

## **EXPLANATORY STATEMENT**

### **Select Legislative Instrument 2009 No. 150**

Issued by the Authority of the Minister for Innovation, Industry, Science and Research

*Patents Act 1990*

*Trade Marks Act 1995*

*Designs Act 2003*

*Intellectual Property Law Amendment Regulations 2009 (No. 1)*

Section 228 of the *Patents Act 1990* (the Patents Act), section 231 of the *Trade Marks Act 1995* (the Trade Marks Act) and section 149 of the *Designs Act 2003* (the Designs Act) provide, in part, that the Governor-General may make regulations for the purposes of those Acts, prescribing matters required or permitted by those Acts to be prescribed.

The Patent Cooperation Treaty (PCT) provides for co-operation between member countries in the filing, searching and examination of applications for the protection of inventions. Subsection 228(5) of the Patents Act requires the Governor-General to make regulations setting out the English text of the PCT as in force for Australia on the commencing day of the Act, and afterwards such regulations as are necessary to keep that English text up-to-date.

The purpose of the Regulations is to update the English text of the rules made under the PCT to reflect recent changes to the PCT.

The Regulations also make changes to improve the administration of various matters prescribed under the Patents Act, Trade Marks Act and the Designs Act and correct some minor typographical errors.

The objectives of the Regulations are further discussed in [Attachment A](#).

The details of the Regulations are set out in [Attachment B](#).

No consultation was undertaken prior to making these Regulations. This is because the Regulations are of a minor or machinery nature only, and do not substantially change the law. The amendments made by Schedule 1 reflect changes to an international treaty and do not change Australian law. The amendments in Schedules 2, 3 and 4 make the requirements for declarations under the designs, patents and trade marks legislation simpler, clearer and consistent. They also correct typographical errors.

The Regulations commence on 1 July 2009.

## Attachment A

### Objectives of the *Intellectual Property Law Amendment Regulations 2009 (No. 1)*

One purpose of the Regulations is to update the English text of the *Regulations under the Patent Cooperation Treaty* (PCT Rules) set out in Schedule 2A to the *Patents Regulations 1991* to reflect changes made to the PCT Rules by the International Patent Cooperation Union Assembly at a meeting held in September 2008. The changes to the PCT Rules are purely of an administrative nature. Firstly, the changes clarify the procedures for withdrawal of an international application under Article 14(4) of the Patent Cooperation Treaty (PCT). Secondly, the changes introduce a requirement for the applicant to submit replacement sheet(s) for every sheet of the international application that is amended by the applicant under Articles 19 or 34 of the PCT.

A further purpose of the Regulations is to align the various requirements for declarations in the designs, patents and trade marks legislation. These requirements are respectively set out in regulation 11.26 of the *Designs Regulations 2004*, regulation 22.13 of the *Patents Regulations* and regulation 21.6 of the *Trade Marks Regulations 1995*. These provisions differed from each other in ways that might, in rare cases, disadvantage the declarant. The provisions also lacked clarity and were difficult to read. As declarations made under the respective pieces of legislation are all intended to perform the same function, it is appropriate to align the various requirements for declarations. It is also appropriate to repackage the requirements into core requirements and case-specific requirements, in accordance with current government recommendations. A person will be able to easily read the provisions, as amended, and skip material that is not relevant to their circumstances.

Finally, the Regulations also make a number of minor typographical corrections to Chapter 20 of the *Patents Regulations* and Part 20 of the *Trade Marks Regulations*.

**Details of the *Intellectual Property Law Amendment Regulations 2009 (No. 1)***

Regulation 1 identifies the Regulations as the *Intellectual Property Law Amendment Regulations 2009 (No. 1)*.

Regulation 2 specifies that the Regulations commence on 1 July 2009.

Regulation 3 specifies that Schedule 1 amends the *Patents Regulations 1991* (the Patents Regulations) and outlines the transitional provisions that will facilitate a smooth transition to the new arrangements in Schedule 1.

Regulation 4 specifies that Schedule 2 also amends the Patents Regulations.

Regulation 5 specifies that Schedule 3 amends the *Trade Marks Regulations 1995* (the Trade Marks Regulations).

Regulation 6 specifies that Schedule 4 amends the *Designs Regulations 2004* (the Designs Regulations).

**Schedule 1 — Amendments of *Patents Regulations 1991* relating to the Patent Cooperation Treaty**

Item 1 amends the date found in subregulation 1.4(2) to reflect the latest Patent Cooperation Treaty (PCT) Rule changes.

Item 2 adds the date 1 July 2009 to the table of amendments to the PCT Rules, set out at the beginning of Schedule 2A to the Patents Regulations. This table identifies the dates of all amendments made to the PCT Rules since their creation.

