

PATENTS 1952.

No. 42 of 1952.

An Act relating to Patents of Inventions.

[Assented to 27th September, 1952.]

BE it enacted by the Queen's Most Excellent Majesty, the Senate, and the House of Representatives of the Commonwealth of Australia, as follows :—

PART I.—PRELIMINARY.

1. This Act may be cited as the *Patents Act 1952*. Short title.
2. This Act shall come into operation on a date to be fixed by Proclamation. Commencement
3. This Act is divided into Parts, as follows :— Parts.
 - Part I.—Preliminary (Sections 1-9).
 - Part II.—Administration (Sections 10-19).
 - Part III.—The Register of Patents (Sections 20-33).
 - Part IV.—Applications for Patents (Sections 34-58).
 - Part V.—Opposition (Sections 59-61).
 - Part VI.—Patents and their Sealing (Sections 62-71).
 - Part VII.—Patents of Addition (Sections 72-76).
 - Part VIII.—Amendment of Specifications (Sections 77-89).

- Part IX.—Extension of Patents (Sections 90–96).
 Part X.—Restoration of Patents (Sections 97–98).
 Part XI.—Revocation and Surrender of Patents
 (Sections 99–107).
 Part XII.—Working of Patents and Compulsory Licences
 (Sections 108–112).
 Part XIII.—Infringement of Patents (Sections 113–124).
 Part XIV.—The Crown (Sections 125–132).
 Part XV.—Patent Attorneys (Sections 133–139).
 Part XVI.—International Arrangements (Sections 140–
 145).
 Part XVII.—The Appeal Tribunal (Sections 146–151).
 Part XVIII.—Miscellaneous (Sections 152–177).

Repeal.

4.—(1.) The Acts specified in the first column of the Schedule to this Act are repealed to the extent respectively specified in the second column of that Schedule.

(2.) The provisions of sections ninety-seven to one hundred (inclusive) of the *Patents Act* 1903–1950 continue, notwithstanding the repeal effected by the last preceding sub-section, to apply in relation to inventions in respect of which directions have been given under section ninety-six of that Act.

Application of act.

5.—(1.) This Act applies to and in relation to all applications for patents lodged after the commencement of this Act and to and in relation to all patents granted on those applications.

(2.) Subject to sub-section (2.) of section one hundred and seventy-six of this Act, this Act also applies to and in relation to patents granted under the repealed Acts.

(3.) The repealed Acts apply, notwithstanding their repeal, to and in relation to all applications for patents lodged before the commencement of this Act and to the sealing of patents on those applications, but this Act applies to and in relation to the patents so sealed.

(4.) The priority date of each claim of the complete specification of a patent referred to in either of the last two preceding sub-sections is—

- (a) the date of the patent ; or
- (b) in the case of a single patent granted on two or more applications, the date of the application which was accompanied by the provisional specification to which the claim relates, and any reference in this Act to a priority date indicated in a claim includes a reference to such a priority date.

Definitions.

6. In this Act, unless the contrary intention appears—

- “actual inventor” does not include a person merely importing an invention from abroad ;
- “Australia” includes the Territories of the Commonwealth to which this Act extends ;

- “ Convention country ” means a country in respect of which there is in force for the time being a Proclamation declaring that country to be a Convention country for the purposes of this Act ;
- “ date of application ”, or “ date of the application ”, in relation to an application for a patent, means—
- (a) in the case of an application which is post-dated under this Act, the date to which the application is so post-dated ; and
 - (b) in any other case, the date on which the application is lodged in the Patent Office ;
- “ Examiner ” means a Supervising Examiner of Patents, or an Examiner of Patents, holding office under this Act ;
- “ exclusive licensee ” means a licensee under a licence granted by the patentee which confers on the licensee, or on the licensee and persons authorized by him, the right to make, use, exercise and vend the patented invention, throughout Australia, to the exclusion of all other persons, including the patentee ;
- “ invention ” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies, and includes an alleged invention ;
- “ legal practitioner ” means a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory of the Commonwealth ;
- “ legal representative ”, in relation to a deceased person, means a person to whom Probate of the will of the deceased person, Letters of Administration of the estate of the deceased person or other like grant has been granted, whether in Australia or elsewhere, but does not include such a person who, by reason of the terms of the grant, is not entitled to do an act in relation to which the expression is used ;
- “ licence ” means a licence under a patent ;
- “ patent ” means letters patent for an invention granted under the repealed Acts or under this Act ;
- “ patented article ” means an article in respect of which a patent has been granted and is still in force ;
- “ patented process ” means a process in respect of which a patent has been granted and is still in force ;
- “ patentee ” means the person for the time being entered on the Register as the grantee or proprietor of a patent ;
- “ State Patent Act ” means a State Act relating to patents and includes regulations made under any such Act ;
- “ the Commissioner ” means the Commissioner of Patents or the Deputy Commissioner of Patents holding office under this Act and includes an Assistant Commissioner of Patents, or a Supervising Examiner of Patents, exercising powers or functions delegated to him under this Act ;

“the *Official Journal*” means the Official Journal referred to in section one hundred and seventy-five of this Act ;

“the Patent Office” means the Patent Office established under this Act ;

“the Register” means the Register of Patents referred to in sub-section (1.) of section twenty of this Act ;

“the repealed Acts” means the Acts repealed by this Act ;

“the Statute of Monopolies” means the Imperial Act known as The Statute of Monopolies ;

“this Act” includes the regulations.

Crown to be bound.

7. This Act binds the Crown in right of the Commonwealth and of the several States.

Extension to Territories.

8. This Act extends to the Territory of Norfolk Island, the Territory of Papua and the Territory of New Guinea as if each of those Territories were part of the Commonwealth, and no application for a patent is receivable under a law (other than this Act) in force in any of those Territories.

No new application to be made under State Acts.

9. An application for a patent under a State Patent Act is not receivable.

PART II.—ADMINISTRATION.

Commissioner of Patents and other officers.

10.—(1.) There shall be a Commissioner of Patents, who shall, under the Attorney-General, have the chief control of the Patent Office.

(2.) There shall be a Deputy Commissioner of Patents, who shall, subject to the control of the Commissioner of Patents, have all the powers and functions of the Commissioner of Patents under this Act, other than the powers of the Commissioner under the next succeeding section.

(3.) Where, under this Act, the exercise of a power or function by the Commissioner, or the operation of a provision of this Act, is dependent upon the opinion, belief or state of mind of the Commissioner in relation to a matter, that power or function may be exercised by the Deputy Commissioner of Patents, or that provision may operate, as the case may be, upon the opinion, belief or state of mind of the Deputy Commissioner of Patents in relation to that matter.

(4.) There shall be one or more Assistant Commissioners of Patents.

(5.) There shall be so many Supervising Examiners of Patents and Examiners of Patents as are necessary.

(6.) The persons holding office as Commissioner of Patents and Examiners of Patents (including Supervising Examiners of Patents) at the commencement of this Act shall continue to hold those offices respectively.

Delegation by Commissioner.

11.—(1.) The Commissioner of Patents may, in relation to a particular matter or class of matters, by writing under his hand, delegate all or any of his powers or functions under this Act (except

this power of delegation) to an Assistant Commissioner of Patents, or to a Supervising Examiner of Patents, so that the delegated powers and functions may be exercised by the delegate with respect to the matter or class of matters specified in the instrument of delegation.

(2.) A delegation under this section is revocable at will and no delegation prevents the exercise of a power or function by the Commissioner of Patents or by the Deputy Commissioner of Patents.

12. For the purposes of this Act, there shall be an office which shall be known as the Patent Office. Patent Office.

13. There shall be a seal of the Patent Office and impressions of the seal shall be judicially noticed. Seal of Patent Office.

14. The Commissioner may, for the purposes of this Act— Powers of Commissioner.

- (a) summon witnesses ;
- (b) receive evidence on oath, whether orally or otherwise ;
- (c) require the production of documents or articles ; and
- (d) award costs against a party to proceedings before him.

15. Costs awarded by the Commissioner against a party may, in default of payment, be recovered in a court of competent jurisdiction as a debt due by the person against whom the costs were awarded to the person in whose favour they were awarded. Recovery of costs awarded by Commissioner.

16.—(1.) A person who has been summoned to appear as a witness before the Commissioner shall not, without lawful excuse, and after tender of reasonable expenses, fail to appear in obedience to the summons. Disobedience to summons an offence.

(2.) A person who has been required by the Commissioner to produce a document or article shall not, without lawful excuse, and after tender of reasonable expenses, fail to produce the document or article.
Penalty : Fifty pounds.

17. A person who appears before the Commissioner shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents or articles, or to answer questions, which he is lawfully required to produce or answer. Refusal to give evidence an offence.
Penalty : Fifty pounds.

18.—(1.) An officer or person employed in the Patent Office shall not buy, sell, acquire or traffic in an invention or patent, whether granted in Australia or elsewhere, or in a right to, or licence under, a patent, whether granted in Australia or elsewhere. Officers not to traffic in inventions.
Penalty : One hundred pounds.

(2.) A purchase, sale, acquisition, assignment or transfer made or entered into in contravention of this section is void.

(3.) This section does not apply to the actual inventor or to an acquisition by bequest or devolution in law.

Officers not to furnish information, &c.

19. An officer or person employed in the Patent Office shall not, except when required or authorized by this Act, or under a direction in writing of the Commissioner or by order of a court—

- (a) furnish information on a matter which is being, or has been, dealt with under this Act or under the repealed Acts ;
- (b) prepare, or assist in the preparation of, a document required or permitted by or under this Act or the repealed Acts to be lodged in the Patent Office ; or
- (c) conduct a search in the records of the Patent Office.

Penalty : One hundred pounds.

PART III.—THE REGISTER OF PATENTS.

Register of Patents.

20.—(1.) There shall be kept at the Patent Office a Register of Patents, in which shall be entered—

- (a) particulars of patents in force ; and
- (b) such other matters as are prescribed.

(2.) The Register of Patents kept under the repealed Acts shall be incorporated with and form part of the Register under this Act.

(3.) A copy of the Register, or of such portion of the Register as the Commissioner directs, shall be kept at such places as the Commissioner directs.

Registration of assignments, transmissions, &c.

21. Where a person becomes entitled to a patent by assignment, transmission or other operation of law, he shall apply to the Commissioner to register his title, and the Commissioner shall, on receipt of the application, and on proof to the satisfaction of the Commissioner of the title of the applicant, cause the applicant to be entered in the Register as the proprietor of the patent.

Probate or Letters of Administration need not be resealed.

22. Where a patentee has died, the Commissioner shall, subject to the next succeeding section, and notwithstanding section twenty-five of this Act, on the application of the legal representative of the deceased patentee, if he is satisfied that the legal representative is entitled to be registered as the proprietor of the patent, register him accordingly.

Registration of mortgages, licences, &c.

23. Where a person becomes entitled as mortgagee, licensee or otherwise to an interest in a patent, he shall apply to the Commissioner to register his title, and the Commissioner shall, on receipt of the application, and on proof to the satisfaction of the Commissioner of the title of the applicant, cause notice of the interest to be entered in the Register, together with particulars of the instrument creating the interest.

Copies of deeds and documents to be supplied.

24. Attested copies of all deeds and documents affecting the proprietorship of a patent or licence shall be supplied to the Commissioner in the prescribed manner and shall be filed in the Patent Office.

25. Except in pursuance of section one hundred and twenty-nine of this Act, notice of a trust, expressed, implied or constructive, relating to a patent or licence shall not be entered on the Register or be receivable by the Commissioner.

Trusts not recognized.

26. A patentee has, subject only to any rights appearing in the Register to be vested in some other person, power to deal with the patent as if he were the absolute owner of the patent and to give good discharges for any consideration for any such dealing.

Power of registered proprietor to deal with patent.

27. The last preceding section does not apply so as to protect a person dealing with a patentee otherwise than as a *bona fide* purchaser for value and without notice of any fraud on the part of the patentee and equities in relation to a patent may be enforced against the patentee except to the prejudice of a *bona fide* purchaser for value.

Exception in case of fraud.

28. Subject to this Act, the Register, and all documents filed in the Patent Office under this Part, shall, at all convenient times, be open for inspection by any person.

Register to be open for inspection.

29.—(1.) The Register is *prima facie* evidence of all matters required or authorized by this Act to be entered in the Register.

Register and certified copies to be evidence.

(2.) The Commissioner may, subject to this Act, supply copies of or extracts from the Register, or of or from a document, abridgment, specification or publication in the Patent Office or the library of the Patent Office, certified by writing under his hand and the seal of the Patent Office, and any such copy or extract so certified and sealed is admissible in evidence in all courts and proceedings without further proof or production of the original.

(3.) The Commissioner may, subject to this Act, certify, by writing under his hand and the seal of the Patent Office—

- (a) that an entry, matter or thing required or permitted by or under this Act or the repealed Acts to be made or done, or not to be made or done, has, or has not, as the case may be, been made or done ; or
- (b) that a document, abridgment, specification or publication in the Patent Office, or in the library of the Patent Office, was made available for public inspection in the Patent Office, or in the library of the Patent Office, on the date specified in the certificate,

and any such certificate is *prima facie* evidence of the statements contained in the certificate.

