



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

Select Legislative Instrument 2008 No. 279

I, QUENTIN BRYCE, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following Regulations under the *Patents Act 1990*, the *Trade Marks Act 1995* and the *Designs Act 2003*.

Dated 12 December 2008

QUENTIN BRYCE
Governor-General

By Her Excellency's Command

KIM CARR
Minister for Innovation, Industry, Science and Research

Contents

1	Name of Regulations	3
2	Commencement	3
3	Amendment of <i>Patents Regulations 1991</i> — Schedule 1	3
4	Amendment of <i>Patents Regulations 1991</i> — Schedule 2	3
5	Amendment of <i>Trade Marks Regulations 1995</i> — Schedule 3	3
6	Amendment of <i>Designs Regulations 2004</i> — Schedule 4	3
Schedule 1	Amendments of <i>Patents Regulations 1991</i> relating to the Patent Cooperation Treaty	4
Schedule 2	Other amendments of <i>Patents Regulations 1991</i>	14
Schedule 3	Amendments of <i>Trade Marks Regulations 1995</i>	18
Schedule 4	Amendments of <i>Designs Regulations 2004</i>	19

1 Name of Regulations

These Regulations are the *Intellectual Property Legislation Amendment Regulations 2008 (No. 1)*.

2 Commencement

These Regulations commence on 1 January 2009.

**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.

**4 Amendment of *Patents Regulations 1991* —
Schedule 2**

Schedule 2 amends the *Patents Regulations 1991*.

**5 Amendment of *Trade Marks Regulations 1995* —
Schedule 3**

Schedule 3 amends the *Trade Marks Regulations 1995*.

**6 Amendment of *Designs Regulations 2004* —
Schedule 4**

Schedule 4 amends the *Designs Regulations 2004*.

Schedule 1 Amendments of *Patents Regulations 1991* relating to the Patent Cooperation Treaty
(regulation 3)

[1] Subregulation 1.4 (2)

omit

1 April 2007

insert

1 January 2009

[2] Schedule 2A, before Table of Provisions

omit

and on 1 July 2008.

insert

on 1 July 2008, and on 1 January 2009.

[3] Schedule 2A, Table of Provisions, after Rule 45.1

insert

- Rule 45^{bis} Supplementary International Searches
- 45^{bis}.1 Supplementary Search Request
- 45^{bis}.2 Supplementary Search Handling Fee
- 45^{bis}.3 Supplementary Search Fee
- 45^{bis}.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to International Searching Authority
- 45^{bis}.5 Start, Basis and Scope of Supplementary International Search

-
- 45^{bis}.6 Unity of Invention
 - 45^{bis}.7 Supplementary International Search Report
 - 45^{bis}.8 Transmittal and Effect of the Supplementary
International Search Report
 - 45^{bis}.9 International Searching Authorities Competent to Carry
Out Supplementary International Search

[4] Schedule 2A, Table of Provisions, after Rule 90^{bis}.3

insert

- 90^{bis}.3^{bis} Withdrawal of Supplementary Search Request

[5] Schedule 2A, after Rule 45.1

insert

*Rule 45^{bis}
Supplementary International Searches*

45^{bis}.1 *Supplementary Search Request*

(a) The applicant may, at any time prior to the expiration of 19 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45^{bis}.9. Such requests may be made in respect of more than one such Authority.

(b) A request under paragraph (a) ("supplementary search request") shall be submitted to the International Bureau and shall indicate:

- (i) the name and address of the applicant and of the agent (if any), the title of the invention, the international filing date and the international application number;
- (ii) the International Searching Authority that is requested to carry out the supplementary international search ("Authority specified for supplementary search"); and
- (iii) where the international application was filed in a language which is not accepted by that Authority, whether any translation furnished to the receiving Office under Rule 12.3 or 12.4 is to form the basis of the supplementary international search.

(c) The supplementary search request shall, where applicable, be accompanied by:

- (i) where neither the language in which the international application was filed nor that in which a translation (if any) has been furnished under Rule 12.3 or 12.4 is accepted by the Authority specified for supplementary search, a translation of the international application into a language which is accepted by that Authority;

- (ii) preferably, a copy of a sequence listing in electronic form complying with the standard provided for in the Administrative Instructions, if required by the Authority specified for supplementary search.

