



# Patents Regulations 1991

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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

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## About this compilation

### This compilation

This is a compilation of the *Patents Regulations 1991* that shows the text of the law as amended and in force on 17 October 2018 (the *compilation date*).

The notes at the end of this compilation (the *endnotes*) include information about amending laws and the amendment history of provisions of the compiled law.

### Uncommenced amendments

The effect of uncommenced amendments is not shown in the text of the compiled law. Any uncommenced amendments affecting the law are accessible on the Legislation Register ([www.legislation.gov.au](http://www.legislation.gov.au)). The details of amendments made up to, but not commenced at, the compilation date are underlined in the endnotes. For more information on any uncommenced amendments, see the series page on the Legislation Register for the compiled law.

### Application, saving and transitional provisions for provisions and amendments

If the operation of a provision or amendment of the compiled law is affected by an application, saving or transitional provision that is not included in this compilation, details are included in the endnotes.

### Editorial changes

For more information about any editorial changes made in this compilation, see the endnotes.

### Modifications

If the compiled law is modified by another law, the compiled law operates as modified but the modification does not amend the text of the law. Accordingly, this compilation does not show the text of the compiled law as modified. For more information on any modifications, see the series page on the Legislation Register for the compiled law.

### Self-repealing provisions

If a provision of the compiled law has been repealed in accordance with a provision of the law, details are included in the endnotes.

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## Chapter 1—Introductory

### 1.1 Name of Regulations

These Regulations are the *Patents Regulations 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.

*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.

Regulation 1.3

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**Council for TRIPS** means the Council for Trade-Related Aspects of Intellectual Property Rights established under Article IV of the WTO Agreement.

**Disciplinary Tribunal** means the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61.

**eligible importing country**: see regulation 1.4A.

**former attorneys Regulations** means the Patent Attorneys Regulations as in force under the 1952 Act immediately before 30 April 1991.

**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.

**least developed country** means a country included in the list of least developed countries maintained by the United Nations, as in force from time to time.

Note: The list of least developed countries could in 2015 be viewed on the United Nations' website (<http://www.un.org>).

**New Zealand** has the meaning given by section 29 of the Interpretation Act 1999 of New Zealand, as in force at the commencement of this definition.

**ordinarily resident**: a person is taken to be ordinarily resident in a country if:

- (a) the person has his or her home in that country; or
- (b) that country is the country of his or her permanent abode even though he or she is temporarily absent from that country.

However, the person is taken not to be so resident if he or she resides in that country for a special or temporary purpose only.

**Panel Chair**, in relation to a Panel of the Disciplinary Tribunal, means:

- (a) the President; or
- (b) if the President is unable to perform his or her functions in proceedings of the Panel because of a conflict of interest—the person appointed under subregulation 20.64(2) to be the Panel Chair for the proceedings.

**Panel of the Disciplinary Tribunal** means a Panel constituted under regulation 20.36 or 20A.11.

**President** means the President of the Disciplinary Tribunal.

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

**the Act** means the *Patents Act 1990*.

**Tribunal member** means a member of the Disciplinary Tribunal and includes the President.

**WTO Agreement** means the Marrakesh Agreement establishing the World Trade Organization, done at Marrakesh on 15 April 1994.

**WTO member** means a country that is a full member of the World Trade Organization.

Note: The list of members of the World Trade Organization could in 2015 be viewed on the World Trade Organization's website (<http://www.wto.org>).

- (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:

Regulation 1.4A

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- (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](http://www.wipo.int).

Note 2: For full members of the World Trade Organization, see [www.wto.org](http://www.wto.org).

#### 1.4A Meaning of *eligible importing country*

For the definition of *eligible importing country* in Schedule 1 to the Act, the following kinds of foreign countries are prescribed:

- (a) a WTO member that notifies the Council for TRIPS, in accordance with the Annex to the TRIPS Agreement, of the member's intention to use the system set out in Article 31bis of the TRIPS Agreement and the Annex to that Agreement as an importer;
- (b) a least developed country.

#### 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 depositary 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
  - (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 file with the application a notice stating the facts on which the application is based.

### 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:
  - (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

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- (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:
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- (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.

#### **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:

Regulation 2.7

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- (a) a copy of the document; and
- (b) if the document is not in English, a copy of:
  - (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.

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## 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 from the applicant or patentee authorising the person to make the request.

##### 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

- (1) A provisional specification must:
  - (a) be in the approved form; and
  - (b) be in English.
- (2) If the Commissioner treats a provisional specification as having been filed, the Commissioner may, within 1 month from the date of filing of the provisional specification, direct the applicant to do anything necessary to ensure that the provisional specification complies with the requirements mentioned in subregulation (1).
- (3) If an applicant to whom a direction has been given under subregulation (2) does not comply with the direction within 2 months from the date of the direction, the provisional specification is taken not to have been filed.

#### 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).

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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- (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 or New Zealand 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; or
      - (iii) an address for service in New Zealand to which it is practicable and reasonable for a person providing mail delivery services to deliver mail; and
    - (aa) provide the name of the inventor of the invention to which the application relates; 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
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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.

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- (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
  - (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<sup>ter</sup> 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

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- (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.
- (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.

#### *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:

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- (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<sup>bis</sup>.4 of the PCT*

- (7) If an indication in relation to a deposited micro-organism is furnished according to Rule 13<sup>bis</sup>.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:

- (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.

### **3.11 Prescribed period—making Convention application**

For subsection 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, or a set of documents considered together, *clearly discloses* an invention if the document, or set of documents, 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.
- (5) For the purposes of subregulation (4), a document, or a set of documents considered together, is taken to clearly disclose an invention as mentioned in that subregulation so far as such disclosure requires a description of a micro-organism, if:
  - (a) the micro-organism is deposited with a prescribed depository institution in accordance with such provisions of the Budapest Treaty as are applicable; and
  - (b) the prescribed circumstances for paragraph 43(2B)(b) of the Act apply.

### **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
  - (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) (a prescribed circumstance for paragraph 43(2A)(a) of the Act) applies to the invention defined in the claim; and
  - (b) either:
    - (i) a document mentioned in subregulation (4) (a prescribed document for paragraph 43(2A)(b) of the Act) clearly discloses the invention in the claim; or
    - (ii) 2 or more of those documents (a prescribed set of prescribed documents for paragraph 43(2A)(b) of the Act), 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<sup>bis</sup>.3, and the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49<sup>ter</sup>.1; or
      - (B) the Commissioner has restored the priority under Rule 49<sup>ter</sup>.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<sup>bis</sup>.3, and the restored



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- priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49<sup>ter</sup>.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<sup>ter</sup>.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
- (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 the documents filed for the earlier application at the time the 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.

*Prescribed circumstances for micro-organisms*

- (6) For paragraph 43(2B)(b) of the Act, the prescribed circumstances for a disclosure that requires a description of a micro-organism are as follows:
- (a) the deposit of the micro-organism with a prescribed depository institution, in accordance with such provisions of the Budapest Treaty as are applicable, occurs on or before the date when the documents mentioned in subregulation (4) are filed;
  - (b) either:
    - (i) a document mentioned in subregulation (4) includes the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the documents are filed; or
    - (ii) 2 or more of those documents, considered together, include the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the documents are filed;
  - (c) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification that contains the claim.

### 3.13B Priority date for Convention application

- (1) This regulation applies to a claim if:
  - (a) the circumstance mentioned in subregulation (1A) (a prescribed circumstance for paragraph 43(2A)(a) of the Act) applies to the invention defined in the claim; and
  - (b) either:
    - (i) a document mentioned in subregulation (2) (a prescribed document for paragraph 43(2A)(b) of the Act) clearly discloses the invention in the claim; or
    - (ii) 2 or more of those documents (a prescribed set of prescribed documents for paragraph 43(2A)(b) of the Act), considered together, clearly disclose the invention in the claim.

#### *Circumstance*

- (1A) For paragraph (1)(a), the circumstance is that the specification containing the claim that defines the invention was filed for:
  - (a) a Convention application; or
  - (b) a complete application that has been amended to become a Convention application.

#### *Documents*

- (2) For paragraph (1)(b), the documents are the documents filed for a related basic application at the time when the application was made.
- (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.

#### *Prescribed circumstances for micro-organisms*

- (5) For paragraph 43(2B)(b) of the Act, the prescribed circumstances for a disclosure that requires a description of a micro-organism are as follows:
  - (a) the deposit of the micro-organism with a prescribed depository institution, in accordance with such provisions of the Budapest Treaty as are applicable, occurs on or before the date when the documents mentioned in subregulation (2) are filed;
  - (b) either:
    - (i) a document mentioned in subregulation (2) includes the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the documents are filed; or

- (ii) 2 or more of those documents, considered together, include the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the documents are filed;
- (c) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification that contains the claim.

### **3.13C Priority date for complete application associated with provisional application**

- (1) This regulation applies to a claim if:
  - (a) the circumstance mentioned in subregulation (1A) (a prescribed circumstance for paragraph 43(2A)(a) of the Act) applies to the invention defined in the claim; and
  - (b) either:
    - (i) a document mentioned in subregulation (2) (a prescribed document for paragraph 43(2A)(b) of the Act) clearly discloses the invention in the claim; or
    - (ii) 2 or more of those documents (a prescribed set of prescribed documents for paragraph 43(2A)(b) of the Act), considered together, clearly disclose the invention in the claim.

#### *Circumstance*

- (1A) For paragraph (1)(a), the circumstance is that 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.

#### *Documents*

- (2) For paragraph (1)(b), the documents are the documents filed for the provisional application at the time when the 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.

