***complete specification*** means (other than in section 116) a specification filed in respect of a complete patent application or, if the specification has been amended, the complete specification as amended.

***compulsory licence*** means a licence granted under an order made under section 133.

***Convention applicant***, in relation to a basic application, means a person (or a body of persons, whether incorporated or not) who:

- (a) has made the basic application; or
- (b) is the assignee of that applicant; or
- (c) would, on the grant of a patent on that application, be entitled to have the patent assigned to the person; or
- (d) is the legal representative of a person mentioned in paragraph (a), (b) or (c); or
- (e) has the consent of a person mentioned in paragraph (a), (b), (c) or (d) to make a Convention application based on that basic application.

**Convention application** means a patent application made under Part 2 of Chapter 8.

**Convention country** means a foreign country declared by the regulations to be a Convention country for the purposes of this Act.

**deposit requirements** means the requirements specified in paragraphs 6(a) to (d), inclusive.

**depository institution** means a body or institution that receives, accepts and stores micro-organisms and furnishes samples of micro-organisms.

**Deputy Commissioner** means a Deputy Commissioner of Patents.

**Designated Manager** has the meaning given by section 200A.

**Director** means the Director of Safeguards.

**eligible person**, in relation to an invention, means a person to whom a patent for the invention may be granted under section 15.

**employee** means a person, other than the Commissioner or a Deputy Commissioner, who:

- (a) is a person engaged under the *Public Service Act 1999* and is employed in the Patent Office; or
- (b) is not such a person but performs services, in the Patent Office, for or on behalf of the Commonwealth.

**examination** means:

- (a) in relation to a patent request and a complete specification relating to a standard patent—an examination of the request and specification under section 45, or a modified examination of the request and specification under section 48; or
- (b) in relation to an innovation patent—an examination of the complete specification relating to the patent under section 101B.

**exclusive licensee** means a licensee under a licence granted by the patentee and conferring on the licensee, or on the licensee and persons authorised by the licensee, the right to exploit the patented invention throughout the patent area to the exclusion of the patentee and all other persons.

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**exploit**, in relation to an invention, includes:

- (a) where the invention is a product—make, hire, sell or otherwise dispose of the product, offer to make, sell, hire or otherwise dispose of it, use or import it, or keep it for the purpose of doing any of those things; or
- (b) where the invention is a method or process—use the method or process or do any act mentioned in paragraph (a) in respect of a product resulting from such use.

**Federal Court** means the Federal Court of Australia.

**file** means file with the Patent Office.

**foreign aircraft** means an aircraft registered in a prescribed foreign country.

**foreign land vehicle** means a land vehicle owned by a person ordinarily resident in a prescribed foreign country.

**foreign patent office** means an office, organisation or other body that may grant protection in respect of an invention in a foreign country.

**foreign vessel** means a vessel registered in a prescribed foreign country.

**formalities check** means, in respect of an application for an innovation patent, the checking process undertaken under section 52 using the process set out in the regulations.

**infringement proceedings** means proceedings for infringement of a patent.

**innovation patent** means letters patent for an invention granted under section 62.

**interested party**, in relation to a patent application, means the applicant or a joint applicant, or a person who claims to be entitled to the grant of a patent on the application, either alone or jointly with another person.

**international application** has the same meaning as in the PCT.

**international depositary authority** has the same meaning as in the Budapest Treaty.

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***international filing date***, in relation to an international application, means:

- (a) the date given to the international application as its international filing date under Article 11 of the PCT; or
- (b) if that date is revised under Article 14 of the PCT—that international filing date as so revised.

[See also section 10]

***invention*** means any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies, and includes an alleged invention.

***legal practitioner*** means a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory.

***legal representative***, in relation to a deceased person, means a person to whom probate of the will of the deceased person, letters of administration of the estate of the deceased person, or any other similar grant, has been granted, whether in Australia or anywhere else, but does not include such a person who, under the terms of the grant, is not entitled to do an act in relation to which the expression is used.

***licence*** means a licence to exploit, or to authorise the exploitation of, a patented invention.

***main invention*** has the meaning given in section 81.

***modified examination***, in relation to a patent request and complete specification relating to an application for a standard patent, means an examination of the request and specification under section 48.

***nominated person*** means the person identified in a patent request as the person to whom the patent is to be granted.

***non-infringement declaration*** means a declaration mentioned in subsection 125(1).

***Official Journal*** means the official journal mentioned in section 222.

***patent*** means a standard patent or an innovation patent.

***patent application*** means an application for a standard patent or an application for an innovation patent.

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***patent area*** means:

- (a) Australia; and
- (b) the Australian continental shelf; and
- (c) the waters above the Australian continental shelf; and
- (d) the airspace above Australia and the Australian continental shelf.

***patent of addition*** means letters patent for an invention granted under Chapter 7 and includes, for the purposes of section 25, a patent of addition that has become an independent patent under section 83.

***Patent Office*** means the Patent Office established under this Act.

***patent request*** means a request for the grant of a patent to a nominated person.

***patentable invention*** means an invention of the kind mentioned in section 18.

***patented process*** means a process in respect of which a patent has been granted and is in force.

***patented product*** means a product in respect of which a patent has been granted and is in force.

***patentee*** means the person for the time being entered in the Register as the grantee or proprietor of a patent.

***PCT*** means the Patent Cooperation Treaty signed at Washington on 19 June 1970, as that treaty is in force for Australia from time to time, together with the Regulations annexed to that treaty, as those Regulations are in force for Australia from time to time.

***PCT application*** means an international application:

- (a) in which Australia is specified as a designated State under Article 4(1)(ii) of the PCT; and
- (b) which has been given an international filing date.

***permit***, in Chapter 15, has the same meaning as in the Safeguards Act.

**pharmaceutical substance** means a substance (including a mixture or compound of substances) for therapeutic use whose application (or one of whose applications) involves:

- (a) a chemical interaction, or physico-chemical interaction, with a human physiological system; or
- (b) action on an infectious agent, or on a toxin or other poison, in a human body;

but does not include a substance that is solely for use in *in vitro* diagnosis or *in vitro* testing.

**prescribed court** means the Federal Court, the Supreme Court of a State, the Supreme Court of the Australian Capital Territory, the Supreme Court of the Northern Territory or the Supreme Court of Norfolk Island.

**prescribed depositary institution** means:

- (a) an international depositary authority, whether in or outside Australia; or
- (b) any other depositary institution in Australia that is prescribed for the purposes of this paragraph.

**prior art base** means:

- (a) in relation to deciding whether an invention does or does not involve an inventive step or an innovative step:
  - (i) information in a document that is publicly available, whether in or out of the patent area; and
  - (ii) information made publicly available through doing an act, whether in or out of the patent area.
- (b) in relation to deciding whether an invention is or is not novel:
  - (i) information of a kind mentioned in paragraph (a); and
  - (ii) information contained in a published specification filed in respect of a complete application where:
    - (A) if the information is, or were to be, the subject of a claim of the specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and
    - (B) the specification was published after the priority date of the claim under consideration; and

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- (C) the information was contained in the specification on its filing date and when it was published.

