

EXPLANATORY STATEMENT

Select Legislative Instrument 2013 No. 31

Issued by the Authority of the Minister for Industry and Innovation

Copyright Act 1968

Designs Act 2003

Patents Act 1990

Trade Marks Act 1995

Intellectual Property Legislation Amendment (Raising the Bar)

Regulation 2013 (No. 1)

Subsection 249(1) of the *Copyright Act 1968* (Copyright Act), subsection 149(1) of the *Designs Act 2003* (Designs Act), subsection 228(1) of the *Patents Act 1990* (Patents Act), and subsection 231(1) of the *Trade Marks Act 1995* (Trade Marks Act) (collectively, 'the Acts') provide that the Governor-General may make regulations prescribing matters required or permitted by the Acts to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to the Acts.

The *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (the 'Raising the Bar Act') amends the Copyright Act, Designs Act, Patents Act and Trade Marks Act to improve Australia's intellectual property (IP) legislation. The Regulation implements the Raising the Bar Act by prescribing requirements under the provisions amended by the Raising the Bar Act and by specifying the administrative and technical details required to give effect to the policy of the Raising the Bar Act.

The first purpose of the Regulation is to amend the *Patents Regulations 1991* (the Patents Regulations) to implement changes to the key tests for patentability. Concerns had been raised that Australia's patentability standards were less stringent than the standards of our major trading partners. Schedule 1 to the Raising the Bar Act amends provisions of the Patents Act to raise the quality of granted patents by strengthening the key requirements for patentability. The amendments bring Australian patent law into closer conformity with international standards. Schedule 1 to the Regulation amends the Patent Regulations to remake or modify the existing regulations consequential to the modifications to the Patents Act made by the Raising the Bar Act. The Regulation also amends the Patent Regulations to improve clarity and readability.

A second purpose of the Regulation is to amend the Patents Regulations and the *Trade Marks Regulations 1995* (the Trade Marks Regulations) to reduce delays in the resolution of patent and trade marks applications. Currently, delays in the resolution of opposition proceedings (administrative proceedings where a person can challenge the grant of a patent or registration of a trade mark) and patent divisional applications (where the subject matter of an earlier application is divided out into a later divisional application which proceeds separately) cause unnecessary expense for other parties, and prolong the period of uncertainty for competitors. Schedule 3 to the Raising the Bar Act amended provisions of the Patents Act and Trade Marks Act

to address issues regarding delays. However, many of the provisions that may lead to delays in resolution of IP matters are procedural issues dealt with by the Patents Regulations and Trade Marks Regulations. Schedule 3 to the Regulation amends both the Patent Regulations and Trade Marks Regulations to streamline the opposition process by reducing time frames and introducing a more rigorous test for granting extensions of time to file evidence. The Regulation would also amend the Patents Regulations, to limit the time period to file divisional applications. The Regulation also amends the *Designs Regulations 2004* (the Designs Regulations) in line with the changes for patents and trade marks.

A third purpose of the Regulation is to amend the Patents Regulations and the Trade Marks Regulations to implement changes to the Patents Act and the Trade Marks Act regarding the regulation of the patent attorney and trade marks attorney professions. Currently there are anomalies between the ways in which patent and trade marks attorneys can conduct their businesses and the ways in which other professions can operate (for example, the legal profession). Schedule 4 to the Raising the Bar Act amended the Patents and Trade Marks Acts to allow attorneys to practice through a corporate structure. Schedule 4 to the Regulation amends the Patents Regulations and the Trade Marks Regulations to prescribe the administrative requirements to register incorporated patent and trade marks attorneys. The Regulation also introduces a suspension scheme for individual attorneys who have been charged with a serious offence. The suspension scheme provides for enhanced consumer protection by permitting the Designated Manager (currently the Director General of IP Australia) to take prompt action in dealing with attorneys charged with serious criminal offences.

A fourth purpose of the Regulation is to amend the *Copyright Regulations 1969* (the Copyright Regulations) and the Trade Marks Regulations regarding the Australian Customs and Border Protection Services' (Customs) procedures for dealing with imports that are suspected of infringing IP rights. Owners of copyright and registered trade marks can lodge a Notice of Objection with Customs. Customs may then seize the suspected infringing goods at the border. The IP right owner then has a period of time within which to bring infringement proceedings against the importer or designated owner, otherwise the goods are released. However, loop holes in the current Notice of Objection scheme enable importers of counterfeit or pirated goods to avoid prosecution and retain the goods, by making it difficult for the IP right owner to locate and contact them.

Schedule 5 to the Raising the Bar Act improves enforcement for copyright and trade marks by making it more difficult for importers of counterfeit goods to evade an IP right holder who is attempting to institute infringement proceedings. The amendments made by the Raising the Bar Act will require the importer to claim for the release of the seized goods and to provide information that would enable the IP rights holder to identify and contact the importer. Schedule 5 to the Regulation amends the Copyright Regulations and the Trade Mark Regulations to prescribe the information to be provided.

The final purpose of the Regulation is to amend the Patents Regulations, the Trade Marks Regulations, and the Designs Regulations to simplify the administrative processes for filing, assessing and accepting an application or granting an IP right.

Schedule 6 to the Raising the Bar Act amended provisions of the Patents Act, Trade Marks Act and Designs Act to address a number of procedural hurdles and inconsistencies that unnecessarily complicate Australia's IP legislation. Schedule 6 to the Regulation amends the principle Regulations made under these Acts as a consequence of modifications made by the Raising the Bar Act. The Regulation amends provisions of the various Regulations to resolve complexities and streamline processes to better adapt the IP system to an increasingly electronic and globalised environment.

Broadly, it is considered that most of the application, savings and transitional provisions are consistent with those in the Raising the Bar Act. The principles underpinning the application provisions are that the changes:

- take effect as soon as possible, to quickly bring about a better balance and operation to the intellectual property system;
- not unduly prejudice the users of the system, particularly with respect to not affecting rights granted prior to implementation of the changes, or making incorrect a decision of the Commissioner made prior to the changes; and
- give applicants control and certainty over whether the old or new rules apply to their application.

Where regulations are to be made under a provision in the Raising the Bar Act, the application provisions usually mirror the application provisions for the relevant item in the Act. Where the application provision differs (for example, where the regulation is not dependent on a provision of the Raising the Bar Act) the policy is explained in more detail.

The details of the Regulation are set out in the Attachment.

The Acts do not specify any conditions that need to be met before the power to make the Regulation may be exercised.

Public consultation on a draft of the Regulation occurred in late 2012, with IP Australia receiving 17 submissions from business, IP professionals and members of the public. Consultative meetings were also held with IP professionals drawn from the registered patent attorney profession, the registered trade marks attorney profession, the legal profession, academia and industry. Several peak bodies were represented in these consultative meetings: the Institute of Patent and Trade Marks Attorneys of Australia, the International Federation of Intellectual Property Attorneys of Australia and the Law Council of Australia.

The Regulation is a legislative instrument for the purposes of the *Legislative Instruments Act 2003*.

The Regulation commences on 15 April 2013.

The Attorney-General is the Minister responsible for copyright legislation. The Attorney-General has been consulted on, and agrees with, the text of the changes to the Copyright Regulations.

The Office of Best Practice Regulation in the Department of Finance and Deregulation has advised that no Regulation Impact Statement is required to be prepared for these amendments.

Details of the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

Schedule 1 amends the *Patent Regulations 1991* (the Patent Regulations) to raise the quality of granted patents by strengthening the key requirements for patentability.

Schedule 3 amends the Patents Regulations and the *Trade Marks Regulations 1995* (the Trade Marks Regulations) to address issues regarding delays in resolving patent and trade marks oppositions and patent divisional applications.

Schedule 4 amends the Patents Regulations and the Trade Marks Regulations to allow Patents and Trade Marks attorneys to provide a scheme for the registration and regulation of incorporated attorneys.

Schedule 5 amends the *Copyright Regulations 1969* (the Copyright Regulations) and the Trade Marks Regulations to provide improvements to the mechanisms for seizing suspected counterfeit and pirated goods at the border.

Schedule 6 amends the *Designs Regulations 2004* (the Designs Regulations), the Trade Marks Regulations and the Patents Regulations to address a number of procedural hurdles and inconsistencies that unnecessarily complicate the present IP legislation.

Note that there is no Schedule 2 to the Regulation, as Schedule 2 to the Raising the Bar Act requires no regulations.

Schedule 1 – Amendments relating to Schedule 1 of the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012*

Patents Regulations 1991

Item 1 – Heading

The Regulation amends Chapter 3 of the Patent Regulations to introduce Divisions. Item 1 introduces a heading consistent with this structure.

Item 2 – subregulation 3.3(7)

This item repeals subregulation 3.3(7) consequential to the amendment in item 9, which prescribes documents considered for determining whether amendment of a complete specification is allowed under subsection 102(1)(b) of the Patents Act. Subregulation 3.3(7) becomes redundant as a result of the amended provisions.

Item 3 – regulations 3.12, 3.13, 3.13A, 3.13B, 3.13C, 3.13D, and 3.13E

This item amends regulation 3.12 to re-structure and clarify the provisions which set out the prescribed circumstances and the corresponding prescribed documents which are used to determine the priority date of a claim.

The priority date of a claim is crucial for determining the validity of a patent, as in general only prior art information published before the priority date can deprive an invention of novelty or inventive step. Currently, the test for determining the priority date is whether the claim is ‘fairly based’ on what is disclosed in the document identified by the applicant as their priority document. This test is imposed in the Patents Regulations. Item 10 of Schedule 1 to the Raising the Bar Act introduces a new test for priority in the Patents Act - whether the priority document ‘discloses the invention in the claim in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art’.

A single patent application may have several claims, with different claims having different priority dates. Currently, the Patents Regulations are structured so that an applicant seeking to determine their priority date may have to follow multiple cross references across several different subregulations to determine the circumstances that apply to a particular type of application. The structure of the existing regulations can be difficult for applicants to navigate and may lead to confusion in determining the priority date of an application.

Item 3 accounts for the changes to priority made by the Raising the Bar Act and addresses the current structure of the regulations by repealing existing regulations 3.12 and 3.13 and introducing new provisions which would deal with applications based on what type of application it is – namely a Patent Cooperation Treaty (PCT) application, a Convention application, a complete application associated with a provisional application, a divisional application prior to the grant of patent, or a divisional application after grant of an innovation patent. The Regulation set out each type of application with the relevant prescribed circumstances and prescribed

documents, enabling a reader to clearly determine what the resulting priority dates would be for each type of application.

The amendments clarify that a prescribed document may be a single document, or more than one prescribed document considered together. This accounts for circumstance where, for example, an abstract and a specification, both filed with the earlier priority application, taken together disclose the invention claimed in the complete specification in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art. For example, see subregulation 3.12(4) and subparagraph 3.13A(1)(b).

The Regulation provide that if a specification filed in another country for a basic application was a provisional specification, and a complete specification is subsequently filed for the basic application, that complete specification is to be treated as a further basic application made on the day that complete specification was filed. This would account for the practice permitted in some foreign jurisdictions where a patent application can be filed with a provisional specification and then ‘completed’ later by the filing of a complete specification for that application. The intention is that both the original application and the later complete specification be treated as basic applications for the purpose of determining priority.

The amendments also clarify the requirement where a claimed invention relates to a micro-organism and the Budapest Treaty deposit requirements must be satisfied to meet the disclosure requirements of paragraph 40 (2) (a) of the *Patents Act 1990*. The priority requirements include that:

- the invention relates to a micro-organism (for example, see subparagraph 3.13A(4)(b)(i));
- the specification of the priority application included such relevant information about the micro-organism as was known to the applicant at the filing date of the application (subparagraph 3.13A(4)(b)(ii));
- the priority document discloses the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art, with the micro-organism in hand (subparagraphs 3.13A(4)(b)(iii));
- the requirements of paragraph 6 (c) of the Patents Act are met in relation to the complete specification (subparagraph 3.13A(4)(b)(iv)); and
- the micro-organism was deposited with the depository authority on or before the filing date of the priority application (subparagraph 3.13A(4)(b)(v)).

Item 4 – regulations 3.14A and 3.14B

This item amends the Patent Regulations to give effect to item 11 of Schedule 1 to the Raising the Bar Act, which introduces a preliminary search and opinion (PSO) for complete applications in section 43A.

Currently, patent applications filed through the Patent Cooperation Treaty (PCT) are subject to an early search and examination opinion soon after filing of the complete

application. The resulting reports provide the applicant and (when published) competitors with an early indication of the likely success of the application.

For non-PCT complete applications and provisional applications there is no similar provision for an early search and examination opinion, with the result that there is often a long period during which the applicant has no information about the likely success of the application.

Item 11 of Schedule 1 to the Raising the Bar Act addresses this issue by introducing a PSO for complete applications. A PSO provides an early search and opinion to the applicant, to give them an early indication of the likely outcome of their application.

Under the regulations in item 4, the PSO would only be done at the request of the applicant, who may request a PSO prior to requesting examination. If a PSO is requested, it would be conducted by the Commissioner after filing, with the results published when the application becomes open for public inspection.

A PSO cannot be requested on a provisional application. However, a similar early search option is provided for. Article 15(5) of the PCT provides for an applicant to request an international-type search on their application. Currently under subregulation 19.1(2), an Article 15(5) search can be requested on a provisional application or a non-PCT complete application. In practice Article 15(5) searches are most commonly requested on provisional applications.

Regulation 3.14A restricts the use of searches under article 15(5) to provisional patent applications only (also see item 15 and the consequential repeal of subregulation 19.2(2)). Under the new scheme, searches on complete applications will be conducted under section 43A rather than Article 15(5).

Subregulation 3.14A(3) provides the Commissioner with the discretion to choose which competent International Searching Authority conducts a search under article 15(5) of the PCT, including limiting those searches to IP Australia as is currently the case.

Regulation 3.14B provides that a person may request a PSO if they have not already requested examination, and that the request must be in a form approved by the Commissioner.

Item 5 – paragraph 3.18(2)(d)

This item repeals paragraph 3.18(2)(d) of the Patents Regulations as this prescribed matter is now included in paragraph 45(1)(c) of the Patents Act.

Currently, section 45 of the Patents Act lists a number of matters that the Commissioner must report on during the examination of a patent application. Paragraph 45(1)(d) of the Patents Act refers to ‘other matters’ which are prescribed in regulation 3.18 of the Patents Regulations.

Item 12 of Schedule 1 to the Raising the Bar Act, expands the patentability requirements of subsection 45(1) of the Patents Act to include in paragraph 45(1)(c) whether a claimed invention is patentable under subsection 18(2) of the Patents Act. Omitting paragraph 3.18(2)(d) is consequential upon insertion of the prescribed matter in the Act.

Items 6 to 8 – subregulations 9.2(1), 9.2(2), 9.2A and 9.2(4)

These items amend the Patents Regulations to alter the requirements for requesting re-examination of a patent application. Re-examination provides a useful means for the Commissioner to review a previous acceptance or grant, usually on the basis of documents presenting new information that casts doubt on the patentability of the application or patent. Currently, after examination of a patent application has been completed and prior to grant of a patent, the Commissioner may re-examine an application. The Commissioner may also re-examine the specification of a granted patent. If a request is made for the Commissioner to re-examine the patent, the Commissioner must do so.

Item 17 of Schedule 1 to the Raising the Bar Act expands the grounds reported on during re-examination from the current grounds of novelty and inventive step. These new grounds will not always be based on prior art documents. For instance, a re-examination on the basis that the invention is not a ‘manner of manufacture’¹ might be based solely on the nature of the invention as disclosed in the specification and the person seeking re-examination may not have any new documents to bring to the Commissioner’s attention.

Item 6 of the Regulation introduces a general obligation for the person requesting re-examination to state the grounds on which they are making the request and also provide reasons for why those grounds apply. This amendment ensures that where a request is made without further documentary evidence, the request is still supported by sufficient information to be fully considered by the Commissioner.

Item 7 is consequential to expanding the grounds for re-examination beyond those in the currently existing subregulation 9.2. It amends subregulations 9.2(2) and 2(A) for better readability and clarifies the applicability of subregulation 9.2(2).

Currently subregulation 9.2(4) of the Patent Regulations provides that the Commissioner must not re-examine a specification unless the request for re-examination complies with the Patent Regulations. There are instances where a person may make a request that does not strictly comply with the regulations, yet nonetheless gives the Commissioner sufficient information to doubt the validity of the application or patent. At present, the Commissioner would not be able to re-examine the specification.

Item 8 amends subregulation 9.2(4) to provide the Commissioner with the discretion to decide whether or not to carry out re-examination where the request for re-

¹ Patents Act, section 18(1)(a).

examination does not comply with the regulations. The Commissioner is not obliged to re-examine a patent application where there is insufficient information provided with the request of re-examination.

Item 9 – regulations 10.2A, 10.2B and 10.2C

This item amends the Patent Regulations to prescribe documents which the Commissioner may consider when determining whether to allow amendment of a patent specification. It also re-makes and re-structures the regulations which prescribe circumstances in which amendment of a patent request or complete specification is not allowable.

Currently, an applicant may amend their specification at any time. This allows an applicant to remedy an inadequate initial disclosure with a later amendment to include additional material that the applicant may not have had at the time they filed their application. This can allow an applicant to gain a priority date from before they fully developed their invention.

From a policy perspective, an applicant should not be able to get a priority date that is earlier than the date at which they had sufficient information to put the invention into practice. Item 29 of Schedule 1 to the Raising the Bar Act introduced a new test in subsection 102(1) of the Patents Act where a specification may not be amended if the amendment contains matter that would extend beyond that disclosed in the complete specification, as it was filed, and any other prescribed documents. Ordinarily, the relevant document against which the amendment would be assessed is the specification as it was filed.

Regulation 10.2A prescribes documents for the purpose of new subsection 102(1)(b) of the Patents Act. This enables the Commissioner to consider these documents when deciding whether an amendment to a specification should be allowed. The prescribed documents provide for instances where vital information was mistakenly omitted from the specification when it was filed. The regulation covers instances where:

- the applicant mistakenly discloses relevant material in the abstract, instead of the specification. Subregulation 3.3(7) currently provides for the abstract to be taken into account when determining the allowability of the amendment. To make this clearer, item 1 repeals subregulation 3.3(7) and an abstract is prescribed directly under new section 102(1)(b);
- a specification is filed, but part of that specification is missing. Under regulation 3.5A of the Patent Regulations and equivalent provisions of the PCT, the ‘missing part or element’ may in certain circumstances be provided by the applicant and incorporated into the specification;
- an amendment has been made to rectify a clerical error or obvious mistake or to incorporate Budapest Treaty deposit information necessary to comply with section (6)(c) of the Patents Act.

In these circumstances it is expected that the applicant would be disadvantaged if the prescribed documents are not able to be considered by the Commissioner when determining whether to allow amendment of the patent specification.

The second aspect of this item is the re-making and re-structuring of provisions which prescribe the circumstances in which amendments to a patent specification are non-allowable. Currently regulation 10.3 of the Patents Regulations provides that certain types of amendment are not allowable. A non-allowable amendment may be refused by the Commissioner under regulation 10.4(a). However the existence of these non-allowable amendments is not explicitly flagged in the Patents Act. To address this, item 31 of Schedule 1 to the Raising the Bar Act introduced subsection 102(2D) to enable regulations to be made prescribing those amendments to either the patent request or complete specification that are non-allowable.

Regulation 10.2B and 10.2(C) prescribe matters for the purpose of new section 102(2D) of the Patents Act. Subregulations 10.2B (2), (3), (4) and (8) are currently prescribed in subregulations 10.3(3), (5), (6) and (9). Similarly, subregulations 10.2C (2) to (5) are currently prescribed in subregulations 10.3 (2), (4), (7) and (8). Re-making of the provisions in regulations 10.2B and 10.2(C) does not effect their operation. The amendments only re-structure and clarify under which provisions of the primary legislation the regulations are made. Related item 9 provides for the consequential repeal of subregulations 10.3(2) to (9).

Subregulations 10.2B (5) and (6) provide that an amendment of a patent request is not allowable if the amendment would convert a patent application into a divisional application in certain circumstances. The Patent Act allows applicants to file 'divisional' patent applications for additional inventions disclosed in their earlier patent application. However, many applicants currently use the divisional system to tactically delay the prosecution of their application. Item 3 of Schedule 3 to the Raising the Bar Act addresses these issues by amending section 79B of the Patents Act to permit the regulations to prescribe an earlier deadline for filing a divisional application, and prescribe particulars to be included in a divisional application. Item 5 of Schedule 3 to the Raising the Bar Act amends section 79C of the Patents Act to permit the regulations to prescribe particulars to be included in a divisional innovation patent application. Amendments in Schedule 3 to this Regulation provide that the deadline for filing a divisional application is 3 months after advertisement of acceptance of the earlier application and that the patent request filed with a divisional application must indicate that the application is a divisional application. Consistent with these changes, subregulations 10.2B (5) and (6) provide that a proposed amendment of a patent request is not allowable if the application to which the patent request relates has been accepted; or the period ending 3 months from advertising the acceptance of the application first mentioned in section 79B has expired.

Subregulation 10.2C (6) provides that an amendment of a complete specification is not allowable if making the amendment would be contrary to section 112 or 112A of the Act. A problem arises when amendments are proposed, or are being prosecuted, when court proceedings commence. Section 112 of the Patents Act provides that amendments to the complete specification may not be made except under section 105 ('Amendments directed by court') while relevant court proceedings are pending. Similarly, item 10 of Schedule 3 to the Raising the Bar Act introduces new section 112A of the Patents Act to limit amendments to complete specifications to those made under section 105 of the Patents Act during an appeal to the court against a

decision of the Commissioner. The purpose of this is to ensure that all contested issues relevant to the proceedings are resolved in the same forum – i.e. the court.

In these circumstances it has been argued that the amendment is not specifically non-allowable and the Commissioner has no power under regulation 10.4(a) of the Patents Regulations to refuse them. To avoid any doubt, subregulation 10.2C (6) makes explicit that any amendment contrary to section 112 or new section 112A of the Patents Act is a non-allowable amendment and can be refused.

Item 10 – regulation 10.3

Item 10 amends the heading to subregulation 10.3, consistent with the structure in item 9 and also amends subregulation 10.3(1) to prescribe what amendments are allowable for provisional specifications. Amendments will be allowed in similar situations to those provided for in new regulation 10.2A in item 9, with some exceptions to account for the difference between complete and provisional applications.

In addition, item 10 repeals subregulations 10.3(2) to (9) as a consequence of the changes to the regulations in item 9, which re-make subregulations 10.3(2) to (9) in new regulations 10.2B and 10.2C. Item 10 substitutes new subregulation 10.3(2) to ensure that the amendment of an abstract is not allowable. This is to prevent inappropriate amendments to be added to the abstract, which under item 9 is a document prescribed for subsection 102(1) of the Patents Act.

Item 11 – regulation 10.4

Item 11 amends subregulation 10.4(a) as a consequence of the amendments made at items 9 and 10.

Item 12 and 13 – regulation 10.5(1)b and 10.5(1)(c)

Items 14 and 21 of Schedule 1 to the Raising the Bar Act amended subsections 49(1) and 101E(1) to impose a higher standard of proof when the Commissioner is deciding whether to accept a standard patent application or certify an innovation patent. This new standard of proof is based on whether the ‘Commissioner is satisfied, on the balance of probabilities’.

Sometime applicants may propose amendments to a patent application or patent to overcome grounds of objection. Present subregulations 10.5(1)(b) and 10.5(1)(c) require the Commissioner to allow certain amendments if they would overcome those grounds of objection. However, the regulations currently require the Commissioner to allow the amendment if she ‘believes on reasonable grounds’ that the amendment would remove all lawful grounds of objection or revocation. Having different standards of proof would result in inconsistent decisions on what is essentially the same substantive question (i.e. whether an application or patent should be accepted or certified).

The amendments to subregulation 10.5(1)(b) and 10.5(1)(c) require the Commissioner to be ‘satisfied, on the balance of probabilities’. This ensures consistency in the standard of proof required before the Commissioner would make a decision and is consistent with items 14 and 21 of Schedule 1 to the Raising the Bar Act.

Item 14 – subregulation 19.2(2)

This item is consequential to the amendments made in item 4, which restricts the use of searches under article 15(5) of the PCT.

Items 15 and 16 – paragraphs 22.2(2)(e) and 22.2B(1)(a)

These items amend the Patent Regulations to stipulate when fees are payable for a search conducted as part of the examination of the application.

Australia has a system of deferred examination, where patent applications are not substantively examined under section 45 of the Patents Act until some time after they are filed and published. This delay gives applicants time to develop their invention and assess its commercial prospects before deciding whether to proceed with full examination. In many cases, other searches will already be available for the examiner to consider at examination. For example:

- PCT applications are subject to an international search
- other IP Offices may have published quality searches for the same invention if it was the subject of an application filed in another jurisdiction
- if the application is divided out from an earlier application (divisional applications), the Commissioner may have searched the same invention in respect of the parent application.

