



# Intellectual Property Law Amendment Regulations 2009 (No. 2)<sup>1</sup>

## Select Legislative Instrument 2009 No. 332

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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 25 November 2009

QUENTIN BRYCE  
Governor-General

By Her Excellency's Command

KIM CARR  
Minister for Innovation, Industry, Science and Research

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**1 Name of Regulations**

These Regulations are the *Intellectual Property Law Amendment Regulations 2009 (No. 2)*.

**2 Commencement**

These Regulations commence on 12 December 2009.

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

Schedule 1 amends the *Patents Regulations 1991*.

**4 Amendment of *Trade Marks Regulations 1995***

Schedule 2 amends the *Trade Marks Regulations 1995*.

**5 Amendment of *Designs Regulations 2004***

Schedule 3 amends the *Designs Regulations 2004*.

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## Schedule 1      **Amendments of *Patents Regulations 1991***

(regulation 3)

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

*insert*

***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”.

**[2]      Regulation 1.6, heading**

*substitute*

**1.6      Disclosure in basic applications — general**

**[3]      After regulation 1.6**

*insert*

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

- (1) For section 8 of the Act, a specification or other document is taken to have been filed in respect of, and at the same time as, a basic application if:
  - (a) the Commissioner is satisfied that a copy of the specification or document has been made available for inspection by the Commissioner in an approved digital library; and

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

**[4] After regulation 1.7**

*insert*

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

*Example*

An online application facility.

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**[5] Regulation 3.2A**

*substitute*

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

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

- (4) If:
  - (a) the Commissioner gives the applicant a direction under subregulation (3) to assist the Commissioner in deciding whether a filed abstract is in accordance with these Regulations; and
  - (b) the Commissioner has specified in the direction a period of not less than 1 month within which the applicant must comply with the direction; and
  - (c) the applicant does not comply with the direction before the end of the period;the complete application to which the patent request and complete specification relate lapses at the end of the period.

- (5) Subject to subregulation (4 ), if an applicant to whom a direction has been given under subregulation (3) does not comply with the direction within 2 months from the date of the direction, the application lapses.
- (6) If an application lapses under subregulation (4 ) or (5), the Commissioner must:
  - (a) advertise that fact in the *Official Journal*; and
  - (b) tell the applicant that the complete application has lapsed.

**[6] Regulation 3.22**

*substitute*

**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.

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

**[7] Paragraph 4.3 (1) (d)**

*omit*

**[8] Regulation 8.6, heading**

*substitute*

**8.6 Particulars required for Convention application — general**

**[9] After regulation 8.6**

*insert*

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

- (1) For subregulation 8.6 (3), a certified copy is taken to have been filed if the Commissioner is satisfied that the certified copy:
- (a) has been made available for inspection by the Commissioner in an approved digital library; and
  - (b) was made available within the period mentioned in subregulation 8.6 (3).
- (2) However, if the Commissioner is satisfied that the certified copy:
- (a) was made available for inspection by the Commissioner in the approved digital library within the period mentioned in subregulation 8.6 (3); but

(b) is no longer available for inspection;  
the certified copy is taken to have been filed in respect of, and at the same time as, the basic application only if the certified copy is again made available for inspection by the Commissioner in the approved digital library, or given to the Commissioner, no later than 2 months after the day on which the Commissioner notifies the applicant or patentee that the Commissioner has not been able to inspect the certified copy in the approved digital library.

**[10] Regulation 22.8A**

*omit*

**[11] Subregulation 22.16 (1), definition of *document***

*substitute*

***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.

**[12] Schedule 3, heading**

*substitute*

**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))



## **Schedule 2      Amendments of *Trade Marks Regulations 1995***

(regulation 4)

**[1]      Subregulation 21.2 (3)**

*omit*

**[2]      Subregulation 21.2 (5)**

*omit*

**Schedule 3 Amendment of *Designs Regulations 2004***

(regulation 5)

**[1] Regulation 11.17**

*omit*

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**Note**

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