



Patents Regulations 1991

Statutory Rules 1991 No. 71 as amended

made under the

Patents Act 1990

This compilation was prepared on 1 August 2010
taking into account amendments up to SLI 2010 No. 181

This document has been split into two volumes

Volume 1 contains Chapters 1 to 23 and Schedules 1, 1A and 2, and

Volume 2 contains Schedules 2A to 8 and the Notes

Each volume has its own Table of Contents

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Regulation 1.1

Chapter 1 Introductory

1.1 **Name of Regulations** [see Note 1]

These Regulations are the *Patents Regulations 1991*.

1.2 **Commencement**

These Regulations commence on 30 April 1991.

1.3 **Interpretation**

- (1) In these Regulations, unless the contrary intention appears:

abstract means abstract of a complete specification.

acceptance means:

- (a) in relation to a patent request and complete specification relating to an application for a standard patent — acceptance of the patent request and complete specification under section 49 of the Act; and
- (b) in relation to a patent request and complete specification relating to an application for an innovation patent — acceptance of the patent request and complete specification under section 52 of the Act.

approved digital library means a library or other facility that the Commissioner specifies as a digital library, for this definition, in the *Official Journal*.

Example

The library administered by the International Bureau of the World Intellectual Property Organization, known as the “Digital Access Service for Priority Documents” or “DAS”.

basic documents means documents filed in a Convention country in respect of a basic application.

certificate of verification means a statement:

- (a) that a document to which the statement relates is a true and complete translation of the accompanying document

Regulation 1.3

to the best of the knowledge of the person who signs the statement; and

- (b) that is dated and signed.

competent authority, in relation to a Convention country, means a person who, under the laws of the country or the arrangements in place in the country, is authorised to certify copies of specifications of patents for the country.

Disciplinary Tribunal means the Patent and Trade Marks Attorneys Disciplinary Tribunal established under regulation 20.41.

former attorneys Regulations means the following Regulations:

- (a) the Patent Attorneys Regulations as in force immediately before the commencing day under the 1952 Act;
- (b) the *Patents Regulations 1991* as in force immediately before 1 July 2008.

former patents Regulations means the Patents Regulations in force immediately before the commencing day under the 1952 Act.

International Bureau means the International Bureau of the World Intellectual Property Organization.

the Act means the *Patents Act 1990*.

the Tribunal means the Administrative Appeals Tribunal.

- (2) A reference in these Regulations to:
- (a) the giving of a notice or other document; or
- (b) the making of a request or an application;
- to the Commissioner or the Patent Office includes a reference to the filing of the document.
- (3) A reference in these Regulations to a document that is open to public inspection is a reference to a document that may be inspected by the public at the Patent Office.

Regulation 1.3A

- (4) Subject to subregulation (5), if the Commissioner or the Patent Office gives a document to a person, the document is taken to have been given to the person on the day on which the document is dated by the Commissioner or the Office, unless the contrary intention appears.
- (5) If:
 - (a) the Commissioner or the Patent Office makes a document available electronically for a person; and
 - (b) sends a notice to the person telling them that the document is available for them to collect electronically;the document is taken to have been given to the person on the day on which the notice is dated by the Commissioner or the Office, unless the contrary intention appears.
- (6) A requirement in these Regulations to give information to the Commissioner or to another person (whether the expression 'give', 'tell', 'inform' or another expression is used) is a requirement to give the information in writing, unless the contrary intention appears.
- (7) For these Regulations, a period expressed in months is to be worked out in the way described in rule 80.2 of the Regulations under the Patent Cooperation Treaty set out in Schedule 2A.

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

For these regulations:

A search is *completed* on the earliest of:

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

Regulation 1.5

1.4 English text of treaties

- (1) The English text of the Budapest Treaty as in force for Australia on 1 October 2002 is the text set out in Schedules 1 (the Treaty) and 1A (the Regulations under the Treaty).
- (2) The English text of the PCT as in force for Australia on 1 July 2010 is the text set out in Schedules 2 (the Treaty) and 2A (the Regulations under the Treaty).

Note This regulation is made for the purposes of subsection 228 (5) of the Act.

1.5 Deposit requirements: prescribed period

- (1) For paragraph 6 (c) of the Act, the prescribed period is:
 - (a) if the Commissioner makes a declaration under subsection 42 (1) of the Act in relation to the specification concerned — the period mentioned in subregulation (2); or
 - (b) in any other case:
 - (i) for a complete specification in respect of a standard patent application — the period mentioned in subregulation (3); or
 - (ii) for a complete specification in respect of an innovation patent application — the period mentioned in subregulation (4).
- (2) For paragraph (1) (a), the period begins on the filing date of the application to which the specification relates and ends 3 months from the date taken to be the date of filing of the specification under paragraph 42 (2) (b) of the Act.
- (3) For subparagraph (1) (b) (i), the period begins on the filing date of the application to which the specification relates and ends:
 - (a) at the end of the day immediately before the day on which the application becomes open to public inspection; or
 - (b) if the application is accepted before the end of the day first mentioned in paragraph (a) — immediately before acceptance.

Regulation 1.6

- (4) For subparagraph (1) (b) (ii), the period begins on the filing date of the application to which the specification relates to and ends immediately before acceptance.
- (5) If a matter mentioned in paragraph 6 (c) of the Act has been included in the specification, the applicant or patentee is taken to consent to a micro-organism being obtained by a person to whom the Commissioner has granted the certification under regulation 3.25 in respect of the deposit:
 - (a) after the period mentioned in subregulation (1) for the specification to which the application relates; and
 - (b) from the prescribed depositary institution with which the micro-organism is deposited.

1.6 Disclosure in basic applications — general

- (1) For section 8 of the Act:
 - (a) the prescribed period for documents to which paragraph 8 (a) of the Act applies is 3 months from the date on which the Commissioner requests the document; and
 - (b) the prescribed period for documents to which paragraph 8 (b) of the Act applies is 3 months from the date on which the Commissioner requests the translation of a document.

Note A translation of a document into English that is filed must have with it a related certificate of verification (see regulation 22.15).

- (2) A matter that was claimed or disclosed in a disclaimer or acknowledgement of prior art in a basic application or in a specification or other document filed in respect of, and at the same time as, the basic application is not taken to have been disclosed.

1.6A Disclosure in basic applications — use of approved digital library

- (1) For section 8 of the Act, a specification or other document is taken to have been filed in respect of, and at the same time as, a basic application if:

Regulation 1.8

- (a) the Commissioner is satisfied that a copy of the specification or document has been made available for inspection by the Commissioner in an approved digital library; and
 - (b) the specification or document was made available within the period mentioned in subregulation 1.6 (1).
- (2) However, if the Commissioner is satisfied that the specification or other document:
- (a) was made available for inspection by the Commissioner in the approved digital library within the period mentioned in subregulation 1.6 (1); but
 - (b) is no longer available for inspection;
- the specification or other document is taken to have been filed in respect of, and at the same time as, the basic application only if the specification or other document is again made available for inspection by the Commissioner in the approved digital library, or given to the Commissioner, no later than 2 months after the day on which the Commissioner notifies the applicant or patentee that the Commissioner has not been able to inspect the specification or other document in the approved digital library.

1.7 Verification of translations of international applications

For the purposes of subsection 10 (2) of the Act, the translation of an international application that was not filed in the receiving Office in English must have with it a related certificate of verification.

1.8 Completion of applications

- (1) A person who makes an application or request using an application form must:
- (a) comply with any directions given on the form; and
 - (b) provide information for each part of the form that describes the information as being mandatory.

Regulation 1.8

- (2) A person who makes an application or request using an application procedure other than a form must:
- (a) comply with any directions given as part of the procedure; and
 - (b) provide information for each part of the procedure that describes the information as being mandatory.

Example

An online application facility.

Regulation 2.2

Chapter 2 Patent rights, ownership and validity

2.1 Applications by co-owners for directions

- (1) An application under section 17 of the Act must be in the approved form.
- (2) A person making an application under that section must:
 - (a) file with the application a notice stating the facts on which the application is based; and
 - (b) serve a copy of the application and notice on the other patentee or patentees.

2.2 Publication or use: prescribed circumstances

- (1) In this Regulation:

Paris Convention means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force for Australia on the commencing day.

recognised exhibition means:

 - (a) an official or officially recognised international exhibition within the meaning of Article 11 of the Paris Convention or Article 1 of the Convention relating to International Exhibitions done at Paris on 22 November 1928, as in force for Australia on the commencing day; or
 - (b) an international exhibition recognised by the Commissioner by a notice published in the *Official Journal* before the beginning of the exhibition.
- (1A) For paragraph 24 (1) (a) of the Act, the circumstance that there was a publication or use of the invention within 12 months before the filing date of the complete application, is a prescribed circumstance.

Regulation 2.2

- (2) For paragraph 24 (1) (a) of the Act the following are also prescribed circumstances:
- (a) the showing or use of the invention at a recognised exhibition;
 - (b) the publication of the invention during a recognised exhibition at which the invention was shown or used;
 - (c) the publication of the invention in a paper written by the inventor and:
 - (i) read before a learned society; or
 - (ii) published with the inventor's consent by or on behalf of a learned society; or
 - (d) the working in public of the invention within the period of 12 months before the priority date of a claim for the invention:
 - (i) for the purposes of reasonable trial; and
 - (ii) if, because of the nature of the invention, it is reasonably necessary for the working to be in public.
- (3) Paragraphs (2) (a) and (b) are prescribed circumstances only if:
- (a) at the time the application is made for a patent for the invention, the applicant has filed a notice stating that the invention has been exhibited; and
 - (b) the applicant has filed a statement issued by the authority responsible for the exhibition in which:
 - (i) the invention and the exhibition are identified; and
 - (ii) the date of the opening of the exhibition is given; and
 - (iii) if the first disclosure of the invention during the exhibition did not take place on that date — the date of that disclosure.
- (4) For paragraph (3) (b), the statement must be filed:
- (a) for an application for a standard patent — before the complete specification in respect of the application is open to public inspection; or
 - (b) for an application for an innovation patent — within 6 months from the filing date of the complete specification in respect of the application.

Regulation 2.3

2.3 Publication or use: prescribed periods

- (1A) For information of the kind referred to in paragraph 24 (1) (a) of the Act, if the applicant relies on the circumstance in subregulation 2.2 (1A), the prescribed period is the period of 12 months after the information was first made publicly available.
- (1) For information of the kind referred to in paragraph 24 (1) (a) of the Act, if the applicant relies on a circumstance in subregulation 2.2 (2), the prescribed period is:
- (a) in the case of a circumstance mentioned in paragraph 2.2 (2) (a) or (b):
 - (i) if the application claims priority from a basic application made within 6 months of the date of the first showing or use of the invention at a recognised exhibition — 12 months from the making of the basic application; and
 - (ii) in any other case — 6 months after the first showing or use of the invention at the exhibition; and
 - (b) in the case of the circumstance mentioned in paragraph 2.2 (2) (c):
 - (i) if the application claims priority from a basic application made within 6 months of the date of the first reading or publication referred to in that paragraph — 12 months from the making of the basic application; and
 - (ii) in any other case — 6 months after the first reading or publication; and
 - (c) in the case of the circumstance mentioned in paragraph 2.2 (2) (d) — 12 months from the start of the first public working of the invention referred to in that paragraph.
- (2) For the purposes of subsection 24 (1) of the Act, in the case of information of the kind referred to in paragraph 24 (1) (b) of the Act, the prescribed period is 12 months from the day when the information referred to in that paragraph became publicly available.

Regulation 2.4

- (3) Subregulation (4) applies:
 - (a) if an application for a patent is a divisional application:
 - (i) under section 79B of the Act for an invention disclosed in the specification filed with a previous application for a standard patent (the *original application*); or
 - (ii) under section 79C of the Act for an invention disclosed in the specification filed in respect of an application for an innovation patent (the *original application*); and
 - (b) only to information disclosed in the divisional application that was disclosed in the original application.
- (4) For determining the prescribed period for subsection 24 (1) of the Act, the filing date of the divisional application is taken to be the filing date of the original application.

2.4 Prescribed period: patents of addition

- (1) For the purposes of section 25 of the Act, the prescribed period is the period that commences on the priority date of the claim of the specification of the main invention and ends immediately before the priority date of the relevant claim of the specification of the patent of addition.
- (2) In subregulation (1), a reference to the claim of the specification of the main invention is a reference to:
 - (a) the claim defining that main invention; or
 - (b) if there are 2 or more claims defining the main invention — the claim that has the earlier or earliest priority date.

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

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

- (a) beginning immediately after the complete specification filed in relation to the application for a standard patent becomes open to public inspection; and

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- (b) ending 3 months after the date of publication in the *Official Journal* of the notice of acceptance under paragraph 49 (5) (b) of the Act.

2.6 Prescribed period: notification of assertion of invalidity of innovation patent

For subsection 28 (2) of the Act, the prescribed period for an innovation patent is the period from the date that the complete specification for the patent becomes open to public inspection to immediately before the Commissioner decides to certify the patent.

2.7 Documents to accompany notice of assertion of invalidity

Notice of an assertion under subsection 27 (1) or 28 (1) of the Act must, if the assertion is based on a document, have with it:

- (a) a copy of the document; and
- (b) if the document is not in English, a copy of:
 - (i) a translation of the document into English; and
 - (ii) a related certificate of verification; and
- (c) evidence of the date and place of publication of the document.

Regulation 3.1

Chapter 3 From application to acceptance

Part 1 Inventions generally

3.1 Prescribed documents: patent applications

- (1) For the purposes of subsection 29 (1) of the Act, an abstract is required to be filed with a patent request made in relation to a complete application.
- (2) For the purposes of subsection 29 (1) of the Act, if a complete application for a standard patent is made, the following documents are required to be filed before acceptance:
 - (a) a notice by the applicant stating the entitlement of the nominated person to the grant of the patent; and
 - (b) if the applicant claims priority from another application — a notice by the applicant stating the entitlement of the nominated person to claim that priority; and
 - (c) if a micro-organism is deposited with a prescribed depositary institution:
 - (i) if the deposit is an original deposit within the meaning of Rule 7.3 of the Budapest Treaty or a new deposit within the meaning of Rule 7.4 of that Treaty — a copy of a receipt issued by the institution under Rule 7 of the Treaty; and
 - (ii) if samples of the micro-organism were transferred to that institution under Rule 5.1 (a) (i) of the Treaty — a copy of a receipt issued by the institution under Rule 7 of the Treaty; and
 - (iii) if a receipt referred to in subparagraph (i) or (ii) is not in English — a translation of the receipt into English and a related certificate of verification; and

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- (d) if the application relies on section 6 of the Act — a notice by the applicant stating the entitlement of the nominated person to rely on the deposit for the purposes of the Act; and
- (e) if the application is an application to which subsection 34 (2) of the Act applies — a copy of the court order declaring the applicant to be an eligible person in relation to the invention so far as claimed in a claim of the specification; and
- (f) if the application is an application to which subsection 36 (4) of the Act applies — a copy of the declaration of the Commissioner that the applicant is an eligible person in relation to the invention as disclosed in the specification; and
- (g) if the request is for a patent of addition and is made by a person authorised by the applicant or patentee — a statement authorising the person that is signed by the applicant or patentee.

3.1A Applicant taken to be nominated person

For an application for a standard patent or an innovation patent, the applicant is taken to be the nominated person.

3.2 Provisional specifications

A provisional specification must be in the approved form.

3.2A Specifications — standard patents

- (1) A patent request for a standard patent must:
 - (a) be in the approved form; and
 - (b) be in English; and
 - (c) comply substantially with the requirements of Schedule 3.
- (2) A complete specification for a standard patent must:
 - (a) be in the approved form; and
 - (b) be in English; and
 - (c) comply substantially with the requirements of Schedule 3.

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- (3) If the Commissioner treats an application for a standard patent as having been filed, the Commissioner may, within 1 month from the date of filing of the application, direct the applicant to do anything necessary to ensure that the patent request and complete specification comply with the requirements mentioned in subregulations (1) and (2).

Note See regulation 3.5 for what happens if certain information required for an application is not filed.

- (4) If:
- (a) the Commissioner gives the applicant a direction under subregulation (3) to assist the Commissioner in deciding whether a filed abstract is in accordance with these Regulations; and
 - (b) the Commissioner has specified in the direction a period of not less than 1 month within which the applicant must comply with the direction; and
 - (c) the applicant does not comply with the direction before the end of the period;
- the complete application to which the patent request and complete specification relate lapses at the end of the period.
- (5) Subject to subregulation (4), if an applicant to whom a direction has been given under subregulation (3) does not comply with the direction within 2 months from the date of the direction, the application lapses.
- (6) If an application lapses under subregulation (4) or (5), the Commissioner must:
- (a) advertise that fact in the *Official Journal*; and
 - (b) tell the applicant that the complete application has lapsed.

3.2B Specifications: formalities check for innovation patents

- (1) For section 52 of the Act, a complete application for an innovation patent passes the formalities check only if the application meets all of the following requirements:
- (a) the complete specification for the application must:
 - (i) be in the approved form; and

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- (ii) be in English; and
 - (iii) comply substantially with the requirements of Schedule 3;
 - (b) the patent request must be in the approved form;
 - (c) if the applicant is an eligible person under section 34 of the Act — a copy of the court order declaring that the applicant is an eligible person in relation to the invention must be filed with the complete application;
 - (d) the complete application must comply with regulation 3.8, 3.10, 6A.1, 6A.2 or subregulation 8.5 (2), or subsection 79C (2) of the Act, if applicable;
 - (e) if the applicant is relying on section 41 of the Act — the receipts mentioned in paragraph 3.1 (2) (c) must be filed with the complete application;
 - (f) the complete specification must not be a cross-reference to an earlier patent application filed in Australia or in a Convention country;
 - (g) the complete specification must not contravene subsection 18 (2) or (3) of the Act;
 - (h) if the application is a divisional application made under section 79B of the Act in relation to an original application that is a PCT application, the complete specification for the PCT application must be open to public inspection.
- (2) If the application does not meet a requirement mentioned in paragraph (1) (a), (b), (c), (d), (e), (f) or (h), the Commissioner must direct the applicant to do any thing necessary to ensure that the application meets the requirement.
- (3) If an applicant to whom a direction under subregulation (2) has been given does not comply with the direction within 2 months from the date of the direction, the application lapses.
- (4) If the application does not meet the requirement mentioned in paragraph (1) (g), the Commissioner must direct the applicant to ensure that the application meets the requirement.
- (5) If an applicant to whom a direction under subregulation (4) has been given does not respond to the direction within 2 months from the date of the direction, the application lapses.

Regulation 3.3

- (6) If an applicant to whom a direction under subregulation (4) has been given does not comply with the direction within 4 months from the date of the direction, the application lapses.
- (7) If an application lapses under subregulation (3), (5) or (6), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) tell the applicant of the lapse.

3.3 Abstracts

- (1) An abstract must consist of:
 - (a) a summary of the disclosure as contained in the description, the claims and any drawings, being a summary:
 - (i) that indicates the technical field to which the invention pertains; and
 - (ii) that is drafted in a way that allows the clearer understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention; and
 - (b) if applicable, any chemical formula that, among all the formulas contained in the specification, best characterises the invention.
- (2) An abstract must be as concise as the disclosure permits, preferably 50 to 150 words.
- (3) An abstract must not contain statements on the alleged merits or value of the claimed invention or on its speculative application.
- (4) Each main technical feature mentioned in the abstract and illustrated by a drawing in the specification must be followed by a reference sign placed between parentheses.
- (5) An abstract must be so drafted that it can efficiently serve as a scanning tool for the purposes of searching in the particular art, especially by assisting in the formulation of an opinion on whether there is a need to consult the specification itself for those purposes.

Regulation 3.4

- (6) An abstract is not taken into account in construing the nature of the invention that is the subject of the specification to which the abstract relates.
- (7) Information in an abstract filed with the complete application may be taken into account in determining, for subsection 102 (1) of the Act, whether a matter was in substance disclosed in the specification as filed.

3.4 Substitute abstracts

- (1) If a filed abstract is not in accordance with these Regulations, the Commissioner may prepare a draft of a new abstract in substitution for the filed abstract.
- (2) A copy of the draft of a new abstract must be given to the applicant who may give the Commissioner written comments on the draft within 1 month of the draft being given to him or her.
- (3) The Commissioner must take the comments into account in the final preparation of the new abstract.
- (4) If the Commissioner prepares a new abstract, the new abstract is taken to be the abstract of the specification to which it relates.
- (5) If an applicant who files a complete specification does not file with it an abstract, the Commissioner, within 1 month of the date of filing of the complete specification, may direct the applicant to file an abstract within 1 month of the day on which the direction is given.
- (6) If an abstract is not filed within 1 month from the day on which the direction was given, the application lapses.
- (7) If an application lapses under subregulation (6), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) advise the applicant of the lapse.

Regulation 3.5

3.5 Filing date

- (1) Subject to this regulation, the filing date of a patent application is the date on which the following information is filed:
 - (a) information in English that indicates that what is filed is intended to be an application for a patent;
 - (b) information that allows the identity of the applicant to be established or allows the applicant to be contacted by the Patent Office;
 - (c) information that appears to be a description.
- (2) For paragraph (1) (c), a description:
 - (a) does not have to be in English; and
 - (b) may be a drawing; and
 - (c) may be a reference, in English, to an earlier patent application filed in Australia or in a Convention country.
- (3) For paragraph (2) (c), the earlier patent application does not have to be in English.
- (4) If all of the information mentioned in subregulation (1) is not filed in respect of an application, the Commissioner must give the applicant notice in writing:
 - (a) telling the applicant that all of the information mentioned in subregulation (1) was not filed in respect of the application; and
 - (b) asking the applicant to file the additional information required.
- (5) If an applicant to whom a notice under subregulation (4) has been given does not file the additional information within 2 months from the date of the notice, the application is taken not to have been filed.
- (6) Subregulation (7) applies if an applicant to whom a notice under subregulation (4) has been given files the additional information within 2 months from the date of the notice.
- (7) For section 30 of the Act, the filing date of the patent application is the date on which the additional information is filed.

Regulation 3.5A

3.5A Filing date: incomplete specifications

- (1) This regulation applies if the information mentioned in subregulation 3.5 (1) has been filed in respect of a patent application but a part of the patent specification is missing.
- (2) If the Commissioner notices that a part of the specification is missing, the Commissioner must give the applicant notice in writing:
 - (a) telling the applicant that a part of the specification is missing; and
 - (b) asking the applicant to file the missing part.
- (3) The missing part must be incorporated into the specification if, within the period applying under subregulation (4), the applicant:
 - (a) files the missing part; or
 - (b) if the applicant claims priority from an earlier basic application or associated provisional application — files:
 - (i) the missing part; and
 - (ii) a copy of the earlier application that contains, and indicates the location of, the missing part; and
 - (iii) if the earlier application is not in English — a translation of the application in to English together with a related certificate of verification.
- (4) For subregulation (3), the period is:
 - (a) if a notice is given under subregulation (2) — 2 months from the date of the notice; or
 - (b) in any other case — the period ending on the earlier of:
 - (i) 2 months after the filing date; and
 - (ii) the time of acceptance.
- (5) For section 30 of the Act, the filing date of the application is:
 - (a) if paragraph (3) (a) applies — the date on which the missing part is filed; and
 - (b) if paragraph (3) (b) applies — the date that would have been the filing date if the missing part had not been incorporated.

Regulation 3.5B

- (6) If paragraph (5) (a) applies, the Commissioner must tell the applicant of the new filing date.
- (7) Despite paragraph (5) (a), if within 1 month after being told of the new filing date, the applicant withdraws the missing part from the specification, the filing date of the application, for section 30 of the Act, is the date that would have been the filing date if the missing part had not been incorporated.

3.5B Filing of documents outside business hours

The Patent Office and each sub-office of the Patent Office may provide facilities for the filing of documents when the Office or sub-office is not open to the public for business.

3.6 Requests to make determinations between interested parties

For section 32 of the Act, a request must:

- (a) be in the approved form; and
- (b) have with it a notice, by the person making the request, stating the grounds on which the request is made.

3.7 Form of certain applications

For the purposes of paragraphs 35 (1) (b) and 36 (1) (b) of the Act, an application must:

- (a) be in the approved form; and
- (b) have with it a notice by the applicant stating the grounds on which the application is made.

3.8 Time within which applications are to be made following certain decisions and declarations

An application under section 29 of the Act must be made:

- (a) in the case of an application of the kind described in section 33 of the Act — within 3 months of the decision of the Commissioner referred to in paragraph 33 (1) (c), (2) (c), (3) (c) or (4) (b) of the Act, as the case requires; or

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- (b) in the case of an application of the kind described in section 34 of the Act — within 3 months of the declaration of a court under subsection 34 (1) of the Act; or
- (c) in the case of an application of the kind described in section 35 of the Act — within 3 months of the declaration of the Commissioner under subsection 35 (1) of the Act; or
- (d) in the case of an application of the kind described in section 36 of the Act — within 3 months of the declaration of the Commissioner under subsection 36 (1) of the Act.

3.9 Prescribed period: treatment of complete application as provisional

For subsection 37 (1) of the Act, the prescribed period is:

- (a) for an application for a standard patent — the period from the date of filing of the complete application until the earlier of:
 - (i) the end of 12 months from the filing date of the complete application; and
 - (ii) the day that is 3 weeks before the due date for publishing a notice under section 54 of the Act; and
- (b) for an application for an innovation patent — 12 months from the filing date of the complete application.

3.10 Prescribed period: making of complete applications

For the purposes of section 38 of the Act, the period of 12 months from the filing date of the provisional application is prescribed.

3.12 Priority dates generally

- (1) Subject to regulations 3.13 and 3.14 and subregulation (2), the priority date of a claim of a specification is the earliest of the following dates:
 - (a) the date of filing of the specification;

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- (b) if the claim is fairly based on matter disclosed in 1 or more priority documents, the date of filing the priority document in which the matter was first disclosed;
 - (c) if the specification is a complete specification filed in respect of a divisional application under section 79B of the Act and the claim is fairly based on matter disclosed in the specification referred to in paragraph 79B (1) (a) of the Act — the date mentioned in subregulation (2C);
 - (d) if the specification is a complete specification filed in respect of a divisional application under section 79C of the Act and:
 - (i) the claim is fairly based on matter disclosed in the specification referred to in subsection 79C (1) of the Act; and
 - (ii) examination of the divisional application is requested within 2 months from the date of the grant of the divisional application;the date mentioned in subregulation (2D).
- (2) For the purposes of paragraph (1) (b):
- (a) if the application that relates to the specification containing the claim is a complete application — a provisional application that is associated with that complete application in accordance with section 38 of the Act is a priority document; and
 - (b) if the application that relates to the specification containing the claim is a Convention application, a document of any of the following kinds is a priority document:
 - (i) a basic application that is related to the Convention application;
 - (ii) a specification, or another document filed in respect of, and at the same time as, a basic application that is related to that Convention application; or
 - (iii) a specification in respect of a basic application that is related to that Convention application, being a specification that was filed after the basic application was made;

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- (c) if:
- (i) the application that relates to the specification containing the claim is a PCT application that, under Article 8 of the PCT, claims the priority of an earlier application; and
 - (ii) that earlier application is:
 - (A) an application made in Australia not more than 12 months before the international filing date of the PCT application; or
 - (AA) an application made in Australia more than 12 months before the international filing date of the PCT application, for which:
 - (I) a receiving Office has restored priority under Rule 26^{bis}.3; and
 - (II) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or
 - (B) a basic application, made not more than 12 months before the international filing date of the PCT application, that is the first application made in a Convention country in respect of the invention; or
 - (BB) a basic application made more than 12 months before the international filing date of the PCT application, that is the first application made in a Convention country in respect of the invention, for which:
 - (I) a receiving Office has restored priority under Rule 26^{bis}.3; and
 - (II) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or

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- (C) a basic application made after a basic application referred to in sub-subparagraph (B);
- that earlier application, and a specification filed in relation to that earlier application after it was made, are priority documents.
- (2A) For the purposes of paragraph (1) (b) and subregulation (2), ‘filed’ includes filed with the Patent Office and filed with a corresponding Office of another country.
- (2B) A reference in subregulation (2) to a basic application does not include a basic application that has been disregarded by the Commissioner under section 96 of the Act.
- (2C) The date for a specification to which paragraph 3.12 (1) (c) applies is the date that would have been the priority date of the claim if it had been included in the specification referred to in paragraph 79B (1) (a) of the Act.
- (2D) The date for a specification to which paragraph 3.12 (1) (d) applies is the date that would have been the priority date of the claim if it had been included in the specification referred to in subsection 79C (1) of the Act.
- (3) For paragraphs 3.12 (1) (c) and (d), a claim is not fairly based on the specification referred to in paragraph 79B (1) (a) or the specification of the first patent referred to in subsection 79C (1) of the Act if, in order to comply with paragraph 40 (2) (a) of the Act, the deposit requirements must be satisfied and on the date of making the divisional application:
- (a) the requirement specified in paragraph 6 (a) of the Act is not satisfied in relation to the specification referred to in paragraph 79B (1) (a) or the specification of the first patent referred to in subsection 79C (1) of the Act; or
 - (b) the period prescribed in subregulation 1.5 (1) has ended and the requirements of paragraph 6 (c) of the Act are not satisfied in relation to the specification referred to in paragraph 79B (1) (a) or the specification of the first patent referred to in subsection 79C (1) of the Act.

Regulation 3.14

- (4) If a PCT application claims priority from a basic application, a specification or other document filed in respect of, and at the same time as, a basic application, section 96 of the Act is taken to apply to the PCT application as if it were a Convention application.

3.13 Priority dates: certain persons and applications

- (1) This regulation applies if, under subsection 36 (1) of the Act:
- (a) the Commissioner declares a person to be an eligible person; and
 - (b) the person makes a complete application under section 29 of the Act.
- (2) The priority date of a claim of the specification in respect of that application, being a claim that is fairly based on matter disclosed in the specification referred to in paragraph 36 (1) (c) of the Act and referred to in the declaration, is:
- (a) if that specification is a complete specification — the priority date of the claim or the date that would have been the priority date of the claim if the claim had been a claim of the specification; and
 - (b) if that specification is a provisional specification — the date of filing of the provisional specification.

3.14 Priority dates: certain amended claims

If subsection 114 (1) of the Act applies to a claim of a specification, the priority date of the claim is:

- (a) in the case of an amendment to which subsection 89 (4) or (5) of the Act applies — the date on which the amendment is taken to have been made under that subsection; and
- (b) in any other case — the date of filing of the statement of proposed amendments that resulted in the disclosure referred to in subsection 114 (1) of the Act.

Regulation 3.15

3.15 Prescribed period and form of request for examination

- (1) For the purposes of subsection 44 (1) of the Act, the period of 5 years from the filing date of the complete application is prescribed.
- (2) For the purposes of subsection 44 (1) of the Act, a request for an examination of a patent request and complete specification must be in the approved form.

3.16 Prescribed grounds and period for examination

- (1) For the purposes of subsection 44 (2) of the Act, the following grounds are prescribed:
 - (a) that the Commissioner reasonably considers it expedient to give the direction having regard to the progress made in the examination of applications filed before the filing date of the application concerned;
 - (b) that the Commissioner reasonably considers it to be in the public interest to give the direction;
 - (c) that the Commissioner reasonably considers it expedient to give the direction, having regard to the examination of another application for a standard patent or the examination of an innovation patent.
- (2) For the purposes of subsection 44 (2) of the Act, the prescribed period is 6 months from the day on which the direction was given.
- (3) A direction must be given in writing and state the grounds on which it is given.

3.17 Requirement for Commissioner to direct or expedite examination

- (1) For the purposes of subsection 44 (3) of the Act, a person may, in the approved form, request the Commissioner to direct an applicant for a standard patent to ask for an examination of the patent request and complete specification under subsection 44 (2) of the Act.

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- (2) If an applicant has asked for an examination of the patent request and complete specification to be expedited, the Commissioner may do so if he or she is reasonably satisfied that:
- (a) it is in the public interest; or
 - (b) there are special circumstances that make it desirable.

3.17A Results of documentary searches — foreign patent office

- (1) For subsection 45 (3) of the Act, an applicant informs the Commissioner of the results of documentary searches by or on behalf of a foreign patent office, other than the European Patent Office or the UK Patent Office, by providing:
- (a) a list of documents, cited by the foreign patent office; or
 - (b) a copy of the search report issued by the foreign patent office.
- (2) For paragraph (1) (a), it is not necessary to refer in a list to a document that has been included in a list or report in relation to the application, previously provided to the Commissioner for the Act or these Regulations.
- (3) For subsection 45 (3) of the Act, an applicant informs the Commissioner of the results of documentary searches by or on behalf of the European Patent Office or the UK Patent Office:
- (a) by providing:
 - (i) a list of the documents cited by the patent office; and
 - (ii) for a list provided on or after 26 August 2003 — the symbols used by the patent office to indicate the relevance of the documents; or
 - (b) by providing a copy of the search report issued by the patent office.
- (4) The applicant must inform the Commissioner of the results of a documentary search by the latest of:
- (a) the day 6 months after the search is completed; and
 - (b) the day 6 months after the applicant asks for an examination under section 44 of the Act; and

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- (c) 1 February 2004.
- (5) However:
 - (a) if an applicant applies for an extension of time:
 - (i) after the day applicable to the applicant under subregulation (4); and
 - (ii) on or before the day 3 months after the date on which a notice of acceptance is published under paragraph 49 (5) (b) of the Act;
the period within which the applicant must inform the Commissioner of the results of a documentary search is taken to end on the date on which the application is filed in accordance with subregulation (6); and
 - (b) the applicant may inform the Commissioner of the results of the documentary search on that date.
- (6) An application under subregulation (5) must be filed:
 - (a) in the approved form; and
 - (b) with:
 - (i) the search results; and
 - (ii) the relevant fee in item 239 in Schedule 7.
- (7) If a single application under subregulation (5) relates to more than 1 set of search results:
 - (a) the applicant needs to pay only one fee in respect of all the search results; and
 - (b) the fee is calculated by reference to the search results that require the longest period of extension.
- (8) For subsection 45 (5) of the Act, **completed**, in relation to a search, has the meaning given by regulation 1.3A.

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

- (1) For paragraph 45 (3) (a) of the Act, the following documentary searches by or on behalf of a foreign patent office are prescribed (so that information need not be given to the Commissioner):
 - (a) for any application — a search that produces a nil result;

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- (b) if the application is a PC T application — a search that results in an International Search Report and any additional search conducted during the international preliminary examination;
- (c) if the application (**application A**) is an application which the applicant is permitted to make under subsection 79B (1) of the Act (**a divisional application**):
 - (i) a search, the result of which was disclosed under subsection 45 (3) of the Act in relation to the first-mentioned application for application A under subsection 79B (1) of the Act (**application B**); and
 - (ii) if application B is also a divisional application — a search, the result of which was disclosed under subsection 45 (3) of the Act in relation to the first-mentioned application under subsection 79B (1) of the Act for application B.

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

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

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

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

- (d) if the application is an application for a patent of addition under Chapter 7 of the Act — a search, the result of which was disclosed under subsection 45 (3) of the Act in relation to the application for the main invention;

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- (e) a search, other than a search by or on behalf of the European Patent Office or the UK Patent Office, the result of which:
 - (i) has already been given to the Commissioner under subsection 45 (3) of the Act in relation to the application; or
 - (ii) was contained in the International Search Report;
 - (f) a search, the result of which was not received by the applicant.
- (2) If:
- (a) under subsection 45 (3) of the Act, an applicant was required to inform the Commissioner of the result of a documentary search by or on behalf of a foreign patent office in relation to a patent request; and
 - (b) the applicant did not inform the Commissioner of the result before 22 October 2007; and
 - (c) the latest of the following dates had not occurred before 22 October 2007:
 - (i) the day 6 months after the documentary search is completed within the meaning of regulation 1.3A;
 - (ii) the day 6 months after the applicant asked for the examination in accordance with section 44 of the Act;
 - (iii) if the patent request and complete specification relating to the application were accepted (whether before or after 22 October 2007) — the day 3 months after the notice of acceptance was published in the *Official Journal* under paragraph 49 (5) (b) of the Act;
- the documentary search is prescribed (so that information need not be given to the Commissioner).
- (3) If:
- (a) an applicant asked, in accordance with section 44 of the Act, for an examination of the patent request and complete specification relating to the application for a standard patent; and

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- (b) the applicant asked for the examination on or after 22 October 2007;
all documentary searches by, or on behalf of, a foreign patent office are prescribed (so that information need not be given to the Commissioner).

3.18 Report of Commissioner: examination

- (2) For the purposes of paragraph 45 (1) (d) or 48 (1) (c) of the Act, the following matters are prescribed:
- (a) whether, to the best of the knowledge of the Commissioner, the request and specification comply with the following provisions of the Act:
 - (i) section 15 ('who may be granted a patent?');
 - (ii) section 29 ('application for patent');
 - (iii) section 38 ('time for making complete application');
 - (iv) section 79B (divisional applications prior to grant of patent);
 - (v) section 81 ('grant of patent of addition');
 - (vi) section 94 ('Convention applicants may make Convention applications');
 - (vii) section 95 ('manner of making Convention applications');
 - (c) whether acceptance of the request and specification should be refused under section 50 of the Act ('application or grant may be refused in certain cases');
 - (d) whether the invention is not a patentable invention because of subsection 18 (2) of the Act ('patentable inventions');
 - (e) whether a patent cannot be granted on the application because of subsection 64 (2) of the Act ('grant: multiple applications');
 - (f) whether the applicant is entitled to ask that any action be taken, or that he or she be allowed to take any action, because of subsection 89 (3) of the Act ('modified application of Act').

Regulation 3.19

- (3) For the purposes of paragraph 48 (1) (c) of the Act, the following matters are prescribed:
- (a) in the case of an invention to which section 6 of the Act applies — whether, to the best of the knowledge of the Commissioner, the requirements of section 6 of the Act are satisfied;
 - (b) whether the specification under modified examination is the same as the specification (the *foreign specification*) relating to the patent granted in the prescribed foreign country, apart from:
 - (i) matters of form; or
 - (ii) the omission of a claim that is made in the foreign specification; or
 - (iii) an amendment of a claim that is consequential on an omission referred to in subparagraph (ii); or
 - (iv) an obvious mistake in the foreign specification; or
 - (v) if the micro-organism deposited in respect of the foreign specification is the same micro-organism as that deposited in respect of the specification, a difference relating to matter referred to in paragraph 6 (c) of the Act that is necessary for the application to comply with the deposit requirements.
- (4) If a notice is filed under subsection 27 (1) of the Act before the patent request and complete specification to which the notice relates have been accepted under subsection 49 (1) of the Act, in examining the patent request and complete specification under section 45 or 48 of the Act, the Commissioner must consider a matter stated in the notice that addresses a claim that the invention concerned does not comply with paragraph 18 (1) (b) of the Act.

3.19 Conduct of examination: standard patents

- (1) If the Commissioner reasonably believes that there are lawful grounds of objection to the patent request or complete specification, he or she must state the grounds of objection in reporting on an examination.

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- (2) The applicant may contest the objection in writing or ask for leave to amend the patent request or complete specification in accordance with Chapter 10.
- (3) If the applicant asks for leave to amend a patent request or complete specification in response to, or in anticipation of, a report under section 45 or 48 of the Act, the Commissioner must examine the request and specification and report as if each proposed amendment had been made.
- (4) If the applicant contests the objection, the Commissioner must examine the request and specification and take note of the matters raised by the applicant.

3.20 Requests for deferment of examination or modified examination

- (1) In this regulation:
prescribed foreign country means a country prescribed in regulation 3.21.
- (2) For the purposes of paragraph 46 (1) (b) of the Act, the following applications are prescribed:
 - (a) a basic application in relation to the complete application;
 - (b) an application for a patent that claims the priority of the complete application or a provisional application associated with the complete application under section 38 of the Act;
 - (c) an application for a patent made in a prescribed foreign country that claims the priority of the application that is a basic application in relation to that complete application.
- (3) For the purposes of paragraph 47 (1) (b) of the Act, an application prescribed for the purposes of paragraph 46 (1) (b) of the Act in relation to which a patent in English has been granted in a prescribed foreign country is prescribed.
- (4) For the purposes of paragraph 46 (1) (d) of the Act, the prescribed ground is that the Commissioner reasonably considers it expedient to give the direction, having regard to the progress made in the examination of applications filed before the filing date of the application concerned.

