



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

Select Legislative Instrument 2009 No. 150

I, QUENTIN BRYCE, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following Regulations under the *Patents Act 1990*, the *Trade Marks Act 1995* and the *Designs Act 2003*.

Dated 24 June 2009

QUENTIN BRYCE
Governor-General

By Her Excellency's Command

KIM CARR
Minister for Innovation, Industry, Science and Research

1 Name of Regulations

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

2 Commencement

These Regulations commence on 1 July 2009.

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

- (1) Schedule 1 amends the *Patents Regulations 1991*.
- (2) The amendment made by item [3] of Schedule 1 applies in relation to an international application whose international filing date is on or after 1 July 2009.
- (3) The amendments made by items [4] to [7] of Schedule 1 apply in relation to an international application for which an amendment under Article 19 or 34 of the PCT is made on or after 1 July 2009.

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

Schedule 2 amends the *Patents Regulations 1991*.

**5 Amendment of *Trade Marks Regulations 1995* —
Schedule 3**

Schedule 3 amends the *Trade Marks Regulations 1995*.

**6 Amendment of *Designs Regulations 2004* —
Schedule 4**

Schedule 4 amends the *Designs Regulations 2004*.

Schedule 1 **Amendments of *Patents
Regulations 1991* relating to
the Patent Cooperation Treaty**
(regulation 3)

[1] Subregulation 1.4 (2)

omit

1 January 2009

insert

1 July 2009

[2] Schedule 2A, before Table of Provisions

omit

and on 1 January 2009.

insert

on 1 January 2009, and on 1 July 2009.

[3] Schedule 2A, Rule 29.4

substitute

29.4 *Notification of Intent to Make Declaration under Article 14 (4)*

(a) Before the receiving Office issues any declaration under Article 14 (4), it shall notify the applicant of its intent to issue such declaration and the reasons therefor. The applicant may, if he disagrees with the tentative finding of the receiving Office, submit arguments to that effect within two months from the date of the notification.

(b) Where the receiving Office intends to issue a declaration under Article 14 (4) in respect of an element mentioned in Article 11 (1) (iii) (d) or (e), the receiving Office shall, in the notification referred to in paragraph (a) of this Rule, invite the applicant to confirm in accordance with Rule 20.6 (a) that the element is incorporated by reference under Rule 4.18. For the purposes of Rule 20.7 (a) (i), the invitation sent to the applicant under this paragraph shall be considered to be an invitation under Rule 20.3 (a) (ii).

(c) Paragraph (b) shall not apply where the receiving Office has informed the International Bureau in accordance with Rule 20.8 (a) of the incompatibility of Rules 20.3 (a) (ii) and (b) (ii) and 20.6 with national law applied by that Office.

[4] Schedule 2A, Rule 46.5

substitute

46.5 *Form of Amendments*

(a) The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed.

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled.

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

substitute

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

[6] Schedule 2A, after Rule 66.8 (b)

insert

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

[7] Schedule 2A, Rule 70.16

substitute

70.16 *Annexes to Report*

(a) Each replacement sheet under Rule 66.8 (a) or (b) shall, unless superseded by later replacement sheets under Rule 66.8 (a) or (b) or amendments resulting in the cancellation of entire sheets under Rule 66.8 (b), be annexed to the report.

(a^{bis}) Replacement sheets under Rule 46.5 (a) shall, unless superseded or considered as reversed by replacement sheets under Rule 66.8 (c), be annexed to the report. Replacement sheets under rules 66.8 (c) shall, unless superseded by later replacement sheets under Rule 66.8 (c), be annexed to the report. Letters under Rule 46.5 (b) or Rule 66.8 (a) or (c) shall not be annexed to the report.

(b) Notwithstanding paragraphs (a) and (a^{bis}), each superseded or reversed replacement sheet referred to in those paragraphs shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2 (c). In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

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

(regulation 4)

[1] **Subregulation 22.13 (2)**

substitute

- (2) A declaration required by the Act or these Regulations to be given to the Commissioner must:
- (a) be headed with the title of the matter for which the declaration is made; and
 - (b) be expressed in the first person; and
 - (c) state the name and address of the person making the declaration; and
 - (d) state the name and title of the person before whom the declaration is made; and
 - (e) state the date on which, and the place at which, the declaration is made; and
 - (f) be divided into paragraphs, each of which must be:
 - (i) numbered consecutively; and
 - (ii) as far as practicable, confined to 1 subject.
- (2A) If the declaration is made on behalf of another person, it must also state the other person's name and address.
- (2B) If the declaration is made for the purposes of a business whose details are set out in the declaration, it must also state:
- (a) the office or position in the business held by the person who makes the declaration; and
 - (b) the address of the place at which the business is conducted or principally conducted.