If a search is available and the examiner is confident of the quality of the search, it often makes sense for the examiner to use the earlier search (in conjunction with a short top-up search, if necessary), rather than conducting a complete search from scratch. This avoids needless rework. In this situation applicants would not be charged any additional fees on top of the ordinary examination fee. This situation applies to the majority of patent applications in Australia.

However, in a minority of cases, sometimes no quality search is available and the examiner must conduct a complete search for the invention. This imposes additional costs which need to be recouped under the cost-recovery principles that apply to IP Australia.

Item 20 of Schedule 1 introduces a new fee for when an additional search is to be conducted as part of examination. The amendment in these items provides for when that fee would be payable and the consequences if that fee is not paid in the correct time.

The intention is to apply the search fee to complete applications where there is no search available at examination. For example, it would apply to: non-Convention, non-PCT, non-Divisional applications; or Convention applications where no useful search is available from another office at examination; or divisional applications where a new invention is claimed. IP Australia will notify the applicant when the fee is payable.

These amendments to the fee requirements are located with, and consistent with, the provisions for other fees which are currently payable to the Patents Office.

Item 17 – Paragraph 22.2C (1)(a)

Item 17 omits a reference to old fee item 106 which relates to modified examination. The ability to request modified examination of a patent application was repealed by item 50 of Schedule 6 to the Raising the Bar Act.

Item 18 – Schedule 7, item 206

This item introduces a new fee item in Schedule 7 of the Patent Regulations for a search by the Commission in relation to a patent request and complete specification for a standard patent.

As discussed above at items 15 and 16, sometimes a quality search is not available on an application and the Commissioner must conduct a full search, which is a costly process. This item introduces a new fee to cover some of the cost of conducting such searches.

Item 19 – Schedule 7, item 236

This item amends item 236 consequential to the amendments in items 4 and 15. The prescribed period of subregulation 19.2 (2) is effectively transferred to regulation 3.14A.

Item 20 – Schedule 7, item 236A

This item introduces a fee for a preliminary search and opinion under new subsection 43A (1) of the Patents Act, discussed in item 4 above. The fee is equivalent to the fee for a search and opinion conducted under the PCT.

Schedule 3 – Amendments relating to Schedule 3 to the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012*

Part 1 - Patents Regulations 1991

Item 1 – subregulations 1.3(4) and (5)

This item amends the Patents Regulations to clarify the date that a document is taken to be given to a person, making it in all cases the day on which the document is dated.

Currently when the Commissioner provides a document to a person, the document is taken to have been given to the person on the date of the document unless the contrary intention appears. However, the wording ‘unless the contrary intention *appears*’ is indefinite.

The policy intention is that the date the document is taken to have been given to the person is the date it is dated by the Commissioner. To provide certainty the subregulation removes the words “unless the contrary intention appears”. The day the document was taken to be given to the person is simply the day the document is dated by the Commissioner.

Where there is an error in the date, there are existing mechanisms to deal with this, such as the extension of time provisions in section 223(1) of the Patents Act.

The amendments would also clarify the relationship between subregulations 1.3(4) and (5) by making it clear that subregulation 1.3(5) is only intended to permit the Commissioner to use electronic means to give a document to a party: it is not intended to provide for the day on which the document is taken to be given to the party.

Finally, the amendments remove obsolete references to the “Patent Office”. Under the patents legislation the relevant actions (dating and giving documents) are performed by the Commissioner (or a delegate of the Commissioner), not the Patents Office. The references to the “Patents Office” are redundant and are removed.

Item 2 – Chapter 5

This item amends the Patents Regulations to replace the current regulations regarding opposition proceedings and the obligations for parties to those proceedings. The item restructures the current regulations to improve readability and makes a number of administrative changes, as discussed below.

Currently, a patent opposition is commenced when a person (the opponent) who wishes to oppose the grant of a patent files a Notice of Opposition with the Patents Office and then serves a copy of that notice on the patent applicant. During opposition proceedings both parties are required to file all documents and evidence in support of their claims with IP Australia and to serve copies of them on the other

party. This can lead to disputes between parties as to whether documents, or evidence, have been served on the relevant party within the statutory time periods.

The Regulation remove the requirement for parties to serve documents and evidence on the other party. Instead, the burden for notifying the other party that documents and evidence have been filed placed on the Patents Office. The Patents Office is required to give the relevant documents to the alternate party and notify them of the commencement of any future statutory time periods for filing documents and evidence to support their claims. This will reduce disputes as to whether statutory time periods are met, as compliance with the commencement and ending of the time period will be overseen by the Patents Office, rather than the individual parties.

New Chapter 5 Part 5.1 sets out preliminary information for the chapter, including definitions necessary for the operation of provisions and the power for the Commissioner to direct the form and means by which documents and evidence are filed and the number of copies which must be provided.

Commencing opposition proceedings

There are two broad categories of oppositions that occur under the Patents Act. Substantive oppositions generally focus on patentability issues and include opposition to the grant of a patent or grant of an extension of term of a patent relating to a pharmaceutical substance. Procedural oppositions consider other issues, such as allowance of amendments and extensions of time.

Currently, the time period for filing a notice of opposition is the same for most opposition proceedings. However, procedural oppositions are generally less complex than substantive oppositions and require less time to prepare and file documents for proceedings. As a result, the time period for commencing procedural oppositions is longer than it needs to be. This delays resolution of procedural oppositions, prolonging uncertainty for patent applicants and the general public.

New regulation 5.4 maintains the 3 month time period for filing a Notice of Opposition for substantive oppositions, under sections 59 and 75 of the Patents Act. New regulation 5.6 maintains the current requirements for opposing an innovation patent under section 101M of the Patents Act. However, for procedural oppositions (commenced under subsections 104(4) and 223(6) of the Patents Act and subregulation 22.21(4) of the Patents Regulations), new regulation 5.10 prescribes the time period in which a person has to file a Notice of Opposition as 2 months. This will enable less complex procedural oppositions to be resolved faster.

Item 79 of schedule 6 to the Raising the Bar, provides a party wishing to contest a rectification of the Register with a right to be heard, without the action being formal opposition proceedings. Consequentially, current subregulation 5.3(5A) is repealed and the regulations no longer make provision for the commencement of opposition proceedings for a correction of the Register.

Statement of grounds and particulars and associated documents

The purpose of a statement of grounds and particulars is to outline the opponent's argument as to why the patent application (or amendment or extension of term) should be rejected and to give the applicant an idea of the case that they will have to meet. Currently, the time period for filing the statement of grounds and particulars for most opposition proceedings is 3 months from the filing of the notice of opposition. For oppositions commenced under section 101M of the Patents Act, the statement of grounds and particulars must be filed at the same time as the notice of opposition.

For substantive oppositions, an opponent may have to undertake significant research prior to finalisation of the statement of grounds and particulars, including analysing patent claims and conducting prior art searches. However, this is generally not the case with procedural oppositions which are significantly simpler, and have a substantially more limited scope. Allowing 3 months to file the statement of grounds and particulars in procedural oppositions serves to unreasonably delay the opposition process.

In the statement of grounds and particulars, the opponent will often refer to documents which demonstrate why a patent application does not meet patentability requirements. For example, an opponent may claim that the invention is not novel or inventive because a particular publication discloses the same or a similar invention. Generally, these associated documents will be filed along with the rest of the opponent's evidence in support - 3 months after the statement of grounds and particulars was filed.

In the case of substantive oppositions, the opponent's evidence in support must generally be served on the patent applicant within 3 months after the statement of grounds and particulars has been served. Thus evidence in support is not due until 6 months after the notice of opposition and 9 months after the initial advertisement of the patent application for acceptance. As a result, many months pass before an applicant has a clear idea of the case that will be made out against their patent application.

New regulations 5.5 and 5.11 address this issue by proposing different time periods for filing the statement of grounds and particulars depending on whether the matter is a procedural or substantive opposition. The new Regulation also require that documents referred to in the statement of grounds and particulars be provided at the same time as the statement of grounds and particulars – unless the document is associated with any complete or provisional application filed with the Patent Office and open to public inspection (in which case it will be freely accessible from IP Australia, usually via the internet).

For substantive oppositions, which require significant research to be undertaken, the prescribed period continue, under new subregulation 5.5(1), to be 3 months. Under new regulation 5.6, the current requirements for section 101M oppositions are also maintained. For procedural oppositions, new regulation 5.11 reduces the prescribed period to one month after the filing of the Notice of Opposition. These changes

balance the interests of the opponent in preparing opposition documents with the interests of the patent applicant and the general public in resolving oppositions faster.

To ensure compliance, new subregulation 5.18(2) provides a sanction for not providing a document mentioned in the statement of grounds and particulars by giving the Commissioner the discretion to dismiss the opposition if a document is not provided. Providing the applicant with these documents at the same time as the statement of grounds and particulars may resolve oppositions sooner, as the applicant will have a better idea of whether the case against them was strong or weak and whether they wish to continue to pursue their application.

Filing evidence - substantive oppositions

New regulations 5.7 and 5.8 set out requirements for parties filing evidence in substantive oppositions. Regulation 5.7 requires that evidence be filed within the evidentiary periods prescribed in new regulation 5.8 and that where a party finishes filing evidence before the end of the period, that party notify the Commissioner that no further evidence is to be filed. Subregulation 5.7(2) requires the Commissioner to give any evidence to the parties involved in the opposition as soon as practicable, after the relevant period ends, and allows the Commissioner to give evidence to a party prior to the end of the relevant evidentiary period. New subregulation 5.7(3) clarifies that the Commissioner is required to notify the parties, when the evidentiary periods are completed, that all the evidence has been filed, or that no evidence has been filed.

New regulation 5.8 sets out evidentiary periods for substantive oppositions and maintains the time periods prescribed under current subregulations 5.8(1A) to (3). However, as parties are no longer required to serve their evidence on the other party, where filing in successive evidentiary periods is to be completed by different parties, subregulation 5.8(2) and (4) clarify that the evidentiary period commences when the Commissioner has both given all evidence filed in the previous period to, and notified the relevant party that the previous period has been completed.

Currently, an opponent is required, within one month of the applicant's evidence in answer, either to serve its evidence in reply or to serve a notice of intention to serve evidence in reply. Current subregulation 5.8(4)(b) provides that if the opponent files a notice of intention to serve evidence in reply, they have 3 months from the date of the applicant's evidence in answer in which to serve and file the evidence in reply. These requirements for evidence in reply are unnecessarily complicated and protracted; considering that evidence in reply is generally narrow in scope, being limited to responding to the applicant's evidence in answer.

New subregulation 5.8(4) streamlines the substantive opposition process by removing the requirement to file a notice of intention to serve evidence in reply, and by reducing the prescribed period for filing of evidence in reply to 2 months in total.

Extending time for filing evidence – substantive oppositions

A major cause of protracted opposition proceedings is extensions to the various time periods for providing evidence. The law has developed in such a way as to

significantly narrow the Commissioner's discretion to disallow extensions. As a result, oppositions are normally subject to multiple extensions of time and extend over many years, contrary to the interest of the public and parties in resolving oppositions faster.

New subregulation 5.9(2) addresses this issue by introducing a new test for determining whether an extension of time for filing evidence is justified. The Commissioner will not be able to extend time periods unless at least one of these conditions was made out. The party seeking the extension will bear the onus of convincing the Commissioner of this. Once the conditions in subregulation 5.9(2) are met, the Commissioner still has the discretion to consider whether or not it is appropriate that an extension of time be granted. In applying the test, the Commissioner will not be required to give a direction to extend a period solely because of delays caused by an agent or a legal representative failing to act promptly or diligently, by difficulties in obtaining expert evidence that could have been anticipated and acted on or by attempts to settle the proceedings.

Where a party cannot satisfy the Commissioner that an extension is justified under the test, the Commissioner will not have the power to give a short extension to allow the filing of evidence immediately available or to validate evidence filed out of time.

New subregulation 5.9(5) provides an inclusive list of circumstances that may be considered by the Commissioner as exceptional circumstances for the purpose of subregulation 5.9(2)(b).

A change in circumstance may not in itself be exceptional. For example, if a preferred expert becomes suddenly unavailable but other experts could be called on to complete the evidence in time, then the sudden loss of the preferred expert is not an exceptional circumstance.

The Regulation will provide the Commissioner with sufficient flexibility to reset evidentiary timeframes or stay proceedings where opposition proceedings are to be: joined; stayed, pending the consideration of amendments; or are subject to court proceedings.

Procedures for procedural opposition proceedings

Currently, the prescribed periods in which parties are to file evidence in an opposition proceeding are set out in the Patent Regulations. The regulations only delineate between oppositions commenced under 101M of the Patents Act and all other substantive and procedural oppositions. In the case of procedural oppositions, evidence is not always required or relied on and having multiple, lengthy fixed statutory periods for filing evidence draws the opposition process out unnecessarily.

Under new regulation 5.12, the Commissioner will have the ability to direct, on a case-by-case basis, the appropriate practice and procedures for procedural oppositions – this will include directing evidential timeframes. The regulation will ensure that when a procedural opposition is complex and the parties will benefit from following the standard evidential periods then the Commissioner could make directions that these periods are to apply. However, where the procedural opposition

is simple and the process can be contracted, then the Commissioner will be able to make the appropriate directions for the matter.

The evidentiary periods for substantive oppositions are set out in new regulation 5.8 and have been discussed previously.

Amendments to opposition documents

Currently the Patents Regulations provide for the amendment of opposition documents in certain situations, including correcting an error or mistake in the Notice of Opposition or statement of grounds and particulars, or to amend the grounds in the statement of grounds and particulars. As part of the restructuring and amendments made to the provisions of Chapter 5, current regulations 5.3A, 5.3B and 5.9 have been re-made as new regulations 5.14, 5.15 and 5.16 respectively. Changes made to the language of the new regulations are consistent with definitions and language usage throughout the rest of the Chapter.

Current regulations 5.7 and 5.9A have been repealed in their entirety as these provisions are now redundant.

Due to the restructuring of Chapter 5 by item 2, current regulation 5.5, which enables an applicant to request the Commissioner to dismiss an opposition, has been re-made as new regulation 5.17. As discussed previously, new regulation 5.18 provides the Commissioner with the discretion to dismiss an opposition where appropriate, including on the grounds that an opposition statement of grounds and particulars or associated document has not been filed.

Hearing of opposition

Current regulation 5.6 allows for the Commissioner to determine an opposition if the complete specification that is the subject of the opposition has been re-examined under subsection 97(1) of the Patents Act. New regulation 5.19 re-makes this provision and clarifies that the Commissioner may hear and decide the opposition at the request of the opponent, if the request is made within the prescribed time, or on her own initiative.

Similarly, current regulation 5.12 provides for the Commissioner to hold a hearing to determine an opposition where the time for providing evidence has passed and the opposition has not been dismissed, determined or withdrawn. New regulation 5.20 re-makes existing regulation 5.12 and clarifies that the Commissioner has the discretion as to whether the hearing is conducted orally or by written submissions provided by the parties.

Summaries of submissions are an important feature of the oral hearing process. They permit the matters of contention between parties to be narrowed and focussed, and can help the hearing officer prepare appropriately. Currently, the Commissioner requests that submissions be provided prior to an oral hearing. However, sometimes submissions are either not provided or are provided too close to the hearing date to be of much assistance.

New subregulation 5.20(4) addresses this issue by setting out a statutory timeframe for the provision of summaries of submissions by parties to the opposition. The opponent will be required to file a summary at least 10 business days before the hearing date. The applicant will be required to file their summary at least 5 business days before the hearing date. Consistent with other provisions regarding the filing of documents, the Commissioner will give the summaries to the alternate party as soon as practicable. This should result in a swifter and more efficient pre-hearing process to the benefit of all participants. Also under new subregulation 5.20(6), the Commissioner is able to sanction parties who fail to comply with the timeframes for filing their summaries. This sanction will be by way of consideration of any costs awarded between the parties.

Miscellaneous regulations

New part 5.6 clarifies and re-makes a number of the current regulations – including new regulations 5.22, 5.24 and 5.26.

New regulation 5.21 clarifies that an opposition to an amendment, made under subsection 104(4) of the Patents Act, may only be made on the basis that the amendment was not allowable under section 102 of the Act or regulation 10.3 of the Patents Regulations. The requirements for the filing of a Notice of Opposition in such situations is prescribed in regulation 5.10 and is discussed previously along with requirements for commencing other types of opposition proceedings.

Currently, parties are able to seek leave from the Commissioner to serve further evidence after the completion of the statutory evidential stages. The ability to serve further evidence is a means for a party to improve its case outside of the statutory evidential periods. However, filing further evidence can significantly delay opposition proceedings. This is a problem when additional evidence is introduced late in proceedings, especially where the evidence is of questionable value and not crucial to the outcome of the opposition.

There is currently an alternative means for the Commissioner to consider information in the possession of the Patent Office. Current regulation 5.11 provides a general power for the Commissioner to inform herself of a fact by reference to any document available in the Patent Office. This power is discretionary - the patents legislation does not provide parties with a right to urge the Commissioner to make use of this power. As a result, the power in current regulation 5.11 cannot be used as a mechanism to delay opposition proceedings.

The Regulation addresses the issue of unreasonable delay in oppositions by repealing the further evidence provisions from the Patent Regulations. Following the restructuring of Chapter 5 by item 2, parties will be able to provide any document to the Patent Office at any stage under new regulation 5.23. The Commissioner will be able to consider the document and then have the discretion to determine the most appropriate course of action in light of the information contained within the document. However, it is not intended that regulation 5.23 is to be used as a substitute for the repealed further evidence provisions.

New regulation 5.25 re-makes current subregulation 5.10(3). Subregulation 5.25(3) provides a clear definition for the amendment period, which is also the period of time for which an extension for filing a document will be given.

Item 3 – Chapter 6A

This item amends the Patent Regulations to prescribe particulars which must be included in a divisional patent application. Amendments made by item 3 also ensure that the prescribed period for filing a divisional application is consistent with the prescribed period for commencing opposition proceedings.

Current Australian law allows an applicant to file ‘divisional’ patent applications for additional inventions disclosed in their earlier patent application. A patent application must relate to one invention only, and divisional provisions permit applicants to ‘divide’ out multiple inventions into separate applications without losing their priority rights. It is not unusual for an applicant to file multiple generations of divisionals, giving rise to what is referred to as a ‘family’ of divisional applications, all of which have the same priority date as the original parent application.

There are currently two main problems with divisional applications. First, divisional applications of standard patent applications can be filed at any time prior to grant of the earlier application, including during opposition proceedings, and are often filed many years after the filing of the earlier application. This leads to significant delay in determining the scope of patent rights around an invention, and imposes additional costs on the opponent and the public by extending the time that they must keep track of an invention, or suite of inventions. Secondly, while divisional applications are derived from an earlier application, there is no explicit requirement in the current regulations for a divisional application to identify the applicable earlier application. This applies to both divisional applications of innovation patents and of standard patents.

Items 3 and 5 of Schedule 3 to the Raising the Bar address these issues by amending the Patents Act to allow for the Patents Regulations to prescribe:

- particulars to be included in divisional applications, for both standard patent and innovation patent applications;
- earlier deadlines for filing divisional applications;

Item 31 of Schedule 1 to the Raising the Bar amends section 102 of the Patents Act to clarify that the Patents Regulations can prescribe what are non-allowable amendments to patent applications.

New regulation 6A.1 prescribes requirements for the filing of divisional applications of standard patent applications and innovation patents. Subregulation 6A.1(1) prescribes the period in which divisional applications can be made for the purposes of new subparagraph 79B(3)(iv) of the Patents Act. This brings the deadline for filing divisional applications into line with the deadline for filing opposition proceedings.

Subregulation 6A.1(2) prescribes the particulars that are required to be provided with the divisional application, including information that identifies the original application from which the application is derived.

Similarly, new regulation 6A.2 makes provisions for divisional applications made after the grant of innovation patents. However, the prescribed period for filing a divisional application, after the grant of an innovation patent, has not been altered and remains the same as the deadline in current subregulation 6A.2(2) of the Patent Regulations.

Item 4 – subregulations 13.1A(1) and 13.1B(1)

This item amends the Patents Regulations to alter a reference in subregulations 13.1A(1) and 13.1B(1) consequential to the amendment of subsection 141(1) of the Patents Act.

These amendments ensure that the period currently prescribed in subregulations 13.1A(1) and 13.2A(1) of the Patent Regulations continues to apply under the new paragraph 141(1)(c) of the Patents Act.

Item 5 – subregulation 22.10(3)

This item repeals subregulation 22.10(3) of the Patents Regulations. Due to the amendments in item 2, regarding the removal of the requirement for a party to serve documents on the alternate party, this subregulation is redundant.

Item 6 – regulation 22.10AC

This item amends the Patents Regulations to renumber the provisions of regulation 22.10AC and to repeal the exclusion for acts done in opposition proceedings for the purposes of subsection 222A(7) of the Patents Act.

Currently, section 222A of the Patents Act allows that if the Patents Office is closed on the last day that certain acts need to occur, then the act will still be valid if it is carried out on the next day the Patent Office is open. Presently, subregulation 22.10AC prescribes certain acts for which section 222A does not apply, including certain acts done in an opposition proceeding which involve the service of documents on another party. With the removal of the requirement for parties to serve documents, all documents in an opposition proceeding will be required to be filed with the Patents Office – thus section 222A of the Patents Act will apply to all acts done by a party in relation to an opposition proceeding.

Item 7 – subregulation 22.11(4)

This item amends the Patents Regulations to account for the restructuring of Chapter 5 of the Regulations, as made by item 2, and consequential changes to references made to Chapter 5.

Item 8 – subregulations 22.21(3) and 22.21(4)

This item consequentially amends subregulations 22.21(3) and (4) of the Patents Regulations to account for the removal of the requirement for parties to an opposition to serve documents on the other party.

Item 9 – Schedule 7, items 216 to 220

This item consequentially amends Schedule 7 of the Patents Regulations to account for the restructuring and renumbering of provisions in Chapter 5 in item 2.

Part 2 - Trade Marks Regulations 1995**Item 10 – regulation 2.3**

This item amends the Trade Marks Regulations to broaden the normal concept of ‘giving’ a document to a person.

This item also introduces subregulation 2.3(2) to provide certainty to the date on which a document is given to a person. This is consistent with the changes to the Patents Regulations at subregulation 1.3(4) in item 1 above.

Item 11 – Part 5 – Opposition to Registration

This item amends the Trade Marks Regulations to replace the current regulations for the processes of conducting opposition proceedings and the obligations for parties to those proceedings. The item restructures the current regulations to improve readability and make a number of administrative changes, as discussed below.

There are two broad categories of oppositions that occur under the Trade Marks Act; substantive oppositions and procedural oppositions. Substantive oppositions focus on registrability and use issues and include opposition to the registration of a trade mark. Procedural oppositions consider other issues, such as allowance of amendments to applications for registration and extensions of time. These types of opposition are dealt with in Part 6 and Part 21.20 of the Trade Marks Regulations. The most common type of opposition occurs when a person (the opponent) who wishes to oppose the registration of a trade mark files a Notice of Opposition with the Trade Marks Office. Currently, during the opposition proceedings both parties are required to file all documents and evidence in support of their claims with IP Australia and to serve copies of the documents and evidence on the other party.

Consistent with item 2 for the Patents Regulations, the amended regulations remove the requirement for parties to serve documents and evidence on the other party. Instead, the burden for notifying the other party that documents and evidence have been filed is placed on the Trade Marks Office.

New regulations 5.1 and 5.2 set out preliminary information for Part 5, including the definitions necessary for the operation of the provisions.

New regulations 5.3 and 5.4 are intended to ensure that all parties to an opposition proceeding are provided with all relevant information that is filed with the Trade Marks Office. New regulation 5.3 operates to make it easier for the Registrar to provide the information to the other party, by ensuring that the process of giving evidence to the other party is not held up by the Registrar having to arrange for the copying of voluminous amounts of evidence.

New regulation 5.4 is to ensure that parties to opposition proceedings are notified of requests made by the other party or any decisions the Registrar is to make. The regulation will also ensure that parties have the opportunity to express their point of view about the request or proposed decision before the Registrar grants the request or makes the decision. This regulation does not apply to some of the other new regulations. Where this occurs it is to prevent unnecessary delays in what generally amounts to administrative processes, such as regulation 5.3 and the Registrar's power to direct the form in which evidence should be filed.

Commencing opposition proceedings

Currently, after a trade mark application is advertised as accepted by the Registrar, a person wishing to oppose the application has 3 months to file a notice of opposition. While the notice must state the grounds on which the application is opposed, opponents frequently list every ground of opposition, even when it becomes apparent later in the opposition process that the opponent only ever intended to press some, or only one of the grounds. This means that the trade mark applicant may be faced with a number of grounds to deal with and no indication of which are key to the opposition until late in the opposition proceedings, and sometimes not until the hearing itself. This makes it difficult for applicants to determine what case they will likely have to meet and to make an informed decision on whether or not to defend the opposition. It also leads to unnecessary costs where an applicant prepares their case in respect of grounds that an opponent does not intend pursuing.

Item 18 of Schedule 3 to the Raising the Bar amended subsections 52(2) and (3) of the Trade Marks Act to permit regulations to be made prescribing the manner, form and timing of the notice opposition, including with respect to different components of the notice of opposition.