Regulation 3.21

- (5) For the purposes of subsection 46 (2) and subsection 47 (1) of the Act, a request for each action must be in the approved form.
- (6) The applicant must, on request by the Commissioner, file a copy of the specification relating to the patent referred to in paragraph 47 (1) (b) of the Act that is:
 - (a) certified by the competent authority of the prescribed foreign country by which the patent was granted; or
 - (b) otherwise verified to the reasonable satisfaction of the Commissioner;before acceptance, unless the applicant makes a request under subsection 47 (2) of the Act.

3.21 Prescribed foreign countries: requests for deferment of examination and modified examination

For the purposes of paragraphs 46 (1) (b) and 47 (1) (b) of the Act, the following countries are prescribed:

- (a) a country that is a signatory to the treaty done at Munich on 5 October 1973 entitled the Convention on the Grant of European Patents, as in force from time to time;
- (b) Canada;
- (c) New Zealand (excluding the Cook Islands, Niue and Tokelau);
- (d) United States of America (including all territories and possessions and the Commonwealth of Puerto Rico).

3.22 Disclosure of patent documents and information to International Bureau etc

- (1) The Commissioner may disclose any or all of the following to the International Bureau or a foreign patent office:
 - (a) the patent application or patent;
 - (b) a document given by the applicant, or another person, to the Commissioner in connection with the patent application or patent;
 - (c) a document in the Commissioner's possession that relates to the patent application or the application of the patent;

Regulation 3.22

- (d) any information in the Commissioner's possession that relates to a document mentioned in paragraph (a), (b) or (c);

whether or not the application is open for public inspection.

- (2) However, if the patent application, document or information is not open for public inspection, the Commissioner must not disclose the application, document or information without the consent of the applicant.

Note Section 194 of the Act also authorises the Commissioner to give a person certain information about patents, patent applications and other documents in certain circumstances.

- (3) The Commissioner may disclose the patent application, document or information by depositing it in an approved digital library or by any other means.

Regulation 3.23

Part 2 Inventions that are micro-organisms

3.23 Documents in accepted applications and patents involving micro-organisms

- (1) Where a micro-organism is deposited with a prescribed depositary institution for the purposes of section 41 of the Act, the following documents must be filed in relation to an application that has been accepted under section 49 or 52 of the Act or a patent in respect of the micro-organism:
 - (a) if the deposit is an original deposit within the meaning of Rule 7.3 of the Budapest Treaty or a new deposit within the meaning of Rule 7.4 of that Treaty — a copy of a receipt issued by the institution under Rule 7 of the Treaty;
 - (b) if samples of the micro-organism were transferred to that institution under Rule 5.1 (a) (i) of the Treaty — a copy of a receipt issued by the institution under Rule 7 of the Treaty;
 - (c) if a receipt referred to in paragraph (a) or (b) is not in English — a translation of the receipt into English and a related certificate of verification.
- (2) The documents referred to in subregulation (1) must be filed within 3 months from the date of receipt of the micro-organism by the prescribed depositary institution.

3.24 Commissioner may request samples and viability statement

- (1) If, in relation to a patent application or patent in respect of a micro-organism, the micro-organism is deposited with a prescribed depositary institution, the Commissioner:
 - (a) on the order of a court in Australia, must; or

Regulation 3.25

- (b) on his or her own motion or on application in writing by another person, may;
for the purposes of proceedings before the Commissioner or any other legal proceedings in Australia:
 - (c) make to that institution a request referred to in Rule 11.1 of the Budapest Treaty for a sample of that micro-organism; and
 - (d) in relation to that micro-organism, make the declaration referred to in that Rule.
- (2) Before making a request, the Commissioner must give the applicant or patentee concerned, and any other person who apparently has an interest in the request, an opportunity to be heard, unless the request is made on the order of a court.
 - (3) If the Commissioner decides to make, or to refuse to make, a request, he or she must inform the applicant or patentee concerned, and any other person who apparently has an interest in the request, of the decision, and of the reasons for the decision, by notice in writing as soon as practicable after the decision.
 - (4) The Commissioner may make a request referred to in Rule 10.2 (a) (iii) of the Budapest Treaty for a statement concerning the viability of a micro-organism if a sample of the micro-organism has been given to the Commissioner in accordance with a request under subregulation (1).

3.25 Request for Commissioner's certificate authorising release of sample of a micro-organism

- (1) If a micro-organism is deposited with a prescribed depositary institution, a person may, in the approved form, request the Commissioner to grant the certification referred to in Rule 11.3 (a) of the Budapest Treaty in respect of the deposit.
- (2) As soon as practicable after receiving a request, the Commissioner must decide whether to:
 - (a) comply with the request; or

Regulation 3.25

- (b) impose such conditions as are reasonable, including a condition that the person give security for damages for any breach of the undertaking referred to in paragraph (4) (c) given by:
 - (i) the person; or
 - (ii) another person who has been nominated as a skilled addressee; or
 - (c) refuse that request.
- (3) If the application is for a standard patent, the applicant may, at any time before the specification relating to the application is open for public inspection, notify the Commissioner that a sample of the deposited micro-organism is only to be provided in a period mentioned in subregulation (3A) to a person who is:
 - (a) a skilled addressee without an interest in the invention; and
 - (b) nominated by the person who made the request.
- (3A) For subregulation (3), the period is:
 - (a) before the patent is granted on that application; or
 - (b) before the application has lapsed or been withdrawn or refused.
- (4) The Commissioner must comply with a request in respect of a patent application or patent:
 - (a) if the specification relating to that application or patent is open to public inspection; and
 - (b) unless the Commissioner is reasonably satisfied that the nominated person is not entitled to rely on the deposit for the purposes of the Act; and
 - (c) if the person making the request or the person nominated as a skilled addressee has undertaken to use that micro-organism only for experimental purposes or in relation to:
 - (i) opposition proceedings under Chapter 5 of the Act in relation to the grant of a standard patent on that application; or
 - (ii) opposition proceedings under section 101M of the Act in relation to an innovation patent; or

Regulation 3.25

- (iii) relevant proceedings in relation to the patent;
and not to make that micro-organism, or a culture derived
from that micro-organism, available to another person; and
- (d) unless the Commissioner is reasonably satisfied that the
undertaking given by the person making the request or the
person nominated as a skilled addressee was not given in
good faith; and
- (e) if:
 - (i) the Commissioner has been notified under
subregulation (3); and
 - (ii) the patent referred to in that subregulation has not
been granted; and
 - (iii) the application referred to in that subregulation has
not lapsed or been withdrawn or refused; and
 - (iv) the Commissioner is reasonably satisfied that the
person nominated as a skilled addressee is a skilled
addressee without an interest in the invention; and
- (f) if:
 - (i) the request is in respect of a patent; and
 - (ii) the person making that request is a person to whom
the patentee has granted a licence under section 133
of the Act; and
 - (iii) the Commissioner is reasonably satisfied that the
licence provides that the person making the request
has a right to obtain a sample of that
micro-organism; and
- (g) if:
 - (i) the request is in respect of a patent; and
 - (ii) the person making that request is a person who may
exploit the invention under section 163 of the Act;
and
 - (iii) the Commissioner is reasonably satisfied that the
terms for the exploitation of the invention provide
that the person making the request has a right to
obtain a sample of that micro-organism.

Regulation 3.26

- (5) Before making a decision under subregulation (2), the Commissioner must give the person making the request, the applicant or patentee concerned and any other person who apparently has an interest in the request, an opportunity to be heard.
- (6) If the Commissioner makes a decision under subregulation (2), he or she must inform the person who made the request, the applicant or patentee concerned and any other person who apparently has an interest in the request, of the decision, and the reasons for the decision, by notice in writing given as soon as practicable after the date of the decision.

3.26 Breach of undertakings given in respect of micro-organisms

- (1) Where the micro-organism is deposited with a prescribed depositary institution, proceedings for breach of an undertaking referred to in paragraph 3.25 (4) (c) may be instituted in a prescribed court by a person who is:
 - (a) if a patent has not been granted on that patent application — the applicant; or
 - (b) if:
 - (i) a patent has been granted on that patent application; or
 - (ii) the deposit is effected in relation to a patent; the patentee of, or an exclusive licensee under, that patent.
- (2) In proceedings by an exclusive licensee, the patentee must be a party to the proceedings.
- (3) A patentee joined as a defendant in the proceedings by an exclusive licensee is not liable for costs unless the patentee enters an appearance and takes part in the proceedings.
- (4) It is a defence in proceedings for breach of the undertaking given in respect of a micro-organism to which a specification filed in respect of a patent application or patent relates, that when the matter complained of took place the specification did not comply with the requirements referred to in paragraph 6 (c) or (d) of the Act.

Regulation 3.28

- (5) A defendant may not plead a defence referred to in subregulation (4) unless:
- (a) the defendant, before becoming a defendant in the proceedings, notified the Commissioner under paragraph 3.29 (1) of the deposit requirement that has ceased to be satisfied; and
 - (b) the applicant for the patent or the patentee fails to take the steps referred to in paragraph 41 (4) (b) of the Act within the appropriate period prescribed by subregulation 3.30 (1) for the purposes of that paragraph.

3.27 Procedure in proceedings for breach of an undertaking

In proceedings referred to in subregulation 3.26 (1) for breach of an undertaking:

- (a) the plaintiff must deliver particulars of the breach as complained of:
 - (i) with the statement of claim or declaration; or
 - (ii) by order of the court, at a later time; and
- (b) the defendant must deliver particulars of any objections on which the defendant relies:
 - (i) with the statement of defence or plea; or
 - (ii) by order of the court, at a later time.

3.28 Relief in proceedings for breach of undertakings

- (1) In proceedings referred to in subregulation 3.26 (1), the court may:
 - (a) make an order for inspection; and
 - (b) impose terms and give directions with respect to the inspection.
- (2) In proceedings referred to in subregulation 3.26 (1), the court may grant such relief as it thinks fit, including:
 - (a) an injunction on such terms as it thinks fit; or
 - (b) an order for damages; or
 - (c) an order for an account of profits; or

Regulation 3.29

- (d) an order with respect to any security given under paragraph 3.25 (2) (b); or
- (e) an order on such terms as it thinks fit to deliver to such person as it thinks fit the micro-organism or any substance or thing derived directly or indirectly from that micro-organism as a result of the breach of the undertaking, including:
 - (i) any products made by using that micro-organism; and
 - (ii) any other micro-organisms derived from that micro-organism; and
 - (iii) any products made by using those other micro-organisms.

3.29 Notification that a deposit requirement has ceased to be satisfied

- (1) If a deposit requirement ceases to be satisfied in relation to a micro-organism to which a specification filed in respect of a patent application or patent relates, a person other than the applicant or patentee may, after the specification has become open to public inspection, notify the Commissioner in the approved form of the requirement referred to in paragraph 6 (c) or (d) of the Act that has ceased to be satisfied.
- (2) As soon as practicable after receiving a notice under subregulation (1), the Commissioner must give a copy of the notice to the applicant or patentee.
- (3) If the Commissioner learns, otherwise than by a notice referred to in subregulation (1), of facts that may establish that a requirement referred to in that subregulation has ceased to be satisfied, the Commissioner must cause a notice setting out those facts to be given to the applicant or patentee.
- (4) As soon as practicable after the Commissioner receives a notice under subregulation (1) or gives a notice under subregulation (3), a notice of the receipt or giving of that notification must be published in the *Official Journal*.

Regulation 3.30

- (5) The terms of a notice under subregulation (1) or (3) need not be published, but the notice must be open to public inspection.
- (6) The applicant or patentee may file a written reply setting out the facts relied upon to establish that the requirement referred to in subregulation (1) is satisfied.
- (7) If a reply filed under subregulation (6) is in answer to a notification under subregulation (1) by a person, the Commissioner must, as soon as practicable after receiving the reply, give a copy of the reply to that person.
- (8) As soon as practicable after a reply is filed under subregulation (6), a notice of the filing must be published in the *Official Journal*.
- (9) The terms of a reply filed under subregulation (6) need not be published, but the reply must be open to public inspection.

3.30 Prescribed period: deposit requirements taken to be satisfied

For the purposes of paragraph 41 (4) (b) of the Act, if, in relation to a patent application or patent relating to a micro-organism:

- (a) that micro-organism is deposited with a prescribed depositary institution; and
- (b) a requirement referred to in paragraph 6 (c) or (d) of the Act ceases to be satisfied in relation to the micro-organism;

the prescribed period is from the day when the requirement ceases to be so satisfied to the end of:

- (c) where the step referred to in paragraph 41 (4) (b) of the Act is the making of a new deposit of a sample of the micro-organism:
 - (i) if the Commissioner has given under subregulation 3.29 (2) the applicant or patentee a copy of a notice of that requirement — the period of 3 months after the copy was given; or

Regulation 3.30

- (ii) if the Commissioner has given under subregulation 3.29 (3) to the applicant or patentee a notice of the requirement — the period of 3 months after the notice was given; or
 - (iii) if under Article 4 (1) of the Budapest Treaty the authority has notified the depositor of its inability to furnish samples of the micro-organism and the Commissioner has not, before the notification, given to the applicant or patentee under subregulation 3.29 (2) or (3) a copy of the notice, or the notice, as the case may be, of the requirement — the period of 3 months after the depositor received that notification under Article 4 (1) (d) of the Treaty; or
 - (iv) in any other case — the day when that new deposit is so made; or
- (d) where the step referred to in paragraph 41 (4) (b) of the Act is an amendment of the specification in respect of that patent application or patent — the date of the allowance of the amendment, unless:
 - (i) the Commissioner has given the applicant or patentee a copy of a notice under subregulation 3.29 (2) or a notice under subregulation 3.29 (3), and the applicant or patentee has not asked for leave to amend the specification within the period of 3 months after the copy or the notice was given; or
 - (ii) the authority has notified the depositor under Article 4 (1) of the Budapest Treaty of its inability to furnish samples of the micro-organism and:
 - (A) the Commissioner has not, before the notification, given to the applicant or patentee under subregulation 3.29 (2) or (3) the notice, or a copy of the notice, as the case may be, of the requirement; and
 - (B) the applicant or patentee has not asked for leave to amend the specification within the period of 3 months after the depositor received the notification under Article 4 (1) (d) of the Treaty.

Regulation 3.31

3.31 Application for declaration that deposit requirements are not satisfied

- (1) An application under section 42 of the Act for a declaration that a specification does not comply with section 40 of the Act unless the deposit requirements are satisfied in relation to a micro-organism, must:
 - (a) be made in the approved form to a prescribed court or the Commissioner; and
 - (b) be lodged at the court or filed.
- (2) A person who applies for a declaration under section 42 of the Act must give a copy of the application:
 - (a) to the applicant or patentee; and
 - (b) to such other person as the court or Commissioner directs.
- (3) If the Commissioner on his or her own motion proposes to declare under section 42 of the Act that the specification in respect of a patent application or patent does not comply with the requirements of section 40 of the Act unless the deposit requirements are satisfied in relation to a micro-organism, he or she must give to the applicant or patentee a statement of the facts relied upon to justify the making of that declaration.
- (4) A person to whom:
 - (a) a copy of an application under subregulation (2); or
 - (b) a statement under subregulation (3);has been given:
 - (c) may, within 3 months, give to the court to which the application is made or to the Commissioner a reply to that application or statement; and
 - (d) must give a copy of the reply to the applicant or patentee and to such other persons as the court or the Commissioner directs.
- (5) As soon as practicable after:
 - (a) a copy of a declaration by a court under subsection 42 (1) of the Act is given to the Commissioner under subsection 42 (6) of the Act; or

Regulation 3.31

- (b) the making of a decision of the Commissioner under subsection 42 (1) of the Act;
notice of the making of the declaration or decision must be published in the *Official Journal*.
- (6) The terms of a declaration or decision referred to in subregulation (5) need not be published, but the declaration or decision must be open to public inspection.

Chapter 4 Publication

4.1 Prescribed information: applicants and applications

For the purposes of section 53 of the Act, the following information is prescribed:

- (a) the number allocated to the application by the Commissioner;
- (b) the name of the applicant;
- (c) in the case of a complete application — the name of the nominated person;
- (d) the title, or an abbreviated title, of the invention;
- (e) the date on which the application was filed;
- (f) in the case of a complete application, other than a PCT application — particulars of priority documents.

4.2 Notice that specification is open to public inspection

- (1) A request under subsection 54 (1) of the Act must be in the approved form.
- (2) For the purposes of subsection 54 (1) of the Act, the Commissioner must publish the notice as soon as practicable after:
 - (a) being asked by the applicant to publish the notice; and
 - (b) the relevant abstract is finally completed; and
 - (c) if a direction has been given under subregulation 3.2A (2) — the direction has been complied with.
- (3) For the purposes of paragraph 54 (3) (b) of the Act, the prescribed period is from the day of filing of the specification to the end of 18 months after:
 - (a) that day; or

Regulation 4.3

- (b) the date of making the earliest priority document referred to in regulation 3.12;
whichever is earlier.

4.3 Prescribed documents: public inspection

- (1) For subsection 55 (1) of the Act, all documents that are:
 - (a) associated with the application, or with any provisional application associated with the application; and
 - (b) in the possession of the Patent Office;are prescribed, other than:
 - (c) documents that would be privileged from production in legal proceedings on the ground of legal professional privilege; and
 - (e) the documents mentioned in subregulation (2).
- (2) For paragraphs 55 (2) (a), (b) and (c) of the Act, the following documents are prescribed:
 - (a) a document that is subject to an order of a court or a tribunal that prohibits disclosure of the document or information in the document;
 - (b) a document required to be produced under paragraph 210 (c) of the Act, if the Commissioner has reasonable grounds for believing that the document or information in the document should not be open to public inspection;
 - (c) a document that contains information from a document to which paragraph (b) applies.

Chapter 5 Opposition

5.1 Application of this Chapter

This Chapter applies if a notice of opposition has been filed for the purposes of:

- (a) the following provisions of the Act:
 - (i) section 59 ('opposition to grant of standard patent');
 - (ii) section 75 (opposition to grant of extension);
 - (iii) section 101M (opposition to innovation patent);
 - (iv) subsection 104 (4) (amendments by applicants and patentees), unless the request for leave to amend is in response to a direction of the Commissioner under section 106 (amendments directed by Commissioner: patents) or section 107 (amendments directed by Commissioner: applications for standard patents);
 - (v) subsection 223 (6) (extensions of time); or
- (b) subregulation 22.21 (4) ('protection or compensation of certain persons') or 10.7 (4) ('correction of Register or patent').

5.2 Interpretation

In this Chapter:

applicant means:

- (a) in relation to an opposition under section 101M of the Act — the patentee of the innovation patent; and
- (b) in relation to another opposition — a person who has filed an application or request in respect of which another person has filed a notice of opposition.

opponent means a person who has filed a notice of opposition.

party means applicant or opponent.

Regulation 5.3

5.3 Filing of opposition (except under section 101M of the Act)

- (1) The Minister or other person who intends to oppose the grant of a patent under section 59 of the Act must file a notice of opposition in the approved form within 3 months of publication in the *Official Journal* of the notice of acceptance under section 49 of the Act.
- (2) The Minister or other person who intends to oppose the grant of an extension of the term of a standard patent under section 75 of the Act must file a notice of opposition in the approved form within 3 months of publication in the *Official Journal* of the notice of acceptance under section 74 of the Act.
- (3) The Minister or other person who intends to oppose allowing an amendment under subsection 104 (4) of the Act must file a notice of opposition in the approved form within 3 months of publication in the *Official Journal* of a notice referred to in subregulation 10.5 (2).
- (4) A person must not oppose the allowance of a proposed amendment of a complete specification, except on the grounds that the amendment is not allowable under section 102 of the Act.
- (5) A person who intends to oppose the grant of an application for an extension of time under subsection 223 (6) of the Act must file a notice of opposition in the approved form within 1 month of the advertisement of the application in the *Official Journal*.
- (5A) A person who intends to oppose a request for amendment of the Register or a patent under subregulation 10.7 (4) must file a notice of opposition in the approved form within 3 months of the publication in the *Official Journal* of the notice referred to in subregulation 10.7 (3).
- (6) A person:
 - (a) on whom a copy of an application for a licence in accordance with subregulation 22.21 (3) has been served; and

Regulation 5.3A

(b) who intends to oppose the grant of the licence;
must file a notice of opposition to the grant of the licence in the approved form within 1 month from the day on which the copy was served on him or her.

- (7) As soon as practicable after a notice of opposition is filed, the opponent must serve a copy of the notice on the applicant.

5.3AA Filing of opposition under section 101M of Act

- (1) The Minister or other person who intends to oppose an innovation patent under section 101M of the Act must file a notice of opposition in the approved form.
- (2) The notice may be filed at any time after the innovation patent is certified.
- (3) The opponent must file with the notice of opposition a statement that sets out the grounds of opposition and the particulars relating to each ground.
- (4) Within 7 days of filing the notice and the statement, the opponent must serve a copy of the notice and statement on the applicant.

5.3A Amendment of notice of opposition: correction of error or mistake

- (1) An opponent may request the Commissioner in writing to amend a notice of opposition for the purpose of correcting a clerical error or obvious mistake.
- (2) The Commissioner may grant the request on the terms (if any) that the Commissioner specifies by notice to the opponent making the request.
- (3) The Commissioner must give the parties an opportunity to make representations concerning the proposed amendment.
- (4) If the Commissioner allows an amendment, he or she must give the applicant a copy of the notice as amended.

Regulation 5.3B

5.3B Amendment of notice of opposition: change of opponent

- (1) This regulation applies if a person files a notice of opposition and the right or interest on which he or she relied to file the notice is subsequently vested in another person (the *new opponent*).
- (2) The new opponent may give to the Commissioner notice, in writing, that the right or interest is vested in him or her and request the Commissioner, in writing, to amend the notice of opposition to record his or her name.
- (3) The Commissioner may grant the request on the terms (if any) that the Commissioner specifies by written notice to the new opponent.
- (4) The Commissioner must give to the parties to the opposition the opportunity to make representations concerning the proposed amendment.
- (5) If the Commissioner allows the amendment:
 - (a) he or she must give the applicant a copy of the notice of opposition as amended; and
 - (b) the opposition is to proceed in the name of the new opponent.

5.4 Filing of statement

An opponent (except an opponent under section 101M of the Act) must:

- (a) within 3 months of filing the notice of opposition, serve on the applicant a copy of a statement that sets out the grounds of opposition, and the particulars relating to each ground; and
- (b) as soon as practicable after the copy of the statement has been served on the applicant, file the statement.

5.5 Dismissal of opposition

- (1) An applicant may:

Regulation 5.6

- (a) within 1 month of being served with a copy of a statement by an opponent under paragraph 5.4 (a); or
 - (b) if the complete specification in relation to an opposed application is re-examined under subsection 97 (1) of the Act — within 1 month from the day when the re-examination is completed under regulation 9.5; request the Commissioner in the approved form to dismiss the opposition.
- (2) As soon as practicable after a request is made, the Commissioner must inform the opponent of the request having been made.
 - (3) The Commissioner may dismiss the opposition whether or not the applicant has requested dismissal of the opposition.
 - (4) Without limiting subregulation (3), the Commissioner may dismiss the opposition:
 - (a) for an opposition under section 101 M of the Act — if the statement of grounds and particulars is not filed with the notice of opposition; or
 - (b) for another opposition — if the statement of grounds and particulars is not served within the period prescribed in paragraph 5.4 (a).

5.6 Determination of opposition

- (1) If the complete specification in relation to an opposed application is re-examined under subsection 97 (1) of the Act, the opponent may, within 1 month from the day when the re-examination is completed under regulation 9.5, request the Commissioner in the approved form to determine the opposition.
- (2) As soon as practicable after a request is made, the Commissioner must inform the applicant of the request having been made.
- (3) The Commissioner may determine the opposition whether or not the opponent has requested determination of the opposition.

Regulation 5.7

5.7 Opponent to serve copy of substitute statement

If the specification in relation to the opposed application is re-examined under subsection 97 (1) of the Act:

- (a) the opponent may, within 1 month from the day when the re-examination is completed under regulation 9.5, serve on the applicant a copy of a statement in substitution for the statement to which paragraph 5.4 (a) relates; and
- (b) if a copy of a substitute statement is served on the applicant, the opponent must, as soon as practicable after the copy of the statement has been so served, file that statement.

5.8 Time for giving of evidence

- (1) If an opponent intends to rely on evidence in support of the opposition, the opponent must:
 - (a) serve on the applicant a copy of any evidence in support of the opposition:
 - (i) for an opposition under section 101 M of the Act — at the same time as the opponent serves on the applicant the notice of opposition and the statement of grounds and particulars; or
 - (ii) for another opposition — within the period mentioned in subregulation (1A); and
 - (b) file the evidence in support of the opposition as soon as practicable after the copy of the evidence has been served on the applicant.
- (1A) For subparagraph (1) (a) (ii), the period is within 3 months after the day when the opponent served on the applicant a copy of the statement mentioned in paragraph 5.4 (a).
- (2) Subject to subregulation (3), if an applicant intends to rely on evidence in answer to the evidence in support of the opposition, the applicant must:
 - (a) serve on the opponent a copy of any evidence in answer to the evidence in support of the opposition within 3 months after being served with that evidence in support of the opposition; and

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- (b) file the evidence in answer as soon as practicable after the copy of the evidence has been served on the opponent.
- (3) If an opponent has not served on an applicant a copy of evidence in support of the opposition and the applicant intends to rely on evidence in answer to the opposition, the applicant must:
 - (a) serve on the opponent a copy of any evidence in answer to the opposition within 3 months from:
 - (i) for an opposition under section 101 M of the Act — the day the notice of opposition was served on the applicant; or
 - (ii) for another opposition — the end of the period that applies under subparagraph (1) (a) (ii); and
 - (b) file the evidence in answer as soon as practicable after the copy of the evidence has been served on the opponent.
- (4) If an opponent intends to rely on evidence in reply to the evidence referred to in paragraph (2) (a) or (3) (a), the opponent must:
 - (a) within 1 month of being served with a copy of the evidence under paragraph (2) (a) or (3) (a), serve on the applicant:
 - (i) a copy of the evidence in reply; or
 - (ii) if the opponent does not serve on the applicant a copy of the evidence in reply — a copy of a notice of intention to serve evidence in reply; and
 - (b) if the opponent serves on the applicant a copy of a notice of intention to serve evidence in reply — serve on the applicant a copy of that evidence within 3 months of being served with a copy of the evidence under paragraph (2) (a) or (3) (a); and
 - (c) file the evidence in reply and any notice of intention as soon as practicable after the copy of the evidence in reply or notice has been served on the applicant.

Regulation 5.9

5.9 Amendment of statement

- (1) Subject to subregulation (2), the Commissioner, on the written request of an opponent and subject to such terms as the Commissioner may specify:
 - (a) if the Commissioner reasonably believes that an amendment of a statement referred to in regulation 5.4 corrects an error or omission by the opponent or by his or her agent — may amend the grounds of opposition set out in the statement; or
 - (b) if the Commissioner reasonably believes that an amendment of the grounds set out in a statement that is served and filed under regulation 5.4 results from an amendment of a patent request or complete specification — must amend those grounds; or
 - (c) must amend particulars relating to a ground set out in a statement that is served and filed under regulation 5.4.
- (2) The Commissioner must not allow an amendment requested under subregulation (1), if:
 - (a) an application for dismissal of opposition is being considered; or
 - (b) an application for determination of opposition is being considered; or
 - (c) in the case of opposition under section 59 of the Act — a specification relating to the opposed application is being re-examined; or
 - (d) he or she does not reasonably believe that the applicant has been notified of the proposed amendment.
- (3) The Commissioner must give the parties an opportunity to make representations concerning the proposed amendment.
- (4) If the Commissioner allows an amendment, he or she must give the applicant a copy of the statement as amended.

Regulation 5.9A

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

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

Regulation 5.10

5.10 Conduct of proceedings to which this Chapter applies

- (1) The Commissioner may, on his or her own motion or on the application of a party:
 - (a) give a direction that is not inconsistent with the Act or these regulations for the conduct of proceedings to which this Chapter applies; or
 - (b) determine that a period prescribed in this Chapter (except in regulation 5.3 or 5.3AA, paragraph 5.4 (a), subparagraph 5.8 (1) (a) (i) or regulation 5.9A) is to be extended by such further period as the Commissioner reasonably allows.
- (2) The Commissioner may extend the time within which the party may take a step prescribed in this Chapter (not being a step that is taken under regulation 5.3 or 5.3AA, paragraph 5.4 (a), subparagraph 5.8 (1) (a) (i) or regulation 5.9A):
 - (a) on the application of a party in the approved form; and
 - (b) on such reasonable terms (if any) as the Commissioner specifies; and
 - (c) after the party has served a copy of the application on the other party.
- (3) If section 107 of the Act applies to an opposed application, the time within which a party may take a step prescribed in this Chapter is extended by a period that is equal to the period from the day when the applicant is given an opportunity to be heard that is referred to in subsection 107 (2) of the Act to the end of the day when the decision is made under 107 (4) of the Act whether or not the amendment is allowed.
- (4) The Commissioner may:
 - (a) on the application of a party; and
 - (b) on such reasonable terms (if any) as the Commissioner specifies;permit the party to serve further evidence on the other party.

Regulation 5.12

- (5) The Commissioner must not give a direction under subregulation (1) or grant an application under subregulation (2) or (4) unless the Commissioner:
 - (a) if he or she proposes to grant an application by a party — is reasonably satisfied that the other party has been notified of the application; and
 - (b) if he or she proposes to act on his or her own motion — ensures that the parties are notified of the proposed action; and
 - (c) in either case:
 - (i) gives the parties a reasonable opportunity to make representations concerning the application or proposed action; and
 - (ii) is reasonably satisfied that a direction, an extension of time or the serving of further evidence is appropriate in all the circumstances.

5.11 Commissioner may inform himself or herself

- (1) The Commissioner may inform himself or herself of a fact by reference to a document available in the Patent Office.
- (2) If the Commissioner proposes to refer to a document under subregulation (1), he or she must:
 - (a) notify the parties accordingly; and
 - (b) give the parties a copy of, or access to, the document; and
 - (c) give the parties an opportunity to give evidence or make representations with respect to the fact or document.
- (3) In subregulation (2), **document** does not include a document filed under regulation 5.3AA, 5.4 or 5.8, or further evidence referred to in subregulation 5.10 (4).

5.12 Hearing of opposition

- (1) This regulation applies if the relevant periods prescribed in regulation 5.8 have ended, unless:
 - (a) the opposition has been dismissed or determined; or
 - (b) the notice has been withdrawn.

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- (2) The Commissioner must, if he or she receives a request by a party to hold a hearing:
 - (a) give a notice of a hearing into the opposition; and
 - (b) hold the hearing.
- (3) The Commissioner may, on his or her own motion:
 - (a) give a notice of a hearing into the opposition; and
 - (b) hold the hearing.

5.13 Representations to Commissioner

A representation mentioned in any of the following provisions may be made to the Commissioner in writing or by any other means approved by the Commissioner:

- (a) subregulation 5.3A (3);
- (b) subregulation 5.3B (4);
- (c) subregulation 5.9 (3);
- (d) subparagraph 5.10 (5) (c) (i);
- (e) paragraph 5.11 (2) (c).

5.14 Commissioner not required to hold hearing

If the Commissioner believes, on reasonable grounds, that no party wishes to be heard in a matter arising under regulation 5.12 or 5.13, the Commissioner is not required to hold a hearing.

5.15 Withdrawal of opposition

An opponent may at any time withdraw opposition by:

- (a) filing a written notice of withdrawal that is signed by him or her; and
- (b) serving a copy of the notice on the applicant.

Chapter 6 Grant and term of patents

Part 1 Patents generally

6.1 Publication of notice of grant of standard patent

If a standard patent is granted under section 61 of the Act, the Commissioner must publish a notice that the patent has been granted in the *Official Journal*.

6.2 Prescribed period: grant of standard patent

- (1) For the purposes of subsection 61 (2) of the Act, the prescribed period is from 3 months after publication under paragraph 49 (5) (b) of the Act of the notice of the acceptance of the request and complete specification to:
 - (a) 6 months after that publication; or
 - (b) such later day as:
 - (i) in the case of proceedings before a court or the Tribunal — the court or Tribunal directs; or
 - (ii) in any other case — the Commissioner reasonably directs;
being satisfied that the grant of the patent should be postponed.
- (2) A person may request the Commissioner in the approved form to give a direction referred to in subparagraph (1) (b) (ii).

6.3 Date of patent

- (1) For paragraph 65 (b) of the Act, the date of a patent is as set out in this regulation.

Regulation 6.3

- (2) For a patent granted under subsection 33 (1) or (2) of the Act, the date of the patent is the date that would have been the date of the patent if the patent had been granted on the application for a standard patent the grant of which was opposed under section 59 of the Act.
- (3) For a patent granted under subsection 33 (3) or (4) of the Act, the date of the patent is the date of the innovation patent that was opposed under section 101M of the Act.
- (4) For a patent granted under subsection 34 (2) of the Act, the date of the patent is the date of the patent referred to in subsection 34 (1) of the Act.
- (5) For a patent granted under section 35 of the Act, the date of the patent is the date of the revoked patent.
- (6) For a patent granted as a result of a declaration under section 36 of the Act, the date of the patent is:
 - (a) if the declaration is made in respect of a complete application — the date that would have been the date of the patent if the patent had been granted on that application; or
 - (b) if the declaration is made in respect of a provisional application — the earlier of:
 - (i) the date 12 months from the date of filing of the provisional specification in respect of that application; and
 - (ii) the date of filing of the complete application referred to in subsection 36 (4) of the Act.
- (7) For a patent granted on a divisional application made under subsection 79B (1) of the Act, the date of the patent is:
 - (a) if the date of the patent was recorded in the Register before 1 January 2000 — the date recorded in the Register; or
 - (b) if the Commissioner determined a date of the patent and told the applicant in writing before 1 January 2000 — the date determined by the Commissioner; or

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- (c) in any other case — the earliest of:
 - (i) the date of the patent of the first-mentioned application referred to in subsection 79B (1) of the Act; and
 - (ii) the date that would be the date of the patent if a patent had been granted on that first-mentioned application; and
 - (iii) if that first-mentioned application was itself a divisional application or was amended to be a divisional application before filing the later application — the date that would be the date of the patent if a patent had been granted on the divisional application.
- (8) For an innovation patent granted on a divisional application made under subsection 79C (1) of the Act, the date of the patent is the date of the first patent mentioned in subsection 79C (1).
- (9) If, under section 223 of the Act, the Commissioner has extended the time for making, under section 38 of the Act, a complete application associated with a provisional application, the date of the patent is the date 12 months from the date of making the first provisional application with which the complete application is associated.
- (10) If, under section 223 of the Act, the Commissioner has extended the time for making, under section 94 of the Act, a Convention application in relation to a basic application, the date of the patent is the date 12 months from the date of making the first basic application to which the Convention application relates.

6.4 Form of application for sealing of duplicate of patent

An application for the sealing of a duplicate of a patent under section 66 of the Act must be in the approved form.

Regulation 6.7

Part 2 Extension of pharmaceutical patents

6.7 Definitions

In this Part:

pre-TGA marketing approval has the same meaning as in section 70 of the Act.

6.8 Information to accompany application

- (1) This regulation applies to an application under section 70 of the Act for an extension of the term of a standard patent for a pharmaceutical substance.
- (2) For paragraph 71 (1) (c) of the Act, the application must be accompanied by information showing that goods containing, or consisting of, the substance are currently included in the Australian Register of Therapeutic Goods.
- (3) The application must also be accompanied by information identifying the substance, as it occurs in those goods, in the same way (as far as possible) as the substance is identified in the complete specification of the patent.

6.9 Application without pre-TGA marketing approval

- (1) This regulation applies to an application under section 70 of the Act for an extension of the term of a standard patent for a pharmaceutical substance for which pre-TGA marketing approval has not been given.
- (2) For paragraphs 71 (1) (b) and (c) of the Act, the application must be accompanied by:
 - (a) a certificate under paragraph 25 (3) (b) or subsection 26 (4) or 26A (9) of the *Therapeutic Goods Act 1989* stating the date of commencement of the first inclusion in

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- the Australian Register of Therapeutic Goods of goods that contain, or consist of, the substance; or
- (b) if the patentee does not have a certificate mentioned in paragraph (a) — information showing the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, the substance.

Note For providing a copy of a certificate mentioned in paragraph (2) (a), see the definition of **document** in subsection 71 (1) of the Act.

6.10 Application with pre-TGA marketing approval

- (1) This regulation applies to an application under section 70 of the Act for an extension of the term of a standard patent for a pharmaceutical substance for which pre-TGA marketing approval has been given.
- (2) For paragraphs 71 (1) (b) and (c) of the Act, the application must be accompanied by:
- (a) a written statement by the person who gave the approval showing:
- (i) that approval has been given; and
- (ii) the date of the first approval; or
- (b) if the patentee does not have a written statement mentioned in paragraph (a) — information showing:
- (i) that approval has been given; and
- (ii) the date of the first approval.

Note For providing a copy of a written statement mentioned in paragraph (2) (a), see the definition of **document** in subsection 71 (1) of the Act.

6.11 Further information

- (1) This regulation applies if the Commissioner needs further information to decide whether he or she is satisfied that the requirements set out in sections 70 and 71 of the Act are satisfied for an application for an extension of the term of a standard patent.

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- (2) The Commissioner may give the applicant a notice requesting the further information within the period mentioned in the notice.
- (3) The period must not be shorter than 2 months or longer than 6 months from the day the notice is issued.

Note The period for giving the further information can be extended — see section 223 of the Act.

- (4) If the applicant does not give the further information within that period, the Commissioner must decide whether he or she is satisfied that the requirements set out in sections 70 and 71 of the Act are satisfied.
- (5) For subsection 71 (2) of the Act, further information given within the period mentioned in subregulation (2) is taken to have been filed with the application for extension of the term of the standard patent.

Chapter 6A Divisional applications

6A.1 Divisional applications: standard patents

For section 79B of the Act, a divisional application must be made:

- (a) under section 29 of the Act; and
- (b) before the date of the grant of a patent on the first-mentioned application in section 79B of the Act.

6A.2 Divisional applications: innovation patents

- (1) For subsection 79C (1) of the Act, a divisional application must be made in accordance with section 29 of the Act.
- (2) For subparagraph 79C (2) (b) (iv) of the Act, the prescribed period is 1 month from the day on which the Commissioner publishes, under paragraph 101E (d) of the Act, a notice of the occurrence of the examination of the first patent mentioned in subsection 79C (1) of the Act.

Regulation 7.1

Chapter 7 Patents of addition

7.1 Form of application for grant of patent of addition etc

- (1) For paragraph 81 (1) (c) of the Act, an application for a further patent must be made under section 29 of the Act.
- (2) The Commissioner must not grant a patent of addition under subsection 81 (1) of the Act unless the date that would be the date of the patent if that patent of addition were granted is the same as, or later than, the date of the patent for the main invention.

7.2 Form of application for revocation of patent and grant of patent of addition instead

An application under section 82 of the Act must be in the approved form.

Chapter 8 PCT applications and Convention applications

Part 1 PCT applications

8.1 International applications taken to be applications under the Act

(1) In this regulation:

priority date, in relation to an international application, has the same meaning as in the PCT.

