



Patents Regulations 1991

Statutory Rules No. 71, 1991 as amended

made under the

Patents Act 1990

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Volume 1: Chapters 1 to 23

Volume 2: Schedules and Endnotes

Each volume has its own contents

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About this compilation

The compiled instrument

This is a compilation of the *Patents Regulations 1991* as amended and in force on 15 April 2013. It includes any amendment affecting the compiled instrument to that date.

This compilation was prepared on 15 April 2013.

The notes at the end of this compilation (the *endnotes*) include information about amending Acts and instruments and the amendment history of each amended provision.

Uncommenced provisions and amendments

If a provision of the compiled instrument has not commenced or is affected by an uncommenced amendment, the text of the uncommenced provision or amendment is set out only in the endnotes.

Application provisions for amendments

If the operation of an amendment is affected by an application provision, this provision is set out in the endnotes.

Modifications

If a provision of the compiled instrument is affected by a textual modification that is in force, the text of the modifying provision is set out in the endnotes.

Provision ceasing to have effect

If a provision of the compiled instrument has expired or otherwise ceased to have effect, or is to expire or otherwise cease to have effect, in accordance with a provision of the instrument, details of the provision are set out in the endnotes.

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Chapter 1—Introductory

1.1 Name of Regulations

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:

AAT means the Administrative Appeals Tribunal.

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”.

approved means, for doing an action or paying a fee, means the means specified for the action or payment by the Commissioner in a notice made under regulation 22.2AA and published by the Commissioner.

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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 to the best of the knowledge of the person who signs the statement; and
- (b) that is dated and signed.

Code of Conduct means the standard of practice titled “Code of Conduct for Patent and Trade Marks Attorneys” that is established by the Board from time to time.

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 by regulation 20.61.

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.

Register of Patent Attorneys means the register mentioned in section 198 of the Act.

the Act means the *Patents Act 1990*.

- (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.
- (4) If the Commissioner gives a document to a person, the document is
taken to have been given to the person on the day the document is
dated by the Commissioner.
- (5) The Commissioner may give a document to a person by:
- (a) making the document available to the person in an electronic
form; and
 - (b) notifying the person that the document is available.
- (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.

1.4 Meaning of *Convention country*

For the definition of *Convention country* in subsection 29B(5) of the Act, the following countries are prescribed:

- (a) a foreign country that is a signatory to the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force from time to time;
- (b) a foreign country that is a full member of the World Trade Organization.

Note 1: For signatories to the Paris Convention for the Protection of Industrial Property, see www.wipo.int.

Note 2: For full members of the World Trade Organization, see www.wto.org.

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.

- (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 depository institution with which the micro-organism is deposited.

1.6 Secret use—prescribed period

For paragraph 9(e) of the Act, the period is 12 months after the first use of the invention that would, but for the application of paragraph 9(e), have constituted secret use.

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.
- (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

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- (b) provide information for each part of the procedure that describes the information as being mandatory.

Example: An online application facility.

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 Information made publicly available—recognised exhibitions

- (1) This regulation sets out:
 - (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
 - (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance—invention shown, used or published at recognised exhibition

- (2) The circumstance is that the information has been made publicly available because the invention was:
 - (a) shown or used at a recognised exhibition; or
 - (b) published during a recognised exhibition at which the invention was shown or used.

Period

- (3) The period for making a complete application for the invention is:

Regulation 2.2A

- (a) if the complete application claims priority from a basic application made within 6 months of the day of the showing, use or publication—12 months from the day the basic application was made; or
 - (b) if the complete application is associated with a provisional application made within 6 months of the day of the showing, use or publication—12 months from the day the provisional application was made; or
 - (c) otherwise—12 months from the day of the showing, use or publication.
- (4) 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.

2.2A Information made publicly available—learned societies

- (1) This regulation sets out:
- (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
 - (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance—information read before learned society or published by or on behalf of learned society

- (2) The circumstance is that the information has been made publicly available in a paper:
- (a) read before a learned society; or
 - (b) published by or on behalf of a learned society.

Period

- (3) The period for making a complete application for the invention is:
- (a) if the complete application claims priority from a basic application made within 6 months of the day of the reading or publication—12 months from the day the basic application was made; or
 - (b) if the complete application is associated with a provisional application made within 6 months of the day of the reading or publication—12 months from the day the provisional application was made; or
 - (c) otherwise—12 months from the day of the reading or publication.

2.2B Information made publicly available—reasonable trial of invention

- (1) This regulation sets out:
- (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
 - (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance—working of invention for reasonable trial

- (2) The circumstance is that:
- (a) the information has been made publicly available because the invention was worked in public; and

Regulation 2.2C

- (b) the working of the invention was for the purposes of a reasonable trial of the invention; and
- (c) because of the nature of the invention, it was reasonably necessary for the working to be in public.

Period

- (3) The period for making a complete application for the invention is:
 - (a) if the complete application claims priority from a basic application made within 12 months of the start of the public working of the invention—12 months from the day the basic application was made; or
 - (b) if the complete application is associated with a provisional application made within 12 months of the start of the public working of the invention—12 months from the day the provisional application was made; or
 - (c) otherwise—12 months from the start of the public working of the invention.

2.2C Information made publicly available—other circumstances

- (1) This regulation sets out:
 - (a) for paragraph 24(1)(a) of the Act—a circumstance in relation to information made publicly available by, or with the consent of, the nominated person, patentee or predecessor in title of the nominated person or patentee; and
 - (b) for subsection 24(1) of the Act—a period for making a complete application for an invention if the circumstance applies.

Circumstance

- (2) The circumstance is that the information has been made publicly available in circumstances other than the circumstances described in regulations 2.2, 2.2A and 2.2B.

Period

- (3) The period for making a complete application for the invention is 12 months from the day the information was made publicly available.

2.2D Information made publicly available without consent—period

For subsection 24(1) of the Act, for information made publicly available in the circumstances mentioned in paragraph 24(1)(b) of the Act, the prescribed period for making a complete application for an invention is 12 months from the day the information was made publicly available.

2.3 Divisional applications—period

- (1) For subsection 24(1) of the Act, this regulation applies to an invention if:
- (a) the specification containing the claim in which the invention is defined was filed for a divisional application under section 79B or 79C of the Act; and
 - (b) the claim is entitled under regulation 3.13D or 3.13E to the priority date that it would have if the claim was in the specification filed with a previous application (the *original application*); and
 - (c) a circumstance mentioned in regulations 2.2 to 2.2D applies; and
 - (d) the original application was filed in the period prescribed in the circumstance under regulations 2.2 to 2.2D.
- (2) The prescribed period for making the divisional application is:
- (a) if the divisional application was filed in the period mentioned in paragraph (1)(d)—that period; or
 - (b) otherwise—the period ending on the day the divisional application was made.

Regulation 2.4

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
- (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:

Regulation 2.7

- (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.

Chapter 3—From application to acceptance

Part 1—Inventions generally

Division 1—Applications

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:
 - (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
 - (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.

- (2) For a PCT application, 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.
- (3) If the Commissioner treats an application for a standard patent (other than a PCT application) 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).

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Division 1 Applications

Regulation 3.2AB

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.

3.2AB PCT application—title of specification

- (1) The title of a specification for a PCT application is taken to be:
- (a) the title approved by the ISA for the application under rule 44.2 of the PCT; or
 - (b) the title established by the ISA for the application under rule 37.2 of the PCT.
- (2) For subregulation (1), if the title is in a language other than English, the title is taken to be the English translation of the title.

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
 - (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, 3.11, 6A.1 or 6A.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 anything necessary to ensure that the application meets the requirement.

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Regulation 3.2C

- (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.
- (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.

3.2C Specifications—formalities check for PCT application

- (1) This regulation applies to a PCT application that complies with subsection 29A(5) of the Act.

Note: This regulation was added on 15 April 2013. If the PCT application was filed before 15 April 2013, see subregulation (7).

- (2) The applicant must:
 - (a) provide:
 - (i) an address for service in Australia at which a document under the Act or these Regulations may be given to the applicant personally, or to a person nominated as the applicant's representative; or
 - (ii) another address for service in Australia to which it is practicable and reasonable for Australia Post, or a person acting for Australia Post, to deliver mail; and
 - (b) if a translation of the application is filed for subsection 29A(5) of the Act—file a certificate of verification for the translation.

- (3) The PCT application must substantially comply with the requirements of Schedule 3.
- (4) The Commissioner may, within one month from the date the PCT application complies with subsection 29A(5) of the Act, direct the applicant to do anything necessary to ensure that the application complies with the requirements mentioned in subregulations (2) and (3).
- (5) The PCT application lapses if:
 - (a) the applicant has been given a direction under subregulation (4); and
 - (b) the applicant has not complied with the direction within 2 months of the date of the direction.
- (6) If the PCT application lapses under subregulation (5), the Commissioner must:
 - (a) advertise that fact in the *Official Journal*; and
 - (b) tell the applicant that the PCT application has lapsed.
- (7) If the PCT application was filed before 15 April 2013:
 - (a) a reference in this regulation to subsection 29A(5) of the Act:
 - (i) is taken to be a reference to subsection 89(3) of the Act, as in force immediately before 15 April 2013; and
 - (ii) if a translation of a PCT application is required to be filed—is taken not to include the requirement to file a related certificate of verification; and
 - (b) for the purposes of the reference to subsection 89(3) of the Act, as in force immediately before 15 April 2013, paragraph 8.2(3)(c) of these Regulations, as in force immediately before 15 April 2013:
 - (i) is taken to apply in relation to the PCT application; and
 - (ii) is taken not to include the requirement to file a related certificate of verification; and
 - (iii) is taken not to include the requirement to file a document setting out an address for service of documents in Australia.

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 clear 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.
- (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.

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.

3.5 Filing date—patent applications other than PCT applications

- (1) Subject to this regulation, the filing date of a patent application (other than a PCT 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

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Regulation 3.5AA

- (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.

3.5AA Filing date—PCT applications

For section 30 of the Act, the filing date of a PCT application is:

- (a) the international filing date; or
- (b) if the Commissioner has treated another date as the international filing date under Rule 82^{ter} of the PCT—that date; or
- (c) if section 10 of the Act applies to the application—the date taken to have been given as the international filing date under that section.

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 (other than a PCT 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 into 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.

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- (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.

3.5AB PCT applications—international applications taken to be applications under the Act

- (1) This regulation applies to an international application that specifies Australia as a designated State under Article 4(1)(ii) of the PCT if:
 - (a) the receiving Office has declared that the international application is taken to be withdrawn; or
 - (b) the International Bureau has made a finding under Article 12(3) of the PCT.
- (2) The international application is taken to be a PCT application, as if a declaration or finding had not been made, if:
 - (a) 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
 - (b) the Commissioner has received, within the time limit specified in Rule 51.3 of the PCT:
 - (i) the fees prescribed for paragraph 29A(5)(b) of the Act; and
 - (ii) if the application is not in English—a translation of the application into English; and
 - (c) the Commissioner believes on reasonable grounds that:
 - (i) the declaration was the result of an error or omission by the receiving Office; or
 - (ii) the finding was the result of an error or omission by the International Bureau.

3.5AC PCT applications—amendment

- (1) For subsection 29A(3) of the Act, this regulation sets out the circumstances and manner in which, and the day on which, a specification of a PCT application is taken to be amended.

Translation of application into English

- (2) If paragraph 29A(5)(a) of the Act applies to the PCT application:
- (a) the description, drawings and claims contained in the application are taken to have been amended by substituting the description, drawings and claims in the translation; and
 - (b) the amendment is taken to have occurred on the day the translation was filed.

Application amended under Article 19 of PCT

- (3) If:
- (a) a PCT application was amended under Article 19 of the PCT; and
 - (b) the application was amended before the applicant met the requirements of subsection 29A(5) of the Act;
- the description, drawings and claims contained in the application are to be taken to have been amended on the day the amendment was made.

Application rectified under Rule 91 of PCT

- (4) If:
- (a) a PCT application was rectified under Rule 91 of the PCT; and
 - (b) the rectification was made before the applicant met the requirements of subsection 29A(5) of the Act;
- the description, drawings and claims contained in the application are to be taken to have been amended on the day the rectification was effective, unless the Commissioner disregards the rectification under Rule 91.3(f) of the PCT.

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Regulation 3.5AD

Application amended under Article 34 of PCT

- (5) If:
- (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 29A(5) of the Act;
- the description, drawings and claims contained in the application are taken to have been amended on the day the amendment was made.
- (6) However, subregulation (5) does not apply if:
- (a) the Commissioner has notified the applicant under regulation 3.17C or paragraph 10.2(1)(d); and
 - (b) the applicant:
 - (i) provides the advice mentioned in paragraph 3.17B(2)(b) or subparagraph 10.2(3)(c)(ii); or
 - (ii) elects under paragraph 3.17B(2)(c) or subparagraph 10.2(3)(c)(iii) to abandon any amendments that may have been made under Article 34 of the PCT.

Indications under Rule 13^{bis}.4 of the PCT

- (7) If an indication in relation to a deposited micro-organism is furnished according to Rule 13^{bis}.4 of the PCT in relation to a PCT application:
- (a) the description contained in the application is taken to have been amended to include that indication; and
 - (b) the amendment is taken to have occurred on the day that indication is furnished to the International Bureau.

3.5AD PCT applications—prescribed requirements

For subsection 29A(4) of the Act, the following requirements are prescribed:

- (a) the requirements of subsection 29(4) of the Act;
- (b) subregulation 3.1(1);
- (c) subregulation 3.2A(1);
- (d) paragraphs 3.2A(2)(a) and (b).

3.5AE PCT applications—prescribed period

- (1) For subsection 29A(5) of the Act, the prescribed period is 31 months after the priority date of the application.
- (2) In this regulation:
priority date has the same meaning as in the PCT.

3.5AF PCT applications—translations and prescribed documents

Translations published under Article 21 of PCT

- (1) For paragraph 29A(5)(a) of the Act, subregulation (2) applies 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 was not filed before the date of publication under Article 21 of the PCT.
- (2) The publication under Article 21 of the PCT is taken:
 - (a) to be the translation mentioned in paragraph 29A(5)(a) of the Act; and
 - (b) to have been filed within the prescribed period; and
 - (c) to have been verified in accordance with these Regulations.

Copy of application

- (3) For paragraph 29A(5)(b) of the Act, if a PCT application has not been published under Article 21 of the PCT, a copy of the application is a prescribed document.
- (4) In this regulation:
PCT application includes:

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- (a) an amendment under Article 19 or 34 of the PCT; and
- (b) a rectification under Rule 91 of the PCT.

3.5AG Convention application—prescribed particulars

- (1) For paragraph 29B(4)(a) of the Act, the following particulars are prescribed in relation to a relevant basic application:
 - (a) the country in which the application was made;
 - (b) the number allocated to the application by the foreign patent office of the Convention country in which the application was made;
 - (c) the date the application was made.
- (2) A reference to a country or a Convention country in subregulation (1) includes an intergovernmental authority to the extent that Rule 4.10 of the PCT permits for a PCT application.

Note: An example for subregulation (2) is that the PCT allows the European Patent Office to be specified for a regional application instead of a particular Convention country.

3.5B Filing of documents outside business hours

The Patent Office and each sub-office of the Patent Office (if any) 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
- (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.

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3.11 Prescribed period—making Convention application

For subsections 29B(2) and 38(1A) of the Act, the prescribed period is 12 months from the day a basic application is first made in a Convention country for the invention.

Division 2—Priority date of claim

3.12 What this Division is about

- (1) This Division determines the priority date of a claim:
 - (a) for subsection 36(4) of the Act (see regulation 3.13); and
 - (b) for paragraph 43(2)(a) of the Act (see regulations 3.13A to 3.13E); and
 - (c) for section 114 of the Act (see regulation 3.14).
- (2) However, if more than one of regulations 3.13A to 3.13E applies to a single claim, the priority date of the claim, for paragraph 43(2)(a) of the Act, is the earliest of the dates that is determined by those regulations.
- (3) Despite regulations 3.13A to 3.13E, the priority date of a claim, for paragraph 43(2)(a) of the Act, is no later than the date of the filing of the specification.
- (4) In this Division, a document *clearly discloses* an invention if the document discloses the invention in a manner that is clear enough, and complete enough, for the invention to be performed by a person skilled in the relevant art.

3.13 Priority date for application by person declared under section 36 of the Act

- (1) This regulation determines the priority date of a claim under subsection 36(4) of the Act.
- (2) If the claimed invention is clearly disclosed in the specification mentioned in paragraph 36(1)(c) of the Act:
 - (a) if the specification was filed in relation to a complete application, the priority date of the claim is the priority date that the claim would have had if the claim was included in the specification; and

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- (b) if the specification was filed in relation to a provisional application, the priority date of the claim is the date the specification was filed.
- (3) If the claimed invention is not clearly disclosed in the specification mentioned in paragraph 36(1)(c) of the Act, the priority date of the claim is the date the specification for the complete application referred to in subsection 36(4) of the Act was filed.

3.13A Priority date for PCT application

- (1) This regulation applies to a claim if:
 - (a) the circumstance mentioned in subregulation (2) applies to the invention defined in the claim; and
 - (b) either:
 - (i) a document mentioned in subregulation (4) clearly discloses the invention in the claim; or
 - (ii) more than one of the documents mentioned in paragraph (4)(a), considered together, clearly disclose the invention in the claim.

Circumstance

- (2) For paragraph (1)(a), the circumstance is that the specification containing the claim that defines the invention was filed for a PCT application, and:
 - (a) either:
 - (i) the PCT application claims the priority of an earlier application under Article 8 of the PCT; or
 - (ii) the PCT application has been amended to include a claim to priority from an earlier application that, at the time of filing the PCT application, was a claim to priority that could have been made under Article 8 of the PCT; and
 - (b) either:
 - (i) the earlier application was made in Australia no more than 12 months before the filing date of the PCT application; or

- (ii) the earlier application was made in Australia more than 12 months before the filing date of the PCT application, and:
 - (A) a receiving Office has restored the priority under Rule 26^{bis}.3, and the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or
 - (B) the Commissioner has restored the priority under Rule 49^{ter}.2; or
 - (C) the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority; or
- (iii) the earlier application is a basic application that was the first application made in a Convention country in relation to the invention, and:
 - (A) the earlier application was made no more than 12 months before the filing date of the PCT application; or
 - (B) the earlier application was made more than 12 months before the filing date of the PCT application, and a receiving Office has restored the priority under Rule 26^{bis}.3, and the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49^{ter}.1; or
 - (C) the earlier application was made more than 12 months before the filing date of the PCT application, and the Commissioner has restored the priority under Rule 49^{ter}.2; or
 - (D) the earlier application was made more than 12 months before the filing date of the PCT application, and the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority; or

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- (iv) the earlier application is a basic application that was made after a basic application mentioned in subparagraph (iii).
- (3) For the purposes of this regulation, if a provisional specification was filed for a basic application when the application was made, a complete specification later filed for the basic application is taken to be another basic application from which the PCT application claims priority, made on the day when the complete specification was filed.

Documents

- (4) For paragraph (1)(b), the documents are:
- (a) the documents filed for the earlier application at the time the application was made; and
 - (b) the complete specification for the PCT application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the documents filed for the earlier application, at the time the application was made, included the relevant information on the characteristics of the micro-organism that was known to the applicant; and
 - (iii) the documents filed for the earlier application, at the time the application was made, clearly disclosed the invention, other than in relation to the description of the micro-organism; and
 - (iv) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification; and
 - (v) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date the earlier application was made.

Priority date

- (5) Subject to regulation 3.12, the priority date is:
- (a) the date when the earlier application was made; or

- (b) if there is more than one earlier application—the date the earliest of those applications was made for which paragraph (1)(b) is satisfied.

3.13B Priority date for Convention application

- (1) This regulation applies to a claim if:
 - (a) the specification containing the claim that defines the invention was filed for:
 - (i) a Convention application; or
 - (ii) a complete application that has been amended to become a Convention application; and
 - (b) a document mentioned in subregulation (2), or more than one of the documents mentioned in paragraph (2)(a) considered together, clearly discloses the invention in the claim.
- (2) For subregulation (1)(b), the documents are:
 - (a) the documents filed for a related basic application at the time when the application was made; and
 - (b) the complete specification for the Convention application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the documents filed for a related basic application, at the time when the application was made, included the relevant information on the characteristics of the micro-organism that was known to the applicant; and
 - (iii) the documents filed for a related basic application, at the time when the application was made, clearly disclosed the invention, other than in relation to the description of the micro-organism; and
 - (iv) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification; and
 - (v) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date when the related basic application was made.

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- (3) For this regulation, if a provisional specification was filed for a related basic application when the application was made, a complete specification later filed for the basic application is taken to be another related basic application made on the day the complete specification was filed.
- (4) Subject to regulation 3.12, the priority date is:
 - (a) the date the related basic application was made; or
 - (b) if there is more than one related basic application—the date the earliest of those applications was made for which paragraph (1)(b) is satisfied.

3.13C Priority date for complete application associated with provisional application

- (1) This regulation applies to a claim if:
 - (a) the specification containing the claim that defines the invention was filed for a complete application that is associated with a provisional application under section 38 of the Act; and
 - (b) a document mentioned in subregulation (2), or more than one of the documents mentioned in paragraph (2)(a) considered together, clearly discloses the invention in the claim.
- (2) For paragraph (1)(b), the documents are:
 - (a) the documents filed for the provisional application at the time when the application was made; and
 - (b) the complete specification for the complete application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the documents filed for the provisional application, at the time the application was made, included the relevant information on the characteristics of the micro-organism that was known to the applicant; and
 - (iii) the documents filed for the provisional application, at the time the application was made, clearly disclosed the invention, other than in relation to the description of the micro-organism; and

- (iv) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification; and
 - (v) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date the provisional application was made.
- (3) Subject to regulation 3.12, the priority date is:
- (a) the date the provisional application was made; or
 - (b) if there is more than one provisional application—the date the earliest of those applications was made for which paragraph (1)(b) is satisfied.

3.13D Priority date for divisional application filed prior to grant of patent

- (1) This regulation applies to a claim if:
- (a) the specification containing the claim that defines the invention was filed for:
 - (i) a divisional application under section 79B of the Act; or
 - (ii) a complete application that has been amended to become a divisional application under section 79B of the Act; and
 - (b) a document mentioned in subregulation (2) clearly discloses the invention in the claim.
- (2) For paragraph (1)(b), the documents are:
- (a) the specification mentioned in subsection 79B(1) of the Act (the *earlier specification*), unless:
 - (i) the deposit requirements must be satisfied in relation to the invention to comply with paragraph 40(2)(a) of the Act; and
 - (ii) when the divisional application under section 79B of the Act is made, the period prescribed in subregulation 1.5(1) has ended in relation to the earlier specification; and
 - (iii) the requirements of paragraph 6(c) of the Act are not satisfied in relation to the earlier specification; and

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- (b) the complete specification for the divisional application, if:
 - (i) the invention in the claim relates to a micro-organism; and
 - (ii) the earlier specification is a prescribed document; and
 - (iii) on the date when the first application was made, the earlier specification included the relevant information on the characteristics of the micro-organism that was known to the applicant; and
 - (iv) on the date when the first application was made, the earlier specification clearly disclosed the invention, other than in relation to the description of the micro-organism; and
 - (v) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification for the divisional application; and
 - (vi) the micro-organism was deposited with a prescribed depository institution, in accordance with the rules of the Budapest Treaty, on or before the date when the first application was made.
- (3) Subject to regulation 3.12, the priority date is the priority date that the claim would have had if the claim was in the earlier specification.