Item 11 amends the Trade Marks Regulations to separate the notice of opposition into two components – a notice of intention to oppose and a statement setting out the grounds of opposition and the material facts which particularise each of those grounds (the statement of grounds and particulars).

New regulation 5.5 clarifies that the notice of opposition is treated as filed only when both the notice of intention to oppose and the statement of grounds and particulars are filed.

New regulation 5.6 prescribes the time period in which a person has to file the first component, the notice of intention to oppose, as 2 months. New regulation 5.7 prescribes the time period in which a person has to file the statement of grounds and particulars as 1 month from the filing of the notice of intention to oppose. The combined total time period for filing both components, of the notice of opposition, remains at 3 months.

Statement of grounds and particulars and associated documents

Requiring grounds to be particularised gives an applicant an indication at an early stage of the opposition process of the case they are likely to have to meet. Having these two components strikes a balance between not delaying notification of opposition proceedings and ensuring that an opponent has sufficient time to prepare the statement of grounds and particulars.

There is a similar requirement in the existing Patent Regulations.² However, the Trade Marks Regulations differ in that the statement of grounds and particulars forms part of the notice of opposition.

New regulation 5.8 provides the Registrar with the flexibility to resolve any issues with the statement of grounds and particulars with the opponent before the Registrar sends the statement of grounds and particulars to the applicant. Under new regulation 5.8, the Registrar may request further and better particulars, delete grounds of opposition or dismiss the opposition for a failure to adequately particularise the grounds. Subparagraph 5.8(6) provides for a review by the Administrative Appeals Tribunal (AAT) of the Registrar's decision to dismiss the opposition under this regulation.

A person considering opposing an application, under section 52(2) of the Trade Marks Act, may seek an extension of time in which to file the notice of opposition. Currently, an extension of time may be sought for a number of reasons, including that the additional time is necessary for the conducting of 'genuine negotiations' with the trade mark applicant and for undertaking 'genuine research' to determine whether opposition is justified or on the grounds for opposition. These reasons for extending the time to file a notice of opposition disadvantages competitors and members of the public who will have an extended period of uncertainty about whether the application is likely to proceed to registration or not.

This item also repeals provisions of the Trade Marks Regulations that allow for an extension of time for conducting negotiations and undertaking research, prior to the filing of the notice of opposition. Consequential to the repeal of these provisions, a cooling-off period has been introduced after opposition proceedings have commenced. During this cooling-off period parties can conduct negotiations and

² Regulation 5.4 of the Patents Regulations.

research with the objective of reaching a negotiated settlement (See regulation 5.16 below).

Amendments to opposition documents – restricting grounds for amending

This item also amends the Trade Marks Regulations to allow amendments to the notice of intention to oppose and the statement of grounds and particulars in specific circumstances only.

Currently, section 66 of the Trade Marks Act permits the Registrar to amend a wide range of documents, either to correct a clerical error or an obvious mistake, or if the Registrar is of the opinion that it is fair and reasonable in all the circumstances to do so. There are no clear limitations as to what amendments can be made to notices filed in a trade marks opposition. It will be possible for an opponent to amend a statement of grounds and particulars to introduce new grounds which should have been included at the time of filing.

Item 25 of Schedule 3 to the Raising the Bar amends section 66 of the Trade Marks Act to prevent an opponent using the broad powers of the section to later add grounds of opposition or particulars that should have been included when the notice of opposition documents were first filed.

The new regulations 5.11 and 5.12 respectively provide opponents with the opportunity to correct simple administrative issues in the notice of intention to oppose for a clerical error or obvious mistake, and in the statement of grounds and particulars for an error or omission. Regulation 5.12 will also enable an opponent to add grounds of opposition to the statement of grounds and particulars in certain circumstances. This ensures that opponents are not disadvantaged by information that comes to light, which the opponent will not have been aware of at the time of filing the notice of opposition documents. This approach improves consistency between patents and trade marks opposition requirements.

Notice of intention to defend

Regulation 5.13 prescribes the time period for trade mark applicants to file a notice of their intention to defend their trade mark application in the face of opposition proceedings.

Sometimes trade mark applicants do not defend their applications after a notice of opposition has been filed. This may be for a number of reasons, including that they may be persuaded by the opponent's case or they may no longer wish to pursue registration due to changing business circumstances. However, where this occurs it will take a number of months for the matter to be finalised and the opponent must still go to some time and expense in preparing their case.

Item 19 of Schedule 3 to the Raising the Bar introduced section 52A of the Trade Marks Act to require trade mark applicants to file a notice of intention to defend within a prescribed period.

Item 21 of Schedule 3 to the Raising the Bar introduced section 54A which provides that a trade mark application will lapse if the applicant fails to file a notice of intention to defend.

New subregulation 5.13(1) prescribes that a notice of intention to defend must be filed within 1 month from the day the applicant is given a copy of the statement of grounds and particulars.

Filing Evidence – substantive oppositions

Currently, parties to an opposition are required to provide notice if they do not intend to rely on, or file, evidence in the proceedings. In some cases, this permits proceedings to be expedited as such notices may truncate the evidence timetable that would otherwise apply. When such a notice is provided, there is no need to await expiry of the 3 month period that otherwise is available for providing evidence. However, parties often either do not file notice of their intention not to rely on evidence or, file the notice just before the deadline for filing, so any benefit to the other party, such as reducing the time period for that stage of the opposition, is lost.

The amended regulations repeal existing regulations 5.8, 5.11 and 5.13 and the current requirement for parties to notify that they will not rely on evidence during the opposition proceedings. This removes an unnecessary burden on the parties to the opposition and aligns the Trade Marks Regulations with the Patent Regulations, which contain no such provision.

Currently, an opponent has 3 months from the date of the trade mark applicant's evidence in answer, in which to serve and file the evidence in reply.

Evidence in reply is limited to being a response to the applicant's evidence in answer and because the scope of evidence in reply is so narrow, it is not always relied upon. The current prescribed period of 3 months is not justified by the nature of the evidence and unnecessarily protracts opposition proceedings.

This item amends the Trade Marks Regulations to remake and restructure current regulations 5.7, 5.9 and 5.12 as new regulation 5.14. New regulation 5.14 sets out the requirements for parties filing evidence in substantive oppositions and reduces the prescribed period for an opponent to file their evidence in reply from 3 months to 2 months.

New regulation 5.14 also improves the opposition process by condensing the prescribed periods for filing evidence. Consistent with the changes for the Patents Regulations, this regulation also requires that documents only be filed with the Trade Marks Office, rather than served on the other party. Evidence in reply is now filed with the Trade Marks Office and the Registrar provides the applicant with the evidence and notifies it when all the evidence has been filed.

Extending time for filing evidence - substantive oppositions

Currently, parties to an opposition are able to extend the period in which they are required to provide evidence.

New regulation 5.15 narrows the circumstances in which the Registrar will grant an extension of time to provide evidence. Extension of the evidentiary periods is at the discretion of the Registrar and only where the Registrar is satisfied that the party entitled to file evidence in that period has acted promptly and diligently at all times since the opposition proceedings began, but despite that, or because of some other exceptional circumstances, cannot file the evidence in that period. Once the conditions are met the Registrar has the discretion to consider whether or not it is appropriate that an extension of time be granted.

The policy and intended operation of this regulation 5.15 is the same as for the corresponding regulation 5.9 at item 2 for the Patent Regulations above, which sets out the new test for extending evidential periods for patents oppositions.

Currently parties are able to seek leave to serve further evidence after the completion of the evidentiary stages of an opposition.³ For the same policy reasons as given in respect of the amendments to the Patent Regulations in item 2, the further evidence provisions have been repealed from the Trade Marks Regulations.

Current regulation 21.19 provides a general discretionary power to the Registrar to inform herself of any information available to the Registrar by reference to any document available in the Trade Marks Office. Following the restructuring of the Trade Marks Regulations by item 11, the Registrar will still have the discretion to consider whether the information is relevant and whether it should be taken into account. However, it is not intended that the provisions of current regulation 21.19 be used as a substitute for the repealed further evidence provisions.

Cooling off period for opposition

This amendment to the Trade Marks Regulations introduces a ‘cooling-off’ period to facilitate negotiations between parties during opposition proceedings.

Often, a dispute about an opposed trade mark application may be resolved by a negotiated settlement between the parties. Negotiated settlements of oppositions can result in a more expeditious resolution of proceedings, and can save parties from being put to unnecessary expense preparing evidence for an adversarial opposition.

The current trade mark opposition procedures facilitate negotiations by permitting an extension of time to lodge a notice of opposition while the parties conduct genuine negotiations or extension of other time periods, or the issue of appropriate directions, during the opposition to facilitate negotiations. However, there are problems with these mechanisms, including where there is an extension of time to lodge a notice of opposition, as the status of the trade mark registration may be unclear for some period. This is not in the public interest. Other extension of time provisions are not well suited to facilitating negotiations, and negotiations may be interrupted by one or other of the parties requiring repeated extensions.

³ Regulation 5.15(1)(b) of the Trade Marks Regulations.

The removal of grounds for seeking extensions of time for notice of opposition to registration and the new test for extending evidentiary periods will prevent the use of extension provisions to facilitate negotiations.

Several overseas trade marks systems provide a ‘cooling-off’ period within the trade marks opposition procedures. Such periods permit parties to the opposition to attempt to settle their differences without going through the full opposition process. This facilitates a swifter and less litigious commercial outcome.

New regulation 5.16 prescribes the requirements for the ‘cooling-off’ period for opposition. The cooling-off period may be requested at any time after the (complete) notice of opposition has been filed and would be agreed to by all parties involved in the opposition. The opposition is suspended for an initial period of 6 months and the suspension could be extended for a further 6 months, up to a maximum of 12 months, at the agreement of both parties. The Registrar will only be able to grant one cooling-off period during an opposition in order not to unnecessarily extend the period of uncertainty for the parties involved and the public. Regulation 5.16(5) provides for the termination of the cooling-off period at the request of either party. After the suspension, if the negotiations are unsuccessful, the formal opposition proceedings would re-commence from the start of the period that was interrupted by the suspension.

Hearing of opposition

Current regulation 5.14 allows for the Registrar to hear and decide an opposition at the request of a party to opposition proceedings. New regulation 5.17 remakes the provisions of regulation 5.14 consequential to the amendments to current regulations 5.8 to 5.13 and clarifies that the Registrar may decide on her own initiative to hold a hearing. New regulation 5.17 also clarifies that the Registrar has the discretion as to whether the hearing is conducted orally or by written submissions provided by the parties.

This item also amends the Trade Marks Regulations to require parties to an opposition to file summaries of their submissions on the matter prior to the hearing date. The policy and intended operation of the new summary of submission provision is the same as the corresponding regulations in respect of filing summary submissions for patents oppositions set out in subregulation 5.20(4) of the Patent Regulations at item 2 above.

Miscellaneous regulations

New Part 5, Division 5 contains a number of regulations which clarify and re-make current regulations 5.5, 5.16 and 5.17.

New regulation 5.18 re-makes current regulation 5.5. New regulation 5.19 re-makes current regulation 5.16. New regulation 5.20 re-makes and amends current regulation 5.17 consequential to the introduction of new regulation 5.8.

Item 12 – Part 6

This item amends the heading of Part 6 of the Trade Marks Regulations to create two divisions under this Part.

Item 13 – Regulations 6.5 and 6.6

This item 13 re-structures and clarifies the provisions for procedural oppositions to the amendment to particulars of a trade mark application as Division 2 of Part 6. New regulation 6.5 sets out the definitions necessary for the operation of the provisions. New regulation 6.6 re-make current regulation 6.5. New regulation 6.7 operates in the same manner as regulations in item 11, which ensures that parties to opposition proceedings are notified of, and have the opportunity to express their point of view about a request to, or decision of, the Registrar before the Registrar grants the requests or makes the decision.

Currently, the prescribed periods in which parties are to file evidence in an opposition proceeding are set out in Trade Mark Regulations 5.7 to 5.17. In the case of procedural oppositions, evidence is not always required or relied on and having multiple, lengthy fixed statutory periods for filing evidence draws the opposition process out unnecessarily.

Under new regulation 6.8, the Registrar has the ability to direct, on a case-by-case basis, the appropriate practice and procedures for oppositions to amendment to particulars of a trade mark application – this will include directing evidential timeframes. This regulation will ensure that when the opposition is complex and the parties will benefit from following the standard evidential periods then the Registrar could make directions that these periods are to apply. However, where the opposition is simple and the process can be contracted, then the Registrar will be able to make the appropriate directions for the matter. The policy and intended operation of this amendment is the same as corresponding regulation 5.12 for patents oppositions set out in item 2 above.

Regulations 6.9, 6.10 and 6.11 re-make and clarify the provisions for hearing a procedural opposition, giving directions and notifying parties of dismissal or discontinuation of a procedural opposition. These provisions mirror the provisions for substantive oppositions.

Item 14 – Part 9 – Removal of trade mark from Register for non-use

This item amends the Trade Marks Regulations to amend and clarify the provisions for an application to remove a trade mark from the Register under section 92 of the Trade Marks Act.

Currently, an application to remove a trade mark from the Register, under section 92 of the Trade Marks Act, may be made to the Registrar. A removal application may be made for any (partial removal) or all of the goods and/or services covered by the trade mark registration. The process for opposing a removal application is similar to

that for opposing an application to register a trade mark, except that the opposing party is usually the owner, or authorised user, of the trade mark, which has already achieved registration for the IP right (unlike a pre-registration opposition, where the opponent is usually a competitor of the trade mark applicant). If the opposition fails, the trade mark is removed from the Register for the goods and/or services specified in the removal application and the trade mark owner loses protection for their mark. Another difference is that a non-use opposition proceeding can be brought before either the Registrar or the courts.

Items 28 to 30 of Schedule 3 to the Raising the Bar amend the Trade Marks Act to permit regulations to be made prescribing requirements and procedures for the conduct of opposition proceedings to an application to remove a trade mark from the Register. Currently, regulation 9.4 of the Trade Marks Regulations prescribes a number of the procedures for non-use opposition proceedings before the Registrar, by reference to regulations in Part 5.

Item 14 amends Part 9 of the Trade Marks Regulations to provide that where an opposition is commenced under new subsection 96(1) of the Trade Marks Act, the manner, form and timing of the opposition are consistent with the provisions for opposition proceedings commenced under other sections of the Act including Section 52. The intention is that all substantive opposition proceedings before the Registrar be conducted in a similar manner. Oppositions before the Court are to continue to follow existing court procedures, in accordance with the form approved by the Court and the court rules.

The policy and intended operation of these new regulations is similar to those for substantive oppositions commenced under section 52 of the Trade Marks Act set out in item 11 above.

Part 9 Division 1 sets out preliminary information for the Part. The provisions include definitions, powers for the Registrar to make directions about the filing of documents and evidence and requirements that will ensure the Registrar notify parties and provide them with the opportunity to express their point of view about a request to, or proposed decision of, the Registrar before the Registrar grants the requests or makes the decision.

New Division 2 re-makes and amends current regulations 9.1 and 9.2 as new regulations 9.5 and 9.6 respectively for better readability.

New Division 3 sets out the requirements for filing opposition documents including the new two components of the notice of opposition - the notice of intention to oppose and the statement of grounds and particulars. The provisions of Division 3 also restrict the grounds for amending the notice of intention to oppose and the statement of grounds and particulars, filing a notice of intention to defend and reducing the prescribed period for filing evidence in reply to 2 months.

New regulations 9.7 to 9.14 operate in a similar manner to regulations 5.5 to 5.12 respectively as discussed at item 11 above.

New regulation 9.15 prescribes the requirements for the filing of a notice of intention to defend an application for the removal of a trade mark for non-use in the face of the trade mark owner filing opposition proceedings. This provision operates in a similar manner to regulation 5.13 as discussed at item 11 above. However, regulation 9.15 enables the Registrar to consider the opposition to have succeeded and refuse to remove the trade mark from the Register if the applicant did not file the notice of intention to defend within the prescribed period.

Occasionally, an opponent (usually the trade mark owner or authorised user) to an application to removal of a registered trade mark will file a notice of opposition, but then lose interest in the opposition and fail to file evidence in support of the opposition. New regulation 9.17 addresses this situation by taking the opposition to have ended, rather than discontinued or dismissed, if evidence in support is not filed or a hearing not requested. It is intended that where an opposition is ended in these circumstances then the application to remove the trade mark would be considered as unopposed and the trade mark removed from the Register under section 97 of the Trade Marks Act.

The test for extending evidential periods is prescribed in regulation 9.18.

Division 4 prescribes the requirements for the cooling-off period. Division 5 sets out the requirements for hearing an opposition. These provisions operate in a similar manner to regulations 5.15 to 5.17 discussed at item 11 above.

Division 6 contains a number of regulations which are administrative in nature, including a requirement for the Registrar to (partially or fully) remove a trade mark from the Register according to what is specified in the removal application, if the opposition proceeding is dismissed.

Item 15 – Subregulation 17A.28(3)

A certification mark is a type of trade mark that shows that a trader's goods or services are certified as meeting particular standards and is defined in section 169 of the Trade Marks Act. The standards which must be met and the rules for use of the certified mark form part of the application process and must be approved by the Australian Competition and Consumer Commission (ACCC). Section 177 of the Trade Marks Act provides that an additional ground for rejecting or opposing an application for a certification mark is if the mark is not capable of distinguishing the certified goods or services of the applicant from the non-certified goods or services of other traders.

Current regulation 17A.28 sets out the grounds for rejecting an International Registration Designating Australia (IRDA). However, the current regulations do not mention section 177 of the Trade Marks Act. There is nothing in the Trade Marks Act that precludes an IRDA from being a certification mark and therefore, subregulation 17A.28 has been amended to clarify that the grounds for rejecting an IRDA include section 177. New subregulation 17A.28(3) clarifies that section 177 of the Trade Marks Act is a ground for rejecting an IRDA which is for a certification mark.

Item 16 – Part 17A, Subdivision 3 – Opposition to IRDA

This item amends the Trade Marks Regulations to reduce delays in the opposition process for International Registrations Designating Australia (IRDA).

In Australia, trade mark protection may also be afforded to foreign marks registered under the international system known as the Madrid Protocol. Currently, Part 17A of the Trade Marks Regulations (along with the Part 17A of the Trade Marks Act) implements the Madrid Protocol into domestic law. For the same policy reasons given in item 1 in respect of patents and item 11 for trade marks, it is intended that all substantive oppositions before the Registrar be conducted in a similar manner, including oppositions to IRDAs. Accordingly, except where modifications are required because of obligations in the Madrid Protocol, Part 17A of the Trade Mark Regulations have been amended to ensure consistency with the amendments to regulations governing domestic substantive oppositions in item 11 above.

New regulations 17A.29 to 17A.31 sets out preliminary information for Subdivision 3 of Part 17A. The provisions include definitions, powers for the Registrar to make directions about the filing of documents and evidence and requirements that ensure the Registrar notified parties and provided them with the opportunity to express their point of view about a request to, or proposed decision of, the Registrar before the Registrar grants the requests or makes the decision.

Regulations 17A.32 to 17A.34G sets out the new two part notice of opposition scheme. These components and their operation consistent with, and contain similar elements and requirements as the notice of opposition scheme as set out in item 11 above.

Regulation 17A.34H prescribes the requirements for filing a notice of intention to defend. Under these provisions, the IRDA holder is required to provide an Australian address for service when filing the notice of intention to defend. The prescribed period for the IRDA holder to file the notice of intention to defend is one month from when the Registrar provides the International Bureau of the World Intellectual Property Organization with the complete Notice of Opposition. Where an IRDA holder failed to file a notice of intention to defend, the Registrar is able to deem the opposition successful and refuse the IRDA based on the grounds of rejection and the particulars asserted by the opponent, and on the IRDA holder's failure to rebut those grounds: the failure to file a notice of intention to defend would be taken to be a concession by the IRDA holder that the opposition grounds were made out. The Registrar will also be required to notify the IRDA holder of the decision to deem the opposition successful.

New regulations 17A.34J to 17A.34M provide for the prescribed period for filing evidence in reply to be 2 months, the new test for extending evidential periods. These provisions also account for the cooling-off period and the requirement that parties must file summaries of submissions before an oral hearing. Regulations 17A.34N to 17A.35 provide for the notification of parties as to the outcome of the opposition proceedings and rights to appeal the decision.

Item 17 – Part 17A, Subdivision 4 – Cessation of protection for non-use

This item amends the Trade Marks Regulations to replace the current regulations for the processes for making an application for the cessation of protection of a protected international trade mark and for conducting opposition proceedings to that application under section 92 of the Trade Marks Act. This item restructures the current regulations to improve readability and make a number of administrative changes, as discussed below.

Currently, subregulation 17A.48(5) of the Trade Marks Regulations prescribes a number of the procedures for non-use opposition proceedings before the Registrar, by reference to current Part 5 of the Trade Marks Regulations.

For the same policy reasons given above in item 2 above in respect of patents and items 11 and 14 above for trade marks, all substantive oppositions before the Registrar will be conducted in a similar manner, including oppositions to cessation of protection of a protected international trade mark for non-use. Accordingly, except where modifications are required because of obligations in the Madrid Protocol, Part 17A, Subdivision 4 of the Trade Mark Regulations is amended to ensure consistency with the amendments to regulations governing domestic substantive oppositions as in item 14 above.

Regulations 17A.48 to 17A.48B sets out preliminary information for subdivision 4. The provisions include definitions, powers for the Registrar to make directions about the filing of documents and evidence and requirements that ensure the Registrar notified parties and provided them with the opportunity to express their point of view about a request to, or proposed decision of, the Registrar before the Registrar grants the requests or makes the decision.

Regulation 17A.48C re-makes and restructures current subregulation 17A.48(1) and (2). Regulation 17A.48E re-makes and restructures current subregulation 17A.48(4). Regulation 17A.48F sets out requirements for the notification of the application for cessation of protection.

Regulations 17A.48G to 17A.48K sets out the new two part notice of opposition scheme. These components and their operation are consistent with, and contain similar elements and requirements as the notice of opposition scheme as set out in items 11 and 14 above.

Regulation 17A.48H requires an opponent to have an address for service in Australia. If an address is not given by the opponent then the Registrar is not required to take any action in response to a notice of opposition. If the opponent does not have an address for service recorded in the Record of International Registrations (maintained by the Registrar at the Trade Marks Office in accordance with regulation 17A.66) then the Registrar is not required to give a document to an opponent or to give the opponent an opportunity to make representations or to be heard on the matter.

Regulations 17A.48N to 17A.48R include provisions that restrict the grounds for amending the notice of intention to oppose and the statement of grounds and particulars, filing a notice of intention to defend and reducing the prescribed period for filing evidence in reply to 2 months.

Consistent with regulation 9.17 at item 14 above, regulation 17A.48S addresses situations where the opponent does not file evidence in support or request a hearing, by taking that opposition to have ended and considering the application for cessation to protection to be unopposed.

Regulations 17A.48T to 17A.48V account for the test for extending evidential periods, the cooling-off period and the requirement that parties must file summaries of submissions before an oral hearing. Regulations 17A.48W to 17A.48Z provide for the notification of parties as to the outcome of the opposition proceedings and the cessation of protection of a protected international trade mark following the dismissal of the opposition proceeding.

Item 18 – Regulation 21.13

This item is consequential to the amendments in item 11 above which introduces the requirement that parties must submit a summary of submissions for oral hearings. Under these new provisions, the Registrar may take a failure to file summary of submissions into account in considering any award of costs between parties. This item amends regulation 21.13 to permit the Registrar to award costs where there is a discretionary power and the Registrar considers it appropriate.

Item 19 – Part 21, Division 2A

This item introduces Division 2A, which clarifies provisions for the opposition of a request for an extension of time of over 3 months. These regulations re-make current regulation 21.26 and 21.27. Regulation 21.20C ensure the Registrar notified parties and provided them with the opportunity to express their point of view about a request to, or proposed decision of, the Registrar before the Registrar grants the requests or makes the decision.

New regulation 21.20D provides the Registrar with the ability to direct on a case-by-case basis the appropriate practice and procedures for procedural extension of time oppositions.

The policy and intended operation of this amendment is the same as corresponding regulation 6.8 for oppositions to amendment to particulars of a trade mark application set out in item 13 above.

Item 20 – regulations 21.26 and 21.27

This item repeals regulations 21.26 and 21.27 consequential to amendments in item 19 above.

Item 21 – Paragraph 21.28 (1) (f) to (ha)

This item repeals paragraphs 21.28(1) (f) to (ha) and substitutes new paragraph (f) consequential to the amendments in item 11 above, which amends the provisions for filing evidence.

Item 22 – Paragraph 21.28(2)(b)

This item amends references in paragraph 21.28(2)(b) and is consequential to the repeal of regulation 21.26 in item 20 above.

Item 23 – Schedule 8

This item repeals Schedule 8 Part 1 and substitutes a new table consequential to the amendments in items 11, 14, 16 and 17 above, which introduces the new two part notice of objection scheme.

Item 24 – Schedule 9, item 6

This item amends item 6 in Schedule 9 consequential to amendments in items 11, 14, 16 and 17 above.