(2) Where:

(a) the receiving Office has declared that an international application that specifies Australia as a designated State under Article 4 (1) (ii) of the PCT is taken to be withdrawn; or

(b) the International Bureau has made a finding under Article 12 (3) of the PCT;

the application is taken to be a PCT application as if a declaration or finding had not been made, if:

(c) the applicant has made a request referred to in Article 25 (1) (a) of the PCT within the time limit specified in Rule 51.1 of the PCT; and

(d) the Commissioner has received within the time limit specified in Rule 51.3 of the PCT:

(i) fees prescribed for the purposes of paragraph 89 (3) (b); and

(ii) if the application is not in English — a translation of the application into English and a related certificate of verification; and

(e) the Commissioner reasonably believes that:

(i) the declaration was the result of an error or omission on the part of the receiving Office; or

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- (ii) the finding was the result of an error or omission on the part of the International Bureau.
- (3) For the purposes of subsection 89 (1) of the Act:
 - (a) the requirements of subsection 29 (4) of the Act; and
 - (b) subregulation 3.1 (1) and regulation 3.2A; are prescribed.
- (4) The applicant must meet the requirements of subsection 89 (3) of the Act within the period of 31 months after the priority date of the application.

8.1A Title of an invention

- (1) A title established by the ISA under rule 37.2 of the PCT for an international application is taken to be the title of the specification.
- (2) For subregulation (1), if the established title is in a language other than English, the title is taken to be the English translation of the established title.

8.2 Prescribed documents: PCT application

- (1) In this regulation:
PCT application includes:
 - (a) an amendment under Article 19 or 34 of the PCT; or
 - (b) a rectification under Rule 91 of the regulations annexed to the PCT.
- (2) For the purposes of paragraph 89 (3) (a) of the Act, if:
 - (a) a PCT application is not filed in English; and
 - (b) the PCT application has been published in English under Article 21 of the PCT; and
 - (c) a translation of the application into English has not been filed before the date of publication under Article 21 of the PCT;the publication under Article 21 of the PCT is taken to be the translation referred to in paragraph 89 (3) (a) of the Act and to have been verified in accordance with these regulations.

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- (3) For the purposes of paragraph 89 (3) (b) of the Act, each of the following documents is prescribed:
 - (a) a document setting out an address for service of documents in Australia;
 - (b) if a PCT application has not been published under Article 21 of the PCT — a copy of the application;
 - (c) if a PCT application is not filed in English and has not been published in English under Article 21 of the PCT — a translation of the application into English together with a related certificate of verification.
- (4) The Commissioner must not, in relation to a PCT application that is treated as an application under the Act for a standard patent, give a direction under section 44 of the Act, unless the applicant has complied with the requirements of subsection 89 (3) of the Act.
- (5) In a PCT application, the applicant is taken to be the nominated person in respect of the application.

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

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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 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.

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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 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.

- (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

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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
- (b) the applicant demonstrated 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

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- (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 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.

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(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.

(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

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- (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
- (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)

Regulation 8.3

(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.

(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.

Regulation 8.3

- (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.
- (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.’.

Regulation 8.4

- (5) Schedule 1, definition of *international filing date*, including the cross-reference to section 10:

substitute

‘international filing date, in relation to a n interna tional application, means:

- (a) the date given to the inte rnational applica tion as its international filing date under Article 11 of the PCT; or
- (b) if that date is revised un der Article 14 of the PCT — that international filing date as so revised; or
- (c) if the Comm issioner h as treated another date as the international filing date under Rule 82^{ter} — that international filing date as so treated.

[See also section 10]’.

8.4 Form of request and prescribed documents: PCT applications

- (1) A request for publication under section 92 of the Act of the Act must be in the approved form.
- (2) For subsection 92 (4) of the Act, all documents that are:
 - (a) associated with the applica tion, or with any provisional application f rom which the applica tion c laims prior ity under article 8 of the PCT; and
 - (b) in the possession of the Patent Office;
are prescribed, other than:
 - (c) documents t hat would be privileged from production in legal proceedings on the gr ound of legal professional privilege; and
 - (e) the documents mentioned in subregulation 4.3 (2).

Regulation 8.6

Part 2 Convention applications

8.5 Convention countries

- (1) Each of the countries specified in Schedule 4 is declared to be a Convention country for the purposes of the definition of *Convention country* in the Act.
- (2) For the purposes of section 94 of the Act, the period of 12 months from the day on which a basic application is first made in a Convention country in respect of the invention is prescribed.

8.6 Particulars required for Convention application — general

- (1) For the purposes of paragraph 95 (2) (a) of the Act, the following particulars are prescribed:
 - (b) the country in which the application was made;
 - (c) the number allocated to the application by the foreign patent office of the Convention country in which the application was made;
 - (d) the date on which the application was made;
 - (e) if the application is not the first made in a Convention country in respect of the invention — the particulars specified in paragraphs (b) to (d) (inclusive) in respect of that first made application.
- (2) For subsection 95 (3) of the Act, the Commissioner may request a copy of the specification relating to the basic application that has been certified by the competent authority of the Convention country in which the basic application was made.
- (3) The certified copy must be filed within 3 months from the date on which the Commissioner requests it.

Regulation 8.6A

8.6A Particulars required for Convention application — use of approved digital library

- (1) For subregulation 8.6 (3), a certified copy is taken to have been filed if the Commissioner is satisfied that the certified copy:
 - (a) has been made available for inspection by the Commissioner in an approved digital library; and
 - (b) was made available within the period mentioned in subregulation 8.6 (3).
- (2) However, if the Commissioner is satisfied that the certified copy:
 - (a) was made available for inspection by the Commissioner in the approved digital library within the period mentioned in subregulation 8.6 (3); but
 - (b) is no longer available for inspection;the certified copy is taken to have been filed in respect of, and at the same time as, the basic application only if the certified copy is again made available for inspection by the Commissioner in the approved digital library, or given to the Commissioner, no later than 2 months after the day on which the Commissioner notifies the applicant or patentee that the Commissioner has not been able to inspect the certified copy in the approved digital library.

8.7 Form of request in relation to withdrawn, abandoned or refused applications

A request under section 96 of the Act must be in the approved form.

Chapter 9 Re-examination

9.1 Notice of Commissioner's decision to re-examine complete specification

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

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

9.2 Request for re-examination of complete specification

- (1) For subsections 97 (2) and 101G (1) of the Act, a request for re-examination of a complete specification must be in the approved form.
- (2) A request must identify the documents on which an assertion is based that 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, is not novel, and:
 - (a) for a standard patent — does not involve an inventive step; or
 - (b) for an innovation patent — does not involve an innovative step.
- (2A) A request must state the relevance of each of the documents mentioned in subregulation (2).
- (3) The request must have with it:
 - (a) if the document is not available in the Patent Office — a copy of the document; and
 - (b) if the document is not in English — a translation of the document into English and a related certificate of verification; and

Regulation 9.3

- (c) evidence of the date and place of publication of the document.
- (4) If the request does not comply with subregulations (2), (2A) and (3), the Commissioner must not re-examine the complete specification.
- (5) A person who has made a request may, by filing a notice in writing, amend or withdraw the request before the Commissioner reports under section 98 or subsection 101G (2) of the Act.
- (6) If the person who made the request is not the patentee, the Commissioner must notify the patentee of his or her decision to re-examine the complete specification.
- (7) A patentee or another person who has requested re-examination of the complete specification under subsection 97 (2) or 101G (1) of the Act must give notice to the Commissioner of any relevant proceedings in relation to the patent of which he or she is aware.

9.3 Copy of report on re-examination

- (1) If a person who asked for the re-examination is not the patentee, a copy of the report under section 98 or subsection 101G (2) of the Act must be given to the person by the Commissioner.
- (2) The Commissioner must give an opponent under Chapter 5 of the Act a copy of the report in respect of a complete specification in relation to the application in respect of which the grant of a patent is opposed.

9.4 Prescribed period: statement disputing report by Commissioner

- (1) For subsection 99 (1) or 101H (1) of the Act, the prescribed period is the period of 2 months from the day when the Commissioner reports under section 98 or subsection 101G (2) of the Act.

Regulation 9.5

- (2) The Commissioner must give a copy of a statement filed under subsection 99 (1) or subsection 101H (1) of the Act to:
- (a) an opponent under Chapter 5 of the Act in respect of the re-examined complete specification in relation to the application in respect of which the grant of a patent is opposed; and
 - (b) if the person who asked for the re-examination is not the patentee — that person.

9.5 Completion of re-examination

If the Commissioner makes an adverse report on a re-examination under subsection 97 (1) of the Act and:

- (a) a statement is filed under section 99 of the Act and:
 - (i) the Commissioner gives the applicant an opportunity to be heard that is referred to in subsection 107 (2) of the Act within 3 months from the day when the Commissioner reports under section 98 of the Act; or
 - (ii) the applicant or patentee asks for leave to amend the complete specification to remove any lawful grounds of objection specified in a report on re-examination within 3 months from the day referred to in subparagraph (i);the re-examination is completed when the decision is made whether or not the amendment is allowed; or
- (b) a statement is filed under section 99 of the Act and subparagraphs (a) (i) and (ii) do not apply — the re-examination is completed 2 months from the day when the Commissioner reports under section 98 of the Act; or
- (c) a statement is not filed under section 99 of the Act and:
 - (i) the Commissioner gives the applicant an opportunity to be heard that is referred to in subsection 107 (2) of the Act within 2 months from the day when the Commissioner reports under section 98 of the Act; or

Regulation 9.5

- (ii) the applicant or patentee asks for leave to amend the complete specification to remove any lawful grounds of objection specified in a report on re-examination within 2 months from the day when the Commissioner reports under section 98 of the Act;

the re-examination is completed when the decision is made whether or not the amendment is allowed; or

- (d) a statement is not filed under section 99 of the Act and subparagraphs (c) (i) and (ii) do not apply — the re-examination is completed 2 months from the day when the commissioner reports under section 98 of the Act.

Chapter 9A Examination of innovation patents

9A.1 Request for examination

- (1) A request for examination of a complete specification relating to an innovation patent must be in the approved form.
- (2) If the Commissioner decides, under paragraph 101A (a) of the Act, to examine a complete specification, the Commissioner must tell the patentee about the decision.
- (3) If a request is made under paragraph 101A (b) of the Act by a person other than the patentee, the Commissioner must tell the patentee about the request.
- (4) A request for examination of a complete specification can be withdrawn only:
 - (a) by the person who made the request; and
 - (b) before examination of the complete specification has begun; and
 - (c) if the Commissioner is satisfied, on reasonable grounds, that the request was made in error.
- (5) If examination of a complete specification has begun, no further requests for examination of the specification can be made.

9A.2 Examination of complete specification

For section 101B of the Act, the Commissioner may examine a complete specification relating to an innovation patent only if the patent has been granted.

Regulation 9A.2A

9A.2A Results of documentary searches — innovation patent

- (1) For subsection 101D (1) of the Act, a patentee informs the Commissioner of the results of documentary searches by or on behalf of a foreign patent office, other than the European Patent Office or the UK Patent Office, by providing:
 - (a) a list of documents, cited by the foreign patent office; or
 - (b) a copy of the search report issued by the foreign patent office.
- (1A) For paragraph (1) (a), it is not necessary to refer in a list to a document that has been included in a list or report in relation to the patent, previously provided to the Commissioner for the Act or these Regulations.
- (1B) For subsection 101D (1) of the Act, a patentee informs the Commissioner of the results of documentary searches by or on behalf of the European Patent Office or the UK Patent Office:
 - (a) by providing:
 - (i) a list of the documents cited by the patent office; and
 - (ii) for a list provided on or after 26 August 2003 — the symbols used by the patent office to indicate the relevance of the documents; or
 - (b) by providing a copy of the search report issued by the patent office.
- (2) The patentee must inform the Commissioner of the results of any documentary searches by the latest of:
 - (a) if the Commissioner decides, under paragraph 101A (a) of the Act, to examine the complete specification relating to an innovation patent — 3 months after the Commissioner tells the patentee under subregulation 9A.1 (2); and
 - (b) if the patentee asks, under paragraph 101A (b) of the Act, for an examination of the complete specification relating to an innovation patent — that time; and
 - (c) if another person asks for an examination under paragraph 101A (b) of the Act — when the patentee pays the fee mentioned in paragraph (b) of item 208 of Schedule 7; and
 - (d) 3 months after the search is completed.

Regulation 9A.2B

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

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

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

Regulation 9A.2B

Commissioner's decision to examine complete specification

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

Request for examination of complete specification

- (4) If:
- (a) a patentee, or another person, asked, in accordance with section 101 A of the Act, for an examination of the complete specification relating to an innovation patent; and
 - (b) under subsection 101D (1) of the Act, the patentee was required to inform the Commissioner of the result of a documentary search in relation to the patent request; and

Regulation 9A.3

- (c) the patentee did not inform the Commissioner of the result before 22 October 2007; and
- (d) if the patentee asked for the examination — the day 3 months after the documentary search is completed, within the meaning of regulation 1.3A, had not occurred before 22 October 2007; and
- (e) if a person other than the patentee asked for the examination — the later of the following dates had not occurred before 22 October 2007:
 - (i) the day 3 months after the documentary search is completed within the meaning of regulation 1.3A;
 - (ii) the day on which the patentee paid the fee mentioned in paragraph (b) of item 208 of Schedule 7;

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

- (5) If:
 - (a) a patentee, or another person, asks, in accordance with section 101A of the Act, for an examination of the complete specification relating to an innovation patent; and
 - (b) that person asked for the examination on or after 22 October 2007;

all documentary searches by, or on behalf of, a foreign patent office are prescribed (so that information need not be given to the Commissioner).

9A.3 Conduct of examination

- (1) If the Commissioner believes, on reasonable grounds, that there are lawful grounds for revocation of the innovation patent, the Commissioner must state the grounds for revocation in reporting on an examination.
- (2) The patentee may contest a ground for revocation in writing or ask for leave to amend the complete specification in accordance with Chapter 10.

Regulation 9A.4

- (3) If the patentee asks for leave to amend a complete specification in response to, or in anticipation of, a report under section 101B of the Act, the Commissioner must examine the specification and report as if each proposed amendment had been made.
- (4) If the patentee contests a ground for revocation, the Commissioner must examine the specification and take note of the matters raised by the applicant.
- (5) If the request for examination was made by a person other than the patentee, the Commissioner must send a copy of the report to the person who requested the examination.

9A.4 Period for examination

For paragraph 101C (b) of the Act, the examination of a complete specification for an innovation patent must be completed before the end of whichever of the following periods ends latest:

- (a) the period of 6 months from the date on which the first report is issued under section 101B of the Act;
- (b) the period mentioned in paragraph 13.4 (1) (d);
- (c) if an appeal has been made to a prescribed court in relation to the patent — the period of 3 months from the date on which the appeal is withdrawn, finally dealt with or determined, or such longer period as the court allows;
- (d) if the Commissioner requests:
 - (i) a translation of a specification or other document under subregulation 1.6 (1); or
 - (ii) a certified copy of a specification under subregulation 8.6 (2);the period of 5 months from the date on which the request is made;
- (e) if:
 - (i) the Commissioner has informed the patentee of a notice under subsection 28 (1) of the Act; or

Regulation 9A.5

- (ii) the patentee has informed the Commissioner, under section 101D of the Act, of the results of any documentary searches;

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

9A.5 Validity of innovation patent

For the purposes of examination, if a notice has been filed under subsection 28 (1) of the Act, the Commissioner must consider a matter stated in the notice that addresses a claim that an invention does not comply with paragraph 18 (1A) (b) of the Act.

Regulation 10.1

Chapter 10 Amendments

10.1 Form of amendments

- (1) For the purposes of subsection 104 (1) of the Act, an applicant or a patentee may ask the Commissioner for leave to amend a patent request or complete specification or another filed document by filing a request for leave to amend in the approved form together with a statement of proposed amendments.
- (1A) If an applicant proposes to amend a patent request, complete specification or other filed document for a reason mentioned in subregulation (1B), the applicant is taken to have complied with subregulation (1) if a written statement of the proposed amendments is filed.
- (1B) For subregulation (1A), the reasons are:
 - (a) to remove a lawful ground of objection or revocation raised in an examination report; or
 - (b) for an application for a standard patent — in anticipation of examination of the patent request and complete specification; or
 - (c) for an innovation patent — in anticipation of examination of the complete specification.
- (2) If:
 - (a) a proposed amendment is to be made by means of substituting a document or part of a document; or
 - (b) the Commissioner requires the applicant or patentee to make a proposed amendment by that means;
the applicant or patentee must file:
 - (c) 2 copies of each document or part that is to be substituted for a document or part; and

Regulation 10.2

- (d) on 1 of the copies, an indication, in a manner approved by the Commissioner, of the nature and location of the proposed amendment.
- (3) The Commissioner may require an applicant or a patentee to file, within 3 months of being asked to do so, a statement of the reasons for the request being made and any evidence in support of the request.
- (4) The Commissioner may, before granting leave to amend, require a patentee to file within 1 month of being asked to do so, a statement that, to the best of his or her knowledge, relevant proceedings are not pending in relation to the patent.
- (5) For the purposes of this Chapter, a statement of proposed amendments may be amended by filing a statement of proposed amendments of the first-mentioned statement before leave is granted under regulation 10.5 to amend the patent request or complete specification or another filed document.

10.2 Commissioner to consider and deal with requests for leave to amend

- (1) For the purposes of subsection 104 (2) of the Act, the Commissioner must report on whether:
 - (a) the request for leave to amend and the statement of proposed amendments do not comply with regulation 10.1 and Schedule 3; and
 - (b) any proposed amendment of a complete specification is not allowable under section 102 or 103 of the Act; and
 - (c) the proposed amendments are not allowable under regulation 10.3 or, if made, would not otherwise be allowable under the Act or these Regulations;
 and may, if the request for leave to amend relates to a PCT application, and a copy of an international preliminary examination report relating to the application has not been provided to the Commissioner:
 - (d) report on that fact; and

Regulation 10.2

- (e) 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.
- (2) The Commissioner must give a copy of each report made under subregulation (1) to the applicant or patentee.
- (3) The applicant or patentee may:
 - (a) contest the report in writing; or
 - (b) file a statement of proposed amendments of the statement referred to in paragraph (1) (a); or
 - (c) if the report relates to a request for leave to amend a PCT application, and the Commissioner has reported under subregulation (1) that the international preliminary examination report has not been provided to the Commissioner:
 - (i) provide a copy of the international preliminary examination report to the Commissioner; or
 - (ii) if:
 - (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);
 advise the Commissioner of that fact; or
 - (iii) elect 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 these Regulations, if the applicant provides the advice mentioned in subparagraph (c) (ii), or makes the election mentioned in subparagraph (c) (iii), any amendments made under Article 34 of the PCT are not taken to be included in the application.

Regulation 10.2

- (4) If a statement of proposed amendments referred to in subregulation (3) is filed, the Commissioner must report under subregulation (1) as if the proposed amendments had been made.
- (5) If, under subregulation (3), the applicant or patentee contests the report, the Commissioner must report under subregulation (1) and take notice of the matters raised by the applicant or patentee.
- (5A) If, under subregulation (3), the applicant:
 - (a) provides a copy of the international preliminary examination report to the Commissioner; or
 - (b) provides the advice mentioned in subparagraph (3) (c) (ii) to the Commissioner; or
 - (c) elects to abandon any amendments that may have been made under Article 34 of the PCT;the Commissioner must report under subregulation (1) taking notice of that fact.
- (6) Subregulation (6A) applies if:
 - (a) either:
 - (i) the grant of a standard patent is opposed under section 59 of the Act; or
 - (ii) an innovation patent is opposed under section 101M of the Act; and
 - (b) the applicant or patentee has requested leave to amend the patent request or complete specification concerned.
- (6A) The Commissioner must:
 - (a) give a copy of the request for leave to amend and the statement of proposed amendments to the opponent as soon as practicable after the request for leave to amend has been filed; and
 - (b) invite the opponent to comment on the request and statement.

Regulation 10.3

- (7) The opponent may file comments within 21 days, or any longer period (up to 2 months) allowed by the Commissioner, after being given the copy of the request for leave to amend and the statement under paragraph (6A) (a).
- (8) If:
 - (a) a person has, under subregulation 3.25 (1), requested the Commissioner to grant the certification referred to in that subregulation; and
 - (b) the Commissioner has not made a decision under subregulation 3.25 (2); and
 - (c) the applicant or patentee has filed a request for leave to amend the complete specification in respect of a matter mentioned in paragraph 6 (c) of the Act;the Commissioner must, as soon as practicable after the request for leave to amend has been filed, give a copy of that request and the statement of proposed amendments to the person referred to in paragraph (a).
- (9) If a request for leave to amend a complete specification in respect of a micro-organism is made for the purpose of including in the specification a matter in respect of which a notice has been filed by a person under subregulation 3.29 (1), the Commissioner must, as soon as practicable after the request for leave to amend has been filed, give the person a copy of the request and the statement of proposed amendments.

10.3 Amendments not allowable

- (1) A proposed amendment of a provisional specification is not allowable if it would materially alter the meaning or scope of the specification.
- (2) A proposed amendment of a complete specification is not allowable if:
 - (a) it is in respect of a matter mentioned in paragraph 6 (c) of the Act; and
 - (b) after the amendment was made the specification would not include each of the matters specified in that paragraph.

Regulation 10.3

- (3) A proposed amendment of a patent request is not allowable if:
 - (a) the patent request has been accepted under section 49 or 52 of the Act; and
 - (b) it would convert the patent application from:
 - (i) an application for a standard patent to an application for an innovation patent; or
 - (ii) an application for an innovation patent to an application for a standard patent.
- (4) The Commissioner must not allow a proposed amendment of a complete specification if he or she has:
 - (a) under subregulation 10.2 (8) or (9) given a person a copy of the request for leave to amend and the statement of proposed amendments; and
 - (b) not given the person a reasonable opportunity to be heard.
- (5) Subregulation (6) applies if a request for leave to amend the patent request for a standard patent is filed within 3 weeks before the date on which a notice is due to be published in the *Official Journal* under section 54 of the Act in respect of the specification, and the amendment would:
 - (a) convert the patent application from an application for a standard patent to an application for an innovation patent; or
 - (b) change the priority date of the application to a date that is later than the priority date that is currently recorded for the application.
- (6) The proposed amendment is not allowable until after the date on which the notice is published.
- (7) A proposed amendment of a complete specification for an application for an innovation patent, other than an amendment proposed in response to a direction under regulation 3.2B, is not allowable until after the patent has been granted.
- (8) A proposed amendment of a complete specification for an innovation patent is not allowable if the amendment would result in the specification claiming:
 - (a) a thing mentioned in subsection 18 (2) of the Act; or

Regulation 10.4

- (b) a thing mentioned in subsection 18 (3) of the Act (other than a thing mentioned in subsection 18 (4) of the Act).
- (9) A proposed amendment of a patent request is not allowable after the patent has been granted.

10.4 Commissioner to refuse request for leave to amend

The Commissioner must refuse the request for leave to amend, if:

- (a) he or she reasonably believes that a proposed amendment is not allowable, other than for the reasons mentioned in subregulation 10.3 (4); or
- (b) the applicant or patentee has not complied with a request of the Commissioner under subregulation 10.1 (3); or
- (c) in the case of a proposed amendment of a complete specification relating to a patent — the patentee has not complied with a request of the Commissioner under subregulation 10.1 (4).

10.5 Commissioner to grant leave to amend

- (1) The Commissioner must grant leave to amend a patent request, complete specification or other filed document:
 - (a) if the report on the proposed amendments under subregulation 10.2 (1) is not an adverse report; and
 - (b) in the case of amendments that are proposed in anticipation of, or in response to, a report relating to an examination under section 45 or 48 of the Act and that do not relate to matters mentioned in paragraph 6 (c) of the Act — if the Commissioner believes on reasonable grounds that the proposed amendments would remove all lawful grounds of objection to the patent request and complete specification; and
 - (c) in the case of amendments that are proposed in anticipation of, or in response to, a report relating to an examination under section 101B of the Act — if the Commissioner believes on reasonable grounds that the proposed amendments would remove all lawful grounds for revocation of the innovation patent.

Regulation 10.6

- (2) If the Commissioner grants leave to amend, he or she must publish a notice of that fact in the *Official Journal*, where:
 - (a) the patent request and complete specification to which the leave to amend relates have been accepted under section 49 of the Act, or a decision to certify has been made under section 101E of the Act; and
 - (b) the proposed amendments are in respect of:
 - (i) the complete specification; or
 - (ii) the patent request or another filed document and the proposed amendments would materially alter the meaning or scope of the request or document.
- (3) The Minister or another person may oppose allowance of an amendment if a notice is published under subregulation (2).
- (4) For the purposes of paragraph (2) (b), if:
 - (a) a request for leave to amend is filed before a patent is granted on an application under section 61 of the Act; and
 - (b) the proposed amendments relate to the name or address of an applicant for the patent;the proposed amendments are not taken to materially alter the meaning or scope of the patent request or other filed document.

10.6 Time for allowance of amendments

- (1) If:
 - (a) the Commissioner grants leave to amend a patent request, complete specification or other filed document; and
 - (b) subregulation 10.5 (2) does not apply to the amendment;the Commissioner must allow the proposed amendment immediately.
- (2) If:
 - (a) subregulation 10.5 (2) applies to a proposed amendment of a patent request, complete specification or other filed document; and
 - (b) no person opposes the allowance of the proposed amendment; and

Regulation 10.7

- (c) the Commissioner is satisfied that no relevant proceedings are pending;

the Commissioner must allow the proposed amendment at the end of the time for bringing opposition proceedings.

- (3) If:

- (a) subregulation 10.5 (2) applies to a proposed amendment of a patent request, complete specification or other filed document; and

- (b) a person opposes the allowance of the proposed amendment; and

- (c) the opposition is decided against the opponent; and

- (d) the Commissioner is satisfied that no relevant proceedings are pending;

the Commissioner must allow the proposed amendment immediately after the opposition is fully determined.

- (4) For the purposes of subregulation (3), an opposition is fully determined when:

- (a) a decision has been made in respect of the opposition and the decision is no longer subject to any form of review (including review by way of appeal against a decision of the Tribunal or a prescribed court); or

- (b) a decision that has been made in respect of the opposition was subject to review (including review by way of appeal against a decision of the Tribunal or a prescribed court) but the period within which review proceedings could have been instituted has expired without review proceedings having been instituted; or

- (c) the opposition is withdrawn.

- (5) If the Commissioner requires a patentee to file a statement that, to the best of the knowledge of the patentee, relevant proceedings are not pending, the patentee must file the statement within 1 month of the Commissioner so requiring.

10.7 Correction of Register or patent

- (1) The Commissioner may, on a request being made in the approved form, amend:

Regulation 10.7

- (a) an entry in the Register for the purposes of:
 - (i) correcting a clerical error or an obvious mistake; or
 - (ii) if a name or an address entered in the Register has been changed — changing the name or address; or
 - (b) a patent for the purposes of correcting a clerical error or an obvious mistake.
- (2) The Commissioner may, if he or she proposes to amend a patent or an entry in the Register, give notice to a person whose name is entered in the Register as having an interest in the patent.
- (3) If a proposed amendment would materially alter the meaning or scope of an entry in the Register or a patent, the Commissioner must publish in the *Official Journal* a notice of the request to amend the entry or the patent.
- (4) If a notice is published, a person may oppose the making of the amendment.
- (5) If the Commissioner publishes a notice of the request to amend, he or she must amend the patent or the entry in the Register:
- (a) where a person has not opposed allowance of the amendments; or
 - (b) subject to the terms of any decision of a prescribed court, the Tribunal or the Commissioner in respect of the opposition.
- (6) The Commissioner may, of his or her own motion, amend a patent or an entry in the Register to correct a clerical error or an obvious mistake.
- (7) If:
- (a) an extension of the term of a standard patent for a pharmaceutical substance has been granted under section 76 of the Act; and
 - (b) the Commissioner becomes aware that the first regulatory approval date in relation to the pharmaceutical substance is earlier than:

Regulation 10.7

- (i) the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods that was supplied, under subregulation 6.9 (2), with the application for the extension of the term; or
- (ii) the date of the first approval that was supplied, under subregulation 6.10 (2), with the application for the extension of the term;

the Commissioner must amend the relevant entry in the Register to insert the correct extension of the term of the patent.

Note 1 Under section 77 of the Act, the term of the extension must be 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 of the Act) in relation to the pharmaceutical substance;

reduced (but not below zero) by:

- (b) 5 years.

The extension of the term of a patent is one of the particulars included in the Register under paragraph 19.1 (1) (c). If the earliest first regulatory approval date is earlier than the date that was used in calculating the term of the extension under section 77 of the Act, then the entry in the Register will be incorrect.

Note 2 Subregulation 6.9 (2) refers to the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, a pharmaceutical substance. The date is supplied with an application for the extension of the term of a patent if pre-TGA marketing approval has not been given.

Subregulation 6.10 (2) refers to the date of the first approval of a pharmaceutical substance. The date is supplied with an application for the extension of the term of a patent if pre-TGA marketing approval has been given.

- (8) If the Commissioner proposes to amend an entry in the Register under subregulation (7), the Commissioner must:
 - (a) give notice to that effect to the patentee; and
 - (b) act in accordance with regulations 22.22 to 22.24 as if those regulations applied to a decision to amend an entry.

Note Regulations 22.22 to 22.24 apply to discretionary decisions made by the Commissioner. However, the procedures in those regulations will be used to allow the Commissioner to establish whether the grounds for a decision under subregulation (7) exist.

Regulation 10.14

- (9) An appeal lies to the Federal Court against a decision of the Commissioner to amend the Register under subregulation (7).

10.8 Prescribed decisions: appeal to Federal Court

For subsection 104 (7) of the Act, a prescribed decision is a decision to grant leave to amend a patent request or complete specification to which paragraph 10.5 (1) (b) or (c) applies.

10.10 Prescribed period: filing of court order

For the purposes of subsection 105 (5) of the Act, the period of 14 days from the date of the order of the court is prescribed.

10.11 Form of direction by Commissioner: patents

A direction of the Commissioner under subsection 106 (1) of the Act:

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that the patent relating to the direction is invalid; and
- (c) must specify the time within which the patentee must file a relevant statement of proposed amendments.

10.12 Form of direction by Commissioner: applications

A direction of the Commissioner under subsection 107 (1) of the Act:

- (a) must be in writing; and
- (b) must state the grounds on which he or she is satisfied that there are lawful grounds of objection to the patent request or complete specification; and
- (c) must specify the time within which the applicant must file a relevant statement of proposed amendments.

10.14 Form of request: claim under assignment or agreement

A request under subsection 113 (1) of the Act for a direction of the Commissioner must be in the approved form.

Regulation 11.1

Chapter 11 Infringement

11.1 **Infringement exemptions: prescribed foreign countries**

For the purposes of the definitions of *foreign aircraft*, *foreign land vehicle* and *foreign vessel* in the Act, each of the foreign countries specified in Schedule 4 is prescribed.

Chapter 12 Compulsory licences and revocation of patents

12.1 Lodgment of applications for compulsory licences

- (1) For the purposes of subsection 133 (1) of the Act, the period of 3 years after the date of sealing of the patent to which the application relates is prescribed.
- (2) An applicant must lodge with the Registrar of the prescribed court to which the application is made:
 - (a) a copy of the application that includes:
 - (i) the name and address of the applicant; and
 - (ii) the address for service in relation to the application; and
 - (iii) the identity of the patent; and
 - (iv) if the applicant relies on the ground mentioned in paragraph 133 (2) (a) of the Act — facts supporting the assertion that the reasonable requirements of the public with respect to the patented invention have not been satisfied; and
 - (iva) if the applicant relies on the ground mentioned in paragraph 133 (2) (b) of the Act — facts supporting the assertion that 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; and
 - (v) for an innovation patent — the date that the patent was certified; and
 - (b) a declaration by the applicant to the effect that the facts in the statement are true to the best of the knowledge of the applicant.

Regulation 12.2

- (3) The applicant must:
 - (a) serve a copy of the application and declaration on the patentee and any other person who claims an interest in the patent as soon as practicable after lodgment; and
 - (b) lodge with the Registrar notice of the date when, and the place where, he or she complied with paragraph (a).

12.2 Prescribed period: revocation of patent

- (1) For subsection 134 (1) of the Act, the prescribed period is 2 years from the date of the grant of the first compulsory licence in respect of a patent.
- (2) A prescribed court may, as a preliminary issue, hear and determine the question of the right of the person concerned to apply for revocation of a patent in respect of which a compulsory licence has been ordered.

12.3 Form of notice: offer to surrender patent

- (1) A notice under subsection 137 (1) of the Act must be in the approved form.
- (2) Notice of an offer to surrender under subsection 137 (2) of the Act must be published in the *Official Journal*.
- (3) An interested person must, not later than 1 month after the publication, give the Commissioner notice of his or her wish to be heard under subsection 137 (3) of the Act.
- (4) The Commissioner may, as a preliminary issue, hear and determine the question of the right of the person concerned to be heard.

12.4 Applications to revoke patents

- (1) An applicant to a prescribed court for an order to revoke a patent under subsection 138 (1) of the Act must include, in the pleading or another document disputing the validity of the patent:
 - (a) particulars of the grounds on which the applicant relies ;
 - and

Regulation 12.4

- (b) for an innovation patent — the date on which the patent was certified.
- (2) If 1 of those grounds is that the invention is not a patentable invention because of information about the invention in a document or through the doing of an act, the particulars must specify:
 - (a) in the case of a document — the time when, and the place where, the document is alleged to have become publicly available; and
 - (b) in the case of an act:
 - (i) the name of the person alleged to have done the act; and
 - (ii) the period in which, and the place where, the act is alleged to have been done publicly; and
 - (iii) a description that is sufficient to identify the act; and
 - (iv) if the act relates to apparatus or machinery — whether the apparatus or machinery exists and, if so, where it can be inspected.
- (3) Except by leave of the court:
 - (a) evidence is not admissible to prove a ground of invalidity that has not been disclosed in the particulars in relation to that ground; and
 - (b) evidence as to apparatus or machinery that exists at the date of lodgment of the particulars is not admissible unless it is proved that the party relying on the evidence:
 - (i) if the apparatus or machinery is in his or her possession — has offered the opportunity to inspect it; or
 - (ii) in any other case — has used reasonable endeavours to obtain its inspection;to, or by, each other party to the hearing of the application.
- (4) The court may:
 - (a) extend the time for giving particulars; and
 - (b) allow the amendment of particulars.

Regulation 13.1

Chapter 13 Withdrawal and lapsing of applications and ceasing of patents

13.1 Publication of notice of withdrawal of application

The Commissioner must publish notice in the *Official Journal* of the withdrawal of a patent application under section 141 of the Act.

13.1A Period in which standard patent applications may not be withdrawn

- (1) For subsection 141 (1) of the Act, the prescribed period for an application for a standard patent is:
 - (a) 3 weeks before the date on which a notice is due to be published in the *Official Journal* under section 54 of the Act in respect of the specification; or
 - (b) 3 weeks before the date on which a notice of acceptance is due to be published in the *Official Journal* under paragraph 49 (5) (b) of the Act.
- (2) Subregulation (1) does not apply if an order made under subsection 152 (3) or 173 (1) of the Act is in force.

13.1B Period in which innovation patent applications may not be withdrawn

- (1) For subsection 141 (1) of the Act, the prescribed period for an application for an innovation patent is the period:
 - (a) beginning when the Commissioner accepts the patent request and complete specification under subsection 52 (2) of the Act; and

Regulation 13.3

- (b) ending when the Commissioner grants the patent under subsection 62 (1) of the Act.
- (2) Subregulation (1) does not apply if an order made under subsection 152 (3) or 173 (1) of the Act is in force.

13.2 Prescribed period: request for examination of applications

The period of 9 months from the date on which the request for deferment of the examination was filed is prescribed for the purposes of paragraph 142 (2) (c) of the Act.

13.3 Prescribed period: continuation fees

- (1) For paragraph 142 (2) (d) of the Act:
 - (a) a continuation fee for an application for a standard patent is payable for a relevant anniversary at the last moment of the anniversary; and
 - (b) the period in which the fee must be paid is the period ending at the last moment of the anniversary.
- (1A) However, if the continuation fee is paid within 6 months after the end of the relevant anniversary (**6 month period**):
 - (a) the period mentioned in paragraph (1) (b) is taken to be extended until the fee is paid; and
 - (b) the continuation fee includes the additional fee stated in item 211 of Schedule 7; and
 - (c) the additional fee is payable from the first day of the 6 month period.
- (2) In the case of an application, filed before 1 April 2002, to which section 33, 34, 35, 36 or 79B of the Act applies, a continuation fee that is payable before 12 months after the date of filing the application is taken to have been paid.
- (3) In this regulation, **relevant anniversary**, for an application for a standard patent, means an anniversary:
 - (a) of the date that would be the date of the patent if a patent had been granted on the application; and

Regulation 13.4

- (b) that is mentioned in item 211 of Schedule 7.

Note 1 For the date of a patent, see section 65 of the Act and regulation 6.3.

Note 2 For the fees payable, see regulation 22.2.

13.4 Prescribed period: acceptance of request and specification

- (1) Subject to this regulation, the period prescribed for the purposes of paragraph 142 (2) (e) of the Act in relation to an application is:
- (a) if the applicant has not made a request under subsection 47 (1) of the Act — the period of 21 months from the date of the first report (if any) under section 45 of the Act;
 - (b) the period of 21 months from the date of the first report (if any) under section 48 of the Act;
 - (c) if examination is requested under subsection 47 (2) of the Act after the Commissioner first reports under section 48 of the Act — the period of 12 months from the date of the first report on the examination under section 45 of the Act;
 - (d) if the Commissioner has reported that the patent request or complete specification relates to an invention that, so far as claimed, is not novel in view of information of the kind described in subparagraph (b) (ii) of the definition of **prior art base** in the Act — the period of 3 months from the earlier of:
 - (i) the date of publication of the specification containing that information; or
 - (ii) its lapsing, refusal or withdrawal;
 - (e) if the patent request and complete specification relate to an application in relation to which a request has been made under section 32 of the Act — subject to subregulation (3), the period of 3 months from the date of the determination by the Commissioner under that section;
 - (f) if:
 - (i) a person has applied under subsection 36 (1) of the Act in relation to the patent request and complete specification; and

Regulation 13.4

- (ii) the Commissioner declares under that subsection that the applicant in relation to the request and complete specification is an eligible person; subject to subregulation (3), the period of 3 months from the date of that declaration;
- (g) if:
 - (i) a person has applied under subsection 36 (1) of the Act in relation to the patent request and complete specification; and
 - (ii) the Commissioner declares under that subsection that that person is an eligible person;either:
 - (iii) if the person has already lodged an application — subject to subregulation (3), the period of 3 months from the date of the Commissioner's declaration; or
 - (iv) in any other case — the period determined under whichever of paragraphs (a), (b) and (c) applies;
- (h) if an appeal has been made to a prescribed court, or an application for review has been made to the Tribunal, in relation to the patent request or complete specification — subject to subregulation (4), the period of 3 months from the day when the appeal or application is withdrawn or finally dealt with or determined;
- (j) if:
 - (i) the application is for a patent of addition; and
 - (ii) an appeal has been made to a prescribed court or an application for review has been made to the Tribunal in respect of the application for a patent for the main invention;subject to subregulation (4), the period of 3 months from the day when the appeal or application is withdrawn or finally dealt with or determined;
- (k) if the Commissioner requests a document under subregulation 1.6 (1) or subregulation 8.6 (2) — 5 months from the date of the request;

Regulation 13.5

- (l) if:
 - (i) the Commissioner has informed the applicant of a notice under subsection 27 (1) of the Act; or
 - (ii) the applicant has informed the Commissioner, under subsection 45 (3) of the Act, of the results of any documentary searches;
 and an objection is raised based on information in the notice or the search results — the period of 3 months from the date of the report that first mentions the objection.
- (2) If more than 1 of paragraphs (1) (a) to (l) applies in a particular case, the lapsing period is whichever period ends latest.
- (3) If paragraph (1) (e) or (f) or subparagraph (1) (g) (iii) applies, the Commissioner may substitute a period longer than 3 months, if the Commissioner is satisfied that acceptance of the patent request and complete specification should be postponed.
- (4) If paragraph (1) (h) or (j) applies, the court or Tribunal may in its discretion substitute a period longer than 3 months.