30. The Commissioner may, subject to this Act, furnish information as to a matter affecting or relating to—

- (a) a patent ;
- (b) an application for a patent which is open to public inspection ;
or
- (c) any other document, abridgment, specification or publication in the Patent Office or the library of the Patent Office.

Request for information as to patent or patent application.

Unregistered
instruments
not to be
admitted in
evidence.

31. A document or instrument in respect of which no entry has been made in the Register in accordance with the provisions of this Act is not, unless the court otherwise directs, admissible in evidence in a court in proof of the title to a patent or to an interest in a patent, except—

- (a) in proceedings to enforce equities in relation to a patent or licence ; or
- (b) in an application made under the next succeeding section.

Rectification
of Register.

32.—(1.) The High Court may, on the application of a person aggrieved by—

- (a) the omission of an entry from the Register ;
- (b) an entry made in the Register without sufficient cause ;
- (c) an entry wrongly existing in the Register ; or
- (d) an error or defect in an entry in the Register,

make such order as it thinks fit directing the rectification of the Register.

(2.) The High Court may, in proceedings under this section, decide any question which it is necessary or expedient to decide in connexion with the rectification of the Register.

(3.) Notice of an application under this section shall be given to the Commissioner, who may appear and be heard, and shall appear if so directed by the High Court.

(4.) An office copy of the order shall be served on the Commissioner, and the Commissioner shall, upon receipt of the order, rectify the Register accordingly.

False entries
in Register.

33. A person shall not wilfully—

- (a) make or cause to be made a false entry in the Register ; or
- (b) produce or tender in evidence a document falsely purporting to be a copy of or extract from an entry in the Register or of or from a document in the Patent Office.

Penalty : Imprisonment for three years.

PART IV.—APPLICATIONS FOR PATENTS.

Who may
apply for
patent.

34.—(1.) Any of the following persons, whether a British subject or not, may make an application for a patent :—

- (a) the actual inventor ;
- (b) the assignee of the actual inventor ;
- (c) the legal representative of a deceased actual inventor ;
- (d) the legal representative of a deceased assignee of the actual inventor ;
- (e) a person to whom the invention has been communicated by the actual inventor, his legal representative or assignee (if the actual inventor, his legal representative or assignee is not resident in Australia) ;

- (f) the assignee of such a legal representative as is specified in paragraph (c) or (d) of this sub-section ; or
 (g) the agent or attorney of a person referred to in any of the preceding paragraphs.

(2.) Two or more persons may make a joint application for a patent and a patent may be granted to them jointly.

(3.) An assignee of a part interest in an invention may make a joint application for a patent with any of the persons referred to in sub-section (1.) of this section and a patent may be granted to them jointly.

35.—(1.) An application for a patent—

Form of application.

- (a) shall be for one invention only ;
 (b) shall be made in the prescribed form ;
 (c) shall be lodged by being left at or delivered by post to the Patent Office ; and
 (d) shall be accompanied by either a provisional specification or a complete specification.

(2.) The application shall be signed by the applicant.

(3.) A declaration setting out—

- (a) the facts relied on to support the application ; and
 (b) except in the case of an application under Part XVI., that the applicant is in possession of the invention forming the subject of the application,

shall be lodged before acceptance of the application.

(4.) The declaration shall be made by the applicant, or, if the applicant is a body corporate, by a person authorized by the body corporate to make the declaration on its behalf.

36. Subject to this Act, an application dates from the date when the application is lodged in the Patent Office.

Date of application.

37. An application shall not be withdrawn except on a request signed by the applicant.

Withdrawal of application.

38. A specification (whether a provisional specification or a complete specification) shall commence with a title indicating the subject matter to which the invention relates.

Title of invention.

39. A provisional specification shall describe the invention

Provisional specification.

40.—(1.) A complete specification—

Complete specification.

- (a) shall fully describe the invention, including the best method of performing the invention which is known to the applicant ; and
 (b) shall end with a claim or claims defining the invention.

(2.) The claim or claims shall be clear and succinct and shall be fairly based on the matter described in the specification.

Time for leaving complete specification.

41.—(1.) If the applicant does not lodge a complete specification with his application, he may lodge it at any time within twelve months after the date of the application.

(2.) Unless a complete specification is lodged in accordance with this section the application shall lapse.

Complete specification may be treated as provisional.

42. Where an application is accompanied by a specification purporting to be a complete specification, the Commissioner may, if the applicant so requests and the specification has not become open to public inspection, direct that the specification be treated as a provisional specification and, in that case, the specification shall, for all the purposes of this Act, be deemed to be a provisional specification.

Publication of complete specification.

43.—(1.) At the expiration of six months after a complete specification has been lodged, the Commissioner shall publish in the *Official Journal* a notification that the complete specification is open to public inspection and, upon publication of the notification, the application, complete specification and provisional specification (if any) shall, subject to this Act, be open to public inspection.

(2.) When a complete specification has become open to public inspection in pursuance of the last preceding sub-section it shall be deemed to have been published.

Each claim of complete specification to have priority date.

44.—(1.) There shall be a priority date for each claim of a complete specification.

(2.) A claim of a complete specification shall indicate the date which the applicant considers to be the priority date of that claim.

Priority dates.

45.—(1.) Subject to this Act, the priority date of a claim of a complete specification is the date of lodgment of that complete specification.

(2.) Subject to the next succeeding sub-section, the priority date of a claim of a complete specification received after a provisional specification, being a claim fairly based on matter disclosed in the provisional specification, is the date of lodgment of that provisional specification.

(3.) The priority date of a claim of a complete specification accepted by the Commissioner under section fifty of this Act in respect of two or more provisional specifications, being a claim fairly based on matter disclosed in one or more of those provisional specifications, is the date of lodgment of the provisional specification in which that matter was first disclosed.

(4.) The priority date of a claim of a complete specification lodged in respect of a further application made by virtue of section fifty-one of this Act, being a claim fairly based on matter disclosed in the provisional specification or complete specification lodged in respect of the original application, is the date which would have been the priority date of that claim if that claim had been included in the complete specification lodged in respect of the original application.

46. A patent is not invalid, so far as it relates to a claim of the complete specification, by reason only of—

- (a) the publication or use of the invention in Australia, so far as claimed in that claim, on or after the priority date of that claim ; or
- (b) the grant of another patent which claims the invention, so far as claimed in the first-mentioned claim, in a claim of the same or a later priority date.

Validity of patent not affected by publication, &c., after priority date.

47.—(1.) An Examiner shall, in respect of each application and specification, report whether the application and specification comply with the requirements of this Act.

Applications to be examined.

(2.) The report made under the last preceding sub-section in respect of a complete specification shall include a report as to whether the priority date of each claim as indicated by the applicant is the priority date of that claim as determined by this Act.

(3.) Nothing in this section requires the examination of a provisional specification before the complete specification has been lodged.

48.—(1.) In the case of a complete specification the Examiner shall—

Report by Examiner as to novelty.

- (a) ascertain and report whether the invention, so far as claimed in any claim, is the subject of a claim of the complete specification of another application for a patent lodged in Australia, being a claim having a priority date earlier than the priority date of the first-mentioned claim ;
- (b) ascertain and report whether the invention, so far as claimed in any claim, has been published before the priority date of that claim in a specification lodged in respect of an application for a patent made in Australia within fifty years before that date ;
- (c) ascertain and report whether the invention, so far as claimed in any claim, is the subject of a claim of earlier priority date contained in the complete specification of a patent ;
- (d) ascertain, as directed by the Commissioner, and report whether the invention, so far as claimed in any claim, has been published in Australia before the priority date of that claim in a document, not being a document referred to in paragraph (a) of sub-section (1.) of section one hundred and fifty-eight of this Act ; and
- (e) report whether, to the best of his knowledge, the invention, so far as claimed in any claim, was, or was not, novel on the priority date of that claim.

(2.) The reference in paragraph (a) of the last preceding sub-section to an application does not include a reference to an application which has lapsed or has been refused or withdrawn or to an application

upon which a patent has been granted and the reference in paragraph (c) of that sub-section to a patent does not include a reference to a patent which is not in force.

(3.) If the Examiner reports adversely to a complete specification under paragraph (a) of sub-section (1.) of this section, the Commissioner may defer acceptance of the application and complete specification until a patent has been sealed on the other application.

Action on
Examiner's
report

49.—(1.) If the Examiner reports adversely to an application or specification under either of the last two preceding sections, the applicant may amend the application or specification so as to remove the grounds of objection and the amended application or specification shall be again reported on in like manner as the original application or specification.

(2.) If the applicant does not amend the application or specification to the satisfaction of the Commissioner, the Commissioner may direct that the application or specification be amended to his satisfaction within such time as the Commissioner allows.

(3.) The applicant may make a separate application for a patent for an invention excluded by an amendment made, or to be made, under this section and the Commissioner may direct that the priority date of any claim of the complete specification accompanying that application shall be such date as the Commissioner determines, being a date not later than the date of the separate application and not earlier than the priority date of the claim excluded by the amendment, or, if two or more claims were so excluded, not earlier than the priority date of whichever of those claims had the earlier or earliest priority date.

(4.) An appeal lies to the Appeal Tribunal from a direction of the Commissioner under this section.

Single patent
for cognate
inventions.

50.—(1.) Where two or more applications for patents accompanied by provisional specifications have been lodged, the applicant or applicants may, if the inventions described in those provisional specifications are so related as to constitute one invention, lodge one complete specification in respect of those applications.

(2.) The Examiner shall report whether the inventions described in those provisional specifications are so related as to constitute one invention.

(3.) If the Commissioner is of opinion that the inventions described in the provisional specifications are so related as to constitute one invention, he may accept the complete specification lodged in respect of the applications and grant one patent on the applications.

(4.) Where the applications were lodged by different applicants, the patent shall be granted to them jointly.

(5.) For the purposes of this section, the reference to an applicant includes a reference to the legal representative or assignee of an applicant.

(6.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

51.—(1.) A person who has made an application for a patent may, at any time before publication of the complete specification, make one or more further applications in respect of an invention disclosed in the provisional specification or complete specification lodged in respect of the first-mentioned application.

Division of application.

(2.) An application under the last preceding sub-section shall be accompanied by a complete specification.

52.—(1.) If the Commissioner is satisfied that there is no lawful ground of objection to an application and complete specification, or that the grounds of objection to an application and complete specification have been removed, the Commissioner shall accept the application and complete specification; if he is not so satisfied, he may refuse to accept the application and complete specification.

Acceptance of application and complete specification.

(2.) Where an application and complete specification have been accepted, the Commissioner shall give notice in writing of the acceptance to the applicant and shall, within three months after the date of acceptance, advertise the acceptance in the *Official Journal*.

(3.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

53.—(1.) Subject to sub-section (3.) of section forty-eight of this Act and to the next two succeeding sub-sections, the time within which an application and complete specification may be accepted is fifteen months from the date on which the first report of the Examiner on the complete specification was sent to the applicant.

Time for acceptance.

(2.) Where—

- (a) an appeal under any of the provisions of this Act has been instituted in respect of an application; or
- (b) in the case of an application for a patent of addition, an appeal under any of the provisions of this Act has been instituted in respect either of that application or of the application for the original patent,

the time within which the application and complete specification may be accepted is extended until the expiration of three months after the determination of the appeal or until the expiration of such further time as the Appeal Tribunal allows.

(3.) Where—

- (a) the time within which an appeal mentioned in the last preceding sub-section may be instituted has not expired; or
- (b) the applicant has died.

the Commissioner may extend, until the expiration of such further time as he determines, the time within which the application and complete specification may be accepted.

Lapsing of application.

54. Where an application and specification have not been accepted within the time for acceptance, or acceptance of an application and specification has not been advertised within three months after the date of acceptance, the application shall lapse.

Certain documents not to be published.

55.—(1.) Subject to this Act—

(a) an Examiner's report on an application or specification ;

(b) an application or a provisional specification—

(i) in respect of which a complete specification has not been lodged ; or

(ii) in respect of which a complete specification has been lodged but the complete specification has not become open to public inspection ; or

(c) a complete specification which has not become open to public inspection,

shall not—

(d) be published or be open for public inspection ; or

(e) be liable to be inspected or produced before the Commissioner or in a legal proceeding, unless the Commissioner, court, or officer having power to order inspection or production, directs that the inspection or production ought to be allowed.

(2.) Notice of an application for the production in a legal proceeding of a report, an application or a specification, under the last preceding sub-section, shall be served on the Commissioner, who shall be entitled to be heard on the application.

Result of search may be disclosed.

56. The Commissioner may disclose the result of a search made under section forty-eight of this Act.

Effect of publication of complete specification.

57. After the publication of a complete specification and until the sealing of a patent on the application, the applicant has, subject to section sixty-seven of this Act, the like privileges and rights as he would have had if a patent for the invention had been sealed on the date of the publication of the complete specification.

Validity of patent not guaranteed.