[2] Paragraph 22.13 (3) (f)

substitute

(f) a person before whom a statutory declaration may be made under the *Statutory Declarations Act 1959* or the law of the State, Territory or foreign country where the declaration is made; or

[3] Subregulation 22.13 (4)

omit

[4] Further amendments — replace ‘practice’ with ‘practise’

The following provisions are amended by omitting ‘practice’ and inserting ‘practise’:

- paragraph 20.6 (2) (b)
- paragraph 20.6 (3) (b)
- paragraph 20.8 (3) (b).

[5] Further amendments — replace second mention of ‘practice’

The following provisions are amended by omitting the second mention of ‘practice’ and inserting ‘practise’:

- paragraph 20.3 (1) (c)
- subregulation 20.8 (1)
- subregulation 20.8 (2)
- subregulation 20.8 (4)
- subregulation 20.8 (5)
- subregulation 20.13 (1).

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

(regulation 5)

[1] Paragraph 20.8 (3) (b)

omit

practice

insert

practise

[2] Subregulation 21.6 (2)

substitute

- (2) A declaration required by the Act or these Regulations to be given to the Registrar must:
- (a) be headed with the title of the matter for which the declaration is made; and
 - (b) be expressed in the first person; and
 - (c) state the name and address of the person making the declaration; and
 - (d) state the name and title of the person before whom the declaration is made; and
 - (e) state the date on which, and the place at which, the declaration is made; and
 - (f) be divided into paragraphs, each of which must be:
 - (i) numbered consecutively; and
 - (ii) as far as practicable, confined to 1 subject.
- (2A) If the declaration is made on behalf of another person, it must also state the other person's name and address.
- (2B) If the declaration is made for the purposes of a business whose details are set out in the declaration, it must also state:
- (a) the office or position in the business held by the person who makes the declaration; and

- (b) the address of the place at which the business is conducted or principally conducted.

[3] Subregulation 21.6 (4)

omit

[4] Further amendments — replace second mention of ‘practice’

The following provisions are amended by omitting the second mention of ‘practice’ and inserting ‘practise’:

- paragraph 20.3 (1) (b)
- subregulation 20.8 (1)
- subregulation 20.8 (2)
- subregulation 20.8 (4)
- subregulation 20.8 (5).

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

(regulation 6)

[1] **Subregulation 11.26 (1)**

substitute

- (1) A declaration required by the Act or these Regulations to be given to the Registrar must:
 - (a) be headed with the title of the matter for which the declaration is made; and
 - (b) be expressed in the first person; and
 - (c) state the name and address of the person making the declaration; and
 - (d) state the name and title of the person before whom the declaration is made; and
 - (e) state the date on which, and the place at which, the declaration is made; and
 - (f) be divided into paragraphs, each of which must be:
 - (i) numbered consecutively; and
 - (ii) as far as practicable, confined to 1 subject.
- (1A) If the declaration is made on behalf of another person, it must also state the other person's name and address.
- (1B) If the declaration is made for the purposes of a business whose details are set out in the declaration, it must also state:
 - (a) the office or position held in the business by the person who makes the declaration; and
 - (b) the address of the place at which the business is conducted or principally conducted.

[2] Paragraphs 11.26 (2) (f) and (g)

substitute

- (f) a person before whom a statutory declaration may be made under the *Statutory Declarations Act 1959* or the law of the State, Territory or foreign country where the declaration is made; or
- (g) a diplomatic or consular officer.

[3] After subregulation 11.26 (2)

insert

- (3) In this regulation:

diplomatic or consular officer means a person who holds any of the following offices of the Commonwealth in a country other than Australia:

- (a) ambassador;
- (b) high commissioner;
- (c) minister;
- (d) chargé d'affaires;
- (e) counsellor or second or third secretary at an embassy, high commission or other post;
- (f) consul-general;
- (g) consul;
- (h) vice-consul.

Note

1. All legislative instruments and compilations are registered on the Federal Register of Legislative Instruments kept under the *Legislative Instruments Act 2003*. See <http://www.frli.gov.au>.