



Patents Amendment Regulations 2010 (No. 1)¹

Select Legislative Instrument 2010 No. 181

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*.

Dated 29 June 2010

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 *Patents Amendment Regulations 2010 (No. 1)*.

2 Commencement

These Regulations commence as follows:

- (a) on 1 July 2010 — regulations 1 to 3 and Schedule 1;
- (b) on 1 August 2010 — regulation 4 and Schedule 2.

**3 Amendment of *Patents Regulations 1991* —
Schedule 1**

Schedule 1 amends the *Patents Regulations 1991*.

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

Schedule 2 amends the *Patents Regulations 1991*.

Schedule 1 Amendments commencing on 1 July 2010

(regulation 3)

[1] Subregulation 1.4 (2)

omit

1 July 2009

insert

1 July 2010

[2] Paragraph 8.4 (2) (d)

omit

[3] Schedule 2A, before Table of Provisions

substitute

Adopted on June 19, 1970, and amended on April 14, 1978, October 3, 1978, May 1, 1979, June 16, 1980, September 26, 1980, July 3, 1981, September 10, 1982, October 4, 1983, February 3, 1984, September 28, 1984, October 1, 1985, July 12, 1991, October 2, 1991, September 29, 1992, September 29, 1993, October 3, 1995, October 1, 1997, September 15, 1998, September 29, 1999, March 17, 2000, October 3, 2000, October 3, 2001, October 1, 2002, October 1, 2003, October 5, 2004, October 5, 2005, October 3, 2006, November 12, 2007, May 15, 2008, September 29, 2008, 1 January, 2009, 1 July, 2009 and 1 July, 2010.

[4] Schedule 2A, Table of Provisions

omit

15.4 Time Limit for Payment; Amount Payable

15.6 Refund

insert

15.3 Time Limit for Payment; Amount Payable

15.4 Refund

[5] Schedule 2A, Table of Provisions*omit*

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

insert

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

[6] Schedule 2A, Table of Provisions*omit*

57.6 Refund

insert

57.4 Refund

[7] Schedule 2A, Rules 15.2(b) to (d)*substitute*

(b) The international filing fee shall be payable in the currency or one of the currencies prescribed by the receiving Office ("prescribed currency").

(c) Where the prescribed currency is the Swiss franc, the receiving Office shall promptly transfer the said fee to the International Bureau in Swiss francs.

(d) Where the prescribed currency is a currency other than the Swiss franc and that currency:

- (i) is freely convertible into Swiss francs, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the international filing fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Bureau;
- (ii) is not freely convertible into Swiss francs, the receiving Office shall be responsible for the conversion of the international filing fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the Schedule of Fees, to the International Bureau. Alternatively, if the receiving Office so wishes, it may convert the international filing fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.

[8] Schedule 2A, Rules 15.4 and 15.6*substitute***15.3 Time Limit for Payment; Amount Payable**

The international filing fee shall be paid to the receiving Office within one month from the date of receipt of the international application. The amount payable shall be the amount applicable on that date of receipt.

15.4 Refund

The receiving Office shall refund the international filing fee to the applicant:

- (i) if the determination under Article 11 (1) is negative,
- (ii) if, before the transmittal of the record copy to the International Bureau, the international application is withdrawn or considered withdrawn, or
- (iii) if, due to prescriptions concerning national security, the international application is not treated as such.

[9] Schedule 2A, Rules 16.1(b) to (f)*substitute*

(b) The search fee shall be collected by the receiving Office. The said fee shall be payable in the currency prescribed by that Office ("prescribed currency").

(c) Where the prescribed currency is the currency in which the International Searching Authority has fixed the said fee ("fixed currency"), the receiving Office shall promptly transfer the said fee to that Authority in that currency.

(d) Where the prescribed currency is not the fixed currency and that currency:

- (i) is freely convertible into the fixed currency, the Director General shall establish, for each receiving Office which prescribes such a currency for the payment of the search fee, an equivalent amount of that fee in the prescribed currency according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the receiving Office to the International Searching Authority;
- (ii) is not freely convertible into the fixed currency, the receiving Office shall be responsible for the conversion of the search fee from the prescribed currency into the fixed currency and shall promptly transfer that fee in the fixed currency, in the amount fixed by the International Searching Authority, to the International Searching Authority.

(e) Where, in respect of the payment of the search fee in a prescribed currency, other than the fixed currency, the amount actually received under paragraph (d)(i) of this Rule by the International Searching Authority in the prescribed currency is, when converted by it into the fixed currency, less than that fixed by it, the difference will be paid to the International Searching Authority by the International Bureau, whereas, if the amount actually received is more, the difference will belong to the International Bureau.