58. The investigation and reports referred to in this Act do not in any way guarantee the validity of a patent and the Commonwealth, the Commissioner, or an officer or person employed in the Patent Office, is not liable, by reason of, or in connexion with, any such investigation or report or any proceedings consequent on any such investigation or report.

PART V.—OPPOSITION.

59.—(1.) The Attorney-General or a person interested may, at any time within three months after the date of the advertisement of the acceptance of an application and complete specification, or within such further period, not exceeding three months, as the Commissioner, on an application made to him within the first-mentioned period, allows, by notice in writing lodged at the Patent Office, oppose the grant of the patent on one or more of the following grounds, but on no other ground :—

Opposition to
grant of patent.

- (a) that the invention, so far as claimed in any claim, was obtained from the opponent, or from a person of whom the opponent is the legal representative, assignee, agent or attorney ;
- (b) in the case of an invention communicated from abroad, that the invention was not communicated to the applicant by the actual inventor or his legal representative or assignee ;
- (c) that the invention, so far as claimed in any claim, is the subject of a claim of the complete specification of another application for a patent lodged in Australia, being a claim the priority date of which is earlier than the priority date of the first-mentioned claim ;
- (d) that the invention, so far as claimed in any claim, is the subject of a claim of earlier priority date contained in the complete specification of a patent ;
- (e) that the invention, so far as claimed in any claim, was published in Australia before the priority date of that claim ;
- (f) that the invention, so far as claimed in any claim, is not a manner of manufacture within the meaning of section six of the Statute of Monopolies ;
- (g) that the invention, so far as claimed in any claim, was obvious and did not involve an inventive step, having regard to what was known or used in Australia on or before the priority date of that claim ;
- (h) that the invention, so far as claimed in any claim, was, before the priority date of that claim, otherwise not novel in Australia ; and
- (i) that the complete specification does not comply with the requirements of section forty of this Act.

(2.) The reference in paragraph (c) of the last preceding sub-section to an application does not include a reference to an application which has lapsed or has been refused or withdrawn or to an application upon which a patent has been granted and the reference in paragraph (d) of that sub-section to a patent does not include a reference to a patent which is not in force.

(3.) For the purposes of this section, no account shall be taken of any secret use.

(4.) This section is subject to section one hundred and fifty-eight of this Act.

Notice of
opposition to
applicant and
hearing.

60.—(1.) Where notice of opposition is given under the last preceding section, the opponent shall serve a copy of the notice on the applicant, and the Commissioner shall, after hearing the applicant and the opponent, if desirous of being heard, decide the case.

(2.) In so deciding the case—

- (a) the Commissioner may take into account a ground of opposition specified in the last preceding section whether relied upon by the opponent or not; and
- (b) the Commissioner may direct that a date other than the date indicated in a claim be the priority date of that claim.

(3.) Where the Commissioner finds that the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent, he may, on the application of the actual inventor, or of some other person referred to in section thirty-four of this Act, made in accordance with the provisions of this Act, grant to the applicant a patent for the invention, so far as so claimed, and the claims of the complete specification of that patent shall have the same priority date as the priority date of the first-mentioned claim.

(4.) The grant of a patent shall not be refused on the ground specified in paragraph (c) of sub-section (1.) of the last preceding section if a patent has not been sealed on the application mentioned in that paragraph.

(5.) The applicant, and an opponent who, in the opinion of the Appeal Tribunal is entitled to be heard in opposition to the grant, may appeal to the Appeal Tribunal from a decision of the Commissioner under this section.

Notice of
opposition may
be given on
basis that
indicated
priority date
is incorrect.

61.—(1.) An opponent may, in a notice of opposition under section fifty-nine of this Act, specify a ground of opposition by reference either to the priority date indicated in the relevant claim or by reference to a date which the opponent alleges to be the priority date of that claim as determined by this Act.

(2.) If the Commissioner finds that a date other than the date indicated in the claim (whether that other date is the date alleged in the notice of opposition or not) is the priority date of the claim as determined by this Act, he shall, in deciding the case, treat the first-mentioned date as the priority date of the claim.

PART VI.—PATENTS AND THEIR SEALING.

Sealing of
patent.

62. If there is no opposition to the grant of a patent, or, in case of opposition, if the Commissioner's decision, or the decision on appeal from that decision, is that a patent should be granted, the Commissioner shall cause a patent, in accordance with the prescribed form, to be sealed with the seal of the Patent Office.

63.—(1.) Where—

- (a) an applicant or his legal representative has agreed in writing to assign a patent, or a part interest in a patent, when granted, to another person, and refuses to proceed with the application ;
- (b) two or more applicants have lodged a complete specification under section fifty of this Act, and one or more of those applicants refuses to proceed with his application ;
- (c) one of two or more joint applicants refuses to proceed with the application ; or
- (d) a person who has filed an attested copy of an agreement under the next succeeding section refuses to proceed with the application,

Refusal of assignee or joint applicant to proceed.

the Commissioner may determine the person who may be allowed to proceed with the application and may grant a patent to him.

(2.) Where a dispute arises between—

- (a) joint applicants or their assignees ; or
- (b) an applicant and an assignee,

as to the manner of proceeding with an application, the Commissioner may determine the manner in which the application shall proceed.

(3.) The Commissioner shall, if so required, hear a person interested in the application.

(4.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

64. Where an applicant has agreed in writing to assign the patent, or a part interest in the patent, when granted, the patent may, upon proof of the agreement to the satisfaction of the Commissioner, and upon an attested copy of the agreement being filed in the Patent Office, be granted to the assignee, or, in the case of an assignment of a part interest in the patent, to the assignee jointly with the other applicant in whom the remaining interest in the patent is vested.

Assignment of patent before grant.

65.—(1.) If an applicant dies before the sealing of a patent on his application, the patent may be granted to his legal representative.

Death of applicant.

(2.) Where, at any time after a patent has been sealed on an application, the Commissioner is satisfied that the patentee had died, or, in the case of a body corporate, had ceased to exist, before the patent was sealed, the Commissioner may amend the patent by substituting for the name of the patentee the name of the person to whom the patent ought to have been granted.

(3.) Where the Commissioner has amended a patent under the last preceding sub-section, the patent has effect, and shall be deemed always to have had effect, accordingly.

66.—(1.) Subject to this section, a patent shall be sealed as soon as may be, and not after six months from the date of the advertisement of the acceptance of the application and complete specification or after the expiration of such further period as is provided by the succeeding sub-sections of this section, or as the High Court allows.

Time for sealing.

(2.) Where the Commissioner has allowed an extension of time within which notice of opposition to the grant of the patent may be given and notice of opposition has not been given, an extension of time for the same period, or the aggregate of the periods, if more than one, after the period of six months referred to in the last preceding sub-section shall be allowed for the sealing of the patent.

(3.) Where the sealing of a patent is delayed by—

(a) opposition to the grant of the patent ;

(b) the taking of proceedings for obtaining the decision of the Commissioner under section sixty-three of this Act ; or

(c) an appeal to the Appeal Tribunal,

that patent, and any patent of addition the sealing of which is delayed in consequence of the delay in the sealing of the first-mentioned patent, may be sealed at such time as—

(d) in a case to which paragraph (a) or (b) of this sub-section applies—the Commissioner directs ; or

(e) in a case to which paragraph (c) of this sub-section applies—the Appeal Tribunal directs.

(4.) Where an applicant dies before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after his death or within such further period as the Commissioner directs.

(5.) Where the Commissioner is satisfied that hardship would arise in connexion with the prosecution by an applicant of an application for a patent in a country outside Australia unless the period for sealing the patent is extended, the Commissioner may extend the period for such time as appears to him to be necessary in order to prevent that hardship arising.

(6.) Where a patent cannot be sealed within the period allowed by or under this section, that period may, on application made to the Commissioner within the prescribed time, but subject to the regulations, be extended for such further period as is prescribed.

Date of
patent.

67.—(1.) Subject to this Act, a patent shall be dated as of the day on which the complete specification was lodged.

(2.) Subject to this Act, a patent granted on an application made under sub-section (3.) of section forty-nine of this Act or under sub-section (1.) of section fifty-one of this Act shall be dated as of the date of lodgment of the complete specification in which the invention the subject of the application was first disclosed.

(3.) Where two or more applications are lodged for patents for the same invention, the sealing of a patent on one of those applications does not prevent the sealing of a patent on any of the other applications.

(4.) A person is not entitled to institute proceedings for infringement unless and until a patent for the invention has been sealed or in respect of an infringement committed before the publication of the complete specification.

68.—(1.) Subject to this Act, the term of a patent shall be sixteen years, reckoned from the date of the patent. Term of patent.

(2.) Subject to the next succeeding sub-section, every patent shall cease if the patentee fails to pay a renewal fee within the prescribed time.

(3.) If a patentee fails to pay a renewal fee within the prescribed time, he may apply to the Commissioner for an extension of the time for making that payment, and the Commissioner shall extend the time accordingly, but the time for making a payment shall not be extended for more than six months.

69. Subject to this Act, the effect of a patent is to grant to the patentee the exclusive right, by himself, his agents and licensees, during the term of the patent, to make, use, exercise and vend the invention in such manner as he thinks fit, so that he shall have and enjoy the whole profit and advantage accruing by reason of the invention during the term of the patent. Effect of patent.

70. A patent has effect throughout Australia. Extent of patent.

71. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Commissioner, the Commissioner may cause a duplicate of the patent to be sealed. Loss or destruction of patent.

PART VII.—PATENTS OF ADDITION.

72. Where a patent for an invention has been applied for or granted and a person (being the applicant or patentee or some other person with the consent of the applicant or patentee) applies for a further patent in respect of an improvement in, or modification of, the invention (in this Part referred to as “the main invention”), the first-mentioned person may, in his application for the further patent, request that the term of that patent shall be the same as that of the patent for the main invention or so much of that term as is unexpired. Application for patent of addition.

73.—(1.) Where an application containing such a request is made, the Commissioner may, subject to this Part, grant a patent (in this Act referred to as a “patent of addition”), and the term of the patent so granted shall, subject to this Part, be the term referred to in the last preceding section. Grant of patent of addition.

(2.) A patent shall not be granted as a patent of addition unless the date of lodging of the complete specification was the same as, or later than, the date of lodging of the complete specification in respect of the main invention.

(3.) A patent of addition shall not be sealed before the sealing of a patent for the main invention.

(4.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

Revocation of patent and grant of patent of addition in lieu.

74. Where an invention, being an improvement in, or modification of, an original invention, is the subject of an independent patent and the patentee in respect of the independent patent is also the patentee in respect of the patent for the original invention, the Commissioner may, on an application made by the patentee, revoke the independent patent and grant a patent of addition in respect of the improvement or modification bearing the same date as the date of the independent patent so revoked.

Duration of patent of addition.

75.—(1.) A patent of addition shall remain in force so long as the patent for the main invention remains in force, and no longer, but may be extended under Part IX. for any period for which the patent for the main invention is extended.

(2.) A fee is not payable in respect of the renewal of a patent of addition.

(3.) If the patent for the original invention is revoked or surrendered, the patent of addition shall, unless the High Court in the case of revocation, or the Commissioner in the case of surrender, otherwise orders, become an independent patent, and the fees payable after the patent of addition becomes an independent patent, and the dates when they become payable, shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the main invention.

Validity of patent of addition.

76. Objection shall not be taken to an application for a patent of addition, so far as the invention is claimed in any claim of the complete specification, and a patent of addition, so far as the invention is so claimed, is not invalid, on the ground only that the invention, so far as claimed in any claim of the complete specification, is obvious and does not involve an inventive step, having regard to—

(a) the publication of the main invention before the priority date of that claim but after the priority date of the claim of the specification of the main invention defining the invention the improvement in which, or the modification of which, is the subject of the first-mentioned claim, or, if there are two or more claims defining that invention, after the priority date of whichever of those claims has the earlier or earliest priority date; or

(b) the use of the main invention during that period.

PART VIII.—AMENDMENT OF SPECIFICATIONS.

Amendment of complete specification.

77.—(1.) An applicant or patentee may, by a request in writing lodged at the Patent Office, seek leave to amend his complete specification.

(2.) The request shall specify the nature of, and the reasons for, the proposed amendment.

(3.) Where a person has been registered as the mortgagee or exclusive licensee of a patent, an amendment shall not be allowed unless the mortgagee or licensee has consented, in writing, to the amendment.

(4.) If the mortgagee or licensee refuses to consent to the proposed amendment, the Commissioner may, on the application of the applicant or patentee, if the Commissioner is of opinion that consent has been unreasonably refused, direct that the consent of the mortgagee or licensee shall not be necessary.

(5.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under the last preceding sub-section.

78.—(1.) An amendment of a specification under this Part is not allowable—

Nature of amendments allowable.

- (a) if the specification as amended would not comply with the requirements of section forty of this Act ; or
- (b) except for the purpose of correcting a clerical error or an obvious mistake, if the specification as amended would claim matter not in substance disclosed in the specification before amendment.

(2.) After the publication of a complete specification, an amendment of the specification under this Part is not allowable, except for the purpose of correcting a clerical error or an obvious mistake, if a claim of the specification as amended would not in substance fall within the scope of the claims of the specification before amendment.