#### *Prescribed circumstances for micro-organisms*

- (4) For paragraph 43(2B)(b) of the Act, the prescribed circumstances for a disclosure that requires a description of a micro-organism are as follows:
  - (a) the deposit of the micro-organism with a prescribed depository institution, in accordance with such provisions of the Budapest Treaty as are applicable, occurs on or before the date when the documents mentioned in subregulation (2) are filed;
  - (b) either:
    - (i) a document mentioned in subregulation (2) includes the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the documents are filed; or

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- (ii) 2 or more of those documents, considered together, include the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the documents are filed;
- (c) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification that contains the claim.

**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) the specification mentioned in subsection 79B(1) of the Act (the *earlier specification*) clearly discloses the invention in the claim.
- (2) However, this regulation does not apply to a claim if:
  - (a) the deposit requirements must be satisfied in relation to the invention to comply with paragraph 40(2)(a) of the Act; and
  - (b) 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
  - (c) the requirements of paragraph 6(c) of the Act are not satisfied in relation to the earlier specification.
- (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.
- (4) For subsection 43(2A) of the Act:
  - (a) the circumstance mentioned in paragraph (1)(a) is a prescribed circumstance; and
  - (b) the document mentioned in paragraph (1)(b) is a prescribed document.
- (5) For paragraph 43(2B)(b) of the Act, the prescribed circumstances for a disclosure that requires a description of a micro-organism are as follows:
  - (a) the deposit of the micro-organism with a prescribed depository institution, in accordance with such provisions of the Budapest Treaty as are applicable, occurs on or before the date when the document mentioned in paragraph (1)(b) is filed;
  - (b) the document mentioned in paragraph (1)(b) includes the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the documents are filed;
  - (c) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification that contains the claim.

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**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) For subsection 43(2A) of the Act:
  - (a) the circumstance mentioned in paragraph (1)(a) is a prescribed circumstance; and
  - (b) the document mentioned in paragraph (1)(b) is a prescribed document.
- (4) For paragraph 43(2B)(b) of the Act, the prescribed circumstances for a disclosure that requires a description of a micro-organism are as follows:
  - (a) the deposit of the micro-organism with a prescribed depository institution, in accordance with such provisions of the Budapest Treaty as are applicable, occurs on or before the date when the document mentioned in paragraph (1)(b) is filed;
  - (b) the document mentioned in paragraph (1)(b) includes the relevant information on the characteristics of the micro-organism that is known to the applicant at the time the document is filed;
  - (c) the requirements of paragraph 6(c) of the Act are satisfied by the complete specification that contains the claim.

**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.

### **3.16 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:
  - (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.
- (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:
  - (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.

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- (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 certification authorising release of sample of a micro-organism**

- (1) If a micro-organism is deposited with a prescribed depository institution, a person may request the Commissioner to grant the certification referred to in Rule 11.3(a) of the Budapest Treaty in respect of the deposit.
- (2) The request:
- (a) must be in the approved form; and
  - (b) must relate to a micro-organism:
    - (i) that is the subject of a patent application or patent; or
    - (ii) the use, modification or cultivation of which is the subject of a patent application or patent; and
  - (c) may nominate another person as a skilled addressee.
- (3) Before making a decision under regulation 3.25B (including a decision about imposing conditions under regulation 3.25G), the Commissioner must:
- (a) give each person mentioned in subregulation (4) a written notice inviting the person to make, within a reasonable time specified in the notice, a submission about the matter; and
  - (b) if a person mentioned in subregulation (4) makes a submission within the time specified in the notice—take the submission into account.
- (4) For subregulation (3), the persons are as follows:
- (a) the person who made the request;
  - (b) the applicant or patentee;
  - (c) any other person who apparently has an interest in the request.

**3.25A Request for certification—micro-organism subject of application for standard patent**

- (1) This regulation applies if:
- (a) the micro-organism, or the use, modification or cultivation of the micro-organism, is the subject of an application for a standard patent; and
  - (b) the complete specification relating to the application is not open to public inspection.
- (2) The applicant may notify the Commissioner that, if:
- (a) a request is made under regulation 3.25 in relation to the application; and
  - (b) regulation 3.25E does not apply to the request;
- a sample of the deposited micro-organism is to be provided during the period mentioned in subregulation (3) only to a person who is a skilled addressee without an interest in the invention.

- (3) For subregulation (2), the period:
  - (a) begins when the complete specification relating to the application is open to public inspection; and
  - (b) ends when:
    - (i) the patent is granted on the application; or
    - (ii) the application lapses or is withdrawn or refused.

### **3.25B Grant of certification—when Commissioner must grant certification**

- (1) Subregulation (2) applies to a request under regulation 3.25 in relation to a patent application if:
  - (a) the applicant for the patent has notified the Commissioner as mentioned in subregulation 3.25A(2); and
  - (b) the period mentioned in subregulation 3.25A(3) has not ended; and
  - (c) regulation 3.25E does not apply to the request.
- (2) The Commissioner must grant the certification if:
  - (a) the specification relating to the application is open to public inspection; and
  - (b) the Commissioner is reasonably satisfied that the nominated person is entitled to rely on the deposit for the purposes of the Act; and
  - (c) a person has been nominated as a skilled addressee by the person who made the request; and
  - (d) the Commissioner is reasonably satisfied that the nominated person:
    - (i) is appropriately skilled; and
    - (ii) does not have an interest in the invention; and
  - (e) regulation 3.25C applies to the request.
- (3) Subregulation (4) applies to any other request under regulation 3.25.
- (4) The Commissioner must grant the certification if:
  - (a) the specification relating to the application or patent is open to public inspection; and
  - (b) the Commissioner is reasonably satisfied that the nominated person is entitled to rely on the deposit for the purposes of the Act; and
  - (c) one or more of regulations 3.25C, 3.25D, 3.25E and 3.25F apply to the request.
- (5) Despite subregulations (1) to (4), the Commissioner must not grant the certification if:
  - (a) the request relates to a micro-organism:
    - (i) that is the subject of a PCT application; or
    - (ii) the use, modification or cultivation of which is the subject of a PCT application; and
  - (b) the applicant of the PCT application has not complied with subsection 29A(5) of the Act.

**3.25C Grant of certification—limited use undertaking**

- (1) For paragraphs 3.25B(2)(e) and (4)(c), this regulation applies to a request if:
- (a) the person making the request or the person nominated as a skilled addressee has undertaken to use the micro-organism, during the period mentioned in subregulation (2), 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 the micro-organism, or a culture derived from the micro-organism, available to another person during that period; and
  - (b) the Commissioner is reasonably satisfied that the undertaking given by the person making the request or the person nominated as a skilled addressee is given in good faith.
- (2) For paragraph (1)(a), the period is:
- (a) for a request in respect of a patent application—the period beginning when the request is granted and ending when:
    - (i) the application lapses, or is refused or withdrawn; or
    - (ii) a patent granted on the application expires, ceases or is revoked; or
  - (b) for a request in respect of a patent—the period beginning when the request is granted and ending when the patent expires, ceases or is revoked.

**3.25D Grant of certification—order under section 133 of Act**

- For paragraph 3.25B(4)(c), this regulation applies to a request if:
- (a) an order has been made, under section 133 of the Act, requiring the patentee to grant to the person making the request a licence to work the patented invention; and
  - (b) the Commissioner is reasonably satisfied that the licence provides that the person making the request has a right to obtain a sample of the micro-organism.

**3.25E Grant of certification—exploitation for purposes of Commonwealth or a State**

- For paragraph 3.25B(4)(c), this regulation applies to a request if:
- (a) the person making the request is authorised by the Commonwealth or a State, under subsection 163(1) of the Act, to exploit the invention for the purposes of the Commonwealth or State; and
  - (b) 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 the micro-organism.

### **3.25F Grant of certification—expired patent etc.**

For paragraph 3.25B(4)(c), this regulation applies to a request if the request is in respect of:

- (a) a patent application that has lapsed or has been refused or withdrawn; or
- (b) a patent that is expired, ceased or revoked.

### **3.25G Imposing conditions on certification**

If the Commissioner grants the requested certification under regulation 3.25B, the Commissioner may impose any conditions the Commissioner considers reasonable, including a condition that the person making the request give security for damages for any breach of the undertaking mentioned in paragraph 3.25C(1)(a) given by:

- (a) the person; or
- (b) another person who has been nominated by the person as a skilled addressee.

### **3.25H Notice of decision on certification request**

- (1) If the Commissioner makes a decision under regulation 3.25B (including a decision about imposing conditions under regulation 3.25G), the Commissioner must inform each person mentioned in subregulation (2) of the decision, and the reasons for the decision, by notice in writing given as soon as practicable after the date of the decision.
- (2) For subregulation (1), the persons are as follows:
  - (a) the person who made the request;
  - (b) the applicant or patentee;
  - (c) any other person who apparently has an interest in the request.

### **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.

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- (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 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.
- (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:

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- (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.

- (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.