(d) Where the International Searching Authority has found that the international application does not comply with the requirement of unity of invention, the supplementary search request may contain an indication of the wish of the applicant to limit the supplementary international search to one of the inventions as identified by the International Searching Authority other than the main invention referred to in Article 17(3)(a).

(e) The supplementary search request shall be considered not to have been submitted, and the International Bureau shall so declare:

- (i) if it is received after the expiration of the time limit referred to in paragraph (a); or
- (ii) if the Authority specified for supplementary search has not stated, in the applicable agreement under Article 16(3)(b), its preparedness to carry out such searches or is not competent to do so under Rule 45^{bis}.9(b).

45^{bis}.2 Supplementary Search Handling Fee

(a) The supplementary search request shall be subject to the payment of a fee for the benefit of the International Bureau ("supplementary search handling fee") as set out in the Schedule of Fees.

(b) The supplementary search handling fee shall be paid in the currency in which the fee is set out in the Schedule of Fees or in any other currency prescribed by the International Bureau. The amount in such other currency shall be the equivalent, in round figures, as established by the International Bureau, of the amount as set out in the Schedule of Fees, and shall be published in the Gazette.

(c) The supplementary search handling fee shall be paid to the International Bureau within one month from the date of receipt of the supplementary search request. The amount payable shall be the amount applicable on the date of payment.

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45^{bis}.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

45^{bis}.3 Supplementary Search Fee

(a) Each International Searching Authority carrying out supplementary international searches may require that the applicant pay a fee ("supplementary search fee") for its own benefit for carrying out such a search.

(b) The supplementary search fee shall be collected by the International Bureau. Rules 16.1(b) to (e) shall apply *mutatis mutandis*.

(c) As to the time limit for payment of the supplementary search fee and the amount payable, the provisions of Rule 45^{bis}.2(c) shall apply *mutatis mutandis*.

(d) The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45^{bis}.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or considered not to have been submitted.

(e) The Authority specified for supplementary search shall, to the extent and under the conditions provided for in the applicable agreement under Article 16(3)(b), refund the supplementary search fee if, before it has started the supplementary international search in accordance with Rule 45^{bis}.5(a), the supplementary search request is considered not to have been submitted.

45^{bis}.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to International Searching Authority

(a) Promptly after receipt of a supplementary search request, the International Bureau shall check whether it complies with the requirements of Rule 45^{bis}.1(b) and (c)(i) and shall invite the applicant to correct any defects within a time limit of one month from the date of the invitation.

(b) Where, by the time they are due under Rules 45^{bis}.2(c) and 45^{bis}.3(c), the International Bureau finds that the supplementary search handling fee and the supplementary search fee have not been paid in full, it shall invite the applicant to pay to it the amount required to cover those fees, together with the late payment fee under paragraph (c), within a time limit of one month from the date of the invitation.

(c) The payment of fees in response to an invitation under paragraph (b) shall be subject to the payment to the International Bureau, for its own benefit, of a late payment fee whose amount shall be 50% of the supplementary search handling fee.

(d) If the applicant does not furnish the required correction or does not pay the amount in full of the fees due, including the late payment fee, before the expiration of the time limit applicable under paragraph (a) or (b), respectively, the supplementary search request shall be considered not to have been submitted and the International Bureau shall so declare and shall inform the applicant accordingly.

(e) On finding that the requirements of Rule 45^{bis}.1(b) and (c)(i), 45^{bis}.2(c) and 45^{bis}.3(c) have been complied with, the International Bureau shall promptly, but not before the date of receipt by it of the international search report or the expiration of 17 months from the priority date, whichever occurs first, transmit to the Authority specified for supplementary search a copy of each of the following:

- (i) the supplementary search request;
- (ii) the international application;
- (iii) any sequence listing furnished under Rule 45^{bis}.1(c)(ii); and
- (iv) any translation furnished under Rule 12.3, 12.4 or 45^{bis}.1(c)(i) which is to be used as the basis of the supplementary international search;

and, at the same time, or promptly after their later receipt by the International Bureau:

- (v) the international search report and the written opinion established under Rule 43^{bis}.1;
- (vi) any invitation by the International Searching Authority to pay additional fees referred to in Article 17(3)(a); and
- (vii) any protest by the applicant under Rule 40.2(c) and the decision thereon by the review body constituted in the framework of the International Searching Authority.