13.5 If applications lapse

- (1) If a complete application lapses under section 142, the Commissioner must advertise that fact in the *Official Journal*.
- (2) Subregulation (1) does not apply in relation to a PCT application that is treated as a patent application under the Act, if the PCT application lapses under paragraph 142 (2) (f) of the Act.

13.6 Time for payment of renewal fee for patent

- (1) For paragraphs 143 (a) and 143A (d) of the Act:
 - (a) a renewal fee for a patent is payable for a relevant anniversary at the last moment of the anniversary; and
 - (b) the period in which the renewal fee must be paid is the period ending at the last moment of the anniversary.

Regulation 13.6

- (1A) However, if an extension of the term of a standard patent is granted under section 76 of the Act, the period in paragraph (1) (b) is taken to be extended until 6 months after the extension is granted for each relevant anniversary happening:
- (a) on or after the twentieth anniversary of the date of the patent; and
 - (b) on or before the day the extension is granted.
- (2) However, if the period mentioned in paragraph (1) (b) is not taken to be extended under subregulation (1A), and the renewal fee is paid within 6 months after the end of the relevant anniversary (**6 month period**):
- (a) the period mentioned in paragraph (1) (b) is taken to be extended until the fee is paid; and
 - (b) the renewal fee includes the additional fee mentioned in subregulation (2A); and
 - (c) the additional fee is payable from the first day of the 6 month period.
- (2A) For paragraph (2) (b), the additional fee is:
- (a) for a standard patent — the fee stated in item 211 of Schedule 7; and
 - (b) for an innovation patent — the fee stated in item 212 of Schedule 7.
- (3) If a continuation fee is paid for a relevant anniversary in accordance with regulation 13.3, the renewal fee for that anniversary is taken to have been paid.
- (4) If an application for an innovation patent is made under section 79B or 79C of the Act, a renewal fee that is payable within 1 month after the grant of the patent is taken to have been paid.
- (5) The Commissioner must publish notice in the *Official Journal* of a patent that ceases under section 143 or 143A of the Act.
- (6) In this regulation, **relevant anniversary**, for a patent, means an anniversary of the date of the patent that is mentioned:
- (a) for a standard patent — in item 211 of Schedule 7; or
 - (b) for an innovation patent — in item 212 of Schedule 7.

Note For the date of a patent, see section 65 of the Act and regulation 6.3.

Regulation 13.7

13.7 Prescribed period: ceasing of innovation patents

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

Chapter 15 Special provisions relating to associated technology

15.1 Time for restoration of application for patent

A request under subsection 150 (1) of the Act must be filed within 3 months after the revocation, under section 149 of the Act, of a direction in respect of the application to which the request relates.

15.2 Requirements for reinstatement of international applications

- (1) For paragraph 151 (4) (c) of the Act, the prescribed period is 3 months from the revocation of a direction under section 149 of the Act.
- (2) For the purposes of paragraph 151 (4) (d) of the Act, the patent request, the specification to which the request relates and such other documents as are prescribed for the purposes of subsection 29 (1) of the Act are prescribed.
- (3) For the purposes of paragraph 151 (4) (d) of the Act, the fee that would have been payable if the application had been filed under section 29 of the Act is prescribed.

15.3 Prescribed period: order relating to standard patent

For subsection 153 (3) of the Act, the prescribed period is 1 month from the revocation of the order under subsection 152 (3) of the Act that relates to the application.

Regulation 17.1

Chapter 17 The Crown

17.1 Application for declaration: exploitation of innovation patent

An application under subsection 169 (1) of the Act for a declaration that an innovation patent has been exploited by the Crown under section 163 of the Act must include the date on which the innovation patent was certified.

17.1A Prescribed period: order relating to standard patent

For subsection 174 (2) of the Act, the prescribed period is 1 month from the revocation of an order under subsection 173 (1) of the Act that relates to the application.

17.2 Prescribed period, document and fee: filing of international applications

- (1) For the purposes of paragraph 176 (c) of the Act, the period of 3 months from the date on which an international application is considered to be withdrawn under Article 12 of the PCT is prescribed.
- (2) For the purposes of paragraph 176 (d) of the Act, the patent request, the specification relating to the request and such other documents as are prescribed for the purposes of subsection 29 (1) of the Act are prescribed.
- (3) For the purposes of paragraph 176 (d) of the Act, the fee that would have been payable if the application had been filed under section 29 of the Act is prescribed.

Regulation 19.1

Chapter 19 The register and official documents

19.1 Particulars to be registered

- (1) For subsections 187 (1) and (2) of the Act, the following particulars are prescribed, that is, particulars of:
 - (a) an entitlement as mortgagee, licensee or otherwise to an interest in a patent;
 - (b) a transfer of an entitlement to a patent or licence, or to a share in a patent or licence;
 - (c) an extension of the term of a patent;
 - (d) a restoration of a patent;
 - (e) an order of a court a copy of which is filed under subsection 105 (5) of the Act;
 - (f) an order of a prescribed court that has been served on the Commissioner under section 140 of the Act;
 - (g) an order of a prescribed court made on appeal in relation to a patent, being an order of which an office copy has been served on the Commissioner;
 - (h) a decision of the Commissioner to revoke a patent under Chapter 9 of the Act;
 - (i) the acquisition of a patent by the Commonwealth under Part 3 of Chapter 17 of the Act;
 - (j) the cessation of a patent.
- (2) A request for registration of particulars referred to in paragraph (1) (a) or (b) must be in the approved form and have with it proof to the reasonable satisfaction of the Commissioner of the entitlement of the person making the request.

Regulation 19.2

19.2 Request for information from Commissioner

- (1) A request made to the Commissioner under section 194 of the Act must be in the approved form.
- (2) A request under Article 15 (5) of the PCT for an international-type search to be carried out must be made by the applicant referred to in that Article within 10 months of the making of the application referred to in the Article.

Chapter 20 Patent attorneys

Part 1 Introduction

20.1 Interpretation

- (1) In this Chapter:

AQF means the Australian Qualifications Framework.

Board means the Professional Standards Board for Patent and Trade Marks Attorneys.

candidate means a person who proposes or proposed to sit, or has sat, for an examination.

Chairperson means Chairperson of the Board.

Disciplinary Tribunal means the Patent and Trade Marks Attorneys Disciplinary Tribunal established by regulation 20.61.

professional misconduct has the meaning given by regulation 20.32.

Register or **Register of Patent Attorneys** means the register kept under section 198 of the Act.

statement of skill has the meaning given by regulation 20.11.

unqualified, in relation to a particular time, means:

- (a) not holding one or more of the academic qualifications or knowledge requirements required for registration at that time by these Regulations; or
- (b) not holding a qualification required for registration at that time by the former attorneys Regulations.

unsatisfactory professional conduct has the meaning given by regulation 20.32.

- (2) For regulation 20.6, the **higher education sector** comprises:

- (a) universities; and
- (b) higher education institutions other than universities; and
- (c) higher education providers.

Regulation 20.2

Part 2 Obtaining registration for first time

20.2 Form of application

An application for registration as a patent attorney must:

- (a) be in writing, in a form approved by the Designated Manager; and
- (b) be accompanied by evidence and material mentioned in regulation 20.3; and
- (c) be accompanied by the fee mentioned in item 104 of Schedule 7.

20.3 Evidence that applicant meets registration requirements

- (1) An application for registration as a patent attorney must be accompanied by the following:
 - (a) evidence that the applicant is ordinarily resident in Australia;
 - (b) evidence that the Board is satisfied that the applicant has, or is entitled to the award of, an academic qualification of a kind mentioned in regulation 20.6;
 - (c) evidence that the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a patent attorney;
 - (d) one or more statements of skill, for the purposes of regulation 20.11;
 - (e) a statutory declaration, by the applicant, that he or she:
 - (i) has not, in the 5 years preceding the application, committed an offence prescribed by subregulation 20.12 (1); and

Regulation 20.6

- (ii) is not under sentence of imprisonment for an offence prescribed by subregulation 20.12 (2);
 - (f) a statutory declaration, by another person, that the applicant is of good fame, integrity and character.
- (2) A statutory declaration under paragraph (1) (f) must contain details of the basis of the opinion that the applicant is of good fame, integrity and character.

20.4 Certificate of registration

If the Designated Manager registers a person as a patent attorney, the Designated Manager must give the person a certificate of registration.

20.5 Evidence of academic qualifications

- (1) The Board must be satisfied that a person has a qualification mentioned in regulation 20.6 if:
- (a) the person makes an application in the form approved by the Board; and
 - (b) the application is accompanied by:
 - (i) evidence that the person has the qualification; and
 - (ii) the original or a certified copy of an academic record that shows the units that make up the qualification.
- (2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the qualification, notify the person, in writing, of its decision.

Note A decision that a person does not have a qualification is reviewable under regulation 22.26.

20.6 Academic qualifications

- (1) The Designated Manager must not approve an applicant for registration as a patent attorney unless the applicant has, or is entitled to:
- (a) an AQF qualification from the higher education sector that the Board is satisfied is an appropriate qualification for a patent attorney; or

Regulation 20.7

- (b) a qualification awarded by an overseas institution that the Board is satisfied is equivalent to an AQF qualification from the higher education sector.
- (2) The Board must not be satisfied that a person has an AQF qualification unless the qualification, or a course taken for the purpose of the qualification:
 - (a) is in a field of science or technology that contains potentially patentable subject matter; and
 - (b) involves a depth of study that the Board considers is sufficient to provide an appropriate foundation for practise as a patent attorney.
- (3) The Board must not be satisfied that a qualification from a foreign institution is equivalent to an AQF qualification unless the qualification, or a course taken for the purpose of the qualification:
 - (a) is in a field of science or technology that contains potentially patentable subject matter; and
 - (b) involves a depth of study that the Board considers is sufficient to provide an appropriate foundation for practise as a patent attorney.

20.7 Evidence of knowledge requirements

- (1) The Board must be satisfied that a person has a knowledge requirement mentioned in regulation 20.8 if:
 - (a) the person makes an application in the form approved by the Board; and
 - (b) the application is accompanied by:
 - (i) evidence that the applicant has the relevant knowledge; and
 - (ii) the original or a certified copy of any academic record that shows the study that contributes to the knowledge.

Regulation 20.8

- (2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the knowledge requirement, notify the person, in writing, of its decision.

Note A decision that a person does not have a knowledge requirement is reviewable under regulation 22.26.

20.8 Knowledge requirements

- (1) The Designated Manager must not approve an applicant for registration as a patent attorney unless the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a patent attorney.
- (2) Subject to subregulations (3), (4) and (5), the Board must, in satisfying itself whether or not an applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a patent attorney, take into account whether the applicant has the knowledge requirements that meet the minimum requirements set out in Schedule 5.
- (3) The Board may publish guidelines setting out criteria for deciding whether or not areas of study are likely:
- (a) to meet the minimum requirements set out in Schedule 5;
 - (b) to provide a person with the appropriate level of understanding to practise as a patent attorney.
- (4) The Board may be satisfied that an applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a patent attorney, despite the fact that the applicant does not meet every requirement set out in Schedule 5.
- (5) The Board is not able to be satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a patent attorney if the knowledge requirements on which the applicant relies were obtained more than 10 years prior to the application.

Regulation 20.9

- (6) If an applicant has been granted an exemption under regulation 20.9, the applicant is taken to meet the requirement in Schedule 5 for which the exemption is granted.

Note Subsection 198 (4) of the Act provides that the Designated Manager must register as a patent attorney a person who satisfies certain conditions. Paragraph 198 (4) (b) requires that a person hold such qualifications as are specified in, or ascertained in accordance with, the Regulations.

20.9 Exemption from a requirement in Schedule 5

- (1) The Board may exempt an applicant from having to satisfy all or some of the requirements mentioned in Schedule 5.
- (2) The Board must not give an exemption to an applicant unless:
- (a) the applicant makes an application in the form approved by the Board; and
 - (b) the applicant gives the Board enough information for the Board to be satisfied under paragraph (c); and
 - (c) the Board is satisfied that:
 - (i) the applicant has passed a course of study at a satisfactory level; and
 - (ii) the course of study has outcomes that are the same as, or similar to, those of a knowledge requirement for which the exemption is sought.
- (3) The Board may give an exemption under subregulation (1) if it is satisfied that the applicant has successfully completed a relevant course of study within the 7 years preceding the application or within a longer period specified in writing by the Board.
- (4) An exemption under subregulation (1) is valid for 5 years from the date that the exemption was granted or for a longer period specified in writing by the Board.

20.10 Employment requirements

- (1) The applicant:
- (a) must have been employed in a position, or positions, that provided the applicant experience in the following skills:
 - (i) searching patent records;

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- (ii) preparing, filing and prosecuting patent applications in Australia;
- (iii) preparing, filing and prosecuting patent applications in other countries and or organisations, particularly countries and organisations that are regarded as major trading partners with Australia;
- (iv) drafting patent specifications;
- (v) providing advice on the interpretation, validity and infringement of patents; and
- (b) must have been employed in a position, or positions, of that kind for at least:
 - (i) 2 continuous years; or
 - (ii) a total of 2 years within 5 continuous years.

Examples of major trading partners for subparagraph (a) (iii)

- European Community
- Japan
- New Zealand
- People's Republic of China
- United States of America.

- (2) The requirements set out in subregulation (1) must be evidenced by means of one or more statements of skill, as defined in regulation 20.11.

Note Subsection 198 (4) of the Act provides that the Designated Manager must register as a patent attorney a person who satisfies certain conditions. Paragraph 198 (4) (c) requires that a person be employed as prescribed for not less than the prescribed period.

20.11 Statements of skill

- (1) For paragraph 20.3 (1) (d) and subregulation 20.10 (2), a **statement of skill** is a statement by a registered patent attorney who has been registered for at least 5 years that, in the opinion of the registered patent attorney, the applicant has the experience mentioned in one or more of subparagraphs 20.10 (1) (a) (i) to (v).
- (2) Without limiting subregulation (1), a statement of skill must:
 - (a) contain details of the basis of the opinion that the applicant has the required experience; and

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- (b) include details of the evidence on which the opinion is based;
described by reference to:
 - (c) the skills mentioned in paragraph 20.10 (1) (a); and
 - (d) the employment requirements mentioned in paragraph 20.10 (1) (b).
- (3) If an applicant is unable to obtain a statement of skill from a registered patent attorney who has been registered for at least 5 years, the Board may, at the request of the applicant, prepare a statement of skill in relation to the applicant.

20.12 Prescribed offences

- (1) An offence against the Act, the *Designs Act 2003* or the *Trade Marks Act 1995* is a prescribed offence for paragraph 198 (4) (e) of the Act.
- (2) An offence of dishonesty for which the maximum penalty is imprisonment for at least 2 years is a prescribed offence for paragraph 198 (4) (f) of the Act.

Note Subsection 198 (4) of the Act provides that the Designated Manager must register as a patent attorney a person who satisfies certain conditions. Paragraph 198 (4) (e) requires that a person not have been convicted of a prescribed offence during the previous 5 years. Paragraph 198 (4) (f) requires that a person not be under sentence of imprisonment for a prescribed offence.

Regulation 20.13

Part 3 Accreditation of courses of study

20.13 Accreditation of courses of study

- (1) The Board may accredit a course of study that is provided by an institution if the Board is satisfied that the learning outcomes of the course would result in a person who passes the course acquiring some or all of the knowledge of intellectual property law and practice that the Board considers necessary for a person to practise as a registered patent attorney.
- (2) In deciding whether or not to accredit the course, the Board must consider whether the learning outcomes of the course meet some or all of the requirements set out in Schedule 5.
- (3) In considering whether the learning outcomes of the course meets some or all of the requirements set out in Schedule 5, the Board must consider any information provided by the institution.
- (4) If the institution gives the Board sufficient information for the Board to decide whether the learning outcomes of the course meet a requirement mentioned in Schedule 5, the Board must, within 4 months after receiving the information, decide whether to accredit the course.
- (5) Subject to subregulation (7), if the Board accredits a course, accreditation is for 5 years.
- (6) If an institution intends to change an accredited course, it must advise the Board in writing.
- (7) The Board may revoke an accreditation if:
 - (a) changes are made to the course; and
 - (b) the Board decides that the course no longer achieves the learning outcomes stated for the knowledge requirements to which it relates.

Regulation 20.14

20.14 Provisional accreditation

- (1) The Board may provisionally accredit a course if:
 - (a) the institution has sought accreditation for the course; and
 - (b) the information provided by the institution shows that the course includes a requirement mentioned in Schedule 5; and
 - (c) either:
 - (i) the Board does not expect to complete its consideration of the course under regulation 20.13 before the start of the academic semester; or
 - (ii) the Board has not completed its consideration of the course under regulation 20.13 when the academic semester starts.
- (2) The Board may provisionally accredit a changed course if:
 - (a) a consequence of the change to the course is that the learning outcomes of the course may meet fewer of the requirements set out in Schedule 5; and
 - (b) the Board considers that the changed course still achieves the learning outcomes stated for the knowledge requirements mentioned in Schedule 5.
- (3) Provisional accreditation:
 - (a) starts when the course is provisionally accredited; and
 - (b) ends at the earlier of:
 - (i) when the course has concluded; and
 - (ii) when a decision in relation to the course is made under regulation 20.13.

Regulation 20.17

Part 4 Board examinations

20.15 Board examinations

- (1) The Board may hold examinations for a requirement mentioned in Schedule 5.
- (2) The Board may appoint examiners for the purposes of the examinations, and give them instructions about the setting and marking of papers.
- (3) An examiner is entitled to be paid the fees that the Minister determines in writing.

20.16 Time for holding Board examinations

- (1) The Board must arrange to publish in the *Official Journal*, with adequate notice:
 - (a) the time of each examination it holds and the place where it is to be held; and
 - (b) the deadline for applications for admission to sit for each examination it holds.
- (2) Subregulation (1) does not apply to a supplementary examination under regulation 20.21.

20.17 Examinable subject matter

From time to time, the Board must arrange to publish in the *Official Journal* particulars of:

- (a) the subject matter covered by the courses for which examinations are to be held in relation to the relevant requirements mentioned in Schedule 5; and
- (b) the reading and study material it recommends to candidates.

Regulation 20.18

20.18 Admission to sit for a Board examination

An application by a person to sit for an examination must be in the form approved by the Board.

20.19 Notification of Board examination results

As soon as practicable after an examination conducted by the Board, the Board must give to each candidate who sat for the examination his or her results in the examination.

20.20 Reasons for failure of Board examination

- (1) A candidate who fails an examination conducted by the Board may apply to the Board in the form approved by the Board within 1 month after being told of the failure for a report of the reasons for the failure.
- (2) For subregulation (1), a report may be given by:
 - (a) the Board; or
 - (b) if the Board approves — the examiner appointed under subregulation 20.15 (2).

20.21 Supplementary Board examination

- (1) An application by a person to sit for a supplementary examination must be in the form approved by the Board.
- (2) The Board may let a candidate sit for a supplementary examination if:
 - (a) the candidate:
 - (i) failed an examination; and
 - (ii) applies to the Board to sit for the supplementary examination within 1 month of being told of the failure; or
 - (b) the candidate:
 - (i) did not sit for the examination because of illness or another reason that the Board reasonably considers sufficient; and
 - (ii) applies to the Board to sit for the supplementary examination within 1 month of the examination.

Regulation 20.21

- (3) For an application under paragraph (2) (a), the Board may take account of an examiner's comments on the candidate's performance.
- (4) A supplementary application under paragraph (2) (b) must be accompanied by evidence of the reason for failing to sit the examination that was obtained at the time of the illness or of the occurrence of the other event giving rise to the reason.

Regulation 20.22

Part 5 Maintaining registration

20.22 Requirements for remaining on Register

- (1) To remain on the Register, a registered patent attorney must, for every year of registration:
 - (a) pay the annual registration fee set out in item 105 or 106 of Schedule 7; and
 - (b) provide evidence that he or she has undertaken continuing professional education, as required by regulation 20.24.
- (2) Paragraph (1) (b) applies to a registered patent attorney who seeks to remain on the Register for the 12 months commencing on 1 July 2009 and for each subsequent period of 12 months.

20.23 Payment of annual registration fee

- (1) The annual registration fee is payable by a registered patent attorney to whom regulation 20.26 does not apply on 1 July in a year.
- (2) The Designated Manager must, not later than 1 June in each year, give to each registered patent attorney to whom regulation 20.26 does not apply, notice of the fee that is payable.

20.24 Continuing professional education — number of hours

- (1) Subject to subregulation (3), a registered patent attorney must, in the 12 months immediately before the date on which the attorney applies for renewed registration, have completed 10 hours of activities that the Designated Manager is satisfied are appropriate for an attorney to undertake as a means of maintaining the currency of his or her professional qualifications.

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- (2) The Board may publish guidelines setting out criteria for deciding whether or not activities are likely to be appropriate for an attorney to undertake as a means of maintaining the currency of his or her professional qualifications.
- (3) A person who is both a registered patent attorney and a registered trade marks attorney must, in the 12 months immediately before the date on which the attorney applies for renewed registration, have completed 15 hours of activities that the Designated Manager is satisfied are appropriate for an attorney to undertake as a means of maintaining the currency of his or her professional qualifications.
- (4) In this regulation:
renewed registration means an application by a registered patent attorney to renew his or her registration, other than the first application to renew his or her registration.

20.25 Method of demonstrating that continuing professional education has been undertaken

- (1) In making an application for a renewed registration, a registered patent attorney must:
 - (a) give the Designated Manager a written statement made by the attorney that states that the attorney has met the requirements of this Part; and
 - (b) have kept written records in relation to each continuing professional education activity on which the attorney relies.
- (2) For paragraph (1) (b), the records must:
 - (a) enable an assessment of the activity to confirm that the activity meets the requirements of this Part; and
 - (b) be produced to the Designated Manager on request; and
 - (c) be kept until 3 years after the end of the registration period during which the activity was completed.

Regulation 20.26

Part 6 Removal from Register

20.26 Voluntary removal of name from Register

The Designated Manager must, on the written request of a registered patent attorney, remove the attorney's name from the Register of Patent Attorneys.

20.27 Failure to pay annual registration fee

If a registered patent attorney does not pay the annual registration fee by 31 July in the year in which the fee is payable, the Designated Manager must:

- (a) remove the name of the attorney from the Register of Patent Attorneys; and
- (b) notify the attorney of that removal.

20.28 Failure to comply with continuing professional education requirements

- (1) If a registered patent attorney fails to comply with the requirements applicable to the attorney under subregulation 20.25 (1) or (2), the Designated Manager may remove the attorney's name from the Register for a period not exceeding 6 months.
- (2) If a registered patent attorney, without reasonable excuse:
 - (a) provides a written statement under paragraph 20.25 (1) (a) that is false in a material particular; or
 - (b) fails to produce written records of his or her continuing professional education activities in accordance with a request under paragraph 20.25 (2) (b);the Designated Manager must remove the attorney's name from the Register.

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- (3) If the Designated Manager removes the name of a registered patent attorney from the Register under subregulation (2), the name of the attorney must not be returned to the Register in accordance with regulation 20.29 for a period of 6 months from the day on which the attorney's name was removed from the Register.

Regulation 20.29

Part 7 Returning to Register

20.29 Restoring attorney's name to Register

- (1) Subject to subregulation (2), if:
 - (a) a patent attorney's name was removed from the Register under regulation 20.26; and
 - (b) the attorney requests the Designated Manager, in writing, to restore the attorney's name to the Register; and
 - (c) the attorney pays:
 - (i) the annual registration fee payable for the year in which the reinstatement is made; and
 - (ii) the fee mentioned in item 107 of Schedule 7;the Designated Manager must restore the attorney's name to the Register.
- (2) A request under paragraph (1) (b) must be made no more than 3 years after the removal of the attorney's name from the Register.
- (3) The Designated Manager may, in restoring the name of a registered patent attorney to the Register, impose a condition that, before 1 July of the following registration year, the registered patent attorney must undertake such continuing professional education activities as the Designated Manager considers reasonable in the circumstances.
- (4) If:
 - (a) the Designated Manager imposes a condition; and
 - (b) the registered patent attorney fails to comply with the condition;the Designated Manager may remove the name of the attorney from the Register.

Regulation 20.31

20.30 Restoring attorney's name to Register following payment of unpaid fee

The Designated Manager must restore a patent attorney's name to the Register if:

- (a) the attorney's name was removed from the Register under regulation 20.27; and
- (b) on or before 1 September of the year in which the attorney's name was removed from the Register, or within such further period as the Designated Manager reasonably allows, the attorney:
 - (i) pays the fee mentioned in regulation 20.27 and item 107 of Schedule 7;
 - (ii) makes an application in the form approved by the Designated Manager.

20.31 Returning to Register in other circumstances

- (1) A person who has been a registered patent attorney, and to whom regulation 20.29 or 20.30 does not apply, may apply to the Designated Manager to have his or her name restored to the Register.
- (2) An application under subsection (1) must be in a form approved by the Designated Manager.
- (3) An application under subsection (1) must be accompanied by the following:
 - (a) evidence that the Board is satisfied with the currency of the person's knowledge of intellectual property law and practice;
 - (b) a statutory declaration, by the applicant, that he or she:
 - (i) has not, in the 5 years preceding the application, committed an offence prescribed by subregulation 20.12 (1); and
 - (ii) is not under sentence of imprisonment for an offence prescribed by subregulation 20.12 (2);
 - (c) a statutory declaration, by another person, that the person is of good fame, integrity and character;

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- (d) a fee that is the sum of the fee mentioned in item 105 or 106 of Schedule 7, whichever is applicable, and the fee mentioned in item 107 of Schedule 7.
- (4) A statutory declaration under paragraph (3) (c) must contain details of the basis of the opinion that the applicant is of good fame, integrity and character

Part 8 Discipline

Division 1 General

20.32 Definitions

In this Part:

Code of Conduct means the document titled ‘Code of Conduct for Patent and Trade Marks Attorneys’ published by the Professional Standards Board for Patent and Trade Marks Attorneys, as existing on 1 July 2008.

conduct includes an act and an omission.

former attorney means a person whose registration as a patent attorney has been suspended or cancelled under this Part.

professional misconduct means:

- (a) unsatisfactory professional conduct that involves a substantial or consistent failure to reach reasonable standards of competence and diligence; or
- (b) any other conduct, whether occurring in connection with practice as an attorney or otherwise, that shows that the attorney is not of good fame, integrity and character; or
- (c) any contravention of a law that is declared by these Regulations to be professional misconduct.

unsatisfactory professional conduct includes conduct, in connection with practice as a registered patent attorney, that falls short of the standard of competence, diligence and behaviour that a member of the public is entitled to expect of an attorney.

20.33 Role of Board in disciplinary proceedings

- (1) The Board has the sole responsibility for commencing and conducting disciplinary proceedings against a registered patent attorney.

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- (2) The role of the Board in commencing disciplinary proceedings includes investigating, either as a result of information received or of its own motion, whether:
 - (a) a registered patent attorney has been engaged in:
 - (i) professional misconduct; or
 - (ii) unsatisfactory professional conduct; or
 - (b) at the time of his or her registration, a registered patent attorney did not hold either or both of the following:
 - (i) the academic qualifications mentioned in regulation 20.6;
 - (ii) the knowledge requirements mentioned in regulation 20.8; or
 - (c) a registered patent attorney obtained his or her registration by fraud.
- (3) The Board may commence proceedings before the Disciplinary Tribunal against a registered patent attorney if the Board is satisfied that there is a reasonable likelihood of the attorney being found guilty of unsatisfactory professional conduct.
- (4) The Board must commence proceedings against a registered patent attorney before the Disciplinary Tribunal if the Board is satisfied that there is a reasonable likelihood of the attorney being found guilty of an offence under subregulation (2), other than of unsatisfactory professional conduct.
- (5) In deciding whether or not to commence disciplinary proceedings against a registered patent attorney, the Board may take into account patterns of behaviour of the attorney when deciding whether or not it is satisfied that there is a reasonable likelihood of the attorney being found guilty of an offence under subregulation (2).
- (6) In deciding whether or not a registered patent attorney has been engaged in:
 - (a) professional misconduct; or
 - (b) unsatisfactory professional conduct;the Board must consider whether or not the attorney has complied with the Code of Conduct.

20.34 Board may require attorney to cooperate with investigation

- (1) In investigating whether or not to commence proceedings against a registered patent attorney, the Board may request the attorney who is the subject of the investigation to provide information.
- (2) The failure, without reasonable excuse, of a registered patent attorney to provide information requested by the Board under subregulation (1) is unsatisfactory professional conduct.

20.35 Commencing disciplinary proceedings

- (1) The Board must commence disciplinary proceedings by way of a notice given to the Disciplinary Tribunal.
- (2) A notice must be in writing and must set out the charges that are made against the registered patent attorney.
- (3) The Board must, as soon as practicable after giving a notice to the Disciplinary Tribunal, give a copy of the notice to the registered patent attorney who is the subject of the notice.

Division 2 Proceedings in Disciplinary Tribunal

20.36 Procedure of Disciplinary Tribunal

- (1) Subject to this Part, the Disciplinary Tribunal may determine its procedure.
- (2) Proceedings before the Disciplinary Tribunal are to be conducted quickly and informally, while allowing for proper consideration of the matter before that Tribunal.
- (3) The Disciplinary Tribunal is not bound by the rules of evidence but may be informed on any matter in the manner it chooses.
- (4) The Disciplinary Tribunal may take evidence on oath or on affirmation and, for that purpose, may administer an oath or affirmation.

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20.37 Notification of hearing of disciplinary proceedings

- (1) The Disciplinary Tribunal must, as soon as practicable after receiving a notice under regulation 20.35 in relation to a registered patent attorney, fix a time and place for the hearing of the charges set out in the notice.
- (2) The Disciplinary Tribunal must, as soon as practicable after fixing a time and date for the hearing of charges against a registered patent attorney, notify the attorney and the Board of that time and place.
- (3) The time of hearing must not be less than 21 days after the day on which the registered patent attorney is notified of the time and place for the hearing.

20.38 Hearings to be public except in special circumstances

- (1) Subject to subregulation (2), a hearing before the Disciplinary Tribunal must be in public.
- (2) If the Disciplinary Tribunal is reasonably satisfied that it is desirable to do so, in the public interest or because of the confidential nature of any evidence or matter, the Tribunal may:
 - (a) direct that a hearing, or a part of a hearing, is to take place in private and give directions as to the persons who may be present; and
 - (b) give directions restricting or prohibiting the publication or disclosure of:
 - (i) evidence given before the Tribunal, whether in public or in private; or
 - (ii) matters contained in documents lodged with the Tribunal or received in evidence by it.
- (3) A person must comply with a direction given to him or her under this regulation.

Penalty: 5 penalty units.

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20.39 Representation before Disciplinary Tribunal

- (1) At the hearing of proceedings before the Disciplinary Tribunal, a party to the proceedings may appear in person or be represented by a legal practitioner.
- (2) The Disciplinary Tribunal may allow a person to be represented by a person who is not a legal practitioner.
- (3) A party to proceedings before the Disciplinary Tribunal, or his or her representative, may request that Tribunal to summon witnesses.

20.40 Summoning of witnesses

- (1) For the purpose of the hearing of a charge against a registered patent attorney before the Disciplinary Tribunal, the Tribunal may, by instrument in writing signed by the person constituting the Tribunal:
 - (a) summon any person, other than the attorney, to appear before the Tribunal to give evidence about the charge and to produce any documents or articles mentioned in the summons; or
 - (b) summon the attorney to appear before the Tribunal:
 - (i) to produce any documents or articles mentioned in the summons; and
 - (ii) to give evidence to identify the documents or articles.
- (2) A registered patent attorney summoned under this regulation must appear in person.

20.41 Offences by persons appearing before Disciplinary Tribunal

- (1) A person summoned to appear before the Disciplinary Tribunal must comply with the summons by:
 - (a) appearing as required by the summons; and
 - (b) producing documents or articles as required by the summons; and

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(c) appearing and reporting to the Tribunal, as required.

Penalty: 10 penalty units.

(2) It is a defence to a prosecution for an offence against subregulation (1) if:

(a) the defendant is prevented or hindered from complying with the summons by:

(i) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or

(ii) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons; or

(b) in relation to paragraph (1) (c) — the defendant is excused by the Tribunal.

Note A defendant bears an evidential burden in relation to the matters mentioned in sub paragraph (2) (a) (i) (see section 13.3 of the *Criminal Code*).

(3) A person commits an offence if:

(a) the person:

(i) is not a registered patent attorney to whom subregulation (5) applies; and

(ii) appears as a witness before the Disciplinary Tribunal; and

(iii) has been paid expenses and allowances; and

(b) the expenses and allowances have been determined by the Tribunal in accordance with Part 2 of Schedule 8; and

(c) the person refuses:

(i) to be sworn or make an affirmation; or

(ii) to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: 10 penalty units.

(4) Strict liability applies to the physical element of an offence against subregulation (3) that is constituted by:

(a) the circumstance mentioned in sub paragraph (3) (a) (i); and

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- (b) the circumstance mentioned in paragraph (3) (b).

Note For *strict liability*, see section 6.1 of the *Criminal Code*.

- (5) A person commits an offence if the person:
- (a) is a registered patent attorney against whom proceedings have been instituted; and
 - (b) is summoned to appear at a hearing before the Disciplinary Tribunal in respect of those proceedings; and
 - (c) refuses:
 - (i) to be sworn or to make an affirmation; or
 - (ii) to answer a question relevant to the evidence that he or she was summoned to give.

Penalty: 10 penalty units.

- (6) It is a defence for a person referred to in subregulation (3) or (5) to refuse to answer a question or to produce a document or article, if the answer to the question, or the document or article, may tend to prove that he or she has committed an offence against a law of the Commonwealth or of a State or Territory.

20.42 Protection of person constituting Disciplinary Tribunal, witnesses etc

- (1) A person:
- (a) constituting or acting as the Disciplinary Tribunal; or
 - (b) appointed under subregulation 20.64 (2);
- has, in the exercise of the powers and the performance of the functions of that Tribunal under this Part, the same protection and immunity as a Justice of the High Court.
- (2) A member of the Board has, in exercising a power under this Part, the same protection and immunity as a Justice of the High Court.
- (3) A legal practitioner or other person appearing before the Disciplinary Tribunal has the same protection and immunity as a barrister has in appearing for a party in proceedings in the High Court.

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- (4) Subject to this Part, a person summoned to attend or appearing before the Disciplinary Tribunal as a witness:
 - (a) has the same protection; and
 - (b) is, in addition to the penalties provided by this Part, subject to the same liabilities; as a witness in proceedings in the High Court.

20.43 Decision of Disciplinary Tribunal

- (1) If the Disciplinary Tribunal has heard a charge of professional misconduct against a registered patent attorney, it may find the attorney guilty of professional misconduct.
- (2) If the Disciplinary Tribunal has heard a charge of unsatisfactory professional conduct against a registered patent attorney, it may find the attorney guilty of unsatisfactory professional conduct.
- (3) If the Disciplinary Tribunal has heard a charge that a registered patent attorney was unqualified at the time of his or her registration, that Tribunal may find the attorney guilty of being unqualified at the time of registration.
- (4) If the Disciplinary Tribunal has heard a charge that a registered patent attorney obtained his or her registration by fraud, that Tribunal may find the attorney guilty of obtaining his or her registration by fraud.

20.44 Penalties — professional misconduct

- (1) Subject to subregulation (2), if the Disciplinary Tribunal finds a registered patent attorney guilty of professional misconduct, it may:
 - (a) cancel the attorney's registration as a patent attorney; or
 - (b) suspend the attorney's registration as a patent attorney for a period of between 6 and 12 months.
- (2) The Disciplinary Tribunal may, in addition to cancelling or suspending a registered patent attorney's registration under subregulation (1), impose conditions on the attorney's return to

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the register after the cancellation has been lifted or the period of suspension has elapsed.

- (3) Without limiting subregulation (2), the conditions that the Disciplinary Tribunal may impose include either or both of the following:
- (a) that the attorney undertake a additional continuing professional education, as specified by the Tribunal;
 - (b) that the attorney work for a period of time, not exceeding 2 years, under the supervision of a person who has been a registered patent attorney for a period not less than 5 years.
- (4) If a registered patent attorney is also a registered trade marks attorney, the Disciplinary Tribunal may also cancel or suspend the attorney's registration as a trade marks attorney.

20.45 Penalties — unsatisfactory professional conduct

- (1) Subject to subregulation (2), if the Disciplinary Tribunal finds a registered patent attorney guilty of unsatisfactory professional conduct, it may:
- (a) suspend the attorney's registration as a patent attorney for a period of not more than 12 months; or
 - (b) administer a public reprimand to the attorney.
- (2) The Disciplinary Tribunal may, in addition to suspending a registered patent attorney's registration under subregulation (1), also impose conditions on the attorney's return to the register after the period of suspension has elapsed.
- (3) Without limiting subregulation (2), the conditions that the Disciplinary Tribunal may impose include either or both of the following:
- (a) that the attorney undertake a additional continuing professional education, as specified by the Tribunal;
 - (b) that the attorney work for a period of time, not exceeding 2 years, under the supervision of a person who has been a registered patent attorney for a period of not less than 5 years.

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20.46 Finding that attorney was unqualified at time of registration

If the Disciplinary Tribunal has heard a charge against a registered patent attorney that the attorney was unqualified at the time of his or her registration and finds the charge proved, that Tribunal may:

- (a) if the attorney has, since the time, obtained that qualification or the qualification is no longer required for registration — reprimand the attorney; or
- (b) in any other case — cancel his or her registration.

20.47 Finding that registration obtained by fraud

If the Disciplinary Tribunal finds that a registered patent attorney obtained his or her registration by fraud, that Tribunal must cancel the registration of the attorney.

20.48 Matters that may be considered in determining penalties

In deciding what to do about a registered patent attorney under regulation 20.44 or 20.45, the Disciplinary Tribunal may take into account the findings about the conduct of the attorney in any other proceedings:

- (a) brought before that Tribunal; or
- (b) brought before the Patent Attorneys Disciplinary Tribunal under the former attorneys regulations.

20.49 Findings of Disciplinary Tribunal

- (1) If the Disciplinary Tribunal reprimands a registered patent attorney, or suspends or cancels the attorney's registration, the Tribunal must give a written notice of the finding of the Tribunal against the attorney that sets out particulars of the reprimand, suspension or cancellation to:
 - (a) the attorney; and
 - (b) the Board; and
 - (c) the Designated Manager.

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- (2) If the registration of a registered patent attorney is suspended, the Designated Manager must not effect the suspension and its duration in the Register of Patent Attorneys.
- (3) If the registration of a registered patent attorney is cancelled, the Designated Manager must remove the name of the attorney from the Register of Patent Attorneys.
- (4) If the Disciplinary Tribunal does not find a charge proved, that Tribunal must notify the registered patent attorney and the Board accordingly.

20.50 Notification and publication of decisions of Disciplinary Tribunal

The Disciplinary Tribunal must, within 14 days after making a decision under regulation 20.44, 20.45, 20.46 or 20.47:

- (a) prepare a written statement that:
 - (i) sets out the decision of the Tribunal; and
 - (ii) sets out the reasons for the decision; and
 - (iii) sets out the findings on any material questions of fact; and
 - (iv) refers to evidence or other material on which the findings of fact are based; and
- (b) give:
 - (i) the registered patent attorney who is the subject of the notice; and
 - (ii) the Board;a copy of the statement referred to in paragraph (a); and
- (c) publish, in the *Official Journal*, a written statement that sets out the decision of the Tribunal; and
- (d) arrange for the publication of a copy of the statement referred to in paragraph (a).

20.51 Completion of outstanding business

- (1) If the registration of a former attorney has been cancelled under paragraph 20.44 (1) (a), the Disciplinary Tribunal may appoint

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a registered patent attorney to carry on the practice of the former attorney until all outstanding matters are disposed of.

- (2) If the registration of the former attorney has been suspended under paragraph 20.44 (1) (b) or 20.45 (1) (a), the Disciplinary Tribunal may appoint a registered patent attorney to carry on the practice of the former attorney for the period of the suspension or for a specified period, not longer than the period of suspension.
- (3) The Disciplinary Tribunal must not appoint a registered patent attorney under subregulation (1) or (2) unless the registered patent attorney consents to the appointment.
- (4) This regulation does not allow a registered patent attorney to act as a registered patent attorney on behalf of a person without the consent of the person.