### **3.32 Provisional specifications—prescribed circumstances**

- (1) For paragraph 41(1A)(b) of the Act, the prescribed circumstances are all of the following:
- (a) the micro-organism was deposited with a prescribed depository institution, in accordance with such provisions of the Budapest Treaty as are applicable, on or before the date the provisional specification was filed;
  - (b) at the time the provisional application to which the provisional specification relates was made, the provisional specification clearly disclosed the invention, other than in relation to the description of the micro-organism;
  - (c) at the time the provisional application to which the provisional specification relates was made, either:
    - (i) a document filed for the provisional application included the relevant information on the characteristics of the micro-organism that was known to the applicant at that time; or
    - (ii) 2 or more documents filed for the provisional application, considered together, included the relevant information on the characteristics of the micro-organism that was known to the applicant at that time;

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- (d) if the circumstances mentioned in subregulation (2) apply—the requirements of paragraph 6(c) of the Act are satisfied by the complete specification mentioned in paragraph (2)(a) of this regulation.
- (2) For paragraph (1)(d), the circumstances are that:
- (a) a complete specification has been filed for a complete application; and
  - (b) the complete application is associated with the provisional application whose specification is referred to in paragraph (1)(b).

Note: A complete application may be associated with a provisional application when the complete application is filed, or as a result of a subsequent amendment to the complete application.

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## 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;

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- (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);
  - (c) a document setting out any information that was not transmitted to the International Bureau in accordance with Rule 26bis.3(h-bis) of the PCT;
  - (d) a document setting out any information in respect of which the International Bureau has, under Rule 48.2(n) of the PCT, notified the

Commissioner that it has omitted that information from international publication;

- (e) a document setting out any information in respect of which the International Bureau has, under Rule 94.1(f) of the PCT, notified the Commissioner that it has omitted that information from public access.

(7A) However, if the Commissioner makes a copy of a document mentioned in paragraph (7)(c), (d) or (e) in a form that does not contain information of the kind mentioned in those paragraphs then, unless the copy is covered by paragraph (7)(a) or (b), it is open for public inspection under paragraph (6)(b).

(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.
- (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.
- (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.

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- (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 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

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- (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.
- (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.

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
  - (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.
- (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 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:
    - (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.

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- (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 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.

| <b>Circumstances</b> |  |   |
|----------------------|--|---|
| <b>Item</b>          | <b>Column 1</b>  | <b>Column 2</b>   |
|                      | <b>The earlier application was...</b>  | <b>and:</b>   |
| 1                    | an application made in Australia more than 12 months before the international filing date of the PCT application   | both of the following apply:<br>(a) a receiving Office has restored priority under Rule 26 <sup>bis</sup> .3 of the PCT;<br>(b) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49 <sup>ter</sup> .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 <sup>ter</sup> .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:<br>(a) a receiving Office has restored priority under Rule 26 <sup>bis</sup> .3 of the PCT;<br>(b) the restored priority has not been found to be ineffective by the Commissioner or a prescribed court under Rule 49 <sup>ter</sup> .1 of the PCT |
| 5                    | 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 restored priority under Rule 49 <sup>ter</sup> .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 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:

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- (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.

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## 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.

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## 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:
    - (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.

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- (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 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 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.



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**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.
- (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.

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**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
  - (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.

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- (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).
- (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.

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- (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.
- (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.



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- (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.

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- (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
  - (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.

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## Chapter 12—Compulsory licences and revocation of patents

### Part 1—Compulsory licences (general)

#### 12.1 Applications for orders 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.

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.

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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.

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## **Part 2—Patented pharmaceutical invention compulsory licences (for manufacture and export to eligible importing countries)**

### **12.2A Applications for PPI orders**

- (1) An applicant for a PPI order in relation to the export of a pharmaceutical product to an eligible importing country must lodge, with the Registrar of the Federal Court, an application that includes the following:
  - (a) the name and address of the applicant;
  - (b) the applicant's address for service in relation to the application;
  - (c) the name of the eligible importing country;
  - (d) if the pharmaceutical product is to be imported by a person on behalf of, and with the authorisation of, the eligible importing country—the name and address of that person;
  - (e) the name of the pharmaceutical product;
  - (f) the proposed use of the pharmaceutical product in the eligible importing country;
  - (g) the amount of the pharmaceutical product proposed to be manufactured for export;
  - (h) the proposed duration of the PPI compulsory licence;
  - (i) the identity of the patent;
  - (j) the name of the patentee;
  - (k) if the patent is an innovation patent—the date of certification of the innovation patent.
- (2) For paragraph (1)(b), 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.
- (3) The applicant must:
  - (a) serve a copy of the application on the patentee and any other person who claims an interest in the patent as soon as practicable after lodgement; 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, as in force from time to time.

### **12.2B PPI compulsory licences—notification requirements**

- (1) This regulation sets out the notification requirements for paragraph 136E(1)(f) of the Act in relation to the importation of a pharmaceutical product into an eligible importing country.

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- (2) Subregulation (3) applies if the eligible importing country is a WTO member.
- (3) The eligible importing country must have notified the Council for TRIPS in accordance with paragraph 2(a) of the Annex to the TRIPS Agreement.
- (4) Subregulation (5) applies if the eligible importing country is:
  - (a) a least developed country; and
  - (b) not a WTO member.
- (5) The eligible importing country must have given the Commissioner a written notice:
  - (a) stating:
    - (i) the name of the eligible importing country; and
    - (ii) the name of the pharmaceutical product; and
    - (iii) the expected quantity of the pharmaceutical product to be imported into the eligible importing country; and
  - (b) confirming that, if the pharmaceutical product is patented in the eligible importing country, it:
    - (i) has granted; or
    - (ii) intends to grant;a compulsory licence that would accord with Articles 31 and 31bis of the TRIPS Agreement and the Annex to that Agreement if the Agreement and Annex applied to the eligible importing country.

**12.2C PPI compulsory licences—labelling and marking of product**

- (1) For paragraph 136F(1)(c) of the Act, the pharmaceutical product must be labelled or marked in a way that:
  - (a) clearly identifies the product as being exported from Australia under the PPI compulsory licence; and
  - (b) distinguishes the product from:
    - (i) the same pharmaceutical product as sold in Australia; and
    - (ii) the same pharmaceutical product as exported other than under the licence.
- (2) For subregulation (1), the labelling or marking must:
  - (a) be applied to:
    - (i) the immediate package containing the pharmaceutical product; and
    - (ii) any other package containing that package (whether or not other packages are involved); and
  - (b) remain clear and legible at all times while the product is being exported.

**12.2D PPI compulsory licences—shipment information**

- (1) For paragraph 136F(1)(d) of the Act, the following shipment information is prescribed in relation to each shipment of a pharmaceutical product:
  - (a) the name of the pharmaceutical product;



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- (b) the amount of the product in the shipment;
  - (c) the name of the licensee;
  - (d) the licensee's address for service;
  - (e) the name of the eligible importing country;
  - (f) if a person is importing the pharmaceutical product on behalf of, and with the authorisation of, the eligible importing country—the name and address of the person;
  - (g) a description of the packaging (including colour, size and shape) and the labelling or marking of the pharmaceutical product.
- (2) For paragraph 136F(1)(d) of the Act, the shipment information must be made available for at least the duration of the licence.

### **12.2E PPI compulsory licences—giving information to the Commissioner**

- (1) This regulation sets out for paragraph 136F(1)(h) of the Act the information that a licensee must give to the Commissioner in relation to the licence.

#### *Grant of licence*

- (2) The licensee must give the Commissioner the following information in relation to the grant of the PPI compulsory licence:
- (a) the date of the PPI order;
  - (b) the place at which the PPI order was made;
  - (c) the name and address of the licensee;
  - (d) the licensee's address for service;
  - (e) the name of the pharmaceutical product;
  - (f) the quantity of the pharmaceutical product that the Federal Court has determined may be manufactured for export;
  - (g) the eligible importing country to which the pharmaceutical product is to be exported;
  - (h) the duration of the licence;
  - (i) the identity of the patent;
  - (j) the address of the website on which the shipment information is to be made available.
- (3) The information mentioned in subregulation (2) must be given to the Commissioner:
- (a) in the approved form; and
  - (b) within 1 month after the Federal Court makes the order requiring the grant of the licence.

#### *Amendment of licence*

- (4) If the licence is amended by order under section 136G of the Act, the licensee must give the Commissioner the following information in relation to the amendment:

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- (a) the date of the amending order;
  - (b) the place at which the amending order was made;
  - (c) details of the amendment.
- (5) The information mentioned in subregulation (4) must be given to the Commissioner:
- (a) in the approved form; and
  - (b) within 1 month after the Federal Court makes the order amending the licence.

*Revocation of licence*

- (6) If the licence is revoked by order under section 136H of the Act, the licensee must give the Commissioner the following information in relation to the revocation:
- (a) the date of the revocation order;
  - (b) the place at which the revocation order was made.
- (7) The information mentioned in subregulation (6) must be given to the Commissioner:
- (a) in the approved form; and
  - (b) within 1 month after the Federal Court makes the order revoking the licence.

*Agreement or determination of remuneration*

- (8) If an amount of remuneration for the licence is agreed under paragraph 136J(3)(a) of the Act or determined by the Federal Court under paragraph 136J(3)(b) of the Act, the licensee must give the Commissioner a statement that an amount of remuneration has been agreed or determined, as the case may be.
- (9) The information mentioned in subregulation (8) must be given to the Commissioner:
- (a) in the approved form; and
  - (b) within 1 month after the agreement is reached or the determination is made.

**12.2F Dealing with information provided under regulation 12.2E**

- (1) If the Commissioner receives the information mentioned in subregulation 12.2E(2) in relation to the grant of a PPI compulsory licence, the Commissioner must:
- (a) if the eligible importing country is a WTO member—give a copy of the information to the Council for TRIPS; or
  - (b) in any other case—publish the information on the internet.
- (2) If the Commissioner receives the information mentioned in subregulation 12.2E(8) in relation to a licence, the Commissioner must give the eligible importing country to which the licence relates a notice stating that the

licensee has advised that an amount of remuneration in respect of the licence has been agreed or determined, as the case may be.

