

EXPLANATORY STATEMENT

Select Legislative Instrument 2009 No. 332

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

Patents Act 1990, Trade Marks Act 1995, and Designs Act 2003

Intellectual Property Law Amendment Regulations 2009 (No. 2)

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 that the Governor-General may make regulations for the purposes of those Acts, prescribing matters required or permitted by the Acts to be prescribed.

Most major patent offices use digital libraries to store electronic copies of patent documents and to enable ready secure access to these documents by other patent offices. Examples of such libraries include those administered by the International Bureau of the World Intellectual Property Organization (WIPO), and by foreign patent offices including the European Patent Office, the United States Patent and Trademark Office and the Japanese Patent Office.

The Commissioner of Patents in Australia (the Commissioner) wants to participate in electronic document transfer arrangements involving digital libraries and any other cooperative arrangements between patent offices. The electronic transfer arrangements also provide tangible benefits to applicants by providing a complementary alternative to costly and time consuming processes that require the preparation and filing of multiple paper copies of the same patent document.

The main purpose of the Regulations is to amend the *Patents Regulations 1991* (the Patents Regulations) facilitate the operation of the Patents Act by enabling the Commissioner to fully participate in these electronic document transfer arrangements. Under the Regulations, the Commissioner treats a patent document that the applicant has made available to the Commissioner via an approved digital library as though the document had been filed directly with the Commissioner by the applicant. This is not possible under existing patents legislation where the applicant must file documents directly with the Commissioner.

The Regulations also make minor procedural amendments to the Patents Regulations, the *Trade Marks Regulations 1995* and the *Designs Regulations 2004*.

The objectives of the Regulations are set out in Attachment A. The details of the Regulations are set out in Attachment B.

In accordance with section 17 of the *Legislative Instruments Act 2003*, IP Australia has undertaken consultation with The Office of the Privacy Commissioner; peak intellectual property organisations; industry associations; and patent and trade marks attorneys.

The Regulations commence on 12 December 2009. This date enables Australia to join up to WIPO's initiatives for the electronic transfer of priority documents between intellectual property offices at the earliest opportunity. The date also supports various work sharing initiatives currently being developed by IP Australia and other intellectual property offices.

Objectives of the *Intellectual Property Law Amendment Regulations 2009 (No. 2)*

The main purpose of the Regulations is to facilitate the operation of the *Patents Act 1990* (the Patents Act) by amending the *Patents Regulations 1991* (the Patents Regulations) to enable the Commissioner of Patents in Australia (the Commissioner) to fully participate in electronic document transfer arrangements with foreign patent offices. The Regulations are primarily intended to facilitate the furnishing of priority documents for the purposes of the *Paris Convention for the Protection of Industrial Property* (the Paris Convention). These Regulations do not affect the basic rights and obligations established by the Paris Convention or the *Patent Law Treaty* (PLT), nor do they give rise to any new obligation under the Paris Convention or the PLT. The provisions also enable the Commissioner to give information and documents relating to patent applications that have become open to public inspection (OPI) to the International Bureau (IB) or a foreign patent office. This information may include information about a patent application and personal details relating to the applicant(s), the inventor(s) and/or third parties with an interest in the patent application. The documents for these purposes are primarily documents that relate to the patent filing, searching and examination processes.

The use of digital libraries for furnishing documents to the Commissioner is a subsidiary means of facilitating the operation of section 8 of the Patents Act. Applicants can still file copies of patent documents under the existing provisions if they so choose.

A secondary purpose of the Regulations is to amend the Patents Regulations to clarify the formality requirements that generally apply to the filing of applications and requests with IP Australia—especially the need to supply key pieces of information. It is important that there should be sufficient information available for interested persons and the general public to determine—at least in a preliminary way—if there is a real likelihood of a patent being granted on an application for a patent. Further, it also serves the interests of the applicant and any entitled persons that any matters of entitlement are resolved promptly: the alternative is an invalid grant that may be subsequently revoked. The amended formality requirements do not apply to patent applications filed under the *Patent Cooperation Treaty* (PCT) due to the continuing operation of subsection 89(1) of the Patents Act. Subsection 89(1) provides that PCT applications are to be treated as complying with the formality requirements.

Another aspect of the Regulations is to amend the Patents Regulations so that a wider range of search results filed under subsection 45(3) of the Patents Act become OPI. Currently, if search results are provided under subsection 45(3), then they only become OPI if the application proceeds to acceptance. Under the Regulations, if the case-file associated with the search results is OPI, then the search results will be OPI from the date that the search results are added to the case-file or the commencement date of the Regulations, whichever is the latter. Otherwise, if the associated case-file is not OPI, then the search results will be OPI from the date that the case-file is made OPI.