Item 25 – Schedule 9, items 7 and 8

This item amends items 7 and 8 in Schedule 9 consequential to amendments in items 11, 13, 14, 16, 17 and 19 above.

Item 26 – Schedule 9, item 13

This item amends item 13 in Schedule 9 consequential to amendments in item 14 above.

Item 27 – Schedule 9, item 14

This item amends item 14 in Schedule 9 consequential to the amendments in items 11, 13, 14, 16, 17 and 19 above.

Item 28 – Schedule 9, item 16

This item amends item 16 in Schedule 9 consequential to the amendments in items 11, 13, 14, 16, 17 and 19 above.

Item 29 – Schedule 9, item 17

This item amends the language of item 17 in Schedule 9 consequential to the amendments in item 28 above.

Item 30 – Schedule 9, item 20

This item amends the reference in item 20 in Schedule 9.

Part 3 Designs Regulations 2004**Item 31 – regulation 9.05(5)**

This item amends the Designs Regulations to remove the obligation for parties to serve a copy of documents on the alternate party in proceedings. Consistent with regulatory changes for patents and trade marks legislation, parties will continue to be required to file documents with IP Australia, and IP Australia will be required to make those documents available to the alternate party.

The policy and intended operation of this item is the same as the corresponding regulations in respect of filing requirements for patent oppositions at item 2 of the Patent Regulations and for Trade Marks Regulations at item 11 above.

Item 32 – subregulation 11.13(3)

This item amends the Designs Regulations to remove the obligation for parties to serve a copy of documents on the alternate party in proceedings. The policy and intended operation of this item is the same as the corresponding regulations in respect of filing requirements for patents at item 2 of the Patent Regulations and for Trade Marks Regulations at item 11 above.

Schedule 4 – Amendments relating to Schedule 4 to the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012*

Part 1 – Patents Regulations 1991

Items 1, 2, 3, 4, 5, 8, 9 and 19 – definitions

These items amend subregulation 1.3(1) of the Patent Regulations to include or relocate definitions for necessary terms within the general definitions regulation.

Item 1 provides a definition for the term ‘AAT’, being the Administrative Appeals Tribunal. Item 2 provides a definition for ‘Code of Conduct’ which is necessary for provisions regarding attorney discipline and the standards of professional conduct expected from registered attorneys. Item 3 amends the definition of ‘Disciplinary Tribunal’ to correct the reference to the provision under which the Tribunal is established. Item 4 provides a definition for ‘Register of Patent Attorneys’ to maintain consistency with the language used in definitions provided in Schedule 1 to the Patents Act.

Items 5, 8, 9 and 19 consequentially remove duplicated definitions from elsewhere in the Regulation.

Item 6 – heading Chapter 20

Item 6 amends the heading to Chapter 20 of the Patents Regulations to clarify that the chapter applies only to individual attorneys and not incorporated attorneys.

Item 21 introduces provisions similar to those in Chapter 20 for incorporated attorneys.

Item 7 – regulation 20.1A

This item amends the Patents Regulations to clarify that Chapter 20 applies only to individuals who are, or are seeking registration as, patent attorneys.

Currently under section 198 of the Patents Act only individuals can be patent attorneys. Chapter 20 of the Patents Regulations specifies the requirements that must be met by an individual to become registered as a patent attorney, to maintain that registration and to be re-instated on the Register if the individual has been removed from the Register. The current regulations include technical and character requirements that an individual must fulfil.

Item 21 of Schedule 4 to the Raising the Bar Act amends section 198 of the Patents Act to allow for the registration of a company as a ‘patent attorney’. The administrative requirements for registration of individuals and companies differ for a number of reasons, in particular because a company is not expected to satisfy the character and educational requirements that currently exist for individual patent attorneys.

The amendment introduces regulation 20.1A that clarifies that Chapter 20 of the Patents Regulations, and the administrative requirements contained within it, apply to individuals only.

Related item 21 provides regulations for the administrative requirements for registration of incorporated patent attorneys. Separating the provisions for registration requirements of individual and incorporated patent attorneys improves the readability of the legislation.

Item 10 – subregulation 20.1(1), definition of *serious offence*

This item amends the Patents Regulations to introduce a definition of ‘serious offence’ for the purpose of the attorney suspension scheme introduced by related item 14 below.

Items 11 to 13 and 15 to 18 – headings to regulations

These items amend the headings to a number of provisions as a consequence of the changes made by item 4 to the definition of Register of Patent Attorneys.

Item 14 – Chapter 20, Part 6A

This item amends the Patents Regulations to introduce a scheme allowing for suspension of the registration of an individual attorney who has been charged with a serious offence. This item also enables the suspension to be removed in appropriate circumstances. The power to make this regulation is granted under subparagraph 228(2)(r)(ii) of the Patents Act.

The Professional Standards Board for Patent and Trade Marks Attorneys (PSB) administers the current attorney discipline regime for patent and trade marks attorneys. The regime provides for establishment of a Disciplinary Tribunal, which is responsible for hearing and deciding on matters of misconduct. If the Tribunal is satisfied misconduct has occurred, the Tribunal can reprimand the attorney, or suspend or cancel the attorney’s registration – depending on the seriousness of the misconduct. When an attorney is charged with a serious criminal offence, the PSB is able to commence disciplinary proceedings before the Tribunal. However, an attorney continues to be able to practice during Tribunal proceedings.

There is a need to protect the public and to maintain public trust in the profession when such a situation arises. This need will sometimes outweigh an attorney’s right to continue practising after being charged with a serious criminal offence. This is particularly so when the alleged offence is one such as theft or fraud which, if established, would put the interests of the client at risk and undermine the fiduciary relationship between attorney and client.

This item introduces an attorney suspension scheme which allows the Designated Manager (currently the Director General of IP Australia), who oversees the registration of patent and trade marks attorneys, to suspend an attorney's registration. The scheme applies to any patent attorney charged with a serious offence. The definition of a serious offence is provided in subregulation 20.1(1) (see item 10 above).

New subregulation 20.28A(2) provides that a failure by an attorney to notify the Designated Manager of a charge for a serious offence laid against the attorney is regarded as unsatisfactory professional conduct under current regulation 20.32 of the Patents Regulations.

New subregulation 20.28B(1) provides the Designated Manager with the discretion to suspend an attorney.

New subparagraph 20.28B(2)(b) ensures that the Designated Manager provides a suspended attorney with the opportunity to explain why the suspension should be removed.

It is intended that suspension of an attorney's registration would occur only if the Designated Manager considered that the alleged offence is sufficiently serious. A decision by the Designated Manager to suspend an attorney's registration will be appealable to the Administrative Appeals Tribunal (AAT) (see item 23 below). This balances the interests of accused attorneys and their clients (and wider public) by providing attorneys with an appeal mechanism when suspension occurs.

Item 20 – subregulation 20.44(2)

This item amends subregulation 20.44(2) as a consequence of the changes made by item 4 to the definition of Register of Patent Attorneys.

Item 21 – Chapter 20A

This item amends the Patents Regulations to introduce administrative requirements for the registration and discipline of 'incorporated' patent attorneys.

Item 21 of Schedule 4 to the Raising the Bar Act amends section 198 of the Patents Act to allow for the registration of a company as a 'patent attorney'. Consequentially the Patents Regulations require amendment to account for companies which seek registration as patent attorneys.

Part 1 of the amendments clarify that Chapter 20A applies to companies that are, or that are seeking to be, registered as a patent attorney. Part 1 also defines the annual registration fee for incorporated patent attorneys, and the meaning of professional indemnity insurance.

Part 2 of the amendments under item 21 provide for a number of administrative requirements for companies that differ from the requirements for individuals.

Obtaining registration for the first time

Item 21 of Schedule 4 to the Raising the Bar Act introduces new subsections 198(9), (10) and (11) to the Patents Act, which require an incorporated attorney firm to have at least one registered patent attorney who has been validly appointed as a director of the company.

New subregulation 20A.3(b)(i) requires companies that apply to be registered as incorporated attorneys to provide the name, or names of each registered patent attorney who is a director of the company.

New subregulation 20A.3(b)(ii) requires that companies who apply to be registered as a patent attorney provide evidence that the company is a registered company under the *Corporations Act 2001*.

Currently, there is no requirement for patent attorneys to be covered by a professional indemnity insurance policy. At present, only individuals can be registered as patent attorneys. The potential for an individual or partner to be personally liable in negligence is sufficient incentive to ensure that they acquire appropriate professional indemnity insurance. With the introduction of incorporated patent attorneys, however, there may be issues of liability for negligence claims. The patent attorney director, or an employee of the company, may bear no personal responsibility if a claim of negligence or breach of professional duty is made against the company. Furthermore, the company may have insufficient assets to cover a successful negligence action.

New subregulation 20A.3(b)(iii) requires that incorporated patent attorneys hold a professional indemnity insurance policy. It is intended that the Designated Manager would be able to ask an incorporated attorney to provide evidence that it had an adequate professional indemnity insurance policy at any time, to ensure that an appropriate policy was maintained.

It is intended that the term, professional indemnity insurance, is given its common meaning as is understood within the insurance industry. A professional indemnity insurance policy should be adequate for an incorporated attorney's individual circumstances, taking into account the attorney's clients, along with the volume, value and risk of the patents work that the firm does.

The Regulation is intended to provide flexibility to incorporated patent attorneys to ensure that there is no restriction on where an insurance policy is sourced from, provided that the insurer could be regulated by the Australian Prudential Regulation Authority (APRA) or by a comparable overseas regulator. Similarly, there is no requirement for firms to hold dual cover if the incorporated attorney is also an incorporated legal practice, so long as the intellectual property work is covered by the insurance policy. Incorporated attorneys failing to maintain professional indemnity insurance face a sanction under new regulation 20A.8, which provides the Designated Manager with the power to remove noncompliant attorneys' names from the Register.

Maintaining Registration and Removal from Register of Patent Attorneys

Item 21 of the Regulation also introduces new Parts 3 and 4. These provisions are adapted from similar requirements for individual patent attorneys.

Part 3, regulation 20A.5 set outs the requirements for remaining on the Register and payment of annual registration fees.

Part 4, regulations 20A.6 to 20A.8 prescribe circumstances for removal of incorporated attorneys from the Register. In addition to voluntary removal and failure to pay an annual registration fee, incorporated attorneys may be removed from the register if they do not maintain adequate and appropriate professional indemnity insurance.

Discipline of incorporated attorneys

New Chapter 20A, Part 5 introduces regulations for managing the discipline of incorporated attorneys. These regulations are adapted from the regulations for individual patent attorneys found in Chapter 20 Part 8 of the Patents Regulations.

Under the new regulation 20A.10, the PSB may apply to the Disciplinary Tribunal for cancellation or suspension of an incorporated patent attorney's registration on the grounds that an officer or employee of the incorporated patent attorney has been found guilty by the Disciplinary Tribunal of professional misconduct under 20.43(1) and the Tribunal has cancelled or suspended the registration of the officer or employee.

The Regulation is intended to provide flexibility for the Disciplinary Tribunal to take action where it considers there is a systemic problem with the firm that might not be sufficiently dealt with by suspension of an individual attorney employed by the firm. The potential for de-registration of an incorporated attorney will provide a greater incentive for the board of the company, as a whole, to take active steps to ensure that individual officers and employees do not engage in activities that would amount to professional misconduct.

This item also introduces Division 2 of Part 5 and subregulations 20A.11 to 20A.17 and 20A.19 to 20A.21 that prescribe the proceedings before the Disciplinary Tribunal. These subregulations reflect the regulations for individual patent attorneys found in Chapter 20 Part 8 Division 2 of the Patents Regulations.

New subregulation 20A.18 prescribes that the Disciplinary Tribunal may cancel or suspend the attorneys registration as an incorporated patent attorney. This regulation differs from the equivalent subregulation for individual attorneys in that there is no prescribed timeframe suspending an incorporated patent attorney's registration.

Restoring attorney's name to the Register of Patent Attorneys

Part 6 sets out the circumstances under which the Designated Manager must return an incorporated attorney's name to the Register. These circumstances replicate those that currently exist for individual attorneys with two exceptions.

Subregulation 20A.22(1)(a) provides for circumstances where the incorporated attorney's name has been removed for failing to maintain professional indemnity insurance. In this circumstance the request for return to the register must include evidence that the attorney has obtained adequate personal indemnity insurance.

Subregulation 20A.22(1)(b) provides for circumstances where the incorporated attorney's name has been removed because of failure to have a patent attorney director. In this circumstance the request for return to the register must include evidence that the attorney has a patent attorney director.

In both circumstances the request for return must be made within 3 years after the name was removed.

Item 22 – subregulation 22.12(1)

This item amends subregulation 22.12(1) to clarify reference to the Disciplinary Tribunal.

Items 23 to 27 – subparagraph 22.26(2)(c) and 22.26(2)(d)

These items amend subparagraphs 22.26(2)(c) and (d) to provide for merits review by the Administrative Appeals Tribunal (AAT) of decisions of the Designated Manager introduced by items 14 and 21 above.

The Regulation is consistent with the existing position for other decisions of the Designated Manager under regulation 22.26(2)(c) of the Patents Regulations.

Item 28 – Schedule 7, Part 1, items 108 to 111

This item introduces fees related to the registration requirements for incorporated patent attorneys, as discussed in item 21 above.

Items 29 and 30 – various regulations

Item 29 amends various regulations as a consequence of the changes made by items 4 and 9 to the definition of Register of Patent Attorneys. Item 30 also amends various regulations as a consequence of the changes made by items 1 and 5 to the definition of Administrative Appeals Tribunal (AAT).

Part 2 – Trade Marks Regulations 1995

Items 31 to 34, 36 and 37 – definitions

These items amend the Trade Marks Regulations to include or relocate definitions for necessary terms within the general definitions regulation.

Item 31 provides a definition for the term ‘AAT’ to account for provisions allowing merits review by the Administrative Appeals Tribunal. Items 32 and 33 provides definitions for ‘Board’, ‘Designated Manager’ and ‘Disciplinary Tribunal’ which are necessary for provisions regarding attorney discipline and the standards of professional conduct expected from registered attorneys. Item 34 provides a definition for ‘Register of Trade Marks Attorneys’ to maintain consistency with the language used in definitions provided in the Trade Marks Act.

Items 36 and 37 consequentially remove duplicated definitions from subregulation 20.1(1) of the Trade Marks Regulations.

Item 35 – regulation 20.1A

This item amends regulation 20.1A to clarify that Part 20 applies only to individuals who are, or are seeking registration as, trade marks attorneys.

Currently under section 228A of the Trade Marks Act only individuals can be registered as trade marks attorneys, as a corporate entity is not able to satisfy the knowledge and character requirements for registration. Item 53 of Schedule 4 to the Raising the Bar Act amends section 228A of the Trade Marks Act to specifically allow for the registration of a company as a ‘trade marks attorney’.

Part 20 of the Trade Marks Regulations specifies the requirements that must be met by an individual to become registered as a trade marks attorney, to maintain that registration and to be re-instated on the Register if the individual has been removed from the Register. This includes technical and character requirements that an individual must fulfil.

The Regulation clarifies that Part 20 of the Trade Marks Regulations, and the administrative requirements contained within it, apply to individuals only. Related item 42 provides regulations for the administrative requirements for registration of incorporated trade marks attorneys. The policy and intended operation of these items is the same as the amendments in respect of individual and incorporated patent attorneys in Part 1 above.

Item 38 – subregulation 20.1(1), definitions of *serious offence* and *unsatisfactory professional conduct*

This item amends the Trade Marks Regulations to introduce a definition of ‘serious offence’ for the purpose of the attorney suspension scheme introduced by related

item 41 below. Also introduced is a definition for ‘unsatisfactory professional conduct’ which is consistent with the meaning given in the Patents Regulations.

Items 39 and 40 – headings to regulations

These items amend the headings to a number of provisions as a consequence of the changes made by item 34 to the definition of Register of Trade Marks Attorneys.

Item 41 – Part 20, Division 5A

This item amends the Trade Marks Regulations to introduce a scheme allowing for suspension of the registration of an individual attorney who has been charged with a serious offence. This item also enables the suspension to be removed in appropriate circumstances. The policy and intended operation of these regulations is the same as the corresponding amendments in respect of incorporated patent attorneys discussed at item 14 above.

This item introduces an attorney suspension scheme which allows the Designated Manager (currently the Director General of IP Australia), who oversees the registration of patent and trade marks attorneys, to suspend an attorney’s registration. The scheme applies to any trade marks attorney charged with a serious offence. The definition of a serious offence is provided in subregulation 20.1(1) (see item 38 above).

New subregulation 20.14A(2) provides that a failure by an attorney to notify the Designated Manager of a charge for a serious offence laid against the attorney is regarded as unsatisfactory professional conduct.

New subregulation 20.14B(1) provides the Designated Manager with the discretion to suspend an attorney.

New subparagraph 20.14B(2)(b) ensures that the Designated Manager provides a suspended attorney with the opportunity to explain why the suspension should be removed.

A decision by the Designated Manager to suspend an attorney’s registration will be appealable to the Administrative Appeals Tribunal (AAT) (see item 45 below).

Item 42 – Part 20A

This item amends the Trade Marks Regulations to introduce administrative requirements for the registration, maintenance, removal and restoration of ‘incorporated’ trade marks attorneys to the Register of Trade Marks Attorneys.

Item 53 of Schedule 4 to the Raising the Bar Act amends section 228A of the Trade Marks Act to allow for companies to be registered as ‘trade marks attorneys’. The

policy and intended operation of these regulations is the same as the corresponding amendments in respect of incorporated patent attorneys discussed at item 21 above.

Division 1 of the amendments clarify that Part 20A applies to companies that are, or that are seeking to be, registered as a trade marks attorney. Regulation 20A.2 introduces a definition for professional indemnity insurance.

Division 2 of the amendments provides for a number of administrative requirements for companies that differ from the requirements for individuals.

Obtaining registration for first time

Item 53 of Schedule 4 to the Raising the Bar Act introduces new subsections 228A(6A), (6B) and (6C) to the Trade Marks Act, which require an incorporated attorney firm to have at least one registered trade marks attorney who has been validly appointed as a director of the company.

New subregulation 20A.3(b)(i) requires companies that apply to be registered as incorporated attorneys to provide the name, or names of each registered trade marks attorney who is a director of the company.

New subregulation 20A.3(b)(ii) requires that companies who apply to be registered as a trade marks attorney provide evidence that the company is a registered company under the *Corporations Act 2001*.

Currently, there is no requirement for trade marks attorneys to be covered by a professional indemnity insurance policy. With the introduction of incorporated trade marks attorneys there may be issues of liability for negligence claims. The trade marks attorney director, or an employee of the company, may bear no personal responsibility if a claim of negligence or breach of professional duty is made against the company. Furthermore, the company may have insufficient assets to cover a successful negligence action.

New subregulation 20A.3(b)(iii) requires that incorporated trade marks attorneys hold a professional indemnity insurance policy. It is intended that the Designated Manager would be able to ask an incorporated attorney to provide evidence that it had an adequate professional indemnity insurance policy at any time, to ensure that an appropriate policy was maintained.

It is intended that the term, professional indemnity insurance, is given its common meaning as is understood within the insurance industry. A professional indemnity insurance policy should be adequate for an incorporated attorney's individual circumstances, taking into account the attorney's clients, along with the volume, value and risk of the trade marks work that the firm does.

The Regulation is intended to provide flexibility to incorporated trade marks attorneys to ensure that there is no restriction on where an insurance policy is sourced from, provided that the insurer could be regulated by the Australian Prudential Regulation Authority (APRA) or by a comparable overseas regulator. Similarly, there is no requirement for firms to hold dual cover if the incorporated

attorney is also an incorporated legal practice, so long as the intellectual property work is covered by the insurance policy. Incorporated attorneys failing to maintain professional indemnity insurance face a sanction under new regulation 20A.8, which provides the Designated Manager with the power to remove noncompliant attorneys' names from the Register of Trade Marks Attorneys.

Maintaining Registration and Removal from Register of Trade Marks Attorneys

Item 42 of the Regulation also introduces new Divisions 3 and 4. These provisions are adapted from similar requirements for individual trade marks attorneys.

Division 3, regulation 20A.5 set outs the requirements for remaining on the Register and payment of annual registration fees.

Division 4, regulations 20A.6 to 20A.8 prescribe circumstances for removal of incorporated attorneys from the Register of Trade Marks Attorneys. In addition to voluntary removal and failure to pay an annual registration fee, incorporated attorneys may be removed from the Register of Trade Marks Attorneys if they do not maintain adequate and appropriate professional indemnity insurance.

Discipline of incorporated attorneys

New Part 20A, Division 5 introduces regulations for managing the discipline of incorporated attorneys. These regulations are adapted from the regulations for individual trade marks attorneys found in Part 20 of the Trade Marks Regulations.

Under the new regulation 20A.10, the PSB may apply to the Disciplinary Tribunal for cancellation or suspension of an incorporated trade marks attorney's registration on the grounds that an officer or employee of the incorporated trade marks attorney has been found guilty by the Disciplinary Tribunal of professional misconduct under Part 20 Division 5 and the Tribunal has cancelled or suspended the registration of the officer or employee.

The Regulation is intended to provide flexibility for the Disciplinary Tribunal to take action where it considers there is a systemic problem with the firm that might not be sufficiently dealt with by suspension of an individual attorney employed by the firm. The potential for de-registration of an incorporated attorney will provide a greater incentive for the board of the company, as a whole, to take active steps to ensure that individual officers and employees do not engage in activities that would amount to professional misconduct.

This item also introduces Subdivision 2 of Division 5 and subregulations 20A.11 to 20A.17 and 20A.19 to 20A.21 that prescribe the proceedings before the Disciplinary Tribunal. These subregulations reflect the regulations for individual trade marks attorneys found in Part 20 of the Trade Marks Regulations.

New subregulation 20A.18 prescribes that the Disciplinary Tribunal may cancel or suspend the attorneys registration as an incorporated trade marks attorney. This regulation differs from the equivalent subregulation for individual attorneys in that

there is no prescribed timeframe suspending an incorporated trade marks attorney's registration.

Returning to Register of Trade Marks Attorneys

Division 6 sets out the circumstances under which the Designated Manager must return an incorporated attorney's name to the Register of Trade Marks Attorneys. These circumstances replicate those that currently exist for individual attorneys with two exceptions.

Subregulation 20A.22(1)(a) provides for circumstances where the incorporated attorney's name has been removed for failing to maintain professional indemnity insurance. In this circumstance the request for return to the register must include evidence that the attorney has obtained adequate personal indemnity insurance.

Subregulation 20A.22(1)(b) provides for circumstances where the incorporated attorney's name has been removed because of failure to have a trade marks attorney director. In this circumstance the request for return to the register must include evidence that the attorney has a trade marks attorney director.

In both circumstances the request for return must be made within 3 years after the name was removed.

Items 43 to 45 – paragraph 21.35(2)(b)

These items provide for merits review by the Administrative Appeals Tribunal (AAT) of decisions of the Designated Manager and reflect the amendments made to the Patents Regulations in items 23 to 27 above.

The Regulation is consistent with the existing position for other decisions of the Designated Manager under regulation 21.35(2)(b) of the Trade Marks Regulations.

Item 46 – Schedule 9, items 36 to 39

This item introduces fees related to the registration requirements for incorporated trade marks attorneys, as discussed in item 42 above.

Items 47 and 48 – various regulations

These items amend various regulations as a consequence of the changes made by item 31 to the definition of Administrative Appeals Tribunal (AAT).

Schedule 5 – Amendments relating to Schedule 5 to the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012*

Part 1 – Copyright Regulations 1969

Item 1 – regulations 21, 22, 22A and 22B

This item amends the Copyright Regulations to provide prescribed time periods for the ‘claim for release’ introduced by items 1, 2, 6 and 13 of Schedule 5 to the Raising the Bar Act. This item also specifies the information required in the ‘claim for release’ provided for in section 135AEA of the Copyright Act, as introduced by item 13 of Schedule 5 to the Raising the Bar Act. The item also prescribes that such claims be made in the form approved by the Customs CEO.

Regulation 21 is amended to clarify that a person must comply with a direction of the Customs CEO to provide information or evidence under paragraph 135(8)(c) of the Copyright Act. Also the note to regulation 21 provides a revised definition for the term CEO by reference to section 134B of the Copyright Act. This definition of CEO is necessary for the operation of regulations 21 and 22B.

Currently Customs is required to hold seized copies for a ‘retention period’ while the objector determines whether to institute infringement proceedings against the importer. The period within which the objector must commence proceedings is known as the ‘action period’. An importer can frustrate the objector’s efforts to commence proceeding within the ‘action period’ by making it difficult for the objector to identify and contact them, or serve the importer with court documents, within this period. If the importer is successful in frustrating the objector’s efforts and proceedings are not commenced, Customs must release the copies to the importer at the end of the ‘retention period’.

The Raising the Bar Act addresses these problem by introducing a ‘claim for release’ into the Notice of Objection scheme. An importer who wishes the return of their copies will be required to lodge a claim for release, which includes the importer’s name and address details to a level of detail that would enable contact to be made within the prescribed period, before Customs will release the seized copies to them.