## Part 3—Surrender and revocation of patents

### 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

- (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.

#### 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:

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- (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:
    - (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:
  - (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.

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- (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.

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## **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.

#### 20.1B Performance of functions and exercise of powers

- (1) A function that is conferred on a person or body under this Chapter may be exercised in Australia or New Zealand.
- (2) A power that is conferred on a person or body under this Chapter may be exercised in Australia or New Zealand.
- (3) For the purposes of this Chapter and subject to regulation 20.1C, it is immaterial whether an act or omission mentioned in this Chapter took place in New Zealand.
- (4) For the purposes of this Chapter and subject to regulation 20.1C, it is immaterial whether a matter mentioned in this Chapter concerns something that took place in New Zealand.

#### 20.1C Conduct in New Zealand does not constitute an offence under this Chapter

A person is not liable to be prosecuted for an offence against these Regulations if the act or omission constituting the offence occurred in New Zealand.

### 20.1 Interpretation

In this Chapter:

*AQF* means the Australian Qualifications Framework.

*Board Chair* means the Chair of the Board mentioned in paragraph 227A(2A)(a) of the Act.

*candidate* means a person who proposes or proposed to sit, or has sat, for an examination.

*NZQF* means the New Zealand Qualifications Framework established under section 248 of the Education Act 1989 of New Zealand, as in force at the commencement of this definition.

*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 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.

## **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:
  - (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.
- (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) a level 5 or higher AQF, or NZQF, qualification 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 a level 5 or higher AQF, or NZQF, qualification.
- (2) The Board must not be satisfied that a person has an AQF or NZQF 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 or NZQF 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 Australia or New Zealand, or in both countries, 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 relation to Australia and New Zealand;
    - (iii) preparing, filing and prosecuting patent applications in relation to other countries and organisations, particularly countries and organisations that are regarded as major trading partners with Australia and New Zealand;
    - (iv) drafting patent specifications;
    - (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.

Note: Examples of major trading partners for subparagraph (1)(a)(iii) are as follows:

- (a) European Union;
- (b) Japan;
- (c) People's Republic of China;
- (d) Republic of Korea;
- (e) 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.
- (3) For subregulation (1), a person is **employed in Australia** only if the person is, in accordance with the terms of his or her employment, required to undertake (and does undertake) the duties of his or her employment in Australia.
- (4) For subregulation (1), a person is **employed in New Zealand** only if the person is, in accordance with the terms of his or her employment, required to undertake (and does undertake) the duties of his or her employment in New Zealand.

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.

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**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 any of the following Acts is a prescribed offence for paragraph 198(4)(e) of the Act:
  - (a) the Act;
  - (b) the *Designs Act 2003*;
  - (c) the *Plant Breeder's Rights Act 1994*;
  - (d) the *Trade Marks Act 1995*;
  - (e) the Designs Act 1953 of New Zealand;
  - (f) the Patents Act 1953 of New Zealand;
  - (g) the Patents Act 2013 of New Zealand;
  - (h) the Plant Variety Rights Act 1987 of New Zealand;
  - (i) the Trade Marks Act 2002 of New Zealand.
- (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:

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- (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.

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- (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
    - (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 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.

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**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.
- (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.
- (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 a Panel of 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 President.

## 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.

### 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 President.
- (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 President, 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 Panel of the Disciplinary Tribunal to be constituted

- (1) Except as otherwise provided by this Part, the Disciplinary Tribunal's functions and powers in relation to disciplinary proceedings under this Part are to be performed and exercised by a Panel of the Disciplinary Tribunal.
- (2) A Panel of the Disciplinary Tribunal is to be constituted by:
  - (a) a Panel Chair; and
  - (b) 2 other members determined by the Panel Chair under subregulation (3).
- (3) The Panel Chair is to determine, in writing, the other members of the Disciplinary Tribunal who are to constitute the Panel that is to conduct the disciplinary proceedings.
- (4) Subject to subregulation 20.36E(5), if disciplinary proceedings are commenced against a registered patent attorney who is ordinarily resident in Australia or New Zealand, one of the members of the Panel that is conducting the proceedings must also be ordinarily resident in the same country as the registered patent attorney.

Note: Regulation 20.64 sets out requirements relating to the disclosure of conflicts of interest.

### 20.36A Meetings of Panel of Disciplinary Tribunal

- (1) The Panel Chair of a Panel of the Disciplinary Tribunal must:
  - (a) convene such meetings of the Panel as the Panel Chair considers necessary for the purpose of conducting disciplinary proceedings being heard by the Panel; and
  - (b) preside at all meetings of the Panel.
- (2) Subject to paragraph 20.36D(2)(a) and subregulation 20.36E(5), all members of a Panel of the Disciplinary Tribunal must be present at a meeting of the Panel.
- (3) A question arising at a meeting of a Panel of the Disciplinary Tribunal must be determined by a majority of the votes of the members of the Panel present and voting.
- (4) However, if, in accordance with paragraph 20.36D(2)(a) or subregulation 20.36E(5), a hearing of proceedings is continued with 2 members of a Panel of the Disciplinary Tribunal, questions arising at the hearing must be determined by a unanimous vote of the 2 members.

### 20.36B Procedure of Panel of Disciplinary Tribunal

- (1) Subject to this Part, the procedures for convening meetings of a Panel of the Disciplinary Tribunal and for the conduct of business by a Panel of the Disciplinary Tribunal are as the Panel Chair determines.

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

### **20.36C Panel Chair unavailable to complete hearing**

- (1) This regulation applies if:
  - (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  - (b) before the matter has been determined, the Panel Chair has:
    - (i) ceased to be a member; or
    - (ii) for any reason, ceased to be available as a member of the Panel.
- (2) The matter is to be reheard by a new Panel constituted in accordance with regulation 20.36.
- (3) The new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

### **20.36D Member other than the Panel Chair unavailable to complete hearing**

- (1) This regulation applies if:
  - (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  - (b) before the matter has been determined, one of the members (other than the Panel Chair) constituting the Panel has:
    - (i) ceased to be a member; or
    - (ii) for any reason, ceased to be available as a member of the Panel.
- (2) Subject to regulation 20.36E, the Panel Chair may determine that:
  - (a) the hearing and determination, or the determination, of the matter is to be completed by the Panel constituted by the remaining members of the Panel;  
or
  - (b) the matter is to be reheard by a new Panel constituted in accordance with regulation 20.36.
- (3) If a matter is reheard under paragraph (2)(b), the new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

**20.36E No member ordinarily resident in same country as registered patent attorney subject to proceedings**

- (1) This regulation applies if:
  - (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  - (b) before the matter has been determined, one of the members (other than the Panel Chair) constituting the Panel has:
    - (i) ceased to be a member; or
    - (ii) for any reason, ceased to be available as a member of the Panel; and
  - (c) the registered patent attorney who is subject to the proceedings is ordinarily resident in Australia or New Zealand; and
  - (d) neither of the remaining members of the Panel is ordinarily resident in the same country as the registered patent attorney who is subject to the proceedings.
- (2) The Panel Chair must, as soon as practicable, give the registered patent attorney notice in writing that:
  - (a) one of the members constituting the Panel has ceased to be, or to be available as, a member of the Panel; and
  - (b) neither of the remaining members is ordinarily resident in the same country as the registered patent attorney; and
  - (c) the registered patent attorney may, within the period specified in the notice:
    - (i) elect to have the matter completed by the Panel constituted by the remaining members of the Panel; or
    - (ii) elect to have the matter reheard by a new Panel constituted in accordance with regulation 20.36.
- (3) An election under paragraph (2)(c) must be in writing and given to the Panel Chair within the period specified in the notice.
- (4) The period specified in the notice must be not less than 21 days after the day on which the notice is given.
- (5) Despite subregulation 20.36(4), if the registered patent attorney elects to have the matter completed by the Panel constituted by the remaining members of the Panel, the Panel constituted by the remaining members may hear and determine, or determine, the matter.
- (6) If the Panel Chair does not receive an election within the period specified in the notice or such longer period as the Panel Chair allows, the Panel Chair must arrange for the matter to be reheard by a new Panel constituted in accordance with regulation 20.36.
- (7) If the matter is reheard in accordance with subparagraph (2)(c)(ii) or subregulation (6), the new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

### **20.37 Notification of hearing of disciplinary proceedings**

- (1) As soon as practicable after receiving a notice under regulation 20.35, the Panel Chair of a Panel of the Disciplinary Tribunal must:
  - (a) fix a day, time and place to hear the charges set out in the notice; and
  - (b) notify the registered patent attorney and the Board of that day, 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 a Panel of the Disciplinary Tribunal must be in public.
- (2) If the Panel Chair of a Panel of 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 Panel Chair 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 Panel, whether in public or in private; or
    - (ii) matters contained in documents lodged with the Panel 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 Panel of Disciplinary Tribunal**

- (1) At a hearing of proceedings before a Panel of the Disciplinary Tribunal, a party to the proceedings may appear in person or be represented by a legal practitioner.
- (2) The Panel Chair may allow a person to be represented by a person who is not a legal practitioner.
- (3) A party to proceedings before the Panel, or his or her representative, may request the Panel Chair to summon witnesses.

### **20.40 Summoning of witnesses**

- (1) For the purpose of the hearing of a charge against a registered patent attorney before a Panel of the Disciplinary Tribunal, the Panel Chair may, by written instrument signed by the Panel Chair:
  - (a) summon any person, other than the attorney, to appear before the Panel 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 Panel:

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- (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 a Panel of Disciplinary Tribunal**

- (1) A person summoned to appear before a Panel of 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 Panel, 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 Panel Chair 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 Panel Chair.