[*Note: For the meaning of **document** see section 25 of the Acts Interpretation Act 1901.*]

**prior art information** means:

- (a) for the purposes of subsection 7(1)—information that is part of the prior art base in relation to deciding whether an invention is or is not novel; and
- (b) for the purposes of subsection 7(3)—information that is part of the prior art base in relation to deciding whether an invention does or does not involve an inventive step; and
- (c) for the purposes of subsection 7(5)—information that is part of the prior art base in relation to deciding whether an invention does or does not involve an innovative step.

**Professional Standards Board** means the Professional Standards Board for Patent and Trade Marks Attorneys established by section 227A.

**prohibition order** means an order under section 173.

**provisional specification** means a specification filed in respect of a provisional patent application.

**receiving Office** has the same meaning as in the PCT.

**re-examination** means:

- (a) in relation to a complete specification relating to an application for a standard patent—the re-examination of the complete specification under Chapter 9; and
- (b) in relation to an innovation patent—the re-examination of the innovation patent under Part 2 of Chapter 9A.

**Register** means the Register of Patents mentioned in section 186.

**registered**, in relation to a patent, means entered in the Register of Patents.

**registered patent attorney** means a person registered as a patent attorney under this Act.

**relevant authority** means:

- (a) in relation to the exploitation of an invention by or for the Commonwealth—the Commonwealth; and
- (b) in relation to the exploitation of an invention by or for a State—that State.

**relevant international application**, in Chapter 15, means an international application in relation to which the Patent Office is the receiving Office (even if Australia is not specified in the application as a designated State under Article 4(1)(ii) of the PCT).

**relevant proceedings**, in relation to a patent, means court proceedings:

- (a) for infringement of the patent; or
- (b) for revocation of the patent; or
- (c) in which the validity of the patent, or of a claim, is in dispute.

**rules relating to micro-organisms** means such provisions of the Budapest Treaty, and such provisions made by or under regulations made under section 228, as are applicable.

**Safeguards Act** means the *Nuclear Non-Proliferation (Safeguards) Act 1987*.

**sealed** means sealed with the seal of the Patent Office.

**specification**, in relation to an international application, means the description, claims and drawings contained in the application.

**standard patent** means letters patent for an invention granted under section 61.

**State**, in Chapter 17, includes the Australian Capital Territory, the Northern Territory and Norfolk Island.

**Statute of Monopolies** means the Imperial Act known as The Statute of Monopolies.

**supply** includes:

- (a) supply by way of sale, exchange, lease, hire or hire-purchase; and
- (b) offer to supply (including supply by way of sale, exchange, lease, hire or hire-purchase).

***Territory*** means a Territory in which this Act applies or to which this Act extends.

***therapeutic use*** means use for the purpose of:

- (a) preventing, diagnosing, curing or alleviating a disease, ailment, defect or injury in persons; or
- (b) influencing, inhibiting or modifying a physiological process in persons; or
- (c) testing the susceptibility of persons to a disease or ailment.

***this Act*** includes the regulations.

***work***, in relation to a patented invention, means:

- (a) where the invention is a product—make or import the product; or
- (b) where the invention is a method or process—use the method or process or do any act mentioned in paragraph (a) in respect of a product resulting from such use.

***1952 Act*** means the *Patents Act 1952*.

***1989 Amending Act*** means the *Patents Amendment Act 1989*.

## Schedule 2—Consequential Amendments

Section 229

**Note:**

The amendments made by this Schedule are incorporated in the compilations on ComLaw.

*Companies Act 1981*

[repealed by Act No. 55, 2001, Sch. 1]

*Designs Act 1906*

[repealed by Act No. 147, 2003, s. 150]

*Industry, Technology and Commerce Legislation Amendment Act (No. 2) 1989 (No. 10, 1990)*

*Jurisdiction of Courts (Cross-vesting) Act 1987*

*Nuclear Non-Proliferation (Safeguards) Act 1987*

*Sales Tax Assessment Act (No. 1) 1930*

[repealed by Act No. 101, 2006, Sch. 5]

*Trade Marks Act 1955*

[repealed by Act No. 156, 1994, s. 241]

For access to the wording of the amendments made by this Schedule, see Act No. 83, 1990.

**Table of Acts****Notes to the *Patents Act 1990*****Note 1**

The *Patents Act 1990* as shown in this compilation comprises Act No. 83, 1990 amended as indicated in the Tables below.

For application, saving or transitional provisions made by the *Corporations (Repeals, Consequential and Transitional) Act 2001*, see Act No. 55, 2001.

All relevant information pertaining to application, saving or transitional provisions prior to 27 July 1998 is not included in this compilation. For subsequent information see Table A.

The *Patents Act 1990* was modified by the *Patents Regulations 1991* (1991 No. 71 as amended by 1995 No. 16; 1999 No. 261; 2001 No. 98; 2003 No. 316; 2004 Nos. 193 and 395; SLI 2007 No. 40) see Table B.

**Table of Acts**

Act	Number and year	Date of Assent	Date of commencement	Application, saving or transitional provisions
<i>Patents Act 1990</i>	83, 1990	30 Oct 1990	30 Apr 1991	
<i>Industry, Technology and Commerce Legislation Amendment Act 1991</i>	66, 1991	15 June 1991	S. 26: (a)	—
<i>Industry, Technology and Regional Development Legislation Amendment Act 1994</i>	58, 1994	9 Apr 1994	29 June 1994 (see <i>Gazette</i> 1994, No. S211)	—
<i>Industry, Science and Technology Legislation Amendment Act 1994</i>	108, 1994	12 July 1994	Div. 2 of Part 2 (ss. 4–6): 9 Aug 1994 Div. 5 of Part 2 (ss. 13–15): 13 July 1994 Remainder: Royal Assent	—
<i>Patents (World Trade Organization Amendments) Act 1994</i>	154, 1994	13 Dec 1994	Ss. 4–7 and 12: 1 July 1995 Remainder: 10 Jan 1995	Ss. 3, 7, 8, 10, 12, 13 and 17

**Table of Acts**

Act	Number and year	Date of Assent	Date of commencement	Application, saving or transitional provisions
<i>Intellectual Property Laws Amendment Act 1998</i>	100, 1998	27 July 1998	Schedules 1 and 2: 27 Jan 1999 Remainder: Royal Assent	Sch. 1 (item 8), Sch. 2 (items 31, 32) and Sch. 3 (item 4) [see Table A]
<i>Public Employment (Consequential and Transitional) Amendment Act 1999</i>	146, 1999	11 Nov 1999	Schedule 1 (items 728–730): 5 Dec 1999 (see <i>Gazette</i> 1999, No. S584) (b)	—
<i>Patents Amendment (Innovation Patents) Act 2000</i>	140, 2000	24 Nov 2000	24 May 2001	Sch. 1 (items 1, 2 (1), 2(3)–2(6), 3–6, 8) Sch. 2 [items 2(2), 7] (am. by 99, 2001, Sch. 2 [items 1, 2]) [see Table A]
<b>as amended by</b>				
<i>Trade Marks and Other Legislation Amendment Act 2001</i>	99, 2001	22 Aug 2001	Schedule 2: (c)	—
<i>Intellectual Property Laws Amendment Act 2003</i>	48, 2003	26 June 2003	Schedule 2 (item 8): (d)	—
<i>Corporations (Repeals, Consequential and Transitions) Act 2001</i>	55, 2001	28 June 2001	Ss. 4–14 and Schedule 3 (item 401): 15 July 2001 (see <i>Gazette</i> 2001, No. S285) (e)	Ss. 4–14 [see Note 1]
<i>Industry, Science and Resources Legislation Amendment (Application of Criminal Code) Act 2001</i>	140, 2001	1 Oct 2001	2 Oct 2001	S. 4 [see Table A]
<i>Patents Amendment Act 2001</i>	160, 2001	1 Oct 2001	Schedule 1: 1 Apr 2002 Schedule 2: (f) Remainder: Royal Assent	Sch. 1 (items 13, 32, 33) [see Table A]