This item prescribes the ‘claim period’, which is the period during which the importer must lodge a claim for return, and the ‘action period’ which is the period during with the objector must commence infringement proceedings.

New regulation 22A prescribes the ‘claim period’ as the period of 10 working days after notice of seizure of the copies is given to the importer. While new regulation 22 prescribes the ‘action period’ as the period of 10 working days after a notice of a claim for release of the copies is given to the objector (via Customs).

Currently an objector is often unable to contact an importer of seized copies within the time limit for instituting infringement proceedings due to a lack of contact and address details for the importer. Also the objector is generally only able to obtain information about the foreign exporter or consignor (the person who provided the copies to the importer) by court order, which can be expensive and time consuming.

The Raising the Bar Act amends the Copyright Act to introduce the ‘claim for release’ into the Notice of Objection scheme. The claim for release requires an importer (who wants the release of the seized copies) to provide identifying information, as prescribed in the regulations, to Customs within the ‘claim period’. The Customs CEO would then provide this information to the objector.

This item also inserts new regulation 22B which prescribe the requirements for the ‘claim for release’. Subregulation 22B(1) prescribes that the claim is in writing in a form approved by the Customs CEO. Subregulation 22B(2) requires that the claim include the full name, address and telephone number of the importer. If the importer does not have a place of residence in Australia, the claim must also include the full name, address and telephone number of the importer’s agent in Australia or of any person that made arrangements on behalf of the importer for the copies to be imported. The phrasing of sub-regulation 22B(e) is intended to ensure that contact and identifying details of any foreign exporter, consignor or other party involved in the importation of the seized copies are included in the information provided to the Customs CEO and ultimately the objector. Providing the objector with details of all parties associated with an importation will allow copyright owners to address infringement at its source and identify repeat offenders.

Part 2 – Trade Marks Regulations 1995

Item 2 – regulation 13.1 to 13.6

This item amends the Trade Marks Regulations to restructure existing regulations for the Notice of Objection scheme and to prescribe time periods and requirements for the ‘claim for release’ introduced by items 18 to 22 of Schedule 5 to the Raising the Bar Act.

New regulation 13.1 clarifies that references to the Customs CEO should be read as being modified to account for differences in border protection laws between Australia, Norfolk Island, Christmas Island and the Cocos (Keeling) Islands.

Currently Customs is required to hold seized goods for an ‘action period’ while the objector determines whether to institute infringement proceedings against the designated owner of the imported goods. A designated owner can frustrate the objector’s efforts to commence infringement proceedings by making it difficult for the objector to contact them within the ‘action period’. If the designated owner is successful in frustrating the objector’s efforts and proceedings are not commenced Customs must release the goods to the designated owner at the end of the ‘action period’.

Also the objector is generally only able to obtain information about the foreign exporter or consignor (the person who provided the goods to the designated owner) by court order, which can be expensive and time consuming.

The Raising the Bar Act amends the Trade Marks Act to introduce the ‘claim for release’, into the Notice of Objection scheme, which requires the designated owner

(who wants the release of seized goods) to provide identifying information to Customs, as prescribed by the regulations, prior to the objector being required to institute proceedings, within a prescribed period.

This item prescribes the ‘action’ and ‘claim’ periods and requirements for the Notice of Objection and the ‘claim for release’. New subregulations 13.2 and 13.3 prescribe the ‘action’ and ‘claim’ periods. The ‘action period’ is 10 working days after a notice of a claim for release of the goods is given to the objector (via Customs). The ‘claim period’ is 10 days after notice of seizure of the goods is given to the designated owner.

New subregulations 13.4 and 13.5 prescribe the requirements for the Notice of Objection. These requirements are currently prescribed in subregulations 13.1 and 13.2 and re-making of the provisions in 13.4 and 13.5 does not affect their operation.

New subregulation 13.6 prescribes the requirements for the purpose of new subsection 136(3) of the Trade Marks Act. Subregulation 13.6(1) prescribes that the claim for release is in writing and in a form approved by the Customs CEO. Subregulation 13.6(2) requires that the claim for release include the full name, address and telephone number of the designated owner that would enable contact to be made with them within the prescribed period. If the designated owner does not have a place of residence in Australia, the claim must also include the full name, address and telephone number of the owner’s agent in Australia or of any person that made arrangements on behalf of the owner for the goods to be imported. The phrasing of sub-regulation 13.6(2)(e) is intended to ensure that contact and identifying details of any foreign exporter, consignor or other party involved in the importation of the seized goods are included in the information provided to the Customs CEO and ultimately the objector. Providing the objector with details of all parties associated with an importation will allow trademark owners to address infringement at its source and identify repeat offenders.

Item 3 – regulations 13.7 to 13.10

This item amends the Trade Marks Regulations consequential to the changes made in item 2. Existing regulations 13.3 to 13.6 have been renumbered as regulations 13.7 to 13.10.

Schedules 3, 4 & 5

These Schedules and their items amend the Trade Marks Regulations to allow for modification of Part 13 of the Trade Marks Act.

Currently Schedules 3 to 5 to the Trade Marks Regulations set out provisions by which Part 13 of the Trade Marks Act is modified to account for differences in border protection laws between Australia, Norfolk Island, Christmas Island and the Cocos (Keeling) Islands. These Schedules and their items amend each of the current Schedules 3 to 5 to the Trade Marks Regulations to account for amendments the Trade Marks Act made by Schedule 5 to the Raising the Bar Act.

Schedule 6 – Amendments relating to Schedule 6 to the Intellectual Property Laws Amendment (Raising the Bar) Act 2012

Designs Regulations 2004

Items 1 and 4 – regulation 1.05 and schedule 1

These items amend the Designs Regulations to define the term ‘convention country’ by reference to countries which are parties to the Paris Convention for the Protection of Industrial Property (Paris Convention) or full members of the World Trade Organization (WTO) on the World Intellectual Property Organization (WIPO) and WTO websites. Item 4 amends the regulations to consequentially repeal the current list of deemed convention countries from the Designs Regulations.

Currently, the Designs Act requires that each ‘convention country’ is listed individually in the Designs Regulations. This practice of defining the term ‘convention country’ by reference to a listed Schedule in the Designs Regulations requires that the regulations be amended each time membership to the Paris Convention or the WTO changes. Items 1 and 4 of Schedule 6 to the Raising the Bar Act address this issue by amending the Designs Act to revise how convention countries are defined in the Designs Regulations.

The Regulation implement the changes made by item 4 of Schedule 6 to the Raising the Bar Act. Defining ‘convention country’ by reference to signatories to the Paris Convention or full members of the WTO listed on the WIPO and WTO websites ensures that users of the system are not being misled or confused by out-of-date lists. Countries which only have ‘observer’ status with the WTO will not be afforded convention country status under these regulations.

Item 2 – subregulation 5.04(c)(iii)

This item provides consequential amendments to the Designs Regulations to ensure that the Designs Act and Designs Regulations are consistent in the jurisdiction of the courts to hear appeals.

Currently, below the High Court, the jurisdiction of courts to hear and decide appeals of the Registrar’s decisions is restricted to the Federal Court. However, many designs matters are relatively simple disputes and parties to those matters would benefit from them being heard in a speedy, cost-effective and less formal setting. Thus items 9 and 10 of Schedule 6 to the Raising the Bar Act amend sections 67 and 68 of the Designs Act to provide the Federal Magistrates’ Court with jurisdiction to hear and decide designs matters.

The Regulation consequentially amends the Designs Regulations to clarify that the Federal Magistrates’ Court has jurisdiction to hear and decide designs matters.

Item 3 – regulation 11.22 and 11.23

These items amend the Designs Regulations to clarify that the Registrar has the discretion to decide that parties may only give written submissions to present their case.

Under the designs legislation there are a number of provisions governing how the Registrar must give parties the opportunity to be heard on matters in which they have an interest. Currently, the Designs Regulations prescribe requirements regarding a party's right to be heard when the Registrar intends to exercise a discretionary power. Generally, matters are resolved through oral hearings and parties, or their representatives, appear in person with a written decision being issued by the hearing officer at a later date.

Oral hearings are necessary for resolving substantive matters where parties may choose to rebut evidence as it is presented. However, holding an oral hearing is often inappropriate for simple and minor issues where there is no need for parties to rebut evidence. This involves extra cost and complexity for both parties and the Registrar, while providing little benefit for simple and straightforward matters. Many matters are more easily dealt with through the provision of written submissions.

The Regulation clarifies how the Registrar's discretionary powers operate and procedures for oral hearings and hearing on written submissions only. The Regulation also makes one further minor change. Currently the Registrar must give at least 10 days notice to applicants before a hearing. The regulations change this to 10 'business' days, to ensure that parties are not disadvantaged and have sufficient time to prepare for the hearing.

Patents Regulations 1991**Item 5 – regulation 1.4**

This item amends the definition of 'Convention country' so that Convention countries are signatories to the Paris Convention or full members of the World Trade Organization. The policy reasons for this change and the intended operation of the provision are the same as item 1.

Item 5 also removes the reference to the Budapest treaty and the Patent Cooperation Treaty (PCT). This change is consequential to the change in item 91 of Schedule 6 to the Raising the Bar Act, which removed the requirement for the regulations to set out the text of these treaties. This avoids the need to amend the regulations every time the Budapest Treaty or PCT is amended.

Item 6 – regulations 1.6 and 1.6A

This item amends the Patent Regulations to introduce the prescribed period within which the use of an invention will not be taken to be 'secret use' under the Patents Act.

Currently, other than the limited circumstances already provided for in section 9 of the Patents Act, the secret use of an invention by the patentee any time before filing a patent application would invalidate any resulting patent. This is intended to encourage early public disclosure of inventions and prevent patentees from obtaining patent rights after profiting from an invention maintained as a trade secret. However, under the patents legislation, the public use of an invention by the patentee within the 12 months before the filing date of the complete application does not affect the patentability of that invention. This creates an inconsistency where public use of an invention in the 12 months prior to filing a complete application does not put a patent at risk due to lack of novelty or an inventive step, but secret use within the same period is grounds for invalidation of the patent.

Item 29 of Schedule 6 to the Raising the Bar Act addresses this inconsistency between secret and public use of an invention by amending the Patents Act to introduce subsection 9(e) and allowing that any use of an invention will not be taken to be secret use, as long as a complete application for the invention is made within the prescribed period.

This item prescribes a period of 12 months from the first use that would have, but for paragraph 9(e), constituted a secret use.

This means that to benefit from this provision the complete application must be filed within 12 months from the first secret use being a use that is not included in any of the exclusions specified in section 9 paragraphs (a) to (d).

Item 7 – regulations 2.2 – 2.3

This item consequentially amends regulations 2.2 to 2.3 to account for the amendments made by items 32 and 33 of Schedule 6 to the Raising the Bar Act.

As a general rule, an invention is not novel and hence unpatentable, if the invention has been published or publically used before the priority date. However, a number of exceptions are provided by section 24 of the Patents Act, including a general ‘grace period’, where the patentability of the invention is not affected by public use or publication of the invention by, or with the consent of, the patentee within the 12 months prior to filing the complete patent application. The further requirements for the grace period are currently prescribed under regulations 2.2 and 2.3 of the Patents Regulations and cover the circumstances where the disclosure of the invention occurred without consent, through disclosure to or by a learned society, at or during a recognised exhibition, and for the purposes of reasonable trial.

This item remakes the grace period regulations consistent with the terminology of the Act. It also restructures the existing provisions which were complicated and difficult to navigate. The new provisions should be more logical and easier to follow.

Note that the new provisions delete the reference to the date the information was ‘first’ made publically available: eg compare existing subregulation 2.3(1A) to new subregulation 2.2C(3). The reference to ‘first’ is redundant, as once something is made publically available (through whatever means) it remains publically available.

Additionally, retaining the ‘first’ could result in possible unintended consequences. As the existing regulation 2.3 has been broken up and split over several new provisions, there is the possibility that the provision could be interpreted to create multiple ‘first’ disclosures – eg a first disclosure with consent under regulation 2.2C and a first disclosure without consent under 2.2D – which would create multiple dates. To avoid this, the provision removes the reference to ‘first’.

Item 8 – paragraphs 3.1 (2) (a) and (b)

This item amends the Patents Regulations to require that an applicant must provide specific information pertaining to the identity of the person entitled to the eventual grant of the patent at the time of filing the patent application.

When an applicant files a patent application there are a number of documents that are required by the Patent Office before the patent can be granted, including the notices referred to in subregulation 3.1(2) of the Patent Regulations. These are notices in which the applicant states who is entitled to the grant of the patent, and their right to claim priority, and are collectively known as a Notice of Entitlement. Such information provides the general public and competitors with an early indication of the basis of entitlement claimed and encourages early resolution of entitlement issues.

Currently, a Notice of Entitlement is only required to be filed prior to acceptance of the patent application. This enables applicants to defer exposing the basis of their entitlement to third parties and can result in delays in accepting applications because the sole reason that an application cannot be accepted is because a Notice of Entitlement is not yet on file. The Commissioner must then issue an additional report requesting that the applicant provide the notice. This delay is not in the public interest as it may frustrate the legitimate concerns of third parties to resolve issues of ownership and unnecessarily increases the period of uncertainty for members of the public trying to determine the outcome of an application.

This item removes the notice of entitlement from those documents that need only be required before acceptance.

The intent is that a statement of entitlement is then included as a mandatory requirement for a request for examination of a patent application, as part of the ‘approved form’ requirement in existing subregulation 3.15(2). Therefore the applicant would have to provide this information prior to examination as part of the information necessary to form a valid request for examination.

Item 9 – regulation 3.1A

This item amends the Regulation to provide that for a PCT application the applicant is taken to be the nominated person. This remakes repealed subregulation 8.2 (5).

A number of different types of complete patent application are provided for under the Patents Act. These include standard applications, Convention applications

(applications claiming an earlier priority date from an application filed in another Convention country⁴) and PCT applications (international applications made under the *Patents Cooperation Treaty 1970*), which are treated as complete applications under the Patents Act.

Currently the provisions dealing with these different types of application are located in different parts of the Patents Act and are unnecessarily complicated and difficult to navigate. Also the Patents Regulations govern many administrative and procedural requirements for PCT applications, however, the existence of such regulations is not well signposted in the Patents Act and readers of the Act may inadvertently miss a procedural requirement imposed in the regulations.

Items in Schedule 6 to the Raising the Bar Act restructure the existing substantive requirements for complete applications by repealing Chapter 8 of the Patents Act and relocating the provisions for Convention and PCT applications with the equivalent provisions for standard applications. The new sections of the Patents Act also more clearly flag the existence of regulations. Item 34 of Schedule 6 to the Raising the Bar Act provides a new power to prescribe special rules for Convention and PCT applications in Chapter 3 of the Patents Act. Consequentially, a number of existing regulations require remaking.

Item 10 – subregulation 3.2A (3)

Subregulation 3.2A 3(3) allows the Commissioner to direct the applicant to comply with the formality requirements in the Regulation. A similar power for the Commissioner to direct an applicant to comply with the formalities for PCT applications is provided in new subregulation 3.2C (4) (see item 13). This item amends regulation 3.2A to exclude PCT applications consequential to item 13.

Item 11 – regulation 3.2AB

This item amends the regulation to provide for the title of a PCT specification. This item remakes existing regulation 8.1A

Consistent with the changes at item 9 this item restructures the provisions regarding PCT applications to make them clearer and more user-friendly.

Item 12 – paragraph 3.2B (1) (d)

This item amends the regulation to update a reference to another regulation. Subregulation 8.5 (2) is repealed and remade as regulation 3.11, so the reference has been updated accordingly.

⁴ Convention countries are countries that are signatories to the Paris Convention for the Protection of Industrial Property 1883 or the Agreement on Trade Related Aspects of Intellectual Property Rights.

Item 13 – regulation 3.2C

This item amends the Patent Regulations to require PCT applications to meet certain formality requirements and to permit the Commissioner to carry out a formalities check.

Currently, non-PCT applications are subject to formalities checks under regulations 3.2A and 3.2B of the Patents Regulations. This enables the Commissioner to require the patent applicant to rectify minor issues relating to the format, legibility and completeness of the patent application.

Under Rule 51bis of the PCT Regulations, the Commissioner has the power to institute a similar formalities check for PCT applications. However, there is no existing national legislation implementing a formalities check for PCT applications.

The amendment ensures that simple formality errors made by the applicant and not addressed in the international phase would be found and rectified once the application has entered the national phase.

The amended Regulation is drafted so that it can apply to applications that enter national phase according to the requirements of the PCT that are reflected in relevant provisions of old subsection 89(3) and new subsection 29A(5). This ensures that the provisions apply to any PCT application that enters national phase after commencement, regardless of whether the original application was made with the International Bureau before commencement. This provides a simpler system for applicants to comply with, as they will only have to check the date the application entered Australian national phase, rather than having to look back to find the original application date (which may have been years ago).

Items 14 and 15 – regulation 3.5 (heading) and subregulation 3.5 (1)

Regulation 3.5 provides for the filing date of patent applications. These items amend regulation 3.5 to exclude PCT applications consequential to item 16. The new regulation 3.5AA in item 16 provides for the filing date of PCT applications.

Item 16 – regulation 3.5AA

This item provides for the filing date of a PCT application.

Currently, the international filing date of a PCT application is governed by subregulation 8.3(5), so that the filing date of a PCT application under section 88(4) of the Patents Act is modified by the regulations. Item 35 of Schedule 6 to the Raising the Bar Act amends section 30 of the Patents Act to include that PCT applications are taken to be made on the filing date determined under the regulations. This item then remakes existing 8.3 (5) under the new section 30 while clarifying the dates that may apply, including a date taken to be the filing date under section 10 of the Act.

This improves transparency by flagging the existence of regulations and by co-locating the provisions dealing with PCT and domestic applications.

Consistent with the changes at item 9 this item restructures the provisions regarding PCT applications to make them clearer and more user-friendly.

Item 17 – subregulation 3.5A (1)

Regulation 3.5A provides for the filing date of incomplete specifications. This item consequentially amends regulation 3.5A to exclude PCT applications. As regulation 3.5A references regulation 3.5, which now applies only to non-PCT applications, regulation 3.5A should also not apply to PCT applications. An equivalent provision is not required for PCT applications because PCT Rule 20 provides for missing parts in international applications.

Item 18 – regulation 3.5AB to 3.5AG

This item provides generally for PCT applications to:

- be taken to be applications under the Patents Act
- be amended
- meet certain requirements
- be made in a certain period
- be accompanied by translations and other documents

It also provides for Convention applications to contain certain particulars.

Consistent with the changes at item 9 this item restructures the provisions regarding PCT applications to make them clearer and more user-friendly.

Regulation 3.5AB remakes existing subregulation 8.1(2). Regulation 3.5AC remakes existing subregulation 8.3 (1BA), subsection 89(4) and the obligations under Rule 13bis.4 provided in subsections 88(5) and 88(6) that were repealed under item 67 of Schedule 6 to the Raising the Bar Act. Regulation 3.5AD remakes existing subregulation 8.1 (3). Regulation 3.5AE remakes existing subregulation 8.1 (4). Regulation 3.5AF remakes existing subregulations 8.2 (1) – (3). Regulation 3.5AG remakes existing subregulation 8.6 (1), with an updated reference to ‘intergovernmental authorities’ to the extent permitted by Rule 4.10 of the PCT to cover regional patent offices such as the European Patent Office.

Item 19 – regulation 3.5B

This item consequentially amends regulation 3.5B to update the reference to state sub-offices. As item 81 of Schedule 6 to the Raising the Bar Act provides the Commissioner with the discretion to establish or abolish state sub-offices, this item has been amended to allow for the possibility that there may be no state sub-offices at some point in the future.

Item 20 – regulation 3.11

This item amends the regulations to provide for the period in which a Convention application may be made.

If an applicant files a first application in one Convention country, Article 4 of the Paris Convention provides that they may use the priority date of this application for subsequent applications for the same invention filed in other Convention countries. Under Article 4.C(1) of the Convention, the period in which the applicant may do this is twelve months from the date they filed the first application. This obligation is currently implemented in Australian domestic law, with section 94 of the Patents Act and subregulation 8.5(2) of the Patents Regulations providing for the twelve month period.

Item 67 of Schedule 6 to the Raising the Bar Act repeals section 94 of the Patents Act. Item 42 of Schedule 6 to the Raising the Bar Act amends section 38 of the Patents Act to provide a new power to prescribe the period in which a Convention application may be made. A similar period is prescribed under the new subsection 29B (2). The time period for both is the same and the period is prescribed underneath the same regulation for convenience.

Items 21 to 23 – regulation 3.14

These items make consequential changes to references to sections of the Act resulting from changes made in the Raising the Bar Act.

Item 24 – regulations 3.14C and 3.14D*Disregarding Convention applications*

This item amends the regulations to prescribe the period in which an earlier Convention or PCT application may be disregarded in certain circumstances.

Currently, where multiple basic applications are made in respect of the same invention, Article 4B (4) of the Paris Convention for the Protection of Intellectual Property states that an earlier basic application may be disregarded for the purposes of determining priority dates if the earlier application has been withdrawn, abandoned or refused without being published. The Convention applicant may seek to rely on the later of the basic applications, rather than the earlier basic application. In these circumstances, the Convention applicant would want the earlier basic application to be disregarded – otherwise it could affect the priority date of the application and render any subsequent patent invalid.

Section 96 of the Patents Act permits the Commissioner to disregard the earlier basic application if the Commissioner is specifically asked to disregard the relevant application by the Convention applicant. This places an unnecessary burden on the applicant and leaves the applicant's IP right vulnerable in case of an administrative

error, such as forgetting to request the Commissioner disregard the earlier basic application. Item 67 of Schedule 6 to the Raising the Bar Act repeals section 96 of the Patents Act. Item 44 of Schedule 6 to the Raising the Bar Act introduces new section 43(5) of the Patents Act, which provides that certain applications are automatically taken, for the purposes of the Act, to have never been made.

Paragraph 43 (5) (b) provides for the regulations to prescribe a time period. New regulation 3.14C prescribes a time period of more than 12 months before the Convention application is filed.

Digital Access Service

This item amends the regulation to prescribe the documents and means by which applicants may provide access to an earlier basic application if required by the Commissioner.

When a Convention application relies on a basic application filed in another Convention country, the Commissioner often needs to be able to access that basic application to determine if it entitles the Convention application to the earlier claimed priority date. Historically, this meant that the applicant had to file copies of the basic application with the Commissioner. WIPO has recently developed its Digital Access Service (DAS), which is a centralised online repository through which an applicant can make their basic applications and other priority documents available to all Patent Offices.

Currently, section 8 of the Patents Act and regulations 1.6 and 1.6A govern the requirements for making such documents available to the Commissioner, including excusing the requirement to file documents with the Commissioner if the documents have been made available through services such as DAS. Section 95(3) of the Patents Act and subregulations 8.6(2) and (3) and 8.6A make similar provision with respect to Convention applications.

Items 27 and 67 of Schedule 6 to the Raising the Bar Act repeal sections 8 and 95 of the Patents Act respectively. Item 45 of Schedule 6 to the Raising the Bar Act introduces new section 43AA which allows the Commissioner to require that certain documents associated with basic applications be made available and replaces repealed sections 8 and 95 of the Patents Act.

The Regulation allows an applicant to meet the requirement by filing the document or making it available through an approved digital library such as DAS.

Items 25 and 26 – regulation 3.15

This item amends the regulations to provide that a PCT applicant cannot request examination until they have entered national phase. This ensures that they cannot request that the Commissioner examine and amend their application until they have provided the Commissioner with a copy of the application and paid the appropriate fees.

Item 88 of Schedule 6 to the Raising the Bar Act remade subsection 89 (3) as the new subsection 29A (5), which now provides the requirements for national phase entry (ie that the relevant documents are filed and the relevant fees are paid).

However, due to an oversight, the new paragraph 228(2)(i) inserted by Item 90 of Schedule 6 to the Raising the Bar Act was only phrased as requiring a PCT applicant to meet the requirements (National Phase Entry) by a certain period. It does not provide the Commissioner with power to refuse early requests from the PCT applicant before they have met the requirements of national phase entry. This could result in applicants requesting examination before they have paid their fees or provided a copy of the application to be examined.

This item amends the regulations to preserve the existing situation that the applicant may not request examination until they have completed the requirements of national phase entry.

Item 27 – subregulation 3.16 (2)

This item amends to the Patent Regulations to reduce the time period for an applicant to request examination of their patent application, after being directed to do so by the Commissioner.

Australia has a system of deferred examination of standard patent applications where examination of an application does not occur unless requested by the applicant. The applicant can request examination at any time after filing (or national phase entry for PCT applications), but generally applicants wait until they receive a direction from the Commissioner to request examination under subsection 44 (2).

Currently, the applicant has six months to request examination following the Commissioner's direction. This period delays commencement of examination; something that is not always in the interests of the public and competitors, who remain uncertain about where they have the freedom to operate.

This item reduces the period of uncertainty by requiring the applicant to request examination within 2 months of the Commissioner issuing her direction. This strikes a balance between giving the applicant sufficient time to decide whether they wish to have their application examined and reducing delays that are not in the public interest.