20.52 Former attorney may be required to provide assistance

- (1) A registered patent attorney appointed to carry on the practice of a former attorney may give a written notice requiring the former attorney to make available to the attorney so appointed:
 - (a) any information about the practice that he or she may reasonably require; or
 - (b) any books, accounts or other documents concerning the practice that he or she may reasonably require; or
 - (c) any moneys held by the former attorney:
 - (i) on behalf of a client; or
 - (ii) that have been paid by a client in respect of services not yet performed for the client.
- (2) A former attorney who has been given a notice under subregulation (1) must not refuse to comply with a requirement in the notice.

Penalty: 5 penalty units.

Regulation 20.52

- (3) It is a defence to a prosecution for an offence against subregulation (2) if the former attorney is prevented or hindered from complying with a requirement in the notice by:
- (a) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
 - (b) any other circumstance that the Disciplinary Tribunal reasonably considers is an impediment to the defendant complying with the summons.

Note A defendant bears an evidential burden in relation to the question of whether he or she has a reasonable excuse (see section 13.3 of the *Criminal Code*).

Regulation 20.53

**Part 9 Rights of registered patent
attorneys**

20.53 Lien

A registered patent attorney has the same right of lien over documents and property of a client as a solicitor.

Part 10 Administration

Division 1 Professional Standards Board for Patent and Trade Marks Attorneys

20.54 Constitution of Board (Act s 227A)

The Board is constituted by:

- (a) the Chairperson, appointed by the Minister; and
- (b) either:
 - (i) the person holding, or carrying out the duties of, the office of the Director-General of the Division of the Department known as IP Australia; or
 - (ii) the nominee of that person; and
- (c) at least 2 other suitably qualified members, appointed by the Minister.

20.55 Term of office of Board members

The Minister may appoint a member of the Board for a term of up to 3 years.

20.56 Resignation and removal of members from Board

- (1) A member of the Board may resign by giving the Minister his or her resignation in writing.
- (2) The Minister may remove the Chairperson of the Board if the Chairperson:
 - (a) has been absent from 3 consecutive meetings of the Board without leave given by the Board under regulation 20.60; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for at least 12 months; or
 - (c) cannot perform his or her duties as Chairperson of the Board; or

Regulation 20.57

- (d) has behaved in an offensive or disorderly way, or in a way that is likely to adversely affect the Board's reputation; or
 - (e) has carried out his or her duties as Chairperson of the Board inefficiently; or
 - (f) becomes bankrupt; or
 - (g) applies to take the benefit of a law for the relief of bankrupt or insolvent debtors; or
 - (h) has entered into a debt agreement under Part IX of the *Bankruptcy Act 1966*; or
 - (i) compounds with his or her creditors or assigns his or her salary and allowances for their benefit.
- (3) The Minister may remove a member of the Board if the member:
- (a) has been absent from 3 consecutive meetings of the Board without leave given by the Chairperson; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for at least 12 months; or
 - (c) cannot perform his or her duties as a member of the Board; or
 - (d) has behaved in an offensive or disorderly way, or in a way that is likely to adversely affect the Board's reputation; or
 - (e) has carried out his or her duties as a member of the Board inefficiently; or
 - (f) becomes bankrupt; or
 - (g) applies to take the benefit of a law for the relief of bankrupt or insolvent debtors; or
 - (h) has entered into a debt agreement under Part IX of the *Bankruptcy Act 1966*; or
 - (i) compounds with his or her creditors or assigns his or her salary and allowances for their benefit.

20.57 Meetings of Board

- (1) The Board must hold as many meetings as are necessary for the performance of its functions.

Regulation 20.62

- (2) The Chairperson may, at any time, by notice in writing to the members, call a meeting of the Board at the time and place specified in the notice.

20.58 Member presiding at meetings of Board

- (1) The Chairperson must preside at all meetings of the Board at which he or she is present.
- (2) In the absence of the Chairperson from a meeting, the members present must appoint one of the members present at the meeting to preside.
- (3) The Chairperson or a member who presides at a meeting has a deliberative vote and, in the event of an equality of votes, also has a casting vote.

20.59 Quorum for Board meetings

At a meeting of the Board, a quorum is formed by the majority of the members of the Board.

20.60 Absence of Chairperson from meeting — leave from Board

If the Chairperson is absent from a meeting of the Board, the members present must decide whether to give leave to the Chairperson.

**Division 2 Patent and Trade Marks Attorneys
Disciplinary Tribunal**

20.61 Establishment of Disciplinary Tribunal

The Patent and Trade Marks Attorneys Disciplinary Tribunal is established.

20.62 Disciplinary Tribunal — substantive appointments

- (1) The Minister may, in writing, appoint a person to constitute the Disciplinary Tribunal.

Regulation 20.63

- (2) A copy of the instrument of appointment must be published in the *Official Journal*.
- (3) A person so appointed holds the office for the period specified in the instrument.
- (4) A person so appointed may resign in writing given to the Minister.
- (5) The Minister may remove a person so appointed from office for inefficiency, misbehaviour or incapacity.
- (6) If a person so appointed:
 - (a) becomes bankrupt, applies to take the benefit of a law for the relief of bankrupt or insolvent debtors, compounds with his or her creditors or makes an assignment of his or her remuneration for their benefit; or
 - (b) is convicted in Australia of an offence punishable by imprisonment for 12 months or longer; or
 - (c) fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.64;the Minister must remove the person from office.

20.63 Disciplinary Tribunal — acting appointments

- (1) Subject to subregulation (2), the Minister may, in writing, appoint a person to act as the Disciplinary Tribunal:
 - (a) during a vacancy in the office, whether or not an appointment has been previously made to the office; or
 - (b) during any period, or during all periods, when the holder of the office is, or is expected to be, absent from duty or from Australia or is, for any reason, unable to perform the functions of the office.
- (2) A person appointed to act during a vacancy must not continue to act for more than 12 months.
- (3) A copy of the instrument of appointment must be published in the *Official Journal*.

Regulation 20.64

- (4) The Minister:
 - (a) may terminate the appointment at any time; and
 - (b) must terminate the appointment if the person appointed fails, without reasonable excuse, to disclose a conflict of interest in accordance with regulation 20.64.
- (5) Anything done by or in relation to a person purporting to act under the appointment is not invalid only because:
 - (a) the need for the appointment had not arisen; or
 - (b) there was a defect or irregularity in connection with the appointment; or
 - (c) the appointment had ceased to have effect; or
 - (d) the need to act had not arisen or had ceased.

20.64 Disclosure of interest

- (1) If a person constituting, or acting as, the Disciplinary Tribunal has or acquires an interest that could conflict with the proper performance of his or her functions in relation to proceedings he or she is to hear, the person:
 - (a) must tell the parties to the proceedings about the interest; and
 - (b) must not perform those functions without the consent of the parties.
- (2) If such a person is unable to perform his or her functions because of a conflict of interest, the Minister may in writing appoint another person to be the Disciplinary Tribunal for the purpose of conducting or completing those proceedings.
- (3) A copy of the instrument of appointment must be published in the *Official Journal*.
- (4) A person so appointed may exercise all the powers and must perform all of the functions of the Disciplinary Tribunal in relation to those proceedings.

Regulation 20.65

**20.65 Qualifications for appointment to, or acting as,
Disciplinary Tribunal**

A person is not qualified to be appointed under subregulation 20.62 (1) or 20.63 (1) or 20.64 (2) unless he or she is enrolled, and has for not less than 7 y ears been enrolled, as a legal practitioner.

Chapter 21 Administration

21.1 Patent Office and sub-offices

The hours of business of the Patent Office and each sub-office of the Patent Office are from 9 am to 5 pm on each day other than:

- (a) a Saturday or a Sunday; or
- (b) a public holiday:
 - (i) where the Office or sub-office is located; or
 - (ii) for the purposes of the Australian Public Service in that place.

21.2 Employees to whom Commissioner may delegate (Act s 209 (1))

For subsection 209 (1) of the Act, the Commissioner may delegate all or any of the Commissioner's powers or functions under the Act, except the powers and functions under paragraphs 210 (a) and (c) of the Act, to an employee of the Patent Office:

- (a) holding, or performing the duties of, the position of Examiner of Patents; or
- (b) employed at any of the following levels:
 - (i) Executive level 1 or 2;
 - (ii) APS level 2, 3, 4, 5 or 6.

Chapter 22 Miscellaneous

Part 1 Fees and costs

Division 1 Fees

22.1 Fees generally

- (1) A fee must be paid in such a manner as the Commissioner reasonably directs.
- (2) If the Commissioner has directed that a complete application is to be treated as a provisional application, the amount by which the fee payable on the filing of a complete application exceeds the fee payable on the filing of a provisional application must be credited towards the payment of the fee payable on the next filing of a complete application associated with the provisional application by the applicant concerned.

22.2 General fees

- (1) For the purposes of subsection 227 (1) of the Act, there is payable to the Commissioner in respect of a matter specified in an item of Part 1 or 2 in Schedule 7 a fee of the amount specified in that item.
- (2) The fees are payable as follows:
 - (a) the fee for filing an application, request or other document is payable when the application, request or other document is filed;
 - (b) the fee for appearing at a hearing is payable:
 - (i) for the first day — immediately before the hearing; and
 - (ii) for each day or part of a day after the first day — immediately after the hearing;

Regulation 22.2B

- (c) the fee for making a representation mentioned in item 219 or 220 of Schedule 7 is payable when the representation is made;
 - (d) the fee for acceptance of a patent request and complete specification, under section 49 of the Act, is payable when the application is accepted.
- (3) If an item specifies the person by whom a fee is payable, the fee is payable by that person.
- (4) For paragraph 89 (3) (b) of the Act:
- (a) if a PCT application is to be treated as an application for a standard patent:
 - (i) the fee specified in item 214A of Schedule 7 is payable in respect of the application for a standard patent; and
 - (ii) if the PCT application was filed in the Patent Office as a receiving office for the purposes of the PCT — the fees specified in item 301, and items 401 to 404, of Schedule 7 are payable in respect of the PCT application; and
 - (b) the fee specified in item 203 of Schedule 7 is not payable in respect of a PCT application.
- (5) The fees specified in item 213 of Schedule 7 do not apply to:
- (a) an application for a standard patent filed before the commencement of this subregulation; or
 - (b) a PCT application that meets the requirements of subsection 89 (3) of the Act before the commencement of this subregulation.

22.2A Failure to pay: patent attorneys fees

The Designated Manager or the Board must not process an application mentioned in Part 1 of Schedule 7 if the fee payable for the application has not been paid.

22.2B Failure to pay: filing fees for patent requests

- (1) This regulation applies if:

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- (a) a fee mentioned in item 201, 202 or 203 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 2 months after the date of the invitation; and
 - (c) the fee is not paid within the 2 month period.
- (2) The application lapses, or the patent ceases, at the end of the 2 month period.

22.2C Failure to pay: certain other filing fees etc

- (1) This regulation applies if:
- (a) a fee mentioned in item 204, 205 or 206, paragraph (a) of item 208, or item 209, 210, 214, 215, 216, 217, 218, 219, 220, 222, 224, 225, 226, 227, 228, 236, 237, 238 or 239 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
 - (c) the fee is not paid within the 1 month period.
- (2) The application, representation, request or other relevant document is taken not to have been filed or made.

22.2D Failure to pay: fees payable by patentee for requests under s 101A (b) of the Act

- (1) Subregulation (2) applies if:
- (a) a fee mentioned in item 207 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the patentee to pay the fee within 1 month after the date of the invitation; and
 - (c) the fee is not paid within the 1 month period.
- (2) The innovation patent ceases at the end of the 1 month period.
- (3) Subregulation (4) applies if:

Regulation 22.2F

- (a) a fee mentioned in paragraph (b) of item 208 of Schedule 7 (the *paragraph (b) fee*) is not paid when it is payable; and
 - (b) within 1 month after the fee mentioned in paragraph (a) of that item is paid for the request to which the paragraph (b) fee relates, the Commissioner invites the patentee to pay the paragraph (b) fee within 2 months after the date of the invitation; and
 - (c) the fee is not paid within the 2 month period.
- (4) The innovation patent ceases at the end of the 2 month period.

22.2E Failure to pay: response fee

- (1) This regulation applies if:
 - (a) the fee mentioned in item 232 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
 - (c) the fee is not paid within the 1 month period.
- (2) The application to which the response relates lapses.

22.2F Consequence if Commissioner does not invite payment

- (1) Subregulation (2) applies if:
 - (a) a fee mentioned in regulation 22.2B, 22.2C, 22.2D or 22.2E is not paid when it is payable; and
 - (b) the Commissioner does not give the invitation mentioned in the relevant regulation within the time allowed.
- (2) The application, representation, request or other relevant document is to be treated as if the fee had been paid when the application, representation, request or other document was filed or made.
- (3) Subregulation (4) applies if:
 - (a) a fee mentioned in regulation 22.2I is not paid when it is payable; and

Regulation 22.2G

- (b) the Commissioner does not give the invitation mentioned in regulation 22.2I within the time allowed.
- (4) The accepted application is to be treated as if the fee for acceptance mentioned in item 213 of Schedule 7 had been paid immediately after its acceptance.
- (5) Subregulation (6) applies if:
 - (a) a fee mentioned in paragraph 22.2EA (1) (a) relating to a grant of leave to amend a complete specification is not paid when it is payable; and
 - (b) the Commissioner does not give the invitation mentioned in paragraph 22.2EA (1) (b) within the time mentioned in that paragraph.
- (6) The request for leave to amend the complete specification is to be treated as if the fee had been paid when leave was granted to amend the complete specification.
- (7) Despite subregulations (2), (4) and (6), the fee remains payable and can be recovered as a debt due to the Commonwealth.

22.2G Failure to pay: hearing fees

- (1) Subregulation (2) applies if:
 - (a) the fee mentioned in item 230 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person making the request to pay the fee within 1 month after the date of the invitation or before the date of the hearing, whichever is earlier; and
 - (c) the fee is not paid within the earlier of the periods mentioned in paragraph (b).
- (2) The request is taken not to have been made.
- (3) A hearing cannot be held if the fee mentioned in item 230 of Schedule 7 has not been paid for the hearing.
- (4) A person cannot appear at a hearing if the fee mentioned in paragraph (a) of item 231 of Schedule 7 has not been paid for the appearance.

22.2H Failure to pay: certain fees for actions by Commissioner

- (1) This regulation applies to a fee mentioned in item 221, 223, 229, 233, 234 or 235 of Schedule 7.
- (2) The Commissioner must not process a request or application for which such a fee is payable if the fee has not been paid.
- (3) If the fee mentioned in item 223 of Schedule 7 is paid for a request, the request is taken to have been made on the date on which the fee was paid.
- (4) If:
 - (a) the fee is not paid when it is payable; and
 - (b) the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
 - (c) the fee is not paid within the 1 month period;the request or application is taken not to have been made.

22.2I Failure to pay: acceptance fee

- (1) This regulation applies if:
 - (a) a fee for acceptance mentioned in item 213 of Schedule 7 is not paid when it is payable; and
 - (b) within 1 month after the fee is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 3 months after the date that the notice of the acceptance is published under paragraph 49 (5) (b) of the Act; and
 - (c) the fee is not paid within the 3 month period.
- (2) The application lapses.

22.3 General fees for international applications

- (1) If:
 - (a) for the purposes of the PCT, the Patent Office is:
 - (i) a receiving Office; or
 - (ii) an International Searching Authority; or

Regulation 22.4

- (iii) an International Preliminary Examining Authority ;
and
- (b) the Commissioner or the Patent Office is empowered by the PCT to charge a fee, other than a fee for the benefit of the International Bureau;
for the purposes of subsection 227 (1) of the Act, the amount of the fee payable to the Commissioner in respect of a matter specified in an item of Part 3 in Schedule 7 is the amount specified in that item.
- (2) The fees specified in items 301 and 302 in Schedule 7 are payable to the Commissioner within 1 month of filing an international application.
- (3) The fee specified in item 304 in Schedule 7 is payable to the Commissioner on filing a demand for a preliminary examination under Article 31 of the PCT.

22.4 Fees for international applications payable for the benefit of the International Bureau

- (1) If, for the purposes of the PCT, the Patent Office is:
 - (a) a receiving Office; or
 - (b) an International Searching Authority; or
 - (c) an International Preliminary Examining Authority;for an international application, the amounts of the international filing fee and handling fee (payable, under the PCT, to the Commissioner for the benefit of the International Bureau) for the application are as set out in Part 4 of Schedule 7.
- (2) The Commissioner must, in accordance with the PCT, determine the currency in which a fee payable under this regulation is payable and the exchange rate between Swiss currency and the currency so determined.
- (3) The Commissioner must give notice of a determination in the *Official Journal*.

Regulation 22.7

- (4) A determination has effect on the date specified in the determination for that purpose or on the date of notification of the determination in the *Official Journal*, whichever is later.

22.5 PCT Fund

Money paid as a fee to the Commissioner under subregulation 22.4 (1):

- (a) must be paid into a Special Account established under section 20 of the *Financial Management and Accountability Act 1997*; and
- (b) may be expended from the Special Account for the purposes of the PCT, including the making of refunds and the remission of fees to the International Bureau.

22.6 Exemption from fees

- (1) The Commissioner may exempt a person from the payment of the whole or any part of a fee if the Commissioner is reasonably satisfied that the action is justified, having regard to all the circumstances.
- (2) If acceptance of a patent request and complete specification for a standard patent has been delayed because of an error or omission on the part of an employee, the period mentioned in subregulation (3) is not, for the purposes of ascertaining the amount of a fee, to be taken into account.
- (3) For subregulation (2), the period is the period that the Commissioner believes, on reasonable grounds, is equal to the period of delay that resulted from the error or omission.

22.7 Refund of certain fees

- (1) Subject to subregulation (2), if:
 - (a) a complete application for a standard patent has been filed; and
 - (b) the application is withdrawn before the specification becomes open to public inspection;

Regulation 22.7A

so much of the fee paid on the filing of the application as the Commissioner reasonably thinks fit may, on written application made to him or her, be refunded.

- (2) If the PCT requires a fee paid to the Commissioner to be refunded in whole or in part, that fee or that part of the fee must be refunded.
- (3) If:
 - (a) a search fee or a preliminary examination fee is payable to an International Searching Authority or an International Preliminary Examining Authority; and
 - (b) the PCT provides for the refund of the fee in whole or in part; and
 - (c) that fee has been paid to the Commissioner;he or she must determine in accordance with the PCT to what extent that fee is to be refunded to the applicant and the fee must be refunded accordingly.

Division 2 Costs

22.7A Proceedings to which this Division applies

This Division applies to proceedings before the Commissioner.

22.8 Costs

- (1) The Commissioner must not award costs in proceedings to which this Division applies, other than costs specified in Schedule 8, unless each party to the proceedings has had the reasonable opportunity to make a submission on the matter of the award of those costs.
- (2) The Commissioner may award an amount:
 - (a) for costs in respect of a matter specified in column 2 of an item of Part 1 in Schedule 8; or
 - (b) in respect of the expenses or allowances of a person in relation to proceedings to which this Division applies.

Regulation 22.8

- (2A) A party to proceedings may request taxation of an amount awarded under subregulation (2).
- (3) If a request for taxation is made, the amount must be taxed, allowed and certified, by an employee appointed by the Commissioner for that purpose, in accordance with:
 - (a) the amount specified in column 3 of that item; or
 - (b) Part 2 in Schedule 8;as the case may be.
- (4) A taxation is subject to review by the Commissioner.

Regulation 22.9

Part 2 Other matters

22.9 Death of applicant or nominated person

The legal representative of a deceased applicant, nominated person or patentee who wishes:

- (a) in accordance with subsection 215 (1) of the Act to proceed with the application; or
- (b) in accordance with subsection 215 (2) of the Act to have the patent granted to him or her; or
- (c) in accordance with subsection 215 (3) of the Act to have the patent amended by substituting for the name of the patentee the name of the person to whom the patent should have been granted;

must file the approved form and such other documents as the Commissioner reasonably considers necessary to support the request.

22.10 Address for service

- (1) If provision is made in an approved form to state an address for service, the person completing the form must state an address in Australia at which a document under the Act or these Regulations may be given to him or her personally or to the person specified in the form as his or her representative.
- (2) A person may file notice of a change of his or her address for service.
- (3) If a notice of opposition is filed under regulation 5.3 or 5.3AA, a person who has filed notice under subregulation (2) must serve a copy of the notice on each person interested in the opposition proceedings.
- (4) If a person serves a document on a person other than the Commissioner, the first-mentioned person must, as soon as practicable after serving the document on the other person, file a notice of the service in the approved form together with a copy of the document served.

Regulation 22.10AB

22.10A Address for correspondence

- (1) If provision is made in an approved form to state an address for correspondence, the person completing the form may state an address to which all correspondence from the Commissioner can be sent.
- (2) A person may file notice of a change of his or her address for correspondence.
- (3) The address for correspondence need not be in Australia.

22.10AA Period for doing certain acts — office not open for business

For subsection 222A (1) of the Act, the circumstance is that the act is done at:

- (a) the Patent Office; or
 - (b) a sub-office of the Patent Office;
- that was not open for business.

Note Subsection 222A (1) provides as follows:

‘(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.’.

22.10AB Days when office not open for business

- (1) For paragraph 222A (2) (a) of the Act, the days on which the Patent Office, or a sub-office of the Patent Office, is not open for business are:
 - (a) Saturday; and
 - (b) Sunday; and
 - (c) Australia Day; and
 - (d) Anzac Day.
- (2) For paragraph 222A (2) (b) of the Act, the Director General of IP Australia is a prescribed person.

Regulation 22.10AC

- (3) For paragraph 222A (2) (b) of the Act, the prescribed way of publishing a declaration is in the *Official Journal*.

22.10AC Period for doing certain acts — acts to which section 222A does not apply

For subsection 222A (7) of the Act, the following acts are prescribed:

- (a) an act done in opposition proceedings, other than the filing of a notice or request with the Patent Office, under the following provisions:
 - (i) Chapter 5, 6, 9A, 10 or 22 of the Act;
 - (ii) Chapter 5, 10 or 22 of these Regulations;
- (b) the act of lodging a return required under section 76A of the Act;
- (c) an act done in relation to proceedings in a court or a tribunal;
- (d) an act done under Chapter 20 of these Regulations.

22.11 Extension of time

- (1) For the purposes of subsection 223 (2) or (2A) of the Act, an application for an extension of time must be in the approved form and have with it a declaration setting out the grounds on which the application is made.
- (1A) Subregulation (1B) applies if:
 - (a) an application for an extension of time for doing a relevant act is made under subsection 223 (2) of the Act; and
 - (b) the relevant act has not been done; and
 - (c) a notice of opposition to the grant of the application is filed.
- (1B) If the Commissioner grants the application, the Commissioner must extend the time to include the period from the day on which the notice of opposition is filed to the end of:
 - (a) if an application is made to the Tribunal for a review of a decision of the Commissioner — the day when the application is withdrawn or finally dealt with or determined; or

Regulation 22.12

- (b) in any other case — 21 days after the end of the day on which the Commissioner decides the application.
- (1C) For paragraph 223 (2A) (b) of the Act the prescribed period is 2 months after the circumstance that prevented the person from doing the relevant act within the time required ceases to exist.
- (1D) For subsection 223 (2B) of the Act the prescribed period is 12 months after the end of the time within which the act is required to be done.
- (2) Notice of the grant of an extension of time must be published in the *Official Journal*.
- (3) For subsection 223 (4) and paragraph 223 (9) (b) of the Act:
 - (a) the payment of a continuation fee or a renewal fee within the 6 month period mentioned in subregulation 13.3 (1A) or 13.6 (2) is a prescribed relevant act; and
 - (b) the prescribed circumstances are that the fee is not paid within that 6 month period mentioned in subregulation 13.3 (1A) or 13.6 (2).
- (4) For the definition of **relevant act** in subsection 223 (11) of the Act, each of the following actions is prescribed:
 - (a) an action or step prescribed in Chapter 5, other than an action or step taken under regulation 5.3 or 5.3AA, paragraph 5.4 (a), subparagraph 5.8 (1) (a) (i) or regulation 5.9A;
 - (b) filing, during the term of a standard patent as required by subsection 71 (2) of the Act, an application under subsection 70 (1) of the Act for an extension of the term of the patent;
 - (c) an action or step prescribed in Chapter 20.

22.12 Evidence

- (1) If evidence is given in writing to the Commissioner or to the Patent Attorneys Disciplinary Tribunal for the purposes of the Act or these regulations, the evidence must be in the form of a declaration.

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- (2) The Commissioner may:
- (a) require a person who has made a declaration to appear before him or her to give evidence orally on oath in substitution for, or addition to, the evidence contained in the declaration; and
 - (b) allow the person to be cross-examined on the declaration.

22.13 Declarations

- (1) In this regulation:

diplomatic or consular officer means a person who holds or performs the duties of any of the following offices of the Commonwealth in a country other than Australia:

- (a) ambassador;
 - (b) high commissioner;
 - (c) minister;
 - (d) chargé d'affaires;
 - (e) counsellor or second or third secretary at an embassy, high commission or other post;
 - (f) consul-general;
 - (g) consul;
 - (h) vice-consul.
- (2) A declaration required by the Act or these Regulations to be given to the Commissioner must:
- (a) be headed with the title of the matter of which the declaration is made; and
 - (b) be expressed in the first person; and
 - (c) state the name and address of the person making the declaration; and
 - (d) state the name and title of the person before whom the declaration is made; and
 - (e) state the date on which, and the place at which, the declaration is made; and
 - (f) be divided into paragraphs, each of which must be:
 - (i) numbered consecutively; and
 - (ii) as far as practicable, confined to 1 subject.

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- (2A) If the declaration is made on behalf of another person, it must also state the other person's name and address.
- (2B) If the declaration is made for the purposes of a business whose details are set out in the declaration, it must also state:
 - (a) the office or position in the business held by the person who makes the declaration; and
 - (b) the address of the place at which the business is conducted or principally conducted.
- (3) A declaration may be made before:
 - (a) a magistrate; or
 - (b) a justice of the peace; or
 - (c) a commissioner for affidavits; or
 - (d) a commissioner for declarations; or
 - (e) a notary public; or
 - (f) a person before whom a statutory declaration may be made under the *Statutory Declarations Act 1959* or the law of the State, Territory or foreign country where the declaration is made; or
 - (g) a diplomatic or consular officer.

22.14 Directions not otherwise prescribed

If the Commissioner reasonably believes that it is necessary for the proper prosecution or completion of proceedings for a person to perform an act, file a document or produce evidence that is not provided for by the Act or these Regulations, the Commissioner may give notice to the person requiring him or her to perform the act, file the document or produce the evidence, specified in the notice.

22.15 Documents to be in English

- (1) An abstract, approved form or specification that is filed must be in English.
- (2) Any other document that is filed must be in English, other than:
 - (a) a document that has been translated into English and that has with it a related certificate of verification; or

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- (b) a document containing search results filed under subsection 45 (3) or 101D (1) of the Act.

22.16 Documents other than specifications and abstracts

- (1) In this regulation:
document does not include:
 - (a) a patent request for a standard patent; or
 - (b) a patent request for an innovation patent; or
 - (c) a specification; or
 - (d) an abstract.
- (2) If a document received at the Patent Office does not substantially comply with Schedule 3 or is not in accordance with whichever approved form is applicable, the Commissioner may treat the document:
 - (a) as not having been filed and return it to the person from whom it was received with a statement indicating how the document or form does not so comply or accord; or
 - (b) as having been filed, but direct the person from whom it was received to do such things as are necessary to ensure that the document will so comply or accord.
- (3) If the Commissioner returns a document under paragraph (2) (a), he or she must return with the document any other document filed with it.
- (4) If the Commissioner gives a direction under paragraph (2) (b) and the person to whom the direction was given does not comply with that direction within 3 months from the day when it was given, the Commissioner must treat the document as not having been filed.
- (5) Chapter 10 does not apply to a document to which this regulation applies.

22.17 Incapacity of certain persons

- (1) In this regulation:

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mental dysfunction means a disturbance or defect, to a severely disabling degree, of perceptual interpretation, comprehension, reasoning, learning, judgment, memory, motivation, or emotion.

- (2) If a person is incapable of doing anything required or permitted by the Act or these Regulations to be done because of infancy or of mental dysfunction or physical disability or disease, a court may, on the application of a person acting on behalf of the incapable person or of another person interested in the doing of the thing:
 - (a) do that thing; or
 - (b) appoint a person to do the thing;
in the name, and on behalf, of the incapable person.
- (3) A thing done in the name of, and on behalf of, an incapable person is taken to have been done by that person as if the person had not been incapable when the thing was done.

22.18 Destruction of documents

- (1) The Commissioner may order the destruction of documents relating to applications filed not less than 25 years before the date of the order.
- (2) Subregulation (1) does not authorise the destruction of:
 - (a) the Register; or
 - (b) documents relating to patents in force; or
 - (c) documents considered by the Commissioner, or the Director-General of the Australian Archives, to be of legal or historical interest.

22.19 Copies of certain documents to be supplied

A copy of a document that:

- (a) affects the ownership of a patent or licence; and
- (b) has been witnessed;

must be filed by a person who seeks to have the Commissioner consider the document for the purposes of the Act or these regulations.

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22.20 International applications and the Patent Office

If, for the purposes of the PCT, the Patent Office is:

- (a) a receiving Office; or
- (b) an International Searching Authority; or
- (c) an International Preliminary Examining Authority;

the Commissioner and the Patent Office may perform the functions under the PCT of a receiving Office, an International Searching Authority or an International Preliminary Examining Authority, as the case requires, in relation to an international application.

22.21 Protection or compensation of certain persons

- (1) The following provisions of this regulation are prescribed for subsections 41 (4), 150 (4) and 223 (9) of the Act.
- (2) Persons who availed themselves of or exploited, or took definite steps by contract or otherwise to avail themselves of or exploit, inventions:
 - (a) in the case of inventions to which subsection 41 (4) of the Act applies — in the period mentioned in paragraph 41 (4) (c) of the Act; and
 - (b) in the case of inventions to which subsection 150 (4) of the Act applies — after the lapse of the applications and before the day on which their restoration was notified in the *Official Journal*; and
 - (c) in the case of inventions to which subsection 223 (9) of the Act applies — within the period of time extended under that subsection;may apply, in the approved form, to the Commissioner for the grant of licences to exploit the inventions.
- (3) An applicant for a licence must serve a copy of the application on a person whose application or patent:
 - (a) was so restored; or
 - (b) is referred to in subsection 41 (4) of the Act;and to such other persons as the Commissioner reasonably directs.

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- (4) A person on whom a copy of an application has been served may oppose the grant of the licence.
- (5) The Commissioner, if reasonably satisfied that the application should be granted, must grant a licence to the applicant on such terms as the Commissioner thinks reasonable.

22.22 Exercise by Commissioner of certain powers

- (1) The Commissioner must, before exercising a discretionary power under the Act or these Regulations adversely to a person, give the person at least 10 days notice of the time when, and the place where, that person may be heard in relation to the exercise of the power.
- (2) The Commissioner may exercise that power, if the person:
 - (a) informs the Commissioner that he or she does not wish to be heard; or
 - (b) does not attend the hearing; or
 - (c) being an applicant or patentee, requests the Commissioner to exercise the power of the Commissioner without the applicant or patentee being heard.
- (3) A request:
 - (a) must be in the approved form; and
 - (b) may be accompanied by written submissions.
- (4) The Commissioner must, after hearing the person, notify him or her of the decision.

22.23 Hearings

- (1) The Commissioner must give notice of the date, time and place of a hearing before him or her to each party to the hearing at least 10 days before the day when the hearing is to begin.
- (2) The Commissioner may adjourn a hearing from time to time or from place to place by notifying the parties to the hearing accordingly.
- (3) The Commissioner may hold a hearing:
 - (a) at which the parties appear before him or her in person; or

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- (b) in which a party participates by telephone or such other means of telecommunication as the Commissioner reasonably allows.
- (4) If a party to a hearing does not intend to appear at the hearing, the party may make a submission in writing to the Commissioner before the hearing begins to which the Commissioner must have regard in reaching his or her decision on the matter being heard as if:
 - (a) the party were present or otherwise participating in the hearing; and
 - (b) the matter of the submission were presented by the party in the presence of the Commissioner.
- (5) The Commissioner must, after hearing the person, notify him or her of the decision.

22.24 Practice and procedure other than for opposition proceedings

- (1) Subject to these Regulations:
 - (a) if the Act or these Regulations authorise the Commissioner to hear and decide an application or matter that is not an opposition; or
 - (b) in a matter being decided on the motion of the Commissioner;the practice and procedure to be followed for the purposes of enabling the application or matter to be decided is to be determined by him or her.
- (2) A person to be heard at a hearing may apply to the Commissioner in respect of the practice and procedure in relation to the hearing to be determined by the Commissioner.

22.25 Requirements cannot be complied with for reasonable cause

If, under these Regulations, a person is required to:

- (a) sign a document, make a declaration or file or give the Commissioner a document or evidence; and

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- (b) the Commissioner is reasonably satisfied that the person cannot comply with the requirement;
the Commissioner may, subject to such conditions as he or she reasonably directs, dispense with the requirement.

22.26 Review of decisions

- (1) In this regulation:
decision has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.
- (2) Application may be made to the Tribunal for review of a decision of:
- (a) the Commissioner under the following provisions:
- (i) paragraph 3.24 (1) (b) ('Commissioner may request samples and viability statement');
 - (ii) subregulation 3.25 (2) ('request for Commissioner's certificate authorising release of sample of a micro-organism');
 - (ia) paragraph 4.3 (2) (b) ('prescribed documents: public inspection');
 - (iii) subregulation 5.5 (3) ('dismissal of opposition');
 - (iv) subregulation 5.6 (3) ('determination of opposition');
 - (v) subparagraph 6.2 (1) (b) (ii) ('prescribed period: grant of standard patent');
 - (vaa) regulation 10.7 ('correction of register or patent'), except subregulations 10.7 (3), (7) or (8);
 - (va) subregulation 13.4 (3);
 - (vi) subregulation 22.21 (5) ('protection or compensation of certain persons'); or
- (b) the Board under the following provisions:
- (i) regulation 20.5 ('evidence of academic qualifications');
 - (ii) regulation 20.7 ('evidence of knowledge requirements'); or

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- (c) the Designated Manager under the following provisions:
 - (i) regulation 20.28 ('failure to comply with continuing professional education requirements');
 - (ii) regulation 20.29 ('restoring attorney's name to Register');
 - (iii) regulation 20.30 ('restoring attorney's name to Register following payment of unpaid fee');
 - (iv) regulation 20.31 ('returning to Register in other circumstances'); or
 - (d) the Disciplinary Tribunal under the following provisions:
 - (i) regulation 20.43 ('decision of Disciplinary Tribunal');
 - (ii) regulation 20.44 ('penalties — professional misconduct');
 - (iii) regulation 20.45 ('penalties — unsatisfactory professional conduct');
 - (iv) regulation 20.46 ('finding that attorney was unqualified at time of registration');
 - (v) regulation 20.47 ('finding that registration obtained by fraud').
- (3) If the Commissioner gives a person affected by a decision referred to in subregulation (2) 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 Tribunal for review of that decision by or on behalf of the person whose interests are affected by it.
- (4) Failure to comply with subregulation (3) in relation to a decision does not affect the validity of the decision.
- (5) If the Tribunal reviews a decision of the Commissioner under subsection 224 (1) of the Act and the decision is not affirmed, the Commissioner must publish a notice of the decision of the Tribunal in the *Official Journal*.

Chapter 23 Transitional and savings provisions

23.1 Saving: prohibition orders

Subsection 4 (2) of the 1952 Act continues in force.

23.2 Delegation: certain matters referred to in this Chapter

Section 11 of the 1952 Act continues on and after the commencing day in respect of the exercise by the Commissioner of his or her powers and functions in relation to the operation of:

- (a) subsection 234 (3) of the Act; or
- (b) a following provision of this Chapter.

23.3 Opposition to grant: practice and procedure

- (1) Division 1 of Part XIV and regulations 82 and 83A of the former patents Regulations continue to apply in relation to opposition to the grant of a standard patent on an application:
 - (a) to which subsection 234 (3) of the Act refers; and
 - (b) acceptance of which has been advertised under the 1952 Act.
- (2) Chapter 5 of these Regulations does not apply to opposition to an application to which subregulation (1) applies.
- (3) Chapter 5 of these Regulations applies to opposition to an application:
 - (a) to which subsection 234 (3) of the Act refers; and
 - (b) of which advertisement of acceptance has taken place under the Act.

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23.4 Certain opposition: practice and procedure

- (1) If, before the commencing day:
 - (a) a matter is advertised in the *Official Journal*; or
 - (b) a document is served on a person;
to enable opposition proceedings to be taken, other than in relation to the grant of a standard patent;
 - (c) the following provisions of the 1952 Act continue to apply:
 - (i) sections 82, 83, 84, 85 and 94;
 - (ii) subsections 160 (5) and (6); and
 - (d) the following provisions of the former patents Regulations continue to apply:
 - (i) regulations 36, 39B, 39C, 39D, 48, 49, 50, 51, 52, 76, 77, 78, 82, 83A and 92;
 - (ii) Divisions 1 and 2 of Part XIV.
- (2) If provisions specified in subregulation (1) continue to apply, the following provisions do not apply to the opposition referred to in that subregulation:
 - (a) sections 104 and 223 of the Act;
 - (b) Chapter 5 and regulations 22.21, 22.22 and 22.23 of these Regulations.

23.5 Fees payable for certain matters relating to opposition

The fee payable in respect of opposition proceedings of the kind mentioned in regulation 23.3 or 23.4 is the fee that would have been payable if these Regulations applied to those proceedings.

23.6 Certain delegations: opposition

The delegation of a person who, before the commencing day, was:

- (a) the delegate of the Commissioner under the 1952 Act; and

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- (b) exercising the powers of the Commissioner in relation to a matter to which regulation 23.3 or 23.4 applies; continues in relation to the matter.

23.7 Certain undertakings

If an undertaking referred to in paragraph 3.25 (4) (c) is given in respect of an application lodged under the 1952 Act, the reference to Chapter 5 of the Act in subparagraph 3.25 (4) (c) (i) includes a reference to Part V of the 1952 Act.

23.8 Restoration of lapsed applications or ceased patents

- (1) If, before the commencing day:
 - (a) an application lapses under:
 - (i) section 47C or 47D of the 1952 Act; or
 - (ii) subregulation 7B (4) or (5) of the former patents Regulations; or
 - (b) a patent ceases because of failure to pay a prescribed fee within the prescribed time; and an application is made for the restoration of the lapsed application or ceased patent, as the case may be, under:
 - (c) subsection 47E (2) or 97 (1) of the 1952 Act; or
 - (d) subregulation 7B (6) of the former patents Regulations; section 47E, subsection 97 (2) or (3) or section 98 of the 1952 Act or the prescribed provisions of the former patents Regulations, as the case requires, continues to apply in relation to that lapsed application or ceased patent and the corresponding provisions of the Act and these Regulations do not so apply.
- (2) There is payable to the Commissioner in respect of a lapsed application or ceased patent to which subregulation (1) applies a fee of the amount specified in column 3 of item 8 of Part 1 in Schedule 2 to the former patents Regulations.
- (3) In subregulation (1), **prescribed provisions** means:
 - (a) regulations 16D, 16E, 16F, 41, 42, 43, 44, 82, 83A, 92; or
 - (b) Division 1 of Part XIV.

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23.9 Certain continuation and renewal fees

- (1) If, before the commencing day:
- (a) the second year after lodgment of a complete specification ends; and
 - (b) the continuation fee prescribed in respect of that year in relation to the specification is payable but has not been paid;
- item 7 of Part 2 in Schedule 7 is taken to include a fee of \$75 in respect of the second anniversary.
- (2) If, before the commencing day:
- (a) the second year of a patent ends; and
 - (b) the renewal fee prescribed in respect of that year in relation to the patent is payable but has not been paid;
- item 7 of Part 2 in Schedule 7 is taken to include a fee of \$75 in respect of the second anniversary.