**Table of Acts**

Act	Number and year	Date of Assent	Date of commencement	Application, saving or transitional provisions
<i>Intellectual Property Laws Amendment Act 2003</i>	48, 2003	26 June 2003	Schedule 1 (item 2): 24 July 2003 Schedule 2 (items 1–5): 26 Aug 2003	Sch. 2 (item 5) [see Table A]
<i>US Free Trade Agreement Implementation Act 2004</i>	120, 2004	16 Aug 2004	Schedule 8: Royal Assent	Sch. 8 (item 3) [see Table A]
<i>Statute Law Revision Act 2005</i>	100, 2005	6 July 2005	Schedule 1 (items 31–37): (g)	—
<i>Intellectual Property Laws Amendment Act 2006</i>	106, 2006	27 Sept 2006	Schedules 5, 6, 8 and 9: 28 Sept 2006 Schedule 7: 25 Oct 2006 Schedules 10 and 12 (item 4): 27 Mar 2007 Schedule 16 (item 1): 4 Oct 2002 (see s. 2(1))	Sch. 5 (item 2), Sch. 6 (item 2), Sch. 7 (item 4), Sch. 8 (item 9), Sch. 9 (item 2) and Sch. 10 (item 3) [see Table A]
<i>Personal Property Securities (Consequential Amendments) Act 2009</i>	131, 2009	14 Dec 2009	Schedule 2 (items 8–15): [see Note 2 and Table A]	Sch. 2 (item 15) [see Table A]
<i>Crimes Legislation Amendment (Serious and Organised Crime) Act (No. 2) 2010</i>	4, 2010	19 Feb 2010	Schedule 10 (item 22): 20 Feb 2010	—
<i>Statute Law Revision Act 2010</i>	8, 2010	1 Mar 2010	Schedule 1 (item 39): Royal Assent	—
<i>Personal Property Securities (Corporations and Other Amendments) Act 2010</i>	96, 2010	6 July 2010	Schedule 3 (item 16): [see (h) and Note 3]	—

**Act Notes**

- (a) Subsection 2(4) of the *Industry, Technology and Commerce Legislation Amendment Act 1991* provides as follows:
- (4) The amendments of the *Patents Act 1990* are taken to commence, or to have commenced, immediately after the commencement of the *Patents Act 1990*.
- (b) The *Patents Act 1990* was amended by Schedule 1 (items 728–730) only of the *Public Employment (Consequential and Transitional) Amendment Act 1999*, subsections 2(1) and (2) of which provide as follows:
- (1) In this Act, **commencing time** means the time when the *Public Service Act 1999* commences.
- (2) Subject to this section, this Act commences at the commencing time.
- (c) The *Patents Amendment (Innovation Patents) Act 2000* was amended by Schedule 2 only of the *Trade Marks and Other Legislation Amendment Act 2001*, subsection 2(3) of which provides as follows:
- (3) Schedule 2 commences, or is taken to have commenced, immediately after the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.
- The *Patents Amendment (Innovation Patents) Act 2000* came into operation on 24 May 2001.
- (d) Subsection 2(1) (item 5) of the *Intellectual Property Laws Amendment Act 2003* provides as follows:
- (1) Each provision of this Act specified in column 1 of the table commences, or is taken to have commenced, on the day or at the time specified in column 2 of the table.

**Commencement information**

Column 1	Column 2	Column 3
Provision(s)	Commencement	Date/Details
5. Schedule 2, Part 3	Immediately after the time specified in the <i>Patents Amendment (Innovation Patents) Act 2000</i> for the commencement of item 3 of Schedule 1 to that Act	24 May 2001

- (e) The *Patents Act 1990* was amended by Schedule 3 (item 401) only of the *Corporations (Repeals, Consequential and Transitions) Act 2001*, subsection 2(3) of which provides as follows:
- (3) Subject to subsections (4) to (10), Schedule 3 commences, or is taken to have commenced, at the same time as the *Corporations Act 2001*.
- (f) Subsection 2(4) of the *Patents Amendment Act 2001* provides as follows:
- (4) Schedule 2 is taken to have commenced immediately after the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.
- The *Patents Amendment (Innovation Patents) Act 2000* came into operation on 24 May 2001.
- (g) Subsection 2(1) (item 20) of the *Statute Law Revision Act 2005* provides as follows:
- (1) Each provision of this Act specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.

Provision(s)	Commencement	Date/Details
20. Schedule 1, items 31 to 37	Immediately after the commencement of the <i>Patents Amendment (Innovation Patents) Act 2000</i> .	24 May 2001

**Act Notes**

(h) Subsection 2(1) (item 13) of the *Personal Property Securities (Corporations and Other Amendments) Act 2010* provides as follows:

- (1) Each provision of this Act specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.

<b>Provision(s)</b>	<b>Commencement</b>	<b>Date/Details</b>
13. Schedule 3, item 16	Immediately after the commencement of item 14 of Schedule 2 to the <i>Personal Property Securities (Consequential Amendments) Act 2009</i> .	[see Note 3]



**Table of Amendments****Table of Amendments**

ad. = added or inserted   am. = amended   rep. = repealed   rs. = repealed and substituted

Provision affected	How affected
<b>Chapter 1</b>	
S. 3.....	am. Nos. 108 and 154, 1994; No. 100, 1998; No. 140, 2000; No. 48, 2003
S. 4.....	rs. No. 140, 2000
S. 6.....	am. No. 100, 1998
Subheads. to s. 7(1), (2) .....	ad. No. 140, 2000
S. 7.....	am. No. 140, 2000; No. 160, 2001
S. 12A .....	ad. No. 140, 2001
<b>Chapter 2</b>	
<b>Part 3</b>	
<b>Division 1</b>	
Subhead. to s. 18(1).....	ad. No. 140, 2000
S. 18.....	am. No. 140, 2000
<b>Division 2</b>	
S. 24.....	am. No. 140, 2000; No. 8, 2010
<b>Division 3</b>	
S. 28.....	rs. No. 140, 2000
<b>Chapter 3</b>	
<b>Part 1</b>	
<b>Division 1</b>	
Ss. 33, 34 .....	rs. No. 140, 2000
S. 35.....	am. No. 140, 2000
S. 36.....	rs. No. 140, 2000
S. 39.....	rep. No. 140, 2000
<b>Division 2</b>	
S. 40.....	am. No. 140, 2000; No. 106, 2006
<b>Division 3</b>	
S. 43.....	am. No. 140, 2000
<b>Part 2</b>	
Heading to Part 2 .....	rs. No. 140, 2000
of Chapt. 3	
<b>Division 1</b>	
S. 45.....	am. No. 140, 2000; No. 160, 2001; No. 48, 2003
<b>Division 2</b>	
S. 48.....	am. No. 140, 2000; No. 160, 2001