79. An Examiner shall ascertain and report whether—

Examination of request for amendment.

- (a) the request for leave to amend is as prescribed ;
- (b) the priority date of each claim as proposed to be amended is the priority date of that claim as determined by this Act ; and
- (c) the amendment is or is not otherwise allowable.

80. If the Examiner reports adversely to the request for leave to amend, the applicant or patentee may amend his request so as to remove the grounds of objection and the amended request shall be reported on in the like manner as the original request.

Action on Examiner's report.

81.—(1.) If the Examiner does not report adversely to the request for leave to amend, or, if the Examiner does so report and the applicant or patentee does not amend his request so as to remove the grounds of objection, the request shall, unless the complete specification has not been published, but subject to sub-section (3.) of this section, be advertised in the *Official Journal*.

Advertisement of request.

(2.) If the Examiner reports adversely to the request for leave to amend, and the applicant or patentee amends the request so as to remove the grounds of objection, the request as amended shall, unless the complete specification has not been published, but subject to the next succeeding sub-section, be advertised in the *Official Journal*.

(3.) The Commissioner may, if he is of opinion that the request for leave to amend should not be allowed, refuse the request, in which case the request shall not be advertised.

(4.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under the last preceding sub-section.

Notice of
opposition

82. Where the request has been advertised, the Attorney-General or a person interested may, at any time within three months after the date of the first advertisement, or within such further period, not exceeding three months, as the Commissioner, on application made to him within the first-mentioned period and on payment of the prescribed fee, allows, give notice to the Commissioner of opposition to the granting of the request on the ground that—

(a) the priority date of a claim as proposed to be amended is not the priority date of that claim as determined by this Act; or

(b) the amendment is not allowable under section seventy-eight of this Act,

but on no other ground, and shall serve a copy of the notice on the applicant or patentee.

Determination
of request.

83.—(1.) The Commissioner shall, after hearing the person making the request and a person who has given notice of opposition, if desirous of being heard, determine whether, and subject to what conditions (if any), the amendment ought to be allowed.

(2.) Where notice of opposition is not given, or the person so giving notice does not appear, the Commissioner shall determine whether, and subject to what conditions (if any), the amendment ought to be allowed.

Appeal to
Appeal
Tribunal.

84. The applicant or the patentee, as the case may be, and an opponent who, in the opinion of the Appeal Tribunal, is entitled to be heard in opposition to the request, may appeal to the Appeal Tribunal from a decision of the Commissioner under the last preceding section.

No amendment
where action
pending.

85. The preceding provisions of this Part do not apply when, and so long as there is pending—

(a) an action for infringement of the patent;

(b) a proceeding for revocation of the patent; or

(c) a proceeding in which the validity of the patent or of a claim of the complete specification is disputed,

whether commenced before or after the lodging of the request for leave to amend.

Court may
direct
amendment.

86.—(1.) In an action for infringement of a patent, in a proceeding for revocation of a patent or in a proceeding in which the validity of a patent, or of a claim of a complete specification, is disputed, the court, Justice or Judge may, at any time, by order made on the application

of the patentee, subject to such terms (if any) as to costs, advertisements or otherwise as the court, Justice or Judge imposes, direct the amendment of the specification in the manner specified in the order.

(2.) The patentee shall give notice of an application for an order under the last preceding sub-section to the Commissioner, who shall be entitled to appear and be heard and shall appear if the court, Justice or Judge so directs.

(3.) The court, Justice or Judge shall not direct an amendment which is not allowable under section seventy-eight of this Act.

(4.) A copy of an order made under sub-section (1.) of this section shall be lodged by the patentee at the Patent Office within fourteen days after the sealing of the order and thereupon the specification shall be deemed to have been amended in the manner specified in the order.

87. Where an amendment is made under this Act to a complete specification after publication, damages shall not be given, and an order shall not be made for an account of profits, in an action for an infringement of the patent occurring before the date of the decision or order allowing or directing the amendment, unless the patentee establishes to the satisfaction of the court that the specification without the amendment was framed in good faith and with reasonable skill and knowledge.

Restriction on recovery of damages.

88.—(1.) A complete specification as amended, or as last amended, under this Part, shall, in all courts and for all purposes, be conclusively accepted as, and be deemed to be, the complete specification.

Effect of amendment.

(2.) Except in the case of an amendment made in contravention of section eighty-five of this Act, it is not competent for a person in an action or other proceeding to take an objection to an amended specification on the ground that an amendment has been made which was not allowable under this Part.

(3.) A court, the Appeal Tribunal or the Commissioner, may, in construing a specification as amended, refer to the specification without the amendment.

89. An amendment under this Part (not being an amendment of a specification which has not been published) shall be advertised in the *Official Journal*.

Advertisement of amendment.

PART IX.—EXTENSION OF PATENTS.

90.—(1.) A patentee who considers that he has been inadequately remunerated by his patent may, after advertising, as prescribed, his intention to do so, present to the High Court, at least six months before the expiration of the term of the patent, or within such further period as the High Court allows, a petition praying that his patent be extended for a further term.

Petition to High Court for extension of term of patent.

(2.) A petition for the extension of the term of a patent may be presented under this section notwithstanding that the patent has previously been extended, or a new patent for the invention has previously been granted, on the ground of loss or damage suffered by reason of hostilities between Her Majesty and a foreign state but a petition may not be presented under this section if the patent has previously been extended, or a new patent for the invention has been granted, on the ground of inadequate remuneration.

Caveat.

91. A person interested may file in the High Court a caveat against the extension and shall serve a copy of the caveat on the Commissioner.

Hearing.

92. On the hearing of the petition, a person who has filed a caveat shall be made a party respondent to the petition, and the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the High Court.

Matters to be considered by Court.

93. The High Court shall, in considering its decision, have regard to—

- (a) the nature and merits of the invention in relation to the public ;
- (b) the profits made by the patentee as such ; and
- (c) all the circumstances of the case.

Extension on ground of inadequate remuneration.

94.—(1.) If the High Court is of opinion that the patentee has been inadequately remunerated by his patent, the Court may—

- (a) order the extension of the term of the patent, subject to such restrictions, conditions and provisions (if any) as the Court thinks fit, for a further term not exceeding five years, or, in exceptional cases, ten years ; or
- (b) order the grant of a new patent for such term, not exceeding five years, or, in exceptional cases, ten years, as the Court thinks fit, and containing such restrictions, conditions and provisions (if any) as the Court thinks fit.

(2.) This section applies although the patentee does not present to the Court a complete account of his receipts and expenditure as patentee if the Court is nevertheless satisfied that the patentee has been inadequately remunerated by the patent.

(3.) The patentee shall serve on the Commissioner an office copy of an order of the Court under this section and the Commissioner shall insert in the Register a reference to the order.

Extension on ground of war loss.

95.—(1.) Where, by reason of hostilities between Her Majesty and a foreign state, a patentee as such has suffered loss or damage, including loss of opportunity of dealing in or developing his invention, the patentee may, after advertising, as prescribed, his intention to do so, apply to the High Court or to the Commissioner for the extension of the term of the patent.

(2.) This section does not apply where the patentee—

(a) is a subject of the foreign state ; or

(b) is a company—

(i) the business of which is managed or controlled by ;
or

(ii) which is carried on wholly or mainly for the
benefit of,

subjects of the foreign state, notwithstanding that the
company is registered in Australia or in some other part
of the Queen's dominions.

(3.) For the purposes of this section, account shall not be taken
of loss or damage suffered by a person while he was a subject of the
foreign state or by a company while its business was managed or
controlled as specified in paragraph (b) of the last preceding sub-
section.

(4.) An application for the extension of a patent may be made
under this section notwithstanding that the patent has previously
been extended, or a new patent for the invention has previously
been granted, on the ground of inadequate remuneration or, on one or
more occasions, on the ground of loss or damage suffered by reason of
hostilities between Her Majesty and a foreign state.

(5.) An application under this section shall be made at least six
months before the expiration of the term of the patent or at such
later time as the High Court or the Commissioner, as the case may be,
allows.

(6.) An application to the High Court under this section shall be
made as prescribed by Rules of Court and an application to the
Commissioner shall be made as prescribed by the regulations.

(7.) A person interested may—

(a) in the case of an application to the High Court—within such
time and in such manner as are prescribed by Rules of
Court ; or

(b) in the case of an application to the Commissioner—within
such time and in such manner as are prescribed by the
regulations,

give notice of opposition to the granting of the application and shall
serve a copy of the notice on the applicant.

(8.) A person so giving notice is entitled to appear and be heard
on the application.

(9.) If the High Court finds that the patentee has suffered loss or
damage by reason of hostilities between Her Majesty and the foreign
state, the High Court may—

(a) order the extension of the term of the patent, subject to such
restrictions, conditions and provisions (if any), for such
further term as the Court thinks fit ; or

(b) order the grant of a new patent for such term, and containing such restrictions, conditions and provisions (if any), as the Court thinks fit.

(10.) If the Commissioner finds that the patentee has suffered loss or damage by reason of hostilities between Her Majesty and the foreign state, the Commissioner may—

(a) extend the term of the patent, subject to such restrictions, conditions and provisions (if any) as the Commissioner thinks fit, for such further term as the Commissioner thinks fit; or

(b) grant a new patent for such term, and containing such restrictions, conditions and provisions (if any), as the Commissioner thinks fit.

(11.) The term granted on the application (whether by way of extension or grant of a new patent) shall not exceed ten years but where the term of the patent has previously been extended or a new patent for the invention has previously been granted, on the ground of loss or damage suffered by reason of hostilities between Her Majesty and a foreign state, the aggregate of the terms (whether by way of extension or grant of a new patent) shall not exceed ten years.

(12.) If the Commissioner considers that an application made to him under this section ought to be decided by the High Court, he may refer the application to the High Court and the High Court may decide the application as though it had been made to the High Court in the first instance.

(13.) The patentee shall serve on the Commissioner an office copy of an order of the Court under this section and the Commissioner shall insert in the Register a reference to the order.

Application by
exclusive
licensee.

96. In this Part, a reference to a patentee includes a reference to an exclusive licensee.

PART X.—RESTORATION OF PATENTS.

Application
for restoration
of patents
which have
ceased.

97.—(1.) Where a patent has ceased by reason of failure to pay a prescribed fee within the prescribed time, the patentee may apply to the Commissioner for the restoration of the patent.

(2.) The application shall contain a statement of the circumstances which led to the failure to pay the prescribed fee within the prescribed time, and if it appears from the statement that the failure was unintentional, and that no undue delay has occurred in the making of the application, the Commissioner shall advertise the application in the *Official Journal*.

(3.) A person interested may, within such time as is prescribed, give notice to the Commissioner of opposition to the restoration and shall serve a copy of the notice on the patentee.

98.—(1.) The Commissioner shall hear the case and either restore the patent (including any patent of addition on that patent) or dismiss the application. Hearing of application and order thereon.

(2.) The Commissioner shall not restore the patent until all unpaid renewal fees have been paid.

(3.) The Commissioner may, if he thinks fit, as a condition of restoring the patent, require that an entry shall be made in the Register in respect of a document or instrument in respect of which the provisions of this Act as to entries in the Register have not been complied with.

(4.) Where a patent is restored under this section, such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by contract or otherwise to avail themselves, of the subject matter of the patent after the patent was notified in the *Official Journal* as having ceased and before the date of the first advertisement of the application.

(5.) Proceedings shall not be taken in respect of an infringement of a patent committed between the date on which the patent ceased and the date of the restoration of the patent.

(6.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section, and the Commissioner shall be entitled to appear and be heard, and shall appear if so directed by the Appeal Tribunal.

PART XI.—REVOCATION AND SURRENDER OF PATENTS.

99. The Attorney-General or any other person may present a petition to the High Court for the revocation of a patent. Petition to revoke patent.

100.—(1.) A patent may be revoked, either wholly or in so far as it relates to any claim of the complete specification, on one or more of the following grounds, but on no other ground :— Grounds of revocation.

- (a) that the applicant was not a person entitled to apply for the patent, so far as the invention is claimed in any claim ;
- (b) that the patent, so far as the invention is claimed in any claim, was obtained in contravention of the rights of the petitioner or of some person under or through whom the petitioner claims ;
- (c) that the complete specification does not comply with the requirements of section forty of this Act ;
- (d) that the invention, so far as claimed in any claim, is not an invention within the meaning of this Act ;
- (e) that the invention, so far as claimed in any claim, was obvious and did not involve an inventive step, having regard to what was known or used in Australia on or before the priority date of that claim ;
- (f) that the invention, so far as claimed in any claim, is the subject of a valid claim of earlier priority date contained in the complete specification of another patent ;

- (g) that the invention, so far as claimed in any claim, was not novel in Australia on the priority date of that claim ;
- (h) that the invention, so far as claimed in any claim, is not useful ;
- (i) that the patentee has contravened, or has not complied with, the conditions contained in the patent ;
- (j) that the patent was obtained on a false suggestion or representation ;
- (k) that the invention, so far as claimed in any claim, was secretly used in Australia, before the priority date of that claim ; and
- (l) that leave to amend, or a direction to amend, the complete specification under Part VIII. of this Act was obtained by fraud.