Finally, the Regulations amend the Patents Regulations, the *Trade Marks Regulations 1995* and the *Designs Regulations 2004* to repeal specific provisions relating to electronic communications such as facsimile transmissions. These specific provisions facilitated the filing of documents at times when IP Australia's offices were not open for business. Due to the general applicability of the *Electronic Transactions Act 1999*, IP Australia believes that specific electronic communication provisions are no longer required in the legislation that IP Australia administers.

Details of the *Intellectual Property Law Amendment Regulations 2009 (No. 2)*

Regulation 1 identifies the Regulations as the *Intellectual Property Law Amendment Regulations 2009 (No. 2)*.

Regulation 2 specifies that the Regulations commence on 12 December 2009.

Regulation 3 specifies that Schedule 1 amends the *Patents Regulations 1991* (the Patents Regulations).

Regulation 4 specifies that Schedule 2 amends the *Trade Marks Regulations 1995* (the Trade Marks Regulations).

Regulation 5 specifies that Schedule 3 amends the *Designs Regulations 2004* (the Designs Regulations).

Schedule 1 – Amendments of the *Patents Regulations 1991*

Item 1 adds the definition of *approved digital library* to subregulation 1.3(1). Digital libraries are secure repositories for storing electronic copies of patent documents. They are an essential component of electronic document transfer arrangements now being established between intellectual property offices. The Commissioner can approve a digital library by listing it in the *Australian Official Journal of Patents*.

Item 2 substitutes a new heading for regulation 1.6 to reflect the general nature of the provisions contained in this regulation.

Items 3 and 9 add, respectively, regulations 1.6A and 8.6A dealing with the use of approved digital libraries to facilitate the operation of the *Patents Act 1990*. Under the provisions, the Commissioner can treat a patent document that the applicant has made available to the Commissioner via an approved digital library as though the document had been filed directly with the Commissioner by the applicant. If the applicant makes the priority document available within the time limits, then their priority rights for an application made using the document transfer arrangements are protected. An applicant can place a document in an approved digital library prior to being asked to do so.

Item 4 adds regulation 1.8 to Chapter 1 as a general provision dealing with formality requirements for making any application or request that is given to the Commissioner. The provisions allow for applications made either by using a paper form (subregulation 1.8(1)) or by using an electronic process (subregulation 1.8(2)).

Item 5 substitutes amended wording for regulation 3.2A. Under the amended wording, the formality requirements for making an application for a standard patent—including a patent request for a standard patent—are aligned with the formality requirements that currently apply for applications for innovation patents as set out in regulation 3.2B. If applicants for standard patents do not comply with the amended requirements, then their application for a standard patent will lapse.

Item 6 substitutes amended wording for regulation 3.22. Under the amended wording, the

Commissioner can disclose copies of any document relating to an application for a patent or a patent—and information relating to those documents—to the International Bureau or a foreign patent office, or to an approved digital library. However, if the application is not open for public inspection (OPI), then the Commissioner must not disclose the application, document or information without the consent of the applicant.

Item 7 omits paragraph 4.3(1)(d). Following the amendment, if an applicant chooses to file search results which are associated with a case-file that is OPI, then the search results will be made OPI from the date that they are added to the case-file. If the associated case-file is not OPI, then the search results will be OPI from the date that the case-file is made OPI. Search results on case-files that are OPI—but have not been accepted—before the commencement date of the Regulations will be made OPI on the commencement date.

Item 8 substitutes a new heading for regulation 8.6 to reflect the general nature of the provisions contained in this regulation.

Item 10 omits regulation 22.8A that provides fax as a prescribed means for filing documents. Due to the general applicability of the *Electronic Transactions Act 1999* (the ET Act), specific electronic communication provisions are no longer required in the Patents Regulations.

Item 11 substitutes a new definition of *document* for the purposes of regulation 22.16. This new definition results from the amended formality requirements for standard patents which include a patent request for a standard patent. Prior to the commencement date of the Regulations, formality requirements for patent requests for standard patents are assessed under regulation 22.16.

Item 12 substitutes the heading of Schedule 3 to the Patents Regulations to update references to specific subregulations, paragraphs and subparagraphs of the Patent Regulations that deal with formal requirements for documents filed with the Commissioner.

Schedule 2 – Amendments of the *Trade Marks Regulations 1995*

Items 1 and 2 omit subregulations 21.2(3) and (5) dealing with the electronic filing of documents. Due to the general applicability of the ET Act, electronic filing provisions are no longer required to be specified in the Trade Marks Regulations.

Schedule 3 – Amendments of the *Designs Regulations 2004*

Item 1 omits regulation 11.17 that provides fax as a prescribed means for filing documents. Due to the general applicability of the ET Act, specific electronic communication provisions are no longer required to be specified in the Designs Regulations.