(f) Upon request of the Authority specified for supplementary search, the written opinion referred to in paragraph (e)(v) shall, when not in English or in a language accepted by that Authority, be translated into English by or under the responsibility of the International Bureau. The International Bureau shall transmit a copy of the translation to that Authority within two months from the date of receipt of the request for translation, and shall at the same time transmit a copy to the applicant.

45^{bis}.5 Start, Basis and Scope of Supplementary International Search

(a) The Authority specified for supplementary search shall start the supplementary international search promptly after receipt of the documents specified in Rule 45^{bis}.4(e)(i) to (iv), provided that the Authority may, at its option, delay the start of the search until it has also received the documents specified in Rule 45^{bis}.4(e)(v) or until the expiration of 22 months from the priority date, whichever occurs first.

(b) The supplementary international search shall be carried out on the basis of the international application as filed or of a translation referred to in Rule 45^{bis}.1(b)(iii) or 45^{bis}.1(c)(i), taking due account of the international search report and the written opinion established under Rule 43^{bis}.1 where they are available to the Authority specified for supplementary search before it starts the search. Where the supplementary search request contains an indication under Rule 45^{bis}.1(d), the supplementary international search may be limited to the invention specified by the applicant under Rule 45^{bis}.1(d) and those parts of the international application which relate to that invention.

(c) For the purposes of the supplementary international search, Article 17(2) and Rules 13^{ter}.1, 33 and 39 shall apply *mutatis mutandis*.

(d) Where the international search report is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may exclude from the supplementary search any claims which were not the subject of the international search.

(e) Where the International Searching Authority has made the declaration referred to in Article 17(2)(a) and that declaration is available to the Authority specified for supplementary search before it starts the search under paragraph (a), that Authority may decide not to establish a supplementary international search report, in which case it shall so declare and promptly notify the applicant and the International Bureau accordingly.

(f) The supplementary international search shall cover at least the documentation indicated for that purpose in the applicable agreement under Article 16(3)(b).

(g) If the Authority specified for supplementary search finds that carrying out the search is excluded by a limitation or condition referred to in Rule 45^{bis}.9(a), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

45^{bis}.6 Unity of Invention

(a) If the Authority specified for supplementary search finds that the international application does not comply with the requirement of unity of invention, it shall:

- (i) establish the supplementary international search report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention");
- (ii) notify the applicant of its opinion that the international application does not comply with the requirement of unity of invention and specify the reasons for that opinion; and

(iii) inform the applicant of the possibility of requesting, within the time limit referred to in paragraph (c), a review of the opinion.

(b) In considering whether the international application complies with the requirement of unity of invention, the Authority shall take due account of any documents received by it under Rule 45^{bis}.4(e)(vi) and (vii) before it starts the supplementary international search.

(c) The applicant may, within one month from the date of the notification under paragraph (a)(ii), request the Authority to review the opinion referred to in paragraph (a). The request for review may be subjected by the Authority to the payment to it, for its own benefit, of a review fee whose amount shall be fixed by it.

(d) If the applicant, within the time limit under paragraph (c), requests a review of the opinion by the Authority and pays any required review fee, the opinion shall be reviewed by the Authority. The review shall not be carried out only by the person who made the decision which is the subject of the review. Where the Authority:

- (i) finds that the opinion was entirely justified, it shall notify the applicant accordingly;
- (ii) finds that the opinion was partially unjustified but still considers that the international application does not comply with the requirement of unity of invention, it shall notify the applicant accordingly and, where necessary, proceed as provided for in paragraph (a)(i);
- (iii) finds that the opinion was entirely unjustified, it shall notify the applicant accordingly, establish the supplementary international search report on all parts of the international application and refund the review fee to the applicant.

(e) On the request of the applicant, the text of both the request for review and the decision thereon shall be communicated to the designated Offices together with the supplementary international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* where the Authority specified for supplementary search decides to limit the supplementary international search in accordance with the second sentence of Rule 45^{bis}.5(b), provided that any reference in the said paragraphs to the "international application" shall be construed as a reference to those parts of the international application which relate to the invention specified by the applicant under Rule 45^{bis}.1(d).