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
    - (ii) appears as a witness before a Panel of the Disciplinary Tribunal; and
    - (iii) has been paid expenses and allowances 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 subparagraph (3)(a)(iii).

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 a Panel of 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 certain persons**

- (1) A person who is a member of a Panel of the Disciplinary Tribunal conducting a hearing of disciplinary proceedings under this Part has, in the performance of his or her duties as a member of the Panel, 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 a Panel of 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 a Panel of 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 Panel of Disciplinary Tribunal**

- (1) If a Panel of 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 a Panel of 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.

Regulation 20.44

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- (3) If a Panel of the Disciplinary Tribunal has heard a charge that a registered patent attorney was unqualified at the time of his or her registration, it may find the attorney guilty of being unqualified at the time of registration.
- (4) If a Panel of the Disciplinary Tribunal has heard a charge that a registered patent attorney obtained his or her registration by fraud, it may find the attorney guilty of obtaining his or her registration by fraud.

**20.44 Penalties—professional misconduct**

- (1) Subject to subregulation (2), if a Panel of 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 Panel 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 Panel may impose include either or both of the following:
  - (a) that the attorney undertake additional continuing professional education, as specified by the Panel;
  - (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 Panel 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 a Panel of 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 Panel 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 Panel may impose include either or both of the following:
  - (a) that the attorney undertake additional continuing professional education, as specified by the Panel;



- (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 a Panel of 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, the Panel 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 a Panel of the Disciplinary Tribunal finds that a registered patent attorney obtained his or her registration by fraud, the Panel must cancel the registration of the attorney.

#### **20.48 Matters that may be considered in determining penalties**

- (1) In deciding what action to take in relation to a registered patent attorney under regulation 20.44 or 20.45, a Panel of the Disciplinary Tribunal may take into account any findings about the conduct of the attorney in any other disciplinary proceedings:
  - (a) under these Regulations; or
  - (b) under the former attorneys Regulations.
- (2) For subregulation (1), it is immaterial when the findings were made.

#### **20.49 Findings of Panel of Disciplinary Tribunal**

- (1) If a Panel of the Disciplinary Tribunal reprimands a registered patent attorney, or suspends or cancels the attorney's registration, the Panel must give a written notice of the finding of the Panel 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 Panel does not find a charge proved, the Panel must notify the registered patent attorney and the Board accordingly.

### **20.50 Notification and publication of decisions of Panel of Disciplinary Tribunal**

Within 14 days after a Panel of the Disciplinary Tribunal makes a decision under regulation 20.44, 20.45, 20.46 or 20.47, the Panel must:

- (a) prepare a written statement that:
- (i) sets out the decision of the Panel; 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 Panel; 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 by a Panel of the Disciplinary Tribunal under paragraph 20.44(1)(a), the Panel Chair 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 by a Panel of the Disciplinary Tribunal under paragraph 20.44(1)(b) or 20.45(1)(a), the Panel Chair 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 Panel Chair of a Panel of 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:
  - (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 Panel Chair of a relevant Panel of 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—Trans-Tasman IP Attorneys Board

#### 20.56 Resignation and removal of members from Board

- (1) A member of the Board mentioned in paragraph 227A(2A)(a), (d) or (e) of the Act may resign by giving the Minister his or her resignation in writing.
- (2) The Minister may terminate the appointment of the Board Chair if the Board Chair:
  - (a) has been absent from 3 consecutive meetings of the Board without leave given by the Board; or
  - (b) is convicted in Australia or New Zealand of an offence punishable by imprisonment for at least 12 months; or
  - (c) cannot perform his or her duties as Board Chair; 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 Board Chair 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 terminate the appointment of a member of the Board mentioned in paragraph 227A(2A)(d) or (e) of the Act if the member:
  - (a) has been absent from 3 consecutive meetings of the Board without leave given by the Board Chair; or
  - (b) is convicted in Australia or New Zealand 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.
- (2) The Board Chair 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 Board Chair must preside at all meetings of the Board at which he or she is present.
- (2) In the absence of the Board Chair from a meeting, the members present must appoint one of the members present at the meeting to preside.
- (3) The Board Chair 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**

- (1) At a meeting of the Board, a quorum is formed by the majority of the members of the Board.
- (2) One of the members of the majority must be ordinarily resident in Australia and one of the members of the majority must be ordinarily resident in New Zealand.

## **Division 2—Trans-Tasman IP Attorneys Disciplinary Tribunal**

### **20.61 Establishment of the Trans-Tasman IP Attorneys Disciplinary Tribunal**

The Trans-Tasman IP Attorneys Disciplinary Tribunal is established.

#### **20.61A Functions of Disciplinary Tribunal**

The functions of the Disciplinary Tribunal are to hear and determine disciplinary proceedings commenced by the Board:

- (a) against a registered patent attorney in accordance with Part 8 of this Chapter or Part 5 of Chapter 20A; and
- (b) against a registered trade marks attorney (within the meaning of the *Trade Marks Act 1995*) in accordance with Division 6 of Part 20 of the *Trade Marks Regulations 1995* or Division 5 of Part 20A of those Regulations.

#### **20.62 Membership of the Disciplinary Tribunal etc.**

- (1) The Disciplinary Tribunal consists of the following members:
  - (a) a President;
  - (b) at least 2 other members.
- (1A) Each Tribunal member is to be appointed by the Minister in writing on a part-time basis.
- (2) A copy of the instrument of appointment must be published in the *Official Journal*.
- (3) A Tribunal member holds the office for the period specified in the instrument.
- (4) A Tribunal member may resign in writing given to the Minister.
- (5) The Minister may terminate the appointment of a Tribunal member for inefficiency, misbehaviour or incapacity.
- (6) If a Tribunal member:
  - (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 or New Zealand 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 terminate the Tribunal member's appointment.

### 20.63 Eligibility for appointment as Tribunal member

#### *President*

- (1) A person is not eligible to be appointed as President unless the person is enrolled as a legal practitioner (however described) in Australia or New Zealand and has been so enrolled for at least 7 years.

#### *Other Tribunal members*

- (2) A person is not eligible to be appointed as a Tribunal member (other than the President) unless the person:
  - (a) is a registered patent attorney in Australia or New Zealand and has been so registered for at least 5 years; or
  - (b) is a person who was, but is no longer, registered as a patent attorney in Australia or New Zealand and had been so registered for at least 5 years; or
  - (c) is a registered trade marks attorney (within the meaning of the *Trade Marks Act 1995*) and has been so registered for at least 5 years; or
  - (d) is a person who was, but is no longer, a registered trade marks attorney (within the meaning of that Act) and had been so registered for at least 5 years; or
  - (e) satisfies both of the following:
    - (i) the person is enrolled as a legal practitioner (however described) in Australia or New Zealand and has been so enrolled for at least 5 years;
    - (ii) the person is a registered patent attorney or a trade marks attorney in Australia or New Zealand.
- (3) A person is not eligible for appointment as a Tribunal member unless the person is an individual.

### 20.63A Acting President

- (1) The Minister may, in writing, appoint a person to act as the President:
    - (a) during a vacancy in the office of President (whether or not an appointment has been previously made to the office); or
    - (b) during any period, or during all periods, when the President:
      - (i) is absent from duty or from Australia and New Zealand; or
      - (ii) is, for any reason, unable to perform the duties of the office.
  - (2) A copy of the instrument of appointment must be published in the *Official Journal*.
  - (3) 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.
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- (4) A person is not eligible for appointment to act as President unless the person is eligible for appointment as President under subregulation 20.63(1).

### **20.63B Acting Tribunal members**

- (1) The Minister may, in writing, appoint a person to act as a Tribunal member (other than the President):
- (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:
    - (i) is absent from duty or from Australia and New Zealand; or
    - (ii) is, for any reason, unable to perform the duties of the office.
- (2) A copy of the instrument of appointment must be published in the *Official Journal*.
- (3) 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.
- (4) A person is not eligible for appointment to act as a Tribunal member (other than the President) unless the person is eligible for appointment as a Tribunal member under subregulation 20.63(2).

### **20.64 Disclosure of interests**

#### *President*

- (1) If the President has or acquires an interest that could conflict with the proper performance of his or her functions as Panel Chair in relation to proceedings that he or she is hearing or is to hear, the President:
- (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 the President 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 Panel Chair for the purpose of conducting or completing those proceedings.
- (3) A person is not eligible for appointment under subregulation (2) unless the person is eligible for appointment as President under subregulation 20.63(1).
- (4) A person so appointed may exercise all the powers and must perform all of the functions of the Panel Chair in relation to those proceedings.

#### *Other Tribunal members*

- (5) If a Tribunal Member (other than the President) has or acquires an interest that could conflict with the proper performance of his or her functions as a member
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of a Panel of the Disciplinary Tribunal in relation to proceedings that he or she is hearing or is to hear, the member:

- (a) must tell the parties to the proceedings about the interest; and
  - (b) must not perform those functions without the consent of the parties.
- (6) If the Tribunal member is unable to perform his or her functions because of a conflict of interest, the Panel Chair may in writing appoint another Tribunal member for the purpose of conducting or completing those proceedings.

## **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.1A Performance of functions and exercise of powers**

- (1) A function that is conferred on a person or body under this Chapter may be exercised in Australia or New Zealand.
- (2) A power that is conferred on a person or body under this Chapter may be exercised in Australia or New Zealand.
- (3) For the purposes of this Chapter and subject to regulation 20A.1B, it is immaterial whether an act or omission mentioned in this Chapter took place in New Zealand.
- (4) For the purposes of this Chapter and subject to regulation 20A.1B, it is immaterial whether a matter mentioned in this Chapter concerns something that took place in New Zealand.