**Table of Amendments**

ad. = added or inserted   am. = amended   rep. = repealed   rs. = repealed and substituted

Provision affected	How affected
<b>Part 3</b>	
<b>Division 1</b>	
Heading to Div. 1 of Part 3..... of Chapt. 3	ad. No. 140, 2000
S. 49.....	am. No. 140, 2000; No. 160, 2001
Ss. 50, 51.....	rs. No. 140, 2000
<b>Division 2</b>	
Heading to Div. 2 of Part 3..... of Chapt. 3	ad. No. 140, 2000
S. 52.....	rs. No. 140, 2000
<b>Chapter 4</b>	
Ss. 54, 55.....	am. No. 140, 2000
S. 56.....	am. No. 66, 1991
S. 57.....	am. No. 140, 2000
<b>Chapter 5</b>	
Heading to Chapt. 5.....	rs. No. 140, 2000
S. 59.....	am. No. 140, 2000; No. 120, 2004
<b>Chapter 6</b>	
<b>Part 1</b>	
S. 61.....	am. No. 160, 2001
S. 62.....	rs. No. 140, 2000
S. 64.....	am. No. 140, 2000
S. 66.....	am. No. 140, 2000
<b>Part 2</b>	
S. 67.....	am. No. 154, 1994
S. 68.....	rs. No. 140, 2000
<b>Part 3</b>	
Heading to Part 3..... of Chapt. 6	rs. No. 140, 2000
Heading to Div. 1 of Part 3..... of Chapt. 6	rep. No. 154, 1994 ad. No. 100, 1998 rep. No. 140, 2000
Div. 1 of Part 3 of Chapt. 6.....	rep. No. 140, 2000
S. 69.....	rep. No. 140, 2000
Heading to Div. 2 of Part 3..... of Chapt. 6	rep. No. 140, 2000
Div. 2 of Part 3 of Chapt. 6.....	rep. No. 154, 1994 ad. No. 100, 1998
S. 70.....	rep. No. 154, 1994 ad. No. 100, 1998 am. No. 100, 2005
Ss. 71–76.....	rep. No. 154, 1994 ad. No. 100, 1998
S. 76A.....	ad. No. 100, 1998

**Table of Amendments**

ad. = added or inserted   am. = amended   rep. = repealed   rs. = repealed and substituted

Provision affected	How affected
S. 77 .....	rep. No. 154, 1994 ad. No. 100, 1998
S. 78 .....	rep. No. 154, 1994 ad. No. 100, 1998 am. No. 106, 2006
S. 79 .....	rep. No. 154, 1994 ad. No. 100, 1998
S. 79A .....	ad. No. 100, 1998 am. No. 100, 2005
<b>Chapter 6A</b>	
Chapt. 6A .....	ad. No. 140, 2000
S. 79B .....	ad. No. 140, 2000
S. 79C .....	ad. No. 140, 2000 am. No. 106, 2006
<b>Chapter 7</b>	
S. 80 .....	rs. No. 140, 2000
S. 83 .....	am. No. 154, 1994 rs. No. 100, 1998 am. No. 100, 2005
S. 84 .....	rep. No. 154, 1994
<b>Chapter 8</b>	
<b>Part 1</b>	
Ss. 88, 89 .....	am. No. 140, 2000
<b>Chapter 9</b>	
Heading to Chapt. 9 .....	rs. No. 140, 2000
S. 96A .....	ad. No. 140, 2000
S. 97 .....	am. No. 66, 1991; No. 160, 2001
S. 98 .....	am. No. 140, 2000; No. 160, 2001
S. 99 .....	am. No. 140, 2000
S. 100 .....	am. No. 66, 1991
S. 100A .....	ad. No. 160, 2001
Heading to s. 101 .....	rs. No. 160, 2001
S. 101 .....	am. No. 66, 1991
<b>Chapter 9A</b>	
Chapt. 9A .....	ad. No. 140, 2000
<b>Part 1</b>	
S. 101A .....	ad. No. 140, 2000
S. 101B .....	ad. No. 140, 2000 am. No. 160, 2001
S. 101C .....	ad. No. 140, 2000
S. 101D .....	ad. No. 140, 2000 rs. No. 160, 2001; No. 48, 2003
S. 101E .....	ad. No. 140, 2000 am. No. 160, 2001
S. 101F .....	ad. No. 140, 2000

**Table of Amendments**

ad. = added or inserted   am. = amended   rep. = repealed   rs. = repealed and substituted

Provision affected	How affected
<b>Part 2</b>	
S. 101G .....	ad. No. 140, 2000 am. No. 160, 2001
S. 101H .....	ad. No. 140, 2000
Ss. 101J–101L .....	ad. No. 140, 2000
<b>Part 3</b>	
Ss. 101M, 101N .....	ad. No. 140, 2000
S. 101P .....	ad. No. 140, 2000
<b>Chapter 10</b>	
<b>Part 1</b>	
Subhead. to s. 102(1).....	ad. No. 140, 2000
S. 102.....	am. No. 140, 2000; No. 160, 2001
<b>Part 2</b>	
S. 104.....	am. No. 120, 2004
S. 106.....	am. No. 140, 2000
Heading to s. 107 .....	am. No. 140, 2000
S. 107.....	am. No. 140, 2000
S. 108.....	rep. No. 140, 2000
S. 109.....	am. No. 140, 2000
<b>Part 3</b>	
S. 111.....	rep. No. 140, 2000
S. 114.....	am. No. 140, 2000
S. 114A .....	ad. No. 140, 2000
<b>Chapter 11</b>	
<b>Part 1</b>	
S. 119 .....	am. No. 160, 2001 rs. No. 106, 2006
S. 119A .....	ad. No. 106, 2006
S. 120.....	am. No. 140, 2000
S. 121A .....	ad. No. 154, 1994
S. 122.....	am. No. 106, 2006
<b>Part 2</b>	
S. 126.....	am. No. 140, 2000
<b>Part 3</b>	
S. 129.....	rs. No. 140, 2000
S. 129A .....	ad. No. 140, 2000
S. 130.....	am. No. 140, 2000
Notes to s. 130(3), (4) .....	ad. No. 140, 2000
<b>Chapter 12</b>	
S. 133.....	am. No. 154, 1994; No. 140, 2000; No. 106, 2006
Heading to s. 134 .....	am. No. 140, 2000
S. 134.....	am. No. 140, 2000; No. 106, 2006



**Table of Amendments**

ad. = added or inserted   am. = amended   rep. = repealed   rs. = repealed and substituted