23.10 Fee taken to have been paid

If:

- (a) in respect of the lodging of an application for an extension of time, a fee specified in item 27 of Part 1 in Schedule 2 to the former patents Regulations is paid in respect of a period referred to in subsection 54 (1B) of the 1952 Act; and
 - (b) the application has not been accepted before the commencing day; and
 - (c) the applicant is required to pay the fee specified in item 22 of Part 2 in Schedule 7 to these Regulations in relation to the application;
- the fee under item 22 is taken to have been paid in respect of the period referred to in paragraph (a).

23.11 Supply of product referred to in section 117 of the Act

- (1) If:

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- (a) a product to which section 117 of the Act applies is supplied by a person to another person before the commencing day; and
 - (b) the supply would not have infringed a patent under the 1952 Act before the commencing day; and
 - (c) the first-mentioned person supplies the product to another person after the commencing day;
- section 117 of the Act does not apply to the supply referred to in paragraph (c).
- (2) In subregulation (1), a reference to the first-mentioned person includes:
 - (a) on the death of the person — the legal personal representative of the estate of the person who has died; or
 - (b) if the person becomes bankrupt — the person who becomes, under the *Bankruptcy Act 1966*, the trustee in bankruptcy of the estate of the first-mentioned person; or
 - (c) if a body corporate is being wound up — the person appointed to be the liquidator of the body corporate; or
 - (d) if the person agrees to dispose of a business relating to the supply of the product — a person who acquires that business, whether from the first-mentioned person or from some other person.

23.12 Certain withdrawn, abandoned or refused applications

- (1) On and after the commencing day, section 142AA of the 1952 Act continues to apply to an application referred to in subsection 234 (2) of the Act.
- (2) Section 96 of the Act does not apply to an application to which subregulation (1) applies.

23.13 Certain certificates of validity

If:

- (a) a court certifies under section 169 of the 1952 Act in relation to the validity of a patent or of a claim; and

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- (b) the validity of the patent or claim is disputed on or after the commencing day;
the certificate referred to in paragraph (a) is taken to have been issued under subsection 19 (1) of the Act.

23.14 Certain action under the 1952 Act

If:

- (a) a provision of the Act requires an act to be done under that or another particular provision of the Act; and
- (b) the act was done under a corresponding provision of the 1952 Act;

that act is taken to have been done under the provision referred to in paragraph (a) under which the act is required to be done.

23.15 Amendment of petty patents

The complete specification of a petty patent granted under section 62A of the 1952 Act cannot be amended under the Act so as to include more than 1 claim.

23.16 Certain applications under 1952 Act: time for acceptance

- (1) This regulation applies to an invention referred to in paragraph 45 (1) (b) or 48 (1) (a) of the Act that is, so far as claimed in any claim, the subject of:
 - (a) a claim of the complete specification in relation to an application for a standard patent referred to in subparagraph 48 (3) (a) (i) of the 1952 Act; or
 - (b) the claim of the complete specification in relation to an application for a petty patent referred to in subparagraph 48 (3) (a) (ii) of the 1952 Act;the priority date of which is earlier than the priority date of the first-mentioned claim.

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- (2) If, under paragraph 45 (1) (b) or 48 (1) (a) of the Act, the Commissioner reports that the first-mentioned claim in subregulation (1) is a claim the priority date of which is later than the priority date of the claim referred to in paragraph (1) (a) or (b), he or she may defer acceptance of the application and complete specification until the end of 3 months after:
- (a) the date on which a patent was sealed on the application referred to in paragraph (1) (a) or (b); or
 - (b) the date on which that application lapsed or was withdrawn or refused.

23.17 PCT applications to which subsection 89 (5) of the Act does not apply

Subsection 89 (5) of the Act does not apply to an application:

- (a) to which subsection 234 (2) of the Act applies; and
- (b) that is 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; and
- (c) in respect of which a filed Preliminary Examination Report made under the PCT reports that an amendment to the application goes beyond the disclosure in the relevant international application that has been filed.

23.18 Certain priority dates: saving

In the case of a claim of a specification:

- (a) relating to a further application for a standard patent or for a petty patent under section 51 of the 1952 Act in respect of an invention disclosed in a provisional specification under that Act; or
 - (b) to which subsection 45 (2), (3), (3A) or (4A) of the 1952 Act applies; or
 - (c) to which subsection 191 (8) of the *Statute Law (Miscellaneous Amendments) Act (No. 1) 1982* applies;
- the priority date is determined under section 45 of the 1952 Act or subsection 191 (8) of the *Statute Law (Miscellaneous Amendments) Act (No. 1) 1982*, as the case requires.

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23.25 Fees

- (1) In this regulation:
continuation fee means a continuation fee for the purposes of section 47D of the 1952 Act.
renewal fee means a renewal fee for the purposes of subsection 68 (2) of that Act.
- (2) Subregulation 22.2 (1) does not apply in respect of:
 - (a) a continuation fee in respect of a year; or
 - (b) a renewal fee in respect of a year of a patent;
that ends on or after the commencing day, if the fee became payable, and was paid, before that day.
- (3) If an application for a standard patent was accepted under section 52 or 52D of the 1952 Act before the commencing day, the fee payable for the sealing of that patent is the fee that was applicable to the sealing of the patent immediately before that day.
- (4) In the case of a PCT application, if:
 - (a) a continuation fee in respect of an anniversary that occurs within the period of 9 months immediately preceding the commencing day; and
 - (b) the continuation fee is not paid in the period referred to in subregulation 13.3 (1) but is paid within 9 months after the anniversary concerned;the prescribed period referred to in subregulation 13.3 (1) is extended to the day on which the fee is paid.

23.26 Certain actions and proceedings

- (1) The 1952 Act applies to an action or proceeding made or started under that Act and not finally dealt with or determined before the commencing day:
 - (a) in which the validity of a patent is disputed; or
 - (b) concerning infringement of a patent.

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- (2) The 1952 Act applies to an action or proceeding in which the validity of a patent granted under the *Patents Act 1990* on an application made under the 1952 Act is disputed.

23.32 Transitional: priority date and date of patent for innovation patent application that is a divisional application of a petty patent or petty patent application

- (1) For an innovation patent that is a divisional application of a petty patent or a petty patent application under section 39 of the old Act:
- (a) the priority date of the innovation patent is the date that would have been the priority date of the application under paragraph 3.12 (1) (c) of the old Regulations if the innovation patent application had been filed as a divisional application under section 39 of the old Act; and
 - (b) the date of the innovation patent is the date that would have been the date of the patent under paragraph 6.3 (1) (f) or (g) of the old Regulations if the innovation patent application had been filed as a divisional application under section 39 of the old Act.

- (2) In this regulation:

old Act means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

old Regulations means the *Patents Regulations 1991* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

23.33 Transitional: examination of innovation patents converted from petty patent applications

- (1) This regulation applies if:
- (a) an innovation patent has been granted; and
 - (b) the application for the innovation patent was converted from an application for a petty patent; and
 - (c) the Commissioner had begun to consider the petty patent application, or had begun to make any investigations in

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- relation to the petty patent application, under section 50 of the old Act; and
- (d) the innovation patent is to be examined under Part 1 of Chapter 9A of the Act.
- (2) In examining the innovation patent, the Commissioner is not required to consider the results of:
- (a) the consideration of the petty patent application; or
 - (b) any investigations made in relation to the petty patent application.
- (3) In this regulation:
- old Act* means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

23.34 Transitional: certain PCT applications

- (1) This regulation applies to a PCT application that:
 - (a) is made on or after the commencement day; and
 - (b) would, if the old Act applied to the application, be an application to which paragraph 88 (2) (a) of the old Act applied.
- (2) The application is to be treated as an application for a standard patent.
- (3) In this regulation:

commencement day means the day the *Patents Amendment (Innovation Patents) Act 2000* commences.

old Act means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

23.35 Transitional: payment of fees for petty patents

- (1) This regulation makes provision in respect of the payment of fees payable for petty patents to which the old Act applies under Part 1 of Schedule 2 to the *Patents Amendment (Innovation Patents) Act 2000*.

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- (2) Subregulations (3) and (4) apply to an application for which the fee mentioned in item 13 of Part 2 of Schedule 7 to the old Regulations is payable.
- (3) If:
 - (a) the fee is not paid when the application is made; and
 - (b) within 1 month after the application is made, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
 - (c) the fee is not paid within the 1 month period; the application is taken not to have been made.
- (4) If the fee is paid, the application is taken to have been made on the date on which the fee was paid.
- (5) Subregulations (6), (7) and (8) apply to a request for which the fee mentioned in paragraph (b) of item 15 of Part 2 of Schedule 7 to the old Regulations is payable.
- (6) The Commissioner must not process the request if the fee has not been paid.
- (7) If:
 - (a) the fee is not paid when the request is made; and
 - (b) within 1 month after the request is made, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month after the date of the invitation; and
 - (c) the fee is not paid within the 1 month period; the request is taken not to have been made.
- (8) If the fee is paid, the request is taken to have been made on the date on which the fee was paid.
- (9) In this regulation:
old Act means the *Patents Act 1990* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

Regulation 23.35

old Regulations means the *Patents Regulations 1991* as in force immediately before the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

Schedule 1 **Budapest Treaty on the
International Recognition of
the Deposit of
Microorganisms for the
Purposes of Patent Procedure**
(subregulation 1.4 (1))

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**BUDAPEST TREATY ON THE INTERNATIONAL
RECOGNITION OF THE DEPOSIT OF MICROORGANISMS
FOR THE PURPOSES OF PATENT PROCEDURE**

Done at Budapest on April 28, 1977, and amended on
September 26, 1980

INTRODUCTORY PROVISIONS

Article 1

Establishment of a Union

The States party to this Treaty (hereinafter called “the Contracting States”) constitute a Union for the international recognition of the deposit of microorganisms for the purposes of patent procedure.

Article 2

Definitions

For the purposes of this Treaty and the Regulations:

- (i) references to a “patent” shall be construed as references to patents for inventions, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition;
- (ii) “deposit of a microorganism” means, according to the context in which these words appear, the following acts effected in accordance with this Treaty and the Regulations; the transmittal of a microorganism to an international depositary authority, which receives and accepts it, or the storage of such a microorganism by the international depositary authority, or both the said transmittal and the said storage;
- (iii) “patent procedure” means any administrative or judicial procedure relating to a patent application or a patent;
- (iv) “publication for the purposes of patent procedure” means the official publication, or the official laying open for public inspection, of a patent application or a patent;
- (v) “intergovernmental industrial property organization” means an organization that has filed a declaration under Article 9 (1);

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- (vi) “industrial property office” means an authority of a Contracting State or an intergovernmental industrial property organization competent for the grant of patents;
- (vii) “depository institution” means an institution which provides for the receipt, acceptance and storage of microorganisms and the furnishing of samples thereof;
- (viii) “international depository authority” means a depository institution which has acquired the status of international depository authority as provided in Article 7;
- (ix) “depositor” means the natural person or legal entity transmitting a microorganism to an international depository authority, which receives and accepts it, and any successor in title of the said natural person or legal entity;
- (x) “Union” means the Union referred to in Article 1;
- (xi) “Assembly” means the Assembly referred to in Article 10;
- (xii) “Organization” means the World Intellectual Property Organization;
- (xiii) “International Bureau” means the International Bureau of the Organization and, as long as it subsists, the United International Bureaux for the Protection of Intellectual Property (BIRPI);
- (xiv) “Director General” means the Director General of the Organization;
- (xv) “Regulations” means the Regulations referred to in Article 12.

CHAPTER I

SUBSTANTIVE PROVISIONS

Article 3

Recognition and Effect of the Deposit of Microorganisms

- (1) (a) Contracting States which allow or require the deposit of microorganisms for the purposes of patent procedure shall recognise, for such purposes, the deposit of a microorganism with any international depository authority. Such recognition shall include the recognition of the fact and date of the deposit as indicated by the international depository authority as well as the recognition of the fact that what is furnished as a sample is a sample of the deposited microorganism.

(b) Any Contracting State may require a copy of the receipt of the deposit referred to in subparagraph (a), issued by the international depositary authority.

(2) As far as matters regulated in this Treaty and the Regulations are concerned, no Contracting State may require compliance with requirements different from or additional to those which are provided in this Treaty and the Regulations.

Article 4

New Deposit

(1) (a) Where the international depositary authority cannot furnish samples of the deposited microorganism for any reason, in particular,

(i) where such microorganism is no longer viable, or

(ii) where the furnishing of samples would require that they be sent abroad and the sending or the receipt of the samples abroad is prevented by export or import restrictions,

that authority shall, promptly after having noted its inability to furnish samples, notify the depositor of such inability, indicating the cause thereof, and the depositor, subject to paragraph (2) and as provided in this paragraph, shall have the right to make a new deposit of the microorganism which was originally deposited.

(b) The new deposit shall be made with the international depositary authority with which the original deposit was made, provided that:

(i) it shall be made with another international depositary authority where the institution with which the original deposit was made has ceased to have the status of international depositary authority, either entirely or in respect of the kind of microorganism to which the deposited microorganism belongs, or where the international depositary authority with which the original deposit was made discontinues, temporarily or definitively, the performance of its functions in respect of deposited microorganisms;

(ii) it may be made with another international depositary authority in the case referred to in subparagraph (a) (ii).

(c) Any new deposit shall be accompanied by a statement signed by the depositor alleging that the newly deposited microorganism is the same as that originally deposited. If the allegation of the depositor is contested, the burden of proof shall be governed by the applicable law.

(d) Subject to subparagraphs (a) to (c) and (e), the new deposit shall be treated as if it had been made on the date on which the original deposit was made where all the preceding statements concerning the viability of the originally deposited microorganism indicated that the microorganism was viable and where the new deposit was made within three months after the date on which the depositor received the notification referred to in subparagraph (a).

(e) Where subparagraph (b) (i) applies and the depositor does not receive the notification referred to in subparagraph (a) within six months after the date on which the termination, limitation or discontinuance referred to in subparagraph (b) (i) was published by the International Bureau, the three-month time limit referred to in subparagraph (d) shall be counted from the date of the said publication.

(2) The right referred to in paragraph (1) (a) shall not exist where the deposited microorganism has been transferred to another international depositary authority as long as that authority is in a position to furnish samples of such microorganism.

Article 5

Export and Import Restrictions

Each Contracting State recognises that it is highly desirable that, if and to the extent to which the export from or import into its territory of certain kinds of microorganisms is restricted, such restrictions should apply to microorganisms deposited, or destined for deposit, under this Treaty only where the restriction is necessary in view of national security or the dangers for health or the environment.

Article 6

Status of International Depositary Authority

(1) In order to qualify for the status of international depositary authority, any depositary institution must be located on the territory of a Contracting State and must benefit from assurances furnished by that State to the effect that the said institution complies and will continue to comply with the requirements specified in paragraph (2). The said assurances may be furnished also by an intergovernmental industrial property organization; in that case, the depositary institution must be located on the territory of a State member of the said organization.

(2) The depositary institution must, in its capacity of international depositary authority:

- (i) have a continuous existence;
- (ii) have the necessary staff and facilities, as prescribed in the Regulations, to perform its scientific and administrative tasks under this Treaty;
- (iii) be impartial and objective;
- (iv) be available, for the purposes of deposit, to any depositor under the same conditions;
- (v) accept for deposit any or certain kinds of microorganisms, examine their viability and store them, as prescribed in the Regulations;
- (vi) issue a receipt to the depositor, and any required viability statement, as prescribed in the Regulations;
- (vii) comply, in respect of the deposited microorganisms, with the requirement of secrecy, as prescribed in the Regulations;
- (viii) furnish samples of any deposited microorganism under the conditions and in conformity with the procedure prescribed in the Regulations.

(3) The Regulations shall provide the measures to be taken:

- (i) where an international depositary authority discontinues, temporarily or definitively, the performance of its functions in respect of deposited microorganisms or refuses to accept any of the kinds of microorganisms which it should accept under the assurances furnished;
- (ii) in case of the termination or limitation of the status of international depositary authority of an international depositary authority.

Article 7

Acquisition of the Status of International Depositary Authority

(1) (a) A depositary institution shall acquire the status of international depositary authority by virtue of a written communication addressed to the Director General by the Contracting State on the territory of which the depositary institution is located and including a declaration of assurances to the effect that the said institution complies and will

continue to comply with the requirements specified in Article 6 (2). The said status may be acquired also by virtue of a written communication addressed to the Director General by an intergovernmental industrial property organisation and including the said declaration.

(b) The communication shall also contain information on the depositary institution as provided in the Regulations and may indicate the date on which the status of international depositary authority should take effect.

(2) (a) If the Director General finds that the communication includes the required declaration and that all the required information has been received, the communication shall be promptly published by the International Bureau.

(b) The status of international depositary authority shall be acquired as from the date of publication of the communication or, where a date has been indicated under paragraph (1) (b) and such date is later than the date of publication of the communication, as from such date.

(3) The details of the procedure under paragraphs (1) and (2) are provided in the Regulations.

Article 8

Termination and Limitation of the Status of International Depositary Authority

(1) (a) Any Contracting State or any intergovernmental industrial property organization may request the Assembly to terminate, or to limit to certain kinds of microorganisms, any authority's status of international depositary authority on the ground that the requirements specified in Article 6 have not been or are no longer complied with. However, such a request may not be made by a Contracting State or intergovernmental industrial property organization in respect of an international depositary authority for which it has made the declaration referred to in Article 7 (1) (a).

(b) Before making the request under subparagraph (a), the Contracting State or the intergovernmental industrial property organization shall, through the intermediary of the Director General, notify the reasons for the proposed request to the Contracting State or the intergovernmental industrial property organization which has made the communication referred to in Article 7 (1) so that that State or organisation may, within

six months from the date of the said notification, take appropriate action to obviate the need for making the proposed request.

(c) Where the Assembly finds that the request is well founded, it shall decide to terminate, or to limit it to certain kinds of microorganisms, the status of international depositary authority of the authority referred to in subparagraph (a). The decision of the Assembly shall require that a majority of two-thirds of the votes cast be in favour of the request.

(2) (a) The Contracting State or intergovernmental industrial property organization having made the declaration referred to in Article 7 (1) (a) may, by a communication addressed to the Director General, withdraw its declaration either entirely or in respect only of certain kinds of microorganisms and in any event shall do so when and to the extent that its assurances are no longer applicable.

(b) Such a communication shall, from the date provided for in the Regulations, entail, where it relates to the entire declaration, the termination of the status of international depositary authority or, where it relates only to certain kinds of microorganisms, a corresponding limitation of such status.

(3) The details of the procedure under paragraphs (1) and (2) are provided in the Regulations.

Article 9

Intergovernmental Industrial Property Organizations

(1) (a) Any intergovernmental organization to which several States have entrusted the task of granting regional patents and of which all the member States are members of the International (Paris) Union for the Protection of Industrial Property may file with the Director General a declaration that it accepts the obligation of recognition provided for in Article 3 (1) (a), the obligation concerning the requirements referred to in Article 3 (2) and all the effects of the provisions of this Treaty and the Regulations applicable to intergovernmental industrial property organizations. If filed before the entry into force of this Treaty according to Article 16 (1), the declaration referred to in the preceding sentence shall become effective on the date of the said entry into force. If filed after such entry into force, the said declaration shall become effective three months after its filing unless a later date has been indicated in the declaration. In the latter case, the declaration shall take effect on the date thus indicated.

(b) The said organization shall have the right provided for in Article 3 (1) (b).

(2) Where any provision of this Treaty or of the Regulations affecting intergovernmental industrial property organizations is revised or amended, any intergovernmental industrial property organization may withdraw its declaration referred to in paragraph (1) by notification addressed to the Director General. The withdrawal shall take effect:

- (i) where the notification has been received before the date on which the revision or amendment enters into force, on that date;
- (ii) where the notification has been received after the date referred to in (i), on the date indicated in the notification or, in the absence of such indication, three months after the date on which the notification was received.

(3) In addition to the case referred to in paragraph (2), any intergovernmental industrial property organization may withdraw its declaration referred to in paragraph (1) (a) by notification addressed to the Director General. The withdrawal shall take effect two years after the date on which the Director General has received the notification. No notification of withdrawal under this paragraph shall be receivable during a period of five years from the date on which the declaration took effect.

(4) The withdrawal referred to in paragraph (2) or (3) by an intergovernmental industrial property organization whose communication under Article 7 (1) has led to the acquisition of the status of international depositary authority by a depositary institution shall entail the termination of such status one year after the date on which the Director General has received the notification of withdrawal.

(5) Any declaration referred to in paragraph (1) (a), notification of withdrawal referred to in paragraph (2) or (3), assurances furnished under Article 6 (1), second sentence, and included in a declaration made in accordance with Article 7 (1) (a), request made under Article 8 (1) and communication of withdrawal referred to in Article 8 (2) shall require the express previous approval of the supreme governing organ of the intergovernmental industrial property organization whose members are all the States members of the said organization and in which decisions are made by the official representatives of the governments of such States.

CHAPTER II

ADMINISTRATIVE PROVISIONS

Article 10

Assembly

- (1) (a) The Assembly shall consist of the Contracting States.
 - (b) Each Contracting State shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
 - (c) Each intergovernmental industrial property organization shall be represented by special observers in the meetings of the Assembly and any committee and working group established by the Assembly.
 - (d) Any State not member of the Union which is a member of the Organization or of the International (Paris) Union for the Protection of Industrial Property and any intergovernmental organization specialised in the field of patents other than an intergovernmental industrial property organization as defined in Article 2 (v) may be represented by observers in the meetings of the Assembly and, if the Assembly so decides, in the meetings of any committee or working group established by the Assembly.
- (2) (a) The Assembly shall:
- (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Treaty;
 - (ii) exercise such rights and perform such tasks as are specially conferred upon it or assigned to it under this Treaty;
 - (iii) give directions to the Director General concerning the preparations for revision conferences;
 - (iv) review and approve the reports and activities of the Director General concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;

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- (v) establish such committees and working groups as it deems appropriate to facilitate the work of the Union;
 - (vi) determine, subject to paragraph (1) (d), which States other than Contracting States, which intergovernmental organizations other than intergovernmental industrial property organizations as defined in Article 2 (v) and which international non-governmental organizations shall be admitted to its meetings as observers and to what extent international depositary authorities shall be admitted to its meetings as observers;
 - (vii) take any other appropriate action designed to further the objectives of the Union;
 - (viii) perform such other functions as are appropriate under this Treaty.
- (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.
- (3) A delegate may represent, and vote in the name of, one State only.
- (4) Each Contracting State shall have one vote.
- (5) (a) One-half of the Contracting States shall constitute a quorum.
- (b) In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence as provided in the Regulations.
- (6) (a) Subject to Articles 8 (1) (c), 12 (4) and 14 (2) (b), the decisions of the Assembly shall require a majority of the votes cast.
- (b) Abstentions shall not be considered as votes.
- (7) (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the General Assembly of the Organization.
- (b) The Assembly shall meet in extraordinary session upon convocation by the Director General, either on his own initiative or at the request of one-fourth of the Contracting States.

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- (8) The Assembly shall adopt its own rules of procedure.

Article 11

International Bureau

- (1) The International Bureau shall:
- (i) perform the administrative tasks concerning the Union, in particular such tasks as are specifically assigned to it under this Treaty and the Regulations or by the Assembly;
 - (ii) provide the secretariat of revision conferences, of the Assembly, of committees and working groups established by the Assembly, and of any other meeting convened by the Director General and dealing with matters of concern to the Union.
- (2) The Director General shall be the chief executive of the Union and shall represent the Union.
- (3) The Director General shall convene all meetings dealing with matters of concern to the Union.
- (4) (a) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly, and any other meeting convened by the Director General and dealing with matters of concern to the Union.
- (b) The Director General, or a staff member designated by him, shall be ex officio secretary of the Assembly, and of the committees, working groups and other meetings referred to in subparagraph (a).
- (5) (a) The Director General shall, in accordance with the directions of the Assembly, make the preparations for revision conferences.
- (b) The Director General may consult with intergovernmental and international non-governmental organizations concerning the preparations for revision conferences.
 - (c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at revision conferences.
 - (d) The Director General, or a staff member designated by him, shall be ex officio secretary of any revision conference.

Article 12

Regulations

- (1) The Regulations provide rules concerning:
 - (i) matters in respect of which this Treaty expressly refers to the Regulations or expressly provides that they are or shall be prescribed;
 - (ii) any administrative requirements, matters or procedures;
 - (iii) any details useful in the implementation of this Treaty.
- (2) The Regulations adopted at the same time as this Treaty are annexed to this Treaty.
- (3) The Assembly may amend the Regulations.
- (4) (a) Subject to subparagraph (b), adoption of any amendment of the Regulations shall require two-thirds of the votes cast.
 - (b) Adoption of any amendment concerning the furnishing of samples of deposited microorganisms by the international depositary authorities shall require that no Contracting State vote against the proposed amendment.
- (5) In the case of conflict between the provisions of this Treaty and those of the Regulations, the provisions of this Treaty shall prevail.

CHAPTER III

REVISION AND AMENDMENT

Article 13

Revision of the Treaty

- (1) This Treaty may be revised from time to time by conferences of the Contracting States.
- (2) The convocation of any revision conference shall be decided by the Assembly.
- (3) Articles 10 and 11 may be amended either by a revision conference or according to Article 14.

Article 14

Amendment of Certain Provisions of the Treaty

- (1) (a) Proposals under this Article for the amendment of Articles 10 and 11 may be initiated by any Contracting State or by the Director General.
- (b) Such proposals shall be communicated by the Director General to the Contracting States at least six months in advance of their consideration by the Assembly.
- (2) (a) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly.
- (b) Adoption of any amendment to Article 10 shall require four-fifths of the votes cast; adoption of any amendment to Article 11 shall require three-fourths of the votes cast.
- (3) (a) Any amendment to the Articles referred to in paragraph (1) shall enter in to force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the Contracting States members of the Assembly at the time the Assembly adopted the amendment.
- (b) Any amendment to the said Articles thus accepted shall bind all the Contracting States which were Contracting States at the time the amendment was adopted by the Assembly, provided that any amendment creating financial obligations for the said Contracting States or increasing such obligations shall bind only those Contracting States which have notified their acceptance of such amendment.
- (c) Any amendment which has been accepted and which has entered into force in accordance with subparagraph (a) shall bind all States which become Contracting States after the date on which the amendment was adopted by the Assembly.

CHAPTER IV

FINAL PROVISIONS

Article 15

Becoming Party to the Treaty

- (1) Any State member of the International (Paris) Union for the Protection of Industrial Property may become party to this Treaty by:

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- (i) signature followed by the deposit of an instrument of ratification, or
 - (ii) deposit of an instrument of accession.
- (2) Instruments of ratification or accession shall be deposited with the Director General.

Article 16

Entry Into Force of the Treaty

- (1) This Treaty shall enter into force, with respect to the first five States which have deposited their instruments of ratification or accession, three months after the date on which the fifth instrument of ratification or accession has been deposited.
- (2) This Treaty shall enter into force with respect to any other State three months after the date on which that State has deposited its instrument of ratification or accession unless a later date has been indicated in the instrument of ratification or accession. In the latter case, this Treaty shall enter into force with respect to that State on the date thus indicated.

Article 17

Denunciation of the Treaty

- (1) Any Contracting State may denounce this Treaty by notification addressed to the Director General.
- (2) Denunciation shall take effect two years after the day on which the Director General has received the notification.
- (3) The right of denunciation provided for in paragraph (1) shall not be exercised by any Contracting State before the expiration of five years from the date on which it becomes party to this Treaty.
- (4) The denunciation of this Treaty by a Contracting State that has made a declaration referred to in Article 7 (1) (a) with respect to a depositary institution which thus acquired the status of international depositary authority shall entail the termination of such status one year after the day on which the Director General received the notification referred to in paragraph (1).

Article 18

Signature and Languages of the Treaty

- (1) (a) This Treaty shall be signed in a single or original in the English and French languages, both texts being equally authentic.
- (b) Official texts of this Treaty shall be established by the Director General, after consultation with the interested Governments and within two months from the date of signature of this Treaty, in the other languages in which the Convention Establishing the World Intellectual Property Organization was signed.
- (c) Official texts of this Treaty shall be established by the Director General, after consultation with the interested Governments, in the Arabic, German, Italian, Japanese and Portuguese languages, and such other languages as the Assembly may designate.
- (2) This Treaty shall remain open for signature at Budapest until December 31, 1977.

Article 19

Deposit of the Treaty; Transmittal of Copies; Registration of the Treaty

- (1) The original of this Treaty, when no longer open for signature, shall be deposited with the Director General.
- (2) The Director General shall transmit two copies, certified by him, of this Treaty and the Regulations to the Governments of all the States referred to in Article 15 (1), to the intergovernmental organizations that may file a declaration under Article 9 (1) (a) and, on request, to the Government of any other State.
- (3) The Director General shall register this Treaty with the Secretariat of the United Nations.
- (4) The Director General shall transmit two copies, certified by him, of any amendment to this Treaty and to the Regulations to all Contracting States, to all intergovernmental industrial property organizations and, on request, to the Government of any other State and to any other intergovernmental organization that may file a declaration under Article 9 (1) (a).

Article 20

Notifications

The Director General shall notify the Contracting States, the intergovernmental industrial property organizations and those States not members of the Union which are members of the International (Paris) Union for the Protection of Industrial Property of:

- (i) signatures under Article 18;
- (ii) deposits of instruments of ratification or accession under Article 15 (2);
- (iii) declarations filed under Article 9 (1) (a) and notifications of withdrawal under Article 9 (2) or (3);
- (iv) the date of entry into force of this Treaty under Article 16 (1);
- (v) the communications under Articles 7 and 8 and the decisions under Article 8;
- (vi) acceptance of amendments to this Treaty under Article 14 (3);
- (vii) any amendment of the Regulations;
- (viii) the dates on which amendments to the Treaty or the Regulations enter into force;
- (ix) denunciations received under Article 17.

Schedule 1A Regulations under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

(subregulation 1.4 (1))

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**REGULATIONS UNDER THE BUDAPEST TREATY ON THE
INTERNATIONAL RECOGNITION OF THE
DEPOSIT OF MICROORGANISMS FOR THE PURPOSES OF
PATENT PROCEDURE**

Adopted on April 28, 1977 and amended on January 20, 1981 and on
October 1, 2002

Rule 1

Abbreviated Expressions and Interpretation of the Word “Signature”

1.1 “*Treaty*”

In these Regulations, the word “Treaty” means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.

1.2 “*Article*”

In these Regulations, the word “Article” refers to the specified Article of the Treaty.

1.3 “*Signature*”

In these Regulations, whenever the word “signature” is used, it shall be understood that, where the law of the State on the territory of which an international depositary authority is located requires the use of a seal instead of a signature, the said word shall mean “seal” for the purposes of that authority.

Rule 2

International Depositary Authorities

2.1 *Legal Status*

Any international depositary authority may be a government agency, including any public institution attached to a public administration other than the central government, or a private entity.

2.2 *Staff and Facilities*

The requirements referred to in Article 6 (2) (ii) shall include in particular the following:

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- (i) the staff and facilities of any international depositary authority must enable the said authority to store the deposited microorganisms in a manner which ensures that they are kept viable and uncontaminated;
 - (ii) any international depositary authority must, for the storage of microorganisms, provide for sufficient safety measures to minimize the risk of losing microorganisms deposited with it.

2.3 *Furnishing of Samples*

The requirements referred to in Article 6 (2) (viii) shall include in particular the requirement that any international depositary authority must furnish samples of deposited microorganisms in an expeditious and proper manner.

Rule 3

Acquisition of the Status of International Depositary Authority

3.1 *Communication*

- (a) The communication referred to in Article 7 (1) shall be addressed to the Director General, in the case of a Contracting State, through diplomatic channels or, in the case of an intergovernmental industrial property organisation, by its chief executive officer.
- (b) The communication shall:
 - (i) indicate the name and address of the depositary institution to which the communication relates;
 - (ii) contain detailed information as to the said institution's capacity to comply with the requirements specified in Article 6 (2), including information on its legal status, scientific standing, staff and facilities;
 - (iii) where the said depositary institution intends to accept for deposit only certain kinds of microorganisms, specify such kinds;
 - (iv) indicate the amount of any fees that the said institution will, upon acquiring the status of international depositary authority, charge for storage, viability statements and furnishing of samples of microorganisms;

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- (v) indicate the official language or languages of the said institution;
 - (vi) where applicable, indicate the date referred to in Article 7 (1) (b).

3.2 *Processing of the Communication*

If the communication complies with Article 7 (1) and Rule 3.1, it shall be promptly notified by the Director General to all Contracting States and intergovernmental industrial property organizations and shall be promptly published by the International Bureau.

3.3 *Extension of the List of Kinds of Microorganisms Accepted*

The Contracting State or intergovernmental industrial property organization having made the communication referred to in Article 7 (1) may, at any time thereafter, notify the Director General that its assurances are extended to specified kinds of microorganisms to which, so far, the assurances have not extended. In such a case, and as far as the additional kinds of microorganisms are concerned, Article 7 and Rules 3.1 and 3.2 shall apply, *mutatis mutandis*.

Rule 4

Termination or Limitation of the Status of International Depositary Authority

4.1 *Request; Processing of Request*

- (a) The request referred to in Article 8 (1) (a) shall be addressed to the Director General as provided in Rule 3.1 (a).
- (b) The request shall:
 - (i) indicate the name and address of the international depositary authority concerned;
 - (ii) where it relates only to certain kinds of microorganisms, specify such kinds;
 - (iii) indicate in detail the facts on which it is based.
- (c) If the request complies with paragraphs (a) and (b), it shall be promptly notified by the Director General to all Contracting States and intergovernmental industrial property organizations.

(d) Subject to paragraph (e), the Assembly shall consider the request not earlier than six and not later than eight months from the notification of the request.

(e) Where, in the opinion of the Director General, respect of the time limit provided for in paragraph (d) could endanger the interests of actual or potential depositors, he may convene the Assembly for a date earlier than the date of the expiration of the six-month period provided for in paragraph (d).

(f) If the Assembly decides to terminate, or to limit to certain kinds of microorganisms, the status of international depositary authority, the said decision shall become effective three months after the date on which it was made.

4.2 *Communication; Effective Date; Processing of Communication*

(a) The communication referred to in Article 8 (2) (a) shall be addressed to the Director General as provided in Rule 3.1 (a).

(b) The communication shall:

- (i) indicate the name and address of the international depositary authority concerned;
- (ii) where it relates only to certain kinds of microorganisms, specify such kinds;
- (iii) where the Contracting State or intergovernmental industrial property organization making the communication desires that the effects provided for in Article 8 (2) (b) take place on a date later than at the expiration of three months from the date of the communication, indicate that later date.

(c) Where paragraph (b) (iii) applies, the effects provided for in Article 8 (2) (b) shall take place on the date indicated under that paragraph in the communication; otherwise, they shall take place at the expiration of three months from the date of the communication.

(d) The Director General shall promptly notify all Contracting States and intergovernmental industrial property organisations of any communication received under Article 8 (2) and of its effective date under paragraph (c). A corresponding notice shall be promptly published by the International Bureau.

4.3 *Consequences for Deposits*

In the case of a termination or limitation of the status of international depositary authority under Articles 8 (1), 8 (2), 9 (4) or 17 (4), Rule 5.1 shall apply, *mutatis mutandis*.

Rule 5

Defaults by the International Depositary Authority

5.1 *Discontinuance of Performance of Functions in Respect of Deposited Microorganisms*

(a) If any international depositary authority temporarily or definitively discontinues the performance of any of the tasks it should perform under the Treaty and these Regulations in relation to any microorganisms deposited with it, the Contracting State or intergovernmental industrial property organization which, in respect of that authority, has furnished the assurances under Article 6 (1) shall:

- (i) ensure, to the fullest extent possible, that samples of all such microorganisms are transferred promptly and without deterioration or contamination from the said authority (“the defaulting authority”) to another international depositary authority (“the substitute authority”);
- (ii) ensure, to the fullest extent possible, that all mail or other communications addressed to the defaulting authority, and all files and other relevant information in the possession of that authority, in respect of the said microorganisms are promptly transferred to the substitute authority;
- (iii) ensure, to the fullest extent possible, that the defaulting authority promptly notifies all depositors affected of the discontinuance of the performance of its functions and the transfers effected;
- (iv) promptly notify the Director General of the fact and the extent of the discontinuance in question and of the measures which have been taken by the said Contracting State or intergovernmental industrial property organization under (i) to (iii).

(b) The Director General shall promptly notify the Contracting States and the intergovernmental industrial property organizations as well as the industrial property offices of the notification received under

paragraph (a) (iv); the notification of the Director General and the notification received by him shall be promptly published by the International Bureau.

(c) Under the applicable patent procedure it may be required that the depositor shall, promptly after receiving the receipt referred to in Rule 7.5, notify to any industrial property office with which a patent application was filed with reference to the original deposit the new accession number given to the deposit by the substitute authority.

(d) The substitute authority shall retain in an appropriate form the accession number given by the defaulting authority, together with the new accession number.

(e) In addition to any transfer effected under paragraph (a) (i), the defaulting authority shall, upon request by the depositor, transfer, as far as possible, a sample of any microorganism deposited with it together with copies of all mail or other communications and copies of all files and other relevant information referred to in paragraph (a) (ii) to any international depositary authority indicated by the depositor other than the substitute authority, provided that the depositor pays any expenses to the defaulting authority resulting from the said transfer. The depositor shall pay the fee for the storage of the said sample to the international depositary authority indicated by him.

(f) On the request of any depositor affected, the defaulting authority shall retain, as far as possible, samples of the microorganisms deposited with it.

5.2 Refusal to Accept Certain Kinds of Microorganisms

(a) If any international depositary authority refuses to accept or deposit any of the kinds of microorganisms which it should accept under the assurances furnished, the Contracting State or intergovernmental industrial property organization which, in respect of that authority, has made the declaration referred to in Article 7 (1) (a) shall promptly notify the Director General of the relevant facts and the measures which have been taken.

(b) The Director General shall promptly notify the other Contracting States and intergovernmental industrial property organizations of the notification received under paragraph (a); the notification of the Director

General and the notification received by him shall be promptly published by the International Bureau.

Rule 6

Making the Original Deposit or New Deposit

6.1 *Original Deposit*

(a) The microorganism transmitted by the depositor to the international depositary authority shall, except where Rule 6.2 applies, be accompanied by a written statement bearing the signature of the depositor and containing:

- (i) an indication that the deposit is made under the Treaty and an undertaking not to withdraw it for the period specified in Rule 9.1;
- (ii) the name and address of the depositor;
- (iii) details of the conditions necessary for the cultivation of the microorganism, for its storage and for testing its viability and also, where a mixture of microorganisms is deposited, descriptions of the components of the mixture and at least one of the methods permitting the checking of their presence;
- (iv) an identification reference (number, symbols, etc.) given by the depositor to the microorganism;
- (v) an indication of the properties of the microorganism which are or may be dangerous to health or the environment, or an indication that the depositor is not aware of such properties.

(b) It is strongly recommended that the written statement referred to in paragraph (a) should contain the scientific description and/or proposed taxonomic designation of the deposited microorganism.

6.2 *New Deposit*

(a) Subject to paragraph (b), in the case of a new deposit made under Article 4, the microorganism transmitted by the depositor to the international depositary authority shall be accompanied by a copy of the receipt of the previous deposit, a copy of the most recent statement concerning the viability of the microorganism which was the subject of the previous deposit indicating that the microorganism is viable and a written statement bearing the signature of the depositor and containing:

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- (i) the indications referred to in Rule 6.1 (a) (i) to (v);
 - (ii) a declaration stating the reason relevant under Article 4 (1) (a) for making the new deposit, a statement alleging that the microorganism which is the subject of the new deposit is the same as that which was the subject of the previous deposit, and an indication of the date on which the depositor received the notification referred to in Article 4 (1) (a) or, as the case may be, the date of the publication referred to in Article 4 (1) (e);
 - (iii) where a scientific description and/or proposed taxonomic designation was/were indicated in connection with the previous deposit, the most recent scientific description and/or proposed taxonomic designation as communicated to the international depositary authority with which the previous deposit was made.
- (b) Where the new deposit is made with the international depositary authority with which the previous deposit was made, paragraph (a) (i) shall not apply.
- (c) for the purposes of paragraphs (a) and (b) and of Rule 7.4, “previous deposit” means,
- (i) where the new deposit has been preceded by one or more other new deposits: the most recent of those other new deposits;
 - (ii) where the new deposit has not been preceded by one or more other new deposits: the original deposit.