(2.) For the purposes of paragraph (e) or (g) of the last preceding sub-section, account shall not be taken of any secret use.

(3.) For the purposes of paragraph (k) of sub-section (1.) of this section, account shall not be taken of any use of the invention, so far as claimed in any claim—

- (a) for the purpose of reasonable trial or experiment only ; or
- (b) by a department or authority of the Commonwealth, or of a State or Territory of the Commonwealth, or by a person authorized by such a department or authority, where the patentee, or a person from whom he derives his title, has communicated or disclosed the invention, so far as so claimed, to the department, authority or person.

(4.) This section is subject to section one hundred and fifty-eight of this Act.

Petition may be presented on basis that indicated priority date is incorrect.

101.—(1.) The petitioner may, in his petition, specify a ground of invalidity by reference either to the priority date indicated in the relevant claim or by reference to a date which the petitioner alleges to be the priority date of that claim as determined by this Act.

(2.) If the High Court finds that a date other than the date indicated in the claim (whether that other date is the date alleged in the petition or not) is the priority date of the claim as determined by this Act, the High Court shall, in deciding the case, treat the first-mentioned date as the priority date of the claim.

Hearing of petition.

102. The respondent is entitled to begin and give evidence in support of the patent, and, if the petitioner gives evidence disputing the validity of the patent, the respondent is entitled to reply.

103. The High Court may—

Powers of
Court

- (a) revoke the patent, and shall order the petitioner to serve on the Commissioner an office copy of the order for the revocation of the patent; or
- (b) if it is of opinion that a claim in the complete specification is invalid, revoke the patent in so far as it relates to that claim, and shall order the patentee to lodge at the Patent Office a disclaimer of the invalid claim.

104. The Commissioner shall insert in the Register a reference to an order or disclaimer served on him or lodged at the Patent Office in pursuance of the last preceding section.

References to
be made in
Register.

105. Every ground on which a patent may be revoked is available as a ground of defence in an action for infringement of a patent, and, for the purposes of such a ground of defence in such an action, references in this Part to the petitioner and the respondent shall be read as references to the defendant and plaintiff, respectively.

Defences in
action for
infringement.

106.—(1.) A patentee may at any time, by giving notice to the Commissioner, offer to surrender his patent, and the Commissioner may, after giving notice of the offer and hearing all parties interested who desire to be heard, if he thinks fit, accept the offer, and shall thereupon revoke the patent.

Surrender of
patent.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under the last preceding sub-section.

(3.) Where an action for infringement, a proceeding for the revocation of a patent, or a proceeding in which the validity of a patent, or of a claim in the complete specification, is disputed, is pending in a court, the Commissioner shall not accept the offer for the surrender, or revoke the patent, except by leave of the court or by consent of the parties to the action or proceeding.

107.—(1.) Where a patent has been revoked, in so far as it relates to any claim of the complete specification, on the ground of fraud, or where a patent fraudulently obtained has been surrendered and revoked, the Commissioner may, on the application of the actual inventor or of a person referred to in section thirty-four of this Act, made in accordance with the provisions of this Act, grant to the applicant a patent for the whole or a part of the invention in lieu of the patent so revoked.

Grant of patent
where patent
revoked.

(2.) The priority date of each claim of the complete specification shall be such date as the Commissioner determines, having regard to the priority dates of the claims of the complete specification of the revoked patent.

(3.) No action lies for an infringement of a patent granted under sub-section (1.) of this section which occurred before the sealing of the patent.

PART XII.—WORKING OF PATENTS AND COMPULSORY LICENCES.

Compulsory
licences.

108.—(1.) A person interested may, after the expiration of three years from the date of sealing of a patent, present a petition to the Commissioner alleging that the reasonable requirements of the public with respect to the patented invention have not been satisfied, and praying for the grant of a compulsory licence.

(2.) The Commissioner shall consider the petition, and, if the parties do not come to an arrangement among themselves and the Commissioner is satisfied that a *prima facie* case has been made out, he shall refer the petition to the High Court; if the Commissioner is not so satisfied he shall dismiss the petition.

(3.) Where the Commissioner refers a petition to the High Court in pursuance of the last preceding sub-section, and the Court is satisfied that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the Court may order the patentee to grant licences on such terms as the Court thinks just.

(4.) On the hearing of a petition under this section—

(a) the patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made a party to the proceedings; and

(b) the Commissioner shall be entitled to appear and be heard.

(5.) An order directing the grant of a licence operates, without prejudice to any other method of enforcement, as if it were embodied in a deed granting a licence executed by the patentee and all other necessary parties.

(6.) The petitioner shall serve on the Commissioner an office copy of an order under this section directing the grant of a licence and the Commissioner shall insert in the Register a reference to the order.

Revocation for
non-working.

109.—(1.) A person interested may, after the expiration of two years from the date of granting of the first compulsory licence, present a petition to the Commissioner alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the revocation of the patent.

(2.) The Commissioner shall consider the petition, and, if the parties do not come to an arrangement among themselves and the Commissioner is satisfied that a *prima facie* case has been made out, he shall refer the petition to the High Court; if the Commissioner is not so satisfied he shall dismiss the petition.

(3.) Where the Commissioner refers a petition to the High Court in pursuance of the last preceding sub-section, and the Court is satisfied that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the Court may (unless the patentee gives satisfactory reasons for his default) make an order revoking the patent.

(4.) On the hearing of a petition under this section—

- (a) the patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made a party to the proceedings; and
- (b) the Commissioner shall be entitled to appear and be heard.

(5.) The petitioner shall serve on the Commissioner an office copy of an order under this section revoking a patent and the Commissioner shall insert in the Register a reference to the order.

110.—(1.) For the purposes of the last two preceding sections, the reasonable requirements of the public shall be deemed not to have been satisfied—

Reasonable requirements of public deemed not to have been satisfied in certain circumstances.

(a) if, by reason of the default of the patentee—

- (i) to manufacture to an adequate extent, and supply on reasonable terms, the patented article, or a part of the patented article which is necessary for its efficient working;
- (ii) to carry on the patented process to an adequate extent; or

(iii) to grant licences on reasonable terms, an existing trade or industry, or the establishment of a new trade or industry, in Australia is unfairly prejudiced, or the demand for the patented article, or the article produced by the patented process, is not reasonably met;

(b) if a trade or industry in Australia is unfairly prejudiced by the conditions attached by the patentee, whether before or after the commencement of this Act, to the purchase, hire or use of the patented article, or to the using or working of the patented process;

(c) if the patented invention, being an invention capable of being worked in Australia, is not being worked in Australia on a commercial scale and no satisfactory reason is given for the non-working; or

(d) if the working of the patented invention in Australia on a commercial scale is being hindered by the importation from abroad of the patented article by—

- (i) the patentee or persons claiming under him;
- (ii) by persons directly or indirectly purchasing from him;

or

(iii) by other persons against whom the patentee is not taking, or has not taken, proceedings for infringement.

(2.) Where, in any case to which paragraph (c) of the last preceding sub-section applies, the Court is satisfied that the time which has elapsed since the sealing of the patent has, by reason of the nature of the invention or for some other cause, been insufficient to enable the invention to be worked in Australia on a commercial scale, the Court may adjourn the further hearing of the petition for such period as appears to the Court to be sufficient for that purpose.

Order not to be at variance with treaty.

111. An order shall not be made under this Part which is at variance with a treaty, convention, arrangement or engagement between the Commonwealth and some other part of the Queen's dominions or between the Commonwealth and a foreign country.

Avoidance of certain conditions attached to sale, &c., of patented articles.

112.—(1.) It is not lawful, in a contract in relation to the sale or lease of, or a licence to use or work, a patented article or patented process, to insert a condition the effect of which would be—

- (a) to prohibit or restrict the purchaser, lessee or licensee from using an article or class of articles or process, whether patented or not, supplied or owned by a person other than the seller, lessor or licensor, or his nominee; or
 - (b) to require the purchaser, lessee or licensee to acquire from the seller, lessor or licensor, or his nominee, an article or class of articles not protected by the patent,
- and any such condition is void.

(2.) The last preceding sub-section does not apply if—

- (a) the seller, lessor or licensor proves that, at the time the contract was entered into, the purchaser, lessee or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms without the condition; and
- (b) the contract entitles the purchaser, lessee or licensee to relieve himself of his liability to observe the condition on giving the other party three months' notice in writing, and on payment in compensation for that relief—
 - (i) in the case of a purchase—of such sum; or
 - (ii) in the case of a lease or licence—of such rent or royalty for the residue of the term of the contract, as is fixed by an arbitrator appointed by the Attorney-General.

(3.) In an action, application or proceeding under this Act, a person is not estopped from applying for or obtaining relief by reason only of an admission made by him as to the reasonableness of the terms offered to him under paragraph (a) of the last preceding sub-section.

(4.) A contract relating to the lease of, or licence to use or work, a patented article or patented process may at any time after the patent, or all the patents, by which the article or process was protected at the time of the making of the contract has, or have, ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party.

(5.) The insertion by the patentee in a contract of a condition which, by virtue of this section, is void is available as a defence to an action for infringement of the patent to which the contract relates, brought while that contract is in force.

(6.) If the patentee offers to the other parties to a contract in which any such condition is inserted a new contract from which the condition is omitted but under which the rights of the parties are otherwise identical, then, whether the other parties accept the new contract in lieu of the existing contract or not, the defence ceases to be available in respect of the contract, but the patentee is not entitled to recover damages, or to an account of profits, in respect of an infringement of the patent committed before the new contract has been so offered.

(7.) Nothing in this section—

- (a) affects a condition in a contract by which a person is prohibited from selling goods other than those of a particular person ;
- (b) validates a contract which, but for this section, would be invalid ;
- (c) affects a right of determining a contract, or a condition in a contract, exercisable independently of this section ; or
- (d) affects a condition in a contract for the lease of, or licence to use, a patented article, by which the lessor or licensor reserves to himself or his nominee the right to supply such new parts of the patented article as are required to put or keep it in repair.

PART XIII.—INFRINGEMENT OF PATENTS.

113. Jurisdiction is, by this section, conferred on the High Court to hear and determine an action or proceeding for the infringement of a patent, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action or proceeding.

High Court to have jurisdiction in infringement actions.

114.—(1.) An exclusive licensee may bring an action or proceeding for the infringement of a patent.

Exclusive licensee may sue for infringement.

(2.) The patentee shall, unless he is joined as a plaintiff in the action or proceeding, be joined as a defendant.

(3.) A patentee joined as a defendant is not liable for costs unless he enters an appearance and takes part in the proceedings.

115. A defendant in an action or proceeding for infringement of a patent may, without presenting a petition to the High Court under Part XI., apply by way of counter-claim in the action or proceeding for the revocation of the patent.

Defendant may counter-claim for revocation.

116.—(1.) Where a defendant, in an action or proceeding for the infringement of a patent in a court other than the High Court, applies by way of counter-claim for the revocation of the patent, the action or proceeding shall thereupon be removed into the High Court.

Proceedings to be removed from State Courts to High Court where counter-claim for revocation.

(2.) The proceedings in the action or proceeding, and such documents (if any) relating to the action or proceeding as are filed as of record in the court in which the action or proceeding was commenced, shall be transmitted to the Registry of the High Court in the State or Territory of the Commonwealth in which the first-mentioned court is situated, or, if there is no such Registry, to the Principal Registry of the High Court.

(3.) The provisions of sections forty-one, forty-three, forty-four and forty-six of the *Judiciary Act 1903-1950* apply in relation to an action or proceeding which is, or ought to be, removed into the High Court under this section.

Procedure
in action
for
infringement
of patent.

117. In an action or proceeding for infringement of a patent—

- (a) the plaintiff shall deliver with his statement of claim or declaration, or, by order of the court, Justice or Judge, at a subsequent time, particulars of the infringements complained of; and
- (b) the defendant shall deliver with his statement of defence or plea, or, by order of the court, Justice or Judge, at a subsequent time, particulars of the objections on which he relies.

Belief in
action for
infringement
of patent.

118.—(1.) The relief which a court may grant in an action or proceeding for infringement of a patent includes an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

(2.) The court, Justice or Judge may, on the application of either party, make such order for inspection, and impose such terms and give such directions with respect to the inspection, as the court, Justice or Judge thinks fit.

Order revoking
patent to be
served on
Commissioner.

119.—(1.) Where, in an action or proceeding for the infringement of a patent, the court, on an application by the defendant by way of counter-claim—

- (a) revokes the patent—the court shall order the defendant to serve on the Commissioner an office copy of the order revoking the patent; or
- (b) revokes the patent in so far as it relates to an invalid claim—the court shall order the patentee to lodge at the Patent Office a disclaimer of the invalid claim.

(2.) The Commissioner shall insert in the Register a reference to an order or disclaimer served on him or lodged at the Patent Office in pursuance of the last preceding sub-section.