Item 28 – regulations 3.17A to 3.17C

This item repeals redundant regulations regarding certain patentability searches and substitutes new regulations 3.17A to 3.17C which provide for matters related to the examination of PCT applications.

Item 48 of Schedule 6 to the Raising the Bar Act repeals sub-sections 45(3) to (5) of the Patents Act and item 60 repeals section 101D. These sub-sections were introduced

as a means of ensuring that patent examiners had access to patentability searches done by foreign patent offices to assist them during examination.⁵

However, these provisions are no longer necessary as most major patent offices now publish this information on their websites, and the Commissioner can access this information directly from the internet.

As a consequence of the repeal of sections 45(3) to (5) and 101D, regulations 3.17A and 3.17B are repealed.

Section 45 of the Patents Act governs the Commissioner's examination of, and report on, a patent application. However, aspects of the PCT system require that PCT applications be treated differently and currently subregulations 8.3(1AA) to (1AC) of the Patent Regulations modify the operation of section 45 of the Patents Act. In effect, the modifications ensure that if the Commissioner reports to the applicant that they are required to provide certain information and the applicant fails to comply, then the Commissioner is not required to examine and report on the application under section 45(1) of the Patents Act until such time as the applicant complies with the Commissioner's request. Furthermore sub-regulation 8.2(4) prohibits the Commissioner from directing an applicant to request examination if the requirements for entering the national phase have not been met.

However, currently it would not be clear to a reader of the Patents Act that the Patent Regulations would modify the Act in this way. Items 46 and 47 of Schedule 6 to the Raising the Bar Act amends section 45 of the Patents Act to provide that the Commissioner may decline to examine a PCT application where the prescribed requirements have not been met. Also with the repeal of Chapter 8 of the Act, and the consequential repeal of the corresponding regulations, new regulations will be required to prescribe requirements under new section 45(1A) of the Patents Act. Regulations 3.17B and 3.17C are made for this purpose. Subregulation 8.2(4) is remade as regulation 3.17A.

Consistent with the changes at item 9, this item restructures the provisions regarding PCT applications to make them clearer and more user-friendly. The Regulation remake the existing regulations in a more logical and convenient place in the legislation.

Item 29 – subregulation 3.18(2)

Item 29 deletes a reference in subregulation 3.18 (2) to section 48 of the Act. Section 48 deals with modified examination and is repealed by item 50 of Schedule 6 to the Raising the Bar Act, as discussed in items 32 to 35 below.

Item 30 – paragraph 3.18(2)(a)

⁵ For standard patents under sub-sections 45(3) to (5) of the Patents Act and regulations 3.17A and 3.17B of the Patent Regulations. For innovation patents under section 101D of the Patents Act and regulations 9A.2A and 9A.2B of the Patent Regulations.

This item consequentially amends the regulations to refer to the new restructured provisions of the Act dealing with convention and PCT applications.

Item 31 – paragraph 3.18 (2) (f)

Item 31 repeals paragraph 3.18 (2) (f). Subregulation 3.18 (2) requires the Commissioner to report on certain matters when examining a patent application. Under section 89 (3), a PCT applicant cannot ask for anything to be done under the Act unless certain requirements have been met. Once these requirements have been met, the application is considered to have entered the “national phase”. Paragraph 3.18 (2) (f) requires the Commissioner to report on whether the applicant has met those requirements.

As discussed under item 9, the Raising the Bar Act restructures the provisions relating to PCT applications. Item 26 introduces subregulation 3.15 (3) which provides that a person cannot request examination unless the PCT application has entered the national phase. This item is consequential to those changes.

In place of the repealed provision, this item inserts a new provision which permits the Commissioner to examine and object to a PCT application on formality grounds. This item is consistent with the new PCT formality check in new regulation 3.2C. Although the PCT formalities check will usually occur before examination, formality errors may be missed or may be introduced through later amendments. The Commissioner should have the ability to require the applicant to resolve these issues the same as if they were raised during the initial formalities check.

Items 32 to 34 – subregulations 3.18 (3) to (4) and 3.19 (3)

These items amend the Patent Regulations to repeal redundant provisions and references to repealed sections 46 to 48 of the Patents Act.

Currently where a recognised foreign patent office has granted a patent on an equivalent application, an applicant can request modified examination of their Australia application. Under modified examination, the Australian examiner relies on the examination done by the foreign patent office in respect of a number of patentability issues. An applicant who wishes to rely on modified examination but whose foreign patent has not yet been granted can request deferment of examination.

However, the provisions for modified examination were not widely used and added complexity to the legislation without corresponding benefit. Accordingly, items 49 and 50 of Schedule 6 to the Raising the Bar Act repealed the provisions for modified examination. Accordingly, consequential amendment of the regulations is required to remove references to the repealed provisions.

Item 35 – regulations 3.20 and 3.21

This item repeals the regulations that prescribe various matters for deferred examination and modified examination. The policy reasons for this change and the intended operation of the provision are the same as items 32 to 34 above.

Items 36 and 37 – regulation 4.1 and paragraph 4.1 (f)

These items consequentially amend the regulations to take account of the new restructured provisions for PCT applications.

Regulation 4.1 is amended to update the reference from section 53 to the new subsection 53(1). Paragraph 4.1 (f) is modified to remove the reference to PCT applications. Item 56 of Schedule 6 to the Raising the Bar Act amended section 53 so that it didn't apply to PCT applications. Accordingly, it is no longer necessary to exclude them from the corresponding regulations.

Item 38 – paragraphs 4.3 (2) (b) and (c)

This item amends the regulations to allow the Commissioner to keep a document confidential if it contains sensitive personal information, or in other appropriate circumstances.

Currently under sections 54 and 55 of the Patents Act, most documents related to a patent application become open to public inspection (OPI) 18 months after the priority date of the application. Occasionally patent applicants and others provide information to the Patent Office that is of a highly sensitive nature and which may not be appropriate for general public inspection. For example, information may be provided to the Commissioner to justify an extension of time and could include details of serious medical conditions, marital difficulties and resulting depression. In such circumstances, general availability to members of the public, with no direct interest in the matter, is not justified.

While documents may be prescribed for the purposes of subsection 55(2) of the Patents Act, so that they do not become OPI, the regulations only account for documents that are subject to legal professional privilege and documents that the applicant was compelled to provide under section 210(c) of the Patents Act via a Notice to Produce. Public access to sensitive information that is provided voluntarily to the Commissioner cannot be restricted or revoked.

This item broadens the Commissioner's power to make a document non-OPI so that any information that is not appropriate for publication is not published or available to the public, regardless of whether it was subject to a Notice to Produce or not.

The amendment is not intended to require the Commissioner to vet all filed documents for sensitive information, as this would impose an unreasonable administrative burden. Rather, if the Commissioner becomes aware of such information in the ordinary course of her duties, the Commissioner would then be

able to make the document non-OPI. A decision made under 4.3(2) (b) would remain subject to merits review by the AAT under subparagraph 22.26 (2) (a) (iia).

To ensure appropriate access to non-OPI information where the public interest warrants it (for example when the information is necessary to determine a matter being disputed before the Commissioner), the Commissioner may use their existing power under paragraph 56 (1) (b) of the Act to order inspection of a non-OPI document. To ensure accountability for decisions to grant or refuse inspection, item 86 of Schedule 6 to the Raising the Bar Act also makes these decisions AAT reviewable.

Item 39 – regulation 4.4

This item amends the regulations to provide for the inspection and publication of PCT applications.

Sections 90 and 92 of the Patents Act provide for the circumstances in which a PCT application is taken to be open to public inspection. However, regulation 8.3(1C, (1D) and 1E) modify those sections.

Currently, it would not be clear to a reader of the Patents Act that the Patents Regulations would modify the Act in this way. Item 67 of Schedule 6 to the Raising the Bar Act repeals Chapter 8 of the Act including Sections 90 and 92 and Item 58 inserts new section 56A which provides that the Patent Regulations may make provision for the publication of information pertaining to PCT applications. New regulations are required to be made under new section 56A of the Patents Act.

The Regulation remake subregulations 8.3 (1C) - (1E). Consistent with the changes at item 9, this item restructures the provisions regarding PCT applications to make them clearer and more user-friendly.

Items 40 and 41 – regulations 6.1A and 6.2A

These items amend the regulations to provide for the particulars that the Commissioner must enter into the Register when granting a patent.

Currently, a patent is granted by ‘sealing’ the patent – this is the physical application of a seal to paper (the patent deed) by the Commissioner. Items 60 to 64 of Schedule 6 to the Raising the Bar Act amend section 61, 62 and 66 of the Patents Act to provide for the Commissioner to grant a patent by registering the prescribed particulars of the patent in the Register of Patents.

These items provide the details that are included in the Register at grant – principally the date the patent is granted and any other particulars considered appropriate by the Commissioner (these would ordinarily be the same particulars that currently appear in the register).

Item 42 – subregulation 6.3 (10)

Items in Schedule 6 to the Raising the Bar Act restructure the existing substantive requirements for complete applications by repealing Chapter 8 of the Patents Act and relocating the provisions for Convention and PCT applications with the equivalent general provisions for patent applications, as discussed under item 9. This item makes a consequential change in referring to the relevant section of the Act.

Item 43 – subregulation 6.3 (11)

This item amends the regulations to correct an anomaly that occasionally occurs in calculating the date of a patent.

The date of a patent is governed by section 65 of the Patents Act and regulation 6.3 of the Patent Regulations. The date of the patent is significant because the term of the monopoly of the patent starts from the date of the patent.

An inconsistency has arisen in how PCT and non-PCT applications are treated in the situation where the applicant mistakenly fails to file an application within the priority period. In some situations, it is possible for a PCT patentee to receive a later date for the patent, and hence a longer patent term, than a non-PCT patentee in similar circumstances.

For non-PCT applicants who fail to file their application within the relevant period (see sections 38 and 94), the Commissioner may extend the time to file under section 223. Ordinarily, the date of the patent is the date of filing the complete specification (section 65(a)), which is broadly the date that an adequate complete specification is filed with the office (regulations 3.5 and 3.5A). However, to ensure that the applicant does not benefit from their delay in filing the application, subregulations 6.3(9) and (10) provide that the date of the patent is at the end of the priority period – ie when they should have filed the application, not when they actually did. This ensures that they do not get a de facto extension of the patent term due to their own error.

Rule 26bis.3 of the PCT Regulations provides for a similar situation for a PCT application. If a PCT applicant files outside the priority period, they still receive an international filing date, but usually lose their right of priority. If, however, the international filing date is outside the priority period by less than 2 months, the receiving Office can restore the right of priority in certain circumstances (broadly similar to some of the circumstances for an extension of time under section 223). Although priority is restored, the international filing date remains the same – ie up to two months later than the end of the priority period. Section 88(4) of the Act deems the filing date of the PCT application to be its international filing date. However, for PCT applications there is no equivalent to subregulations 6.3(9) and (10) prescribed for section 65(b). This means that the filing date (and hence the international filing date – which may be up to 2 months outside the priority period) is the date of the patent under section 65(a).

The net effect of this is that the PCT applicant who mistakenly filed late may have a date of the patent that is up to 2 months later than an equivalent non-PCT applicant

who mistakenly filed late on the same day in similar circumstances. As a result the PCT applicant would receive a de facto extension of their patent term of up to 2 months.

This is undesirable. Accordingly, the regulations provide that the date of the patent, where priority is restored under Rule 26bis.3, is calculated in the same manner as where an extension of time to file late is granted under section 223.

Note, however, that when a receiving Office restores priority, Rule 49ter.1 of the PCT Regulations provides that in certain circumstances the Commissioner, or a court, may find that a restoration of priority was not effective. In such circumstances, as the application would lose its right of priority, it would be inappropriate to reset the date of the patent to the end of the priority period. The date of such a patent will remain the international filing date and the new regulations provide for this.

The Regulation also recognise that restoration of priority may also be granted by the Commissioner under Rule 49^{ter}.2 or by the grant of an extension of time under section 223 that has the same effect.

Item 44 – regulation 6.4

This item is consequential to the amendments in items 60 and 62 of Schedule 6 to the Raising the Bar Act. As patents will no longer be granted by sealing a physical patent deed it will no longer be necessary to issue a duplicate deed. Consequently it is unnecessary to provide for requests for duplicate deeds to be in the approved form.

Item 45 – chapter 8

This item repeals Chapter 8.

Consistent with the changes at item 9 this item restructures the provisions regarding PCT applications to make them clearer and more user-friendly. Item 67 of Schedule 6 to the Raising the Bar Act repealed Chapter 8 of the Act. Accordingly, it is necessary to repeal chapter 8 of the regulations consequentially.

Item 46 – regulations 9A.2A and 9A.2B

This item omits these regulations consequentially to the repeal of section 101D in item 68 of Schedule 6 to the Raising the Bar Act. The policy reasons for this change are the same as item 28.

Item 47 – paragraphs 9A.4 (d) and (e)

This item consequentially amends paragraph 9A.4 (d) to refer to the new section 43AA of the Act, which was inserted by item 45 of Schedule 6 to the Raising the Bar Act.

This item also consequentially amends paragraph 9A.4 (e) to remove reference to section 101D. Section 101D is repealed by item 68 of Schedule 6 to the Raising the Bar Act.

This item introduces paragraph 9A.4 (f) and (g) which provide a longer period for completing examination of an innovation patent in certain circumstances. Paragraph (f) deals with the situation where an applicant is given an opportunity to be heard. If the patentee and the examiner reach an impasse on the progress of an examination, the patentee will often request a hearing to reconsider the examiner's original decision to raise a ground of objection. The process of having the hearing and making the decision can be lengthy and may go beyond the date that examination is required to be completed by. Similar to the changes at items 62 and 64 below, this amendment fixes this problem by providing a period of 3 months from the date of the Commissioner's decision for the examination to be completed. Where the Commissioner decides to uphold the ground of objection after the hearing, the 3 month period is intended to permit the patentee time to consider overcoming the objection through an amendment.

Paragraph (g) is consequential to the new power to revoke certification of an innovation patent under new section 101EA (see item 69 of Schedule 6 to the Raising the Bar Act). If the Commissioner revokes a certification that should not have been granted, the 3 month period permits the Commissioner to continue examination and resolve the issues.

Item 48 – subregulation 10.1 (1)

This item amends the regulations to prevent a PCT applicant from requesting an amendment until they have entered national phase. The policy for this change, and the intended operation, is the same as for items 25 and 26 above.

Item 49 – paragraph 10.2 (1) (d)

Subregulation 10.2 (1) requires the Commissioner to report on a request to amend a specification. During the international phase of a PCT application, the applicant may make amendments under Article 34 of the PCT. These become part of the PCT application. Paragraph 10.2 (1) (d) allows the Commissioner to report on whether a copy of the international preliminary examination report, which may include amendments made during the international phase, has been provided. The current wording suggests this is to be reported on at the same time as other matters. This is inefficient, as the Commissioner may be reporting on a specification that has been superseded.

Item 49 amends paragraph 10.2 (1) (d) so that the Commissioner can notify the applicant that the international preliminary examination report has not been provided. The changes will move the notification of a lack of the international preliminary examination report from examination to administration within IP Australia, which will provide greater efficiency for both IP Australia and for patent applicants.

Items 50, 51 – sub-subparagraph 10.2 (3) (c) (ii) (C), and subparagraph 10.2 (3) (c) (iii) note

These items provide consequential amendments to update references to sections of the Act that have changed with the restructure of the provisions governing PCT applications.

Item 52 – Regulation 10.5

Item 50 of Schedule 6 to the Raising the Bar Act repealed Division 2 of Part 2 of Chapter 3, including section 48 that dealt with modified examination of standard patent applications. Item 52 removes the obsolete reference to section 48 from subregulation 10.5(1)(b).

Item 53 – regulation 10.6B

This item provides that grants of leave to amend are revoked in certain circumstances. Subregulations (1) and (2) are consequential to the Commissioner's new power to revoke acceptance of a standard patent application (item 54 of Schedule 6 to the Raising the Bar Act) or to revoke certification of an innovation patent (item 69 of Schedule 6 to the Raising the Bar Act). The usual practice in examination when amendments are proposed is to grant leave to amend when all issues are resolved and the application is accepted or certified. However, if it later turns out that the Commissioner should not have accepted or certified the application or patent, then it is necessary to 'undo' those amendments so that examination can continue. If the issue can be resolved, leave to amend would then be granted when the rectified application or patent was re-accepted or re-certified.

Subregulation (3) follows for the same policy reasons as given for the new power to revoke acceptance or certification. If due to an administrative oversight, leave to amend was granted in error, for example a relevant statement of amendments was overlooked, when an issue with the amendments remained outstanding, the amendment would be revoked and the Commissioner would address the outstanding issues with the amendment. This will provide an inexpensive and straightforward process for the Commissioner to rectify administrative errors in grants of leave to amend.

The power is discretionary and the Commissioner will not be obliged to revoke a grant on request of the applicant or patentee or a third party. It will not be used as an avenue for a third party to seek review of or oppose an amendment as other avenues for this are already available under the legislation.

Item 54 – regulation 10.7

This item provides for the process for rectifying the Register.

Currently, regulation 10.7 of the Patents Regulations allows certain corrections to be made to the Register, or to a patent, including as a result of a clerical error or obvious mistake. With the amendments made to sections 61 and 62 of the Patents Act, by items 60 and 61 of Schedule 6 to the Raising the Bar Act and the insertion of section 191A by item 79, for rectification of patents and rectification of the register, including under all the circumstances provided in regulation 10.7, will be governed by section 191A.

Regulation 10.7 is therefore amended to provide that an application for rectification under section 191A must be in the approved form.

It also provides that the Commissioner must publish a notice of certain requested rectifications, and in those cases refrain from rectifying the Register for a period of two months and until an interested party is heard. This is to ensure that any party with a legitimate interest in the rectification is able to become aware of the rectification and be heard by the Commissioner either under subsection 191A (4) or regulation 22.22. However, if the Commissioner is satisfied that an application for rectification would not be granted and should not be made, the Commissioner is not required to publish the request filed under section 191A.

In making a determination on the application filed under s191A, the Commissioner would be able to seek further information from any person for the purposes of considering the application. The intent of this is to ensure that the Commissioner can request information to determine if the rectification can properly be made.

Item 55 – regulation 11.1

This is a consequential amendment to the change in item 5. The reference to Convention countries is changed from the reference to the repealed Schedule 4 to the new regulation 1.4.

Item 56 – subregulation 12.1 (1)

This item consequentially amends the regulations to replace a reference to ‘sealing’ with a reference to ‘granting’. This is because patents will no longer be granted by physically sealing a physical patent deed – see items 60 and 62 of Schedule 6 to the Raising the Bar Act.

Item 57 – regulation 13.1C

This item consequentially amends the regulations to remake existing subregulation 8.3 (2).

Section 141 of the Patents Act governs the circumstances in which a patent applicant may withdraw their application. However, for PCT applications, section 141 is

modified by subregulation 8.3(2) of the Patent Regulations. A reader of the Patents Act would not be aware of the modifications by the Regulation.

Item 76 of Schedule 6 to the Raising the Bar Act amends section 141 of the Patents Act to provide that the Patents Regulations may prescribe circumstances in which a PCT application is withdrawn, or is taken to be withdrawn. Item 11 of Schedule 3 to the Raising the Bar Act amends subsection 141(1) of the Patents Act in respect to non-PCT applications. However, it is intended that the conditions of amended subsection 141(1) of the Patents Act should apply to PCT application, along with the requirements of current subregulation 8.3(2) of the Patent Regulations. Also, Chapter 8, and thus regulation 8.3, of the Patent Regulations is repealed by item 45 above.

Item 58 – regulation 13.2

This item consequentially repeals regulation 13.2.

Currently, paragraph 142(2)(c) of the Patents Act deals with the lapsing of applications that have been deferred under section 46 of the Act. Regulation 13.2 of the Patents Regulations prescribes the period for the purposes of paragraph 142(2)(c) of the Patents Act.

Item 49 of Schedule 6 to the Raising the Bar Act repeals section 46 of the Patents Act. Similarly, item 77 of Schedule 6 to the Raising the Bar Act repeals paragraph 142(2)(c) of the Patents Act. As a consequence, regulation 13.2 of the Patents Regulations requires repeal.

Item 59 – paragraphs 13.4 (1) (a) and (b)

This item amends to the Patent Regulations to reduce the time period for an applicant to obtain the Commissioner's acceptance of an application after the first examination report.

When a patent application is examined under section 45 of the Patents Act and the examiner identifies an issue or issues that preclude acceptance at that stage, the Commissioner will provide a first examination report to the applicant outlining any objections the Commissioner has to the patent application. The applicant is then able to address these objections in response to the report and through amendments to the patent application. Currently, an applicant has 21 months, from the date of the first examination report, to resolve any issues and obtain the Commissioner's acceptance of the patent application, or the application will lapse. Applicants must also pay monthly response fees when responses to examination reports are filed more than 12 months after the date of the first examination report.

In order to provide earlier resolution of patent applications, the Regulation reduce the prescribed period for applicants to obtain acceptance to 12 months from the date of the first examination report.

Item 60 – paragraph 13.4 (1) (c)

This item omits a provision that dealt with modified examination. Modified examination is being discontinued (see items 49 and 50 of the Raising the Bar Act) and so this provision is being repealed consequentially.

Item 61 – subparagraph 13.4 (1) (f) (ii)

This item amends this subparagraph to update the reference section 36 (1) (c). This is consequential to the changes at item 40 of Schedule 6 to the Raising the Bar Act.

Items 62 and 64 – paragraph 13.4 (1) (g) and subregulation 13.4 (3)

These items amend regulation 13.4 to provide for an extended acceptance period in certain circumstances.

Paragraph (g) provides for a longer acceptance period if the Commissioner gives the applicant an opportunity to be heard to address outstanding objections. Paragraph (ga) provides for a longer acceptance period where acceptance is revoked under the new section 50A of the Act. The policy reasons for both of these changes, and the intended operation of these provisions, is the same as item 47.

Item 63 – paragraph 13.4 (1) (k)

This item amends the regulations consequentially to pick up a reference to the new section 43AA of the Act, as inserted by item 45 of Schedule 6 to the Raising the Bar Act.

Item 65 – regulation 13.5A

This item provides for the lapsing of PCT applications, by remaking existing subregulation 8.3 (3).

Section 142 of the Patents Act governs the circumstances in which a patent application lapses. However, for PCT applications, section 142 of the Patents Act is modified by subregulation 8.3(3) of the Patents Regulations. A reader of the Patents Act would not be readily aware of the modifications by the Regulation.

Item 78 of Schedule 6 to the Raising the Bar Act amends section 142 of the Patents Act to provide that the Patents Regulations may prescribe circumstances in which a PCT application lapses.

Consistent with the changes at item 9, this item restructures the provisions regarding PCT applications to make them clearer and more user-friendly.

Chapter 8, and thus regulation 8.3, of the Patent Regulations is repealed by item 45 above. Regulations for the purpose of new paragraph 142(2)(f) of the Patents Act are required to prescribe circumstances in which a PCT application will lapse.

While expressed in terms of compliance with section 29A(5), subregulation 13.5A(1) operates in the same way as modified section 142 where Article 11(3) of the PCT ceases to have effect in relation to the application under Article 24(1)(iii) or Article 39(2).

Subregulation 13.5A(2) operates in the same way as modified section 142 where Article 11(3) of the PCT ceases to have effect in relation to the application under Article 24(1)(ii). However the application will lapse under this provision only where Article 11(3) ceases to have effect before the requirements of subsection 29A(5) are met. This is intended to provide greater certainty for applications that have entered the national phase in Australia, particularly that they are not affected by certain decisions subsequently made under the PCT.

Item 66 – subregulation 22.2 (4)

This item is a consequential amendment to update references to section of the Act that have changed with the restructure of the provisions governing PCT applications.

Items 67 and 68 – regulation 22.2E and paragraph 22.2F (1) (a)

These items amend the regulation to remove response fees. This is consequential to item 59. As the acceptance period is reduced from 21 to 12 months, there is no need to have fees from responses more than 12 months from the examiner's first report.

Items 69 to 71 – paragraph 22.10AA (b) to subregulation 22.10AB (1)

These items amend the Patent Regulations to clarify that there may, or may not, be sub-offices of the Patents Office.

Currently the Patents Office has a head office in the ACT and sub-offices in each of the States. This structure dates from a time when most transactions with the Patents Office were conducted 'over the counter'. However, the Patents Office is continually expanding its e-commerce channels and foresees that in the future there may be no need for sub-offices.

Items 81 and 82 of Schedule 6 to the Raising the Bar Act amend the Patents Act to provide the flexibility for the Patents Office to withdraw the services of sub-offices in the future. The Regulation consequentially amends the Patents Regulations to ensure consistency between the Act and Regulations in regards to this matter.

Item 72 – regulation 22.15

This item consequentially amends regulation 22.15 to account for the new section 43AA. Section 43AA along with new subregulation 3.14B (1) provide for translations of documents relating to basic applications if required by the Commissioner. Regulation 22.15 is amended consequentially to exclude documents prescribed under section 43AA.