6.3 *Requirements of the International Depositary Authority*

- (a) Any international depositary authority may require:
 - (i) that the microorganism be deposited in the form and quantity necessary for the purposes of the Treaty and these Regulations;
 - (ii) that a form established by such authority and duly completed by the depositor for the purposes of the administrative procedures of such authority be furnished;
 - (iii) that the written statement referred to in Rule 6.1 (a) or 6.2 (a) be drafted in the language, or in any of the languages, specified by such authority, it being understood that such specification must at least include the official language or languages indicated under Rule 3.1 (b) (v);

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- (iv) that the fee for storage referred to in Rule 12.1 (a) (i) be paid;
and
 - (v) that, to the extent permitted by the applicable law, the depositor enter into a contract with such authority defining the liabilities of the depositor and the said authority.
- (b) Any international depositary authority shall communicate any such requirements and any amendments thereof to the International Bureau.

6.4 *Acceptance Procedure*

- (a) The international depositary authority shall refuse to accept the microorganism and shall immediately notify the depositor in writing of such refusal and of the reasons therefor:
- (i) where the microorganism is not of a kind of microorganism to which the assurances furnished under Rule 3.1 (b) (iii) or 3.3 extend;
 - (ii) where the properties of the microorganism are so exceptional that the international depositary authority is technically not in a position to perform the tasks in relation to it that it must perform under the Treaty and these Regulations;
 - (iii) where the deposit is received in a condition which clearly indicates that the microorganism is missing or which precludes for scientific reasons the acceptance of the microorganism.
- (b) Subject to paragraph (a), the international depositary authority shall accept the microorganism when all the requirements of Rule 6.1 (a) or 6.2 (a) and Rule 6.3 (a) are complied with. If any of those requirements are not complied with, the international depositary authority shall immediately notify the depositor in writing of that fact and invite him to comply with those requirements.
- (c) When the microorganism has been accepted as an original or new deposit, the date of that original or new deposit, as the case may be, shall be the date on which the microorganism was received by the international depositary authority.
- (d) The international depositary authority shall, on the request of the depositor and provided that all the requirements referred to in paragraph (b) are complied with, consider a microorganism, deposited before the acquisition by such authority of the status of international depositary

authority, to have been received, for the purposes of the Treaty, on the date on which such status was acquired.

Rule 7

Receipt

7.1 *Issuance of Receipt*

The international depositary authority shall issue to the depositor, in respect of each deposit of microorganism effected with it or transferred to it, a receipt in attestation of the fact that it has received and accepted the microorganism.

7.2 *Form; Languages; Signature*

- (a) Any receipt referred to in Rule 7.1 shall be established on a form called an “international form,” a model of which shall be established by the Director General in those languages which the Assembly shall designate.
- (b) Any words or letters filled in the receipt in characters other than those of the Latin alphabet shall also appear therein transliterated in characters of the Latin alphabet.
- (c) The receipt shall bear the signature of the person or persons having the power to represent the international depositary authority or that of any other official of that authority duly authorised by the said person or persons.

7.3 *Contents in the Case of the Original Deposit*

Any receipt referred to in Rule 7.1 and issued in the case of an original deposit shall indicate that it is issued by the depositary institution in its capacity of international depositary authority under the Treaty and shall contain at least the following indications:

- (i) the name and address of the international depositary authority;
- (ii) the name and address of the depositor;
- (iii) the date of the original deposit as defined in Rule 6.4 (c);
- (iv) the identification reference (number, symbols, etc.) given by the depositor to the microorganism;

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- (v) the accession number given by the international depositary authority to the deposit;
 - (vi) where the written statement referred to in Rule 6.1 (a) contains the scientific description and/or proposed taxonomic designation of the microorganism, a reference to that fact.

7.4 *Contents in the Case of the New Deposit*

Any receipt referred to in Rule 7.1 and issued in the case of a new deposit effected under Article 4 shall be accompanied by a copy of the receipt of the previous deposit (within the meaning of Rule 6.2 (c)) and a copy of the most recent statement concerning the viability of the microorganism which was the subject of the previous deposit (within the meaning of Rule 6.2 (c)) indicating that the microorganism is viable, and shall at least contain:

- (i) the name and address of the international depositary authority;
- (ii) the name and address of the depositor;
- (iii) the date of the new deposit as defined in Rule 6.4 (c);
- (iv) the identification reference (number, symbols, etc.) given by the depositor to the microorganism;
- (v) the accession number given by the international depositary authority to the new deposit;
- (vi) an indication of the relevant reason and the relevant date as stated by the depositor in accordance with Rule 6.2 (a) (ii);
- (vii) where Rule 6.2 (a) (iii) applies, a reference to the fact that a scientific description and/or a proposed taxonomic designation has/have been indicated by the depositor;
- (viii) the accession number given to the previous deposit (within the meaning of Rule 6.2 (c)).

7.5 *Receipt in the Case of Transfer*

The international depositary authority to which samples of microorganisms are transferred under Rule 5.1 (a) (i) shall issue to the depositor, in respect of each deposit in relation with which a sample is transferred, a receipt indicating that it is issued by the depositary institution in its capacity of international depositary authority under the Treaty and containing at least:

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- (i) the name and address of the international depositary authority;
 - (ii) the name and address of the depositor;
 - (iii) the date on which the transferred sample was received by the international depositary authority (date of the transfer);
 - (iv) the identification reference (number, symbols, etc.) given by the depositor to the microorganism;
 - (v) the accession number given by the international depositary authority;
 - (vi) the name and address of the international depositary authority from which the transfer was effected;
 - (vii) the accession number given by the international depositary authority from which the transfer was effected;
 - (viii) where the written statement referred to in Rule 6.1 (a) or 6.2 (a) contained the scientific description and/or proposed taxonomic designation of the microorganism, or where such scientific description and/or proposed taxonomic designation was/were indicated or amended under Rule 8.1 at a later date, a reference to that fact.

7.6 Communication of the Scientific Description and/or Proposed Taxonomic Designation

On request of any party entitled to receive a sample of the deposited microorganism under Rules 11.1, 11.2 or 11.3, the international depositary authority shall communicate to such party the most recent scientific description and/or proposed taxonomic designation referred to in Rules 6.1 (b), 6.2 (a) (iii) or 8.1 (b) (iii).

Rule 8

Later Indication or Amendment of the Scientific Description and/or Proposed Taxonomic Designation

8.1 Communication

- (a) Where, in connection with the deposit of a microorganism, the scientific description and/or taxonomic designation of the microorganism was/were not indicated, the depositor may later indicate or, where already indicated, may amend such description and/or designation.

(b) Any such later indication or amendment shall be made in a written communication, bearing the signature of the depositor, addressed to the international depositary authority and containing:

- (i) the name and address of the depositor;
- (ii) the accession number given by the said authority;
- (iii) the scientific description and/or proposed taxonomic designation of the microorganism;
- (iv) in the case of an amendment, the last preceding scientific description and/or proposed taxonomic designation.

8.2 *Attestation*

The international depositary authority shall, on the request of the depositor having made the communication referred to in Rule 8.1, deliver to him an attestation showing the data referred to in Rule 8.1 (b) (i) to (iv) and the date of receipt of such communication.

Rule 9

Storage of Microorganisms

9.1 *Duration of the Storage*

Any microorganism deposited with an international depositary authority shall be stored by such authority, with all the care necessary to keep it viable and uncontaminated, for a period of at least five years after the most recent request for the furnishing of a sample of the deposited microorganism was received by the said authority and, in any case, for a period of at least 30 years after the date of the deposit.

9.2 *Secrecy*

No international depositary authority shall give information to anyone whether a microorganism has been deposited with it under the Treaty. Furthermore, it shall not give any information to anyone concerning any microorganism deposited with it under the Treaty except to an authority, natural person or legal entity which is entitled to obtain a sample of the said microorganism under Rule 11 and subject to the same conditions as provided in that Rule.

Rule 10

Viability Test and Statement

10.1 *Obligation to Test*

The international depositary authority shall test the viability of each microorganism deposited with it:

- (i) promptly after any deposit referred to in Rule 6 or any transfer referred to in Rule 5.1;
- (ii) at reasonable intervals, depending on the kind of microorganism and its possible storage conditions, or at any time, if necessary for technical reasons;
- (iii) at any time, on the request of the depositor.

10.2 *Viability Statement*

(a) The international depositary authority shall issue a statement concerning the viability of the deposited microorganism:

- (i) to the depositor, promptly after any deposit referred to in Rule 6 or any transfer referred to in Rule 5.1;
- (ii) to the depositor, on his request, at any time after the deposit or transfer;
- (iii) to any industrial property office, other authority, natural person or legal entity, other than the depositor, to whom or to which samples of the deposited microorganism were furnished in conformity with Rule 11, on his or its request, together with or at any time after such furnishing of samples.

(b) The viability statement shall indicate whether the microorganism is or is no longer viable and shall contain:

- (i) the name and address of the international depositary authority issuing it;
- (ii) the name and address of the depositor;
- (iii) the date referred to in Rule 7.3 (iii) or, where a new deposit or a transfer has been made, the most recent of the dates referred to in Rules 7.4 (iii) and 7.5 (iii);
- (iv) the accession number given by the said authority;
- (v) the date of the test to which it refers;

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- (vi) information on the conditions under which the viability test has been performed, provided that the said information has been requested by the party to which the viability statement is issued and that the results of the test were negative.
 - (c) In the cases of paragraph (a) (ii) and (iii), the viability statement shall refer to the most recent viability test.
 - (d) As to form, languages and signature, Rule 7.2 shall apply, *mutatis mutandis*, to the viability statement.
 - (e) In the case of paragraph (a) (i) or where the request is made by an industrial property office, the issuance of the viability statement shall be free of charge. Any fee payable under Rule 12.1 (a) (iii) in respect of any other viability statement shall be chargeable to the party requesting the statement and shall be paid before or at the time of making the request.

Rule 11

Furnishing of Samples

11.1 Furnishing of Samples to Interested Industrial Property Offices

Any international depositary authority shall furnish a sample of any deposited microorganism to the industrial property office of any Contracting State or of any intergovernmental industrial property organization, on the request of such office, provided that the request shall be accompanied by a declaration to the effect that:

- (i) an application referring to the deposit of that microorganism has been filed with that office for the grant of a patent and that the subject matter of that application involves the said microorganism or the use thereof;
- (ii) such application is pending before that office or has led to the grant of a patent;
- (iii) the sample is needed for the purposes of a patent procedure having effect in the said Contracting State or in the said organization or its member States;
- (iv) the said sample and any information accompanying or resulting from it will be used only for the purposes of the said patent procedure.

11.2 *Furnishing of Samples to or with the Authorisation of the Depositor*

Any international depositary authority shall furnish a sample of any deposited microorganism:

- (i) to the depositor, on his request;
- (ii) to any authority, natural person or legal entity (hereinafter referred to as “the authorised party”), on the request of such party, provided that the request is accompanied by a declaration of the depositor authorising the requested furnishing of a sample.

11.3 *Furnishing of Samples to Parties Legally Entitled*

(a) Any international depositary authority shall furnish a sample of any deposited microorganism to any authority, natural person or legal entity (hereinafter referred to as “the certified party”), on the request of such party, provided that the request is made on a form whose contents are fixed by the Assembly and that on the said form the industrial property office certifies:

- (i) that an application referring to the deposit of that microorganism has been filed with that office for the grant of a patent and that the subject-matter of that application involves the said microorganism or the use thereof;
- (ii) that, except where the second phrase of (iii) applies, publication for the purposes of patent procedure has been effected by that office;
- (iii) *either* that the certified party has a right to a sample of the microorganism under the law governing patent procedure before that office and, where the said law makes the said right dependent on the fulfilment of certain conditions, that that office is satisfied that such conditions have actually been fulfilled *or* that the certified party has affixed his signature on a form before that office and that, as a consequence of the signature of the said form, the conditions for furnishing a sample to the certified party are deemed to be fulfilled in accordance with the law governing patent procedure before that office, where the certified party has the said right under the said law prior to publication for the purposes of patent procedure by the said

office and such publication has not yet been effected, the certification shall expressly state so and shall indicate, by citing it in the customary manner, the applicable provision of the said law, including any court decision.

(b) In respect of patents granted and published by any industrial property office, such office may from time to time communicate to any international depositary authority lists of the accession numbers given by that authority to the deposits of the microorganisms referred to in the said patents. The international depositary authority shall, on the request of any authority, natural person or legal entity (hereinafter referred to as “the requesting party”), furnish to it a sample of any microorganism where the accession number has been so communicated. In respect of deposited microorganisms whose accession numbers have been so communicated, the said office shall not be required to provide the certification referred to in Rule 11.3 (a).

11.4 *Common Rules*

(a) Any request, declaration, certification or communication referred to in Rules 11.1, 11.2 and 11.3 shall be

- (i) in English, French, Russian or Spanish where it is addressed to an international depositary authority whose official language is or whose official languages include English, French, Russian or Spanish, respectively, provided that, where it must be in Russian or Spanish, it may be instead filed in English or French and, if it is so filed, the International Bureau shall, on the request of the interested party referred to in the said Rules or the international depositary authority, establish, promptly and free of charge, a certified translation into Russian or Spanish;
- (ii) in all other cases, it shall be in English or French, provided that it may be, instead, in the official language or one of the official languages of the international depositary authority.

(b) Notwithstanding paragraph (a), where the request referred to in Rule 11.1 is made by an industrial property office whose official language is Russian or Spanish, the said request may be in Russian or Spanish, respectively, and the International Bureau shall establish, promptly and free of charge, a certified translation into English or

French, on the request of that office or the international depositary authority which received the said request.

(c) Any request, declaration, certification or communication referred to in Rules 11.1, 11.2 and 11.3 shall be in writing, shall bear a signature and shall be dated.

(d) Any request, declaration or certification referred to in Rules 11.1, 11.2 and 11.3 (a) shall contain the following indications:

- (i) the name and address of the industrial property office making the request, of the authorised party or of the certified party, as the case may be;
- (ii) the accession number given to the deposit;
- (iii) in the case of Rule 11.1, the date and number of the application or patent referring to the deposit;
- (iv) in the case of Rule 11.3 (a), the indications referred to in (iii) and the name and address of the industrial property office which has made the certification referred to in the said Rule.

(e) Any request referred to in Rule 11.3 (b) shall contain the following indications:

- (i) the name and address of the requesting party;
- (ii) the accession number given to the deposit.

(f) The container in which the sample furnished is placed shall be marked by the international depositary authority with the accession number given to the deposit and shall be accompanied by a copy of the receipt referred to in Rule 7, an indication of any properties of the microorganism which are or may be dangerous to health or the environment and, upon request, an indication of the conditions which the international depositary authority employs for the cultivation and storage of the microorganism.

(g) The international depositary authority having furnished a sample to any interested party other than the depositor shall promptly notify the depositor in writing of that fact, as well as of the date on which the said sample was furnished and of the name and address of the industrial property office, of the authorised party, of the certified party or of the requesting party, to whom or to which the sample was furnished. The said notification shall be accompanied by a copy of the pertinent request, of any declarations submitted under Rules 11.1 or 11.2 (ii) in connection

with the said request, and of any forms or requests bearing the signature of the requesting party in accordance with Rule 11.3.

(h) The furnishing of samples referred to in Rule 11.1 shall be free of charge. Where the furnishing of samples is made under Rule 11.2 or 11.3, any fee payable under Rule 12.1 (a) (iv) shall be chargeable to the depositor, to the authorised party, to the certified party or to the requesting party, as the case may be, and shall be paid before or at the time of making the said request.

11.5 Changes in Rules 11.1 and 11.3 when Applying to International Applications

Where an application was filed as an international application under the Patent Cooperation Treaty, the reference to the filing of the application with the industrial property office in Rules 11.1 (i) and 11.3 (a) (i) shall be considered a reference to the designation, in the international application, of the Contracting State for which the industrial property office is the “designated Office” within the meaning of that Treaty, and the certification of publication which is required by Rule 11.3 (a) (ii) shall, at the option of the industrial property office, be either a certification of international publication under the said Treaty or a certification of publication by the industrial property office.

Rule 12

Fees

12.1 Kinds and Amounts

(a) Any international depositary authority may, with respect to the procedure under the Treaty and these Regulations, charge a fee:

- (i) for storage;
- (ii) for the attestation referred to in Rule 8.2;
- (iii) subject to Rule 10.2 (e), first sentence, for the issuance of viability statements;
- (iv) subject to Rule 11.4 (h), first sentence, for the furnishing of samples;
- (v) for the communication of information under Rule 7.6.

(b) The fee for storage shall be for the whole duration of the storage of the microorganism as provided in Rule 9.1.

(c) The amount of any fee shall not vary on account of the nationality or residence of the depositor or on account of the nationality or residence of the authority, natural person or legal entity requesting the issuance of a viability statement or furnishing of samples.

12.2 *Change in the Amounts*

(a) Any change in the amount of the fees charged by any international depositary authority shall be notified to the Director General by the Contracting State or intergovernmental industrial property organization which made the declaration referred to in Article 7 (1) in respect of that authority. The notification may, subject to paragraph (c), contain an indication of the date from which the new fees will apply.

(b) The Director General shall promptly notify all Contracting States and intergovernmental industrial property organizations of any notification received under paragraph (a) and of its effective date under paragraph (c); the notification of the Director General and the notification received by him shall be promptly published by the International Bureau.

(c) Any new fees shall apply as of the date indicated under paragraph (a), provided that, where the change consists of an increase in the amounts of the fees or where no date is so indicated, the new fees shall apply as from the thirtieth day following the publication of the change by the International Bureau.

Rule 12^{bis}

Computation of Time Limits

12^{bis}.1 *Periods Expressed in Years*

When a period is expressed as one year or a certain number of years, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

12^{bis}. 2 Periods Expressed in Months

When a period is expressed as one month or a certain number of months, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.

12^{bis}. 3 Periods Expressed in Days

When a period is expressed as a certain number of days, computation shall start on the day following the day on which the relevant event occurred, and the period shall expire on the day on which the last day of the count has been reached.

Rule 13*Publication by the International Bureau**13.1 Form of Publication*

Any publication by the International Bureau referred to in the Treaty or these Regulations shall be made on paper or in electronic form.

13.2 Contents

- (a) At least once a year, preferably in the first quarter of the year, an up-to-date list of the international depository authorities shall be published, indicating in respect of each such authority the kinds of microorganisms that may be deposited with it and the amount of the fees charged by it.
- (b) Full information on any of the following facts shall be published once, promptly after the occurrence of the fact:
 - (i) any acquisition, termination or limitation of the status of international depository authority, and the measures taken in connection with that termination or limitation;
 - (ii) any extension referred to in Rule 3.3;

-
- (iii) any discontinuance of the functions of an international depositary authority, any refusal to accept certain kinds of microorganisms, and the measures taken in connection with such discontinuance or refusal;
 - (iv) any change in the fees charged by an international depositary authority;
 - (v) any requirements communicated in accordance with Rule 6.3 (b) and any amendments thereof.

Rule 14

Expenses of Delegations

14.1 *Coverage of Expenses*

The expenses of each delegation participating in any session of the Assembly and in any committee, working group or other meeting dealing with matters of concern to the Union shall be borne by the State or organisation which has appointed it.

Rule 15

Absence of Quorum in the Assembly

15.1 *Voting by Correspondence*

- (a) In the case provided for in Article 10 (5) (b), the Director General shall communicate any decision of the Assembly (other than decisions relating to the Assembly's own procedure) to the Contracting States which were not represented when the decision was made and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication.
- (b) If, at the expiration of the said period, the number of Contracting States having thus expressed their vote or abstention attains the number of Contracting States which was lacking for attaining the quorum when the decision was made, that decision shall take effect provided that at the same time the required majority still obtains.

Schedule 2 Patent Cooperation Treaty

(subregulation 1.4 (2))

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PATENT COOPERATION TREATY

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

The Contracting States,

Desiring to make a contribution to the progress of science and technology,

Desiring to perfect the legal protection of inventions,

Desiring to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries,

Desiring to facilitate and accelerate access by the public to the technical information contained in documents describing new inventions,

Desiring to foster and accelerate the economic development of developing countries through the adoption of measures designed to increase the efficiency of their legal systems, whether national or regional, instituted for the protection of inventions by providing easily accessible information on the availability of technological solutions applicable to their special needs and by facilitating access to the ever expanding volume of modern technology,

Convinced that cooperation among nations will greatly facilitate the attainment of these aims,

Have concluded the present Treaty.

Introductory Provisions

Article 1

Establishment of a Union

(1) The States party to this Treaty (hereinafter called “the Contracting States”) constitute a Union for cooperation in the filing, searching, and examination, of applications for the protection of inventions, and for rendering special technical services. The Union shall be known as the International Patent Cooperation Union.

(2) No provision of this Treaty shall be interpreted as diminishing the rights under the Paris Convention for the Protection of Industrial Property of any national or resident of any country party to that Convention.

Article 2

Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

- (i) “application” means an application for the protection of an invention; references to an “application” shall be construed as references to applications for patents for inventions, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition;
- (ii) references to a “patent” shall be construed as references to patents for inventions, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition;
- (iii) “national patent” means a patent granted by a national authority;
- (iv) “regional patent” means a patent granted by a national or an intergovernmental authority having the power to grant patents effective in more than one State;
- (v) “regional application” means an application for a regional patent;
- (vi) references to a “national application” shall be construed as references to applications for national patents and regional patents, other than applications filed under this Treaty;
- (vii) “international application” means an application filed under this Treaty;
- (viii) references to an “application” shall be construed as references to international applications and national applications;
- (ix) references to a “patent” shall be construed as references to national patents and regional patents;

(x) references to “national law” shall be construed as references to the national law of a Contracting State or, where a regional application or a regional patent is involved, to the treaty providing for the filing of regional applications or the granting of regional patents;

(xi) “priority date”, for the purposes of computing time limits, means:

- (a) where the international application contains a priority claim under Article 8, the filing date of the application whose priority is so claimed;
- (b) where the international application contains several priority claims under Article 8, the filing date of the earliest application whose priority is so claimed;
- (c) where the international application does not contain any priority claim under Article 8, the international filing date of such application;

(xii) “national Office” means the government authority of a Contracting State entrusted with the granting of patents; references to a “national Office” shall be construed as referring also to any intergovernmental authority which several States have entrusted with the task of granting regional patents, provided that at least one of those States is a Contracting State, and provided that the said States have authorized that authority to assume the obligations and exercise the powers which this Treaty and the Regulations provide for in respect of national Offices;

(xiii) “designated Office” means the national Office of or acting for the State designated by the applicant under Chapter I of this Treaty;

(xiv) “elected Office” means the national Office of or acting for the State elected by the applicant under Chapter II of this Treaty;

(xv) “receiving Office” means the national Office or the intergovernmental organization with which the international application has been filed;

(xvi) “Union” means the International Patent Cooperation Union;

(xvii) “Assembly” means the Assembly of the Union;

(xviii) “Organization” means the World Intellectual Property Organization;

(xix) “International Bureau” means the International Bureau of the Organization and, as long as it subsists, the United International Bureaux for the Protection of Intellectual Property (BIRPI);

(xx) “Director General” means the Director General of the Organization and, as long as BIRPI subsists, the Director of BIRPI.

CHAPTER I

International Application and International Search

Article 3

The International Application

(1) Applications for the protection of inventions in any of the Contracting States may be filed as international applications under this Treaty.

(2) An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.

(3) The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought.

(4) The international application shall:

- (i) be in a prescribed language;
- (ii) comply with the prescribed physical requirements;
- (iii) comply with the prescribed requirement of unity of invention;
- (iv) be subject to the payment of the prescribed fees.

Article 4

The Request

(1) The request shall contain:

(i) a petition to the effect that the international application be processed according to this Treaty;

(ii) the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application (“designated States”); if for any designated State a regional patent is available and the applicant wishes to obtain a regional patent rather than a national patent, the request shall so indicate; if, under a

treaty concerning a regional patent, the applicant cannot limit his application to certain of the States party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent shall be treated as designation of all the States party to that treaty; if, under the national law of the designated State, the designation of that State has the effect of an application for a regional patent, the designation of the said State shall be treated as an indication of the wish to obtain the regional patent;

(iii) the name of and other prescribed data concerning the applicant and the agent (if any);

(iv) the title of the invention;

(v) the name of and other prescribed data concerning the inventor where the national law of at least one of the designated States requires that these indications be furnished at the time of filing a national application. Otherwise, the said indications may be furnished either in the request or in separate notices addressed to each designated Office whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application.

(2) Every designation shall be subject to the payment of the prescribed fee within the prescribed time limit.

(3) Unless the applicant asks for any of the other kinds of protection referred to in Article 43, designation shall mean that the desired protection consists of the grant of a patent by or for the designated State. For the purposes of this paragraph, Article 2 (ii) shall not apply.

(4) Failure to indicate in the request the name and other prescribed data concerning the inventor shall have no consequence in any designated State whose national law requires the furnishing of the said indications but allows that they be furnished at a time later than that of the filing of a national application. Failure to furnish the said indications in a separate notice shall have no consequence in any designated State whose national law does not require the furnishing of the said indications.

*Article 5**The Description*

The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

*Article 6**The Claims*

The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description.

*Article 7**The Drawings*

(1) Subject to the provisions of paragraph (2) (ii), drawings shall be required when they are necessary for the understanding of the invention.

(2) Where, without being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings:

(i) the applicant may include such drawings in the international application when filed,

(ii) any designated Office may require that the applicant file such drawings with it within the prescribed time limit.

*Article 8**Claiming Priority*

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2) (a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or

for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

Article 9

The Applicant

(1) Any resident or national of a Contracting State may file an international application.

(2) The Assembly may decide to allow the residents and the nationals of any country party to the Paris Convention for the Protection of Industrial Property which is not party to this Treaty to file international applications.

(3) The concepts of residence and nationality, and the application of those concepts in cases where there are several applicants or where the applicants are not the same for all the designated States, are defined in the Regulations.

Article 10

The Receiving Office

The international application shall be filed with the prescribed receiving Office, which will check and process it as provided in this Treaty and the Regulations.

Article 11

Filing Date and Effects of the International Application

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:

(i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,

(ii) the international application is in the prescribed language,

(iii) the international application contains at least the following elements:

(a) an indication that it is intended as an international application,

- (b) the designation of at least one Contracting State,
- (c) the name of the applicant, as prescribed,
- (d) a part which on the face of it appears to be a description,
- (e) a part which on the face of it appears to be a claim or claims.

(2) (a) If the receiving Office finds that the international application did not, at the time of receipt, fulfil the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.

(b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.

(3) Subject to Article 64 (4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

(4) Any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) shall be equivalent to a regular national filing within the meaning of the Paris Convention for the Protection of Industrial Property.

Article 12

Transmittal of the International Application to the International Bureau and the International Searching Authority

(1) One copy of the international application shall be kept by the receiving Office (“home copy”), one copy (“record copy”) shall be transmitted to the International Bureau, and another copy (“search copy”) shall be transmitted to the competent International Searching Authority referred to in Article 16, as provided in the Regulations.

(2) The record copy shall be considered the true copy of the international application.

(3) The international application shall be considered withdrawn if the record copy has not been received by the International Bureau within the prescribed time limit.

*Article 13**Availability of Copy of the International Application to Designated Offices*

(1) Any designated Office may ask the International Bureau to transmit to it a copy of the international application prior to the communication provided for in Article 20, and the International Bureau shall transmit such copy to the designated Office as soon as possible after the expiration of one year from the priority date.

(2) (a) The applicant may, at any time, transmit a copy of his international application to any designated Office.

(b) The applicant may, at any time, ask the International Bureau to transmit a copy of his international application to any designated Office, and the International Bureau shall transmit such copy to the designated Office as soon as possible.

(c) Any national Office may notify the International Bureau that it does not wish to receive copies as provided for in subparagraph (b), in which case that subparagraph shall not be applicable in respect of that Office.

*Article 14**Certain Defects in the International Application*

(1) (a) The receiving Office shall check whether the international application contains any of the following defects, that is to say:

- (i) it is not signed as provided in the Regulations;
- (ii) it does not contain the prescribed indications concerning the applicant;
- (iii) it does not contain a title;
- (iv) it does not contain an abstract;
- (v) it does not comply to the extent provided in the Regulations with the prescribed physical requirements.

(b) If the receiving Office finds any of the said defects, it shall invite the applicant to correct the international application within the prescribed time limit, failing which that application shall be considered withdrawn and the receiving Office shall so declare.

(2) If the international application refers to drawings which, in fact, are not included in the application, the receiving Office shall notify the applicant accordingly and he may furnish them within the prescribed time limit and, if he does, the international filing date shall be the date on which the drawings are received by the receiving Office. Otherwise, any reference to the said drawings shall be considered non-existent.

(3) (a) If the receiving Office finds that, within the prescribed time limits, the fees prescribed under Article 3 (4) (iv) have not been paid, or no fee prescribed under Article 4 (2) has been paid in respect of any of the designated States, the international application shall be considered withdrawn and the receiving Office shall so declare.

(b) If the receiving Office finds that the fee prescribed under Article 4 (2) has been paid in respect of one or more (but less than all) designated States within the prescribed time limit, the designation of those States in respect of which it has not been paid within the prescribed time limit shall be considered withdrawn and the receiving Office shall so declare.

(4) If, after having accorded an international filing date to the international application, the receiving Office finds, within the prescribed time limit, that any of the requirements listed in items (i) to (iii) of Article 11 (1) was not complied with at that date, the said application shall be considered withdrawn and the receiving Office shall so declare.

Article 15

The International Search

(1) Each international application shall be the subject of international search.

(2) The objective of the international search is to discover relevant prior art.

(3) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any).

(4) The International Searching Authority referred to in Article 16 shall endeavour to discover as much of the relevant prior art as its facilities permit, and shall, in any case, consult the documentation specified in the Regulations.

(5) (a) If the national law of the Contracting State so permits, the applicant who files a national application with the national Office of or acting for such State may, subject to the conditions provided for in such

law, request that a search similar to an international search (“international-type search”) be carried out on such application.

(b) If the national law of the Contracting State so permits, the national Office of or acting for such State may subject any national application filed with it to an international-type search.

(c) The international-type search shall be carried out by the International Searching Authority referred to in Article 16 which would be competent for an international search if the national application were an international application and were filed with the Office referred to in subparagraphs (a) and (b). If the national application is in a language which the International Searching Authority considers it is not equipped to handle, the international-type search shall be carried out on a translation prepared by the applicant in a language prescribed for international applications and which the International Searching Authority has undertaken to accept for international applications. The national application and the translation, when required, shall be presented in the form prescribed for international applications.

Article 16

The International Searching Authority

(1) International search shall be carried out by a national International Searching Authority, which may be either a national Office or an intergovernmental organization, such as the International Patent Institute, whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications.

(2) If, pending the establishment of a single International Searching Authority, there are several International Searching Authorities, each receiving Office shall, in accordance with the provisions of the applicable agreement referred to in paragraph (3) (b), specify the International Searching Authority or Authorities competent for the searching of international applications filed with such Office.

(3) (a) International Searching Authorities shall be appointed by the Assembly. Any national Office and any intergovernmental organization satisfying the requirements referred to in subparagraph (c) may be appointed as International Searching Authority.

(b) Appointment shall be conditional on the consent of the national Office or intergovernmental organization to be appointed and the conclusion of an agreement, subject to approval by the Assembly,

between such Office or organization and the International Bureau. The agreement shall specify the rights and obligations of the parties, in particular, the formal undertaking by the said Office or organization to apply and observe all the common rules of international search.

(c) The Regulations prescribe the minimum requirements, particularly as to manpower and documentation, which any Office or organization must satisfy before it can be appointed and must continue to satisfy while it remains appointed.

(d) Appointment shall be for a fixed period of time and may be extended for further periods.

(e) Before the Assembly makes a decision on the appointment of any national Office or intergovernmental organization, or on the extension of its appointment, or before it allows any such appointment to lapse, the Assembly shall hear the interested Office or organization and seek the advice of the Committee for Technical Cooperation referred to in Article 56 once that Committee has been established.

Article 17

Procedure Before the International Searching Authority

(1) Procedure before the International Searching Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.

(2) (a) If the International Searching Authority considers

- (i) that the international application relates to a subject matter which the International Searching Authority is not required, under the Regulations, to search, and in the particular case decides not to search, or
- (ii) that the description, the claims, or the drawings, fail to comply with the prescribed requirements to such an extent that a meaningful search could not be carried out,

the said Authority shall so declare and shall notify the applicant and the International Bureau that no international search report will be established.

(b) If any of the situations referred to in subparagraph (a) is found to exist in connection with certain claims only, the international search report shall so indicate in respect of such claims, whereas, for the other claims, the said report shall be established as provided in Article 18.

(3) (a) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the applicant to pay additional fees. The International Searching Authority shall establish the international search report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to inventions in respect of which the said fees were paid.

(b) The national law of any designated State may provide that, where the national Office of that State finds the invitation, referred to in subparagraph (a), of the International Searching Authority justified and where the applicant has not paid all additional fees, those parts of the international application which consequently have not been searched shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.

Article 18

The International Search Report

(1) The international search report shall be established within the prescribed time limit and in the prescribed form.

(2) The international search report shall, as soon as it has been established, be transmitted by the International Searching Authority to the applicant and the International Bureau.

(3) The international search report or the declaration referred to in Article 17 (2) (a) shall be translated as provided in the Regulations. The translations shall be prepared by or under the responsibility of the International Bureau.

*Article 19**Amendment of the Claims Before the International Bureau*

(1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

(2) The amendments shall not go beyond the disclosure in the international application as filed.

(3) If the national law of any designated State permits amendments to go beyond the said disclosure, failure to comply with paragraph (2) shall have no consequence in that State.

*Article 20**Communication to Designated Offices*

(1) (a) The international application, together with the international search report (including any indication referred to in Article 17 (2) (b)) or the declaration referred to in Article 17 (2) (a), shall be communicated to each designated Office, as provided in the Regulations, unless the designated Office waives such requirements in its entirety or in part.

(b) The communication shall include the translation (as prescribed) of the said report or declaration.

(2) If the claims have been amended by virtue of Article 19 (1), the communication shall either contain the full text of the claims both as filed and as amended or shall contain the full text of the claims as filed and specify the amendments, and shall include the statement, if any, referred to in Article 19 (1).

(3) At the request of the designated Office or the applicant, the International Searching Authority shall send to the said Office or the applicant, respectively, copies of the documents cited in the international search report, as provided in the Regulations.

*Article 21**International Publication*

(1) The International Bureau shall publish international applications.

(2) (a) Subject to the exceptions provided for in subparagraph (b) and in Article 64 (3), the international publication of the international application shall be effected promptly after the expiration of 18 months from the priority date of that application.

(b) The applicant may ask the International Bureau to publish his international application any time before the expiration of the time limit referred to in subparagraph (a). The International Bureau shall proceed accordingly, as provided in the Regulations.

(3) The international search report or the declaration referred to in Article 17 (2) (a) shall be published as prescribed in the Regulations.

(4) The language and form of the international publication and other details are governed by the Regulations.

(5) There shall be no international publication if the international application is withdrawn or is considered withdrawn before the technical preparations for publication have been completed.

(6) If the international application contains expressions or drawings which, in the opinion of the International Bureau, are contrary to morality or public order, or if, in its opinion, the international application contains disparaging statements as defined in the Regulations, it may omit such expressions, drawings, and statements, from its publications, indicating the place and number of words or drawings omitted, and furnishing, upon request, individual copies of the passages omitted.

*Article 22**Copy, Translation, and Fee, to Designated Offices*

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national

application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for that State not later than at the expiration of 30 months from the priority date.

(2) Where the International Searching Authority makes a declaration, under Article 17 (2) (a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).

(3) Any national law may, for performing the acts referred to in paragraphs (1) or (2), fix time limits which expire later than the time limit provided for in those paragraphs.

Article 23

Delaying of National Procedure

(1) No designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22.

(2) Notwithstanding the provisions of paragraph (1), any designated Office may, on the express request of the applicant, process or examine the international application at any time.

Article 24

Possible Loss of Effect in Designated States

(1) Subject, in case (ii) below, to the provisions of Article 25, the effect of the international application provided for in Article 11 (3) shall cease in any designated State with the same consequences as the withdrawal of any national application in that State:

- (i) if the applicant withdraws his international application or the designation of that State;
- (ii) if the international application is considered withdrawn by virtue of Articles 12 (3), 14 (1) (b), 14 (3) (a), or 14 (4), or if the designation of that State is considered withdrawn by virtue of Article 14 (3) (b);
- (iii) if the applicant fails to perform the acts referred to in Article 22 within the applicable time limit.

(2) Notwithstanding the provisions of paragraph (1), any designated Office may maintain the effect provided for in Article 11 (3) even where such effect is not required to be maintained by virtue of Article 25 (2).

Article 25

Review By Designated Offices

(1) (a) Where the receiving Office has refused to accord an international filing date or has declared that the international application is considered withdrawn, or where the International Bureau has made a finding under Article 12 (3), the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to any of the designated Offices named by the applicant.

(b) Where the receiving Office has declared that the designation of any given State is considered withdrawn, the International Bureau shall promptly send, at the request of the applicant, copies of any document in the file to the national Office of such State.

(c) The request under subparagraphs (a) or (b) shall be presented within the prescribed time limit.

(2) (a) Subject to the provisions of subparagraph (b), each designated Office shall, provided that the national fee (if any) has been paid and the appropriate translation (as prescribed) has been furnished within the prescribed time limit, decide whether the refusal, declaration, or finding, referred to in paragraph (1) was justified under the provisions of this Treaty and the Regulations, and, if it finds that the refusal or declaration was the result of an error or omission on the part of the receiving Office or that the finding was the result of an error or omission on the part of the International Bureau, it shall, as far as effects in the State of the designated Office are concerned, treat the international application as if such error or omission had not occurred.

(b) Where the record copy has reached the International Bureau after the expiration of the time limit prescribed under Article 12 (3) on account of any error or omission on the part of the applicant, the provisions of subparagraph (a) shall apply only under the circumstances referred to in Article 48 (2).

*Article 26**Opportunity to Correct Before Designated Offices*

No designated Office shall reject an international application on the grounds of non-compliance with the requirements of this Treaty and the Regulations without first giving the applicant the opportunity to correct the said application to the extent and according to the procedure provided by the national law for the same or comparable situations in respect of national applications.

*Article 27**National Requirements*

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

(2) The provisions of paragraph (1) neither affect the application of the provisions of Article 7 (2) nor preclude any national law from requiring, once the processing of the international application has started in the designated Office, the furnishing:

- (i) when the applicant is a legal entity, of the name of an officer entitled to represent such legal entity,
- (ii) of documents not part of the international application but which constitute proof of allegations or statements made in that application, including the confirmation of the international application by the signature of the applicant when that application, as filed, was signed by his representative or agent.

(3) Where the applicant, for the purposes of any designated State, is not qualified according to the national law of that State to file a national application because he is not the inventor, the international application may be rejected by the designated Office.

(4) Where the national law provides, in respect of the form or contents of national applications, for requirements which, from the viewpoint of applicants, are more favourable than the requirements provided for by this Treaty and the Regulations in respect of international applications, the national Office, the courts and any other competent organs of or acting for the designated State may apply the former

requirements, instead of the latter requirements, to international applications, except where the applicant insists that the requirements provided for by this Treaty and the Regulations be applied to his international application.

(5) Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.

(6) The national law may require that the applicant furnish evidence in respect of any substantive condition of patentability prescribed by such law.