(f) As to the time limit for payment of the search fee and the amount payable, the provisions of Rule 15.3 relating to the international filing fee shall apply *mutatis mutandis*.

[10] Schedule 2A, Rule 16bis.1(a)

substitute

(a) Where, by the time they are due under Rules 14.1(c), 15.3 and 16.1(f), the receiving Office finds that no fees were paid to it, or that the amount paid to it is insufficient to cover the transmittal fee, the international filing fee and the search fee, the receiving Office shall, subject to paragraph (d), invite the applicant to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under Rule 16bis.2, within a time limit of one month from the date of the invitation.

[11] Schedule 2A, Rule 16bis.1(d)

substitute

(d) Any payment received by the receiving Office before that Office sends the invitation under paragraph (a) shall be considered to have been received before the expiration of the time limit under Rule 14.1(c), 15.3 or 16.1(f), as the case may be.

[12] Schedule 2A, Rule 19.4(c)

substitute

(c) For the purposes of Rules 14.1(c), 15.3 and 16.1(f), where the international application was transmitted to the International Bureau under paragraph (b), the date of receipt of the international application shall be considered to be the date on which the international application was actually received by the International Bureau. For the purposes of this paragraph, the last sentence of paragraph (b) shall not apply.

[13] Schedule 2A, Rule 45bis.1(d)

substitute

(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 restrict 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).

[14] Schedule 2A, Rule 45bis.2(d)

substitute

(d) The International Bureau shall refund the supplementary search handling fee to the applicant if, before the documents referred to in Rule 45bis.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 is considered not to have been submitted under Rule 45bis.1(e).

[15] Schedule 2A, Rules 45bis.3(d) and (e)*substitute*

(d) if, before the documents referred to in Rule 45bis.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 is considered not to have been submitted under Rules 45bis.1(e) or 45bis.4(d).

(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 45bis.5(a), the supplementary search request is considered not to have been submitted under Rule 45bis.5(g).

[16] Schedule 2A, Rule 45bis.4, heading*substitute*

45bis.4 Checking of Supplementary Search Request; Correction of Defects; Late Payment of Fees; Transmittal to Authority Specified for Supplementary Search

[17] Schedule 2A, Rule 45bis.5(b)*substitute*

(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 45bis.1(b)(iii) or 45bis.1(c)(i), taking due account of the international search report and the written opinion established under Rule 43bis.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 45bis.1(d), the supplementary international search may be restricted to the invention specified by the applicant under Rule 45bis.1(d) and those parts of the international application which relate to that invention.

[18] Schedule 2A, Rule 45bis.5(g)*substitute*

(g) If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation or condition referred to in Rule 45bis.9(a), other than a limitation under Article 17(2) as applicable by virtue of Rule 45bis.5(c), 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.

(h) The Authority specified for supplementary search may, in accordance with a limitation or condition referred to in Rule 45bis.9(a), decide to restrict the search to certain claims only, in which case the supplementary international search report shall so indicate.

[19] Schedule 2A, Rule 45bis.6(f)*substitute*

(f) Paragraphs (a) to (e) shall apply *mutatis mutandis* where the Authority specified for supplementary search decides to restrict the supplementary international search in accordance with the second sentence of Rule 45bis.5(b) or with Rule 45bis.5(h), 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 45bis.1(d) or which relate to the claims and those parts of the international application for which the Authority will carry out a supplementary international search, respectively.

[20] Schedule 2A, Rule 45bis.9(c)*substitute*

(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, other than limitations under Article 17(2) as applicable by virtue of Rule 45bis.5(c), limitations as to the total number of supplementary international searches which will be carried out in a given period, and limitations to the effect that the supplementary international searches will not extend to any claim beyond a certain number of claims.

[21] Schedule 2A, Rule 46.5(b)*substitute*

- (b) The replacement sheet or sheets shall be accompanied by a letter which:
- (i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;
 - (ii) shall identify the claims originally filed which, on account of the amendments, are cancelled;
 - (iii) shall indicate the basis for the amendments in the application as filed.

[22] Schedule 2A, Rules 57.2(c) to (e)*substitute*

(b) The handling fee shall be payable in the currency or one of the currencies prescribed by the International Preliminary Examining Authority ("prescribed currency").

(c) Where the prescribed currency is the Swiss franc, the Authority shall promptly transfer the said fee to the International Bureau in Swiss francs.