The amendment also removes the general requirement that a specification be in English and clarifies that a document that is required to be in an approved form must be in English. Consequently specifications for domestic applications must still be in English, as these are required to be in the approved form. For specifications filed in other circumstances a translation of the original foreign language document is more appropriate and a related certificate of verification into English for the translation is also to be provided.

Item 73 to 76 – regulation 22.16

This item amends the regulations to provide for a more streamlined and modern systems for dealing with documents that are not in the approved form or do not substantially comply with the form requirements in Schedule 3. Occasionally documents filed with the Patent Office may not be in the approved form or may not comply with Schedule 3.

There are two problems with how the existing regulations deal with this situation. First, under existing regulation 22.16 the Commissioner may treat the document as not having been filed. However, under the current rules the Commissioner must also *return* the document to the person. This requirement does not make sense in modern electronic business environments, where the document may be data entered into an electronic form in one of IP Australia's electronic business channels, instead of a traditional paper document.

The amendments address this by requiring the Commissioner to 'notify' the applicant, instead of returning the document.

Second, the Commissioner may treat the document as having been filed, but may direct the person to do such things as necessary as to ensure the document will comply or accord with the relevant requirement (in practice, this would usually mean filing a corrected version of the document). However, the time period of 3 months for complying with such a direction is inconsistent with other similar provisions. For example, applicants are given 2 months under regulations 3.2, 3.2A and 3.5 to correct similar formality errors (noting that regulations 3.2, 3.2A and 3.5 are much more commonly used than the procedure in 22.16). There is no policy reason for this inconsistency, and minor formality errors should be simple to correct in a 2 month period.

The amendments address this by providing for a 2 month period in which to comply with a direction of the Commissioner.

The amendments further apply to a document that does not comply with the requirements of new regulation 22.15 (see item 72 above). This will ensure that a document that is in the approved form, but that is not in English will still be able to be dealt with. The amendments would clarify that the Commissioner can treat the document as filed, but direct the applicant to comply, thereby allowing applicants an opportunity to rectify the error.

Item 77 – regulations 22.22 and 22.23

This item amends the Patent Regulations to clarify that the Commissioner has the discretion to decide the means by which a person may be heard.

Under the patents legislation there are a number of provisions governing how the Commissioner must give parties an opportunity to be heard on matters in which they have an interest. However, regulations 22.22 – 22.24 specify in greater detail the requirements for certain hearings that the Commissioner must hold.

Hearings in relation to patents matters are conducted in a similar manner to those for design and trade marks matters, as discussed at item 3 above. Currently regulations 22.22 – 22.24 of the Patents Regulations prescribe matters regarding a party's right to be heard and the conduct of hearings. Currently the wording of these regulations may suggest that a 'right to be heard' requires the holding of an oral hearing.

For the same policy reasons as discussed at item 3 in regards to the designs changes, the changes seek to clarify that the Commissioner has the discretion to determine whether a hearing is conducted orally or in writing. They also clarify that the Commissioner must give at least 10 business days notice for a hearing.

As a result regulations 22.22 and 22.23 of the Patent Regulations are amended to clarify that:

- the Commissioner must, before exercising a discretionary power under the Act or Regulations adversely to a person, give the person a reasonable opportunity to be heard
- the Commissioner may either hear the person orally or in writing but the Commissioner is not be required to hold an oral hearing.

Item 78 – regulation 22.27

This item prescribes documents which, for the purposes of subsection 226(1) of the Patents Act, can be reproduced without infringing on the author's copyright.

Currently, section 226 of the Patents Act contains an exemption from copyright infringement for the reproduction in 2 dimensions of any part of a complete specification that is open to public inspection. Item 87 of Schedule 6 to the Raising the Bar Act amends section 226 to ensure communicating a document to the public is not an infringement of copyright. This is to ensure that the Patent Office and others can provide copies of patent documents that are open to public inspection to members of the public without infringing copyright.

Items 79 and 81 – schedules 1, 1A, 2, 2A and 4

These items consequentially amend the regulations to repeal certain Schedules.

Schedules 1, 1A, 2, and 2A to the Patents Regulations contain the text of various treaties that were required to be set out by previous subsections 228 (5) and (6). Setting out the texts imposed unnecessary costs on government in updating the regulations every time the treaties were amended. As the text of these treaties is easily accessible by other means, there is no reason to continue to retain them in the regulations. Accordingly, item 91 of the Raising the Bar Act repeals subsections 228 (5) and (6). These Schedules are repealed accordingly.

Similarly, Schedule 4 to the regulations currently contains a list of Convention countries. Again this imposes unnecessary costs on government when the regulations must be updated every time a new country joins the Paris Convention or the World Trade Organization. The changes to regulation 1.4 in item 5 above define a Convention country according to the current signatories of the Paris Convention and the current membership of the World Trade Organization, instead of listing the countries individually. Accordingly, Schedule 4 is repealed.

Item 80 – schedule 3 (heading)

This item consequentially amends the heading for Schedule 3, as both PCT and non-PCT applications are now required to comply with it as part of their respective formalities checks.

Item 82 – schedule 7, item 214

Item 79 of Schedule 6 to the Raising the Bar Act inserted section 191A to provide the Commissioner with the power to rectify the patent register.

Sections 191A(2) – (4) provides that on application, the Commissioner must make a declaration concerning entitlement of a granted patent on determining whether to correct entitlement details. Aside from the fact that this is conducted after patent grant, an application to the Commissioner to hear an entitlement issue under section 191A(2) is largely analogous to hearing an entitlement issue under sections 32 or 36. An application under sections 32 or 36 must be accompanied by a \$600 fee. As hearing an application under section 191A(2) would be conducted in a similar manner, the \$600 fee should also apply for hearing a matter under s191A(2). This item accordingly amends the fee items in Schedule 7 to the regulations to insert a \$600 fee for the Commissioner to hear a dispute under new section 191A(2).

Item 83 – schedule 7, item 214A

This item consequentially provides amendments to update references to sections of the Act that have changed with the restructure of the provisions governing PCT applications.

Item 84 – schedule 7, item 221

This item consequentially repeals a fee item for sealing a duplicate patent deed. As patents will no longer be granted by physically sealing patent deed, this fee is no longer required.

Item 85 – schedule 7, item 224

This item consequentially amends a fee item for amending an innovation patent. The fee item is more appropriately expressed as being for amending a complete specification relating to an innovation patent.

Item 86 – schedule 7, item 232

This item amends the regulations to remove the fee item for response fees. With the change in the acceptance period from 21 to 12 months (see item 59), response fees are no longer required.

Trade Marks Regulations 1995**Items 87 to 89 – paragraphs 4.4 (6) (b), 4.7 (2) (b) , 4.7 (2) (c) and regulation 4.15**

These items consequentially amend paragraph 4.4(6)(b) and regulation 4.7 to update the reference to state sub-offices. As item 129 of Schedule 6 to the Raising the Bar Act provides the Registrar with the discretion to establish or abolish state sub-offices, this item has been amended to allow for the possibility that there may be no state sub-offices at some point in the future.

Item 90 – regulation 17.28(2)(b)

This item is consequential to the amendment in item 113 of Schedule 6 to the Raising the Bar Act. Item 113 restructures the subsections of section 41. Paragraph 17.28(2)(b) of the Trade Marks Regulations refers to a paragraph of section 41 and so the reference needs to be updated.

Items 91 and 92 – regulation 17A.42F

These items provide consequential amendments to the Trade Marks Regulations to ensure that the Trade Marks Act and Trade Marks Regulations are consistent in regards to the jurisdiction of the courts to hear appeals of the Registrar's decisions.

Currently, below the High Court, the jurisdiction of courts to hear and decide appeals of the Registrar's decisions is restricted to the Federal Court. However, many trade marks matters are relatively simple disputes and parties to those matters would benefit from them being heard in a speedy, cost-effective and less formal setting. Thus items 114 to 128 of Schedule 6 to the Raising the Bar Act amend the Trade Marks Act to provide the Federal Magistrates' Court with jurisdiction to hear and decide trade marks matters.

The Regulation consequentially amends the Trade Marks Regulations to clarify that the Federal Magistrates' Court has jurisdiction to hear and decide trade marks matters. Item 92 of the Regulation amends regulation 17A.42F to maintain consistency in jurisdiction of the Federal Magistrates' Court across the trade marks legislation.

Items 93, 94 and 96 – regulation 19.1, subregulation 21.5(2), and paragraph 21.24A(b)

These items provide consequential amendments to regulation 19.1, subregulation 21.5(2) and paragraph 21.24A(b) to update the reference to state sub-offices similar to the amendments above at items 87 to 89.

As item 129 of Schedule 6 to the Raising the Bar Act provides the Registrar with the discretion to establish or abolish state sub-offices, these items have been amended to allow for the possibility that there may be no state sub-offices at some point in the future.

Item 95 – regulations 21.15 and 21.16

Hearings in relation to trade marks matters are conducted in a similar manner to those for patent and design matters, as discussed at item 3 above. Currently the wording of regulation 21.15 of the Trade Marks Regulations may suggest that a 'right to be heard' requires the holding of an oral hearing. Regulations 21.14 and 21.16 of the Trade Marks Regulations provide limited discretionary powers to the Registrar regarding the procedure to be followed in proceedings (other than oppositions) and determining a matter without hearing. For the same policy reasons as discussed at item 3 in regards to the designs changes, the amendments clarify that the Registrar has the discretion to decide that parties may only give written submissions to present their case.

As a result regulations 21.15 and 21.16 of the Trade Marks Regulations are amended to clarify that the Registrar may either hear the person orally or in writing but the Registrar should not be required to hold an oral hearing. They also clarify that the Registrar must give at least 10 business days notice for a hearing.

However, there are a number of differences between the current hearing requirements for trade marks and the other IP rights. These differences are preserved:

- Regulation 21.15 continues to apply only if another provision of the Act or regulations provides for a person to be heard by the Registrar.
- Under subregulation 21.15(2) the Registrar has the discretion to ask for written submissions, notify a person that they may request a hearing or set a hearing date. This is consistent with the discretion in the existing subregulation 21.15(3), which does not require the Registrar to specifically notify a person.
- Subregulations 21.15(4) and 21.16(6) replicate existing subregulations 21.15 (7) and (8).
- Under subregulation 21.15(3) a request for a hearing must be in an approved form, consistent with existing subregulation 21.15(2).

Item 97 – subregulation 21.29 (1)

This item amends regulation 21.29 so that a Convention country is defined by reference to the current signatories of the Paris Convention or the current membership of the WTO. The policy reasons for this change and the intended operation of the provision are the same as items 1 and 4.

Item 98 – schedule 9, items 1 and 3

This item amends fee items 1 and 3 of Schedule 9 to clarify the fees payable when an application to register a trade mark is filed in one or more prescribed classes when using an ‘approved means’ compared to when filed using another means. Approved means are defined according to existing regulation 2.1, and are generally electronic filing methods that result in a more efficient administration of the application process.

The intent of the fee structure is to provide an incentive to applicants who use such electronic filing means.

The wording of the current fee items implies that an additional fee will be charged to an applicant if filing using a non-approved means when nominating goods or services not using the ‘official Goods and Services pick list’. However, in practice the ‘official Goods and Services pick list’ is limited to use only with ‘approved means’ and would not be available when an applicant makes an application by ‘another means’. If an application is filed using another means, this would automatically impose an additional fee to be applied for nominating the goods or services. This was not the intended policy.

Therefore, this item clarifies the language to ensure that applicants are not liable to pay an additional fee for not using a goods and services pick list that is not available via the means that they used.

Item 99 – schedule 10

Item 99 repeals the current list of deemed convention countries from the Trade Marks Regulations as a consequence of the amendments at item 97. The policy reason for this change is the same as items 1 and 4.

Schedule 7 – Amendments relating to transitional provisions

Part 1 – Patents Regulations 1991

Regulation 22.36 (1) – transitional provisions for Schedule 1

Amendments of Patent Regulations 1991

This item amends the Patents Regulations to provide for the application provisions of Schedule 1 to the Regulation.

Item 1 – The amendments made by item [1] relate to restructuring the headings consistent with the introduction of Divisions to Chapter 3 of the regulations. These changes will apply in the same manner as sub-item 55(1) of Schedule 1 to the Raising the Bar Act 2012.

These changes are to apply in relation to the following:

- standard and innovation patents for which the complete application was made on or after the day of commencement;
- standard patents for which the application was made before the day of commencement, but where the applicant has not yet requested examination of the application relating to the patent on or before that day;
- innovation patents granted on or after commencement, if the application relating to the patent was made before that day;
- complete innovation and standard patent applications made on or after the day of commencement;
- standard patent applications made before the day of commencement, but where the applicant has not requested examination of the application before that day;
- innovation patent applications made before the day of commencement but not granted at that day; and
- innovation patents granted before the day of commencement, but where the Commissioner has not received a request to examine the patent or has not decided to examine the patent on or before that day.

This means that the changes will only apply to applications and patents where, at commencement, the applicant has not yet asked for examination of whether the application meets the substantive requirements of the Act. This strikes a balance between implementing the changes as soon as possible, addressing the need to raise patentability standards, and giving applicants control and certainty over whether the old or new rules apply to them.

Item 2 – The amendments made by item [2] relates to amendments made to prescribe documents and allowable amendments considered in regard to requests or directions to amend. The amendment at item [2] repeals regulation 3.3(7) as a result of amendments at item [9] of Schedule 1 to the Regulation.

Consistent with items 29 and 31 - 34 of Schedule 1 to the Raising the Bar Act, the application of these items will mirror sub-item 55(9) of Schedule 1 to the Act. The amendments ensure that any requests or directions to amend made in respect of the following applications or patents are assessed according to the amendment provisions existing prior to commencement:

- standard patents granted, and innovation patents certified, prior to commencement;
- standard patent applications where the applicant has requested examination of the patent application prior to commencement; and
- innovation patents where the patentee or another person has requested examination of the patent, or the Commissioner has decided to examine the patent, prior to commencement.

This will apply regardless of whether the request or direction to amend the application or patent was made prior to, on or after commencement.

Requests or directions to amend made on or after commencement in respect of the following applications or patents are, however, assessed according to the amendment provisions existing after commencement:

- standard patent applications where the applicant has not requested examination of the patent application before commencement, and patents granted on these applications; and
- innovation patents where the patentee or another person has not requested examination of the patent, or the Commission has not decided to examine the patent, before commencement.

Item 3 – The amendments made by item [3] relate to raising patentability standards. These changes restructure and clarify the provisions setting out the prescribed circumstances and corresponding prescribed documents used to determine the priority date of a claim.

These changes will apply to applications and patents as according to the matters referred to in sub-item 55(1) of Schedule 1 to the Raising the Bar Act 2012, as explained above at item 1.

Item 4 – The amendments made at item [5] relate to changes made to expand the scope for substantive examination and raise the threshold for acceptance of patent applications and grant of patents. The amendment at item 5 repeals regulation 3.18(2)(d) consequential to item 12 of Schedule to the Raising the Bar Act that amended the patentability requirements of subsection 45(1).

Consistent with the other changes to raise standards, the change applies to:

- standard patent applications made on or after the day of commencement; and
- standard patent applications made before commencement, but where the applicant has not requested examination before commencement.

Consistent with item 12 of Schedule 1 to the Raising the Bar Act, the application of this item will mirror item 55(4) of Schedule 1 to the Act.

Item 5 – The amendments made by item [6], [7] and [8] relate to altering the requirements for requesting and expanding the grounds for re-examination of patent specifications.

Consistent with items 16 and 17 of Schedule 1 to the Raising the Bar Act the application of items [6], [7] and [8] concerning re-examination of a standard patent will mirror item 55(5) of Schedule 1 to the Act.

The changes will apply to all standard patents and patent applications, regardless of when the application was made, or when the standard patent was granted.

Item 6 – The amendments made by item [6], [7] and [8] relate to altering the requirements for requesting and expanding the grounds for re-examination of innovation patent specifications.

Consistent with items 23 to 25 of Schedule 1 to the Act, the application of items [6], [7] and [8] concerning re-examination of an innovation patent will mirror item 55(7) of Schedule 1 to the Act.

The changes will apply to all innovation patents, regardless of when the application was made, or when the innovation patent was certified.

Item 7 – The amendments made in item [9] relate to prescribed documents and allowable amendments considered in regard to requests or directions to amend patent requests and specifications. These changes prescribe the documents that can be considered for determining whether to allow amendment of a patent specification and the allowance of amendments to patent requests and complete specifications.

Consistent with items 29 and 31 - 34 of Schedule 1 to the Raising the Bar Act, the application of these items will mirror sub-item 55(9) of Schedule 1 to the Act, as explained above at item 2 above.

Item 8 – The amendments made by item [10] relate to amendments concerning provisional specifications. The amendments made by item [10] amend regulation 10.3(1) to prescribe the circumstances and the documents that can be considered for determining whether to allow an amendment of a provisional specification.

This change will apply so that the provisions of regulation 10.3(1) will apply to provisional applications filed on or after commencement of this Schedule.

Item 9 – The amendments made by item [10] relate to amendments concerning provisional specifications. The amendments made by item [10] introduce regulation 10.3(2) to prescribe that an amendment of an abstract filed with a provisional specification is not allowable.

Consistent with items 29 and 31 - 34 of Schedule 1 to the Raising the Bar Act, the application of these items will mirror sub-item 55(9) of Schedule 1 to the Act, but treating the first reference to a complete specification in that sub-item as a reference to an abstract. The operation is explained at item 2 above.

Item 10 – The amendment made by item [11] amends subregulation 10.4(a) as a consequence of the amendments at items [9] and [10] to prescribe documents which the Commissioner may consider when determining whether to allow amendment of a patent specification.

Consistent with items 29 and 31 - 34 of Schedule 1 to the Raising the Bar Act, the application of these items will mirror sub-item 55(9) of Schedule 1 to the Act. The changes will apply to in the same way as the amendment made by item [9], discussed in item 2 above.

Item 11 – The amendment made by item [12] amends subregulations the 10.5(1)(b) to impose a higher standard of proof when the Commissioner is deciding whether to grant leave to amend a patent application for standard patent to overcome grounds of objection.

Consistent with items 14, 15 and 18 of Schedule 1 to the Raising the Bar Act, the application of this item will mirror subitem 55(4) of Schedule 1 to the Act. The changes will apply to in the same way as item [5], discussed at item 4 above.

Item 12 – The amendment made by item [13] amends subregulations the 10.5(1)(c) to impose a higher standard of proof when the Commissioner is deciding whether to grant leave to amend in relation to an innovation patent to overcome grounds of objection.

The application of these items will mirror sub-item 55(8) of Schedule 1 to the Act. The means that consistent with the other changes to raise standards, the change applies to:

- complete innovation patent applications made on or after the day of commencement;
- patent applications made before the day of commencement but not granted at that day;
- innovation patents granted before the day of commencement, but where the Commissioner has not received a request to examine the patent or has not decided to examine the patent on or before that day;
- innovation patents for which the complete application was made on or after the day of commencement; and

- innovation patents granted on or after commencement, if the application relating to the patent was made before that day.

Item 13 – The amendments made by items [15], [16], [17], [18] and [20] relate to changes made to searches, examination, and the fees associated with these matters.

These amendments stipulate when fees are payable for a search conducted as part of the examination of a patent application (items [15] – [16] and [18]), and to omit a reference to old fee item 106 which relates to modified examination (item [17]).

These changes will apply to standard complete patent applications filed on or after the commencement - ie the application will mirror sub-item 55(3) of Schedule 1 to the Act.

Regulation 22.36 (2) – transitional provisions for Part 1 of Schedule 3

Amendments of Patent Regulations 1991

The application of the changes to the patents and trade marks opposition systems follow three broad principles:

First, for all oppositions commenced by filing a notice of opposition on or after commencement, the entirety of the new provisions will apply to those oppositions. The exception is where the period to file a notice of opposition is changing and that period falls across the commencement date, the opponent will get the more generous of the two time periods (whether old or new) in which to file the opposition.

Second, where the opponent files a notice of opposition before the day of commencement, the old provisions will apply for the life of the opposition, but with some notable exceptions as described below. Broadly, for oppositions commenced prior to the day of commencement of the Schedule, the exceptions are as follows:

- Move from the ‘serve-and-file’ regime to the ‘file-and-give’ regime for documents filed after commencement;
- New extension of time test to apply to extensions of evidentiary periods that began on or after commencement;
- Summary of submissions requirement to apply to hearings where the hearing date was set on or after commencement; and
- The Commissioner can direct the form and means of filing for documents filed on or after commencement.

Third, where the regulations provide a change to the period to file a notice of opposition and that period falls across the commencement date, the opponent will get the more generous of the two time periods (whether old or new) in which to file the opposition.

Item 1 – The amendments made by item [2] of Schedule 3 to the Regulation concerning new regulation 5.3 provide the Commissioner with the power to direct the form, number of copies and the means by which documents and evidence are filed in opposition proceedings.

The changes made by this item at regulation 5.3 will apply in relation to all opposition proceedings on foot, regardless of whether they were commenced before, on or after the day of commencement of the Schedule.

Item 2 – The amendments made by the items and regulations of Schedule 3 and listed in this item relate to the power of the Commissioner to grant an extension of time for a party to provide evidence in an opposition proceeding.

These amendments include the new extension of time test and are to be implemented all opposition proceedings, regardless of whether they were commenced before, on or after the day of commencement of the Schedule. Where an opposition proceeding commenced before the commencement date of the Schedule and an extension of time is requested for an evidentiary period which began on or after the commencement date, then the new extension of time test will be applied by the Commissioner to any extension of time sought for that evidential period. The extension of time provisions as in force immediately before the commencement date will not be available.

Conversely, where the opposition proceeding commenced before the commencement date of the Schedule and an evidentiary period also began before commencement of Schedule, then the Commissioner will apply the extension of time test as in force immediately before the commencement date of the Schedule to any extension of time sought for that evidential period.

Item 3 – The amendments made by item [2] regulation 5.20 of Schedule 3 relate to the Commissioner holding a hearing of the opposition matter. This new regulation formalises the filing of summaries of submissions by the parties to opposition proceedings.

Where an opposition proceeding commenced before the commencement date of the Schedule and the Commissioner has not set a hearing date, or issued a notice of hearing to the parties before the commencement date, new regulation 5.20 will apply and the parties will be required to file summaries of submissions according to the new provisions.

However, where an opposition proceeding commenced before the commencement date of the Schedule and a hearing date has already been set by the Commissioner before that date – the hearing date being on or after the commencement of the Schedule – the parties will be required to file summaries of submissions according to the practice directed by the Commissioner before commencement.

The application provision for this item also includes references to specific regulations:

- not applying in some circumstances;

- being taken to be a reference to particular current regulations; and
- including conditions of particular current regulations.

This is to ensure that the current regulations and the new regulations are able to operate together in situations where an opposition proceeding that commenced before the commencement date of the Schedule is to have specific new regulations apply to it.

These changes will apply to all opposition proceedings commenced before, on or after the day of commencement of the Schedule and where the Commissioner has not set the hearing date, or issued a notice of hearing to the parties, prior to the commencement date of the Schedule.

Item 4 – The amendments made by items [2], [7] and [9] relate to the replacement of the current regulations regarding patent opposition proceedings and the obligations for parties to those proceedings. These changes will apply to all opposition proceedings commenced by the filing of a notice of opposition on or after the day of commencement of the Schedule.

However, under the revised patent opposition proceedings, new subregulation 5.10(1) replaces old subregulation 5.3(3) and reduces the opposition period from 3 months to 2 months. These changes will apply to all opposition proceedings commenced by the filing of a notice of opposition on or after the day of commencement of the Schedule.

Where the advertisement for amendment occurs prior to the commencement date of the Schedule, the opposition period may not end until after the commencement date. However, with the reduction in time period to file a notice of opposition, a potential opponent may be out of time to file the notice from the day of commencement of the new Regulation. It is not intended that the opponent be disadvantaged by the change in regulation and in this situation only, the references in the new regulation 5.10(1) to 2 months will be taken to be 3 months.

The amendments to the regulations made by item [2] remove the requirement to serve documents and evidence on the alternate party, instead the documents will be filed and the Commissioner will be required to give a copy of any document filed to the alternate party. The new filing requirements of item [2] will apply to oppositions filed on or after commencement.

The intention is also to implement a “file-and-give” regime for opposition proceedings commenced before commencement. This is to prevent both the Commissioner and opposition parties from having to check the date of the notice of opposition to decide whether they will need to serve or only file the document. It is easier for all parties to know that all documents must only be filed after the commencement of the Raising the Bar Act.

Accordingly, for opposition proceedings started before the commencement date of the Schedule, the old provisions will apply excepting that, where a document or evidence has not been served before the commencement date and is not required to be served

on or after that date then (including in any extension of an evidentiary period ending before commencement), then:

- the person will now only be required to file the document within the relevant time period; and
- the Commissioner must give the filed document to the other party as soon as practicable; and
- a reference in the old provisions to a document or evidence having been served will be taken as a reference to the document or evidence having been filed.