3.13E Priority date for divisional application after grant of innovation patent

- (1) This regulation applies to a claim if:
 - (a) both of the following apply:
 - (i) the specification containing the claim that defines the invention was filed for a divisional application under section 79C of the Act;
 - (ii) examination of the divisional application is requested within 2 months from the date of the grant of the divisional application; and
 - (b) the specification referred to in subsection 79C(1) of the Act clearly discloses the invention in the claim.

- (2) Subject to regulation 3.12, the priority date is the priority date that the claim would have had if the claim had been in the specification mentioned in subsection 79C(1) of the Act.

3.14 Priority dates: certain amended claims

If section 114 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 29A(3) 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 subparagraph 114(1)(c)(ii) of the Act.

Division 3—Examination

3.14A Request for international-type search relating to provisional application

- (1) An applicant for a provisional application may make a request under Article 15(5) of the PCT for an international-type search in relation to the application.
- (2) The applicant must make the request within 10 months from the date the provisional application was filed.
- (3) If more than one International Searching Authority is competent under Article 15(5) of the PCT to carry out the search, the Commissioner may choose the Authority that will carry out the search.

3.14B Request for preliminary search and opinion relating to complete application

- (1) This regulation applies to a complete application for a standard patent made on or after 15 April 2013.
- (2) If the applicant has not asked for an examination under section 44 of the Act, the applicant may request a preliminary search and opinion relating to the application under section 43A of the Act.
- (3) The request must be in the approved form.

Note: Section 43A of the Act does not require a request to be made before the Commissioner conducts a preliminary search and opinion.

3.14C Priority dates—Convention applications and PCT applications: prescribed period for disregarding earlier applications

For paragraph 43(5)(b) of the Act, the period of more than 12 months before the filing of the Convention application or PCT application is prescribed.

3.14D Prescribed documents: basic application

- (1) For subsection 43AA(1) of the Act, the following documents that relate to a basic application are prescribed:
 - (a) a copy of the specification filed for, and at the same time as, the basic application;
 - (b) a copy of any other document filed for the basic application, whether filed at the same time as, or after, the basic application is filed;
 - (c) a document mentioned in paragraph (a) or (b) that has been certified by the competent authority of the Convention country in which the basic application was made;
 - (d) if the application relates to a micro-organism—a copy of a receipt for the deposit of the micro-organism issued by a prescribed depository institution;
 - (e) if a document mentioned in paragraphs (a) to (d) is not in English—a translation of the document into English and a certificate of verification of the translation.
- (2) For subsection 43AA(4) of the Act, if the Commissioner requires that a prescribed document relating to a basic application be made available to the Commissioner:
 - (a) the prescribed means for making the document available are:
 - (i) filing the document with the Australian Patent Office; or
 - (ii) making the document available through an approved digital library; and
 - (b) the prescribed period for making the document available is 3 months from the day the Commissioner requires the document be made available.
- (3) However, if the Commissioner is satisfied that:
 - (a) a document was made available for inspection by the Commissioner in an approved digital library within the period mentioned in paragraph (2)(b); and
 - (b) the document is no longer available for inspection;the prescribed period is 2 months after the day the Commissioner notifies the applicant or patentee that the Commissioner has not been able to inspect the document in the approved digital library.

3.15 Requirements 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) An applicant of a PCT application may not make a request for the examination of the patent request and complete specification until the applicant has complied with the requirements of subsection 29A(5) of the Act.

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 2 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.

- (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 PCT applications—Commissioner not to give certain directions

- (1) This regulation applies to a PCT application that is treated as an application for a standard patent under the Act.
- (2) The Commissioner must not give a direction under section 44 of the Act unless the applicant has complied with the requirements of subsection 29A(5) of the Act.

3.17B PCT applications—examination requirements

- (1) For subsection 45(1A) of the Act, this regulation prescribes requirements for a PCT application.
- (2) The requirements are that the applicant must:
 - (a) give a copy of the international preliminary examination report to the Commissioner; or
 - (b) advise that:
 - (i) no demand was made under Article 31 of the PCT; or
 - (ii) no amendments were made under Article 34 of the PCT; or
 - (iii) 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 29A(5) of the Act; or
 - (c) elect to abandon any amendments that may have been made under Article 34 of the PCT.
- (3) However, subregulation (2) applies only if:

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- (a) each of the following applies:
 - (i) the applicant demanded an international preliminary examination under Article 31 of the PCT before complying with the requirements of subsection 29A(5) of the Act;
 - (ii) at least 3 months after the applicant complied with the requirements of subsection 29A(5) of the Act, the Commissioner asks for a copy of the international preliminary examination report from the International Bureau;
 - (iii) the International Bureau advises that the international preliminary examination report is not available; or
- (b) both of the following apply:
 - (i) the applicant asks for the examination to be expedited under subregulation 3.17(2);
 - (ii) a copy of an international preliminary examination report relating to the application has not been provided to the Commissioner.

Note: Under subparagraph 3.5AC(9)(b)(ii), if the applicant provides the advice, or makes the election, mentioned in paragraph (2)(b) or (c), any amendments made under Article 34 of the PCT are not taken to be included in the application.

- (4) In this regulation:

international preliminary examination report has the same meaning as it has in the PCT.

3.17C PCT applications—notice if examination declined

If the Commissioner declines to examine a request and specification under subsection 45(1A) of the Act, the Commissioner must notify the applicant and ask the applicant to meet the requirements in subregulation 3.17B(2).

3.18 Report of Commissioner: examination

- (2) For paragraph 45(1)(d) of the Act, the following matters are prescribed:

- (a) whether, to the best of the Commissioner's knowledge, 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—general rules);
 - (iii) section 29B (Applications for patents—special rules for Convention applications);
 - (iv) section 38 (Time for making complete application);
 - (v) section 79B (Divisional applications prior to grant of patent);
 - (vi) section 81 (Grant of patent of addition);
 - (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');
 - (e) whether a patent cannot be granted on the application because of subsection 64(2) of the Act ('grant: multiple applications');
 - (f) for a PCT application—whether, to the best of the Commissioner's knowledge, the application complies with subregulations 3.2C(2) and (3).
- (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 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 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.

3.22 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;
 - (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.
-

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 depository 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 depository 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 depository institution, the Commissioner:
 - (a) on the order of a court in Australia, must; or
 - (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:

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- (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 depository 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
 - (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
 - (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

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- 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.
- (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 matters complained of took place the specification did not comply with the requirements referred to in paragraph 6(c) or (d) of the Act.
- (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

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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 breaches 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
 - (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*.
- (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.

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- (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 depository 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
 - (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.

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.

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- (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
 - (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 subsection 53(1) 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) 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
 - (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 that the Commissioner has reasonable grounds for believing should not be open to public inspection.

4.4 Publication and inspection of PCT applications

- (1) For subsection 56A(1) of the Act, a PCT application is taken to have become open to public inspection, and to have been published in Australia:
 - (a) if a notice in relation to the application is published under subregulation (3)—on the day the notice is published; or
 - (b) if subregulation (5) applies—on the day the application is published under Article 21 of the PCT.
- (2) Subregulation (3) applies to a PCT application:
 - (a) that has not lapsed, or been withdrawn or refused; and
 - (b) for which the applicant has complied with subsection 29A(5) of the Act before the end of 18 months after the priority date of the application.
- (3) 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.
- (4) A request for publication under subregulation (3) must be in the approved form.
- (5) The PCT application is open to public inspection if:
- (a) the applicant does not comply with subsection 29A(5) of the Act within 18 months after the priority date of the application; and
 - (b) the application is published under Article 21 of the PCT.
- (6) The following documents are open for inspection if a notice is published under subregulation (3) or if subregulation (5) applies:
- (a) a copy of the relevant application;
 - (b) all documents in the possession of the Patent Office, other than those mentioned in subregulation (7), that are associated with:
 - (i) the application; or
 - (ii) any provisional application from which the application claims priority under Article 8 of the PCT.
- (7) Subregulation (6) does not apply to the following documents:
- (a) a document that would be privileged from production in legal proceedings on the ground of legal professional privilege;
 - (b) a document mentioned in subregulation 4.3(2).
- (8) In this regulation:
- priority date*** has the same meaning as in the PCT.

Chapter 5—Opposition

Part 5.1—Preliminary

5.1 What this Chapter is about

This Chapter sets out requirements for the following:

- (a) the filing of notices of opposition and associated documents;
- (b) the amending of filed documents;
- (c) the dismissal of an opposition;
- (d) the hearing of an opposition;
- (e) associated matters.

5.2 Definitions

General

In this Chapter:

applicant means:

- (a) for a section 101M opposition—the patentee of an innovation patent; or
- (b) for any other opposition—a person whose application or request under the Act or these Regulations is opposed by an opponent.

notice of opposition means a notice filed under regulation 5.4, 5.6 or 5.10.

opponent means:

- (a) for a section 101M opposition—a person who files a notice of opposition under regulation 5.6; or
- (b) for any other opposition—a person who files a notice of opposition under regulation 5.4 or 5.10.

party means an applicant or an opponent.

procedural opposition means an opposition begun by filing a notice of opposition under regulation 5.10.

section 101M opposition means an opposition under section 101M of the Act.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds on which the opponent intends to rely; and
- (b) the facts and circumstances forming the basis for the grounds.

substantive opposition means:

- (a) an opposition begun by filing a notice of opposition under regulation 5.4; or
- (b) a section 101M opposition.

Note: The following terms are defined in Schedule 1 to the Act:

- (a) approved form;
- (b) complete specification;
- (c) file;
- (d) patent request;
- (e) patentee;
- (f) re-examination.

5.3 Commissioner may give direction about filing document or evidence

- (1) If a document or evidence may or must be filed under this Chapter, the Commissioner may give a direction specifying:
 - (a) the number of copies of the document or evidence to be filed; and
 - (b) the form in which the document or evidence is to be filed; and
 - (c) the means by which the document or evidence is to be filed.
- (2) The Commissioner may make or revoke the direction as the Commissioner sees fit.

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- (3) If a party does not comply with the direction, the Commissioner may:
 - (a) treat the document or evidence as not having been filed; or
 - (b) tell the party to comply with the direction.

Part 5.2—Filing of opposition documents

Division 5.2.1—Substantive opposition

5.4 Notice of opposition—standard patent opposition

- (1) For section 59 of the Act, a person opposes the grant of a standard patent by filing a notice of opposition, in the approved form, within 3 months from the day the notice of acceptance is published under paragraph 49(5)(b) of the Act.
- (2) For subsection 75(1) of the Act, a person opposes the grant of an extension of the term of a standard patent by filing a notice of opposition, in the approved form, within 3 months from the day the notice of acceptance is published under paragraph 74(2)(b) of the Act.
- (3) The Commissioner must give an applicant in relation to a notice of opposition filed under subregulation (1) or (2) a copy of the notice of opposition as soon as practicable.

5.5 Statement of grounds and particulars—standard patent opposition

- (1) An opponent in a substantive opposition, other than a section 101M opposition, must file a statement of grounds and particulars within 3 months from the day the notice of opposition is filed.
- (2) The statement of grounds and particulars must be:
 - (a) in the approved form; and
 - (b) accompanied by a copy of each document mentioned in the statement, unless the document:
 - (i) is open to public inspection; and
 - (ii) relates to a provisional or complete application for a patent.

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- (3) The Commissioner must give the applicant a copy of the statement and accompanying documents as soon as practicable.

**5.6 Notice of opposition and statement of grounds and particulars—
section 101M opposition**

- (1) For section 101M of the Act, a person opposes an innovation patent that has been certified by filing the following documents:
- (a) a notice of opposition in the approved form;
 - (b) a statement of grounds and particulars;
 - (c) a copy of each document mentioned in the statement, unless the document:
 - (i) is open to public inspection; and
 - (ii) relates to a provisional or complete application for a patent.
- (2) The documents:
- (a) may be filed at any time after the certification of the patent; and
 - (b) must be filed at the same time.
- (3) The Commissioner must give copies of the documents to the applicant as soon as practicable.

5.7 Filing of evidence

- (1) A party who intends to file evidence in a substantive opposition must:
- (a) file the evidence within the relevant evidentiary period mentioned in regulation 5.8; and
 - (b) if the party files all the evidence before the end of the period—notify the Commissioner of that fact.
- (2) The Commissioner must give a copy of any evidence filed by a party under regulation 5.8 to the other party:
- (a) before the end of the period, if the Commissioner considers it appropriate to do so; or

- (b) as soon as practicable after the relevant evidentiary period ends.
- (3) The Commissioner must, as soon as practicable, notify:
 - (a) the other party of a notification under paragraph (1)(b); or
 - (b) if no notification is given under paragraph (1)(b)—the parties that:
 - (i) all the evidence for the period has been filed; or
 - (ii) no evidence was filed.

5.8 Evidentiary periods

Evidence in support

- (1) An opponent in a substantive opposition must file any evidence in support of the opposition:
 - (a) for a section 101M opposition—at the same time as the documents mentioned in subregulation 5.6(1); or
 - (b) for any other substantive opposition—within 3 months from the day the opponent files the statement of grounds and particulars under regulation 5.5.

Evidence in answer

- (2) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the evidence in support within 3 months from the day the Commissioner:
 - (a) gives the applicant:
 - (i) all the evidence in support; or
 - (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
 - (b) notifies the applicant that all the evidence in support has been filed.
- (3) If the opponent does not file any evidence in support of the opposition, the applicant must file any evidence in answer to the statement of grounds and particulars within 3 months from the day

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the Commissioner notifies the applicant that no evidence in support was filed.

Evidence in reply

- (4) If the applicant files evidence in answer under subregulation (2) or (3), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Commissioner:
 - (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and
 - (b) notifies the opponent that all the evidence in answer has been filed.

5.9 Extension of time for filing evidence

- (1) The Commissioner may extend an evidentiary period mentioned in regulation 5.8:
 - (a) if requested in writing by a party; or
 - (b) on the Commissioner's own initiative.
- (2) The Commissioner may extend the period only if the Commissioner is satisfied that:
 - (a) the party who intended to file evidence in the period:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements under this Chapter; and
 - (ii) despite acting promptly and diligently at all times to ensure the appropriate evidence is filed within the period, is unable to do so; or
 - (b) there are exceptional circumstances that warrant the extension.
- (3) The Commissioner must determine the length of the extended period having regard to what is reasonable in the circumstances.
- (4) The Commissioner must notify the parties of the extension as soon as practicable.

(5) In this regulation:

exceptional circumstances includes the following:

- (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Chapter;
- (b) an error or omission by the Commissioner that prevents a party from complying with a filing requirement under this Chapter;
- (c) an order of a court, or a direction by the Commissioner, that the opposition be stayed pending the completion of a related proceeding or action under the Act.

Division 5.2.2—Procedural opposition

5.10 Notice of opposition

Leave to amend filed document

- (1) For subsection 104(4) of the Act, a person opposes a request for leave to amend a filed document by filing a notice of opposition, in the approved form, within 2 months from the day the notice of the granting of leave to amend is published under subregulation 10.5(2).

Note: For the grounds on which an amendment may be opposed, see regulation 5.21.

Extension of time to do relevant act

- (2) For subsection 223(6) of the Act, a person opposes the grant of an application for an extension of time to do a relevant act by filing a notice of opposition, in the approved form, within 2 months from the day the advertisement of the extension application is advertised under subsection 223(4) of the Act.

Application for grant of licence

- (3) For subregulation 22.21(4), a person opposes the grant of a licence by filing a notice of opposition, in the approved form, within 2 months from the day the Commissioner gives the person a copy of the application under subregulation 22.21(3).

Commissioner to give copy of notice to applicant

- (4) The Commissioner must give an applicant in relation to subregulation (1), (2) or (3) a copy of the notice of opposition as soon as practicable.

5.11 Statement of grounds and particulars

- (1) An opponent in a procedural opposition must file a statement of grounds and particulars within one month from the day the notice of opposition is filed under regulation 5.10.
- (2) The statement of grounds and particulars must be:
 - (a) in the approved form; and
 - (b) accompanied by a copy of each document mentioned in the statement of grounds and particulars, unless the document:
 - (i) is open to public inspection; and
 - (ii) relates to a provisional or complete application for a patent.
- (3) The Commissioner must give the applicant a copy of the statement of grounds and particulars and accompanying documents as soon as practicable.

5.12 Practice and procedure

The Commissioner may:

- (a) decide the practice and procedure to be followed in a procedural opposition; and
- (b) direct the parties accordingly.

Part 5.3—Amendments to opposition documents

5.13 Application of regulation 22.22

Regulation 22.22 does not apply to an amendment made under this Part.

5.14 Notice of opposition—correction of errors or mistake

- (1) An opponent may request the Commissioner in writing to amend the opponent's notice of opposition to correct a clerical error or obvious mistake.
- (2) The Commissioner must give the parties an opportunity to make representations about the proposed amendment.
- (3) The Commissioner must, as soon as practicable:
 - (a) notify the parties of the Commissioner's decision; and
 - (b) if the Commissioner decides to make the amendment—give the applicant a copy of the amended notice of opposition.

5.15 Notice of opposition—change of opponent

- (1) This regulation applies if an opponent's right or interest in an opposition is transferred to another person (the *new opponent*) during an opposition.
- (2) The new opponent may:
 - (a) tell the Commissioner that the right or interest in the opposition has been transferred to the new opponent; and
 - (b) request the Commissioner in writing to amend the notice of opposition to record the new opponent's name.
- (3) The Commissioner must give the applicant, the opponent and the new opponent an opportunity to make representations about the amendment.
- (4) The Commissioner must:

- (a) as soon as practicable:
 - (i) notify the parties of the Commissioner's decision; and
 - (ii) if the Commissioner decides to make the amendment—
give the applicant a copy of the amended notice of
opposition; and
- (b) ensure that the opposition proceeds in the name of the new
opponent.

5.16 Statement of grounds and particulars

- (1) An opponent may request the Commissioner in writing to amend
the opponent's statement of grounds and particulars:
 - (a) to correct an error or omission in the grounds of opposition;
or
 - (b) to update the grounds of opposition to reflect an amendment
to the patent request or complete specification to which the
statement relates; or
 - (c) to amend the facts and circumstances forming the basis for
the grounds.
- (2) The Commissioner must:
 - (a) notify the applicant of the opponent's request; and
 - (b) give the parties an opportunity to make representations about
the amendment.
- (3) The Commissioner must not make the amendment if:
 - (a) the Commissioner is considering an application for dismissal
of the opposition under Part 5.4; or
 - (b) for an opposition begun under subregulation 5.4(1):
 - (i) the applicant's complete specification is being
re-examined; and
 - (ii) the re-examination is not completed as required by
regulation 9.5.
- (4) The Commissioner must make the amendment if:
 - (a) subregulation (3) does not apply; and
 - (b) the Commissioner is satisfied that the amendment should be
made.

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Part 5.3 Amendments to opposition documents

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- (5) The Commissioner must, as soon as practicable:
 - (a) notify the parties of the Commissioner's decision; and
 - (b) if the Commissioner decides to make the amendment—give the applicant a copy of the amended statement.

Part 5.4—Dismissal of opposition

5.17 Dismissal on request

- (1) An applicant may request the Commissioner to dismiss an opposition:
 - (a) within one month from the day the Commissioner gives the applicant a copy of the statement of grounds and particulars under subregulation 5.5(3), 5.6(3) or 5.11(3); or
 - (b) if the applicant's complete specification is re-examined under subsection 97(1) of the Act—within one month from the day the re-examination is completed as required by regulation 9.5.
- (2) The request must be in the approved form.
- (3) The Commissioner must give the opponent a copy of the request as soon as practicable.
- (4) If the Commissioner decides to dismiss the opposition, the Commissioner must, as soon as practicable, notify the parties of the decision.

Note: For the requirements the Commissioner must satisfy when exercising a discretionary power adversely to a person, see regulation 22.22.

5.18 Dismissal on initiative of Commissioner

- (1) The Commissioner may dismiss an opposition if the Commissioner considers it appropriate to do so.
- (2) The grounds on which the Commissioner may dismiss the opposition include an opponent's failure to file a statement of grounds and particulars or document mentioned in the statement in accordance with regulation 5.5, 5.6 or 5.11.
- (3) If the Commissioner decides to dismiss the opposition, the Commissioner must notify the parties of the decision as soon as practicable.

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Part 5.4 Dismissal of opposition

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Note: For the requirements the Commissioner must satisfy when exercising a discretionary power adversely to a person, see regulation 22.22.

Part 5.5—Hearing of opposition

5.19 Hearing and decision—re-examination

- (1) This regulation applies to an opposition if:
 - (a) the applicant's complete specification is re-examined under subsection 97(1) of the Act; and
 - (b) the re-examination is completed as required by regulation 9.5.
- (2) The Commissioner may hear and decide the opposition:
 - (a) on the Commissioner's own initiative, if the Commissioner considers it appropriate to do so; or
 - (b) at the opponent's request, if the request is made:
 - (i) less than one month after the re-examination is completed as required by regulation 9.5; and
 - (ii) in the approved form.
- (3) The Commissioner must give the applicant a copy of a request under paragraph (2)(b) as soon as practicable.
- (4) The Commissioner must notify the parties of the decision as soon as practicable.

5.20 Hearing and decision—other circumstances

- (1) This regulation applies to an opposition if:
 - (a) the periods for filing evidence have ended; and
 - (b) the notice of opposition has not been withdrawn under regulation 5.26; and
 - (c) the opposition has not been dismissed under Part 5.4 or heard and decided under regulation 5.19.
- (2) The Commissioner:
 - (a) must hold a hearing of the opposition if requested by a party in writing; or

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- (b) may decide, on the Commissioner's own initiative, to hold a hearing of the opposition.
- (3) The hearing may, at the Commissioner's discretion, be:
 - (a) an oral hearing; or
 - (b) by written submissions.
- (4) If the Commissioner decides on an oral hearing:
 - (a) the Commissioner must notify the parties of the date, time and place of the hearing; and
 - (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
 - (c) the applicant must file a summary of submissions at least 5 business days before the hearing; and
 - (d) the Commissioner must give a copy of each party's summary of submissions to the other party as soon as practicable.
- (5) The Commissioner must:
 - (a) decide the opposition; and
 - (b) notify the parties of the Commissioner's decision.
- (6) The Commissioner, in making an award of costs in relation to an opposition under subregulation 22.8(2), may consider a failure by a party to file a summary of submissions under subregulation (4).

Part 5.6—Miscellaneous

5.21 Opposition to amendment—grounds

For subsection 104(4) of the Act, an opposition to an amendment may be made only on the ground that the amendment is not allowable under:

- (a) section 102 of the Act; or
- (b) regulation 10.3.

Note: For the period for filing a notice of opposition to the allowance of an amendment, see subregulation 5.10(1).

5.22 Commissioner may give directions

- (1) The Commissioner may give a direction in relation to an opposition to which this Chapter applies:
 - (a) if requested by a party in writing; or
 - (b) on the Commissioner's own initiative.
- (2) If the Commissioner proposes to give a direction, the Commissioner must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Commissioner must notify the parties of the direction as soon as practicable.

5.23 Commissioner may consult documents

- (1) For the purposes of deciding an opposition, the Commissioner may consult a document that:
 - (a) is relevant to the opposition; and
 - (b) has not been filed under this Chapter; and
 - (c) is available in the Patent Office.

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- (2) If the Commissioner proposes to rely on the document, the Commissioner must give the parties:
 - (a) notice of the Commissioner's intention to do so; and
 - (b) a copy of, or access to, the document; and
 - (c) an opportunity to give evidence or make representations about the document.

5.24 Representations to Commissioner—formal requirements

A representation mentioned in a provision of this Chapter may be made to the Commissioner by any means approved by the Commissioner.