Items 3 to 7 update the English text of the PCT Rules set out in Schedule 2A to the Patents Regulations to reflect changes made to the PCT Rules by the thirty-eighth session of the International Patent Cooperation Union meeting held in Geneva on 22 to 30 September 2008.

The changes to the PCT Rules:

- clarify the procedures for withdrawal of an international application under Article 14(4) of the PCT—Item 3
- introduce a requirement for the applicant to submit replacement sheet(s) for every sheet of the international application which is amended by the applicant under Articles 19 or 34 of the PCT—Items 4 to 7.

**Schedule 2 — Other amendments of *Patents Regulations 1991***

Item 1 amends regulation 22.13 of the Patents Regulations, by substituting new subregulations

(2), (2A) and (2B) for the existing subregulation (2). This makes the requirements for declarations under the patents legislation ('patents declarations') simpler and clearer. The general matters required of all patents declarations are set out in new subregulation (2). The additional requirements for certain patents declarations—those made on behalf of another person, or for the purposes of a business whose details are set out in the declaration—are set out in new subregulations (2A) and (2B).

New subregulation (2A) introduces a new requirement: where a patents declaration is made on behalf of another person, that other person's address must be stated. New subregulation (2B) introduces a new requirement: where the declarant makes the declaration for the purposes of a business whose details are set out in the declaration, the declarant's office or position and the business's address must be stated.

Item 2 substitutes replacement paragraph 22.13 (f) for the existing provision in the Patents Regulations, so that any person who can witness a Commonwealth statutory declaration (that is, under the *Statutory Declarations Act 1959* (Cth)) can witness a declaration for the purpose of the patents legislation. A patents declaration is not required to be made as a Commonwealth statutory declaration.

Item 3 omits subregulation 22.13 (4) from the Patents Regulations. The requirements in that provision—to state before whom, when and where a patents declaration is made—are more clearly set out in new paragraphs 22.13 (2) (d) and (e), inserted by item 1.

Items 4 and 5 correct several typographic errors in provisions in Chapter 20 of the Patents Regulations, governing the initial registration of patent attorneys. These errors are uses of the noun 'practice', where it should have been the verb 'practise'.

### **Schedule 3 — Amendments of *Trade Marks Regulations 1995***

Item 1 corrects a typographical error in paragraph 20.8 (3) (b) of the Trade Marks Regulations, namely the use of the noun 'practice', where it should have been the verb 'practise'.

Item 2 amends regulation 21.6 of the Trade Marks Regulations, by substituting new subregulations (2), (2A) and (2B) for existing subregulation (2). This makes the requirements for declarations under the trade marks legislation (trade marks declarations) simpler and clearer. The general matters required of all trade marks declarations are set out in new subregulation (2). The additional requirements for certain trade marks declarations—those made on behalf of another person, or for the purposes of a business whose details are set out in the declaration—are set out in new subregulations (2A) and (2B). There are no new requirements for trade marks declarations.

Item 3 omits subregulation 21.6 (4) from the Trade Marks Regulations. The requirements in that provision—to state before whom, when and where a trade marks declaration is made—are more clearly set out in new paragraphs 21.6 (2) (d) and (e), inserted by item 2.

Item 4 corrects several typographic errors in provisions in Part 20 of the Trade Marks Regulations, governing the initial registration of trade marks attorneys. These errors are uses of the noun 'practice', where it should have been the verb 'practise'.

#### **Schedule 4 — Amendments of *Designs Regulations 2004***

Item 1 amends regulation 11.26 of the Designs Regulations, by substituting new subregulations (1), (1A) and (1B) for the existing subregulation (1). This makes the requirements for declarations under the designs legislation ('designs declarations') simpler and clearer. The general matters required of all designs declarations are set out in new subregulation (1). The additional requirements for certain designs declarations—those made on behalf of another person, or for the purposes of a business whose details are set out in the declaration—are set out in new subregulations (1A) and (1B).

New subregulation (1A) also introduces a new requirement: where a designs declaration is made on behalf of another person, that other person's address must be stated. New subregulation (2B) also introduces a new requirement: where the declarant makes the declaration for the purposes of a business whose details are set out in the declaration, the declarant's office or position and the business's address must be stated..

Items 2 and 3 substitutes replacement paragraphs 11.26 (f) and (g) for the existing provisions, and inserts a new subregulation 11.26 (3) into the Designs Regulations. This ensures that any person who can witness a Commonwealth statutory declaration can witness a designs declaration. A designs declaration is not required to be made as a Commonwealth statutory declaration. Further, the current reference to an Australian Consular or Diplomatic Officer (within the meaning of the *Consular Fees Act 1959*)—as persons who can witness designs declarations—is replaced with a simple reference to a diplomatic or consular officer. These officers are listed in new subregulation (3). This is for ease of reference, and consistency with the equivalent provisions in the Patents Regulations and the Trade Marks Regulations.