(d) Where the prescribed currency is a currency other than the Swiss franc and that currency:

- (i) is freely convertible into Swiss francs, the Director General shall establish, for each Authority which prescribes such a currency for the payment of the handling fee, an equivalent amount of that fee in the prescribed currency

according to directives given by the Assembly, and the amount in that currency shall promptly be transferred by the Authority to the International Bureau;

- (ii) is not freely convertible into Swiss francs, the Authority shall be responsible for the conversion of the handling fee from the prescribed currency into Swiss francs and shall promptly transfer that fee in Swiss francs, in the amount set out in the Schedule of Fees, to the International Bureau. Alternatively, if the Authority so wishes, it may convert the handling fee from the prescribed currency into euros or US dollars and promptly transfer the equivalent amount of that fee in euros or US dollars, as established by the Director General according to directives given by the Assembly as referred to in item (i), to the International Bureau.

[23] Schedule 2A, Rule 57.6

substitute

57.4 Refund

The International Preliminary Examining Authority shall refund the handling fee to the applicant:

- (i) if the demand is withdrawn before the demand has been sent by that Authority to the International Bureau, or
- (ii) if the demand is considered, under Rule 54.4 or 54bis.1(b), not to have been submitted.

[24] Schedule 2A, Rule 66.8(a)

substitute

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, shall indicate the basis for the amendment in the application as filed and shall preferably also explain the reasons for the amendment.

[25] Schedule 2A, after Rule 70.2(c)

insert

(c-bis) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter indicating the basis for the amendment in the application as filed, as required under Rule 46.5(b)(iii) as applicable by virtue of Rule 66.8(c), or Rule 66.8(a), as applicable, the report may be established as if the amendment had not been made, in which case the report shall so indicate.

[26] Schedule 2A, Rule 96.1

substitute

96.1 *Schedule of Fees Annexed to Regulations*

The amounts of the fees referred to in Rules 15, 45*bis*.2 and 57 shall be expressed in Swiss currency. They shall be specified in the Schedule of Fees which is annexed to these Regulations and forms an integral part thereof.

Schedule 2 Amendments commencing on 1 August 2010

(regulation 4)

[1] Subparagraph 22.2 (4) (a) (i)

omit

item 203

insert

item 214A

[2] After regulation 2.22E

insert

**22.2EA Failure to pay: fee for grant of leave to amend
specification**

- (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 is payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 1 month 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 the 1 month period.
- (2) The request for leave to amend the complete specification is taken not to have been filed.

[3] Subregulation 22.2F (5)*substitute*

- (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.

[4] Schedule 7, item 201*substitute*

- 201 Filing a request for a patent accompanied by a provisional specification:
- (a) by an electronic means approved by the Commissioner for this paragraph; \$80
 - (b) by another means \$110

[5] Schedule 7, item 203, third column, fee for paragraph (a)*omit*

\$290

insert

\$340

[6] Schedule 7, item 203, third column, fee for paragraph (b)

omit

\$320

insert

\$370

[7] Schedule 7, item 205, third column

omit

\$420

insert

\$450

[8] Schedule 7, item 207, third column

omit

\$370

insert

\$400

[9] Schedule 7, item 208, third column, fee for paragraph (a)

omit

\$180

insert

\$200

[10] Schedule 7, item 208, third column, fee for paragraph (b)*omit*

\$180

insert

\$200

[11] Schedule 7, item 211, paragraphs (f) to (o)*substitute*

(f) the tenth anniversary	\$450
(g) the eleventh anniversary	\$450
(h) the twelfth anniversary	\$450
(i) the thirteenth anniversary	\$450
(j) the fourteenth anniversary	\$450
(k) the fifteenth anniversary	\$1 020
(l) the sixteenth anniversary	\$1 020
(m) the seventeenth anniversary	\$1 020
(n) the eighteenth anniversary	\$1 020
(o) the nineteenth anniversary	\$1 020

[12] Schedule 7, item 212, third column, fee for paragraph (d)*omit*

\$160

insert

\$200

[13] Schedule 7, item 212, third column, fee for paragraph (f)

omit

\$230

insert

\$200

[14] Schedule 7, item 213, third column, fee for paragraph (a)

omit

\$140

insert

\$200

[15] Schedule 7, after item 214

insert

214A National phase entry of a PCT application \$340
under paragraph 89 (3) (b) of the Act

[16] Schedule 7, item 216, third column

omit

\$550

insert

\$600

[17] Schedule 7, after item 222

insert

- 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:
- \$100 for each additional claim that arises as described in paragraph (b)
- (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

[18] Schedule 7, item 223, third column

omit

\$140

insert

\$190

[19] Schedule 7, item 238, third column

omit

\$1 300

insert

\$2 000

[20] Schedule 7, item 302, third column

omit

\$1 600

insert

\$1 900

[21] Schedule 7, item 303, third column*omit*

\$1 600

insert

\$1 900

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>.