5.25 Extension of time for filing—amendment at Commissioner's direction

- (1) This regulation applies if:
 - (a) the Commissioner directs an applicant to file a statement of proposed amendments under subsection 107(1) of the Act; and
 - (b) a period for filing a document under this Chapter begins or ends during the amendment period.
- (2) The period for filing the document is extended by the equivalent of the amendment period.
- (3) In this regulation:

amendment period means the period that:

 - (a) begins on the day the applicant is given an opportunity to be heard under subsection 107(2) of the Act; and
 - (b) ends on the day the Commissioner decides whether to allow the amendment.

5.26 Withdrawal of opposition

- (1) An opponent may withdraw an opposition at any time by filing a signed notice of withdrawal in the approved form.

- (2) The Commissioner must give the applicant a copy of the notice of withdrawal as soon as practicable.

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*.

6.1A Prescribed particulars—grant of standard patent

For subsection 61(1) of the Act, the following particulars are prescribed:

- (a) the date the patent is granted by the Commissioner;
- (b) any other particulars of the grant that the Commissioner considers appropriate.

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 AAT—the court or AAT 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).

6.2A Prescribed particulars—grant of innovation patent

For subsection 62(1) of the Act, the following particulars are prescribed:

- (a) the date the innovation patent is granted by the Commissioner;
- (b) any other particulars of the grant that the Commissioner considers appropriate.

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.
- (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:

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- (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
 - (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 subsections 29B(1) and (2) of the Act, a Convention application in relation to a basic application, the date

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of the patent is the date 12 months from the date of making the first basic application to which the Convention application relates.

- (11) If a PCT application claims the priority of an earlier application under Article 8 of the PCT, and a circumstance mentioned in an item of the following table applies, the date of the patent is the date 12 months from the date of making the first application mentioned in the item.

Circumstances		
Item	Column 1	Column 2
	The earlier application was...	and:
1	an application made in Australia more than 12 months before the international filing date of the PCT application	both of the following apply: (a) a receiving Office has restored priority under Rule 26 ^{bis} .3 of the PCT; (b) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49 ^{ter} .1 of the PCT
2	an application made in Australia more than 12 months before the international filing date of the PCT application	the Commissioner has restored priority under Rule 49 ^{ter} .2 of the PCT
3	an application made in Australia more than 12 months before the international filing date of the PCT application	the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority
4	a basic application made more than 12 months before the international filing date of the PCT application, being the first application made in a Convention country for the invention	both of the following apply: (a) a receiving Office has restored priority under Rule 26 ^{bis} .3 of the PCT; (b) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49 ^{ter} .1 of the PCT
5	a basic application made more than	the Commissioner has restored

Chapter 6 Grant and term of patents
Part 1 Patents generally

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Circumstances

Item	Column 1	Column 2
	The earlier application was...	and:
	12 months before the international filing date of the PCT application, being the first application made in a Convention country for the invention	priority under Rule 49 ^{ter} .2 of the PCT
6	a basic application made more than 12 months before the international filing date of the PCT application, being the first application made in a Convention country for the invention	the Commissioner has granted an extension of time under section 223 of the Act that has the effect of restoring a right of priority

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 the Australian

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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.

- (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 before grant—standard and innovation patents

- (1) For paragraph 79B(2)(a) and subparagraph 79B(3)(b)(iv) of the Act, a further complete application must:
 - (a) be made in accordance with section 29 of the Act; and
 - (b) be filed:
 - (i) if the first application is for a standard patent—no later than 3 months from the day the notice of acceptance of the first application is published under paragraph 49(5)(b) of the Act; or
 - (ii) if the first application is for an innovation patent—before the grant of the patent under subsection 62(1) of the Act.

Note: For the definition of *first application*, see section 79B of the Act.

- (2) For paragraph 79B(2)(b) of the Act, the particulars are:
 - (a) a statement that the application is a further complete application for section 79B of the Act; and
 - (b) the number of the first application.

6A.2 Divisional applications after grant—innovation patents

- (1) For paragraph 79C(1A)(a) and subparagraph 79C(2)(b)(iv) of the Act, a further complete application must be:
 - (a) made in accordance with section 29 of the Act; and
 - (b) filed no later than one month from the day the notice of the occurrence of the examination of the first patent is published under paragraph 101E(2)(b) of the Act.

Note: For the definition of *first patent*, see section 79C of the Act.

- (2) For paragraph 79C(1A)(b) of the Act, the particulars are:
 - (a) a statement that the application is a further complete application for section 79C of the Act; and

(b) the number of the first patent.

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 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.
- (1A) A request must state:
 - (a) the grounds of the request; and
 - (b) the reasons why the grounds are relevant to the complete specification.
- (2) Subregulations (2A) and (3) apply if the request includes an assertion that the invention, so far as claimed in any claim and when compared with the prior art base that existed before the priority date of that claim:
 - (a) is not novel; or
 - (b) for a standard patent—does not involve an inventive step; or
 - (c) for an innovation patent—does not involve an innovative step.
- (2A) For subregulation (2), the request must:
 - (a) identify the documents on which the assertion is based; and
 - (b) state the relevance of each document.
- (3) The request must have with it:

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- (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
 - (c) evidence of the date and place of publication of the document.
- (4) If the request does not comply with subregulation (1A), or subregulations (2), (2A) and (3) if applicable, the Commissioner may decide not to 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.
- (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

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- Act within 2 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 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.

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

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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.
- (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 requires a document to be made available under subsection 43AA(4) of the Act—5 months from the date the requirement is made;
- (e) if:
 - (i) the Commissioner has informed the patentee of a notice under subsection 28(1) of the Act; and

- (ii) a ground for revocation is raised based on information in the notice;
3 months from the date of the report that first mentions the ground for revocation;
- (f) if:
 - (i) the Commissioner gives the applicant an opportunity to be heard in relation to a report under section 101B of the Act or regulation 10.2 by:
 - (A) notifying the applicant in writing of the date by which written submissions must be filed; or
 - (B) notifying the applicant in writing of the date, time and place of an oral hearing; and
 - (ii) the Commissioner makes a decision in writing in relation to the report;
3 months from the date the decision is made;
- (g) if the Commissioner revokes a certificate of examination under section 101EA of the Act—3 months from the date the decision to revoke is made.

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.

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.
- (1AA) However, an applicant of a PCT application may not ask the Commissioner for leave to amend until the applicant has complied with the requirements of subsection 29A(5) of the Act.
- (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

- (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) notify the applicant of that fact; and

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- (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 29A(5);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: 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.

- (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.
- (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).

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- (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.

10.2A Documents considered for determining whether amendment allowed

For paragraph 102(1)(b) of the Act, the following documents are prescribed:

- (a) an abstract that was filed with the complete specification;
- (b) a missing part or element of a complete specification that was incorporated into the specification, in accordance with regulation 3.5A or Rule 20.5 or 20.6 of the PCT;
- (c) an amendment that has been made to the complete specification after filing, for the purpose of:
 - (i) correcting a clerical error or obvious mistake; or
 - (ii) complying with paragraph 6(c) of the Act.

10.2B Amendments not allowable for patent requests

- (1) This regulation is made for subsection 102(2D) of the Act.
- (2) An 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) the amendment 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.
- (3) If:
 - (a) a request for leave to amend a patent request for a standard patent is filed within 3 weeks before the date a notice is due to be published in the *Official Journal* under section 54 of the Act in relation to the specification; and
 - (b) the amendment would:
 - (i) convert the patent application from an application for a standard patent to an application for an innovation patent; or
 - (ii) change the priority date of the application to a date that is later than the priority date that is currently recorded for the application;

the amendment is not allowable until after the date the notice is published.
- (4) An 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) the amendment would convert the patent application into a further complete application within the meaning of section 79B or 79C of the Act.
- (5) An amendment of a patent request is not allowable if:

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- (a) the amendment would convert the patent application into a further complete application within the meaning of section 79B of the Act; and
 - (b) the period allowed under subsection 79B(3) of the Act for making a further complete application has ended.
- (6) An amendment of a patent request is not allowable if:
- (a) the amendment would convert the patent application into a further complete application within the meaning of section 79C of the Act; and
 - (b) the period allowed under subsection 79C(2) of the Act for making a further complete application has ended.
- (7) An amendment of a patent request is not allowable after the patent has been granted.

10.2C Amendments not allowable for complete specifications

- (1) This regulation is made for subsection 102(2D) of the Act.
- (2) An amendment of a complete specification is not allowable if:
- (a) the amendment relates to 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.
- (3) An amendment of a complete specification is not allowable if the Commissioner:
- (a) has given a copy of a request for leave to amend under subregulation 10.2(8) or (9) to a person; and
 - (b) has not given the person a reasonable opportunity to be heard.
- (4) An amendment of a complete specification 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.

- (5) An 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
 - (b) a thing mentioned in subsection 18(3) of the Act (other than a thing also mentioned in subsection 18(4) of the Act).
- (6) An amendment of a complete specification is not allowable if making an amendment would be contrary to section 112 or 112A of the Act.

10.3 Amendments not allowable for other documents

- (1) For a provisional specification, an amendment of the provisional specification is not allowable if, as a result of the amendment, the specification would disclose matter that extends beyond that disclosed in the following documents taken together:
 - (a) the provisional specification as filed;
 - (b) an abstract that was filed with the provisional specification;
 - (c) a missing part of a provisional specification that was incorporated into the specification in accordance with regulation 3.5A.
- (2) An amendment of an abstract is not allowable.

Note: An abstract may be substituted under regulation 3.4.

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 10.2C(3); 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 of the Act and that do not relate to matters mentioned in paragraph 6(c) of the Act—if the Commissioner is satisfied, on the balance of probabilities, 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 is satisfied, on the balance of probabilities, that the proposed amendments would remove all lawful grounds for revocation of the innovation patent.
- (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
 - (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.

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- (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 AAT 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 AAT 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.

10.6A Deferred consideration of request for amendment

- (1) This regulation applies if:
 - (a) on or after 1 January 2012—an applicant asks the Commissioner for leave to amend a complete specification; and
 - (b) the complete specification relates to an application for a standard patent; and
 - (c) the applicant has not filed a request for examination of the patent request and complete specification relating to the application; and
 - (d) the applicant asks the Commissioner to defer considering the request for leave to amend until the Commissioner examines the patent request and complete specification.
- (2) The request for leave to amend the complete specification is taken to be filed immediately after the applicant files the request for examination of the patent request and complete specification.

10.6B Revocation of grant of leave

- (1) A grant of leave to amend a patent request, complete specification or other filed document under regulation 10.5 is revoked if:
 - (a) leave to amend was granted at the same time as the acceptance of the patent request and complete specification under subsection 49(1) of the Act; and
 - (b) acceptance of the patent request and complete specification is later revoked under section 50A of the Act.
- (2) A grant of leave to amend a patent request, complete specification or other filed document under regulation 10.5 is revoked if:
 - (a) leave to amend was granted at the same time as the decision mentioned in paragraph 101E(a) of the Act was made; and
 - (b) the certificate of examination issued in relation to the patent is later revoked under subsection 101EA(1) of the Act.
- (3) The Commissioner may revoke a grant of leave to amend a patent request, complete specification or other filed document under regulation 10.5 if the Commissioner is satisfied that:
 - (a) leave to amend should not have been granted, taking into account all of the circumstances that existed when leave was granted (whether or not the Commissioner knew the circumstances existed); and
 - (b) it is reasonable to revoke the grant and allowance of the amendment(if applicable), taking into account all of the circumstances; and
 - (c) there are no relevant proceedings pending.
- (4) If leave to amend a patent request, complete specification or other filed document under regulation 10.5 is revoked (whether automatically or by the Commissioner):
 - (a) leave to amend is taken to never have been granted; and
 - (b) if allowed under regulation 10.6, the amendment is taken not to have been allowed; and
 - (c) the Commissioner must continue to examine and report on the amendment in accordance with subregulation 10.2(1); and

Regulation 10.7

- (d) regulations 10.5 and 10.6 continue to apply in relation to the amendment.

10.7 Rectification of Register

- (1) A person applying for rectification of the Register under section 191A of the Act must do so in the approved form.
- (2) The Commissioner:
 - (a) may seek further information from any person for the purpose of considering the application; and
 - (b) is not required to consider the application while seeking the further information.
- (3) The Commissioner must publish a notice of the rectification request in the *Official Journal* unless the rectification:
 - (a) relates to an address included in the Register; or
 - (b) relates to a name included in the Register and does not relate to a change of identity; or
 - (c) relates to the title of an invention included in the Register; or
 - (d) is to correct an obvious mistake made in the Register; or
 - (e) does not materially alter the meaning or scope of an entry in the Register.
- (4) However, the Commissioner is not required to publish a notice under subregulation (3) if the Commissioner is satisfied that the rectification should not be made.
- (5) If the Commissioner publishes a notice under subregulation (3), the Commissioner must not rectify the Register until the later of:
 - (a) 2 months after publishing the notice; and
 - (b) if a person requests to be heard in relation to the rectification request—after the person has been heard.

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.

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 mentioned in regulation 1.4 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 granting of the patent to which the application relates is prescribed.
- (2) An applicant must lodge with the Registrar of the Federal Court:
 - (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.
- (2A) For subparagraph (2)(a)(ii), the address for service must be an address that is mentioned in Rules made by the Federal Court for the service of the application, as in force from time to time.

Regulation 12.2

Note: In a transitional period after this subregulation commences, there may be different Rules made by the Federal Court to deal with suitable addresses for service in particular circumstances.

- (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).
- (4) For subregulation (3), the applicant must serve the copy in accordance with Rules made by the Federal Court for the service of the application and declaration, as in force from time to time.

Note: In a transitional period after this subregulation commences, there may be different Rules made by the Federal Court to deal with service in particular circumstances.

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) The Federal 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
 - (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

Regulation 12.4

- (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.

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 paragraph 141(1)(c) 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 paragraph 141(1)(c) 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
 - (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.

Regulation 13.1C

13.1C PCT applications—prescribed circumstances in which application may be withdrawn or taken to be withdrawn

- (1) For subsection 141(2) of the Act, a PCT application may be withdrawn if the conditions mentioned in subsection 141(1) of the Act are met.
- (2) For subsection 141(2) of the Act, a PCT application is taken to be withdrawn if Article 11(3) of the PCT ceases to have effect in Australia in relation to the PCT application under Article 24(1)(i) of the PCT.

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

(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 examination of the patent request and complete specification is requested before 15 April 2013—21 months from the date of the first report (if any) under section 45 of the Act;
 - (b) if examination is requested on or after 15 April 2013—12 months from the date of the first report (if any) 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
 - (ii) the Commissioner has made a declaration under paragraph 36(1)(c) of the Act;subject to subregulation (3), the period of 3 months from the date of that declaration;
 - (g) subject to subregulation (3), if:

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- (i) the Commissioner gives the applicant an opportunity to be heard in relation to a report under section 45 of the Act or regulation 10.2 by:
 - (A) notifying the applicant in writing of the date by which written submissions must be filed; or
 - (B) notifying the applicant in writing of the date, time and place of an oral hearing; and
- (ii) the Commissioner makes a decision in writing in relation to the report;
3 months from the date the decision is made;
- (ga) subject to subregulation (3), if the Commissioner revokes an acceptance under subsection 50A(1) of the Act—3 months from the date the decision to revoke is made;
- (h) if an appeal has been made to a prescribed court, or an application for review has been made to the AAT, 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 AAT 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 requires a document to be made available under subsection 43AA(4) of the Act—the period of 5 months from the date the requirement is made;
- (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), (f), (g) or (ga) 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.

13.5A PCT application—prescribed circumstances for lapsing of application

- (1) For paragraph 142(2)(f) of the Act, a circumstance in which a PCT application lapses is that the applicant has not met the requirements of subsection 29A(5) of the Act within the prescribed period for that subsection.
- (2) For paragraph 142(2)(f) of the Act, a circumstance in which a PCT application lapses is that the effect of the international application under Article 11(3) of the PCT ceases in Australia under Article 24(1)(ii) of the PCT before the requirements of subsection 29A(5) of the Act have been met.

13.6 Time for payment of renewal fee for patent

- (1) For paragraphs 143(a) and 143A(d) of the Act:
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Regulation 13.6

- (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.
- (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.

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.

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.

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.

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.

Chapter 20—Individual Patent Attorneys

Part 1—Introduction

20.1A Application of this Chapter

This Chapter applies to:

- (a) a patent attorney who is not an incorporated patent attorney;
and
- (b) an individual applying for registration as a patent attorney.

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.

professional misconduct has the meaning given by regulation 20.32.

serious offence means an offence that:

- (a) involves obtaining property or a financial advantage by deception or fraudulent conduct; and
- (b) is either:
 - (i) an indictable offence against a law of the Commonwealth, a State or a Territory (whether or not the offence may be dealt with summarily); or
 - (ii) an offence against a law of a foreign country that would be an indictable offence against a law of the Commonwealth, a State or a Territory if committed in

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Australia (whether or not the offence could be dealt with summarily if committed in Australia).

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.

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 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);
 - (f) a declaration, by another person, that the applicant is of good fame, integrity and character.

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- (2) A 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
 - (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.
- (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.

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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.
- (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;
 - (ii) preparing, filing and prosecuting patent applications in Australia;
 - (iii) preparing, filing and prosecuting patent applications in other countries and organisations, particularly countries and organisations that are regarded as major trading partners with Australia;
 - (iv) drafting patent specifications;

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- (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
 - (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.

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.

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.

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.

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

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- (ii) applies to the Board to sit for the supplementary examination within 1 month of the examination.
- (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.

Part 5—Maintaining registration

20.22 Requirements for remaining on Register of Patent Attorneys

- (1) To remain on the Register of Patent Attorneys, 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 of Patent Attorneys 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.
- (2) The Board may publish guidelines setting out criteria for deciding whether or not activities are likely to be appropriate for an attorney

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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.

Part 6—Removal of attorney's name from Register of Patent Attorneys

20.26 Voluntary removal of name from Register of Patent Attorneys

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 of Patent Attorneys 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 of Patent Attorneys.

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Part 6 Removal of attorney's name from Register of Patent Attorneys

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- (3) If the Designated Manager removes the name of a registered patent attorney from the Register of Patent Attorneys under subregulation (2), the name of the attorney must not be returned to the Register of Patent Attorneys 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 of Patent Attorneys.

Part 6A—Suspension of registration

20.28A Requirement to notify of serious offence

- (1) A registered patent attorney who has been charged with a serious offence must, within 14 days after being charged, notify the Designated Manager, in writing, of the charge.
- (2) If the registered patent attorney:
 - (a) fails to comply with subregulation (1); and
 - (b) does not have a reasonable excuse for failing to comply;the failure to comply constitutes unsatisfactory professional conduct.

20.28B Suspension of registration—serious offence

- (1) The Designated Manager may, by written notice to a registered patent attorney, suspend the registered patent attorney's registration if the Designated Manager:
 - (a) is notified under subregulation 20.28A(1); or
 - (b) becomes aware that the registered patent attorney has been charged with a serious offence.
- (2) If the Designated Manager suspends the registered patent attorney's registration:
 - (a) the suspension takes effect when the notice is given to the registered patent attorney; and
 - (b) the Designated Manager must:
 - (i) give written notice to the Board of the suspension; and
 - (ii) by written notice, give the registered patent attorney 28 days after the date of the notice (a *show cause notice*) within which to show cause why the suspension should be lifted.

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- (3) The Designated Manager must consider any information provided by the registered patent attorney in response to the show cause notice.
- (4) The Designated Manager must immediately end the suspension if:
 - (a) the Designated Manager becomes aware that the charge is not proceeded with or the prosecution of the charge is abandoned; or
 - (b) the Designated Manager becomes aware that the proceedings have been completed without a conviction being recorded; or
 - (c) the proceedings have been completed with a conviction being recorded and the Disciplinary Tribunal decides not to continue the suspension or cancel the registered patent attorney's registration; or
 - (d) the Designated Manager considers that the suspension is no longer necessary.
- (5) If the Designated Manager ends the suspension, the Designated Manager must notify, in writing, each of the following that the suspension has ended:
 - (a) the registered patent attorney;
 - (b) the Board;
 - (c) the Disciplinary Tribunal.

Part 7—Restoring attorney's name to Register of Patent Attorneys

20.29 Restoring attorney's name to Register of Patent Attorneys

- (1) Subject to subregulation (2), if:
 - (a) a patent attorney's name was removed from the Register of Patent Attorneys under regulation 20.26; and
 - (b) the attorney requests the Designated Manager, in writing, to restore the attorney's name to the Register of Patent Attorneys; 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 of Patent Attorneys.
- (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 of Patent Attorneys.
- (3) The Designated Manager may, in restoring the name of a registered patent attorney to the Register of Patent Attorneys, 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 of Patent Attorneys.

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

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

- (a) the attorney's name was removed from the Register of Patent Attorneys 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 of Patent Attorneys, 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 Restoring attorney's name to Register of Patent Attorneys 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 of Patent Attorneys.
- (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 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 declaration, by another person, that the person is of good fame, integrity and character;
 - (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 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:

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.
- (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.

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.

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- (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.

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
 - (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 subparagraph (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

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- (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 subparagraph (3)(a)(i); and
 - (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.
- (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.

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- (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 the Register of Patent Attorneys 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 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 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.

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 that 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

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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.
- (2) If the registration of a registered patent attorney is suspended, the Designated Manager must note 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 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:

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- (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.

- (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*).

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

- (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 20.58

- (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.
- (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:
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Regulation 20.64

- (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*.
- (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.

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 years been enrolled, as a legal practitioner.

Chapter 20A—Incorporated Patent Attorney

Part 1—Introduction

20A.1 Application of Chapter 20A

This Chapter applies to:

- (a) an incorporated patent attorney; and
- (b) a company applying for registration as an incorporated patent attorney.

20A.2 Definitions

In this Chapter:

annual registration fee means the fee set out in item 109 or 110 of Schedule 7.

professional indemnity insurance means insurance for claims that may be made against the company in relation to its business, practices or acts as an incorporated patent attorney.

Part 2—Obtaining registration for first time

20A.3 Form of application

An application for registration as an incorporated patent attorney must:

- (a) be in writing, in a form approved by the Designated Manager; and
- (b) be accompanied by the following evidence and material:
 - (i) the name of each patent attorney director of the company;
 - (ii) evidence that the company is a registered company under the *Corporations Act 2001*;
 - (iii) evidence that the company has adequate and appropriate professional indemnity insurance; and
- (c) be accompanied by the fee set out in item 108 of Schedule 7.

20A.4 Certificate of registration

If the Designated Manager registers a company as an incorporated patent attorney, the Designated Manager must give the company a certificate of registration as soon as practicable.

Part 3—Maintaining registration

20A.5 Requirements for remaining on Register of Patent Attorneys

- (1) To remain on the Register of Patent Attorneys, a registered incorporated patent attorney must, for every year of registration, pay the annual registration fee.
- (2) The Designated Manager must, not later than 1 June in each year, give to each registered incorporated patent attorney notice of the fee that is payable.
- (3) The annual registration fee is payable on 1 July each year by a registered incorporated patent attorney:
 - (a) whose name is on the Register of Patent Attorneys on that day; and
 - (b) that has not asked the Designated Manager, under regulation 20A.6, to remove its name from the Register of Patent Attorneys.

Part 4—Removal from Register of Patent Attorneys

20A.6 Voluntary removal of name from Register of Patent Attorneys

If a patent attorney director of a registered incorporated patent attorney asks the Designated Manager, in writing, to remove the name of the registered incorporated patent attorney from the Register of Patent Attorneys, the Designated Manager must comply with the request.

20A.7 Failure to pay annual registration fee

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

- (a) remove the name of the incorporated patent attorney from the Register of Patent Attorneys; and
- (b) notify, in writing, the attorney of the removal.

20A.8 Failure to maintain professional indemnity insurance

- (1) If an incorporated patent attorney does not maintain adequate and appropriate professional indemnity insurance, the Designated Manager may remove the name of the attorney from the Register of Patent Attorneys.
- (2) If the Designated Manager removes the name of the incorporated patent attorney from the Register of Patent Attorneys, the Designated Manager must notify, in writing, the attorney of the removal.

