

Patents Regulations 1991 No. 71

EXPLANATORY STATEMENT

STATUTORY RULES 1991 No. 71

Issued by the Authority of the Minister for Industry, Technology and Commerce

On 22 November 1986, the Government announced the acceptance of a number of recommendations made by the Industrial Property Advisory Committee in its report "Patents, Innovation and Competition in Australia" (IPAC's Report). Recommendation 23 of that report, which was accepted by the Government, provided that the patents legislation should be reviewed and completely redrafted to streamline procedures, particularly with a view to eliminating unnecessary steps and procedures, avoiding special categories, and establishing appropriate sanctions for non-compliance. Following the acceptance of the recommendation, the Commissioner of Patents invited representatives of the Law Council of Australia and the Institute of Patent Attorneys of Australia Inc to form a working party, under the Chairmanship of the Commissioner, to review the legislation, particularly with a view to relegating procedural matters to the regulations. An undertaking was given that other interested parties would be consulted as appropriate.

The Patents Act 1990 (the Act) is the result of that Working Party's review of the patent legislation and incorporates other agreed recommendations made in IPAC's report that are aimed at fostering indigenous innovation and the use of the international patent system in developing export markets to improve Australia's international competitive position.

In addition to redrafting the provisions contained in the former Patents Regulations, the Patents Regulations (the Regulations) will give effect to the Working Party's considerations in relation to the relegation of procedural matters to the regulations, as well as making provision for procedural matters resulting from the incorporation into the Act of other recommendations contained in IPAC's report.

Significant additions and changes to the Regulations provide for:

- matters that have been introduced into the Act and which have provisions included in the Regulations; such as
 - summary hearings by the Commissioner in relation to opposition matters resulting from disputes between parties over the eligibility of a particular invention for patenting or the eligibility of a particular party to claim ownership of the invention
 - procedures relating to re-examination of an application for a patent
 - provisions for procedures relating to the supply of abstracts for patent specifications
- a number of matters that have been relegated from the 1952 Act to the Regulations including
 - priority date for claims of a specification i.e. the date from which an owner of a patent can claim protection following the grant of a patent
 - certain matters which the Commissioner must examine and report on when considering a patent application

- provisions for the Commissioner to approve the forms used for the purposes of the Act and the Regulations
- the English text of the Patent Cooperation Treaty and the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure
- incorporation into the Regulations of provisions relating to the administration of the patent attorneys profession which were previously the subject of separate regulations.

As with the development of the Act, there has been extensive consultation with the interest groups during the processes associated with the drafting of the Regulations, both through the working party and by the issue of an exposure draft of the Regulations on 5 March 1991. All comments on the exposure draft of the Regulations made by the Working Party, interest groups and the general public that were received by the due date, 29 March 1991, have been considered and where appropriate have been taken into account in settling the Regulations.

While the development of the Regulations has been undertaken in consultation with the Working Party, there have been several contentious issues where for reasons of Government policy or drafting style it has not been possible to adopt the Working Party's preferred position.

In addition to the revision of the fees structure, required as a result of changes to the legislation, the level of fees for actions are being increased by an average of 8%. This increase follows consultation with the Patent Office's interest groups and is to enable the Patent, Trade Marks and Designs Offices to meet the Government's expectation that they will recover 100% of the costs of operation.

The Act commenced on 30 April 1991, the first day after the end of the 6 months period from the date of the Royal Assent, and the Regulations commenced on the same day.

Attachment A provides a summary of the contents of the Regulations. In line with drafting policy, the chapter numbers that have been used in the Regulations relate to those used in the Act. As a consequence the chapter numbers in the Regulations are not sequential as some chapters of the Act do not require regulations.

ATTACHMENT A

Details of the Patents Regulations

Chapter 1 - Introductory

- provides the formalities including a 30 April 1991 commencement date and the definition of certain words and phrases in the Regulations.

Chapter 2 - Patent rights, ownership and validity

- prescribes necessary formalities in relation to a patent right, its ownership and its validity.