45^{bis}.7 Supplementary International Search Report

(a) The Authority specified for supplementary search shall, within 28 months from the priority date, establish the supplementary international search report, or make the declaration referred to in Article 17(2)(a) as applicable by virtue of Rule 45^{bis}.5(c) that no supplementary international search report will be established.

(b) Every supplementary international search report, any declaration referred to in Article 17(2)(a) as applicable by virtue of Rule 45^{bis}.5(c) and any declaration under Rule 45^{bis}.5(e) shall be in a language of publication.

(c) For the purposes of establishing the supplementary international search report, Rules 43.1, 43.2, 43.5, 43.6, 43.6^{bis}, 43.8 and 43.10 shall, subject to paragraphs (d) and (e), apply *mutatis mutandis*. Rule 43.9 shall apply *mutatis mutandis*, except that the references therein to Rules 43.3, 43.7 and 44.2 shall be considered non-existent. Article 20(3) and Rule 44.3 shall apply *mutatis mutandis*.

(d) The supplementary international search report need not contain the citation of any document cited in the international search report, except where the document needs to be cited in conjunction with other documents that were not cited in the international search report.

(e) The supplementary international search report may contain explanations:

- (i) with regard to the citations of the documents considered to be relevant;
- (ii) with regard to the scope of the supplementary international search.

45^{bis}.8 Transmittal and Effect of the Supplementary International Search Report

(a) The Authority specified for supplementary search shall, on the same day, transmit one copy of the supplementary international search report or the declaration that no supplementary international search report shall be established, as applicable, to the International Bureau and one copy to the applicant.

(b) Subject to paragraph (c), Article 20(1) and Rules 45.1, 47.1(d) and 70.7(a) shall apply as if the supplementary international search report were part of the international search report.

(c) A supplementary international search report need not be taken into account by the International Preliminary Examining Authority for the purposes of a written opinion or the international preliminary examination report if it is received by that Authority after it has begun to draw up that opinion or report.

45^{bis}.9 International Searching Authorities Competent to Carry Out Supplementary International Search

(a) An International Searching Authority shall be competent to carry out supplementary international searches if its preparedness to do so is stated in the applicable agreement under Article 16(3)(b), subject to any limitations and conditions set out in that agreement.

(b) The International Searching Authority carrying out the international search under Article 16(1) in respect of an international application shall not be competent to carry out a supplementary international search in respect of that application.

(c) The limitations referred to in paragraph (a) may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, beyond those which would apply under Article 17(2) to the international search, and limitations as to the total number of supplementary international searches which will be carried out in a given period.

[6] Schedule 2A, Rule 48.3(a)

after

Japanese,

insert

Korean, Portuguese,

[7] Schedule 2A, Rule 90.1(a)

after

the International Searching Authority

insert

, any Authority specified for supplementary search

[8] Schedule 2A, after Rule 90.1(b)

insert

(*b-bis*) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.

[9] Schedule 2A, Rule 90.1(d)(i)

after

the International Searching Authority

insert

, any Authority specified for supplementary search

[10] Schedule 2A, Rule 90.1(d)(ii)

substitute

- (ii) specifically before the International Searching Authority, any Authority specified for supplementary search or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, the Authority specified for supplementary search or International Preliminary Examining Authority, as the case may be.

[11] Schedule 2A, Rule 90.4(b)

substitute

(b) Subject to Rule 90.5, a separate power of attorney shall be submitted to either the receiving Office or the International Bureau, provided that, where a power of attorney appoints an agent under Rule 90.1(b), (*b-bis*), (c) or (d)(ii), it shall be submitted to the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

[12] Schedule 2A, Rule 90.4(d)

after

any International Searching Authority,

insert

any Authority competent to carry out supplementary searches,

[13] Schedule 2A, Rule 90.5(b), (c) and (d)

substitute

(b) The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (b-*bis*), (c) or (d)(ii), it shall be deposited with the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

(c) Any receiving Office, any International Searching Authority, any Authority competent to carry out supplementary searches and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

(d) Notwithstanding paragraph (c), where the agent submits any notice of withdrawal referred to in Rules 90^{bis}.1 to 90^{bis}.4 to the receiving Office, the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be, a copy of the general power of attorney shall be submitted to that Office or Authority.