Declaration as
to non-
infringement.

120.—(1.) A person who desires to use a process, or to make, use or sell an article, may, by action in the High Court against a patentee or exclusive licensee, claim a declaration that the use of

the process, or the making, use or sale of the article, would not constitute an infringement of a claim of the specification of the patent, although no assertion to the contrary has been made by the patentee or licensee.

(2.) The High Court has jurisdiction to hear and determine an action under the last preceding sub-section.

(3.) The High Court shall not make a declaration sought in an action under sub-section (1.) of this section unless—

(a) the plaintiff—

- (i) has applied in writing to the defendant for an admission in writing to the effect of the declaration sought;
- (ii) has furnished the defendant with full particulars in writing of the process or article; and
- (iii) has undertaken to pay a reasonable sum for the expenses of the defendant in obtaining advice in respect of the declaration sought; and

(b) the defendant has refused or failed to make such an admission.

(4.) The costs of all parties in proceedings for a declaration under this section shall, unless the High Court otherwise orders, be paid by the person seeking the declaration.

(5.) The validity of a claim in the specification of a patent shall not be called in question in proceedings for a declaration under this section and the making of, or refusal to make, the declaration does not imply that the patent is valid.

(6.) Proceedings for a declaration under this section may be taken at any time after the publication of the complete specification and references in this section to a patentee shall be read as including a reference to an applicant whose complete specification has been published.

121.—(1.) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding for infringement of a patent, or some other like proceeding, then, whether the person making the threats is or is not entitled to or interested in a patent, or is or is not interested in an application for a patent, a person aggrieved may bring an action against the first-mentioned person and may obtain a declaration to the effect that the threats are unjustifiable, and an injunction against the continuance of the threats, and may recover such damages (if any) as he has sustained, unless the first-mentioned person satisfies the court that the acts in respect of which the proceedings were threatened constitute, or, if done, would constitute—

Groundless
threats of legal
proceedings.

(a) an infringement of a patent in respect of a claim in the specification which is not shown by the plaintiff to be invalid; or

(b) an infringement of rights arising from the publication of the complete specification in respect of a claim in the specification which is not shown to be one which would be invalid if a patent had been granted in respect of the complete specification.

(2.) The mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

(3.) Nothing in this section renders a legal practitioner or a patent attorney liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4.) Jurisdiction is, by this section, conferred on the High Court to hear and determine an action under this section, but this section does not deprive any other court of any jurisdiction which it possesses to hear and determine such an action.

Counter-claim
by defendant
for
infringement.

122.—(1.) The defendant in an action under the last preceding section may apply, by way of counter-claim, for relief to which he would be entitled in a separate action in respect of an infringement, by the plaintiff, of the patent to which the threats relate and in any such case the provisions of this Act with respect to an action for infringement of a patent are, *mutatis mutandis*, applicable in relation to the action.

(2.) Where the defendant applies by way of counter-claim for relief in respect of such an infringement, the plaintiff may, without presenting a petition to the High Court under Part XI., apply in the action for the revocation of the patent, and in any such case the provisions of section one hundred and sixteen of this Act and the provisions of this Act with respect to a petition for the revocation of a patent are, *mutatis mutandis*, applicable in relation to the action.

Special
provisions as
to vessels,
aircraft and
land vehicles.

123.—(1.) Subject to this section, the rights of the patentee are not infringed—

(a) by the use on board a foreign vessel of the patented invention in the body of the vessel or in the machinery, tackle, apparatus or other accessories of the vessel, if the vessel comes into waters within the territorial limits of Australia temporarily or accidentally only and the invention is used exclusively for the needs of the vessel; or

(b) by the use of the patented invention in the construction or working of a foreign aircraft or land vehicle, or in the accessories of such an aircraft or vehicle, if the aircraft or vehicle comes into Australia temporarily or accidentally only.

(2.) In this section—

(a) “foreign vessel” and “foreign aircraft” mean a vessel or aircraft registered in a country with respect to which there is in force for the time being a Proclamation declaring

that the laws of that country confer corresponding rights with respect to vessels, aircraft and land vehicles of Australia; and

(b) "foreign land vehicle" means a land vehicle owned by a person ordinarily resident in such a country.

124.—(1.) A court may refuse to award damages, or to make an order for an account of profits, in respect of an infringement of a patent committed after the date of commencement of this Act from a defendant who satisfies the court that, at the date of the infringement, he was not aware, and had no reason to believe, that a patent for the invention existed.

Exemption of innocent infringer from liability for damages.

(2.) If articles manufactured according to a patented invention and marked in such a manner as to indicate that the articles are patented in Australia have been sold or used in Australia to a substantial extent, the defendant shall be deemed, unless the contrary is proved, to have been aware of the existence of the patent.

(3.) Nothing in this section affects the power of a court to grant relief by way of an injunction.

PART XIV.—THE CROWN.

125.—(1.) At any time after an application for a patent has been lodged at the Patent Office or a patent has been granted, the Commonwealth or a State, or a person authorized in writing by the Commonwealth or a State, may make, use, exercise or vend the invention for the services of the Commonwealth or State.

Use of inventions for services of the Commonwealth or a State.

(2.) Where a patented invention was, before the priority date of the relevant claim of the complete specification, recorded in a document by, or tested by or on behalf of, the Commonwealth or a State, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or by a person from whom he derives title, no remuneration is payable to the patentee in respect of the use of the invention by the Commonwealth or the State, as the case may be, under the last preceding sub-section.

(3.) Authority may be given under sub-section (1.) of this section either before or after a patent for the invention has been granted, and either before or after the acts in respect of which the authority is given have been done, and may be given to a person notwithstanding that he is authorized directly or indirectly by the applicant or patentee to make, use, exercise or vend the invention.

(4.) Where an invention has been made, used, exercised or vended under sub-section (1.) of this section, the Commonwealth or State shall, unless it appears to the Commonwealth or State that it would be contrary to the public interest to do so, inform the applicant or patentee as soon as possible of the fact and shall furnish him with such information as to the making, use, exercise or vending of the invention as he from time to time reasonably requires.

(5.) Subject to sub-section (2.) of this section, where a patented invention is made, used, exercised or vended under sub-section (1.) of this section, the terms for the making, use, exercise or vending of the invention are such terms as are, whether before or after the making, use, exercise or vending of the invention, agreed upon between the Commonwealth or the State and the patentee or, in default of agreement, as are fixed by the High Court.

(6.) The High Court may, in fixing those terms, take into consideration compensation which a person interested in the invention or patent has received, directly or indirectly, from the Commonwealth or State in respect of the invention or patent.

(7.) An agreement or licence (whether made or given before or after the commencement of this Act) fixing the terms upon which a person other than the Commonwealth or a State may make, use, exercise or vend an invention is inoperative with respect to the making, using, exercising or vending of the invention, after the commencement of this Act, under sub-section (1.) of this section, unless the agreement has been approved by the Attorney-General of the Commonwealth or of the State.

(8.) No action for infringement lies in respect of the making, use, exercise or vending of a patented invention under sub-section (1.) of this section.

(9.) The right to make, use, exercise and vend an invention under sub-section (1.) of this section includes the right to sell goods which have been made in exercise of that right and a purchaser of goods so sold, and a person claiming through him, is entitled to deal with the goods as if the Commonwealth or State were the patentee of the invention.

(10.) Where the Government of the Commonwealth has made an agreement or arrangement with the Government of some other country for the supply to that country of goods required for the defence of that country—

- (a) the use of an invention by the Commonwealth, or by a person authorized in writing by the Commonwealth, for the supply of those goods shall, for the purposes of this Part, be deemed to be use of the invention by the Commonwealth for the purposes of the Commonwealth ;
- (b) the Commonwealth or that person may sell those goods to that country in pursuance of the agreement or arrangement ; and
- (c) the Commonwealth or that person may sell to any person such of those goods as are not required for the purpose for which they were made.

Declaration
may be sought
as to use of
patented
invention.

126.—(1.) A patentee who considers that a patented invention has been made, used, exercised or vended under sub-section (1.) of the last preceding section may apply to the High Court for a declaration accordingly.

(2.) In a proceeding under the last preceding sub-section—

- (a) the Commonwealth or the State concerned, as the case may be, shall be the defendant; and
- (b) the Commonwealth or State may, by way of counter-claim in the proceeding, apply for the revocation of the patent, in which case the provisions of this Act with respect to the revocation of patents apply, *mutatis mutandis*, in relation to the counter-claim.

127. In the last two preceding sections, references to a patentee include references to an exclusive licensee under the patent. Exclusive licensees.

128. Nothing in this Part affects the right of the Commonwealth or of a State, or of a person deriving title directly or indirectly from the Commonwealth or a State, to sell or use an article forfeited under a law of the Commonwealth or the State. Forfeited articles.

129.—(1.) The Governor-General may direct that an invention the subject of an application for the grant of a patent, or a patent, shall be acquired by the Attorney-General from the applicant or patentee and thereupon the invention or patent, and all rights in respect of the invention or patent, are, by force of this section, transferred to and vested in the Attorney-General in trust for the Commonwealth. Acquisition of inventions and patents by the Commonwealth.

(2.) Notice of the acquisition shall be given to the applicant or patentee and be published in the *Official Journal* and the *Gazette* unless, in the case of the acquisition of an invention the subject of an application for a patent, an order is in force under section one hundred and thirty-one of this Act in relation to the application.

(3.) The Commonwealth shall pay to the applicant or patentee, and, in the case of the acquisition of a patent, to all other persons appearing in the Register as having an interest in the patent, such compensation as is agreed upon between the Commonwealth and the applicant, patentee or other persons, as the case may be, or as, in default of agreement, is determined by the High Court in an action for compensation against the Commonwealth.

130.—(1.) The inventor of an invention, or a person who has acquired from an inventor the right to apply for a patent in respect of an invention, may assign the invention and the patent obtained, or to be obtained, for the invention to the Commonwealth. Assignment of invention to Commonwealth.

(2.) The assignment and all covenants and agreements contained in the assignment are valid and effectual notwithstanding any want of valuable consideration and may be enforced by action or other appropriate proceeding in the name of the Attorney-General.

131.—(1.) Subject to any directions of the Attorney-General, the Commissioner may, if it appears to him to be necessary or expedient so to do in the interests of the defence of the Commonwealth, by order in writing under his hand, prohibit or restrict the publication Prohibition of publication of information with respect to inventions.

of information with respect to the subject-matter of an application made for the grant of a patent, whether generally or to a particular person or to the persons included in a class of persons.

(2.) A person shall not, except in accordance with the written consent of the Commissioner, publish or communicate information in contravention of an order made under the last preceding sub-section.

Penalty—

(a) if the offence is prosecuted summarily—a fine not exceeding Two hundred and fifty pounds or imprisonment for a term not exceeding six months, or both ; or

(b) if the offence is prosecuted upon indictment—a fine not exceeding Five thousand pounds or imprisonment for a term not exceeding two years, or both.

(3.) Where an order is in force under this section in relation to an application, the application may proceed up to the acceptance of the application and complete specification, but the complete specification shall not be published, the acceptance shall not be advertised and a patent shall not be granted on the application.

(4.) Where an order under this section has been revoked after the acceptance of the application and complete specification, the acceptance shall be advertised within one month after the date of revocation of the order.

(5.) Nothing in this Act prevents the disclosure of information concerning an invention to a Department or authority of the Commonwealth for the purpose of obtaining advice as to whether an order under this section should be made, amended or revoked.

Interpretation.

132. In this Part, references to the Commonwealth include references to an authority of the Commonwealth and references to a State include references to an authority of the State.

PART XV.—PATENT ATTORNEYS.

Registration
of patent
attorneys.

133.—(1.) There shall be kept at the Patent Office a Register of Patent Attorneys.

(2.) The Register of Patent Attorneys under the repealed Acts shall continue to be the Register of Patent Attorneys under this Act.

(3.) The Commissioner may register as a patent attorney a person who—

(a) is a British subject ;

(b) is not less than twenty-one years of age ;

- (c) has passed in all the subjects of the prescribed examination,
or—
- (i) being a legal practitioner, has passed in such of the subjects of the prescribed examination as the regulations require to be passed by legal practitioners ; or
 - (ii) being a person registered as a patent agent in the United Kingdom, has passed in such of the subjects of the prescribed examination as the regulations require to be passed by such persons ;
- (d) possesses such other qualifications as are prescribed ; and
- (e) has been employed as prescribed, for not less than the prescribed period, by a patent attorney.

134.—(1.) A patent attorney—

Privileges.

- (a) is entitled to prepare all documents, transact all business and conduct all proceedings for the purposes of this Act ; and
- (b) has such other rights and privileges as are prescribed.

(2.) Nothing in this section authorizes a patent attorney to prepare a document which is to be issued from or filed in a court or to transact business or conduct proceedings in a court.

135. The name of a person registered as a patent attorney may be removed from the Register of Patent Attorneys in the prescribed manner and on the prescribed grounds.

Removal from register.

136.—(1.) Subject to section one hundred and thirty-eight of this Act—

Unregistered persons not to practise.