Chapter 3 - From application to acceptance

- provides formalities and practice relating to the processing of an application to acceptance including such things as abstracts, priority dates, examination and procedures for inventions involving micro-organisms.

Chapter 4 - Publication

- prescribes the information that must be published and documents that must be open for public inspection.

Chapter 5 - opposition

- prescribes necessary formalities and practice relating to opposition proceedings including procedures for the filing of an opposition, time allowed for opposition actions and the conduct of opposition proceedings.

Chapter 6 - Grant and term of patents

- prescribes the procedures and formalities in relation to the grant or term of the patent including publication, the date of the patent, extensions of term of a petty patent (a patent granted for a shorter period, fewer monopoly claims, fewer formalities, and is less expensive to obtain), periods in which an application for extension of term will lapse.

Chapter 7 - Patents of addition

- prescribes the form of application for patents of addition (patents that are granted for an improvement or modification to an invention that is already the subject of a patent or application for a patent) and the form for the revocation of a patent and grant of a patent of addition instead.

Chapter 8 - PCT applications and Convention applications

- prescribes matters necessary for Australia to meet its obligations under the PCT and in relation to Convention countries.

Chapter 9 - Re-examination

- prescribes the matters necessary for the re-examination of a specification including formalities.

Chapter 10 - Amendments

- prescribes matters necessary to enable amendments to be made to patent requests, specifications, and other filed documents.

Chapter 11 - Infringement

- prescribes the countries listed in Part 1 of Schedule 4 for the purpose of definitions in the Act and the time of lodging particulars of infringement.

Chapter 12 - Compulsory licences and revocation of patents

- prescribes the matters necessary in relation to lodgements of applications for compulsory licences, the revocation of a standard patent after grant of a compulsory licence and the surrender of a patent.

Chapter 13 - Withdrawal and lapsing of applications and ceasing of patents

- prescribes matters relating the withdrawal and lapsing of applications or the ceasing of patents including publication of notices in the Official Journal, prescribed periods in which actions must be taken and fees required in relation to relevant actions.

Chapter 15 - Special provisions relating to associated technology

- prescribes the time periods for restoration of a lapsed patent application, requirements relating the reinstatement of overseas applications and periods for orders relating to standard patents.

Chapter 17 - The Crown

- prescribes matters relating to prohibitions on the publication of documentation associated with the grant of patents on subject matter associated with defence-sensitive material.

Chapter 19 - The Register and official documents

- prescribes matters that shall be entered on the Register of Patents and provisions associated with a request for information contained in the Register.

Chapter 20 - Patent attorneys

- prescribes procedures for the conduct of examinations, recognition of qualifications, registration and disciplinary provisions for patent attorneys.

Chapter 21 - Administration

- prescribes the hours of duty of the Patent Office and each sub-office.

Chapter 22 - Miscellaneous

- prescribes matters relating to requirements associated with fees for both national and PCT applications and matters relating to costs associated with proceedings under the Act and Regulations. In addition it prescribes matters associated with the death of an applicant or nominated person, addresses for the service of documents, extensions of time for taking actions,

evidence and declarations, matters relating to documentation and the review of decisions made by the Commissioner.

Schedule 1 - Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

- incorporates into the Regulations the text of the Budapest Treaty.

Schedule 2 - Patent Cooperation Treaty

- incorporates into the Regulations the text of the Patent Cooperation Treaty.

Schedule 3 - Requirements for documents to be filed

- prescribes the formalities that must be met in relation to documents filed in the Offices. The formalities are necessary to facilitate publication of relevant documents and for Australia to meet PCT requirements.

Schedule 4 - Convention countries

- lists the Convention countries for the purposes of Regulations 8.5 and 11.1.

Schedule 5 - Prescribed subjects

- prescribes the subjects in which the Patent Attorneys Professional Standards Board conducts examinations.

Schedule 6 - Prescribed qualifications

- prescribes the qualifications the Patents Attorneys Professional Standards Board must recognise.

Schedule 7 - Fees

- prescribes the level of fees for actions taken under the Act and Regulations.

Schedules 8 - Costs

- prescribes the scale of costs taxed under the Act.