Provision affected	How affected
S. 136A .....	ad. No. 106, 2006
S. 138.....	am. No. 140, 2000; No. 120, 2004
<b>Chapter 13</b>	
S. 141.....	rs. No. 140, 2000
S. 142.....	am. No. 140, 2000; No. 160, 2001
S. 143A .....	ad. No. 140, 2000 am. No. 160, 2001
S. 143B .....	ad. No. 160, 2001
<b>Chapter 14</b>	
S. 144.....	am. No. 140, 2000
<b>Chapter 15</b>	
S. 151.....	am. No. 140, 2000
S. 153.....	am. No. 140, 2000
<b>Chapter 17</b>	
<b>Part 2</b>	
S. 163.....	am. No. 154, 1994
S. 165.....	am. No. 154, 1994
S. 165A .....	ad. No. 154, 1994
S. 169.....	am. No. 140, 2000
<b>Part 4</b>	
S. 174.....	am. No. 140, 2000
S. 176.....	am. No. 140, 2000
<b>Chapter 18</b>	
S. 178.....	am. No. 140, 2000
Ss. 179–181 .....	am. No. 140, 2001
S. 185.....	rs. No. 100, 1998
<b>Chapter 19</b>	
S. 186.....	am. No. 140, 2000
S. 187.....	rs. No. 140, 2000
S. 191.....	am. No. 140, 2001
<b>Chapter 20</b>	
<b>Part 1</b>	
S. 198.....	rs. No. 100, 1998
S. 200.....	am. No. 100, 1998
S. 200A .....	ad. No. 100, 1998 rs. No. 146, 1999
<b>Part 2</b>	
S. 201.....	am. No. 100, 1998; No. 55, 2001
S. 202A .....	ad. No. 100, 1998
S. 204.....	am. No. 100, 1998; No. 140, 2000
<b>Chapter 21</b>	
Ss. 207–209 .....	am. No. 58, 1994

**Table of Amendments**

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ad. = added or inserted   am. = amended   rep. = repealed   rs. = repealed and substituted

Provision affected	How affected
<b>Chapter 22</b>	
S. 213.....	am. No. 100, 1998
S. 220.....	am. No. 100, 1998
S. 222A .....	ad. No. 106, 2006
S. 223.....	am. No. 66, 1991; No. 154, 1994; No. 140, 2000; No. 160, 2001; No. 48, 2003
S. 224.....	am. No. 100, 1998; No. 140, 2000
Heading to s. 225 .....	rs. No. 140, 2001
S. 225.....	am. No. 140, 2001; No. 4, 2010
Note to s. 225.....	ad. No. 140, 2001
S. 227.....	am. No. 100, 1998; No. 140, 2000
S. 227A .....	ad. No. 100, 1998
S. 228.....	am. No. 140, 2000
<b>Chapter 23</b>	
S. 232.....	rep. No. 154, 1994
S. 233.....	am. No. 66, 1991
<b>Schedule 1</b>	
Schedule 1 .....	am. No. 66, 1991; Nos. 58, 108 and 154, 1994; No. 100, 1998; No. 146, 1999; No. 140, 2000; No. 160, 2001; No. 48, 2003; No. 106, 2006

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**Note 2****Note 2***Personal Property Securities (Consequential Amendments) Act 2009*  
(No. 131, 2009)

The following amendments commence on 1 February 2012 or an earlier time determined by the Minister (*see* section 306 of the *Personal Property Securities Act 2009*):

**Schedule 2****8 Section 3 (list of definitions)**

Insert “PPSA security interest”.

**9 After subsection 189(2)**

Insert:

- (2A) Despite subsection (1), the recording in the Register of a right that is a PPSA security interest does not affect a dealing with a patent.

**10 At the end of section 189**

Add:

- (4) Subsection (3) does not apply in relation to an equity that is a PPSA security interest.

Note: The *Personal Property Securities Act 2009* deals with the rights of purchasers of personal property (including intellectual property such as patents) that is subject to PPSA security interests. That Act also provides for the priority and enforcement of PPSA security interests. See the following provisions of that Act:

- (a) Part 2.5 (taking personal property free of security interests);
- (b) Part 2.6 (priority between security interests);
- (c) Chapter 4 (enforcement of security interests).

**11 At the end of section 195**

Add:

- (3) This section does not apply in relation to any particulars registered in the Register in relation to a PPSA security interest.

Note: Certain particulars relating to registrations in respect of PPSA security interests under the *Personal Property Securities Act 2009* are admissible in evidence: see section 174 of that Act.

## Note 2

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### 12 Section 196

Before “A document”, insert “(1)”.

### 13 At the end of section 196

Add:

- (2) However, subsection (1) does not restrict the admissibility in any proceedings of a document in relation to a PPSA security interest.

Note: Certain particulars relating to registrations in respect of PPSA security interests under the *Personal Property Securities Act 2009* are admissible in evidence: see section 174 of that Act.

### 14 Schedule 1 (Dictionary)

Insert:

***PPSA security interest*** (short for Personal Property Securities Act security interest) means:

- (a) a security interest within the meaning of the *Personal Property Securities Act 2009* and to which that Act applies (other than a transitional security interest within the meaning of that Act); or
- (b) a transitional security interest within the meaning of that Act, and to which Division 4 of Part 9.4 of that Act applies.

Note 1: The *Personal Property Securities Act 2009* applies to certain security interests in personal property. See the following provisions of that Act:

- (a) section 8 (interests to which the Act does not apply);
- (b) section 12 (meaning of ***security interest***);
- (c) Chapter 9 (transitional provisions).

Note 2: For the meaning of ***transitional security interest***, see section 308 of the *Personal Property Securities Act 2009*. Division 4 of Part 9.4 of that Act applies to transitional security interests in situations including the bankruptcy or insolvency of a secured party, grantor or debtor.

As at 8 July 2010 the amendments are not incorporated in this compilation.

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**Note 3****Note 3**

*Personal Property Securities (Corporations and Other Amendments) Act 2010*  
(No. 96, 2010)

The following amendment commences immediately after the commencement of item 14 of Schedule 2 to the *Personal Property Securities (Consequential Amendments) Act 2009*:

**Schedule 3****16 Schedule 1 (Dictionary) (definition of *PPSA security interest*)**

Repeal the definition, substitute:

***PPSA security interest*** (short for Personal Property Securities Act security interest) means a security interest within the meaning of the *Personal Property Securities Act 2009* and to which that Act applies, other than a transitional security interest within the meaning of that Act.

Note 1: The *Personal Property Securities Act 2009* applies to certain security interests in personal property. See the following provisions of that Act:

- (a) section 8 (interests to which the Act does not apply);
- (b) section 12 (meaning of ***security interest***);
- (c) Chapter 9 (transitional provisions).

Note 2: For the meaning of ***transitional security interest***, see section 308 of the *Personal Property Securities Act 2009*.

Note: This amendment replaces the definition inserted by item 14 of Schedule 2 to the *Personal Property Securities (Consequential Amendments) Act 2009*.

As at 8 July 2010 the amendment is not incorporated in this compilation.

**Table A**

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**Table A**

**Application, saving or transitional provisions**

*Intellectual Property Laws Amendment Act 1998* (No. 100, 1998)

**Schedule 1**

**8 Application of amendments**

The amendments made by this Schedule apply to:

- (a) standard patents granted on or after the commencement of this item; and
- (b) standard patents granted before the commencement of this item (other than a standard patent granted for a term of 16 years and whose term at the time of the grant was due to end before 1 July 1995).