Part 5—Discipline

Division 1—General

20A.9 Definitions

In this Part:

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

20A.10 Board may apply for cancellation or suspension of incorporated patent attorney's registration

- (1) The Board may apply to the Disciplinary Tribunal to cancel or suspend an incorporated patent attorney's registration if:
 - (a) a registered patent attorney who is, or was, an employee or officer of the incorporated patent attorney is found guilty of professional misconduct under subregulation 20.43(1); and
 - (b) the professional misconduct occurred when the registered patent attorney was an employee or officer of the incorporated patent attorney; and
 - (c) The Disciplinary Tribunal has cancelled or suspended the patent attorney's registration under subregulation 20.44(1).
- (2) Before applying to the Disciplinary Tribunal, the Board may request an incorporated patent attorney to provide the Board with information relating to the professional misconduct.
- (3) In deciding whether to apply to the Disciplinary Tribunal, the Board may consider the following:
 - (a) the professional misconduct engaged in by the registered patent attorney;
 - (b) the behaviour of the incorporated patent attorney's officers and employees;

- (c) whether officers and employees of the incorporated patent attorney have complied with the Code of Conduct;
 - (d) any information provided under subregulation (2).
- (4) An application by the Board to the Disciplinary Tribunal must:
- (a) be in writing; and
 - (b) set out the reasons why the Board considers the incorporated patent attorney's registration should be cancelled or suspended.
- (5) The Board must give the incorporated patent attorney, as soon as practicable after the application is made to the Disciplinary Tribunal, a copy of the application.

Division 2—Proceedings in Disciplinary Tribunal

20A.11 Procedure of Disciplinary Tribunal

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

20A.12 Notification of hearing

- (1) The Disciplinary Tribunal must, as soon as practicable after receiving an application under regulation 20A.10, fix a day, time and place to hear the application.
- (2) The Disciplinary Tribunal must, as soon as practicable, notify the incorporated patent attorney and the Board of that day, time and place.
- (3) The day of hearing must not be less than 21 days after the day the incorporated patent attorney is notified of the day, time and place for the hearing.

20A.13 Hearings to be public except in special circumstances

- (1) A hearing before the Disciplinary Tribunal must be in public.
- (2) However, 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 the Tribunal.
- (3) A person commits an offence if the person:
- (a) is given a direction under paragraph (2)(a) or (b); and
 - (b) does not comply with the direction.

Penalty: 5 penalty units.

20A.14 Representation before Disciplinary Tribunal

- (1) At the hearing before the Disciplinary Tribunal, the incorporated patent attorney must be represented by a patent attorney director of the incorporated patent attorney or a legal practitioner.
- (2) A party to proceedings before the Disciplinary Tribunal, or a representative of the party, may request the Tribunal to summon witnesses.

20A.15 Summoning of witnesses

- (1) For the purpose of the hearing before the Disciplinary Tribunal, the Tribunal may, by instrument in writing signed by the person constituting the Tribunal:
 - (a) summon a person to appear before the Tribunal to give evidence and to produce any documents or articles mentioned in the summons; or
 - (b) summon a patent attorney director of the incorporated patent 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.

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- (2) A patent attorney director who is summoned must appear in person.

20A.16 Offences by persons appearing before Disciplinary Tribunal

- (1) A person commits an offence if the person:
- (a) is summoned to appear before the Disciplinary Tribunal; and
 - (b) does not comply with the summons by:
 - (i) appearing as required by the summons; and
 - (ii) producing documents or articles as required by the summons; and
 - (iii) 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 Disciplinary Tribunal.

Note: A defendant bears an evidential burden in relation to the matters mentioned in subparagraph (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 patent attorney director 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 Disciplinary 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 the person 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 subparagraph (3)(a)(i); and
 - (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 patent attorney director who has been summoned to appear at a hearing before the Disciplinary Tribunal; and
 - (b) refuses:
 - (i) to be sworn or to make an affirmation; or
 - (ii) to answer a question relevant to the evidence that the person was summoned to give.

Penalty: 10 penalty units.

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

20A.17 Protection of person constituting Disciplinary Tribunal, witnesses etc.

- (1) A person:
 - (a) constituting the Disciplinary Tribunal; or

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- (b) appointed under subregulation 20.64(2);
has, in the exercise of the powers and the performance of the functions of the 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.
- (4) 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.

20A.18 Decision of Disciplinary Tribunal

- (1) After hearing an application for the cancellation or suspension of the incorporated patent attorney's registration, the Disciplinary Tribunal may:
- (a) cancel the attorney's registration as an incorporated patent attorney; or
 - (b) suspend the attorney's registration as an incorporated patent attorney.
- (2) The Disciplinary Tribunal may also impose conditions on the attorney's return to the Register of Patent Attorneys after the cancellation has been lifted or the period of suspension has elapsed.
- (3) In making a decision under this regulation, the Disciplinary Tribunal may consider the following:
- (a) the professional misconduct engaged in;

- (b) the behaviour of the incorporated patent attorney's officers and employees;
- (c) whether officers and employees of the incorporated patent attorney had complied with the Code of Conduct;
- (d) findings made about the conduct of the incorporated patent attorney in any other proceedings brought before the Disciplinary Tribunal;
- (e) findings made about the conduct of the incorporated patent attorney's employees and officers in any other proceedings brought before the Disciplinary Tribunal;
- (f) if the incorporated patent attorney failed, without reasonable excuse, to provide information requested by the Board under subregulation 20A.10(2)—the incorporated patent attorney's failure to provide requested information.

20A.19 Notification and publication of decisions of Disciplinary Tribunal

- (1) The Disciplinary Tribunal must, within 14 days after making a decision under regulation 20A.18:
 - (a) prepare a written statement that states:
 - (i) the decision of the Tribunal; and
 - (ii) the reasons for the decision; and
 - (iii) the findings on any material questions of fact; and
 - (iv) evidence or other material on which the findings of fact are based; and
 - (b) give a copy of the statement to:
 - (i) the incorporated patent attorney who is the subject of the decision; and
 - (ii) the Board; and
 - (iii) the Designated Manager; and
 - (c) publish, in the *Official Journal*, a written statement that sets out the decision of the Tribunal.
- (2) If the registration of an incorporated patent attorney is suspended, the Designated Manager must note the suspension and its duration in the Register of Patent Attorneys.

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- (3) If the registration of an incorporated patent attorney is cancelled, the Designated Manager must remove the name of the incorporated patent attorney from the Register of Patent Attorneys.

20A.20 Completion of outstanding business

- (1) If the Disciplinary Tribunal cancels the registration of an incorporated patent attorney, the Tribunal may appoint a registered patent attorney to complete the unfinished patents work of the former attorney.
- (2) If the Disciplinary Tribunal suspends the registration of an incorporated patent attorney, the Tribunal may appoint a registered patent attorney to carry on the former attorney's patents work for:
 - (a) the period of the suspension; or
 - (b) 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) A registered patent attorney appointed under subregulation (1) or (2) may only act as a registered patent attorney for a client of the former attorney if the client has given consent for the appointed attorney to act.

20A.21 Former attorney may be required to provide assistance

- (1) A registered patent attorney appointed under subregulation 20A.20(1) or (2) may, by written notice, request the former attorney to make available the following:
 - (a) information about the patents work that the appointed attorney may reasonably require;
 - (b) books, accounts or other documents about the patents work that the appointed attorney may reasonably require;
 - (c) money held by the former attorney:
 - (i) on behalf of a client; or
 - (ii) that has been paid by a client in relation to services not yet performed for the client.

- (2) A person commits an offence if the person:
- (a) is a former attorney; and
 - (b) is given a notice under subregulation (1); and
 - (c) fails to comply with the notice.

Penalty: 5 penalty units.

- (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 request 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*).

Part 6—Restoring attorney's name to Register of Patent Attorneys

20A.22 Restoring name to Register of Patent Attorneys

- (1) This regulation sets out circumstances in which the Designated Manager must restore to the Register of Patent Attorneys the name of an incorporated patent attorney that has been removed under:
 - (a) regulation 20A.6, 20A.7 or 20A.8; or
 - (b) subsection 201B(7) of the Act.
- (2) The Designated Manager must restore the name if:
 - (a) the attorney requests the Designated Manager, in the form approved by the Designated Manager, to restore the name; and
 - (b) the request includes:
 - (i) the name of each patent attorney director of the company; and
 - (ii) evidence that the company is a registered company under the *Corporations Act 2001*; and
 - (iii) evidence that the company has adequate and appropriate professional indemnity insurance; and
 - (c) the request is made:
 - (i) if the name was removed under regulation 20A.7—on or before 1 September of the year that the name was removed from the Register of Patent Attorneys, or within a further period that the Designated Manager allows; or
 - (ii) in any other case—within 3 years after the name was removed from the Register of Patent Attorneys; and
 - (d) the attorney pays:
 - (i) the annual registration fee for the year the reinstatement is made; and
 - (ii) the fee mentioned in item 111 of Schedule 7.

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 and being heard at an oral 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;
 - (ba) the fee for a hearing on the basis of written submissions only is payable when the written submissions are filed;

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- (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;
 - (e) if the Commissioner decides to conduct a search as part of the examination of a patent request and complete specification for a standard patent, the fee is payable when the Commissioner notifies the applicant that the fee is payable.
- (3) If an item specifies the person by whom a fee is payable, the fee is payable by that person.
 - (4) For paragraph 29A(5)(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.
 - (6) Paragraph 211(a) of Schedule 7, as in force on 1 July 2012, applies to:
 - (a) a patent:
 - (i) that has a date of patent of 1 July 2008 or later; and
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- (ii) the fourth anniversary of which falls on or after commencement; and
- (b) a patent application:
 - (i) filed on or after 1 July 2008; and
 - (ii) the fourth anniversary of which falls on or after commencement.
- (7) Paragraph 231(a) of Schedule 7, as in force on 1 July 2012, does not apply to a person in relation to a hearing held after the commencement of this subregulation if:
 - (a) the person requests the hearing, and pays the fee mentioned in item 230 of Schedule 7, before the commencement of this subregulation; or
 - (b) the person pays the fee mentioned in paragraph 231(a) of Schedule 7 for the hearing before the commencement of this subregulation; or
 - (c) the hearing relates to a representation or request by the person for which the person paid the fee mentioned in item 219, 220 or 229 of Schedule 7 before the commencement of this subregulation.
- (8) Paragraph 231(b) of Schedule 7, as in force on 1 July 2012, does not apply to a person in relation to a hearing held after the commencement of this subregulation if the person pays the fee mentioned in paragraph 231(b) of Schedule 7 for the hearing before the commencement of this subregulation.

22.2AA Approved means

- (1) The Commissioner may, by notice published by the Commissioner, specify one or more means for doing an action mentioned in Schedule 7 or for paying a fee.

Examples of actions:

- 1 Filing a request.
- 2 Filing an application.

- (2) The means may be an electronic means or any other means.

Note: The means become *approved means* when they are published.

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:
 - (a) a fee mentioned in item 201, 202, 203 or 206 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 or 205, 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:

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- (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:
- (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.

22.2EA Failure to pay: fee for grant of leave to amend specification (person invited to pay)

- (1) This regulation applies if:
- (a) a fee mentioned in item 222A of Schedule 7 relating to a grant of leave to amend a complete specification is not paid when it is payable; and
 - (b) within 1 month after the fee first becomes payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 2 months after the date on which notice of the grant of leave is published under subregulation 10.5(2); and
 - (c) the fee is not paid within that period of 2 months.
- (2) The request for leave to amend the complete specification is taken not to have been filed.

22.2F Consequence if Commissioner does not invite payment

- (1) Subregulation (2) applies if:
 - (a) a fee mentioned in regulation 22.2B, 22.2C or 22.2D 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
 - (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:
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- (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 and be heard at an oral hearing if the fee mentioned in paragraph 231(a) of Schedule 7 has not been paid for the person.
 - (5) A person is not entitled to a hearing on the basis of written submissions if the fee mentioned in item 231A of Schedule 7 has not been paid.

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
 - (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*.
- (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;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.
- (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.

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:
 - (a) 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; or
 - (b) another address in Australia to which it is practicable and reasonable for Australia Post, or a person acting on behalf of Australia Post, to deliver mail.
- (2) A person may file notice of a change of his or her address for service to another address that complies with paragraph (1)(a) or (b).
- (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

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notice of the service in the approved form together with a copy of the document served.

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 (if any);
- 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 (if any), 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 (if any), 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 table sets out prescribed persons.

Item	Person
1	The Director General of IP Australia
2	The Deputy Director General of IP Australia
3	Another person who: (a) is an SES employee of IP Australia; and (b) acts with the agreement of the Director General of IP Australia
4	Another person who: (a) is an SES employee of IP Australia; and (b) acts with the agreement of the Deputy Director General of IP Australia
5	Another person who: (a) is an SES employee of IP Australia; and (b) acts with the agreement of another SES employee of IP Australia

Note: *SES employee* is explained in section 34 of the *Public Service Act 1999*. That meaning is applied generally to Commonwealth legislation by section 2B of the *Acts Interpretation Act 1901*.

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

22.10AC Prescribed acts

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

- (a) lodging a return under section 76A of the Act;
- (b) an act done in relation to proceedings in a court or a tribunal;
- (c) an act done under Chapter 20.

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:

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- (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 AAT for a review of a decision of the Commissioner—the day when the application is withdrawn or finally dealt with or determined; or
 - (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, the following are prescribed:
- (a) an action mentioned in Chapter 5, other than an action or step taken under regulation 5.4, 5.5, 5.10 or 5.11;
 - (b) filing, during the term of a standard patent under 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 mentioned in Chapter 20.

22.12 Evidence

- (1) If evidence is given in writing to the Commissioner or to the Disciplinary Tribunal for the purposes of the Act or these regulations, the evidence must be in the form of a declaration.
- (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) A declaration required or permitted by the Act or these Regulations must be in the approved form.

Note: Declaration forms in the approved form are available on the IP Australia website at www.ipaustralia.gov.au.

- (2) A declaration in the form of a statutory declaration, required or permitted to be given to a person mentioned in subregulation (3), may be given to the person in an electronic form by a means of electronic communication approved by the Commissioner.

Note: A declaration that is not in the form of statutory declaration may also be given in an electronic form by means of an electronic communication: see section 11 of the *Electronic Transactions Act 1999*.

- (3) For subregulation (2), the following persons may be given declarations, including statutory declarations, in electronic form by electronic means:
 - (a) the Commissioner;
 - (b) the Designated Manager;
 - (c) the Disciplinary Tribunal;
 - (d) the Professional Standards Board.

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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 in English and English translations

- (1) An abstract that is filed must be in English.
- (2) A document required to be in an approved form that is filed must be in English.
- (3) If any other document is filed:
 - (a) the document must be in English; or
 - (b) the document must be filed with:
 - (i) a translation of the document into English; and
 - (ii) a related certificate of verification.
- (4) However, this regulation does not apply to documents relating to a basic application that are prescribed under subsection 43AA(1) of the Act.

Note: For a list of these documents, see subregulation 3.14B(1).

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 regulation 22.15 or 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 notify the person from whom it was received, including in the notification 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.
- (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 2 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:

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.

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) The Commissioner must give a copy of the application to:
- (a) a person whose application was restored under section 150 of the Act; or
 - (b) a patent applicant or patentee of the application or patent for which an extension of time was granted under section 223 of the Act; or
 - (c) the patent applicant or patentee of the application or patent to which subsection 41(4) of the Act applies;
- and to any other person the Commissioner believes to have an interest in the application.
- (4) A person mentioned in subregulation (3) may oppose the grant of the licence to which the application relates.
- (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 of discretionary powers by Commissioner

- (1) The Commissioner must give a person an opportunity to be heard before exercising a discretionary power under the Act or these Regulations adversely to the person.

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Note: See section 216 of the Act for a similar provision.

- (2) The Commissioner must give the person an opportunity to be heard by:
 - (a) asking the person for written submissions; or
 - (b) notifying the person that, on request to the Commissioner, the person may be heard by way of an oral hearing on a date, and at a time and place, determined by the Commissioner; or
 - (c) notifying the person of the date, time and place of an oral hearing.
- (3) The Commissioner may exercise the discretionary power if the person:
 - (a) notifies the Commissioner that the person does not want to be heard; or
 - (b) does not file written submissions if requested under subregulation 22.23(1); or
 - (c) does not attend an oral hearing if notified under subregulation 22.23(2).
- (4) If the Commissioner exercises discretionary power in any of the circumstances mentioned in subregulation (3), the Commissioner must notify the person of the Commissioner's decision.

22.23 Written submissions and oral hearings

Written submissions

- (1) If the Commissioner decides that a person may be heard by way of written submissions, the Commissioner must:
 - (a) notify the person of the period in which the submissions must be filed (being at least 10 business days); and
 - (b) determine the matter after considering the written submissions; and
 - (c) notify the person of the Commissioner's decision in relation to the exercise of the discretionary power.

Oral hearings

- (2) If the Commissioner decides that a person may be heard by way of an oral hearing, the Commissioner must give notice of the date, time and place of the hearing, to the person, at least 10 business days before the day the hearing is to begin.
- (3) The Commissioner may adjourn an oral hearing from time to time or from place to place by notifying the person.
- (4) The Commissioner may hold an oral hearing in which:
 - (a) a person appears in person; or
 - (b) a person participates by telephone or other means of telecommunications that the Commissioner reasonably allows.
- (5) In addition to the Commissioner's other powers, the Commissioner may direct a person to provide a written summary of submissions.
- (6) The Commissioner must notify a person who appears at the hearing of the Commissioner's decision in relation to the exercise of the discretionary power.

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.

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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
- (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 AAT 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');
 - (iia) 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');
- (b) the Board under the following provisions:
 - (i) regulation 20.5 ('evidence of academic qualifications');

- (ii) regulation 20.7 ('evidence of knowledge requirements');
or
- (c) the Designated Manager under the following provisions:
 - (i) regulation 20.28 ('failure to comply with continuing professional education requirements');
 - (ii) regulation 20.28B (suspension of registration—serious offence);
 - (iii) subregulation 20.29(3) (imposing a condition when restoring attorney's name to Register of Patent Attorneys);
 - (iv) regulation 20.31 ('returning to Register of Patent Attorneys in other circumstances');
 - (v) regulation 20A.8 (failing to maintain professional indemnity insurance); or
- (d) the Disciplinary AAT under the following provisions:
 - (i) regulation 20.43 ('decision of Disciplinary AAT');
 - (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');
 - (vi) regulation 20A.18 (decision of Disciplinary Tribunal).
- (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 AAT 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 AAT reviews a decision of the Commissioner under subsection 224(1) of the Act and the decision is not affirmed, the

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Commissioner must publish a notice of the decision of the AAT in the *Official Journal*.

22.27 Documents not to infringe copyright—prescribed documents

- (1) For paragraph 226(2)(c) of the Act, the following documents are prescribed:
 - (a) a document open to public inspection under Chapter 4 of the Act;
 - (b) a document open to public inspection under these Regulations.
- (2) However, a journal, book or catalogue is not prescribed if:
 - (a) it is provided for prosecution, examination or proceedings in relation to a patent application, or subsequent patent; and
 - (b) a right subsisting in the journal, book or catalogue under the *Copyright Act 1968* is held by a party other than the patent applicant, patentee or another person who has filed a document for the application or patent.

Chapter 23—Transitional and savings provisions

Part 1—General

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.

23.4 Certain opposition: practice and procedure

- (1) If, before the commencing day:
-

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- (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
 - (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.

23.9 Certain continuation and renewal fees

- (1) If, before the commencing day:
-

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- (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:
- (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
- (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.

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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.
- (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.

23.25 Fees

- (1) In this regulation:

continuation fee means a continuation fee for the purposes of section 47D of the 1952 Act.

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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.
- (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 relation to the petty patent application, under section 50 of the old Act; and

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- (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*.

- (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*.

Chapter 23 Transitional and savings provisions
Part 1 General

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

Part 2—Amendments made by particular instruments

23.36 Amendments made by *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

- (1) The amendments of these Regulations made by the items of Schedule 1 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

Transitional provisions		
Item	Column 1 The amendments made by:	Column 2 apply in relation to:
1	item 1	the matters referred to in subitem 55(1) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
2	item 2	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
3	item 3	the matters referred to in subitem 55(1) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
4	item 5	the matters referred to in subitem 55(4) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
5	items 6, 7 and 8, in their application to the re-examination of a standard patent	the matters referred to in subitem 55(5) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
6	items 6, 7 and 8, in their application to the re-examination of an innovation patent	the matters referred to in subitem 55(7) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
7	item 9	the matters referred to in subitem 55(9) of

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Part 2 Amendments made by particular instruments

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Transitional provisions

Item	Column 1 The amendments made by:	Column 2 apply in relation to:
		Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
8	item 10, new subregulation 10.3(1)	a provisional specification filed on or after 15 April 2013
9	item 10, new subregulation 10.3(2)	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i> , but treating the first reference to a complete specification in that subitem as a reference to an abstract
10	item 11	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
11	item 12	the matters referred to in subitem 55(4) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
12	item 13	the matters referred to in subitem 55(8) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
13	items 15, 16, 17, 18 and 20	the matters referred to in subitem 55(3) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

(2) The amendments of these Regulations made by the items of Part 1 of Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

Transitional provisions

Item	Column 1 The amendments made by:	Column 2 apply in relation to:
1	item 2 (new regulation 5.3)	an opposition proceeding commenced before 15 April 2013

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
2	item 2 (new subregulations 5.9(1) to (5)) and item 9 (new item 218 of Schedule 7)	<p>an opposition proceeding commenced before 15 April 2013 in which an extension of time is requested for a period that commences on or after 15 April 2013</p> <p>However:</p> <p>(a) a reference in subregulation 5.9(1) to regulation 5.8 is taken to be a reference to regulation 5.8 as in force immediately before 15 April 2013; and</p> <p>(b) paragraph 5.10(1)(b) and subregulation 5.10(2), as in force immediately before 15 April 2013, are taken not to apply</p>
3	item 2 (new regulation 5.20)	<p>an opposition proceeding commenced before 15 April 2013 in which the Commissioner has not set a hearing date, or issued a notice of hearing to the parties, before 15 April 2013</p> <p>However:</p> <p>(a) a reference in that regulation to regulation 5.26 is taken to be a reference to regulation 5.15 as in force immediately before 15 April 2013; and</p> <p>(b) a reference in that regulation to Part 5.4 is taken to be a reference to regulation 5.5 as in force immediately before 15 April 2013; and</p> <p>(c) a reference in that regulation to regulation 5.19 is taken to be a reference to regulation 5.6 as in force immediately before 15 April 2013; and</p> <p>(d) regulation 5.12, as in force immediately before 15 April 2013, is taken not to apply</p>
4	items 2, 7 and 9	<p>an opposition proceeding commenced by the filing of a notice of opposition on or after 15 April 2013</p> <p>However, if:</p>

Chapter 23 Transitional and savings provisions
Part 2 Amendments made by particular instruments

Regulation 23.36

Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		(a) an amendment was advertised under regulation 10.5 before 15 April 2013; and
		(b) a notice of opposition is filed for subsection 104(4) of the Act on or after 15 April 2013;
		the reference in subregulation 5.10(1) to 2 months is taken to be a reference to 3 months
		Also, if:
		(a) an opposition proceeding was commenced by the filing of a notice of opposition before 15 April 2013; and
		(b) a document or evidence was not served in relation to the opposition proceeding before 15 April 2013; and
		(c) the document or evidence is required to be served on or after 15 April 2013;
		then:
		(d) a requirement in Chapter 5, or regulation 22.21, as in force immediately before 15 April 2013, for a party to serve a document or evidence on a person is taken to be a requirement to file the document or evidence; and
		(e) a reference to a document or evidence having been served is taken to be a reference to the document or evidence having been filed; and
		(f) the Commissioner must give a copy of the document or evidence to the person; and
		(g) if:
		(i) under Chapter 5, as in force immediately before 15 April 2013, a period for the person to do an action was calculated from the date that a