(7) Any receiving Office or, once the processing of the international application has started in the designated Office, that Office may apply the national law as far as it relates to any requirement that the applicant be represented by an agent having the right to represent applicants before the said Office and/or that the applicant have an address in the designated State for the purpose of receiving notifications.

(8) Nothing in this Treaty and the Regulations is intended to be construed as limiting the freedom of any Contracting State to apply measures deemed necessary for the preservation of its national security or to limit, for the protection of the general economic interests of that State, the right of its own residents or nationals to file international applications.

Article 28

Amendment of the Claims, the Description, and the Drawings, Before Designated Offices

(1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each designated Office within the prescribed time limit. No designated Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired except with the express consent of the applicant.

(2) The amendments shall not go beyond the disclosure in the international application as filed unless the national law of the designated State permits them to go beyond the said disclosure.

(3) The amendments shall be in accordance with the national law of the designated State in all respects not provided for in this Treaty and the Regulations.

(4) Where the designated Office requires a translation of the international application, the amendments shall be in the language of the translation.

Article 29

Effects of the International Publication

(1) As far as the protection of any rights of the applicant in a designated State is concerned, the effects, in that State, of the international publication of an international application shall, subject to the provisions of paragraphs (2) to (4), be the same as those which the national law of the designated State provides for the compulsory national publication of unexamined national applications as such.

(2) If the language in which the international publication has been effected is different from the language in which publications under the national law are effected in the designated State, the said national law may provide that the effects provided for in paragraph (1) shall be applicable only from such time as:

- (i) a translation into the latter language has been published as provided by the national law, or
- (ii) a translation into the latter language has been made available to the public, by laying open for public inspection as provided by the national law, or
- (iii) a translation into the latter language has been transmitted by the applicant to the actual or prospective unauthorized user of the invention claimed in the international application, or
- (iv) both the acts described in (i) and (iii), or both the acts described in (ii) and (iii), have taken place.

(3) The national law of any designated State may provide that, where the international publication has been effected, on the request of the applicant, before the expiration of 18 months from the priority date, the effects provided for in paragraph (1) shall be applicable only from the expiration of 18 months from the priority date.

(4) The national law of any designated State may provide that the effects provided for in paragraph (1) shall be applicable only from the date on which a copy of the international application as published under Article 21 has been received in the national Office of or acting for such State. The said Office shall publish the date of receipt in its gazette as soon as possible.

Article 30

Confidential Nature of the International Application

(1) (a) Subject to the provisions of subparagraph (b), the International Bureau and the International Searching Authorities shall not allow access by any person or authority to the international application before the international publication of that application, unless requested or authorized by the applicant.

(b) The provisions of subparagraph (a) shall not apply to any transmittal to the competent International Searching Authority, to transmittals provided for under Article 13, and to communications provided for under Article 20.

(2) (a) No national Office shall allow access to the international application by third parties, unless requested or authorized by the applicant, before the earliest of the following dates:

- (i) date of the international publication of the international application,
- (ii) date of the receipt of the communication of the international application under Article 20,
- (iii) date of the receipt of a copy of the international application under Article 22.

(b) The provisions of subparagraph (a) shall not prevent any national Office from informing third parties that it has been designated, or from publishing that fact. Such information or publication may, however, contain only the following data: identification of the receiving

Office, name of the applicant, international filing date, international application number, and title of the invention.

(c) The provisions of subparagraph (a) shall not prevent any designated Office from allowing access to the international application for the purposes of the judicial authorities.

(3) The provisions of paragraph (2) (a) shall apply to any receiving Office except as far as transmittals provided for under Article 12 (1) are concerned.

(4) For the purposes of this Article, the term “access” covers any means by which third parties may acquire cognizance, including individual communication and general publication, provided, however, that no national Office shall generally publish an international application or its translation before the international publication or, if international publication has not taken place by the expiration of 20 months from the priority date, before the expiration of 20 months from the said priority date.

CHAPTER II

International Preliminary Examination

Article 31

Demand for International Preliminary Examination

(1) On the demand of the applicant, his international application shall be the subject of an international preliminary examination as provided in the following provisions and the Regulations.

(2) (a) Any applicant who is a resident or national, as defined in the Regulations, of a Contracting State bound by Chapter II, and whose international application has been filed with the receiving Office of or acting for such State, may make a demand for international preliminary examination.

(b) The Assembly may decide to allow persons entitled to file international applications to make a demand for international preliminary examination even if they are residents or nationals of a State not party to this Treaty or not bound by Chapter II.

(3) The demand for international preliminary examination shall be made separately from the international application. The demand shall contain the prescribed particulars and shall be in the prescribed language and form.

(4) (a) The demand shall indicate the Contracting State or States in which the applicant intends to use the results of the international preliminary examination ("elected States"). Additional Contracting States may be elected later. Election may relate only to Contracting States already designated under Article 4.

(b) Applicants referred to in paragraph (2) (a) may elect any Contracting State bound by Chapter II. Applicants referred to in paragraph (2) (b) may elect only such Contracting States bound by Chapter II as have declared that they are prepared to be elected by such applicants.

(5) The demand shall be subject to the payment of the prescribed fees within the prescribed time limit.

(6) (a) The demand shall be submitted to the competent International Preliminary Examining Authority referred to in Article 32.

(b) Any later election shall be submitted to the International Bureau.

(7) Each elected Office shall be notified of its election.

Article 32

The International Preliminary Examining Authority

(1) International preliminary examination shall be carried out by the International Preliminary Examining Authority.

(2) In the case of demands referred to in Article 31 (2) (a), the receiving Office, and, in the case of demands referred to in Article 31 (2) (b), the Assembly, shall, in accordance with the applicable agreement between the interested International Preliminary Examining Authority or Authorities and the International Bureau, specify the International Preliminary Examining Authority or Authorities competent for the preliminary examination.

(3) The provisions of Article 16 (3) shall apply, *mutatis mutandis*, in respect of International Preliminary Examining Authorities.

*Article 33**The International Preliminary Examination*

(1) The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable.

(2) For the purposes of the international preliminary examination, a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.

(3) For the purposes of the international preliminary examination, a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.

(4) For the purposes of the international preliminary examination, a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. "Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.

(5) The criteria described above merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purpose of deciding whether, in that State, the claimed invention is patentable or not.

(6) The international preliminary examination shall take into consideration all the documents cited in the international search report. It may take into consideration any additional documents considered to be relevant in the particular case.

*Article 34**Procedure Before the International Preliminary Examining Authority*

(1) Procedure before the International Preliminary Examining Authority shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.

(2) (a) The applicant shall have a right to communicate orally and in writing with the International Preliminary Examining Authority.

(b) The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.

(c) The applicant shall receive at least one written opinion from the International Preliminary Examining Authority unless such Authority considers that all of the following conditions are fulfilled:

- (i) the invention satisfies the criteria set forth in Article 33 (1),
- (ii) the international application complies with the requirements of this Treaty and the Regulations in so far as checked by that Authority,
- (iii) no observations are intended to be made under Article 35 (2), last sentence.

(d) The applicant may respond to the written opinion.

(3) (a) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention as set forth in the Regulations, it may invite the applicant, at his option, to restrict the claims so as to comply with the requirement or to pay additional fees.

(b) The national law of any elected State may provide that, where the applicant chooses to restrict the claims under subparagraph (a), those parts of the international application which, as a consequence of the restriction, are not to be the subject of international preliminary examination shall, as far as effects in that State are concerned, be considered withdrawn unless a special fee is paid by the applicant to the national Office of that State.

(c) If the applicant does not comply with the invitation referred to in subparagraph (a) within the prescribed time limit, the International Preliminary Examining Authority shall establish an international preliminary examination report on those parts of the international application which relate to what appears to be the main invention and shall indicate the relevant facts in the said report. The national law of any elected State may provide that, where its national Office finds the invitation of the International Preliminary Examining Authority justified, those parts of the international application which do not relate to the main invention shall, as far as effects in that State are concerned, be

considered withdrawn unless a special fee is paid by the applicant to that Office.

(4) (a) If the International Preliminary Examining Authority considers

- (i) that the international application relates to a subject matter on which the International Preliminary Examining Authority is not required, under the Regulations, to carry out an international preliminary examination, and in the particular case decides not to carry out such examination, or
- (ii) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the novelty, inventive step (non-obviousness), or industrial applicability, of the claimed invention,

the said Authority shall not go into the questions referred to in Article 33 (1) and shall inform the applicant of this opinion and the reasons therefor.

(b) If any of the situations referred to in subparagraph (a) is found to exist in, or in connection with, certain claims only, the provisions of that subparagraph shall apply only to the said claims.

Article 35

The International Preliminary Examination Report

(1) The international preliminary examination report shall be established within the prescribed time limit and in the prescribed form.

(2) The international preliminary examination report shall not contain any statement on the question whether the claimed invention is or seems to be patentable or unpatentable according to any national law. It shall state, subject to the provisions of paragraph (3), in relation to each claim, whether the claim appears to satisfy the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined for the purposes of the international preliminary examination in Article 33 (1) to (4). The statement shall be accompanied by the citation of the documents believed to support the stated conclusion with such explanations as the circumstances of the case may require. The statement shall also be accompanied by such other observations as the Regulations provide for.

(3) (a) If, at the time of establishing the international preliminary examination report, the International Preliminary Examining Authority considers that any of the situations referred to in Article 34 (4) (a) exists, that report shall state this opinion and the reasons therefor. It shall not contain any statement as provided in paragraph (2).

(b) If a situation under Article 34 (4) (b) is found to exist, the international preliminary examination report shall, in relation to the claims in question, contain the statement as provided in subparagraph (a), whereas, in relation to the other claims, it shall contain the statement as provided in paragraph (2).

Article 36

Transmittal, Translation, and Communication, of the International Preliminary Examination Report

(1) The international preliminary examination report, together with the prescribed annexes, shall be transmitted to the applicant and to the International Bureau.

(2) (a) The international preliminary examination report and its annexes shall be translated into the prescribed languages.

(b) Any translation of the said report shall be prepared by or under the responsibility of the International Bureau, whereas any translation of the said annexes shall be prepared by the applicant.

(3) (a) The international preliminary examination report, together with its translation (as prescribed) and its annexes (in the original language), shall be communicated by the International Bureau to each elected Office.

(b) The prescribed translation of the annexes shall be transmitted within the prescribed time limit by the applicant to the elected Offices.

(4) The provisions of Article 20 (3) shall apply, *mutatis mutandis*, to copies of any document which is cited in the international preliminary examination report and which was not cited in the international search report.

*Article 37**Withdrawal of Demand or Election*

- (1) The applicant may withdraw any or all elections.
- (2) If the election of all elected States is withdrawn, the demand shall be considered withdrawn.
- (3) (a) Any withdrawal shall be notified to the International Bureau.
(b) The elected Offices concerned and the International Preliminary Examining Authority concerned shall be notified accordingly by the International Bureau.
- (4) (a) Subject to the provisions of subparagraph (b), withdrawal of the demand or of the election of a Contracting State shall, unless the national law of that State provides otherwise, be considered to be withdrawal of the international application as far as that State is concerned.
(b) Withdrawal of the demand or of the election shall not be considered to be withdrawal of the international application if such withdrawal is effected prior to the expiration of the applicable time limit under Article 22; however, any Contracting State may provide in its national law that the aforesaid shall apply only if its national Office has received, within the said time limit, a copy of the international application, together with a translation (as prescribed), and the national fee.

*Article 38**Confidential Nature of the International Preliminary Examination*

- (1) Neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, allow access within the meaning, and with the proviso, of Article 30 (4) to the file of the international preliminary examination by any person or authority at any time, except by the elected Offices once the international preliminary examination report has been established.
- (2) Subject to the provisions of paragraph (1) and Articles 36 (1) and (3) and 37 (3) (b), neither the International Bureau nor the International Preliminary Examining Authority shall, unless requested or authorized by the applicant, give information on the issuance or non-issuance of an international preliminary examination report and on the withdrawal or non-withdrawal of the demand or of any election.

*Article 39**Copy, Translation, and Fee, to Elected Offices*

(1) (a) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than the expiration of 30 months from the priority date.

(b) Any national law may, for performing the acts referred to in subparagraph (a), fix time limits which expire later than the time limit provided for in that subparagraph.

(2) The effect provided for in Article 11 (3) shall cease in the elected State with the same consequences as the withdrawal of any national application in that State if the applicant fails to perform the acts referred to in paragraph (1) (a) within the time limit applicable under paragraph (1) (a) or (b).

(3) Any elected Office may maintain the effect provided for in Article 11 (3) even where the applicant does not comply with the requirements provided for in paragraph (1) (a) or (b).

*Article 40**Delaying of National Examination and Other Processing*

(1) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 23 shall not apply to such State and the national Office of or acting for that State shall not proceed, subject to the provisions of paragraph (2), to the examination and other processing of the international application prior to the expiration of the applicable time limit under Article 39.

(2) Notwithstanding the provisions of paragraph (1), any elected Office may, on the express request of the applicant, proceed to the examination and other processing of the international application at any time.

*Article 41**Amendment of the Claims, the Description, and the Drawings, Before Elected Offices*

(1) The applicant shall be given the opportunity to amend the claims, the description, and the drawings, before each elected Office within the prescribed time limit. No elected Office shall grant a patent, or refuse the grant of a patent, before such time limit has expired, except with the express consent of the applicant.

(2) The amendments shall not go beyond the disclosure in the international application as filed, unless the national law of the elected State permits them to go beyond the said disclosure.

(3) The amendments shall be in accordance with the national law of the elected State in all respects not provided for in this Treaty and the Regulations.

(4) Where an elected Office requires a translation of the international application, the amendments shall be in the language of the translation.

*Article 42**Results of National Examination in Elected Offices*

No elected Office receiving the international preliminary examination report may require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same international application in any other elected Office.

CHAPTER III**Common Provisions***Article 43**Seeking Certain Kinds of Protection*

In respect of any designated or elected State whose law provides for the grant of inventors' certificates, utility certificates, utility models, patents or certificates of addition, inventors' certificates of addition, or utility certificates of addition, the applicant may indicate, as prescribed in the Regulations, that his international application is for the grant, as far as that State is concerned, of an inventor's certificate, a utility certificate, or a utility model, rather than a patent, or that it is for the grant of a

patent or certificate of addition, an inventor's certificate of addition, or a utility certificate of addition, and the ensuing effect shall be governed by the applicant's choice. For the purposes of this Article and any Rule thereunder, Article 2 (ii) shall not apply.

Article 44

Seeking Two Kinds of Protection

In respect of any designated or elected State whose law permits an application, while being for the grant of a patent or one of the other kinds of protection referred to in Article 43, to be also for the grant of another of the said kinds of protection, the applicant may indicate, as prescribed in the Regulations, the two kinds of protection he is seeking, and the ensuing effect shall be governed by the applicant's indications. For the purposes of this Article, Article 2 (ii) shall not apply.

Article 45

Regional Patent Treaties

(1) Any treaty providing for the grant of regional patents ("regional patent treaty"), and giving to all persons who, according to Article 9, are entitled to file international applications the right to file applications for such patents, may provide that international applications designating or electing a State party to both the regional patent treaty and the present Treaty may be filed as applications for such patents.

(2) The national law of the said designated or elected State may provide that any designation or election of such State in the international application shall have the effect of an indication of the wish to obtain a regional patent under the regional patent treaty.

Article 46

Incorrect Translation of the International Application

If, because of an incorrect translation of the international application, the scope of any patent granted on that application exceeds the scope of the international application in its original language, the competent authorities of the Contracting State concerned may accordingly and retroactively limit the scope of the patent, and declare it null and void to the extent that its scope has exceeded the scope of the international application in its original language.

*Article 47**Time Limits*

(1) The details for computing time limits referred to in this Treaty are governed by the Regulations.

(2) (a) All time limits fixed in Chapters I and II of this Treaty may, outside any revision under Article 60, be modified by a decision of the Contracting States.

(b) Such decisions shall be made in the Assembly or through voting by correspondence and must be unanimous.

(c) The details of the procedure are governed by the Regulations.

*Article 48**Delay in Meeting Certain Time Limits*

(1) Where any time limit fixed in this Treaty or the Regulations is not met because of interruption in the mail service or unavoidable loss or delay in the mail, the time limit shall be deemed to be met in the cases and subject to the proof and other conditions prescribed in the Regulations.

(2) (a) Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.

(b) Any Contracting State may, as far as that State is concerned, excuse, for reasons other than those referred to in subparagraph (a), any delay in meeting any time limit.

*Article 49**Right to Practice Before International Authorities*

Any attorney, patent agent, or other person, having the right to practice before the national Office with which the international application was filed, shall be entitled to practice before the International Bureau and the competent International Searching Authority and competent International Preliminary Examining Authority in respect of that application.

CHAPTER IV

Technical Services

Article 50

Patent Information Services

(1) The International Bureau may furnish services by providing technical and any other pertinent information available to it on the basis of published documents, primarily patents and published applications (referred to in this Article as “the information services”).

(2) The International Bureau may provide these information services either directly or through one or more International Searching Authorities or other national or international specialized institutions, with which the International Bureau may reach agreement.

(3) The information services shall be operated in a way particularly facilitating the acquisition by Contracting States which are developing countries of technical knowledge and technology, including available published know-how.

(4) The information services shall be available to Governments of Contracting States and their nationals and residents. The Assembly may decide to make these services available also to others.

(5) (a) Any service to Governments of Contracting States shall be furnished at cost, provided that, when the Government is that of a Contracting State which is a developing country, the service shall be furnished below cost if the difference can be covered from profit made on services furnished to others than Governments of Contracting States or from the sources referred to in Article 51 (4).

(b) The cost referred to in subparagraph (a) is to be understood as cost over and above costs normally incident to the performance of the services of a national Office or the obligations of an International Searching Authority.

(6) The details concerning the implementation of the provisions of this Article shall be governed by decisions of the Assembly and, within the limits to be fixed by the Assembly, such working groups as the Assembly may set up for that purpose.

(7) The Assembly shall, when it considers it necessary, recommend methods of providing financing supplementary to those referred to in paragraph (5).

*Article 51**Technical Assistance*

(1) The Assembly shall establish a Committee for Technical Assistance (referred to in this Article as “the Committee”).

(2) (a) The members of the Committee shall be elected among the Contracting States, with due regard to the representation of developing countries.

(b) The Director General shall, on his own initiative or at the request of the Committee, invite representatives of intergovernmental organizations concerned with technical assistance to developing countries to participate in the work of the Committee.

(3) (a) The task of the Committee shall be to organize and supervise technical assistance for Contracting States which are developing countries in developing their patent systems individually or on a regional basis.

(b) The technical assistance shall comprise, among other things, the training of specialists, the loaning of experts, and the supply of equipment both for demonstration and for operational purposes.

(4) The International Bureau shall seek to enter into agreements, on the one hand, with international financing organizations and intergovernmental organizations, particularly the United Nations, the agencies of the United Nations, and the Specialized Agencies connected with the United Nations concerned with technical assistance, and, on the other hand, with the Governments of the States receiving the technical assistance, for the financing of projects pursuant to this Article.

(5) The details concerning the implementation of the provisions of this Article shall be governed by decisions of the Assembly and, within the limits to be fixed by the Assembly, such working groups as the Assembly may set up for that purpose.

*Article 52**Relations with Other Provisions of the Treaty*

Nothing in this Chapter shall affect the financial provisions contained in any other Chapter of this Treaty. Such provisions are not applicable to the present Chapter or to its implementation.

CHAPTER V

Administrative Provisions

Article 53

Assembly

(1) (a) The Assembly shall, subject to Article 57 (8), consist of the Contracting States.

(b) The Government of each Contracting State shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(2) (a) The Assembly shall:

- (i) deal with all matters concerning the maintenance and development of the Union and the implementation of this Treaty;
- (ii) perform such tasks as are specifically assigned to it under other provisions of this Treaty;
- (iii) give directions to the International Bureau concerning the preparation for revision conferences;
- (iv) review and approve the reports and activities of the Director General concerning the Union, and give him all necessary instructions concerning matters within the competence of the Union;
- (v) review and approve the reports and activities of the Executive Committee established under paragraph (9), and give instructions to such Committee;
- (vi) determine the program and adopt the triennial budget of the Union, and approve its final accounts;
- (vii) adopt the financial regulations of the Union;
- (viii) establish such committees and working groups as it deems appropriate to achieve the objectives of the Union;
- (ix) determine which States other than Contracting States and, subject to the provisions of paragraph (8), which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;

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- (x) take any other appropriate action designed to further the objectives of the Union and perform such other functions as are appropriate under this Treaty.
- (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.
- (3) A delegate may represent, and vote in the name of, one State only.
- (4) Each Contracting State shall have one vote.
- (5) (a) One-half of the Contracting States shall constitute a quorum.
- (b) In the absence of the quorum, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the quorum and the required majority are attained through voting by correspondence as provided in the Regulations.
- (6) (a) Subject to the provisions of Articles 47 (2) (b), 58 (2) (b), 58 (3) and 61 (2) (b), the decisions of the Assembly shall require two-thirds of the votes cast.
- (b) Abstentions shall not be considered as votes.
- (7) In connection with matters of exclusive interest to States bound by Chapter II, any reference to Contracting States in paragraphs (4), (5), and (6), shall be considered as applying only to States bound by Chapter II.
- (8) Any intergovernmental organization appointed as International Searching or Preliminary Examining Authority shall be admitted as observer to the Assembly.
- (9) When the number of Contracting States exceeds forty, the Assembly shall establish an Executive Committee. Any reference to the Executive Committee in this Treaty and the Regulations shall be construed as references to such Committee once it has been established.
- (10) Until the Executive Committee has been established, the Assembly shall approve, within the limits of the program and triennial budget, the annual programs and budgets prepared by the Director General.

(11) (a) The Assembly shall meet in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of the Executive Committee, or at the request of one-fourth of the Contracting States.

(12) The Assembly shall adopt its own rules of procedure.

Article 54

Executive Committee

(1) When the Assembly has established an Executive Committee, that Committee shall be subject to the provisions set forth hereinafter.

(2) (a) The Executive Committee shall, subject to Article 57 (8), consist of States elected by the Assembly from among States members of the Assembly.

(b) The Government of each State member of the Executive Committee shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(3) The number of States members of the Executive Committee shall correspond to one-fourth of the number of States members of the Assembly. In establishing the number of seats to be filled, remainders after division by four shall be disregarded.

(4) In electing the members of the Executive Committee, the Assembly shall have due regard to an equitable geographical distribution.

(5) (a) Each member of the Executive Committee shall serve from the close of the session of the Assembly which elected it to the close of the next ordinary session of the Assembly.

(b) Members of the Executive Committee may be re-elected but only up to a maximum of two-thirds of such members.

(c) The Assembly shall establish the details of the rules governing the election and possible re-election of the members of the Executive Committee.

(6) (a) The Executive Committee shall:

(i) prepare the draft agenda of the Assembly;

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- (ii) submit proposals to the Assembly in respect of the draft program and biennial budget of the Union prepared by the Director General;
 - (iv) submit, with appropriate comments, to the Assembly the periodical reports of the Director General and the yearly audit reports on the accounts;
 - (v) take all necessary measures to ensure the execution of the program of the Union by the Director General, in accordance with the decisions of the Assembly and having regard to circumstances arising between two ordinary sessions of the Assembly;
 - (vi) perform such other functions as are allocated to it under this Treaty.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Executive Committee shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(7) (a) The Executive Committee shall meet once a year in ordinary session upon convocation by the Director General, preferably during the same period and at the same place as the Coordination Committee of the Organization.

(b) The Executive Committee shall meet in extraordinary session upon convocation by the Director General, either on his own initiative or at the request of its Chairman or one-fourth of its members.

(8) (a) Each State member of the Executive Committee shall have one vote.

(b) One-half of the members of the Executive Committee shall constitute a quorum.

(c) Decisions shall be made by a simple majority of the votes cast.

(d) Abstentions shall not be considered as votes.

(e) A delegate may represent, and vote in the name of, one State only.

(9) Contracting States not members of the Executive Committee shall be admitted to its meetings as observers, as well as any intergovernmental organization appointed as International Searching or Preliminary Examining Authority.

(10) The Executive Committee shall adopt its own rules of procedure.

Article 55

International Bureau

(1) Administrative tasks concerning the Union shall be performed by the International Bureau.

(2) The International Bureau shall provide the secretariat of the various organs of the Union.

(3) The Director General shall be the chief executive of the Union and shall represent the Union.

(4) The International Bureau shall publish a Gazette and other publications provided for by the Regulations or required by the Assembly.

(5) The Regulations shall specify the services that national Offices shall perform in order to assist the International Bureau and the International Searching and Preliminary Examining Authorities in carrying out their tasks under this Treaty.

(6) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly, the Executive Committee and any other committee or working group established under this Treaty or the Regulations. The Director General, or a staff member designated by him, shall be ex officio secretary of these bodies.

(7) (a) The International Bureau shall, in accordance with the directions of the Assembly and in cooperation with the Executive Committee, make the preparations for the revision conferences.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for revision conferences.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at revision conferences.

(8) The International Bureau shall carry out any other tasks assigned to it.

*Article 56**Committee for Technical Cooperation*

(1) The Assembly shall establish a Committee for Technical Cooperation (referred to in this Article as “the Committee”).

(2) (a) The Assembly shall determine the composition of the Committee and appoint its members, with due regard to an equitable representation of developing countries.

(b) The International Searching and Preliminary Examining Authorities shall be *ex officio* members of the Committee. In the case where such an Authority is the national Office of a Contracting State, that State shall not be additionally represented on the Committee.

(c) If the number of Contracting States so allows, the total number of members of the Committee shall be more than double the number of *ex officio* members.

(d) The Director General shall, on his own initiative or at the request of the Committee, invite representatives of interested organizations to participate in discussions of interest to them.

(3) The aim of the Committee shall be to contribute, by advice and recommendations:

- (i) to the constant improvement of the services provided for under this Treaty,
- (ii) to the securing, so long as there are several International Searching Authorities and several International Preliminary Examining Authorities, of the maximum degree of uniformity in their documentation and working methods and the maximum degree of uniformly high quality in their reports, and
- (iii) on the initiative of the Assembly or the Executive Committee, to the solution of the technical problems specifically involved in the establishment of a single International Searching Authority.

(4) Any Contracting State and any interested international organization may approach the Committee in writing on questions which fall within the competence of the Committee.

(5) The Committee may address its advice and recommendations to the Director General or, through him, to the Assembly, the Executive Committee, all or some of the International Searching and Preliminary Examining Authorities, and all or some of the receiving Offices.

(6) (a) In any case, the Director General shall transmit to the Executive Committee the texts of all the advice and recommendations of the Committee. He may comment on such texts.

(b) The Executive Committee may express its views on any advice, recommendation, or other activity of the Committee, and may invite the Committee to study and report on questions falling within its competence. The Executive Committee may submit to the Assembly, with appropriate comments, the advice, recommendations and report of the Committee.

(7) Until the Executive Committee has been established, references in paragraph (6) to the Executive Committee shall be construed as references to the Assembly.

(8) The details of the procedure of the Committee shall be governed by the decisions of the Assembly.

Article 57

Finances

(1) (a) The Union shall have a budget.

(b) The budget of the Union shall include the income and expenses proper to the Union and its contribution to the budget of expenses common to the Unions administered by the Organization.

(c) Expenses not attributable exclusively to the Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Union in such common expenses shall be in proportion to the interests the Union has in them.

(2) The budget of the Union shall be established with due regard to the requirements of co-ordination with the budgets of the other Unions administered by the Organization.

(3) Subject to the provisions of paragraph (5), the budget of the Union shall be financed from the following sources:

- (i) fees and charges due for services rendered by the International Bureau in relation to the Union;

- (ii) sale of, or royalties on, the publications of the International Bureau concerning the Union;
- (iii) gifts, bequests, and subventions;
- (iv) rents, interests, and other miscellaneous income.

(4) The amounts of fees and charges due to the International Bureau and the prices of its publications shall be so fixed that they should, under normal circumstances, be sufficient to cover all the expenses of the International Bureau connected with the administration of this Treaty.

(5) (a) Should any financial year close with a deficit, the Contracting States shall, subject to the provisions of subparagraph (b) and (c), pay contributions to cover such deficit.

(b) The amount of the contribution of each Contracting State shall be decided by the Assembly with due regard to the number of international applications which has emanated from each of them in the relevant year.

(c) If other means of provisionally covering any deficit or any part thereof are secured, the Assembly may decide that such deficit be carried forward and that the Contracting States should not be asked to pay contributions.

(d) If the financial situation of the Union so permits, the Assembly may decide that any contributions paid under subparagraph (a) be reimbursed to the Contracting States which have paid them.

(e) A Contracting State which has not paid, within two years of the due date as established by the Assembly, its contribution under subparagraph (b) may not exercise its right to vote in any of the organs of the Union. However, any organ of the Union may allow such a State to continue to exercise its right to vote in that organ so long as it is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(6) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(7) (a) The Union shall have a working capital fund which shall be constituted by a single payment made by each Contracting State. If the fund becomes insufficient, the Assembly shall arrange to increase it. If part of the fund is no longer needed, it shall be reimbursed.

(b) The amount of the initial payment of each Contracting State to the said fund or of its participation in the increase thereof shall be decided by the Assembly on the basis of principles similar to those provided for under paragraph (5) (b).

(c) The terms of payments shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(d) Any reimbursement shall be proportionate to the amounts paid by each Contracting State, taking into account the dates at which they were paid.

7provided that, whenever the working capital fund is insufficient, such State shall grant advances. The amount of these advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such State and the Organization. As long as it remains under the obligation to grant advances, such State shall have an ex officio seat in the Assembly and on the Executive Committee.

(b) The State referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(9) The auditing of the accounts shall be effected by one or more of the Contracting States or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

Article 58

Regulations

- (1) The Regulations annexed to this Treaty provide Rules:
 - (i) concerning matters in respect of which this Treaty expressly refers to the Regulations or expressly provides that they are or shall be prescribed,
 - (ii) concerning any administrative requirements, matters, or procedures,
 - (iii) concerning any details useful in the implementation of the provisions of this Treaty.

(2) (a) The Assembly may amend the Regulations.

(b) Subject to the provisions of paragraph (3), amendments shall require three-fourths of the votes cast.

(3) (a) The Regulations specify the Rules which may be amended

(i) only by unanimous consent, or

(ii) only if none of the Contracting States whose national Office acts as an International Searching or Preliminary Examining Authority dissents, and, where such Authority is an intergovernmental organization, if the Contracting State member of that organization authorized for that purpose by the other member States within the competent body of such organization does not dissent.

(b) Exclusion, for the future, of any such Rules from the applicable requirement shall require the fulfilment of the conditions referred to in subparagraph (a) (i) or (a) (ii), respectively.

(c) Inclusion, for the future, of any Rule in one or the other of the requirements referred to in subparagraph (a) shall require unanimous consent.

(4) The Regulations provide for the establishment, under the control of the Assembly, of Administrative Instructions by the Director General.

(5) In the case of conflict between the provisions of the Treaty and those of the Regulations, the provisions of the Treaty shall prevail.

CHAPTER VI

Disputes

Article 59

Disputes

Subject to Article 64 (5), any dispute between two or more Contracting States concerning the interpretation or application of this Treaty or the Regulations, not settled by negotiation, may, by any one of the States concerned, be brought before the International Court of Justice by application in conformity with the Statute of the Court, unless the States concerned agree on some other method of settlement. The Contracting State bringing the dispute before the Court shall inform the International Bureau; the International Bureau shall bring the matter to the attention of the other Contracting States.

CHAPTER VII

Revision and Amendment

Article 60

Revision of the Treaty

(1) This Treaty may be revised from time to time by a special conference of the Contracting States.

(2) The convocation of any revision conference shall be decided by the Assembly.

(3) Any intergovernmental organization appointed as International Searching or Preliminary Examining Authority shall be admitted as observer to any revision conference.

(4) Articles 53 (5), (9) and (11), 54, 55 (4) to (8), 56, and 57, may be amended either by a revision conference or according to the provisions of Article 61.

Article 61

Amendment of Certain Provisions of the Treaty

(1) (a) Proposals for the amendment of Articles 53 (5), (9) and (11), 54, 55 (4) to (8), 56, and 57, may be initiated by any State member of the Assembly, by the Executive Committee, or by the Director General.

(b) Such proposals shall be communicated by the Director General to the Contracting States at least six months in advance of their consideration by the Assembly.

(2) (a) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly.

(b) Adoption shall require three-fourths of the votes cast.

(3) (a) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the States members of the Assembly at the time it adopted the amendment.

(b) Any amendment to the said Articles thus accepted shall bind all the States which are members of the Assembly at the time the amendment enters into force, provided that any amendment increasing the financial obligations of the Contracting States shall bind only those States which have notified their acceptance of such amendment.

(c) Any amendment accepted in accordance with the provisions of subparagraph (a) shall bind all States which become members of the Assembly after the date on which the amendment entered into force in accordance with the provisions of subparagraph (a).

CHAPTER VIII

Final Provisions

Article 62

Becoming Party to the Treaty

(1) Any State member of the International Union for the Protection of Industrial Property may become party to this Treaty by:

- (i) signature followed by the deposit of an instrument of ratification, or
- (ii) deposit of an instrument of accession.

(2) Instruments of ratification or accession shall be deposited with the Director General.

(3) The provisions of Article 24 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property shall apply to this Treaty.

(4) Paragraph (3) shall in no way be understood as implying the recognition or tacit acceptance by a Contracting State of the factual situation concerning a territory to which this Treaty is made applicable by another Contracting State by virtue of the said paragraph.

Article 63

Entry into Force of the Treaty

(1) (a) Subject to the provisions of paragraph (3), this Treaty shall enter into force three months after eight States have deposited their instruments of ratification or accession, provided that at least four of those States each fulfil any of the following conditions:

- (i) the number of applications filed in the State has exceeded 40,000 according to the most recent annual statistics published by the International Bureau,
- (ii) the nationals or residents of the State have filed at least 1,000 applications in one foreign country according to the

most recent annual statistics published by the International Bureau,

- (iii) the national Office of the State has received at least 10,000 applications from nationals or residents of foreign countries according to the most recent annual statistics published by the International Bureau.

(b) For the purposes of this paragraph, the term “applications” does not include applications for utility models.

(2) Subject to the provisions of paragraph (3), any State which does not become party to this Treaty upon entry into force under paragraph (1) shall become bound by this Treaty three months after the date on which such State has deposited its instrument of ratification or accession.

(3) The provisions of Chapter II and the corresponding provisions of the Regulations annexed to this Treaty shall become applicable, however, only on the date on which three States each of which fulfil at least one of the three requirements specified in paragraph (1) have become party to this Treaty without declaring, as provided in Article 64 (1), that they do not intend to be bound by the provisions of Chapter II. That date shall not, however, be prior to that of the initial entry into force under paragraph (1).

Article 64

Reservations

(1) (a) Any State may declare that it shall not be bound by the provisions of Chapter II.

(b) States making a declaration under subparagraph (a) shall not be bound by the provisions of Chapter II and the corresponding provisions of the Regulations.

(2) (a) Any State not having made a declaration under paragraph (1) (a) may declare that:

- (i) it shall not be bound by the provisions of Article 39 (1) with respect to the furnishing of a copy of the international application and a translation thereof (as prescribed),
- (ii) the obligation to delay national processing, as provided for under Article 40, shall not prevent publication, by or through its national Office, of the international application or a translation thereof, it being understood, however, that it

is not exempted from the limitations provided for in Articles 30 and 38.

(b) States making such a declaration shall be bound accordingly.

(3) (a) Any State may declare that, as far as it is concerned, international publication of international applications is not required.

(b) Where, at the expiration of 18 months from the priority date, the international application contains the designation only of such States as have made declarations under subparagraph (a), the international application shall not be published by virtue of Article 21 (2).

(c) Where the provisions of subparagraph (b) apply, the international application shall nevertheless be published by the International Bureau:

(i) at the request of the applicant, as provided in the Regulations,

(ii) when a national application or a patent based on the international application is published by or on behalf of the national Office of any designated State having made a declaration under subparagraph (a), promptly after such publication but not before the expiration of 18 months from the priority date.

(4) (a) Any State whose national law provides for prior art effect of its patents as from a date before publication, but does not equate for prior art purposes the priority date claimed under the Paris Convention for the Protection of Industrial Property to the actual filing date in that State, may declare that the filing outside that State of an international application designating that State is not equated to an actual filing in that State for prior art purposes.

(b) Any State making a declaration under subparagraph (a) shall to that extent not be bound by the provisions of Article 11 (3).

(c) Any State making a declaration under subparagraph (a) shall, at the same time, state in writing the date from which, and the conditions under which, the prior art effect of any international application designating that State becomes effective in that State. This statement may be modified at any time by notification addressed to the Director General.

(5) Each State may declare that it does not consider itself bound by Article 59. With regard to any dispute between any Contracting State having made such a declaration and any other Contracting State, the provisions of Article 59 shall not apply.

(6) (a) Any declaration made under this Article shall be made in writing. It may be made at the time of signing this Treaty, at the time of depositing the instrument of ratification or accession, or, except in the case referred to in paragraph (5), at any later time by notification addressed to the Director General. In the case of the said notification, the declaration shall take effect six months after the day on which the Director General has received the notification, and shall not affect international applications filed prior to the expiration of the said six-month period.

(b) Any declaration made under this Article may be withdrawn at any time by notification addressed to the Director General. Such withdrawal shall take effect three months after the day on which the Director General has received the notification and, in the case of the withdrawal of a declaration made under paragraph (3), shall not affect international applications filed prior to the expiration of the said three-month period.

(7) No reservations to this Treaty other than the reservations under paragraphs (1) to (5) are permitted.

Article 65

Gradual Application

(1) If the agreement with any International Searching or Preliminary Examining Authority provides, transitionally, for limits on the number or kind of international applications that such Authority undertakes to process, the Assembly shall adopt the measures necessary for the gradual application of this Treaty and the Regulations in respect of given categories of international applications. This provision shall also apply to requests for an international-type search under Article 15 (5).

(2) The Assembly shall fix the dates from which, subject to the provision of paragraph (1), international applications may be filed and demands for international preliminary examination may be submitted. Such dates shall not be later than six months after this Treaty has entered into force according to the provisions of Article 63 (1), or after Chapter II has become applicable under Article 63 (3), respectively.

*Article 66**Denunciation*

(1) Any Contracting State may denounce this Treaty by notification addressed to the Director General.

(2) Denunciation shall take effect six months after receipt of the said notification by the Director General. It shall not affect the effects of the international application in the denouncing State if the international application was filed, and, where the denouncing State has been elected, the election was made, prior to the expiration of the said six-month period.

*Article 67**Signature and Languages*

(1) (a) This Treaty shall be signed in a single original in the English and French languages, both texts being equally authentic.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in the German, Japanese, Portuguese, Russian and Spanish languages, and such other languages as the Assembly may designate.

(2) This Treaty shall remain open for signature at Washington until December 31, 1970.

*Article 68**Depositary Functions*

(1) The original of this Treaty, when no longer open for signature, shall be deposited with the Director General.

(2) The Director General shall transmit two copies, certified by him, of this Treaty and the Regulations annexed hereto to the Governments of all States party to the Paris Convention for the Protection of Industrial Property and, on request, to the Government of any other State.

(3) The Director General shall register this Treaty with the Secretariat of the United Nations.

(4) The Director General shall transmit two copies, certified by him, of any amendment to this Treaty and the Regulations to the Governments of all Contracting States and, on request, to the Government of any other State.

*Article 69**Notifications*

The Director General shall notify the Governments of all States party to the Paris Convention for the Protection of Industrial Property of:

- (i) signatures under Article 62,
- (ii) deposits of instruments of ratification or accession under Article 62,
- (iii) the date of entry into force of this Treaty and the date from which Chapter II is applicable in accordance with Article 63 (3),
- (iv) any declarations made under Article 64 (1) to (5),
- (v) withdrawals of any declarations made under Article 64 (6) (b),
- (vi) denunciations received under Article 66, and
- (vii) any declarations made under Article 31 (4).