**Schedule 2**

**31 Transitional—Register of Patent Attorneys**

After the commencement of this item, the Register of Patent Attorneys kept under section 198 of the *Patents Act 1990* (as in force immediately before that commencement) is taken to form part of the Register of Patent Attorneys kept under section 198 of that Act as amended by this Schedule.

**32 Transitional—registered patent attorneys**

- (1) This item applies to a person who was, immediately before the commencement of this item, a registered patent attorney within the meaning of the *Patents Act 1990*.
- (2) The *Patents Act 1990* has effect, after the commencement of this item, in relation to the person, as if the person had been registered as a patent attorney under section 198 of the *Patents Act 1990* as amended by this Schedule.

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**Table A****Schedule 3****4 Application**

Section 227 of the *Patents Act 1990* as amended by item 3 of this Schedule applies only in relation to a fee payable under that Act in respect of the doing of an act or the filing of a document that is to occur on or after the commencement of that item.

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*Patents Amendment (Innovation Patents) Act 2000* (No. 140, 2000)

**Schedule 2****1 Definitions**

In this Schedule:

*commencement day* means the day this Act commences.

*new law* means the *Patents Act 1990* as amended by this Act.

*old law* means the *Patents Act 1990*, and the regulations made under it, in force immediately before this Act commences.

*petty patent* means letters patent for an invention granted under section 62 of the old law.

**2 Saving and application provisions relating to old law**

- (1) Despite the amendments and repeals made by this Act, the old law continues to apply, with the exceptions set out in the following subitems, to:
- (a) petty patents in force immediately before the commencement day; and
  - (b) petty patents the term of which has expired before the commencement day; and
  - (c) applications for petty patents made before the commencement day but not decided upon by the Commissioner before that day; and
  - (d) petty patents granted on or after the commencement day on applications for a patent made before the commencement day.

The old law continues to apply as if those amendments and repeals had not been made.

**Table A**

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*Exception—fees payable in respect of petty patents after the commencement day*

- (2) The amendments made by items 89 and 90 of Schedule 1 are incorporated into the old law in relation to fees payable in respect of petty patents on or after the commencement day.

*Exception—under subsection 33(2) of the old law only innovation patents may be granted*

- (3) Despite subsection 33(2) of the old law providing that the Commissioner may grant a person who applies for a petty patent if the matters listed in paragraphs 33(2)(a), (b) and (c) are satisfied, the Commissioner, on or after the commencement day, may only grant the person an innovation patent.

*Exception—under sections 34, 35 and 36 of the old law only innovation patents or standard patents may be granted*

- (4) Despite section 34, 35 and 36 of the old law providing that the Commissioner may grant a person a patent, the Commissioner, on or after the commencement day, may only grant a person an innovation patent or a standard patent.

Note: Under the old law, *patent* means a standard patent or a petty patent. This subitem overrides that meaning for grants of patent that the Commissioner makes on or after the commencement day.

*Exception—divisional applications made after commencement day*

- (5) Despite subsection 39(1) of the old law providing that a further complete application may be made for a standard patent or a petty patent, on or after the commencement day a further complete application may only be made, as provided for in that subsection, for a standard patent or an innovation patent.
- (6) Despite subsection 39(2) of the old law providing that a patentee of a petty patent may make a further complete application for a petty patent, on or after the commencement day a further complete application may only be made as provided for in that subsection for an innovation patent.



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**Table A****3 Transitional—applications for petty patents made before the commencement day may be converted to innovation patents or standard patents**

- (1) If, before the commencement day:
- (a) a person files a complete application in respect of a petty patent; and
  - (b) a patent has not been accepted in respect of that application;
- then, after that day, the person may convert the application, as provided for under subsection 104(2) of the old law.
- (2) However, despite subsection 104(2) of the old law providing that the application may be for a standard patent or a petty patent, an application may only be made for a standard patent or an innovation patent.

**4 Transitional—Register of Patents**

Despite the continuation of section 186 of the old law by subitem 2(1):

- (a) entries on the Register of Patents immediately before the commencement day relating to petty patents are included, after that day, in the Register in the part dealing with standard patents; and
- (b) after that day, entries relating to petty patents are to be entered in the Register in the part dealing with standard patents.

Note: Section 186 of the new law provides for the Register of Patents to have 2 parts: one dealing with entries relating to standard patents and the other dealing with entries relating to innovation patents.

**5 Continuity of Register of Patents not affected**

To avoid doubt, the continuity of the Register of Patents and the entries on it, are unaffected by the amendments made by this Act.

**6 Other transitional matters relating to innovation patents and petty patents may be provided for in the regulations**

The Governor-General may make regulations, not inconsistent with this Act or the new law, prescribing other transitional matters, apart from transitional matters provided for in this Schedule, that are necessary or convenient for carrying out or giving effect to:

- (a) the introduction of the innovation patent scheme; and

**Table A**

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- (b) the limited continuation of the petty patent scheme as provided for in this Schedule.

**7 Application**

- (1) The amendments made by items 86, 87, 89 and 90 of Schedule 1 do not apply in relation to fees that were due and payable before the day on which this Act commences.
- (2) The amendments made by items 86, 87, 89 and 90 of Schedule 1 do not apply in relation to fees paid before the day on which this Act commences (even if they were not due until that day or a later day).

**8 Saving of regulations for subsection 223(9)**

- (1) Regulations in force for the purposes of subsection 223(9) of the *Patents Act 1990* immediately before the day on which this Act commences continue to have effect on and after that day as if they had been made for the purposes of that subsection as amended by this Schedule.
- (2) Subitem 1 does not prevent the repeal or amendment of regulations continued by that subitem.

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*Industry, Science and Resources Legislation Amendment (Application of Criminal Code) Act 2001* (No. 140, 2001)

**4 Application of amendments**

- (1) Each amendment made by this Act applies to acts and omissions that take place after the amendment commences.
- (2) For the purposes of this section, if an act or omission is alleged to have taken place between 2 dates, one before and one on or after the day on which a particular amendment commences, the act or omission is alleged to have taken place before the amendment commences.
-

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**Table A**

*Patents Amendment Act 2001* (No. 160, 2001)

**Schedule 1****13 Application**

The amendments made by this Part apply in relation to:

- (a) patents for which the complete application is made on or after the day on which this Schedule commences; and
- (b) the making of complete applications for patents on or after the day on which this Schedule commences.

**32 Application**

- (1) The amendments made by items 14 and 24 of this Schedule apply in relation to an application if the patent request and complete specification in relation to that application has not been accepted under subsection 49(1) of the *Patents Act 1990* before the commencement of this Schedule.
- (2) The amendment made by item 15 of this Schedule applies in relation to the acceptance of a patent request and complete specification under subsection 49(1) of the *Patents Act 1990* on or after the commencement of this Schedule.
- (3) The amendments made by items 16, 17 and 18 of this Schedule apply in relation to the grant of a patent on or after the commencement of this Schedule.
- (4) The amendment made by item 19 of this Schedule applies in relation to a patent unless the Commissioner has started examination of the patent under section 101B of the *Patents Act 1990* before the commencement of this Schedule.
- (5) The amendments made by items 20, 21 and 25 of this Schedule apply in relation to decisions of the Commissioner made under section 101E of the *Patents Act 1990* on or after the commencement of this Schedule.
- (6) The amendment made by item 23 of this Schedule applies in relation to a patent if the date of the patent is the date on which this Schedule commences or a later date.