Transitional provisions

Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		party served the document or evidence; and (ii) the Commissioner does not give the document or evidence to the person on the filing date; the Commissioner must extend the period for the person to do the action by a number of days equal to the number of days between when the document or evidence was filed and when the Commissioner gave the document or evidence to the person
5	item 3 (new regulation 6A.1)	the matters referred to in subitem 32(3) of Schedule 3 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
6	item 3 (new regulation 6A.2)	the matters referred to in subitem 32(4) of Schedule 3 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

- (3) The amendment of these Regulations made by item 14 of Schedule 4 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* applies in relation to a charge that:
- (a) is laid against a registered patent attorney on or after 15 April 2013; and
 - (b) alleges the commission of a serious offence.
- (4) The amendments of these Regulations made by the items of Part 2 of Schedule 6 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

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Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
1	item 5	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
2	item 6	the matters referred to in subitem 133(1) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
3	item 7	the matters referred to in subitem 133(4) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
4	item 8	a complete application for a standard patent in which a request for examination is made on or after 15 April 2013
5	items 9 to 12	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
6	item 13	a PCT application that enters the national phase on or after 15 April 2013
7	items 14 to 18	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
8	item 20	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws</i>

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		<i>Amendment (Raising the Bar) Act 2012</i>
9	item 21	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
10	item 22	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
11	item 23	the matters referred to in subitem 55(9) of Schedule 1 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
12	item 24, regulation 3.14C	the matters referred to in subitem 133(8) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
13	item 25 and 26	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
14	item 27	a direction issued under subsection 44(2) of the Act, on or after 15 April 2013
15	item 28	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

Chapter 23 Transitional and savings provisions
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Regulation 23.36

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
16	item 30	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
17	item 31	a PCT application that enters the national phase on or after 15 April 2013
18	items 36 and 37	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
19	item 38	a document that: (a) is related to a patent application; and (b) is not a specification; filed before, on or after 15 April 2013
20	item 39	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
21	items 40 and 41	the matters referred to in subitem 133(9) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
22	item 42	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
23	item 43	a PCT application filed with a receiving Office on or after 15 April 2013
24	item 44	the matters referred to in subitem 133(9) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
25	item 45	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
26	item 47, paragraph 9A.4(f)	an application in relation to which a request for examination is made on or after 15 April 2013
27	item 47, paragraph 9A.4(g)	the matters referred to in subitem 133(12) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
28	items 48 to 50	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
29	item 51	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
30	item 53	an application or patent in relation to which leave to amend the patent request, complete specification or other filed document is granted on or

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Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		after 15 April 2013
31	item 54	the matters referred to in subitem 133(3) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i> unless other arrangements are made in this regulation
32	item 54	a request to rectify the Register to which the following apply: (a) the request was published before 15 April 2013; (b) the period to file an opposition under subregulation 5.3(5A) had not expired before 15 April 2013; (c) no notice of opposition was filed before 15 April 2013; as if it were a request to rectify the Register made on 15 April under regulation 10.7
33	item 55	all of the following: (a) aircraft, land vehicles and vessels that were foreign aircraft, foreign land vehicles or foreign vessels, within the meaning of the Act, immediately before 15 April 2013; (b) aircraft and vessels that are registered on or after 15 April 2013; (c) land vehicles the ownership of which is acquired on or after 15 April 2013
34	item 56	the matters referred to in subitem 133(9) of Schedule 6 to the

Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		<i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
35	item 57	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
36	item 58	the matters referred to in subitem 133(15) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
37	item 61	the matters referred to in subitem 133(6) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
38	item 62, new paragraph 13.4(1)(g)	an application in relation to which a request for examination is made on or after 15 April 2013
39	item 62, new paragraph 13.4(1)(ga)	the matters referred to in subitem 133(11) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
40	item 64, reference to new paragraph 13.4(1)(g)	an application in relation to which a request for examination is made on or after 15 April 2013
41	item 64, reference to new paragraph 13.4(1)(ga)	the matters referred to in subitem 133(11) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
42	items 65 and 66	the matters referred to in

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Transitional provisions		
Item	Column 1	Column 2
	The amendments made by:	apply in relation to:
		subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
43	items 67 and 68	an application in relation to which a request for examination is made on or after 15 April 2013
44	item 77, other than the insertion of new subregulation 22.22(1)	a hearing for which the Commissioner has issued a hearing notice, or an invitation to be heard, on or after 15 April 2013
45	item 78	an act referred to in subsection 226(1) of the Act done in relation to a prescribed document on or after 15 April 2013
46	item 80	a PCT application that enters the national phase on or after 15 April 2013
47	item 81	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
48	item 82	the matters referred to in subitem 133(3) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
49	item 83	the matters referred to in subitem 133(2) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
50	items 84 and 85	the matters referred to in subitem 133(9) of Schedule 6 to the

Transitional provisions

Item	Column 1 The amendments made by:	Column 2 apply in relation to:
		<i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
51	item 86	an application in relation to which a request for examination is made on or after 15 April 2013

(5) The amendments of these Regulations made by the items of Part 2 of Schedule 6 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* do not apply as set out in the following table.

Transitional provisions

Item	Column 1 The amendments made by:	Column 2 do not apply:
1	item 29	in relation to the matters referred to in subitem 134(1) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
2	items 32 to 35	in relation to the matters referred to in subitem 134(1) of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
3	item 52	in relation to the matters referred to in item 134 of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>
4	item 54	to the extent that they would prevent the correction of a patent granted before 15 April 2013 in accordance with regulation 10.7 as in force immediately before 15 April 2013
5	item 60	in relation to the matters referred to in item 134 of Schedule 6 to the <i>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</i>

Regulation 23.36

(6) Regulation 8.3, as continued in force in accordance with this regulation, is amended by omitting subregulation 8.3(2) and inserting:

(2) At the end of section 141:

Add:

(3) Despite subsection (2), a PCT application is also 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.

Note: This amendment applies in relation to a PCT application that was made before 15 April 2013 and for which a notice of withdrawal was filed on or after 15 April 2013.



Patents Regulations 1991

Statutory Rules No. 71, 1991 as amended

made under the

Patents Act 1990

Compilation start date: 15 April 2013

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Volume 1: Chapters 1 to 23

Volume 2: Schedules and Endnotes

Each volume has its own contents

Prepared by the Office of Parliamentary Counsel, Canberra

About this compilation

The compiled instrument

This is a compilation of the *Patents Regulations 1991* as amended and in force on 15 April 2013. It includes any amendment affecting the compiled instrument to that date.

This compilation was prepared on 15 April 2013.

The notes at the end of this compilation (the *endnotes*) include information about amending Acts and instruments and the amendment history of each amended provision.

Uncommenced provisions and amendments

If a provision of the compiled instrument has not commenced or is affected by an uncommenced amendment, the text of the uncommenced provision or amendment is set out only in the endnotes.

Application provisions for amendments

If the operation of an amendment is affected by an application provision, this provision is set out in the endnotes.

Modifications

If a provision of the compiled instrument is affected by a textual modification that is in force, the text of the modifying provision is set out in the endnotes.

Provision ceasing to have effect

If a provision of the compiled instrument has expired or otherwise ceased to have effect, or is to expire or otherwise cease to have effect, in accordance with a provision of the instrument, details of the provision are set out in the endnotes.

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Schedule 3—Formal requirements for documents to be filed

(paragraph 3.2A(1)(c), paragraph 3.2A(2)(c), subparagraph 3.2B(1)(a)(ii), paragraph 10.2(1)(a) and subregulation 22.16(2))

1 Terminology and signs

In a document:

- (a) units of description must be expressed in terms of the metric system or, if first expressed in other terms, must be expressed also in terms of that system; and
- (b) temperatures must be expressed in degrees Celsius or, if first expressed in another manner, must be expressed also in degrees Celsius; and
- (c) to indicate units of measurement, the rules of international practice must be observed; and
- (d) in chemical formulas, the symbols, atomic weights and molecular formulas in general use must be employed; and
- (e) other terms, signs and symbols that are generally accepted in the art to which the document principally relates must be employed; and
- (f) if the document is expressed in English—the beginning of any decimal fraction must be marked by a period; and
- (g) units, signs, symbols and other terms must be used consistently.

1A Title of specification

A specification must commence with a short and precise title.

2 Fitness for reproduction

Each sheet comprising a document or part of a document:

- (a) must be presented in a manner that allows any number of copies of the sheet to be reproduced directly by means of photography, an electrostatic or photo-offset process and microfilming; and
- (b) must not be folded, creased or cracked; and

- (c) subject to subclause 8(4) ('drawings, formulas and tables in textual matter') and subclause 11(14) ('special requirements for drawings'), must be presented in a vertical format; and
- (d) must be durable, flexible, smooth, strong, white and have a matt finish; and
- (e) must be international sheet size A4; and
- (f) must be printed on only one side of the sheet.

3 Separate sheets

- (1) The patent request, the description of the invention, the claim or claims, any drawing, and an abstract, must each commence on a separate sheet.
- (2) The sheets comprising a document must be connected so that they may be readily:
 - (a) turned to be read; and
 - (b) separated for the purposes of reproduction and then rejoined.

4 Margins

- (1) Subject to subclause (2), each sheet of a specification, or an abstract, must have a margin that is not less than:
 - (a) at the top—2 cm; and
 - (b) on the left—2.5 cm; and
 - (c) on the right—2 cm; and
 - (d) at the bottom—2 cm.
- (2) A sheet of drawings:
 - (a) must have a margin that is not less than:
 - (i) at the top—2.5 cm; and
 - (ii) on the left—2.5 cm; and
 - (iii) on the right—1.5 cm; and
 - (iv) at the bottom—1 cm; and
 - (b) must show the drawings entirely within that margin and within an area of the sheet measuring 26.2 cm × 17.0 cm (the *useable surface*); and
 - (c) must not contain a frame surrounding the drawings or the useable surface.

5 Numeration

- (1) The parts of a patent application must be presented in the following order:
 - (a) patent request;
 - (b) description of the invention, other than any sequence listing part of the description;
 - (c) claim or claims;
 - (d) abstract;
 - (e) drawing or drawings;
 - (f) sequence listing part of the description, if applicable.
- (2) Subject to subclause (3), if a specification is numbered in accordance with subclause 6(2), the sheets of the specification must be numbered consecutively in arabic numerals beginning with '1' that are placed at the top, and in the middle, of the sheet, but not within the margins of the sheet.
- (3) The sheets of a specification that contain drawings must be numbered by means of sets of 2 arabic numerals separated by an oblique stroke, the first numeral in each set being the consecutive number of each sheet, beginning with the arabic number '1', and the second being the total number of the sheets containing the drawings.
- (4) If there is more than 1 claim referred to in a complete specification, the claims must be numbered consecutively in arabic numerals beginning with '1'.
- (5) In a statement of proposed amendments:
 - (a) the proposed amendments must be numbered consecutively; and
 - (b) if the statement is a subsequent one, the numbering must be consecutive with the numbers in the previous statement.

7 Writing of textual matter

- (1) Subject to subclause (2), except with the consent of the Commissioner, a patent request, specification and any abstract relating to a patent application must be typewritten or otherwise machine printed.

- (2) If necessary, symbols relating to graphic matter, or chemical or mathematical formulas, may be handwritten or drawn, as the case may be.
- (3) The lines of text in a typewritten document must be 1¹/₂ spaced.
- (4) The text in a document must be presented in letters the capitals of which are not less than 0.21 cm high, in a dark colour and be indelible.

8 Drawings, formulas and tables in textual matter

- (1) A patent request must not include a drawing.
- (2) The description of an invention or an abstract:
 - (a) must not include a drawing; and
 - (b) may include chemical or mathematical formulas or tables.
- (3) A claim:
 - (a) must not include a drawing; and
 - (b) may include chemical or mathematical formulas; and
 - (c) if, in the reasonable opinion of the Commissioner, the subject matter of the claim makes the use of a table desirable—may include tables.
- (4) A table or a chemical or mathematical formula may be presented in a horizontal format if it cannot be presented in a vertical format in a satisfactory manner.
- (5) If a table or a chemical or mathematical formula is presented in a horizontal format, the top of the table or formula must be placed on the left side of the paper.

9 Words in drawings

A drawing must not include text, other than a word or words indispensable to the understanding of the drawing.

10 Alterations

- (1) Subject to subclause (2), a document must be free from erasures, alterations, overwritings and interlineations.

- (2) If, in the reasonable opinion of the Commissioner, failure to comply with subclause (1) would not:
 - (a) compromise the authenticity; or
 - (b) jeopardise the likelihood of clear reproduction;of a document, the Commissioner may excuse it from compliance with subclause (1).

11 Special requirements for drawings

- (1) A drawing must be executed in durable, black, dense, dark, uniformly thick and well-defined, lines and strokes without colouring.
- (2) A cross-section must be indicated by oblique hatching that does not impede the clear reading of reference letters, numbers or signs and leading lines.
- (3) The scale of a drawing and the distinctness of its execution must enable all the details to be distinguished without difficulty on a photographic reproduction of the drawing with a two-thirds linear reduction in size.
- (4) If the scale of a drawing is given on the drawing, it must be represented graphically.
- (5) A letter, number or reference line that is shown on a drawing must be presented simply and be clear.
- (6) Brackets, braces, circles or inverted commas must not be used in association with letters or numbers.
- (7) A line in a drawing must ordinarily be drawn with the aid of drafting instruments.
- (8) A sheet of drawings may include more than 1 drawing.
- (9) Each element of a drawing must be shown in proper proportion to each other element of the drawing, other than where the use of a different proportion is indispensable for the clarity of the drawing.
- (10) The height of a letter or a number in a drawing must not be less than 0.32 cm.

- (11) For the lettering of a drawing, the Latin or, if customary, the Greek alphabet must be used.
- (12) If drawings on 2 or more sheets of drawings form in effect a single drawing, the drawings must be so arranged that the single drawing can be assembled without concealing any part of the other drawings.
- (13) Subject to subclause (14), if there is more than 1 drawing on a sheet of drawings, the drawings must be presented on the sheet of drawings in a vertical format and separate from each other.
- (14) If the drawings on a sheet of drawings cannot be presented in a vertical format, they must be presented in a horizontal format with the tops of the drawings on the left of the sheet of drawings.
- (15) The drawings must be numbered consecutively in arabic numerals beginning with '1'.
- (16) A reference sign that is not mentioned in the description of the invention must not be referred to in a drawing.
- (17) A reference sign that is not mentioned in a drawing must not be referred to in the description.
- (18) A feature of a drawing that is denoted by a reference sign must be so denoted consistently.

12 Amino acid sequences and nucleotide sequences

An amino acid sequence or a nucleotide sequence that is part of a specification may be filed in a format approved by the Commissioner on a compact disk or by other electronic means approved by the Commissioner.

13 Electronic documents

A document that is filed in electronic form must be in the approved form.

14 Scandalous matter

A complete application must not contain or consist of scandalous matter.

Schedule 5—Knowledge requirements

(regulation 20.8)

Part 1—Overall requirement

1. A course of study must provide for a student to have an appropriate level of:
 - (a) knowledge and practical application so that the student can give advice about applicable categories of protection for particular activities; and
 - (b) appreciation of the advantages of each form of protection for a client; and
 - (c) understanding of how to get and maintain appropriate protection for a client; and
 - (d) understanding of the required standard of professional conduct.

Part 2—Legal process and overview of intellectual property

2. A course of study must provide for a student to have an appropriate level of understanding of the Australian legal system and how intellectual property rights may be protected, including by reference to:
 - (a) the Australian legal system; and
 - (b) intellectual property rights.

Part 3—Professional conduct

3. A course of study must provide for a student to have an appropriate level of understanding of the rights, privileges and responsibilities of a patent attorney or trade marks attorney.

Part 4—Intellectual property law

4. A course of study must provide for a student to have an appropriate level of understanding of the principles of trade marks, patents, designs and copyright.

Part 5—Intellectual property systems

5. A course of study must provide for a student to have an appropriate level of understanding of the system of protecting and exploiting trade marks, patents and designs, both in Australia and other countries. This includes:
 - (a) the ability to draft patent specifications; and
 - (b) an understanding of patent specifications; and
 - (c) the ability to advise on the interpretation, validity and infringement of patent specifications.

Schedule 7—Fees

(regulations 22.2, 22.2AA, 22.3 and 22.4)

Part 1—Patent Attorneys

Item	Matter	Fee (\$)
101	Applying for admission to sit for an examination conducted by the Board	400
102	Applying for grant of a supplementary examination conducted by the Board	200
103	Applying for a report of reasons for failure of an examination conducted by the Board	200
104	Applying for registration as a patent attorney	300
105	Annual registration of a patent attorney	350
106	Annual registration fee payable for combined registration as a patent attorney and trade marks attorney	550
107	Applying under regulation 20.29, 20.30 or 20.31	250
108	Applying for registration as an incorporated patent attorney	300
109	Annual registration of an incorporated patent attorney	350
110	Annual registration fee payable for combined registration as an incorporated patent attorney and incorporated trade marks attorney	550
111	Applying to be restored to the Register of Patent Attorneys, as authorised by regulation 20A.22	250

Schedule 7 Fees
Part 2 General fees

Part 2—General fees

Item	Matter	Fee
201	Filing a request for a patent accompanied by a provisional specification:	
	(a) by approved means;	\$110
	(b) by another means	\$210
202	Filing a request for an innovation patent accompanied by a complete specification:	
	(a) by approved means;	\$180
	(b) by another means	\$280
203	Filing a request for a standard patent accompanied by a complete specification:	
	(a) by approved means;	\$370
	(b) by another means	\$470
204	Filing a request for an examination, under section 45 of the Act, of a standard patent request and complete specification for a PCT application if the Patent Office has established an international preliminary examination report under Article 35 of the PCT, other than a report under Rule 44 ^{bis} .1 of the PCT, in respect of the application	\$300
205	Filing a request for an examination, under section 45 of the Act, of a standard patent request and complete specification if item 204 does not apply	\$490
206	Search by the Commissioner in relation to a patent request and complete specification for a standard patent as part of an examination, if the complete application was made on or after 15 April 2013	\$1,400
207	Filing a request under paragraph 101A(b) of the Act, by the patentee of an innovation patent, for examination of the complete specification relating to the innovation patent	\$500
208	Filing a request under paragraph 101A(b) of the Act, by a person other than the patentee of an innovation patent, for examination of the complete specification relating to the innovation patent:	

Item	Matter	Fee
	(a) payable by the person making the request; and	\$250
	(b) payable by the patentee	\$250
209	Filing a request under subsection 44(3) of the Act requiring the Commissioner to direct an applicant to request examination	\$100
210	Filing a request under subsection 97(2) or paragraph 101G(1)(b) of the Act for re-examination of a complete specification	\$800
211	Continuation fee under paragraph 142(2)(d) of the Act, or renewal fee under paragraph 143(a) of the Act, for:	
	(a) the fourth anniversary:	
	(i) fee paid by approved means;	\$300
	(ii) fee paid by another means;	\$350
	(b) the fifth anniversary:	
	(i) fee paid by approved means;	\$300
	(ii) fee paid by another means;	\$350
	(c) the sixth anniversary:	
	(i) fee paid by approved means;	\$300
	(ii) fee paid by another means;	\$350
	(d) the seventh anniversary:	
	(i) fee paid by approved means;	\$300
	(ii) fee paid by another means;	\$350
	(e) the eighth anniversary:	
	(i) fee paid by approved means;	\$300
	(ii) fee paid by another means;	\$350
	(f) the ninth anniversary:	
	(i) fee paid by approved means;	\$300
	(ii) fee paid by another means;	\$350
	(g) the tenth anniversary:	
	(i) fee paid by approved means;	\$500
	(ii) fee paid by another means;	\$550
	(h) the eleventh anniversary:	
	(i) fee paid by approved means;	\$500
	(ii) fee paid by another means;	\$550
	(i) the twelfth anniversary:	
	(i) fee paid by approved means;	\$500

Schedule 7 Fees
Part 2 General fees

Item	Matter	Fee
	(ii) fee paid by another means;	\$550
(j)	the thirteenth anniversary:	
	(i) fee paid by approved means;	\$500
	(ii) fee paid by another means;	\$550
(k)	the fourteenth anniversary:	
	(i) fee paid by approved means;	\$500
	(ii) fee paid by another means;	\$550
(l)	the fifteenth anniversary:	
	(i) fee paid by approved means;	\$1 120
	(ii) fee paid by another means;	\$1 170
(m)	the sixteenth anniversary:	
	(i) fee paid by approved means;	\$1 120
	(ii) fee paid by another means;	\$1 170
(n)	the seventeenth anniversary:	
	(i) fee paid by approved means;	\$1 120
	(ii) fee paid by another means;	\$1 170
(o)	the eighteenth anniversary:	
	(i) fee paid by approved means;	\$1 120
	(ii) fee paid by another means;	\$1 170
(p)	the nineteenth anniversary:	
	(i) fee paid by approved means;	\$1 120
	(ii) fee paid by another means;	\$1 170
(q)	if an extension of the term of a standard patent is granted under section 76 of the Act:	
	(i) the twentieth anniversary, fee paid using approved means;	\$2 300
	(ii) the twentieth anniversary, fee paid by another means;	\$2 350
	(iii) each subsequent anniversary during the period of extension, fee paid by approved means;	\$2 300
	(iv) each subsequent anniversary during the period of extension, fee paid by another means	\$2 350
	and, in addition, if the fee is not paid on or before the anniversary but is paid within 6 months after the anniversary	\$100 for each month, or part of a month, in the period between the anniversary and the day when the fee is paid

Item	Matter	Fee
212	Renewal fee under paragraph 143A(d) of the Act for:	
	(a) the second anniversary:	
	(i) fee paid by approved means;	\$110
	(ii) fee paid by another means;	\$160
	(b) the third anniversary:	
	(i) fee paid by approved means;	\$110
	(ii) fee paid by another means;	\$160
	(c) the fourth anniversary:	
	(i) fee paid by approved means;	\$110
	(ii) fee paid by another means;	\$160
	(d) the fifth anniversary:	
	(i) fee paid by approved means;	\$220
	(ii) fee paid by another means;	\$270
	(e) the sixth anniversary:	
	(i) fee paid by approved means;	\$220
	(ii) fee paid by another means;	\$270
	(f) the seventh anniversary:	
	(i) fee paid by approved means;	\$220
	(ii) fee paid by another means	\$270
	and, in addition, if the fee is not paid on or before the anniversary but is paid within 6 months after the anniversary	\$100 for each month, or part of a month, in the period between the anniversary and the day when the fee is paid
213	Acceptance of a patent request and complete specification under section 49 of the Act:	
	(a) for acceptance; and	\$250
	(b) if more than 20 claims are contained in the specification at acceptance	\$110 for each claim in excess of 20
214	Filing an application or request under section 17, 32 or 36, or subsection 191A(2) of the Act	\$600
214A	National phase entry of a PCT application under paragraph 29A(5)(b) of the Act:	
	(a) fee paid by approved means;	\$370
	(b) fee paid by another means	\$470