#### **20A.1B Conduct in New Zealand does not constitute an offence under this Chapter**

A person is not liable to be prosecuted for an offence against these Regulations if the act or omission constituting the offence occurred in New Zealand.

#### **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* or the *Companies Act 1993* of New Zealand;
  - (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 has, at any time, been 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 patent attorney's registration was cancelled or suspended under subregulation 20.44(1) because he or she was found guilty of professional misconduct.
- (2) Before applying to the Disciplinary Tribunal, the Board may request the 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; and
  - (c) be addressed and sent to the President.
- (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 Panel of the Disciplinary Tribunal to be constituted**

- (1) Except as otherwise provided by this Part, the Disciplinary Tribunal's functions and powers in relation to disciplinary proceedings under this Part are to be performed and exercised by a Panel of the Disciplinary Tribunal.
- (2) A Panel of the Disciplinary Tribunal is to be constituted by:
  - (a) a Panel Chair; and
  - (b) 2 other members determined by the Panel Chair under subregulation (3).
- (3) The Panel Chair is to determine, in writing, the other members of the Disciplinary Tribunal who are to constitute the Panel that is to conduct the disciplinary proceedings.
- (4) Subject to subregulation 20A.11E(5), if disciplinary proceedings are commenced against an incorporated patent attorney that is incorporated in Australia or New Zealand, one of the members of the Panel that is conducting the proceedings must also be ordinarily resident in the same country as the country in which the incorporated patent attorney is registered.

Note: Regulation 20.64 sets out requirements relating to the disclosure of conflicts of interest.

### **20A.11A Meetings of Panel of Disciplinary Tribunal**

- (1) The Panel Chair of a Panel of the Disciplinary Tribunal must:
  - (a) convene such meetings of the Panel as the Panel Chair considers necessary for the purpose of conducting disciplinary proceedings being heard by the Panel; and
  - (b) preside at all meetings of the Panel.
- (2) Subject to paragraph 20A.11D(2)(a) and subregulation 20A.11E(5), all members of a Panel of the Disciplinary Tribunal must be present at a meeting of the Panel.
- (3) A question arising at a meeting of a Panel of the Disciplinary Tribunal must be determined by a majority of the votes of the members of the Panel present and voting.
- (4) However, if, in accordance with paragraph 20A.11D(2)(a) or subregulation 20A.11E(5), a hearing of proceedings is continued with 2 members of the Panel, questions arising at the hearing must be determined by a unanimous vote of the 2 members.

### **20A.11B Procedure of Panel of Disciplinary Tribunal**

- (1) Subject to this Part, the procedures for convening meetings of a Panel of the Disciplinary Tribunal and for the conduct of business by a Panel of the Disciplinary Tribunal are as the Panel Chair determines.



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

#### **20A.11C Panel Chair unavailable to complete hearing**

- (1) This regulation applies if:
  - (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  - (b) before the matter has been determined, the Panel Chair has:
    - (i) ceased to be a member; or
    - (ii) for any reason, ceased to be available as a member of the Panel.
- (2) The matter is to be reheard by a new Panel constituted in accordance with regulation 20A.11.
- (3) The new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

#### **20A.11D Member other than the Panel Chair unavailable to complete hearing**

- (1) This regulation applies if:
  - (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  - (b) before the matter has been determined, one of the members (other than the Panel Chair) constituting the Panel has:
    - (i) ceased to be a member; or
    - (ii) for any reason, ceased to be available as a member of the Panel.
- (2) Subject to regulation 20A.11E, the Panel Chair may determine that:
  - (a) the hearing and determination, or the determination, of the matter is to be completed by the Panel constituted by the remaining members of the Panel; or
  - (b) the matter is to be reheard by a new Panel constituted in accordance with regulation 20A.11.
- (3) If a matter is reheard under paragraph (2)(b), the new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

**20A.11E No member ordinarily resident in same country in which incorporated patent attorney subject to proceedings is registered**

- (1) This regulation applies if:
  - (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  - (b) before the matter has been determined, one of the members (other than the Panel Chair) constituting the Panel has:
    - (i) ceased to be a member; or
    - (ii) for any reason, ceased to be available as a member of the Panel; and
  - (c) neither of the remaining members of the Panel is ordinarily resident in the same country in which the incorporated patent attorney that is subject to the proceedings is registered.
- (2) The Panel Chair must, as soon as practicable, give the incorporated patent attorney notice in writing that:
  - (a) one of the members constituting the Panel has ceased to be, or to be available as, a member of the Panel; and
  - (b) neither of the remaining members is ordinarily resident in the same country in which the incorporated patent attorney is registered; and
  - (c) the incorporated patent attorney may, within the period specified in the notice:
    - (i) elect to have the matter completed by the Panel constituted by the remaining members of the Panel; or
    - (ii) elect to have the matter reheard by a new Panel constituted in accordance with regulation 20A.11.
- (3) An election under paragraph (2)(c) must be in writing and given to the Panel Chair within the period specified in the notice.
- (4) The period specified in the notice must be not less than 21 days after the day on which the notice is given.
- (5) Despite subregulation 20A.11(4), if the incorporated patent attorney elects to have the matter completed by the Panel constituted by the remaining members of the Panel, the Panel constituted by the remaining members may hear and determine, or determine, the matter.
- (6) If the Panel Chair does not receive an election within the period specified in the notice or such longer period as the Panel Chair allows, the Panel Chair must arrange for the matter to be reheard by a new Panel constituted in accordance with regulation 20A.11.
- (7) If the matter is reheard in accordance with subparagraph (2)(c)(ii) or subregulation (6), the new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

### **20A.12 Notification of hearing**

- (1) As soon as practicable after receiving an application under regulation 20A.10, the Panel Chair of a Panel of the Disciplinary Tribunal must:
  - (a) fix a day, time and place to hear the application; and
  - (b) 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 a Panel of the Disciplinary Tribunal must be in public.
- (2) However, if the Panel Chair 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 Panel Chair 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 Panel, whether in public or in private; or
    - (ii) matters contained in documents lodged with the Panel or received in evidence by the Panel.
- (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 a Panel of Disciplinary Tribunal**

- (1) At a hearing before a Panel of 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 Panel, or a representative of the party, may request the Panel Chair to summon witnesses.

### **20A.15 Summoning of witnesses**

- (1) For the purpose of a hearing before a Panel of the Disciplinary Tribunal, the Panel Chair may, by written instrument signed by the Panel Chair:
  - (a) summon a person to appear before the Panel 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 Panel:
    - (i) to produce any documents or articles mentioned in the summons; and

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(ii) to give evidence to identify the documents or articles.

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

**20A.16 Offences by persons appearing before a Panel of Disciplinary Tribunal**

(1) A person commits an offence if the person:

- (a) is summoned to appear before a Panel of 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 Panel, 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 Panel Chair reasonably considers is an impediment to the defendant complying with the summons; or
- (b) in relation to subparagraph (1)(b)(iii)—the defendant is excused by the Panel Chair.

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 a Panel of the Disciplinary Tribunal; and
  - (iii) has been paid expenses and allowances 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 subparagraph (3)(a)(iii).

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 a Panel of 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 certain persons**

- (1) A person who is a member of a Panel of the Disciplinary Tribunal conducting a hearing of disciplinary proceedings under this Part has, in the performance of his or her duties as a member of the Panel, 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 a Panel of 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 a Panel of 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 Panel of Disciplinary Tribunal**

- (1) After hearing an application for the cancellation or suspension of the incorporated patent attorney's registration, a Panel of 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 Panel 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 Panel may consider the following:
  - (a) the professional misconduct engaged in;

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- (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 (regardless of when the findings were made) about the conduct of the incorporated attorney in any other proceedings brought before a relevant disciplinary tribunal;
- (e) findings made (regardless of when the findings were made) about the conduct of the incorporated attorney's employees and officers in any other proceedings brought before a relevant 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.

(4) In this regulation:

*relevant disciplinary tribunal* means any of the following:

- (a) the Patents and Trade Marks Attorneys Disciplinary Tribunal established by regulation 20.61 as in force before the commencement of this subregulation;
- (b) the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 as in force on the commencement of this subregulation;
- (c) the Patents and Trade Marks Attorneys Disciplinary Tribunal as continued in force by subregulation 23.42(1) or 23.43(1) of these Regulations or subregulation 22.16(1) or 22.17(1) of the *Trade Marks Regulations 1995*.

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

- (1) Within 14 days after a Panel of the Disciplinary Tribunal makes a decision under regulation 20A.18, the Panel must:
  - (a) prepare a written statement that states:
    - (i) the decision of the Panel; 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 Panel.
- (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.

- (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 a Panel of the Disciplinary Tribunal cancels the registration of an incorporated patent attorney, the Panel Chair may appoint a registered patent attorney to complete the unfinished patents work of the former attorney.
- (2) If a Panel of the Disciplinary Tribunal suspends the registration of an incorporated patent attorney, the Panel Chair 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 Panel Chair 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

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- (b) any other circumstance that the relevant Panel Chair 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* or the *Companies Act 1993* of New Zealand; 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.

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## **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;
  - (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
    - (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.