## Table A

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- (7) The amendments made by items 27, 28, 29, 30 and 31 of this Schedule apply in relation to applications made under section 223 of the *Patents Act 1990* on or after the commencement of this Schedule.

### 33 Saving of regulations

- (1) Regulations in force for the purposes of a provision of the *Patents Act 1990* immediately before the day on which this Schedule commences continue to have effect on and after that day as if they had been made for the purposes of that provision as amended by this Schedule.
- (2) Subitem (1) does not prevent the repeal or amendment of regulations continued by that subitem.

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*Intellectual Property Laws Amendment Act 2003* (No. 48, 2003)

## Schedule 2

### 5 Application

- (1) The amendment made by item 2 of this Schedule applies in relation to an application if the patent request and complete specification in relation to that application had not been accepted under subsection 49(1) of the *Patents Act 1990* before 1 April 2002.
- (2) The amendment made by item 3 of this Schedule applies in relation to an innovation patent unless the Commissioner had started examination of the patent under section 101B of the *Patents Act 1990* before 1 April 2002.
- (3) For the purposes of subitem (1), information given before commencement under old subsection 45(3) is taken to be information given under new subsection 45(3).
- (4) For the purposes of subitem (2), information given before commencement under old section 101D is taken to be information given under new section 101D.
- (5) In this item:

***commencement*** means the time of commencement of Part 1 of this Schedule.

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**Table A**

*new section 101D* means section 101D of the *Patents Act 1990* as in force immediately after commencement.

*new subsection 45(3)* means subsection 45(3) of the *Patents Act 1990* as in force immediately after commencement.

*old section 101D* means section 101D of the *Patents Act 1990* as in force immediately before commencement.

*old subsection 45(3)* means subsection 45(3) of the *Patents Act 1990* as in force immediately before commencement.

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*US Free Trade Agreement Implementation Act 2004* (No. 120, 2004)

**Schedule 8**

**3 Application of amendments of section 59 of the Patents Act 1990**

The amendments of section 59 of the *Patents Act 1990* made by this Schedule apply in relation to each patent application for a standard patent:

- (a) made after the commencement of this Schedule; or
- (b) made before the commencement of this Schedule, but for which a patent has not been granted by the commencement of this Schedule.

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*Intellectual Property Laws Amendment Act 2006* (No. 106, 2006)

**Schedule 5**

**2 Application**

The amendment of section 122 of the *Patents Act 1990* made by this Schedule applies to infringements of patents occurring on or after the commencement of this Schedule.

## **Table A**

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### **Schedule 6**

#### **2 Application**

The amendment of the *Patents Act 1990* made by this Schedule applies in relation to patents granted as a result of applications filed on or after the commencement of this Schedule.

### **Schedule 7**

#### **4 Application**

The amendments of the *Patents Act 1990* made by this Schedule apply in relation to the exploitation, at or after the time this Schedule commences, of inventions claimed in patents in force at or after that time.

### **Schedule 8**

#### **9 Application and saving provisions**

- (1) The amendments of the *Patents Act 1990* made by this Schedule apply in relation to conduct (including omissions) that:
  - (a) occurs after the commencement of this Schedule; and
  - (b) is connected with a patent granted before, on or after that commencement.
- (2) To avoid doubt, proceedings started in a prescribed court under section 133 or 134 of the *Patents Act 1990* but not concluded before the commencement of this Schedule may be continued in the court after that commencement as if the amendments of that Act by this Schedule had not been made.

### **Schedule 9**

#### **2 Application**

The amendment of paragraph 40(2)(c) of the *Patents Act 1990* made by this Schedule applies to complete specifications relating to applications for innovation patents filed before, on or after the commencement of this Schedule.

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**Table A****Schedule 10****3 Application**

The amendments made by this Schedule apply to the making of a complete application on or after the commencement of this Schedule, whether the first patent concerned was granted before, on or after that commencement.

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*Personal Property Securities (Consequential Amendments) Act 2009*  
(No. 131, 2009)

The following provision commences on 1 February 2012 or an earlier time determined by the Minister (*see* section 306 of the *Personal Property Securities Act 2009*):

**Schedule 2****15 Application of amendments of the *Patents Act 1990***

- (1) The amendment of the *Patents Act 1990* made by item 9 of this Schedule does not apply in relation to a dealing that starts before the time the item commences.
- (2) The amendment of the *Patents Act 1990* made by item 10 of this Schedule does not apply in relation to the enforcement of an equity if the equity starts to be enforced before the time the item commences.
- (3) The amendments of the *Patents Act 1990* made by items 11, 12 and 13 of this Schedule do not apply in relation to any proceedings in a court or tribunal in relation to patents (or interests in patents) that are commenced before the time the items commence.

Note: Items 9 to 13 commence at the registration commencement time within the meaning of section 306 of the *Personal Property Securities Act 2009*.

**Table B**

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**Table B**

**Modifications**

*Patents Regulations 1991*

**8.3 Modification of Act to apply to PCT applications**

- (1) For paragraph 228 (2) (t) of the Act, the Act is modified under this regulation for PCT applications that are treated as patent applications under the Act.

(1AA) Subsection 45 (1):

*omit*

Where

*insert*

Subject to subsection (1AC), where

(1AB) After subsection 45 (1):

*insert*

(1AA) Where:

- (a) an applicant asks for an examination of a patent request and complete specification relating to a PCT application; and
- (b) the applicant demanded an international preliminary examination under Article 31 of the PCT before complying with the requirements of subsection 89 (3); and
- (c) at least 3 months after the applicant complied with the requirements of subsection 89 (3), the Commissioner asks for a copy of the international preliminary examination report from the International Bureau; and
- (d) the International Bureau advises that the international preliminary examination report is not available;



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**Table B**

the Commissioner may report on these matters and ask the applicant to provide a copy of the international preliminary examination report, or to advise that no amendments were made under Article 34 of the PCT, or to abandon any amendments that may have been made under Article 34 of the PCT.

- (1AB) Where:
- (a) an applicant asks for an examination of a patent request and complete specification relating to a PCT application; and
  - (b) subsection (1AA) does not apply; and
  - (c) the applicant asks for the examination to be expedited under subregulation 3.17 (2) of the *Patents Regulations 1991*; and
  - (d) a copy of an international preliminary examination report relating to the application has not been provided to the Commissioner;

the Commissioner may report on these matters and ask the applicant to provide a copy of the international preliminary examination report, or to advise that no amendments were made under Article 34 of the PCT, or to abandon any amendments that may have been made under Article 34 of the PCT.

- (1AC) If subsection (1AA) or (1AB) applies, the Commissioner is not required to perform his or her functions under subsection (1) unless:
- (a) a copy of the international preliminary examination report is provided to the Commissioner; or
  - (b) the applicant:
    - (i) advises that:
      - (A) no demand was made under Article 31 of the PCT; or
      - (B) no amendments were made under Article 34 of the PCT; or

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(C) the demand was made under Article 31 of the PCT, or the international preliminary examination report was established, after the applicant complied with the requirements of subsection 89 (3); or

(ii) elects to abandon any amendments that may have been made under Article 34 of the PCT.