Schedule 7 Fees
Part 2 General fees

Item	Matter	Fee
215	Filing a request under subregulation 3.25(1) for the certification referred to in Rule 11.3(a) of the Budapest Treaty	\$550
216	Filing a notice of opposition under regulation 5.4, 5.6 or 5.10	\$600
217	Filing a request under subregulation 5.17(1) for dismissal of opposition	\$600
218	Filing an application under subregulation 5.9(1) for an extension of time	\$500 for each month or part of a month for which the extension is sought
219	Making a representation to the Commissioner, under subregulation 5.14(2) or 5.15(3) or paragraph 5.16(2)(b), objecting to a proposed amendment	\$600
220	Making a representation to the Commissioner under subregulation 5.22(2) objecting to a proposed direction	\$600
222	Filing a request for leave to amend: (a) a complete specification relating to an application for a standard patent, before a request for examination is filed or after the complete specification is accepted; or (b) a complete specification relating to a standard patent	\$250
222A	Grant of leave to amend a complete specification relating to a standard patent, or relating to an application for a standard patent, after the complete specification is accepted, if: (a) more than 20 claims are contained in the complete specification as proposed to be amended; and (b) the effect of the proposed amendment would be to increase the number of claims in the complete specification	\$110 for each additional claim that arises as described in paragraph (b)
223	Filing a request for leave to amend a patent request for an innovation patent to make it a patent request for a standard patent	\$190

Item	Matter	Fee
224	Filing a request for leave to amend a complete specification relating to an innovation patent: (a) after the patent is granted but before a request for examination is filed; or (b) after the patent is certified	\$250
226	Filing an application for an extension of time under subsection 223(2) of the Act on a ground specified in paragraph 223(2)(a) of the Act	\$100 for each month or part of a month for which the extension is sought
227	Filing an application under subsection 223(2) of the Act for an extension of time on the ground specified in paragraph 223(2)(b) of the Act	\$100
228	Filing an application for an extension of time under subsection 223(2A) of the Act	\$100 for each month or part of a month for which the extension is sought
229	Filing a request under regulation 22.22 for the exercise of discretionary power	\$600
230	Filing a request for a hearing	\$600
231	Appearing and being heard at an oral hearing in person or by other means: (a) for the first day (b) if the hearing runs for more than a day	\$1 000 less any amount paid under item 219, 220, 229 or 230 in relation to the hearing \$1 000 for each day, or part of a day, after the first day
231A	Hearing on the basis of written submissions only, where the submissions are filed after the notice of hearing or invitation to be heard is issued	\$600 less any amount paid under item 219, 220, 229 or 230 in relation to the hearing
233	Requesting the supply of a copy of a patent specification	\$50
234	Requesting the supply of a copy of a document other than a patent specification: (a) for more than 6 documents from a single source and supplied at the same time;	\$200 plus \$1 per page for each document

Schedule 7 Fees
Part 2 General fees

Item	Matter	Fee
	(b) otherwise	in excess of 6 documents \$50 per document
235	Requesting the supply of a certificate by the Commissioner	\$50
236	Filing a request under regulation 3.14A for an international-type search	\$2 200
236A	Preliminary search and opinion by the Commissioner in relation to a patent request and complete specification under subsection 43A(1) of the Act	\$2,200
238	Filing an application under subsection 70(1) of the Act for the grant of an extension of the term of a standard patent	\$2 000
239	Filing an application to the Commissioner, for an extension of time under subregulation 3.17A(5):	
	(a) if the application is filed on or before the date on which notice of acceptance is published;	\$100 per month or part of a month
	(b) if the application is filed after the date on which notice of acceptance is published	\$150 per month or part of a month

Part 3—General fees for international applications

Item	Matter	Fee
301	Transmittal fee under Rule 14 of the PCT	\$200
302	Search fee under Rule 16 of the PCT	\$2 200
303	Additional fee for search under Article 17(3)(a) of the PCT	\$2 200
304	Preliminary examination fee under Rule 58 of the PCT	
	(a) if the international search report was issued by the Patent Office in respect of the international application;	\$590
	(b) in other cases	\$820
305	Additional fee for international preliminary examination under Article 34(3)(a) of the PCT	\$590
306	For a copy of a document in accordance with Rule 44.3(b) or 71.2(b) of the PCT	\$50
307	Late payment fee under Rule 16 ^{bis} .2 of the PCT	the greater of: (a) 50% of the amount of the unpaid fees specified in the invitation; and (b) the amount of the transmittal fee; but not more than 50% of the international filing fee, not taking into account any fee for each sheet of the international application in excess of 30 sheets
308	For processing a request for restoration of priority under Rule 26 ^{bis} of the PCT.	\$200

Part 4—Fees payable for benefit of International Bureau

Item	Matter	Fee
401	International filing fee: (Rule 15.2 of the PCT)	1,330 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
402	Handling fee: (Rule 57.2 of the PCT)	200 Swiss francs
Reductions		
403	The international filing fee is reduced by the following amount if the international application is, as provided for in the Administrative Instructions, filed:	
	(a) on paper together with a copy in electronic form, in character coded format, of the request and the abstract:	100 Swiss francs
	(b) in electronic form, the request not being in character coded format:	100 Swiss francs
	(c) in electronic form, the request being in character coded format:	200 Swiss francs
	(d) in electronic form, the request, description, claims and abstract being in character coded format:	300 Swiss francs
404	The international filing fee (where applicable, as reduced under item 403) and the handling fee are reduced by 90% if the international application is filed by:	
	(a) an applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997) or, until December 31, 2009, one of the following States: Antigua and Barbuda, Bahrain, Barbados, Libyan Arab Jamahiriya, Oman, Seychelles, Singapore, Trinidad & Tobago and United Arab Emirates; or	

Item	Matter	Fee
	(b) an applicant, whether a natural person or not, who is a national of and resides in a State that is classed as a least developed country by the United Nations; provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).	

Schedule 8 Costs, expenses and allowances
Part 1 Costs

Schedule 8—Costs, expenses and allowances

(subregulation 20.30(2) and regulation 22.8)

Part 1—Costs

Column 1	Column 2	Column 3
Item	Matter	Amount
1	Notice of opposition	\$200
2	Statement of grounds and particulars	\$750
3	Receiving and perusing statement of grounds and particulars	\$500
4	Evidence in support	\$1 500
5	Receiving and perusing notice of opposition	\$200
6	Receiving and perusing evidence in support	\$750
7	Evidence in answer	\$1 500
8	Receiving and perusing evidence in answer	\$750
9	Evidence in reply	\$750
10	Receiving and perusing evidence in reply	\$350
11	Preparation of case for hearing	\$1 000
12	Attendance at hearing by registered patent attorney or solicitor without counsel	\$260 an hour, but not more than \$1 170 a day
13	Attendance at hearing by registered patent attorney or solicitor instructing counsel	\$200 an hour, but not more than \$900 a day
14	Counsel fees for attendance at a hearing	\$300 an hour, but not more than \$1 350 a day

Part 2—Expenses and allowances

Division 1—Expenses

- 1 A person who has paid a fee prescribed in these Regulations in relation to proceedings before the Commissioner or the Disciplinary Tribunal may be paid the amount of the fee.

- 2** A person attending proceedings before the Commissioner or the Disciplinary Tribunal must be paid:
- (a) a reasonable amount for allowances for transport between the usual place of residence of the person and the place that he or she attends for that purpose; and
 - (b) if the person is required to be absent overnight from his or her usual place of residence—a reasonable amount for allowances up to a daily maximum of \$700 for meals and accommodation.

Division 2 Allowances

- 3** A person who, because of his or her professional, scientific or other special skill or knowledge, is summoned to appear before the Commissioner or the Disciplinary Tribunal as a witness must be paid:
- (a) if the person is remunerated in his or her occupation by wages, salary or fees—an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; or
 - (b) in any other case—an amount of not less than \$140, or more than \$700, for each day on which he or she so attends.
- 4** A person summoned to appear before the Commissioner or the Disciplinary Tribunal as a witness, other than a witness referred to in clause 3, must be paid:
- (a) if the person is remunerated in his or her occupation by wages, salary or fees—an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; or
 - (b) in any other case—an amount of not less than \$80, or more than \$130, for each day on which he or she so attends.

Endnotes

Endnote 1—Legislation history

Endnotes

Endnote 1—Legislation history

This endnote sets out details of the legislation history of the *Patents Regulations 1991*.

Number and year	Gazettal or FRLI registration date	Commencement date	Application, saving and transitional provisions
1991 No. 71	26 Apr 1991	30 Apr 1991	
1991 No. 456	19 Dec 1991	rr. 3, 5 and 7: 1 Jan 1992 Remainder: 19 Dec 1991	—
1992 No. 148	9 June 1992	r. 5: 9 June 1992 Remainder: 1 July 1992	r. 7
1993 No. 113	3 June 1993	1 July 1993	r. 9
1993 No. 227	26 Aug 1993	rr. 3.1, 4.1 and 4.4: 1 Oct 1992 Remainder: 1 Jan 1993	—
1993 No. 340	10 Dec 1993	10 Dec 1993	r. 8
1993 No. 341	10 Dec 1993	1 Jan 1994	—
1994 No. 182	16 June 1994	29 June 1994	—
1994 No. 317	6 Sept 1994	1 Oct 1994	r. 10
1994 No. 387	21 Nov 1994	rr. 9 and 10: 30 May 1995 Remainder: 21 Nov 1994	r. 10
1995 No. 16	14 Feb 1995	r. 38: 30 Apr 1991 Remainder: 14 Feb 1995	r. 45
1995 No. 20	22 Feb 1995	23 Feb 1995	—
1995 No. 82	9 May 1995	rr. 4–9, 11.2 and 12–14: 1 July 1995 Remainder: 9 May 1995	r. 14
1995 No. 427	22 Dec 1995	1 Jan 1996	—

Endnote 1—Legislation history

Number and year	Gazettal or FRLI registration date	Commencement date	Application, saving and transitional provisions
1996 No. 271	11 Dec 1996	11 Dec 1996	—
1997 No. 192	4 July 1997	4 July 1997	—
1997 No. 345	9 Dec 1997	rr. 3, 4, 8–10, 13 and 14: 1 Jan 1998 Remainder: 9 Dec 1997	r. 3
1998 No. 45	25 Mar 1998	25 Mar 1998	—
1998 No. 56	8 Apr 1998	8 Apr 1998	rr. 13–17
1998 No. 141	25 June 1998	rr. 3–5: 1 July 1998 Remainder: 25 June 1998	—
1998 No. 241	31 July 1998	31 July 1998	—
1998 No. 257	12 Aug 1998	12 Aug 1998	—
1998 No. 264	26 Aug 1998	rr. 7.1, 7.2 and 7.4: 1 Nov 1998 Remainder: 26 Aug 1998	—
1998 No. 291	7 Sept 1998	7 Sept 1998	—
1998 No. 319	1 Dec 1998	27 Jan 1999 (<i>see r. 2</i>)	—
1998 No. 342	22 Dec 1998	1 Jan 1999	—
1998 No. 345	22 Dec 1998	27 Jan 1999	—
1999 No. 154	14 July 1999	14 July 1999	—
1999 No. 184	1 Sept 1999	rr. 1–3 and Schedule 1: 1 Sept 1999 Remainder: 6 Sept 1999	—
1999 No. 261	27 Oct 1999	rr. 1–4 and Schedule 1: 27 Oct 1999 Remainder: 1 Jan 2000	r. 4
1999 No. 349	22 Dec 1999	rr. 1–3 and Schedule 1: 22 Dec 1999 Remainder: 1 Jan 2000	—
2000 No. 317	29 Nov 2000	rr. 1–3 and Schedule 1: 29 Nov 2000 Schedule 2: 1 Jan 2001 Remainder: 1 Mar 2001	—

Endnotes

Endnote 1—Legislation history

Number and year	Gazettal or FRLI registration date	Commencement date	Application, saving and transitional provisions
2001 No. 98	23 May 2001	24 May 2001 (<i>see</i> r. 2)	—
2001 No. 184	5 July 2001	5 July 2001	—
2001 No. 345	21 Dec 2001	Schedule 2: 1 Jan 2002 Remainder: 21 Dec 2001	—
2002 No. 59	28 Mar 2002	1 Apr 2002	r. 4
2002 No. 100	23 May 2002	23 May 2002	—
2002 No. 173	11 July 2002	rr. 1–5 and Schedules 1–3: 11 July 2002 Remainder: 1 Sept 2002	—
2002 No. 263	6 Nov 2002	6 Nov 2002	—
2002 No. 317	19 Dec 2002	rr. 1–3 and Schedule 1: 19 Dec 2002 Remainder: 1 Jan 2003	r. 4
2003 No. 71	28 Apr 2003	28 Apr 2003	—
2003 No. 213	21 Aug 2003	rr. 1–3 and Schedule 1: 21 Aug 2003 Remainder: 26 Aug 2003 (<i>see</i> r. 2(b))	—
2003 No. 316	11 Dec 2003	rr. 1–4 and Schedule 1: 11 Dec 2003 Remainder: 1 Jan 2004	r. 4
2004 No. 23	26 Feb 2004	11 Mar 2004	—
2004 No. 193	1 July 2004	1 July 2004	r. 4
2004 No. 250	20 Aug 2004	20 Aug 2004	—
2004 No. 395	23 Dec 2004	23 Dec 2004	r. 4
2005 No. 51	29 Mar 2005 (<i>see</i> F2005L00753)	rr. 1–4 and Schedule 1: 30 Mar 2005 Schedule 2: 1 Apr 2005 Schedule 3: 3 Apr 2005	r. 4
2006 No. 55	22 Mar 2006 (<i>see</i> F2006L00846)	1 Apr 2006	r. 4
2006 No. 355	15 Dec 2006 (<i>see</i> F2006L03971)	1 Mar 2007	—

Endnote 1—Legislation history

Number and year	Gazettal or FRLI registration date	Commencement date	Application, saving and transitional provisions
2007 No. 40	23 Mar 2007 (<i>see</i> F2007L00650)	rr. 1–10 and Schedules 1, 2, 3, 5 and 6: 27 Mar 2007 Schedules 4 and 8: 1 Apr 2007 (<i>see</i> r. 2(b)) Schedule 7: 27 Mar 2007 (<i>see</i> r. 2(c))	r. 8
2007 No. 357	18 Oct 2007 (<i>see</i> F2007L04114)	22 Oct 2007	—
2008 No. 122	23 June 2008 (<i>see</i> F2008L02119)	1 July 2008	r. 5
2008 No. 178	2 Sept 2008 (<i>see</i> F2008L03228)	1 July 2008	—
2008 No. 279	19 Dec 2008 (<i>see</i> F2008L04588)	1 Jan 2009	r. 3
2009 No. 150	26 June 2009 (<i>see</i> F2009L02472)	1 July 2009	r. 3
2009 No. 332	27 Nov 2009 (<i>see</i> F2009L04297)	12 Dec 2009	—
2010 No. 181	30 June 2010 (<i>see</i> F2010L01791)	rr. 1–3 and Schedule 1: 1 July 2010 r. 4 and Schedule 2: 1 Aug 2010	—
2011 No. 62	16 May 2011 (<i>see</i> F2011L00773)	1 July 2011	rr. 3 and 4
2011 No. 217	29 Nov 2011 (<i>see</i> F2011L02480)	rr. 1–3 and Schedule 1: 27 Dec 2011 r. 4 and Schedule 2: 1 Jan 2012	—
2012 No. 66	14 May 2012 (<i>see</i> F2012L01031)	Schedule 1 (Parts 1–4): 1 July 2012 Schedule 1 (Part 5): 1 Oct 2012	s. 3

Endnotes

Endnote 1—Legislation history

Number and year	Gazettal or FRLI registration date	Commencement date	Application, saving and transitional provisions
2012 No. 221	17 Sept 2012 (<i>see</i> F2012L01878)	18 Sept 2012	—
31, 2013	18 Mar 2013 (<i>see</i> F2013L00479)	Schedule 1, Schedule 3 (items 1–9), Schedule 4 (items 1–29), Schedule 6 (items 5–86) and Schedule 7 (items 1, 2): 15 Apr 2013	—

Endnote 2—Amendment history

Endnote 2—Amendment history

This endnote sets out the amendment history of the *Patents Regulations 1991*.

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
Chapter 1	
r. 1.1	rs. 1998 No. 257
r. 1.3	am. 1998 No. 345; 2001 No. 98; 2004 No. 395; 2008 Nos. 122 and 279; 2009 No. 332; 2011 No. 217; 2012 No. 66; No. 31, 2013
r. 1.3A	ad. 2003 No. 213
r. 1.4	am. 1991 No. 456; 1992 No. 148; 1993 Nos. 227 and 341 rs. 1995 Nos. 16 and 427 am. 1997 No. 345; 1998 Nos. 141 and 342; 1999 No. 349; 2000 No. 317; 2001 No. 345; 2002 Nos. 59 and 317; 2003 No. 316; 2005 No. 51; 2006 No. 55; 2007 No. 40; 2008 No. 279; 2009 No. 150; 2010 No. 181; 2011 No. 62; 2012 No. 66 rs. No. 31, 2013
r. 1.5	am. 1995 No. 16 rs. 2001 No. 98
Heading to r. 1.6	rs. 2009 No. 332; No. 31, 2013
r. 1.6	am. 1995 No. 16; 2000 No. 317; 2001 No. 98; 2008 No. 279 rs. No. 31, 2013
r. 1.6A	rep. No. 31, 2013
r. 1.7	am. 2001 No. 98
r. 1.8	ad. 2009 No. 332
Chapter 2	
r. 2.1	am. 2001 No. 98
Heading to r. 2.2	rs. 2002 No. 59; No. 31, 2013
r. 2.2	am. 1995 No. 16; 2001 No. 98; 2002 No. 59 rs. No. 31, 2013
r. 2.2A	ad. No. 31, 2013

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 2.2B.....	ad. No. 31, 2013
r. 2.2C.....	ad. No. 31, 2013
r. 2.2D.....	ad. No. 31, 2013
Heading to r. 2.3.....	rs. 2002 No. 59; No. 31, 2013
r. 2.3.....	am. 1995 No. 16; 2001 No. 98; 2002 No. 59 rs. No. 31, 2013
r. 2.4.....	rs. 1995 No. 16 am. 2001 No. 98
r. 2.5.....	am. 2001 No. 98 rs. 2007 No. 357
r. 2.6.....	rs. 2001 No. 98
r. 2.7.....	am. 1995 No. 16 rs. 2001 No. 98
Chapter 3	
Part 1	
Division 1	
Heading to Div. 1..... of Part 1	ad. No. 31, 2013
r. 3.1.....	am. 1995 No. 16; 2000 No. 317; 2001 No. 98; 2003 No. 316; No. 31, 2013
r. 3.1A.....	ad. 2001 No. 98 am. No. 31, 2013
r. 3.2.....	am. 1995 No. 16; 2000 No. 317 rs. 2001 No. 98
r. 3.2A.....	ad. 2001 No. 98 rs. 2009 No. 332 am. No. 31, 2013
r. 3.2AB.....	ad. No. 31, 2013
r. 3.2B.....	ad. 2001 No. 98 am. 2002 No. 59; No. 31, 2013

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 3.2C.....	ad. No. 31, 2013
r. 3.3	am. 1995 No. 16; 2002 No. 59; No. 31, 2013
r. 3.4	am. 1995 No. 16; 2002 No. 59
Heading to r. 3.5	rs. No. 31, 2013
r. 3.5	am. 2000 No. 317
	rs. 2001 No. 98
	am. No. 31, 2013
r. 3.5AA.....	ad. No. 31, 2013
r. 3.5A	ad. 2001 No. 98
	am. 2002 No. 59; 2008 No. 279; No. 31, 2013
r. 3.5AB.....	ad. No. 31, 2013
r. 3.5AC.....	ad. No. 31, 2013
r. 3.5AD.....	ad. No. 31, 2013
r. 3.5AE.....	ad. No. 31, 2013
r. 3.5AF	ad. No. 31, 2013
r. 3.5AG.....	ad. No. 31, 2013
r. 3.5B.....	ad. 2001 No. 98
	am. No. 31, 2013
r. 3.6	rs. 2001 No. 98
r. 3.7	am. 2001 No. 98
r. 3.8	rs. 1995 No. 16
	am. 2001 No. 98
r. 3.9	rs. 2001 No. 98
r. 3.10	am. 2001 No. 98
r. 3.11	rep. 2001 No. 98
	ad. No. 31, 2013
Division 2	
Heading to Div. 2	ad. No. 31, 2013
of Part 1	
r. 3.12	am. 1995 No. 16; 2001 No. 98; 2007 No. 40

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
	rs. No. 31, 2013
r. 3.13	rs. 2001 No. 98; No. 31, 2013
r. 3.13A.....	ad. No. 31, 2013
r. 3.13B.....	ad. No. 31, 2013
r. 3.13C.....	ad. No. 31, 2013
r. 3.13D.....	ad. No. 31, 2013
r. 3.13E.....	ad. No. 31, 2013
r. 3.14	am. 2001 No. 98; No. 31, 2013
Division 3	
Heading to Div. 3	ad. No. 31, 2013
of Part 1	
r. 3.14A.....	ad. No. 31, 2013
r. 3.14B.....	ad. No. 31, 2013
r. 3.14C.....	ad. No. 31, 2013
r. 3.14D.....	ad. No. 31, 2013
Heading to r. 3.15	rs. No. 31, 2013
r. 3.15	am. 2001 No. 98; No. 31, 2013
r. 3.16	am. 2001 No. 98; No. 31, 2013
r. 3.17	am. 2001 No. 98
r. 3.17A.....	ad. 2002 No. 59
	am. 2002 No. 263, 2003 No. 71
	rs. 2003 No. 213; No. 31, 2013
r. 3.17B.....	ad. 2003 No. 213
	am. 2007 No. 357
	rs. No. 31, 2013
r. 3.17C.....	ad. No. 31, 2013
r. 3.18	am. 1995 No. 16; 2001 No. 98; 2007 No. 357; 2008 No. 279; No. 31, 2013
Heading to r. 3.19	rs. 2001 No. 98
r. 3.19	am. 1995 No. 16; 2001 No. 98; No. 31, 2013

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 3.20	am. 2001 No. 98; 2008 No. 279 rep. No. 31, 2013
r. 3.21	am. 1995 No. 16; 2001 No. 98 rep. No. 31, 2013
r. 3.22	am. 1995 No. 16 rep. 2001 No. 98 ad. 2008 No. 279 rs. 2009 No. 332
Part 2	
r. 3.23	am. 1995 No. 16; 2001 No. 98
r. 3.24	am. 1995 No. 16
r. 3.25	am. 1995 No. 16; 2001 No. 98
r. 3.26	am. 2001 No. 98
r. 3.27	am. 2001 No. 98
r. 3.28	am. 2001 No. 98
r. 3.29	am. 2001 No. 98
r. 3.30	am. 1995 No. 16; 2001 No. 98
r. 3.31	am. 2001 No. 98
Chapter 4	
r. 4.1	am. 2001 No. 98; No. 31, 2013
r. 4.2	am. 1995 Nos. 16 and 82; 2001 No. 98
r. 4.3	am. 1995 No. 16; 1998 No. 45; 1999 No. 261; 2002 No. 100; 2009 No. 332; No. 31, 2013
r. 4.4	ad. No. 31, 2013
Chapter 5	
Chapter 5	rs. No. 31, 2013
Part 5.1	
r. 5.1	am. 1995 Nos. 16 and 82; 1997 No. 192; 1998 No. 319; 2001 No. 98 rs. No. 31, 2013
r. 5.2	am. 2001 No. 98