### 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, 218, 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:
- (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:

(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, 233 or 234 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

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- (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 78 of the *Public Governance, Performance and Accountability Act 2013*; 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 or New Zealand 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) an 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; or
  - (c) an address in New Zealand to which it is practicable and reasonable for a person providing mail delivery services 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), (b) or (c).
- (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 notice of the service in the approved form together with a copy of the document served.
- (5) Service by post is a prescribed means by which a document may be served on, or given or sent to, a person for the purposes of subsection 221(1) of the Act.

### **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.

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- (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:<br>(a) is an SES employee of IP Australia; and<br>(b) acts with the agreement of the Director General of IP Australia        |
| 4    | Another person who:<br>(a) is an SES employee of IP Australia; and<br>(b) acts with the agreement of the Deputy Director General of IP Australia |
| 5    | Another person who:<br>(a) is an SES employee of IP Australia; and<br>(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 the purposes of subsection 222A(7) of the Act, the following are prescribed:

- (a) an act done in relation to proceedings in a court or a tribunal;
- (b) 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:
  - (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;

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- (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](http://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) in relation to a Panel of the Disciplinary Tribunal—the Panel Chair;
  - (d) the Board.

**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 3.14D(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.

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- (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.

### 22.19 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.

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

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- (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.

**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) regulation 5.17 or 5.18 (dismissal of opposition);
  - (iv) regulation 5.19 (determination of opposition);
  - (v) subparagraph 6.2(1)(b)(ii) (prescribed period: grant of standard patent);
  - (va) subregulation 13.4(3);
  - (vi) subregulation 22.21(5) (protection or compensation of certain persons); or
- (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) a Panel of the Disciplinary Tribunal under the following provisions:
  - (i) regulation 20.43 (decision of Panel of Disciplinary Tribunal);
  - (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 Panel 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*

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*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 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.

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## **Chapter 23—Application, saving and transitional 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:
  - (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:

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- (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:
  - (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).

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- (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.

**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.

**renewal fee** means a renewal fee for the purposes of subsection 68(2) of that Act.

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- (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
  - (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*.

**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.

| <b>Transitional provisions</b> |  |   |
|--------------------------------|--|---|
| <b>Item</b>                    | <b>Column 1<br/>The amendments made by:</b>  | <b>Column 2<br/>apply in relation to:</b>   |
| 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 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>  |

**Chapter 23** Application, saving and transitional provisions  
**Part 2** Amendments made by particular instruments

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**Transitional provisions**

| <b>Item</b> | <b>Column 1</b><br><b>The amendments made by:</b> | <b>Column 2</b><br><b>apply in relation to:</b>  |
|-------------|---|--|
| 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**

| <b>Item</b> | <b>Column 1</b><br><b>The amendments made by:</b>                                 | <b>Column 2</b><br><b>apply in relation to:</b>   |
|-------------|---|---|
| 1           | item 2 (new regulation 5.3)   | an opposition proceeding commenced before 15 April 2013   |
| 2           | item 2 (new subregulations 5.9(1) to (5)) and item 9 (new item 218 of Schedule 7) | 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<br>However:<br>(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<br>(b) paragraph 5.10(1)(b) and subregulation 5.10(2), as in force immediately before 15 April 2013, are taken not to apply  |
| 3           | item 2 (new regulation 5.20)  | 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<br>However:<br>(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<br>(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<br>(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<br>(d) regulation 5.12, as in force immediately before |

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**Transitional provisions**

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| <b>Item</b> | <b>Column 1</b><br><b>The amendments made by:</b> | <b>Column 2</b><br><b>apply in relation to:</b>  |
|-------------|---|--|
| 4           | items 2, 7 and 9                                  | <p>15 April 2013, is taken not to apply</p> <p>an opposition proceeding commenced by the filing of a notice of opposition on or after 15 April 2013</p> <p>However, if:</p> <ul style="list-style-type: none"> <li>(a) an amendment was advertised under regulation 10.5 before 15 April 2013; and</li> <li>(b) a notice of opposition is filed for subsection 104(4) of the Act on or after 15 April 2013;</li> </ul> <p>the reference in subregulation 5.10(1) to 2 months is taken to be a reference to 3 months</p> <p>Also, if:</p> <ul style="list-style-type: none"> <li>(a) an opposition proceeding was commenced by the filing of a notice of opposition before 15 April 2013; and</li> <li>(b) a document or evidence was not served in relation to the opposition proceeding before 15 April 2013; and</li> <li>(c) the document or evidence is required to be served on or after 15 April 2013;</li> </ul> <p>then:</p> <ul style="list-style-type: none"> <li>(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</li> <li>(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</li> <li>(f) the Commissioner must give a copy of the document or evidence to the person; and</li> </ul> <p>(g) if:</p> <ul style="list-style-type: none"> <li>(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 party served the document or evidence; and</li> <li>(ii) the Commissioner does not give the document or evidence to the person on the filing date;</li> </ul> <p>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</p> |

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**Transitional provisions**

| <b>Item</b> | <b>Column 1</b><br><b>The amendments made by:</b> | <b>Column 2</b><br><b>apply in relation to:</b>  |
|-------------|---|--|
| 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.

**Transitional provisions**

| <b>Item</b> | <b>Column 1</b><br><b>The amendments made by:</b> | <b>Column 2</b><br><b>apply in relation to:</b>   |
|-------------|---|---|
| 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 Amendment (Raising the Bar) Act 2012</i> |



| <b>Transitional provisions</b> |   |   |
|--------------------------------|---|---|
| <b>Item</b>                    | <b>Column 1<br/>The amendments made by:</b> | <b>Column 2<br/>apply in relation to:</b>   |
| 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>     |
| 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:<br>(a) is related to a patent application; and<br>(b) is not a specification;<br>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>     |
| 23                             | item 43                                     | a PCT application filed with a receiving  |

**Chapter 23** Application, saving and transitional provisions  
**Part 2** Amendments made by particular instruments

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| <b>Transitional provisions</b> |                                |   |
|--------------------------------|--------------------------------|---|
| <b>Item</b>                    | <b>Column 1</b>                | <b>Column 2</b>   |
|                                | <b>The amendments made by:</b> | <b>apply in relation to:</b>  |
|                                |                                | 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 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:<br>(a) the request was published before 15 April 2013;<br>(b) the period to file an opposition under subregulation 5.3(5A) had not expired before 15 April 2013;<br>(c) no notice of opposition was filed before 15 April 2013;<br>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:<br>(a) aircraft, land vehicles and vessels that were foreign aircraft, foreign land   |

| <b>Transitional provisions</b> |   |  |
|--------------------------------|---|--|
| <b>Item</b>                    | <b>Column 1</b>   | <b>Column 2</b>  |
|                                | <b>The amendments made by:</b>                                  | <b>apply in relation to:</b>   |
|                                |   | 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 <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 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                 |

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**Transitional provisions**

| <b>Item</b> | <b>Column 1<br/>The amendments made by:</b> | <b>Column 2<br/>apply in relation to:</b>   |
|-------------|---|---|
| 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 <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**

| <b>Item</b> | <b>Column 1<br/>The amendments made by:</b> | <b>Column 2<br/>do not apply:</b>   |
|-------------|---|---|
| 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>                                |

(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.

### **23.37 Amendments made by *Intellectual Property Legislation Amendment (TRIPS Protocol and Other Measures) Regulation 2015***

(1) The amendments of these Regulations made by Schedule 1 to the *Intellectual Property Legislation Amendment (TRIPS Protocol and Other Measures) Regulation 2015* (the **amending instrument**) apply in relation to patents granted before or after the commencement of that Schedule.

(2) The amendments of these Regulations made by items 2 to 13 of Schedule 4 to the amending instrument apply in relation to the following:

- (a) patents for which the complete application is made after that Schedule commences;
- (b) standard patents for which the application had been made before that Schedule commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that time;
- (c) innovation patents granted after that Schedule commences, if the complete application to which the patent relates had been made before that time;
- (d) complete patent applications made after the time that Schedule commences;
- (e) complete applications for standard patents made before the commencement of that Schedule, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that time;
- (f) complete applications for innovation patents made before that Schedule commences, if a patent had not been granted in relation to the application on or before that time;
- (g) innovation patents granted before that Schedule commences, if:
  - (i) the Commissioner had not decided to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that time; and
  - (ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that time.

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- (3) Regulation 3.25 as repealed and substituted by Schedule 5 of the amending instrument applies in relation to requests made after the commencement of that Schedule, regardless of when the micro-organism was deposited with a prescribed depository institution.
- (4) Regulation 3.25A as inserted by Schedule 5 of the amending instrument applies in relation to applications for standard patents made:
  - (a) after the commencement of that Schedule; and
  - (b) before the commencement of that Schedule, if the complete specification relating to the application is not open to public inspection at that commencement.

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## **Part 3—Transitional provisions for Schedule 4 to the Intellectual Property Laws Amendment Act 2015 and Schedule 1 to the Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016**

### **23.38 Definitions**

In this Part:

*commencement day* means the day on which Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* commences.

*old regulations* means these Regulations as in force immediately before the commencement day.

### **23.39 Removal of name from Register if New Zealand court determines person should not practise as a patent attorney in New Zealand**

- (1) This regulation is made for section 199 of the Act and applies if:
  - (a) an individual is a registered patent attorney; and
  - (b) immediately before the commencement day the individual was registered as a patent attorney in New Zealand (whether or not the individual was also a registered patent attorney in Australia); and
  - (c) on or after that commencement day, the New Zealand Commissioner of Patents advises the Designated Manager that:
    - (i) a New Zealand court has determined that the individual should not practise as a patent attorney in New Zealand; and
    - (ii) all rights of appeal in relation to the court's determination have been exhausted or have expired; and
    - (iii) the conduct giving rise to the court's determination occurred before the commencement day.
- (2) The Designated Manager must remove the name of the individual from the Register of Patent Attorneys as soon as practicable after receiving the advice.