- (a) a person shall not carry on business, practise or act as a patent attorney unless he is registered as a patent attorney or is a legal practitioner ; or
- (b) the members of a partnership shall not carry on business, practise or act as patent attorneys unless each member of the partnership is so registered or is a legal practitioner.

Penalty : One hundred pounds.

(2.) Subject to section one hundred and thirty-eight of this Act—

- (a) a person shall not describe himself or hold himself out, or permit himself to be described or held out, as a patent attorney, patent agent or agent for obtaining patents, unless he is registered as a patent attorney or is a legal practitioner who, within one year after the commencement of this Act, has satisfied the Commissioner that, at any time before the first day of January, One thousand nine hundred and fifty-two, he had practised as a patent attorney ; or

- (b) the members of a partnership shall not describe themselves or hold themselves out, or permit themselves to be described or held out, as patent attorneys, patent agents or agents for obtaining patents, unless each member of the partnership is so registered or is such a legal practitioner.

Penalty : One hundred pounds.

- (3.) A company shall not carry on business, practise, act, describe itself or hold itself out, or permit itself to be described or held out, as a patent attorney, patent agent or agent for obtaining patents.

Penalty : One hundred pounds.

- (4.) A director, manager, secretary or other officer of a company which is guilty of an offence against the last preceding sub-section, who is knowingly a party to the offence, is guilty of an offence.

Penalty : One hundred pounds.

- (5.) For the purposes of this section, a person who, or a company which, undertakes for gain in Australia—

- (a) to apply for or obtain patents in Australia or elsewhere ;
- (b) to prepare specifications or other documents for the purposes of this Act or of the patent law of another country ; or
- (c) to give advice, other than of a scientific or technical nature, as to the validity of patents or their infringement,

shall be deemed to carry on business as a patent attorney.

Legal practitioners not to prepare specifications, &c.

137. A legal practitioner shall not prepare a specification or a document relating to an amendment of a specification, other than a document relating to an amendment directed under section eighty-six of this Act—

- (a) unless, within one year after the commencement of this Act, he has satisfied the Commissioner that, at any time before the first day of January, One thousand nine hundred and fifty-two, he had practised as a patent attorney ; or
- (b) unless he is acting under the instructions of a patent attorney or of a legal practitioner who has satisfied the Commissioner as provided by the last preceding paragraph.

Penalty : One hundred pounds.

Carrying on business of deceased patent attorney.

138. It is not an offence against section one hundred and thirty-six of this Act if the legal representative of a deceased patent attorney carries on the business or practice of that deceased patent attorney for a period not exceeding three years from the death of the patent attorney, or, in the case of a patent attorney who died before the date of commencement of this Act, for a period of three years from that date, or, in either case, for such further period (if any) as the High Court

allows, and is himself a patent attorney or person entitled to practise as a patent attorney, or employs a patent attorney, or person entitled to practise as a patent attorney, to manage that business or practice on his behalf.

139. A patent attorney shall not practise or act as a patent attorney, or hold himself out as so practising, at an office or place of business at which specifications or other documents are prepared for the purposes of this Act, unless that patent attorney, some other patent attorney, or some person entitled to practise as a patent attorney, is in regular attendance at, and in continuous charge of, that office or place.

Attendance at
patent
attorney's office.

Penalty : Fifty pounds.

PART XVI.—INTERNATIONAL ARRANGEMENTS.

140.—(1.) The Governor-General may, with a view to the fulfilment of a treaty, convention, arrangement or engagement between the Commonwealth and another country, by Proclamation, declare that a country specified in the Proclamation is a Convention country for the purposes of this Act.

Convention
countries.

(2.) The Governor-General may, by Proclamation, declare a part of the Queen's dominions which has made satisfactory provision for the protection in that part of inventions to be a Convention country for the purposes of this Act.

(3.) Where the Governor-General, by Proclamation, declares that an application for a patent or similar protection in respect of an invention—

- (a) is, in accordance with the terms of a treaty subsisting between two or more Convention countries, equivalent to an application made in one of those Convention countries, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country ; or
- (b) is, in accordance with the law of a Convention country, equivalent to an application made in that Convention country, the first-mentioned application shall, for the purposes of this Act, be deemed to have been made in that Convention country.

141.—(1.) Where a person (being a person specified in section thirty-four of this Act) has made an application for a patent or similar protection in respect of an invention in a Convention country (in this Part referred to as "the basic application") and—

Applications
under
International
Conventions.

- (a) that person ;
- (b) that person jointly with the assignee of a part interest in the invention ;
- (c) the assignee of that person ; or

- (d) the legal representative, or the assignee of the legal representative, of a person referred to in any of the last three preceding paragraphs, either solely or jointly with some other person so referred to, as the case requires,

lodges an application for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim fairly based on matter disclosed in the basic application, is the date of making of the basic application.

(2.) Where applications have been made for similar protection in respect of an invention in two or more Convention countries, the period of twelve months referred to in the last preceding sub-section shall be reckoned from the date on which the earlier or earliest of those applications was made.

Multiple
priorities.

142.—(1.) Where two or more applications for patents or similar protection in respect of inventions have been made in one or more Convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in sub-section (1.) of the last preceding section within twelve months from the date on which the earlier or earliest of those applications was made, in respect of the inventions disclosed in the specifications which accompanied the basic applications.

(2.) The Examiner shall report whether those inventions are so related as to constitute one invention.

(3.) If the Commissioner is of opinion that the inventions are so related as to constitute one invention, he may accept the application and grant one patent on the application.

(4.) The priority date of a claim of the complete specification, being a claim fairly based on matter disclosed in one or more of the basic applications, is the date on which that matter was first disclosed.

(5.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

Manner of
application
under this
Part.

143.—(1.) Subject to the next succeeding sub-section, an application for the grant of a patent under this Part shall be made and proceeded with in the same manner as an ordinary application under this Act.

(2.) The application shall be accompanied by a complete specification.

(3.) In addition to the complete specification, a copy or copies of the specification or specifications, or corresponding documents, filed or deposited by the applicant in the Patent Office of the Convention country in which the basic application was made, certified

by the official chief or head of the Patent Office of the Convention country or otherwise verified to the satisfaction of the Commissioner, shall be lodged at the Patent Office—

- (a) at the same time as the application is so lodged ;
- (b) within three months after that time ; or
- (c) within such further period after that time as the Commissioner allows.

(4.) If any such specification or other document is in a foreign language, a translation of the specification or document, verified by declaration or otherwise to the satisfaction of the Commissioner, shall be annexed to the specification or document.

144. For the purposes of this Act, the date on which an application was made in a Convention country is such date as the Commissioner is satisfied, by certificate of the official chief or head of the Patent Office of the Convention country or otherwise, is the date on which the application was made in that Convention country.

Date of making application in Convention country.

145. For the purposes of this Act—

- (a) matter shall be deemed to have been disclosed in a basic application if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in the basic application or in a specification or other document lodged in support of, and at the same time as, the basic application ; and
- (b) account shall not be taken of a disclosure effected by such a specification or other document unless a copy of the specification or document is lodged at the Patent Office with the application under this Part or within such further time as is prescribed.

Disclosure in Convention applications.

PART XVII.—THE APPEAL TRIBUNAL.

146.—(1.) The High Court is the Appeal Tribunal for the purposes of this Act.

Appeal Tribunal.

(2.) The High Court has jurisdiction to hear and determine appeals which lie to the Appeal Tribunal under this Act.

147. The jurisdiction of the High Court as the Appeal Tribunal shall be exercised by a single Justice.

Jurisdiction to be exercised by a single Justice.

148. The Appeal Tribunal may grant to the Commissioner leave to intervene in an appeal to the Appeal Tribunal.

Intervention by Commissioner.

149. Upon the hearing of an appeal, the Appeal Tribunal may—

Powers of Appeal Tribunal.

- (a) if it thinks fit, call in the aid of an assessor specially qualified to assist it in the hearing and determination of the appeal ;
- (b) admit further evidence, either orally or upon affidavit or otherwise ;
- (c) permit the examination and cross-examination of witnesses, including witnesses who gave evidence orally or upon affidavit or otherwise at the hearing before the Commissioner ;

- (d) order an issue of fact to be tried in such manner as it directs ;
- (e) affirm, reverse or modify the decision, determination or direction appealed from ;
- (f) give such judgment, or make such order, as in all the circumstances it thinks fit, or refuse to make an order ; and
- (g) order a party to pay costs to another party.

Special case.

150.—(1.) The Appeal Tribunal may state a case or reserve a question for the consideration of a Full Court of the High Court, or may direct a case or question to be argued before a Full Court of the High Court.

(2.) A Full Court of the High Court has jurisdiction to hear and determine the case or question.

Appeals.

151. A Full Court of the High Court has jurisdiction to hear and determine appeals from a judgment or order of the Appeal Tribunal with respect to which a Full Court of the High Court grants leave to appeal.

PART XVIII.—MISCELLANEOUS.

Devolution of patents.

152.—(1.) The rights granted to a patentee by a patent are personal property and are capable of assignment and of devolution by operation of law.

(2.) An assignment of a patent shall be in writing signed by or on behalf of the assignor and assignee.

(3.) A patent may be assigned for a place in or part of Australia.

Co-ownership of patents.

153.—(1.) Where a patent is granted to two or more persons, each of those persons is, unless an agreement to the contrary is in force, entitled to an equal undivided share in the patent.

(2.) Subject to this section and to the next succeeding section, where two or more persons are patentees, each of those patentees is, unless an agreement to the contrary is in force, entitled, by himself or his agents, to make, use, exercise and vend the patented invention for his own benefit without accounting to the other or others.

(3.) Subject to the next succeeding section and to any agreement for the time being in force, where there are two or more patentees in respect of a patent, one of those patentees shall not grant a licence under the patent, or assign an interest in the patent, except with the consent of the other patentee or patentees.

(4.) Where an article is sold by one of two or more patentees, the purchaser, and a person claiming through him, is entitled to deal with the article in the same manner as if it had been sold by both or all the patentees.

(5.) Subject to this section, the laws applicable to ownership and devolution of personal property apply in relation to patents as they apply in relation to other choses in action.

(6.) Nothing in sub-section (1.) or (2.) of this section affects the rights or obligations of a trustee or of the legal representative of a deceased person or rights or obligations arising out of either of those relationships.

154.—(1.) Where there are two or more patentees in respect of a patent, the Commissioner may, upon application made to him by one or more of those patentees, give such directions in accordance with the application as to a dealing with the patent or interest in the patent, the grant of licences under the patent or the exercise of a right under the last preceding section in relation to the patent, as he thinks fit.

Power of Commissioner to give directions to co-owners.

(2.) If a patentee fails, within fourteen days after being requested in writing by one of the other patentees to execute an instrument or to do some other thing required for the carrying out of a direction given under the last preceding sub-section, to execute that instrument or to do that thing, the Commissioner may, upon application made to him by one of those other patentees, give directions empowering a person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3.) Before giving a direction in pursuance of an application under this section, the Commissioner shall give an opportunity to be heard—

- (a) in the case of an application under sub-section (1.) of this section—to the other patentee or patentees ; or
- (b) in the case of an application under sub-section (2.) of this section—to the person in default.

(4.) A direction shall not be given under this section—

- (a) so as to affect the rights or obligations of a trustee or of the legal representative of a deceased person or rights or obligations arising out of either of those relationships ; or
- (b) which is inconsistent with the terms of an agreement between the patentees.

(5.) An appeal lies to the Appeal Tribunal from a decision or direction of the Commissioner under this section.

155.—(1.) The Commissioner may refuse to accept an application and complete specification or to grant a patent—

Refusal of certain applications.

- (a) for an invention the use of which would be contrary to law ; or
- (b) on the ground that the specification claims as an invention—
 - (i) a substance which is capable of being used as food or medicine, whether for human beings or for animals and whether for internal or external use, and is a mere mixture of known ingredients ; or
 - (ii) a process producing such a substance by mere admixture.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under the last preceding sub-section.

156. An amendment under this Act of a complete specification may be or include an amendment of the priority date of a claim.

Priority dates may be amended.

Invalid claim
not to vitiate
valid claim.

157. Where a complete specification contains two or more claims, the invalidity of the patent so far as it relates to one claim does not affect the validity of the patent so far as it relates to another claim.

Invention not
anticipated
or patent not
invalid in certain
cases.