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
	rs. No. 31, 2013
Heading to r. 5.3	rs. 2001 No. 98
	rs. No. 31, 2013
r. 5.3	am. 1995 Nos. 16 and 82; 1998 No. 319; 2001 No. 98
	rs. No. 31, 2013
Part 5.2	
Division 5.2.1	
r. 5.3AA.....	ad. 2001 No. 98
	rep. No. 31, 2013
Heading to r. 5.3A	rs. 2001 No. 98
	rep. No. 31, 2013
r. 5.3A	ad. 1995 No. 16
	rep. No. 31, 2013
r. 5.3B.....	ad. 2001 No. 98
	rep. No. 31, 2013
r. 5.4	am. 1993 No. 113; 1995 No. 82
	rs. 2001 No. 98; No. 31, 2013
r. 5.5	am. 2001 No. 98
	rs. No. 31, 2013
r. 5.6	am. 2001 No. 98
	rs. No. 31, 2013
r. 5.7	am. 2001 No. 98
	rs. No. 31, 2013
r. 5.8	am. 1995 Nos. 16 and 82; 2001 No. 98; 2002 No. 59
	rs. No. 31, 2013
r. 5.9	am. 1995 No. 16; 2000 No. 317; 2001 No. 98
	rs. No. 31, 2013
r. 5.9A	ad. 2004 No. 250
	rep. No. 31, 2013

Division 5.2.2

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 5.10	am. 1993 Nos. 113 and 340; 2000 No. 317; 2001 No. 98; 2002 No. 59; 2004 No. 250 rs. No. 31, 2013
r. 5.11	am. 2001 No. 98 rs. No. 31, 2013
r. 5.12	rs. 2001 No. 98 rs. No. 31, 2013
Part 5.3	
r. 5.13	am. 1995 No. 16 rs. 2001 No. 98; No. 31, 2013
r. 5.14	rs. 2001 No. 98; No. 31, 2013
r. 5.15	rs. No. 31, 2013
r. 5.16	ad. No. 31, 2013
Part 5.4	
r. 5.17	ad. No. 31, 2013
r. 5.18	ad. No. 31, 2013
Part 5.5	
r. 5.19	ad. No. 31, 2013
r. 5.20	ad. No. 31, 2013
Part 5.6	
r. 5.21	ad. No. 31, 2013
r. 5.22	ad. No. 31, 2013
r. 5.23	ad. No. 31, 2013
r. 5.24	ad. No. 31, 2013
r. 5.25	ad. No. 31, 2013
r. 5.26	ad. No. 31, 2013
Chapter 6	
Part 1	
Heading to Part 1 of.....	ad. 1998 No. 319
Chapt. 6	

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 6.1	am. 2001 No. 98
r. 6.1A	ad. No. 31, 2013
r. 6.2	am. 2001 No. 98; No. 31, 2013
r. 6.2A	ad. No. 31, 2013
r. 6.3	am. 1999 No. 261 rs. 2001 No. 98 am. No. 31, 2013
r. 6.4	am. 2001 No. 98 rep. No. 31, 2013
rr. 6.5, 6.6	rep. 2001 No. 98
Part 2	
r. 6.7	am. 1995 No. 16 rep. 1995 No. 82
Part 2 of Chapt. 6	ad. 1998 No. 319
r. 6.7	ad. 1998 No. 319
r. 6.8	ad. 1998 No. 319
r. 6.9	ad. 1998 No. 319
r. 6.10	ad. 1998 No. 319
r. 6.11	ad. 1998 No. 319 am. 2001 No. 98
Chapter 6A	
Chapter 6A	ad. 2001 No. 98 rs. No. 31, 2013
r. 6A.1	ad. 2001 No. 98 rs. No. 31, 2013
r. 6A.2	ad. 2001 No. 98 rs. 2007 No. 40; No. 31, 2013
Chapter 7	
r. 7.1	am. 2001 No. 98
r. 7.2	am. 2001 No. 98

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
Chapter 8	rep. No. 31, 2013
r. 8.1	am. 1995 No. 16; 2001 No. 98; 2002 No. 59 rep. No. 31, 2013
r. 8.1A	ad. 1999 No. 184 rep. No. 31, 2013
r. 8.1B.....	ad. 2003 No. 213 rep. 2004 No. 395
r. 8.2	am. 1995 No. 16; 2001 No. 98 rep. No. 31, 2013
r. 8.3	am. 1995 No. 16; 1999 No. 261; 2001 No. 98; 2003 No. 316; 2004 Nos. 193 and 395; 2007 No. 40 rep. No. 31, 2013
r. 8.4	am. 1995 No. 16; 2001 Nos. 98 and 345; 2002 No. 100; 2004 No. 193; 2010 No. 181 rep. No. 31, 2013
r. 8.5	am. 2001 No. 98 rep. No. 31, 2013
Heading to r. 8.6	rs. 2009 No. 332 rep. No. 31, 2013
r. 8.6	am. 1995 No. 16; 2000 No. 317; 2001 No. 98; 2008 No. 279 rep. No. 31, 2013
r. 8.6A	ad. 2009 No. 332 rep. No. 31, 2013
r. 8.7	am. 2001 No. 98 rep. No. 31, 2013
Chapter 9	
r. 9.1	am. 2001 No. 98 rs. 2002 No. 59
r. 9.2	am. 2001 No. 98; No. 31, 2013

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 9.3	am. 2001 No. 98
r. 9.4	am. 1995 No. 16; 2001 No. 98
r. 9.5	am. 2001 No. 98
Chapter 9A	
Chapter 9A	ad. 2001 No. 98
r. 9A.1	ad. 2001 No. 98
r. 9A.2	ad. 2001 No. 98
r. 9A.2A.....	ad. 2002 No. 59 am. 2002 No. 173; 2003 No. 213 rep. No. 31, 2013
r. 9A.2B.....	ad. 2003 No. 213 am. 2007 No. 357 rep. No. 31, 2013
r. 9A.3	ad. 2001 No. 98
r. 9A.4	ad. 2001 No. 98 am. 2002 No. 59; 2008 No. 279; No. 31, 2013
r. 9A.5	ad. 2001 No. 98
Chapter 10	
r. 10.1	am. 1995 No. 16; 2001 No. 98; 2003 No. 316; No. 31, 2013
r. 10.2	am. 1995 No. 16; 2000 No. 317; 2001 No. 98; 2004 No. 395; No. 31, 2013
Note to r. 10.2(3)(c)(iii).....	rs. No. 31, 2013
r. 10.2A.....	ad. No. 31, 2013
r. 10.2B.....	ad. No. 31, 2013
r. 10.2C.....	ad. No. 31, 2013
r. 10.3	am. 1997 No. 345; 2001 No. 98 rs. No. 31, 2013
r. 10.4	am. 2001 No. 98; No. 31, 2013
r. 10.5	am. 1995 No. 16; 2001 No. 98; No. 31, 2013
r. 10.6	rs. 1995 No. 16

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
	am. No. 31, 2013
r. 10.6A.....	ad. 2011 No. 217
r. 10.6B.....	ad. No. 31, 2013
r. 10.7.....	am. 2005 No. 51; No. 31, 2013
	rs. No. 31, 2013
r. 10.8.....	rs. 2001 No. 98
r. 10.9.....	rep. 2001 No. 98
r. 10.10.....	am. 2001 No. 98
r. 10.11.....	am. 2001 No. 98
r. 10.12.....	am. 2001 No. 98
r. 10.13.....	rep. 2001 No. 98
r. 10.14.....	am. 2001 No. 98
Chapter 11	
r. 11.1.....	am. 1997 No. 345; No. 31, 2013
Chapter 12	
r. 12.1.....	am. 2001 No. 98; 2007 No. 40; 2011 No. 62; No. 31, 2013
Heading to r. 12.2.....	rs. 2001 No. 98
r. 12.2.....	am. 2001 No. 98; 2011 No. 62
r. 12.3.....	am. 2001 No. 98
r. 12.4.....	am. 2001 No. 98
Chapter 13	
r. 13.1.....	am. 2001 No. 98
r. 13.1A.....	ad. 2001 No. 98
	am. 2004 No. 395; No. 31, 2013
r. 13.1B.....	ad. 2004 No. 395
	am. No. 31, 2013
r. 13.1C.....	ad. No. 31, 2013
r. 13.2.....	am. 2001 No. 98
	rep. No. 31, 2013

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 13.3	am. 1994 No. 317; 1998 No. 264; 2001 No. 98; 2002 Nos. 59, 100 and 173
Notes 1, 2 to r. 13.3	ad. 1998 No. 264
r. 13.4	rs. 1995 No. 16 am. 2000 No. 317; 2001 No. 98; 2002 No. 59; 2008 No. 279; No. 31, 2013
r. 13.5	am. 2001 No. 98; 2004 No. 193
r. 13.5A.....	ad. No. 31, 2013
Heading to r. 13.6.....	rs. 2001 No. 98
r. 13.6	am. 1994 No. 317; 1995 No. 82; 1998 Nos. 264 and 319; 2001 No. 98; 2002 Nos. 59 and 173
Notes 1, 2 to r. 13.6	ad. 1998 No. 264
r. 13.7	ad. 2002 No. 59
Chapter 15	
r. 15.1	rs. 2001 No. 98
r. 15.2	am. 2001 No. 98
r. 15.3	am. 1995 No. 16 rs. 2001 No. 98
Chapter 17	
r. 17.1	rs. 2001 No. 98
r. 17.1A.....	ad. 2001 No. 98
r. 17.2	am. 1995 No. 16; 2001 No. 98
Chapter 19	
r. 19.1	am. 2001 No. 98
r. 19.2	am. 1995 No. 16; 2001 No. 98; 2002 No. 59; No. 31, 2013
Chapter 20	
Heading to Chapt. 20.....	rs. No. 31, 2013
Part 1	
r. 20.1A.....	ad. No. 31, 2013
r. 20.1	am. 1994 No. 387; 1998 Nos. 56 and 345; 2001 No. 98

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
	rs. 2008 No. 122
	am. No. 31, 2013
Part 2	
r. 20.2	rs. 1998 No. 56; 2008 No. 122
r. 20.2A.....	ad. 1998 No. 345
	rep. 2008 No. 122
r. 20.2B.....	ad. 1998 No. 345
	rep. 2008 No. 122
r. 20.3	rs. 1998 No. 345; 2008 No. 122
	am. 2009 No. 150; 2012 No. 66
r. 20.3A.....	ad. 1998 No. 345
	rep. 2008 No. 122
r. 20.4	am. 1998 No. 345; 2001 No. 98; 2002 No. 173
	rs. 2008 No. 122
r. 20.5	am. 1998 No. 345
	rs. 2008 No. 122
Heading to r. 20.6.....	rs. 1998 No. 345
r. 20.6	am. 1998 No. 345
	rs. 2008 No. 122
	am. 2009 No. 150
r. 20.7	rs. 1998 No. 345
	am. 2001 No. 98
	rs. 2008 No. 122
Heading to r. 20.8.....	rs. 1998 No. 345
r. 20.8	am. 1998 No. 345
	rs. 2008 No. 122
	am. 2009 No. 150
Heading to r. 20.9.....	rs. 1998 No. 345
r. 20.9	am. 1998 No. 345; 1999 No. 154
	rs. 2008 No. 122

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
Heading to r. 20.10	rs. 1998 No. 345
r. 20.10	am. 1998 No. 345 rs. 2008 No. 122
r. 20.11	rs. 1998 No. 345 rs. 2008 No. 122
Heading to r. 20.12	rs. 1998 No. 345
r. 20.12	am. 1998 No. 345 rs. 2008 No. 122
Part 3	
r. 20.13	am. 1998 No. 345 rs. 2008 No. 122 am. 2009 No. 150
r. 20.14	am. 1998 No. 345 rs. 2008 No. 122
Part 4	
Heading to r. 20.15	rs. 1998 No. 345
r. 20.15	am. 1998 No. 345 rs. 2008 No. 122
r. 20.16	am. 1995 No. 16 rs. 1998 No. 345; 2008 No. 122
Heading to Div. 3 of	rs. 1998 No. 345
Part 2 of Chapt. 20	rep. 2008 No. 122
r. 20.17	am. 1998 No. 345 rs. 2008 No. 122
r. 20.18	am. 1998 No. 345 rs. 2008 No. 122
r. 20.19	am. 1998 No. 345; 1999 Nos. 184 and 349; 2001 No. 98; 2002 No. 173 rs. 2008 No. 122
r. 20.19A	ad. 1998 No. 345 am. 1999 No. 349; 2002 No. 173

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
	rep. 2008 No. 122
r. 20.20	am. 1998 No. 345
	rs. 2008 No. 122
Heading to r. 20.21	rs. 1998 No. 345
r. 20.21	am. 1998 No. 345; 2001 No. 98
	rs. 2008 No. 122
Part 5	
Heading to r. 20.22	rs. No. 31, 2013
r. 20.22	am. 1998 No. 345
	rs. 2008 No. 122
	am. No. 31, 2013
r. 20.23	am. 1998 No. 345
	rs. 2008 No. 122
r. 20.24	am. 2001 No. 98
	rs. 2008 No. 122
r. 20.25	am. 1998 No. 345; 2001 Nos. 98 and 345
	rs. 2008 No. 122
Part 6	
Heading to Part 6	rs. No. 31, 2013
of Chapt. 20	
Heading to r. 20.26	rs. No. 31, 2013
r. 20.26	rs. 2008 No. 122
r. 20.27	am. 2001 No. 345
	rs. 2008 No. 122
r. 20.28	rs. 2008 No. 122
	am. No. 31, 2013
Part 6A	
Part 6A of Chapt. 20	ad. No. 31, 2013
r. 20.28A	ad. No. 31, 2013
r. 20.28B	ad. No. 31, 2013

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
Part 7	
Heading to Part 7 of Chapt. 20	rs. No. 31, 2013
Heading to r. 20.29	rs. No. 31, 2013
r. 20.29	am. 1998 No. 345; 2001 No. 345 rs. 2008 No. 122 am. No. 31, 2013
Heading to r. 20.30	rs. No. 31, 2013
r. 20.30	am. 1998 No. 345; 2001 No. 345 rs. 2008 No. 122 am. No. 31, 2013
Heading to r. 20.31	rs. No. 31, 2013
r. 20.31	am. 2001 No. 98 rs. 2008 No. 122 am. 2012 No. 66; No. 31, 2013
Part 8	
Division 1	
Heading to Div. 1 of Part 5 of Chapt. 20	rs. 1998 No. 56 rep. 2008 No. 122
Heading to Div. 1 of Part 8 of Chapt. 20	ad. 2008 No. 122
Heading to r. 20.32	rs. 1998 No. 345
r. 20.32	am. 1994 No. 387; 1995 No. 82 rs. 1998 No. 56 am. 1998 No. 345 rs. 2008 No. 122 am. No. 31, 2013
r. 20.33	rep. 1998 No. 56 ad. 2008 No. 122
r. 20.34	rs. 1998 Nos. 56 and 345; 2008 No. 122

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
 exp. = expired or ceased to have effect

Provision affected	How affected
r. 20.35	rs. 1998 No. 56; 2008 No. 122
Division 2	
r. 20.36	rep. 1998 No. 56 ad. 2008 No. 122
r. 20.37	am. 1994 No. 387 rs. 2008 No. 122
r. 20.38	am. 1994 No. 387 rs. 2008 No. 122
r. 20.39	am. 1994 No. 387 rs. 1998 No. 56; 2008 No. 122
r. 20.40	am. 1994 No. 387 rs. 1998 No. 56; 2008 No. 122
Heading to Div. 2 of	rs. 1998 No. 345
Part 5 of Chapt. 20	rep. 2008 No. 122
r. 20.41	am. 1998 No. 345 rs. 2008 No. 122
r. 20.42	am. 2001 No. 98 rs. 2008 No. 122
r. 20.43	am. 1997 No. 345; 2001 No. 98 rs. 2008 No. 122
r. 20.44	am. 2001 No. 98 rs. 2008 No. 122 am. No. 31, 2013
r. 20.45	rs. 2008 No. 122
r. 20.46	ad. 2008 No. 122
r. 20.47	ad. 2008 No. 122
r. 20.48	ad. 2008 No. 122
r. 20.49	ad. 2008 No. 122
r. 20.50	ad. 2008 No. 122
r. 20.51	ad. 2008 No. 122

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 20.52	ad. 2008 No. 122
Note to r. 20.52(3)	am. 2008 No. 279

Part 9

r. 20.53	ad. 2008 No. 122
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Part 10

Division 1

r. 20.54	ad. 2008 No. 122
r. 20.55	ad. 2008 No. 122
r. 20.56	ad. 2008 No. 122
r. 20.57	ad. 2008 No. 122
r. 20.58	ad. 2008 No. 122
r. 20.59	ad. 2008 No. 122
r. 20.60	ad. 2008 No. 122

Division 2

r. 20.61	ad. 2008 No. 122
r. 20.62	ad. 2008 No. 122
r. 20.63	ad. 2008 No. 122
r. 20.64	ad. 2008 No. 122
r. 20.65	ad. 2008 No. 122

Chapter 20A

Chapter 20A	ad. No. 31, 2013
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Part 1

r. 20A.1.....	ad. No. 31, 2013
r. 20A.2.....	ad. No. 31, 2013

Part 2

r. 20A.3.....	ad. No. 31, 2013
r. 20A.4.....	ad. No. 31, 2013

Part 3

r. 20A.5.....	ad. No. 31, 2013
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Part 4

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 20A.6.....	ad. No. 31, 2013
r. 20A.7.....	ad. No. 31, 2013
r. 20A. 8.....	ad. No. 31, 2013
Part 5	
Division 1	
r. 20A.9.....	ad. No. 31, 2013
r. 20A.10.....	ad. No. 31, 2013
Division 2	
r. 20A.11.....	ad. No. 31, 2013
r. 20A.12.....	ad. No. 31, 2013
r. 20A.13.....	ad. No. 31, 2013
r. 20A.14.....	ad. No. 31, 2013
r. 20A.15.....	ad. No. 31, 2013
r. 20A.16.....	ad. No. 31, 2013
r. 20A.17.....	ad. No. 31, 2013
r. 20A.18.....	ad. No. 31, 2013
r. 20A.19.....	ad. No. 31, 2013
r. 20A.20.....	ad. No. 31, 2013
r. 20A.21.....	ad. No. 31, 2013
Part 6	
r. 20A.22.....	ad. No. 31, 2013
Chapter 21	
r. 21.1.....	am. 1999 No. 184
r. 21.2.....	ad. 1994 No. 182
	rs. 1998 No. 257; 1999 No. 184
Chapter 22	
Part 1	
Division 1	
r. 22.1.....	am. 1998 Nos. 241 and 342

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 22.2	am. 1991 No. 456; 1993 No. 113; 1994 No. 317; 1997 No. 345; 2001 No. 98; 2002 No. 173; 2003 No. 316; 2010 No. 181; 2012 No. 66; No. 31, 2013
r. 22.2AA.....	ad. 2012 No. 66
r. 22.2A.....	ad. 1998 No. 241 rs. 2001 No. 98
r. 22.2B.....	ad. 2001 No. 98 am. 2002 No. 173; No. 31, 2013
r. 22.2C.....	ad. 2001 No. 98 am. 2002 Nos. 59 and 173; 2003 No. 213; No. 31, 2013
r. 22.2D.....	ad. 2001 No. 98 am. 2002 No. 173
r. 22.2E.....	ad. 2001 No. 98 am. 2002 No. 173 rep. No. 31, 2013
r. 22.2EA	ad. 2010 No. 181 rs. 2011 No. 62
r. 22.2F	ad. 2001 No. 98 am. 2002 No. 173; 2010 No. 181; No. 31, 2013
r. 22.2G.....	ad. 2001 No. 98 am. 2002 No. 173; 2012 No. 66
r. 22.2H.....	ad. 2001 No. 98 am. 2002 No. 173
r. 22.2I	ad. 2002 No. 173
r. 22.3	am. 1995 No. 16; 2001 No. 98; 2002 No. 173
r. 22.4	am. 1995 Nos. 16 and 427; 1998 No. 342; 2003 No. 316
Note to r. 22.4(1C)	rep. 2003 No. 316
r. 22.5	am. 1995 No. 16; 2001 No. 98
r. 22.6	am. 1995 No. 16; 2001 No. 98
r. 22.7	am. 1995 No. 16

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
Division 2	
r. 22.7A.....	ad. 1993 No. 340
r. 22.8	am. 1993 No. 340; 1995 No. 16; 2001 No. 98
Part 2	
r. 22.8A.....	ad. 2001 No. 98 rep. 2009 No. 332
r. 22.9	am. 2001 No. 98
r. 22.10	am. 2001 No. 98; 2011 No. 62; No. 31, 2013
r. 22.10A.....	ad. 2001 No. 98
r. 22.10AA.....	ad. 2007 No. 40 am. No. 31, 2013
Note to r. 22.10AA	am. No. 31, 2013
r. 22.10AB.....	ad. 2007 No. 40 am. 2011 No. 62; No. 31, 2013
Note to r. 22.10AB (2)	am. 2011 No. 217
r. 22.10AC.....	ad. 2007 No. 40 rs. No. 31, 2013
r. 22.11	am. 1993 No. 113; 1995 No. 82; 1998 Nos. 241, 264 and 319; 2001 No. 98; 2002 No. 59; 2004 No. 250; 2008 No. 122; No. 31, 2013
r. 22.12	am. No. 31, 2013
r. 22.13	am. 1995 No. 16; 2009 No. 150 rs. 2012 No. 66
r. 22.15	am. 1995 No. 16 rs. 1998 No. 141 am. 2003 No. 213 rs. No. 31, 2013
r. 22.16.....	am. 2001 No. 98; 2009 No. 332; No. 31, 2013
r. 22.20	am. 1995 No. 16
r. 22.21	am. 2001 No. 98; No. 31, 2013
r. 22.22	rs. No. 31, 2013

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
r. 22.23	am. 1995 No. 16 rs. No. 31, 2013
r. 22.26	am. 1995 No. 16; 1998 Nos. 45, 291 and 345; 2001 No. 98; 2004 No. 395; 2005 No. 51; 2008 No. 122; No. 31, 2013
r. 22.27	ad. No. 31, 2013
Chapter 23	
Part 1	
Heading to Part 1	ad. No. 31, 2013 of Chapt. 23
r. 23.2	am. 2001 No. 98
r. 23.3	am. 1995 No. 16; 2001 No. 98
r. 23.4	am. 1995 Nos. 16 and 82; 2001 No. 98
r. 23.5	am. 2001 No. 98
r. 23.6	am. 2001 No. 98
r. 23.7	am. 2001 No. 98
r. 23.8	am. 1995 No. 16
r. 23.9	am. 1994 No. 317
r. 23.10	am. 1994 No. 317; 1995 No. 16; 1997 No. 345
r. 23.11	am. 1995 No. 16; 2001 No. 98
r. 23.12	am. 2001 No. 98
r. 23.13	am. 2001 No. 98
r. 23.14	am. 1995 No. 16
r. 23.16	am. 2001 No. 98
r. 23.17	am. 1995 No. 16; 2001 No. 98
r. 23.18	am. 1995 No. 16
r. 23.19	am. 2001 No. 98 rep. 2008 No. 122
r. 23.20	am. 1995 No. 16; 2001 No. 98 rep. 2008 No. 122
r. 23.21	am. 2001 No. 98

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
	rep. 2008 No. 122
r. 23.22	am. 2001 No. 98
	rep. 2008 No. 122
r. 23.23	am. 2001 No. 98
	rep. 2008 No. 122
r. 23.24	rep. 2008 No. 122
r. 23.25	am. 1995 No. 16; 2001 No. 98
r. 23.27	ad. 1998 No. 345
	rep. 2008 No. 122
r. 23.28	ad. 1998 No. 345
	rep. 2008 No. 122
r. 23.29	ad. 1998 No. 345
	rep. 2008 No. 122
r. 23.30	ad. 1998 No. 345
	rep. 2008 No. 122
r. 23.31	ad. 1998 No. 345
	rep. 2008 No. 122
r. 23.32	ad. 2001 No. 98
r. 23.33	ad. 2001 No. 98
r. 23.34	ad. 2001 No. 98
r. 23.35	ad. 2001 No. 98
Part 2	
Part 2 of Chapt. 23.....	ad. No. 31, 2013
r. 23.36	ad. No. 31, 2013
Schedule 1	am. 1995 No. 16
	rep. No. 31, 2013
Heading to Schedule 1A.....	ad. 1995 No. 16
	rep. No. 31, 2013
Schedule 1A	am. 1995 No. 16; 2002 No. 317
	rep. No. 31, 2013

Endnotes

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
Schedule 2	am. 1991 No. 456 rs. 1992 No. 148 am. 1993 Nos. 227 and 341; 1995 No. 16; 2002 No. 59 rep. No. 31, 2013
Heading to Schedule 2A	ad. 1995 No. 16 rep. No. 31, 2013
Schedule 2A	am. 1995 Nos. 16 and 427; 1997 No. 345 rs. 1998 No. 141 am. 1998 No. 342; 1999 No. 349; 2000 No. 317; 2001 No. 345; 2002 Nos. 59 and 317; 2003 No. 316; 2005 No. 51; 2006 No. 55; 2007 No. 40; 2008 Nos. 178 and 279; 2009 No. 150; 2010 No. 181; 2011 No. 62; 2012 No. 66 rep. No. 31, 2013
Schedule 3	
Heading to Schedule 3	rs. 2001 No. 98; 2009 No. 332; No. 31, 2013
Schedule 3	am. 1995 No. 16; 1998 No. 141; 2000 No. 317; 2001 No. 98; 2003 No. 213; 2011 No. 62
Schedule 4	rs. 1991 No. 456 am. 1992 No. 148 rs. 1993 No. 340 am. 1994 No. 182; 1995 Nos. 20 and 427 rs. 1996 No. 271; 1997 No. 345 am. 1998 Nos. 257 and 342; 1999 No. 349; 2002 Nos. 173 and 317; 2004 Nos. 23 and 193; 2005 No. 51; 2007 No. 40; 2008 No. 279; 2012 No. 66 rep. No. 31, 2013
Schedule 5	
Schedule 5	am. 1994 No. 387 rs. 1998 No. 345; 2008 No. 122
Schedule 6	am. 1998 No. 345; 2001 No. 184 rep. 2008 No. 279
Schedule 6A	ad. 1994 No. 182

Endnote 2—Amendment history

ad. = added or inserted am. = amended rep. = repealed rs. = repealed and substituted
exp. = expired or ceased to have effect

Provision affected	How affected
	rs. 1997 No. 192
	am. 1997 No. 345
	rs. 1998 No. 257
	rep. 1999 No. 184
Schedule 7	
Schedule 7	am. 1991 No. 456
	rs. 1992 No. 148
	am. 1993 Nos. 113 and 340; 1994 No. 317; 1995 Nos. 16, 82 and 427; 1997 Nos. 192 and 345; 1998 Nos. 264, 319, 342 and 345; 1999 Nos. 261 and 349; 2000 No. 317; 2001 Nos. 98 and 345; 2002 Nos. 59 and 173; 2003 Nos. 213 and 316; 2006 No. 355; 2007 No. 40; 2008 Nos. 122 and 178; 2010 No. 181
	rs. 2012 No. 66
	am. 2012 Nos. 66 and 221; No. 31, 2013
Schedule 8	
Schedule 8	am. 1992 No. 148
	rs. 1993 No. 113
	am. 1993 No. 340; 1994 No. 317; 1998 No. 345; 1999 No. 184; 2006 No. 355

Endnote 3—Application, saving and transitional provisions

This endnote sets out application, saving and transitional provisions for amendments of the *Patents Regulations 1991*.