### **23.40 Restoring attorney's name after advice from New Zealand Commissioner of Patents**

For paragraph 198(4)(g) of the Act, if an individual's name is removed from the Register of Patent Attorneys under regulation 23.39, the Designated Manager must not enter the individual's name in the Register unless the Designated Manager has received written advice from the New Zealand Commissioner of

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Patents that a New Zealand court has determined that the individual's name may be entered in the Register.

**23.41 Transitional—registration as a patent attorney**

- (1) This regulation applies in relation to a person if he or she satisfies the following requirements:
  - (a) the person has passed each relevant New Zealand examination mentioned in subregulation (4);
  - (b) the person passed at least one of those examinations before the commencement day;
  - (c) the person passed the remainder of those examinations before the end of the 4-year period beginning on the commencement day.
- (2) For the purposes of subsection 198(4) of the Act (as affected by item 82 of Schedule 4 to the *Intellectual Property Laws Amendment Act 2015*), the person must meet the requirements set out in subregulation (3) instead of the requirements set out in regulations 20.2, 20.3, 20.5, 20.6, 20.7 and 20.8.
- (3) The person's application for registration as a patent attorney must be:
  - (a) in writing, in a form approved by the Designated Manager; and
  - (b) accompanied by the statements and declarations mentioned in paragraphs 20.3(1)(d), (e) and (f); and
  - (c) accompanied by a written declaration signed by the person that he or she satisfies the requirements mentioned in subregulation (1); and
  - (d) accompanied by the fee mentioned in item 104 of Schedule 7.
- (4) For paragraph (1)(a), the relevant examinations are the following examinations jointly arranged and conducted by the New Zealand Commissioner of Patents and the Council of the New Zealand Institute of Patent Attorneys under Part 30 of the Patents Regulations 1954 of New Zealand:
  - (a) an examination on the subject of New Zealand law and practice relating to patents and designs;
  - (b) an examination on the subject of New Zealand law and practice relating to trade marks;
  - (c) an examination on the subject of foreign patent law;
  - (d) an examination on the subject of preparation of specifications for New Zealand patents;
  - (e) an examination on the subject of patent attorney practice in New Zealand, including the interpretation and criticism of patent specifications.

Note: Under subitem 82(2) of Schedule 4 to the *Intellectual Property Laws Amendment Act 2015*, an individual who passes these examinations must apply for registration as a patent attorney under section 198 of the *Patents Act 1990* within 6 months after the completion of the last of the examinations.



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**23.42 Continuation of certain disciplinary proceedings—individuals**

- (1) This regulation applies if:
  - (a) before the commencement day disciplinary proceedings had been commenced against a registered patent attorney by the Professional Standards Board for Patent and Trade Marks Attorneys under Part 8 of Chapter 20 of the old regulations; and
  - (b) the proceedings had not been completed under the old regulations before the commencement day.
- (2) Despite the amendments and repeals made by Schedule 1 to the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*, on and after the commencement day:
  - (a) Part 8 of Chapter 20, and Division 2 of Part 10 of Chapter 20, of the old regulations continue to apply in relation to the proceedings; and
  - (b) the appointment of the person constituting the Patents and Trade Marks Attorneys Disciplinary Tribunal conducting the proceedings is continued in force for the purpose of completing the proceedings; and
  - (c) the Minister may, if necessary, appoint a person under regulation 20.63 or 20.64 of the old regulations in the circumstances mentioned in those regulations for the purpose of completing the proceedings; and
  - (d) for the purposes of the proceedings, references in Part 8 of Chapter 20 of the old regulations to the Professional Standards Board for Patent and Trade Marks Attorneys are taken to be references to the Trans-Tasman IP Attorneys Board.

**23.43 Continuation of certain disciplinary proceedings—incorporated patent attorneys**

- (1) This regulation applies if:
  - (a) before the commencement day disciplinary proceedings had been commenced against an incorporated patent attorney by the Professional Standards Board for Patent and Trade Marks Attorneys under Part 5 of Chapter 20A of the old regulations; and
  - (b) the proceedings had not been completed under the old regulations before the commencement day.
- (2) Despite the amendments and repeals made by Schedule 1 to the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*, on and after the commencement day:
  - (a) Division 2 of Part 10 of Chapter 20, and Part 5 of Chapter 20A, of the old regulations continue to apply in relation to the proceedings; and
  - (b) the appointment of the person constituting the Patents and Trade Marks Attorneys Disciplinary Tribunal conducting the proceedings is continued in force for the purpose of completing the proceedings; and

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- (c) the Minister may, if necessary, appoint a person under regulation 20.63 or 20.64 of the old regulations in the circumstances mentioned in those regulations for the purpose of completing the proceedings; and
- (d) for the purposes of the proceedings, references in Part 5 of Chapter 20A of the old regulations to the Professional Standards Board for Patent and Trade Marks Attorneys are taken to be references to the Trans-Tasman IP Attorneys Board.

**23.44 Termination of appointment of Patents and Trade Marks Attorneys  
Disciplinary Tribunal upon completion of all proceedings**

The Minister must, in writing, terminate the appointment of the person constituting the Patents and Trade Marks Attorneys Disciplinary Tribunal conducting proceedings mentioned in any of the following provisions as soon as practicable after the Minister is satisfied that all such proceedings (including all appeals) have been finalised:

- (a) subregulation 23.42(1);
- (b) subregulation 23.43(1);
- (c) subregulation 22.16(1) of the *Trade Marks Regulations 1995*;
- (d) subregulation 22.17(1) of the *Trade Marks Regulations 1995*.

**23.45 Transitional—exemptions from patents knowledge requirements**

- (1) This regulation applies in relation to an applicant who, before 1 January 2018:
  - (a) has passed a course of study that has outcomes that are the same as, or similar to, those of a knowledge requirement mentioned in Schedule 5 to the old regulations; and
  - (b) has passed the course of study at a satisfactory level.
- (2) Despite the amendments of Schedule 5 made by Schedule 1 to the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*, Schedule 5 to the old regulations continues to apply for the purpose of the Board making a decision to grant an exemption to the applicant under regulation 20.9.

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## **Part 4—Amendments made by the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018**

### **23.46 Amendments made by Part 2 of Schedule 2**

- (1) The amendments of regulations 3.2A, 3.2B, 3.2C, 3.4, 3.5, 3.5A, 3.24, 3.25, 3.25H, 9.1, 9A.1, 9A.4 and 13.4 made by Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to notifications occurring on or after the commencement of that Part.
- (2) Regulation 3.5, as in force immediately before the commencement of Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, continues to apply on and after that commencement in relation to a notice given under subregulation 3.5(4) before that commencement.
- (3) Regulation 3.5A, as in force immediately before the commencement of Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, continues to apply on and after that commencement in relation to a notice given under subregulation 3.5A(2) before that commencement.
- (4) Regulation 3.25, as in force immediately before the commencement of Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, continues to apply on and after that commencement in relation to a notice given under paragraph 3.25(3)(a) before that commencement.

### **23.47 Amendments made by Part 3 of Schedule 2**

- (1) The repeal of regulation 5.3 made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to documents or evidence filed on or after the commencement of that Part.
- (2) The repeal of subregulation 22.12(1) made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to evidence given on or after the commencement of that Part.
- (3) The amendment of subregulation 22.12(2) made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* does not affect the validity of any

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requirement or permission given under that subregulation before the commencement of that Part.

- (4) The amendments of regulation 22.15 made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to documents filed on or after the commencement of that Part.
- (5) Regulation 22.16A, as inserted by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, applies in relation to evidence filed on or after the commencement of that Part.
- (6) The amendments of items 201, 202 and 203 of the table in clause 2 of Schedule 7, and the repeal of regulation 22.2AA (so far as it relates to those items), made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to documents filed on or after the commencement of that Part.
- (7) The amendments of items 211, 212 and 214A of the table in clause 2 of Schedule 7, and the repeal of regulation 22.2AA (so far as it relates to those items), made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to fees paid on or after the commencement of that Part.

**23.48 Amendments made by Part 5 of Schedule 2**

- (1) The amendment of paragraph 3.1(2)(g) made by Part 5 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to a request referred to in that paragraph made on or after the commencement of that Part.
- (2) The amendment of subregulation 5.26(1) made by Part 5 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to a notice of withdrawal filed on or after the commencement of that Part.

**23.49 Amendments made by Part 7 of Schedule 2**

- (1) The repeal and substitution of regulation 3.2 made by Part 7 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to patent requests filed under subsection 29(1) of the Act on or after the commencement of that Part.
- (2) The amendments of regulation 3.2A made by Part 7 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to patent

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requests filed under subsection 29(1) of the Act on or after the commencement of that Part.

- (3) The amendment of regulation 3.2B made by Part 7 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to complete applications made on or after the commencement of that Part.
- (4) The amendments of regulations 3.2C and 3.18 made by Part 7 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to an applicant's compliance with the requirements of subsection 29A(5) of the Act on or after the commencement of that Part (regardless of when the PCT application was made).
- (5) The amendments of regulation 3.5AD made by Part 7 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to PCT applications made on or after the commencement of that Part.
- (6) The amendments of regulations 10.1 and 10.2 made by Part 7 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to requests made under subsection 104(1) of the Act on or after the commencement of that Part.
- (7) The amendment of regulation 22.16 made by Part 7 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to documents received at the Patent Office on or after the commencement of that Part.