158.—(1.) Objection shall not be taken to an application for a patent, so far as the invention is claimed in any claim of the complete specification, and a patent, so far as the invention is so claimed, is not invalid, by reason only of—

- (a) the invention, so far as so claimed, having been published in Australia—
 - (i) in a specification lodged in connexion with an application for a patent made in Australia and dated not less than fifty years before the priority date of that claim ;
 - (ii) in a specification describing the invention for the purpose of an application for a patent or similar protection in a country outside Australia made not less than fifty years before that date ; or
 - (iii) in an abridgment of, or extract from, a specification referred to in either of the last two preceding subparagraphs, published under the authority of the Commissioner or of the government of a country outside Australia ;
- (b) the invention, so far as so claimed, having been published or used before the priority date of that claim, if the Commissioner, Appeal Tribunal or court is satisfied—
 - (i) that the publication was made or the user took place without the knowledge and consent of the applicant or patentee ;
 - (ii) that the subject of the publication or user was derived or obtained from the applicant or patentee or from some person from whom the applicant or patentee derived his title ; and
 - (iii) if the applicant or patentee was aware of the publication or user before the priority date of that claim, that he applied for a patent for the invention with all reasonable diligence after becoming aware of the publication or user ;
- (c) the exhibition of the invention, so far as so claimed, at an exhibition certified by the Attorney-General, by notice in the *Gazette*, to be an exhibition for the purposes of this section ;
- (d) the publication of the invention, so far as so claimed, during the period of the holding of such an exhibition ;
- (e) the use of the invention, so far as so claimed, for the purpose of such an exhibition in the place where the exhibition is held ;

- (f) the use of the invention, so far as so claimed, during the period of the holding of such an exhibition by a person elsewhere without the knowledge and consent of the applicant or patentee ;
- (g) by the publication of the invention, so far as so claimed, in a paper prepared by the actual inventor and read before a learned society or, if the paper was not so read, published with his consent by or on behalf of such a society, if an application for a patent for the invention was made within six months after the reading or publication of the paper, as the case may be ;
- (h) the invention, so far as so claimed, having been publicly worked in Australia, within one year before the priority date of that claim—
- (i) by the patentee or applicant or by a person from whom he derives his title ; or
 - (ii) by some other person with the consent of a person referred to in the last preceding sub-paragraph, if the working was for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should have been in public ;
- (i) the publication of the invention—
- (i) by the patentee or applicant or by a person from whom he derives his title ; or
 - (ii) by some other person with the consent of a person referred to in the last preceding sub-paragraph, being publication—
 - (iii) to the Commonwealth or a State or to an authority of the Commonwealth or a State ; or
 - (iv) to a person authorized by the Commonwealth or a State to make an investigation of the invention ;
- or
- (j) anything done for the purpose of an investigation referred to in sub-paragraph (iv) of the last preceding paragraph.

(2.) Paragraphs (c), (d), (e) and (f) of the last preceding sub-section apply only if the applicant or patentee, before exhibiting the invention, has given to the Commissioner notice of his intention to exhibit the invention and an application for a patent for the invention has been made before the closing of the exhibition, or, if the exhibition was open for a longer period than six months, within six months after the opening of the exhibition.

159.—(1.) The Commissioner may correct a clerical error or obvious mistake in the Register, in a patent, in an application or specification or in proceedings under this Act, not being proceedings in a court.

Correction of clerical errors and obvious mistakes.

(2.) Where a request is made for a correction under the last preceding sub-section and it appears to the Commissioner that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons who would be affected by the correction, the Commissioner shall—

- (a) if the request relates to a complete specification—treat the request as an application for leave to amend the specification, in which case the provisions of this Act relating to amendment of complete specifications are applicable; or
- (b) in any other case—require a notice of the nature of the proposed correction to be advertised in the *Official Journal*.

(3.) Where the Commissioner has required notice of the nature of the proposed correction to be advertised under paragraph (b) of the last preceding sub-section, a person interested may, within the prescribed time, give notice to the Commissioner of opposition to the request and shall serve a copy of the notice on the person making the request.

(4.) Where notice is so given, the Commissioner shall, after hearing the applicant and the opponent, if desirous of being heard, decide the case.

(5.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under the last preceding sub-section.

Power to extend times by reason of errors in Patent Office, &c.

160.—(1.) Where, by reason of—

- (a) an error or action on the part of an officer or person employed in the Patent Office; or
- (b) circumstances beyond the control of the person concerned, an act or step in relation to an application for a patent or in proceedings under this Act (not being proceedings in a court) required to be done or taken within a certain time has not been so done or taken, the Commissioner may extend the time for doing the act or taking the step and permit the act to be done or the step to be taken.

(2.) The time required for doing an act or taking a step may be extended under this section although that time has expired.

Examiners' reports to be communicated.

161. A copy of each report of an Examiner under this Act shall, subject to Part XIV., be sent to the applicant or patentee, as the case requires.

Exercise of discretionary power by Commissioner.

162. Where a discretionary power is by this Act given to the Commissioner, he shall not exercise that power adversely to the person applying for the exercise of that power without (if so required by that person within such time as is specified by the Commissioner) giving to that person an opportunity of being heard.

163.—(1.) Where in this Act provision is made that a person interested may give notice to the Commissioner of opposition to an action or matter or may do some other act, or that the Commissioner shall hear a person interested, the Commissioner may, as a preliminary issue, hear and determine the question of the right of the person concerned to give the notice of opposition or do the other act, or to be heard by the Commissioner, as the case may be.

Determination
of question of
interest.

(2.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

164. Where by this Act an application, notice or request is required or permitted to be made or signed by a person, that application, notice or request may be made or signed, on behalf of that person, by a person entitled under this Act to practise as a patent attorney.

Making and
signing of
application.

165. If a person is, by reason of infancy, lunacy or other disability, incapable of making a declaration, or doing anything required or permitted by this Act, the guardian or committee of the incapable person, or if there is no such guardian or committee, a person appointed by a court, or a Justice or Judge of a court, of the Commonwealth or of a State or Territory of the Commonwealth possessing jurisdiction in respect of the property of incapable persons, upon the petition of a person on behalf of the incapable person, or of some other person interested in the making of the declaration or the doing of the thing, may make the declaration (or a declaration as nearly corresponding to the declaration as the circumstances permit) and may do that thing, in the name and on behalf of the incapable person, and all acts so done are, for the purposes of this Act, as effectual as if they had been done by the incapable person and that person had not been incapable at the time of the making of the declaration or the doing of the thing.

Declaration
by infant,
lunatic, &c.

166.—(1.) A person who applies under this Act for the revocation of a patent, and a person who, in an action or proceeding, disputes the validity of a patent, either wholly or in so far as it relates to a claim of the complete specification, shall deliver with his petition, or with the pleading or other document in which he disputes the validity of the patent, particulars of the grounds of invalidity on which he relies.

Particulars of
objections.

(2.) If one of those grounds is previous publication or user, the particulars shall state the time and place of the previous publication or user alleged, and, in the case of previous user, the particulars—

- (a) shall specify the name of the person who is alleged to have made the previous user ;
- (b) shall specify the period during which the previous user is alleged to have continued ;
- (c) shall contain a description sufficient to identify the previous user ; and

(d) if the previous user relates to machinery or apparatus, shall specify whether the machinery or apparatus is in existence and, if it is in existence, where it can be inspected.

(3.) Except by leave of the court, Justice or Judge—

(a) evidence is not admissible in proof of a ground of invalidity of which particulars have not been given ; and

(b) evidence as to machinery or apparatus which is in existence at the date of the delivery of the particulars is not admissible unless it is proved that the party relying on the evidence, if the machinery or apparatus is in his own possession, has offered inspection of the machinery or apparatus, or, if it is not in his own possession, has used reasonable endeavours to obtain inspection of the machinery or apparatus for the other parties to the petition, action or proceeding.

(4.) The court, Justice or Judge may extend the time for delivering particulars under this section and may allow particulars so delivered to be amended.

Assessor.

167. On the hearing of an action or proceeding under this Act, the High Court may, if it thinks fit, call in the aid of an assessor specially qualified to assist it in the hearing and trial of the case.

Costs where patent bad in part.

168. In an action or proceeding in which the validity of a patent is disputed, the court may, if it is of opinion that some of the claims in the complete specification which are alleged to be invalid are not invalid but that others are invalid, apportion the costs between the parties to the action or proceeding in such manner as it thinks just.

Certificate of validity.

169. In an action or proceeding in which the validity of a patent is disputed, the court may certify that the validity of a claim of the complete specification came in question, and if the court so certifies, then, in a subsequent action or proceeding for the infringement of that claim, or for the revocation of the patent so far as it relates to that claim, the patentee, or other person supporting the validity of the claim, on obtaining a final order or judgment in his favour, is entitled, unless the court trying the action or proceeding otherwise directs, to have his full costs, charges and expenses as between solicitor and client so far as that claim is concerned.

Security for costs.

170. If a person who—

(a) gives notice of opposition under this Act ; or

(b) appeals to the Appeal Tribunal,

neither resides nor carries on business in Australia, the Appeal Tribunal or the Commissioner, as the case may be, may require that person to give security for the costs of the proceeding or appeal, and in default of security being given to the satisfaction of the Appeal Tribunal or the Commissioner, as the case may be, the proceeding or appeal may be dismissed.

171. Where, at the hearing of an action or proceeding under this Act, a patent attorney attends in court for the purpose of assisting a party in the conduct of the hearing and an order is made for payment of the costs of that party, those costs may include an allowance in respect of that attendance.

Costs of attendance of patent attorney.

172.—(1.) Where by this Act provision is made for the service on the Commissioner of a judgment or order of a court, and an order is made by the Queen in Council, or by a court, on appeal from such a judgment or order, the person in whose favour the order on appeal is made is not entitled to enforce the order until he has served on the Commissioner an office copy of that order.

Service of orders on appeal.

(2.) Upon the service on him of such an order, the Commissioner shall make such entries (if any) in the Register, or take such other action (if any), as the case requires.

173.—(1.) A person shall not use, in connexion with his business, words which would reasonably lead to the belief that his office is, or is officially connected with, the Patent Office.

Improperly describing any office as the Patent Office.

Penalty : Twenty pounds.

(2.) Without limiting the effect or application of the last preceding sub-section, a person who—

- (a) places, or suffers or permits to be placed, on the building in which his office is situated ;
- (b) uses in advertising his office or business ; or
- (c) places on a document, as a description of his office or business, the words " Patent Office ", or the words " Office for obtaining Patents ", or words of similar import, whether alone or in conjunction with other words, is guilty of an offence.

Penalty : Twenty pounds.

174.—(1.) A person shall not falsely represent that he or another person is the patentee of an invention.

Penalty : One hundred pounds.

False representation as to patents and patented articles.

(2.) A person shall not falsely represent that an article sold by him is patented in Australia or is the subject of an application for a patent in Australia.

Penalty : One hundred pounds.

(3.) For the purposes of this section—

- (a) a person shall be deemed to represent that an article is patented in Australia if there are stamped, engraved or impressed on, or otherwise applied to, the article the word " patent " or " patented ", the words " provisional patent ", or some other word or words expressing or implying that a patent for the article has been obtained in Australia ; and

(b) a person shall be deemed to represent that an article is the subject of an application for a patent in Australia if there are stamped, engraved or impressed on, or otherwise applied to, the article the words "patent applied for", "patent pending", or some other word or words implying that an application for a patent for the article has been made in Australia.

(4.) A prosecution under this section shall not be instituted except with the written consent of the Attorney-General or of some person authorized by him.

Publication
of Journal,
indexes, &c.

175.—(1.) The Commissioner shall issue periodically an Official Journal containing such matters as are prescribed or as the Commissioner thinks fit.

(2.) The Commissioner shall make provision for selling copies of the *Official Journal* and of complete specifications which are open for public inspection.

(3.) The Commissioner shall prepare and publish such indexes, abridgments of specifications and other works relating to inventions as he thinks fit.

Fees.

176.—(1.) Subject to the next succeeding sub-section, there shall be paid to the Commissioner such fees as are prescribed.

(2.) The renewal fees in respect of a patent granted under the repealed Acts are as fixed by or under those Acts.

(3.) Where—

(a) a fee is payable in respect of the doing of an act by the Commissioner, the Commissioner shall not do that act until the fee has been paid ;

(b) a fee is payable in respect of the doing of an act by a person other than the Commissioner, the act shall be deemed not to have been done until the fee has been paid ; or

(c) a fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.

Regulations.

177. The Governor-General may make regulations, not inconsistent with this Act, prescribing all matters which by this Act are required or permitted to be prescribed, or which are necessary or convenient to be prescribed for carrying out or giving effect to this Act, or for the conduct of any business relating to the Patent Office, and in particular—

(a) for providing for the amendment of a document for the amendment of which no provision is made by this Act ;

- (b) for providing for the destruction of documents relating to applications for patents lodged at the Patent Office not less than twenty-five years before the time of destruction ; and
- (c) for prescribing penalties not exceeding a fine of Fifty pounds or imprisonment for six months for offences against the regulations.

THE SCHEDULE.

Section 4.

ACTS REPEALED.

FIRST COLUMN. Acts Repealed.	SECOND COLUMN. Extent of Repeal.
<i>Patents Act 1903</i>	The whole
<i>Patents Act 1909</i>	The whole
<i>Patents Trade Marks and Designs Act 1910</i>	Section 3
<i>Patents Act 1921</i>	The whole
<i>Patents Act 1930</i>	The whole
<i>Patents, Trade Marks and Designs Act 1932</i>	Sections 4, 5, 6 and 7
<i>Patents Act 1933</i>	The whole
<i>Patents Act 1935</i>	The whole
<i>Patents Act 1946</i>	The whole
<i>Statute Law Revision Act 1950</i>	Section 9 .