Patents Regulations (Amendment) (1997 No. 345)

3 Application to certain applications

- 3.1 The amendment of Part 4 of Schedule 7 of the Patents Regulations by regulation 14 of these Regulations applies only to an international application filed on or after 1 January 1998.

Patents Regulations (Amendment) (1998 No. 56)

13 Definitions

- 13.1 In this Part:

new Board means the Professional Standards Board for Patent and Trade Marks Attorneys established under Chapter 20 of the Patents Regulations as amended by these Regulations.

old Board means the Patent Attorneys Professional Standards Board:

- (a) established under Chapter 20 of the Patents Regulations before the commencement of these Regulations; and
- (b) as constituted at any time before the commencement of these Regulations.

14 Continuing effect of certain applications

- 14.1 This regulation applies to an application (including anything accompanying the application) made in accordance with regulation 20.2 of the Patents Regulations if:
- (a) the application was made before the commencement of these Regulations; and
 - (b) anything that could have been done by the old Board under Chapter 20 of the Patents Regulations in relation to the

Endnote 3—Application, saving and transitional provisions

application (*unfinished business*) was not done before the commencement of these Regulations.

- 14.2 The application is taken to have been made in accordance with regulation 20.2 of the Patents Regulations as amended by these Regulations.
- 14.3 The unfinished business may be finished by the new Board in accordance with Chapter 20 of the Patents Regulations as amended by these Regulations.

15 Continuing effect of decisions of old Board

- 15.1 This regulation applies to any act done, or decision made, by the old Board under Chapter 20 of the Patents Regulations as amended and in force at any time before the commencement of these Regulations.
- 15.2 The act or decision has effect as if the act had been done, or decision had been made, by the new Board.

16 Continuing effect of certificates

- 16.1 This regulation applies to each certificate given by the old Board under Chapter 20 of the Patent Regulations as amended and in force at any time before the commencement of these Regulations.
- 16.2 The certificate is as valid as it would be if it had been given by the new Board.

17 Continuing effect of certain complaints

- 17.1 This regulation applies to a complaint in writing to the old Board made under Part 4 of Chapter 20 of the Patents Regulations as amended and in force at any time, if:
- (a) the complaint was made before the commencement of these Regulations; and
 - (b) anything that could have been done by the old Board in relation to the complaint under the Part (*unfinished*

business) was not done before the commencement of these Regulations.

17.2 The unfinished business may be finished by the new Board in accordance with Part 4 of Chapter 20 of the Patents Regulations.

17.3 Any reply or further information sought by the old Board under regulation 20.20 of the Patents Regulations, but not given to the old Board before the commencement of these Regulations must be given to the new Board in accordance with regulation 20.20 as if the reply or further information had been sought by the new Board.

Patents Amendment Regulations 1999 (No. 3) (1999 No. 261)

4 Transitional

Paragraphs 6.3(ea) and (eb) as substituted by these Regulations do not apply to a patent or patent application for which, before the commencement of these Regulations, the Commissioner extended the time for making an application under section 38 or 94 of the Act.

Patents Amendment Regulations 2002 (No. 1) (2002 No. 59)

4 Transitional

- (1) The amendment made by item [3] of Schedule 1 applies to information made publicly available on or after 1 April 2002.
- (2) The amendment made by item [19] of Schedule 1 does not apply to an application that has lapsed because of paragraph 142(2)(f) of the Act.
- (3) The amendment made by item [28] of Schedule 1 applies to an application made on or after 1 April 2002.

Patents Amendment Regulations 2002 (No. 4) (2002 No. 317)

4 Transitional

- (1) The amendments made by items [1] to [4] and [6] to [15] of Schedule 2 apply in relation to an international application if the

Endnote 3—Application, saving and transitional provisions

international filing date of the application is a date on or after 1 January 2003.

- (2) The amendments made by items [5] and [16] of Schedule 2 apply in relation to an international application if the applicable time limit under Article 22 or 39(1) of the PCT expires on or after 1 January 2003.

Note: *international application*, *international filing date* and *PCT* have the meanings given in the dictionary in Schedule 1 to the Act.

Patents Amendment Regulations 2003 (No. 3) (2003 No. 316)

4 Transitional

- (1) The amendments made by items [7] to [171] of Schedule 2 apply to an international application if the international filing date of the application is a date on or after 1 January 2004.
- (2) However:
- (a) the amendments made by items [50] and [171] of Schedule 2 do not apply to an international application that is filed before 1 January 2004 but is given an international filing date that is on or after 1 January 2004; and
 - (b) the amendments made by items [44], [104], [105], [106], [108], [114] to [125] and [166] of Schedule 2 also apply to an international application that was filed before 1 January 2004 if a demand for international preliminary examination of the application is filed on or after 1 January 2004; and
 - (c) the amendments made by items [143] to [145] of Schedule 2 also apply to an international application that was filed before 1 January 2004, for which an international preliminary examination report is established on or after 1 January 2004; and
 - (d) the amendment made by item [170] of Schedule 2 also applies to the giving, on or after 1 January 2004, of copies of an international preliminary examination report for an application that was filed before 1 January 2004.

Patents Amendment Regulations 2004 (No. 2) (2004 No. 193)

4 Transitional—amendments made by Schedule 2

- (1) This regulation applies to a PCT application that, before 1 July 2004 was not open to public inspection.
- (2) If the PCT application was filed before 1 January 2004, regulations 8.3, 8.4 and 13.5 of the *Patents Regulations 1991*, as in force immediately before 1 July 2004, continue to apply in relation to the application.
- (3) If the PCT application was filed after 31 December 2003 and published under Article 21 of the PCT before 1 July 2004, it is taken, for paragraph 90(b) of the Act as modified under regulation 8.3 of the *Patents Regulations 1991*, to have been published on 1 July 2004.

Patents Amendment Regulations 2004 (No. 4) (2004 No. 395)

4 Transitional

- (1) The amendments made by items [2] and [4] of Schedule 1 apply to an application in relation to which the applicant had not met the requirements of subsection 89(3) of the *Patents Act 1990* before these Regulations commence.
- (2) The amendment made by item [3] of Schedule 1 applies to an application in relation to which a patent request and complete specification had not been accepted under section 49 of the *Patents Act 1990* before these Regulations commence.
- (3) The amendments made by items [5] to [8] of Schedule 1 apply to requests for leave to amend in relation to which the Commissioner had not granted leave under regulation 10.5, and in respect of which the corresponding patent request and complete specification had not been accepted under section 49 of the *Patents Act 1990*, before these Regulations commence.
- (4) The amendment made by item [10] of Schedule 1 applies to an application for an innovation patent in relation to which a patent

Endnote 3—Application, saving and transitional provisions

request and complete specification had not been accepted under section 52 of the *Patents Act 1990* before these Regulations commence.

Patents Amendment Regulations 2005 (No. 1) (2005 No. 51)

4 Transitional

- (1) The amendments made by Schedule 1 apply to an entry in the Register made:
 - (a) on or after the commencement of these Regulations; and
 - (b) before the commencement of these Regulations.
- (2) The amendments made by items [2] to [23] of Schedule 2 apply to an international application if the international filing date of the application is a date on or after 1 April 2005.
- (3) However, the amendments made by items [10] and [18] to [21] of Schedule 2 also apply to an international application that was filed before 1 April 2005 if a demand for international preliminary examination of the application is filed on or after 1 April 2005.

Patents Amendment Regulations 2006 (No. 1) (2006 No. 55)

4 Transitional

- (1) The amendments made by Part 2 of Schedule 1 apply in relation to:
 - (a) an international application:
 - (i) the filing date of which occurred before 1 April 2006; and
 - (ii) that is published under Article 21 of the Patent Cooperation Treaty on or after 1 April 2006; and
 - (b) an international application the filing date of which occurs on or after 1 April 2006.
- (2) The amendments made by Part 3 of Schedule 1 apply in relation to:
 - (a) an international application:
 - (i) the filing date of which occurred before 1 April 2006; and

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Endnote 3—Application, saving and transitional provisions

- (ii) that is communicated under Article 20 of the Patent Cooperation Treaty on or after 1 April 2006; and
 - (b) an international application the filing date of which occurs on or after 1 April 2006.
- (3) The amendments made by Part 4 of Schedule 1 apply in relation to the issue, on or after 1 April 2006, of a Gazette in relation to an international application the filing date of which occurred at any time.
- (4) The amendments made by Part 5 of Schedule 1 apply in relation to:
- (a) the communication, on or after 1 April 2006, of an international application the filing date of which occurred at any time; and
 - (b) the communication, on or after 1 April 2006, of a Gazette in relation to an international application the filing date of which occurred at any time; and
 - (c) the communication, on or after 1 April 2006, of another publication in relation to an international application the filing date of which occurred at any time.

Intellectual Property Legislation Amendment Regulations 2007 (No. 1) (2007 No. 40)

8 Transitional provisions for Schedule 4—amendments of Patents Regulations 1991 commencing on 1 April 2007

- (1) Subject to subregulation (2), the amendments made by Schedule 4 apply to an international application whose filing date is on or after 1 April 2007.
- (2) An amendment made by an item of Schedule 4 mentioned in an item in table 1, to a provision of the Rules mentioned in that table, does not apply to an international application in respect of which 1 or more elements referred to in Article 11(1)(iii) were first received by the receiving Office before 1 April 2007.

Table 1

Item	Item of Schedule 4	Provision of the Rules
1	29	Rule 4.1(c)(iv)

Endnote 3—Application, saving and transitional provisions

Item	Item of Schedule 4	Provision of the Rules
2	31	Rule 4.18 Rule 4.19
3	35	Rule 12.1 ^{bis}
4	38	Rule 12.3
5	39	Rule 20.1 Rule 20.2 Rule 20.3 Rule 20.4 Rule 20.5 Rule 20.6 Rule 20.7 Rule 20.8
6	40	Rule 21.2
7	41	Rule 22.1
8	42	Rule 26.1 Rule 26.2
9	43 and 44	Rule 26.3 ^{ter}
10	45	Rule 26.4 Rule 26.5
11	55	Rule 48.2(b)(v)
12	58	Rule 51.1 Rule 51.2
13	59	Rule 51 ^{bis} .1(e)
14	61	Rule 55.2
15	69 and 70	Rule 76.5
16	71	Rule 82 ^{ter} .1

- (3) The amendments made by Schedule 4 do not apply to an international application whose filing date is before 1 April 2007, except as mentioned in subregulation (4).
- (4) For subregulation (3), an amendment made by an item of Schedule 4 mentioned in an item in table 2, to a provision of the Rules mentioned in that table, applies to an international application whose filing date is before 1 April 2007, in the

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Endnote 3—Application, saving and transitional provisions

circumstance or subject to the condition mentioned in the item in table 2.

Table 2

Item	Item of Schedule 4	Provision of the Rules	Circumstance or condition
1	48 and 49	Rule 34.1	Applies in relation to any international search carried out on or after 1 April 2007
2	52	Rule 43.4	Applies in relation to an international application in respect of which an international search report is established on or after 1 April 2007
3	53 54 65 66 67	Rule 43.6 ^{bis} Rule 43 ^{bis} .1(b) Rule 66.1(d) Rule 66.4 ^{bis} Rule 70.2(e)	Apply in relation to international search reports, written opinions and international preliminary examination reports established on or after 1 April 2007, as if references to rectifications of obvious mistakes authorised under Rule 91.1 were references to rectifications of obvious errors authorised under that Rule before 1 April 2007
4	56	Rule 48.3(c)	Applies in relation to an international application that is published under Article 21 on or after 1 April 2007
5	57	Rule 49 ^{ter} .2	Applies in respect of acts mentioned in Article 22 (1) that are performed on or after 1 April 2007
6	60 61 62 62	Rule 54 ^{bis} .1(a) Rule 55.2 (a ^{ter}) Rule 55.2(c) Rule 55.2(d)	Apply in relation to an international application in respect of which a demand for international preliminary examination is made on or after 1 April 2007

Endnote 3—Application, saving and transitional provisions

Item	Item of Schedule 4	Provision of the Rules	Circumstance or condition
7	70	Rule 76.5	Applies, to the extent that it has the effect of making Rule 49 ^{ter} .2 applicable, in respect of acts mentioned in Article 39 (1)(a) that are performed on or after 1 April 2007

- (5) In relation to the amendment made by item 39 of Schedule 4, information as to incompatibility given to the International Bureau under Rule 20.4(d) before 1 April 2007 is taken to remain effective under Rule 20.1(d) on or after 1 April 2007.
- (6) In relation to the amendment made by item 60 of Schedule 4, information as to incompatibility given to the International Bureau under Rule 51^{bis}.1(f) in relation to Rule 51^{bis}.1(e) before 1 April 2007 is taken to remain effective under Rule 51^{bis}.1(f) in relation to Rule 51^{bis}.1(e) on or after 1 April 2007.

Patents and Trade Marks Legislation Amendment Regulations 2008 (2008 No. 122)

5 Transitional

- (1) The amendments made by Schedules 1 and 2 apply to:
- (a) an application for registration received on or after 1 July 2008; and
 - (b) a disciplinary proceeding commenced on or after 1 July 2008.
- (2) For paragraph (1)(b), disciplinary proceedings are taken to have commenced on or before 30 June 2008 if, on or before that date, the Board has given written authority to a complainant to bring proceedings against a registered patent attorney.
- (3) If, on or before 30 June 2008:
- (a) a person has been granted an exemption from a requirement in Schedule 5 to the *Patents Regulations 1991*; or

Endnote 3—Application, saving and transitional provisions

- (b) the Board has decided that it is satisfied that a person has an academic qualification; or
 - (c) the Board has accredited a course of study; the exemption, decision or accreditation applies to that person or course, as if it had been exempted, decided or accredited under the relevant provision of the *Patents Regulations 1991*, as amended by these Regulations.
- (4) If, in the period starting on 1 July 2008 and ending at the end of 30 June 2009:
- (a) a person would have satisfied the employment requirements set out in regulation 20.3 of the *Patents Regulations 1991* immediately before the commencement of Schedule 1; and
 - (b) the person applies for registration as a patent attorney; the person is taken to meet the employment requirements.

Patents Amendment Regulations 2008 (No. 1) (2008 No. 178)

4 Transitional provision for international applications received or filed before commencement

- (1) Despite the amendment of Schedule 2A to the *Patents Regulations 1991* by Schedule 1 to these Regulations, Schedule 2A to the *Patents Regulations 1991*, as in force immediately before 1 July 2008, continues to apply in relation to an international application whose international filing date is earlier than 1 July 2008.
- (2) Despite the amendment of:
- (a) the Schedule of Fees in Schedule 2A to the *Patent Regulations 1991* by Schedule 1 to these Regulations; and
 - (b) Part 4 of Schedule 7 to the *Patents Regulations 1991* by Schedule 1 to these Regulations;
- the Schedule of Fees in Schedule 2A, and Part 4 of Schedule 7, to the *Patents Regulations 1991*, as in force immediately before 1 July 2008, continue to apply in relation to an international application:
- (c) whose international filing date is earlier than 1 July 2008; or
 - (d) that was received by the Patent Office before 1 July 2008.

Endnote 3—Application, saving and transitional provisions

**Intellectual Property Legislation Amendment Regulations 2008 (No. 1)
(2008 No. 279)**

3 Amendment of Patents Regulations 1991—Schedule 1

- (1) Schedule 1 amends the *Patents Regulations 1991*.
- (2) The amendments made by Schedule 1 apply in relation to an international application whose international filing date is on or after 1 January 2009.
- (3) The amendments made by items [1] to [5] and [7] to [17] of Schedule 1 also apply in relation to an international application if:
 - (a) the international filing date of the application is earlier than 1 January 2009; and
 - (b) the time limit for making a supplementary search request in relation to the application under Rule 45^{bis}.1(a) of Schedule 2A to the *Patents Regulations 1991*, as amended by Schedule 1 to these Regulations, expires on or after 1 January 2009.

**Intellectual Property Law Amendment Regulations 2009 (No. 1) (2009
No. 150)**

3 Amendment of Patents Regulations 1991—Schedule 1

- (1) Schedule 1 amends the *Patents Regulations 1991*.
- (2) The amendment made by item [3] of Schedule 1 applies in relation to an international application whose international filing date is on or after 1 July 2009.
- (3) The amendments made by items [4] to [7] of Schedule 1 apply in relation to an international application for which an amendment under Article 19 or 34 of the PCT is made on or after 1 July 2009.

**Intellectual Property Legislation Amendment Regulations 2011 (No. 1)
(2011 No. 62)**

3 Amendment of Patents Regulations 1991

- (1) Schedule 1 amends the *Patents Regulations 1991*.
- (2) The amendment of regulation 22.2EA of the *Patents Regulations 1991* made by item [7] of Schedule 1 applies in relation to request for leave to amend a complete specification:
 - (a) if:
 - (i) the request was made before the commencement of Schedule 1; and
 - (ii) on or after the commencement of Schedule 1, the Commissioner invites the person by whom the fee relating to the grant of leave is payable to pay the fee in accordance with regulation 22.2EA; or
 - (b) if the request is made on or after the commencement of Schedule 1.
- (3) The amendments made by items [8] to [10] of Schedule 1 apply in relation to a document filed on or after the commencement of Schedule 1.

4 Amendment of Patents Regulations 1991

- (1) Schedule 2 amends the *Patents Regulations 1991*.
- (2) The amendments made by items [5], [6], [8] to [12] and [14] of Schedule 2 apply in relation to an international application under the Patent Cooperation Treaty whose international filing date is on or after 1 July 2011.
- (3) The amendment made by item [7] of Schedule 2 applies in relation to an international application under the Patent Cooperation Treaty in respect of which:
 - (a) the applicant has performed the acts referred to in Article 22 or Article 39 of the Treaty on or after 1 July 2011; and
 - (b) an amendment under Article 19 or Article 34 of the Treaty was filed on or after 1 July 2009.

Endnote 3—Application, saving and transitional provisions

- (4) The amendment made by item [13] of Schedule 2 applies in relation to an international preliminary examination report under the Patent Cooperation Treaty which is completed in accordance with Rule 70.4 of the Treaty on or after 1 July 2011, irrespective of the international filing date of the relevant international application.

**Intellectual Property Legislation Amendment Regulations 2012 (No. 1)
(2012 No. 66)**

3 Amendment of Patents Regulations 1991

- (1) Schedule 1 amends the *Patents Regulations 1991*.
- (2) The amendments made by Part 1 of Schedule 1 apply in relation to a declaration required or permitted by the *Patents Act 1990* or the *Patents Regulations 1991* on or after 1 July 2012.
- (3) The amendment made by item [9] of Schedule 1 applies to an international application under the Patent Cooperation Treaty, irrespective of its international filing date, in respect of which the time limit under amended Rule 17.1(b-*bis*) expires on or after 1 July 2012.
- (4) The amendment made by item [10] of Schedule 1 applies to an international application under the Patent Cooperation Treaty whose international filing date is on or after 1 July 2012.
- (5) The amendments made by items [11] and [12] of Schedule 1 apply to an international application under the Patent Cooperation Treaty, irrespective of its international filing date, in respect of which an international search is carried out on or after 1 July 2012.
- (6) Despite the omission of Rule 82.2 by item [13] of Schedule 1, Rule 82.2 as in force immediately before the commencement of Schedule 1 continues to apply to an international application under the Patent Cooperation Treaty whose international filing date is before 1 July 2012, and in relation to which the six months time limit for the submission of evidence referred to in Rule 82.1(c), as applicable because of Rule 82.2(b) (in force immediately before the commencement of Schedule 1), expires on or after 1 July 2012.

Endnotes

Endnote 3—Application, saving and transitional provisions

- (7) The amendment made by item [14] of Schedule 1 applies to an international application under the Patent Cooperation Treaty, irrespective of its international filing date, in relation to which the six months time limit for the submission of evidence referred to in Rule 82quater.1(a) (inserted by item [14]) expires on or after 1 July 2012.

Endnote 4—Uncommenced amendments

Endnote 4—Uncommenced amendments

This endnote sets out amendments of the *Patents Regulations 1991* that have not yet commenced.

There are no uncommenced amendments.

Endnotes

Endnote 5—Misdescribed amendments

Endnote 5—Misdescribed amendments

This endnote sets out amendments of the *Patents Regulations 1991* that have been misdescribed.

There are no misdescribed amendments.