[14] Schedule 2A, after Rule 90^{bis}.3

insert

90^{bis}.3^{bis} Withdrawal of Supplementary Search Request

(a) The applicant may withdraw a supplementary search request at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45^{bis}.8(a), of the supplementary international search report or the declaration that no such report will be established.

(b) Withdrawal shall be effective on receipt, within the time limit under paragraph (a), of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in paragraph (a), the communication of that report or declaration under Article 20(1), as applicable by virtue of Rule 45^{bis}.8(b), shall nevertheless be effected.

[15] Schedule 2A, Rule 90^{bis}.5(b)(i)

after

the International Bureau

insert

, the Authority carrying out the supplementary international search

[16] Schedule 2A, Rule 90^{bis}.5(b)(ii)

omit

90^{bis}.2 (d) or 90^{bis}.3 (c),

insert

90^{bis}.2 (d), 90^{bis}.3 (c) or 90^{bis}.3^{bis} (b)

[17] Schedule 2A, after Rule 90^{bis}.6(b)

insert

(*b-bis*) Where a supplementary search request is withdrawn under Rule 90^{bis}.3^{bis}, the supplementary international search by the Authority concerned shall be discontinued.

Schedule 2 **Other amendments of *Patents Regulations 1991***

(regulation 4)

[1] Subregulation 1.3 (1), after definition of *certificate of verification*

insert

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.

[2] Subregulations 1.6 (1), (1A) and (1B)

substitute

(1) For section 8 of the Act:

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

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

[3] Subparagraph 3.5A (3) (b) (iii)

substitute

- (iii) if the earlier application is not in English — a translation of the application into English together with a related certificate of verification.

[4] Subregulation 3.18 (3) (b)

omit everything before subparagraph (i), insert

- (b) whether the specification under modified examination is the same as the specification (the *foreign specification*) relating to the patent granted in the prescribed foreign country, apart from:

[5] Subregulation 3.20 (6)

after

The applicant must

insert

, on request by the Commissioner,

[6] Paragraph 3.20 (6) (a)

omit

official chief or head of the Patent Office

insert

competent authority

[7] After regulation 3.21

insert

3.22 Disclosure of patent documents and information to International Bureau etc

- (1) The Commissioner may, before a patent application becomes open to public inspection, disclose any or all of the following to the International Bureau or a foreign patent office:
- (a) the patent application;
 - (b) a document given by the applicant to the Commissioner in connection with the application;
 - (c) information in the possession of the Commissioner relating to the applicant or the application.

- (2) However, 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.

[8] Paragraph 8.6 (1) (c)

omit

official chief or head of the Patent Office

insert

foreign patent office

[9] Subregulation 8.6 (2)

substitute

- (2) For subsection 95 (3) of the Act, the Commissioner may request a copy of the specification relating to the basic application that has been certified by the competent authority of the Convention country in which the basic application was made.
- (3) The certified copy must be filed within 3 months from the date on which the Commissioner requests it.

[10] Paragraph 9A.4 (d)

substitute

- (d) if the Commissioner requests:
- (i) a translation of a specification or other document under subregulation 1.6 (1); or
 - (ii) a certified copy of a specification under subregulation 8.6 (2);
- the period of 5 months from the date on which the request is made;

[11] Paragraph 13.4 (1) (k)

omit

subparagraph 1.6 (1) (b) (ii) or paragraph 1.6 (1A) (b)

insert

subregulation 1.6 (1) or subregulation 8.6 (2)

[12] Subregulation 20.52 (3), note

omit

opf

insert

of

[13] Schedule 4

omit

Bosnia and Herzegovina

insert

Bosnia and Herzegovina

[14] Schedule 4

after

Canada

insert

Cape Verde

[15] Schedule 6

omit

Schedule 3 Amendments of *Trade Marks Regulations 1995*

(regulation 5)

[1] Schedule 10

omit

Bosnia and Herzegovina

insert

Bosnia and Herzegovina

[2] Schedule 10

after

Canada

insert

Cape Verde

Schedule 4 Amendments of *Designs Regulations 2004*

(regulation 6)

[1] Schedule 1

omit

Bosnia and Herzegovina

insert

Bosnia and Herzegovina

[2] Schedule 1

after

Canada

insert

Cape Verde

Note

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