*Note* Under subsection 89 (7) of the Act, as modified by the *Patents Regulations 1991*, if the applicant provides the advice, or makes the election, mentioned in paragraph (1AC) (b), any amendments made under Article 34 of the PCT are not taken to be included in the application.

(1AC) After subsection 45 (5):

*insert*

(6) In this section:

***International Bureau*** means the International Bureau of the World Intellectual Property Organization.

***international preliminary examination report*** has the same meaning as it has in the PCT.

(1AD) Subsection 48 (1):

*omit*

When

*insert*

Subject to subsection (1AC), when

(1AE) After subsection 48 (1):

*insert*

(1AA) Where:

(a) an applicant asks for a modified examination of a patent request and complete specification relating to a PCT application; and

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- (b) the applicant demanded an international preliminary examination under Article 31 of the PCT before complying with the requirements of subsection 89 (3); and
- (c) at least 3 months after the applicant complied with the requirements of subsection 89 (3), the Commissioner asks for a copy of the international preliminary examination report from the International Bureau; and
- (d) the International Bureau advises that the international preliminary examination report is not available;

the Commissioner may report on these matters and ask the applicant to provide a copy of the international preliminary examination report, or to advise that no amendments were made under Article 34 of the PCT, or to abandon any amendments that may have been made under Article 34 of the PCT.

(1AB) Where:

- (a) an applicant asks for a modified examination of a patent request and complete specification relating to a PCT application; and
- (b) subsection (1AA) does not apply; and
- (c) the applicant asks for the examination to be expedited under subregulation 3.17 (2) of the *Patents Regulations 1991*; and
- (d) a copy of an international preliminary examination report relating to the application has not been provided to the Commissioner;

the Commissioner may report on these matters and ask the applicant to provide a copy of the international preliminary examination report, or to advise that no amendments were made under Article 34 of the PCT, or to abandon any amendments that may have been made under Article 34 of the PCT.

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- (1AC) If subsection (1AA) or (1AB) applies, the Commissioner is not required to perform his or her functions under subsection (1) unless:
- (a) a copy of the international preliminary examination report is provided to the Commissioner; or
  - (b) the applicant:
    - (i) advises the Commissioner that:
      - (A) no demand was made under Article 31 of the PCT; or
      - (B) no amendments were made under Article 34 of the PCT; or
      - (C) the demand was made under Article 31 of the PCT, or the international preliminary examination report was established, after the applicant complied with the requirements of subsection 89 (3); or
    - (ii) elects to abandon any amendments that may have been made under Article 34 of the PCT.

*Note* Under subsection 89 (7) of the Act, as modified by the *Patents Regulations 1991*, if the applicant provides the advice, or makes the election, mentioned in paragraph (1AC) (b), any amendments made under Article 34 of the PCT are not taken to be included in the application.

- (1AF) After subsection 48 (2):

*insert*

- (3) In this section:

***International Bureau*** means the International Bureau of the World Intellectual Property Organization.

***international preliminary examination report*** has the same meaning as it has in the PCT.

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(1A) Section 53:

*omit*

Where

*insert*

(1) Where

(1B) Section 53:

*insert*

(2) For a PCT application, the prescribed information is taken to have been published under subsection (1) when the application is published by the International Bureau of the World Intellectual Property Organization.

(1BA) Subsection 89 (5):

*substitute*

(5) If:

(a) a PCT application has been amended under Article 19 of the PCT before the applicant meets the requirements of subsection (3); or

(b) a PCT application has been rectified under Rule 91 of the Regulations mentioned in the definition of *PCT* in Schedule 1 before the applicant meets the requirements of subsection (3);

then the description, drawings and claims contained in the application are, for the purposes of this Act, to be taken to have been amended:

(c) on the day the amendment was made; or

(d) unless the Commissioner disregards the rectification under Rule 91.3 (f) — on the day the rectification was effective.

(1BD) After subsection 89 (5):

*insert*

(6) Subject to subsection (7), where:

(a) a PCT application in respect of which Australia has been elected under Chapter II of the PCT has been amended under Article 34 of the PCT; and

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- (b) an international preliminary examination report is established before the applicant meets the requirements of subsection (3);  
the description, drawings and claims contained in the application are, for the purposes of this Act, to be taken to have been amended on the day on which the amendment was made.
- (7) Subsection (6) does not apply if:
  - (a) the Commissioner has reported under subsection 45 (1AA) or (1AB), or 48 (1AA) or (1AB), or under regulations made for the purpose of section 104, in relation to an application; and
  - (b) the applicant elects under subparagraph 45 (1AC) (b) (ii) or 48 (1AC) (b) (ii), or under regulations made for the purpose of section 104, to abandon any amendments that may have been made under Article 34 of the PCT, or provides the advice mentioned in subparagraph 45 (1AC) (b) (i) or 48 (1AC) (b) (i) or in regulations made for the purpose of section 104.
- (1C) Paragraph 90 (a):
  - omit*  
subsection 92 (1) or (2)
  - insert*  
subsection 92 (2)
- (1D) Paragraph 90 (b):
  - substitute*
    - (b) where subsection 92 (3) applies — on the day on which the application is published under Article 21 of the PCT.

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(1E) Section 92:

*substitute*

**92 Notice of publication**

- (1) Subsection (2) applies to a PCT application:
    - (a) that has not lapsed, or been withdrawn or refused; and
    - (b) that is to be treated as an application for a standard patent under this Act; and
    - (c) for which the applicant complies with subsection 89 (3) before the end of 18 months after the priority date of the application.
  - (2) The Commissioner must publish a notice in the *Official Journal* stating that the PCT application is open to public inspection:
    - (a) if the applicant asks the Commissioner in writing to publish the notice; or
    - (b) in any case — as soon as practicable after the end of 18 months after the priority date of the application.
  - (3) If:
    - (a) the applicant does not comply with subsection 89 (3) within 18 months after the priority date of a PCT application; and
    - (b) the application is published under Article 21 of the PCT;the application is open to public inspection.
  - (4) If a PCT application is open to public inspection, any other prescribed documents are also open to public inspection.
  - (5) In this section:

*priority date*, for an international application, has the same meaning as in the PCT.
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- (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.’.
- (3) Subsection 142 (2):  
Add at the end:  
‘; or (f) Article 11 (3) of the PCT ceases to have effect in Australia in relation to the application under Article 24 (1) (ii) or (iii) or Article 39 (2) of the PCT’.
- (4) Section 223:  
After subsection (1) insert:  
‘(1A) If, because of an error or omission by the receiving Office or the International Bureau, a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Commissioner must extend the time for doing the act.’.
- (5) Schedule 1, definition of *international filing date*, including the cross-reference to section 10:  
*substitute*  
‘*international filing date*, in relation to an international application, means:  
(a) the date given to the international application as its international filing date under Article 11 of the PCT; or  
(b) if that date is revised under Article 14 of the PCT — that international filing date as so revised; or



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- (c) if the Commissioner has treated another date as the international filing date under Rule 82<sup>ter</sup> — that international filing date as so treated.

*[See also section 10]*'.