



Patents Amendment Regulations 2008 (No. 1)¹

Select Legislative Instrument 2008 No. 178

I, PHILIP MICHAEL JEFFERY, 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*.

Dated 29 August 2008

P. M. JEFFERY
Governor-General

By His Excellency's Command

KIM CARR
Minister for Innovation, Industry, Science and Research

1 Name of Regulations

These Regulations are the *Patents Amendment Regulations 2008 (No. 1)*.

2 Commencement

These Regulations are taken to have commenced on 1 July 2008.

3 Amendment of *Patents Regulations 1991*

Schedule 1 amends the *Patents Regulations 1991*.

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.

Schedule 1 Amendments taken to have commenced on 1 July 2008

(regulation 3)

[1] Schedule 2A, before Table of Provisions

omit

and on 1 April 2007.

insert

on 1 April 2007, and on 1 July 2008.

[2] Schedule 2A, Table of Provisions, Rule 4.11

substitute

4.11 Reference to Continuation or Continuation-in-Part, or
Parent Application or Grant

4.12 Taking into Account Results of Earlier Search

[3] Schedule 2A, Table of Provisions, before Rule 13

insert

Rule 12^{bis} Copy of Results of Earlier Search and of Earlier
Application; Translation

12^{bis}.1 Copy of Results of Earlier Search and of Earlier
Application; Translation

[4] Schedule 2A, Table of Provisions, Rules 41 and 41.1

substitute

Rule 41 Taking into Account Results of Earlier Search

41.1 Taking into Account Results of Earlier Search

[5] Schedule 2A, Rule 4.1 (b) (ii)*substitute*

- (ii) indications relating to an earlier search as provided in Rules 4.12 (i) and 12^{bis}.1 (c) and (f),

[6] Schedule 2A, Rule 4.1 (c) (v)*substitute*

- (v) a request for restoration of the right of priority,
- (vi) a statement as provided in Rule 4.12 (ii).

[7] Schedule 2A, Rule 4.11*substitute***4.11 Reference to Continuation or Continuation-in-Part, or Parent Application or Grant****(a) If:**

- (i) the applicant intends to make an indication under Rule 49^{bis}.1 (a) or (b) of the wish that the international application be treated, in any designated State, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition; or
- (ii) the applicant intends to make an indication under Rule 49^{bis}.1 (d) of the wish that the international application be treated, in any designated State, as an application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall indicate the relevant parent application or parent patent or other parent grant.

(b) The inclusion in the request of an indication under paragraph (a) shall have no effect on the operation of Rule 4.9.

4.12 Taking into Account Results of Earlier Search

If the applicant wishes the International Searching Authority to take into account, in carrying out the international search, the results of an earlier international, international-type or national search carried out by the same or another International Searching Authority or by a national Office ("earlier search"):

- (i) the request shall so indicate and shall specify the Authority or Office concerned and the application in respect of which the earlier search was carried out;
- (ii) the request may, where applicable, contain a statement to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language.

[8] Schedule 2A, before Rule 13*insert**Rule 12^{bis}**Copy of Results of Earlier Search
and of Earlier Application; Translation**12^{bis}.1 Copy of Results of Earlier Search and of Earlier Application; Translation*

(a) Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search carried out by the same or another International Searching Authority or by a national Office, the applicant shall, subject to paragraphs (c) to (f), submit to the receiving Office, together with the international application, a copy of the results of the earlier search, in whatever form (for example, in the form of a search report, a listing of cited prior art or an examination report) they are presented by the Authority or Office concerned.

(b) The International Searching Authority may, subject to paragraphs (c) to (f), invite the applicant to furnish to it, within a time limit which shall be reasonable under the circumstances:

- (i) a copy of the earlier application concerned;
- (ii) where the earlier application is in a language which is not accepted by the International Searching Authority, a translation of the earlier application into a language which is accepted by that Authority;
- (iii) where the results of the earlier search are in a language which is not accepted by the International Searching Authority, a translation of those results into a language which is accepted by that Authority;
- (iv) a copy of any document cited in the results of the earlier search.

(c) Where the earlier search was carried out by the same Office as that which is acting as the receiving Office, the applicant may, instead of submitting the copies referred to in paragraphs (a) and (b) (i) and (iv), indicate the wish that the receiving Office prepare and transmit them to the International Searching Authority. Such request shall be made in the request and may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee.

(d) Where the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, no copy or translation referred to in paragraphs (a) and (b) shall be required to be submitted under those paragraphs.

(e) Where the request contains a statement under Rule 4.12 (ii) to the effect that the international application is the same, or substantially the same, as the application in respect of which the earlier search was carried out, or that the international application is the same, or substantially the same, as that earlier application except that it is filed in a different language, no copy or translation referred to in paragraphs (b) (i) and (ii) shall be required to be submitted under those paragraphs.

(f) Where a copy or translation referred to in paragraphs (a) and (b) is available to the International Searching Authority in a form and manner acceptable to it, for example, from a digital library or in the form of the priority document, and the applicant so indicates in the request, no copy or translation shall be required to be submitted under those paragraphs.

[9] Schedule 2A, Rule 16.3*substitute***16.3 Partial Refund**

Where the International Searching Authority takes into account, under Rule 41.1, the results of an earlier search in carrying out the international search, that Authority shall refund the search fee paid in connection with the international application to the extent and under the conditions provided for in the agreement under Article 16 (3) (b).

[10] Schedule 2A, Rule 26^{bis}.3 (d)*substitute*

(d) The submission of a request under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration, payable within the time limit applicable under paragraph (e). The amount of that fee, if any, shall be fixed by the receiving Office. The time limit for payment of the fee may be extended, at the option of the receiving Office, for a period of up to two months from the expiration of the time limit applicable under paragraph (e).

[11] Schedule 2A, Rule 29.1 (iv)*substitute*

- (iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy;
- (v) no international publication of the international application shall be effected if the notification of the said declaration transmitted by the receiving Office reaches the International Bureau before the technical preparations for international publication have been completed.

[12] Schedule 2A, Rule 41*substitute**Rule 41**Taking into Account Results of Earlier Search***41.1 Taking into Account Results of Earlier Search**

Where the applicant has, under Rule 4.12, requested the International Searching Authority to take into account the results of an earlier search and has complied with Rule 12^{bis}.1 and:

- (i) the earlier search was carried out by the same International Searching Authority, or by the same Office as that which is acting as the International Searching Authority, the International Searching Authority shall, to the extent possible, take those results into account in carrying out the international search;

- (ii) the earlier search was carried out by another International Searching Authority, or by an Office other than that which is acting as the International Searching Authority, the International Searching Authority may take those results into account in carrying out the international search.

[13] Schedule 2A, Schedule of Fees

substitute

SCHEDULE OF FEES

Fees	Amounts
1. International filing fee: (Rule 15.2)	1,330 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling fee: (Rule 57.2)	200 Swiss francs

Reductions

3. 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
4. The international filing fee (where applicable, as reduced under item 3) 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
 - (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;

Fees**Amounts**

provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).

[14] Schedule 7, Part 4

substitute

Part 4 Fees payable for the benefit of the 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

Item	Matter	Fee
404	<p>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:</p> <p>(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</p> <p>(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;</p> <p>provided that, if there are several applicants, each must satisfy the criteria set out in either sub-item (a) or (b).</p>	

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>.