Where the Commissioner is required to give a copy of the filed document or evidence to another party there may be a delay between when the first party filed the document or evidence and when the second party is given the document or evidence. The subsequent time period for the next step in the opposition process is usually calculated from when the preceding document was served (now to be filed). This could result in a *de facto* shortening of the time period that the other party has to conduct the next step, as the time period would start before the party had been given the document or evidence by the Commissioner. It is not intended that time periods be shortened in this manner.

Instead a mandatory extension of time is provided for the subsequent time period to account for the delay, as follows:

- where a period for party A to do an action is calculated under the old provisions from the date that party B serves a document (now to be filed); and
- the Commissioner does not give the document to party A on the day it is filed; then
- the Commissioner must extend the period for party A to do the action by an amount equal to the number of days between when the document was filed and when the Commissioner gave the document to the Party A.

This extension does not apply where the period for a person to do an action is calculated from a date the person filed an earlier document.

Item 5 – The amendments made by item [3] concerning regulation 6A.1 prescribe requirements for filing divisional applications of standard patent applications and innovation applications under section 79B of the Patents Act, as amended by item 3 of Schedule 3 to the Raising the Bar Act.

The amendments apply in relation to divisional applications filed on or after commencement. The application of this item would mirror item 32(3) of Schedule 3 of the Raising the Bar Act.

Item 6 – The amendments made by item [3] concerning regulation 6A.2 prescribe the particulars required when filing a divisional application under section 79C of the Patents Act, as amended by item 5 of Schedule 3 to the Raising the Bar Act.

The amendments apply in relation to divisional applications filed on or after commencement. The application of this item would mirror item 32(4) of Schedule 3 to the Raising the Bar Act.

Regulation 22.36 (3) – transitional provisions for Schedule 4

Amendments of Patent Regulations 1991

The amendments at items [1] to [30] concern amendments relating to the patent attorney profession that allow for the incorporation of patent attorneys, professional indemnity insurance and attorney discipline and suspension. With the exception of item [14], these amendments do not require application provisions. This is consistent with Schedule 4 to the Act.

The amendment at item [14] introduces a suspension scheme for individual attorneys who have been charged with a serious offence.

The attorney suspension provisions apply to charges laid on or after the commencement of the Regulation, regardless of whether the alleged offence occurred before or after commencement of the provisions.

Regulation 22.36 (4) – transitional provisions for Part 2 of Schedule 6

Amendments of Patent Regulations 1991

These items amend the regulations based on the amendments under the items of Schedule 6 in order to provide for the transitional provisions.

Application provisions are not necessary for items [1] – [2], [4], [19], [46], [59], [63], [69] – [76], [79], [87] – [94], and [96] – [99]. These items should have the default transitions arrangements (as per the *Acts Interpretation Act 1901*) apply. As the corresponding provisions of the Act have no application provisions, no application provisions are necessary for these regulations.

Item 1 – The amendment made by item [5] relates to the definition of a ‘Convention country’. This amendment removes reference to the Budapest Treaty and the Patent Cooperation Treaty (PCT). These amendments will apply to PCT and Convention applications made on or after the day the Schedule commences.

This is consistent with item 34 of Schedule 6 to the Raising the Bar Act, the application of this item will mirror item 133(2) of Schedule 6 to the Act. The amendments apply to PCT and Convention applications made on or after the day the Schedule commences.

Item 2 – The amendment made by item [6] relates to the introduction of the prescribed period within which the use of an invention will not be taken to be ‘secret

use' under the Patents Act. This change will apply to any secret use that occurs on or after the Schedule commences.

This is consistent with item 29 of schedule 6 to the Raising the Bar Act. The application of this item will mirror item 133(1) of Schedule 6 to the Act.

Item 3 – The amendment made by item [7] amends regulations 2.2 to 2.3 as a consequence of the amendments made by items 32 and 33 in Schedule 6 to the Raising the Bar Act relating to grace periods.

This change will apply so that the amendments will capture information made publically available on or after the day of commencement of the Schedule. This is consistent with items 32 and 33 of Schedule 6 to the Raising the Bar Act and the application of this item will mirror item 133(4) of Schedule 6 to the Act.

Item 4 – This item relates to an amendment made by item [8] to remove the notice of entitlement from the documents that are required to be filed before acceptance by omitting regulation 3.1(2)(a) and (b). This change will apply so that these provisions will apply to applications in relation to which a request for examination was made on or after day the Schedule commences.

Item 5 – The amendments made by items [9] to [12] relate to regulations concerning PCT applications. These amendments will apply to PCT applications made on or after the day the Schedule commences. This is consistent with item 34 of Schedule 6 to the Raising the Bar Act and the application of this item will mirror item 133(2) of Schedule 6 to the Act.

Item 6 – The amendments made by item [13] relate to the requirements for PCT applications to meet certain formality requirements. The changes also permit the Commissioner to conduct a formality check in particular circumstances.

This change will apply so that these provisions will apply to PCT applications that enter national phase on or after the day the Schedule commences. The requirements for national phase entry for the purposes of the PCT are:

- the fee specified at item 214A of Schedule 7 to the Regulation;
- if the PCT application has not been published under Article 21 of the PCT, a copy of the application; and
- if the PCT application was not filed with a Receiving Office in English, a translation of the application.

Item 7 – The amendments made by items [14] to [18] relate to the filing date of PCT applications and PCT applications that are deemed to be patent applications under the Patents Act in particular circumstances.

The amendments apply to PCT applications made on or after the day of the commencement of this Schedule. This is consistent with item 35 of Schedule 6 to the Raising the Bar Act and the application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 8 – The amendment made by item [20] relates to prescribing the period in which a Convention application can be made. This amendment will apply to convention applications made on or after the day the Schedule commences. This is consistent with item 42 of Schedule 6 to the Raising the Bar Act and the application of this item will mirror item 133(2) of Schedule 6 to the Act.

Item 9 – The amendment made by item [21] relate to the priority date of amended specifications. This item is consequential to the changes in item 33 of Schedule 1 of the Raising the Bar Act.

This change will apply such that any requests or directions to amend made in respect of the following applications or patents are assessed according to the provisions governing the priority date of an allowable amendment as existing prior to commencement:

- standard patents granted, and innovation patents certified, prior to commencement;
- standard patent applications where the applicant has requested examination of the patent application prior to commencement; and
- innovation patents where the patentee or another person has requested examination of the patent, or the Commissioner has decided to examine the patent, prior to commencement.

This will apply regardless of whether the request or direction to amend the application or patent was made prior to, on or after commencement.

Requests or directions to amend made on or after commencement in respect of the following applications or patents are, however, assessed according to the amendment provisions existing after commencement:

- standard patent applications where the applicant has not requested examination of the patent application before commencement, and patents granted on these applications; and
- innovation patents where the patentee or another person has not requested examination of the patent, or the Commission has not decided to examine the patent, before commencement.

This is consistent with item 55(9) in Schedule 1 to the Raising the Bar Act.

Item 10 – The amendment made by item [22] relates to the priority date of amended specifications and are consequential to changes to references to sections of the Act resulting from changes made in the Raising the Bar Act. The amendments will apply to PCT applications made on or after the day the Schedule commences.

This is consistent with item 34 of Schedule 6 to the Raising the Bar Act and the application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 11 – The amendment made by item [23] relate to the priority date of amended specifications. This item is consequential to the changes in item 33 of Schedule 1 to the Raising the Bar Act.

This is consistent with item 55(9) in Schedule 1 to the Raising the Bar Act, as discussed at item 9 above.

Item 12 – The amendments made by item [24] concerning regulation 3.14C relate to disregarding earlier PCT and convention applications. The amendments will apply in relation to application filed and patents granted before, on or after the day the Schedule commences.

This is consistent with item 44 of Schedule 6 to the Raising the Bar Act and the application of these items will mirror item 133(8) of Schedule 6 to the Act.

Item 13 – The amendments made at items [25] and [26] provide that a PCT applicant cannot request examination until they have complied with the requirements of national phase entry. The amendments will apply in relation to PCT applications made on or after the day the Schedule commences.

This is consistent with item 34 of Schedule 6 to the Raising the Bar Act and the application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 14 – The amendment made at item [27] reduces the time for requesting examination from 6 to 2 months. This item amends regulation 3.16(2) to prescribe that the relevant time for requesting examination is 2 months.

This change at subsection 44(2) will apply to all directions issued, under subsection 44(2) of the Patents Act, on or after the day the Schedule commences.

Item 15 – The amendment made by item [28] relates to new regulations 3.17A to 3.17C which provide for matters related to the examination of PCT applications. The changes made by these amendments will apply to PCT applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 of the Act.

Item 16 – The amendments made by item [30] amends the regulations to refer to the new restructured provisions of the Act dealing with convention applications

The changes made by these amendments will apply to Convention applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 17 – The amendments made by item [31] repeals paragraph 3.18 (2) (f) that required the Commissioner to report on certain matters when examining a patent application. The changes at this item insert a new provision which permits the Commissioner to examine and object to a PCT application on formality grounds.

The changes made by these amendments will apply to a PCT application that enters the national phase on or after the day the Schedule commences.

Item 18 – The amendments made by items [36] and [37] relate to amendments to the regulations to take account of the new restructured provisions for PCT applications.

The changes made by these amendments will apply to PCT applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 of the Act.

Item 19 – The amendments made by item [38] amend the regulations to ensure that document containing sensitive personal information can be made not Open for Public Inspection.

The changes made by this amendment will apply to any document filed before, on or after the day the Schedule commences, provided that the document is related to a patent application, but is not the patent specification for that application.

Item 20 – The amendment made by item [39] amends the regulations to provide for the inspection and publication of PCT applications.

The changes made by these amendments will apply to PCT applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 of the Act.

Item 21 – The amendments made by items [40] and [41] amend the regulations to provide for the particulars that the Commissioner must enter into the Register when granting a patent.

Consistent with items 60 to 64 of Schedule 6 to the Act, the application mirrors subitem 133(9) of Schedule 6 to the Act. The changes made by these items will apply only to patents granted on or after the day the Schedule commences.

Item 22 – The amendments made by item [42] amends the regulations to take into account the new restructured provisions for Convention applications.

The changes made by these amendments will apply to Convention applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 23 – The amendment made by item [43] amends the regulations to correct an unintended anomaly that occasionally occurs in calculating the date of a patent for PCT applications in certain circumstances.

The changes made by this amendment will apply to PCT applications filed with a receiving Office on or after the day the Schedule commences.

Item 24 – The amendment made by item [44] make amendments consequential to removing the need to issue a duplicate deed as items 60 and 62 of Schedule 6 to the Raising the Bar Act remove the requirement to grant a patent by physically sealing a paper deed.

These changes will apply only to patents granted on or after the day the Schedule commences. The application of these items will mirror item 133(9) of Schedule 6 to the Act.

Item 25 – The amendment made by item [45] repeals Chapter 8 of the Regulation consequential to the restructure of the provisions regarding PCT and Convention applications to make them clearer and more user-friendly.

The changes made by these amendments will apply to PCT and Convention applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 26 – The amendments made by item [47] make amendments to introduce paragraph 9A.4 (f) to provide longer a period for completing examination of innovation patents in certain circumstances. Paragraph 9A.4(f) deals with the situation where an applicant is given an opportunity to be heard.

The changes will apply to applications in relation to which a request for examination is made on or after the day of the commencement of the Schedule.

Item 27 – The amendments made by item [47] make amendments to introduce paragraph 9A.4 (g) to provide longer a period for completing examination of innovation patents in certain circumstances. Paragraph 9A.4(g) deals with the new power to revoke certification of an innovation patent under new section 101EA.

A certificate will only be able to be revoked under the new provisions if the innovation patent was certified on or after the day of the commencement of the

Schedule. The application of these items will mirror item 133(12) of Schedule 6 to the Act.

Item 28 – The amendments made by items [48] to [50] prevent a PCT applicant from requesting an amendment until they have entered national phase (item [48]) and update references to sections of the Act that have changed with the restructure of the provisions governing PCT applications (items [49] to [50]).

The changes made by these amendments will apply to PCT applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 29 – The amendments made by item [51] relate to amendments to update references to sections of the Act that have changed with the restructure of the provisions governing PCT applications.

The changes made by these amendments will apply to PCT applications made on or after the day of the commencement of the Schedule. The application of these items will mirror item 133(2) of Schedule 6 to the Act.

Item 30 – The amendment made by item [53] provide that grants of leave to amend are revoked in certain circumstances.

The changes will apply to an application or patent in relation to which leave to amend the patent request, complete specification or other filed document is granted on or after the day of the commencement of the Schedule.

Item 31 – The amendments made by item [54] provides amendments to regulation 10.7 that relate to requests for rectification of the Register under new section 191A and their consideration.

These amendments apply to patents granted before, on or after the day of the commencement of the Schedule. The application of this item will mirror item 133(3) of Schedule 6 to the Act.

Item 32 – The amendments made by item [54] amend regulation 10.7 which provides for rectification of the register. Under the existing regulation 5.3(5A), a person could oppose such a rectification. Item [2] of Schedule 3 to the Regulation repeals regulation 5.3(5A). Although there will no longer be a formal opposition process, the Commissioner will still be required to advertise significant rectification requests, and a party wishing to challenge the rectification will have a right to be heard under regulation 22.22.

This application provision deals with the situation where requests for rectification were made under the old regulation 10.7 where the period to oppose under regulation 5.3(5A) crosses over the commencement date.

If a notice of opposition is filed before commencement, then the opposition would continue in accordance with previous regulation 5.3(5A) and 10.7. No application provision is necessary to deal with this situation as the default regime in paragraph 7(2)(c) of the Acts Interpretation Act 1901 would apply.

However, if no notice of opposition has been filed prior to commencement, then the application provisions in this item would apply. They have the effect that a request to rectify under the old regulation 10.7 is treated as a request to rectify under the new 10.7. Accordingly, no formal opposition will be available. However, an interested party will still have a right to be heard. The publication of the request under the old regulation 10.7 is treated as the publication of the request under the new regulation 10.7. This means that any interested person will have 2 months from publication to request to be heard under regulation 22.22.

Item 33 – The amendment made by item [55] amends the definition of foreign country so that it continues to apply to Convention countries with the repeal of Schedule 4 to the Patents Regulations. The changes made by this amendment will apply to any foreign aircraft, land vehicle or vessel, regardless of the date it was registered or the date the person acquired ownership of it.

Item 34 – The amendment made by item [56] relate to amendments to the regulations to replace a reference to ‘sealing’ with a reference to ‘granting’. These changes will apply only to patents granted on or after commencement of the Schedule. The application of this item will mirror item 133(9) of Schedule 6 to the Act.

Item 35 – The amendments made by item [57] make consequential amendments to the regulations to remake existing subregulation 8.3 (2) as regulation 13.1C.

The application of this item will mirror item 133(2) of Schedule 6 to the Act. The changes made by this amendment will apply to PCT applications made on or after the day of the commencement of the Schedule. However, an amended form of regulation 8.3(2) will continue to apply to PCT applications made before commencement – see regulation 22.36(6) below.

Item 36 – The amendment made by item [58] repeals regulation 13.2 as a consequence of the amendments made under item 49 of Schedule 6 to the Raising the Bar Act.

The changes made by the amendment will apply to ensure that an application that was deferred before section 46 was repealed can still be lapsed under the existing section 142(2)(c) even where the prescribed time period for the applicant to request examination expires after the date of commencement of the Schedule.

Item 37 – The amendment made by item [61] makes amendments to subparagraph 13.4(1)(f)(ii) to update the reference to section 36 (1) (c). This amendment is consequential to the changes at item 40 of Schedule 6 to the Raising the Bar Act and relate to the Commissioner’s power to resolve ownership disputes.

The changes apply in relation to declarations made on or after commencement. The application of this item will mirror item 133(6) of Schedule 6 to the Act.

Item 38 – The amendments made by item [62] concerning new paragraph 13.4(1)(g) provide for a longer acceptance period if the Commissioner gives the applicant an opportunity to be heard to address outstanding objections.

The changes apply to an application in relation to which a request for examination is made on or after the day of commencement of the Schedule.

Item 39 – The amendments made by item [62] concerning new paragraph 13.4(1)(ga) provide for a longer acceptance period where acceptance is revoked under the new section 50A of the Act.

The changes will apply so that acceptance of an application will only be able to be revoked if the acceptance the application occurred or after the day of commencement of the Schedule. Consistent with items 54 and 55 of Schedule 6 to the Act, the application of this item will mirror subitem 133(11) of Schedule 6 to the Act.

Item 40 – The amendments made by item [64] concerning new paragraph 13.4(1)(g) provide for a longer acceptance period if the Commissioner gives the applicant an opportunity to be heard to address outstanding objections.

The changes apply to an application in relation to which a request for examination is made on or after the day of commencement of the Schedule.

Item 41 – The amendments made by item [62] concerning new paragraph 13.4(1)(ga) provide for a longer acceptance period where acceptance is revoked under the new section 50A of the Act.

The changes will apply so that acceptance of an application will only be able to be revoked if the acceptance the application occurred or after the day of commencement of the Schedule. Consistent with items 54 and 55 of Schedule 6 to the Act, the application of this item will mirror subitem 133(11) of Schedule 6 to the Act.

Item 42 – The amendments made by items [65] and [66] relate to amendments to provide for the lapsing of PCT applications, by remaking existing subregulation 8.3 (3) (item [65]) and provide consequential amendments to subregulation 22.2(4) to

update references to sections of the Act that have changed with the restructure of the provisions governing PCT applications (item [66]).

The changes made by this amendment will apply to all PCT applications made on or after the day of the commencement of the Schedule. The application of this item will mirror item 133(2) of Schedule 6 to the Act.

Item 43 – The amendments made by items [67] and [68] relate to amendments to the Regulation to remove response fees. These amendments are consequential to the amendment at item [59] which reduces the acceptance period from 21 to 12 month and removes the need for response fees.

The changes made by these items will apply to an application in relation to which a request for examination is made on or after the day of commencement of the Schedule, consistent with the application of item [59] (as provided for in Schedule 6 to the Regulations).

Item 44 – The amendments made by item [77] relates to amendments to the Patent Regulations to clarify that the Commissioner has the discretion to decide the means by which a person may be heard.

The changes made by these items, with the exception of new subregulation 22.22(1), will apply to a hearing for which the Commissioner has issued a hearing notice, or an invitation to be heard, on or after the day of commencement of the Schedule.

Item 45 – The amendments made by item [78] relate to amendments that prescribe documents which, for the purposes of subsection 226(1) of the Patents Act, can be reproduced without infringing on the author's copyright.

The changes will apply to an act referred to in subsection 226(1) of the Patents Act done in relation to a prescribed document on or after the day of commencement of the Schedule.

Item 46 – The amendment made by item [80] relate to consequential amendments to the heading for Schedule 3, as both PCT and non-PCT applications are now required to comply with it as part of their respective formalities checks. The changes will apply to a PCT application that enters the national phase on or after the day of commencement of the Schedule.

Item 47 – The amendment made by item [81] relates to consequential amendments to the Regulation to repeal Schedule 4.

The changes made by this amendment will apply to Convention applications made on or after the day of the commencement of the Schedule. The application of this item will mirror subitem 133(2) of Schedule 6 to the Act.

Item 48 – The amendment made by item [82] relate to amendments to the fee items in Schedule 7 of the Regulation to apply the \$600 fee for the Commissioner to hear a dispute under the existing section 17, 32 and 36, so that it also applies to requests under the new section 191A(2) to rectify the Register.

The changes will apply to patents granted before, on or after the day of commencement of the Schedule, consistent with subitem 133(3) of Schedule 6 to the Act.

Item 49 – The amendments made by item [83] relate to consequential amendments that update references to sections of the Act that have changed with the restructure of the provisions governing PCT applications.

The changes made by this amendment will apply to PCT applications made on or after the day of the commencement of the Schedule. The application of this item will mirror item 133(2) of Schedule 6 to the Act.

Item 50 – The amendments made by items [84] and [85] relate to the consequential repeal a fee item for sealing a duplicate patent deed (item [84]) and amending of a fee item for providing amendment of an innovation patent (item [85]).

Consistent with items 60 to 64 of Schedule 6 to the Act, the application of these items will mirror subitem 133(9) of Schedule 6 to the Act. These changes will apply only to patents granted on or after the day of commencement of the Schedule.

Item 51 – The amendments made by item [86] relate to amendments to the regulations to remove the fee item for response fees as similarly discussed at item 43.

The changes will apply to an application in relation to which a request for examination is made on or after the day of commencement of the Schedule.

Regulation 22.36 (5) – savings provisions for Part 2, Schedule 6

Amendments of Patent Regulations 1991

Item 1 – The amendment made by item [29] relate to amendments to delete a reference in subregulation 3.18 (2) to section 48 of the Act. Section 48 deals with modified examination and is repealed by item 50 of Schedule 6 to the Raising the Bar Act.

Item [29] will not apply where a modified examination has been requested, but not completed at the day of commencement of the Schedule. This will have the effect of ensuring that the existing provisions will continue to apply after commencement. This is consistent with item 134 of Schedule 6 to the Raising the Bar Act.

Item 2 – The amendments made by items [32] to [35] relate to amendments to the regulations to repeal redundant provisions and references to repealed sections 46 to 48 of the Patents Act concerning modified examination.

Items [32] to [35] will not apply where a modified examination has been requested, but not completed at the day of commencement of the Schedule. This will have the effect of ensuring that the existing provisions will continue to apply after commencement. This is consistent with item 134 of Schedule 6 to the Raising the Bar Act.

Item 3 – The amendments made by item [52] relates to amendments to delete reference to section 48 from subregulation 10.5(1)(b) consequential to the repeal of sections 48 of the Patents Act concerning modified examination.

Item [52] will not apply where a modified examination has been requested, but not completed at the day of commencement of the Schedule. This will have the effect of ensuring that the existing provisions will continue to apply after commencement. This is consistent with item 134 of Schedule 6 to the Raising the Bar Act.

Item 4 – The amendments made by item [54] relate to amendments that provide for the process of rectifying the Register.

The repeal of the provisions for sealing patent deeds only applies to patents granted on or after the commencement date – see item 133(9) of Schedule 6 to the Raising the Bar Act. Accordingly, there will be some physical patent deeds sealed before commencement that patentees may wish to have rectified after commencement.

This change will apply to the extent that where a patent was granted before the day of commencement of the Schedule, the provisions in accordance with regulation 10.7(1)(b) as it was in force immediately before the day of commencement of the Schedule will continue to apply.

Item 5 – The amendments made by item [60] relate to amendments to omit provision 13.4(1)(c) that dealt with modified examination. This amendment is consequential to the repeal of redundant provisions and references to sections 48 of the Patents Act concerning modified examination.

Item [60] will not apply where a modified examination has been requested, but not completed at the day of commencement of the Schedule. This will have the effect of ensuring that the existing provisions will continue to apply after commencement. This is consistent with item 134 of Schedule 6 to the Raising the Bar Act.

Regulation 22.36 (6)

The amendment provided by regulation 22.36(6) relates to regulation 8.3 and concerns modifications of the act to apply to PCT applications.

This provision is required to deal with the interplay between the amendments in item 11 of Schedule 3 to the Act (which provides that the Commissioner's consent is required to withdraw an opposed application) and item 57 of Schedule 6 to the Act (which restructures the provisions that apply to PCT applications, including the provision for withdrawing a PCT application). The latter amendments apply only to PCT applications made on or after commencement (see subitem 133(2) of Schedule 6 to the Act). However, the former amendments apply to notices of withdrawal filed on or after commencement, regardless of when the application was made (see subitem 32(6) of Schedule 3 to the Act).

Special provision is required for PCT applications that fall in the gap between these two provisions – ie where the application was made before commencement, but the notice of withdrawal was filed on or after commencement.

This provision deals with this by saving subregulation 8.3(2) in respect of these applications, but also amending it so that it can work together with section 141 as amended by item 11 of Schedule 3 to the Act.

Part 2 – Trade Marks Regulations 1995**Regulation 22.9(1) – transitional provisions for Part 2, Schedule 3**

Amendments of *Trade Marks Regulations 1995*

Item 1 – The amendments made by the items of Part 2 of Schedule 3 concern the replacement of the current regulations regarding trade mark opposition proceedings and the obligations for parties to those proceedings.

These changes will apply to all opposition proceedings commenced by notices of intention to oppose made on or after the day of commencement of the Schedule.

Item 2 – The amendments made by items [10] to [30] of Schedule 3 concern the replacement of the current regulations regarding trade mark opposition proceedings and the obligations for parties to those proceedings.

These amendments include changes to the filing of a notice of opposition – separating the notice into two components, a notice of intention to oppose and a statement of grounds and particulars. The current regulations provide a 3 month period in which to file a notice of opposition. Under the new Regulation, the period to file a notice of intention to oppose is 2 months, with a further one month to file the statement of grounds and particulars.

Where a trade mark application (or application for removal) is advertised for opposition purposes in the three months prior to the commencement date of the Schedule, the opposition period may not lapse until after the commencement date. However, with the reduction in time period to file a notice of intention to oppose, a potential opponent may be out of time to file the notice from the day of commencement of the new regulations.

To ensure that potential opponents are not disadvantaged by the change in regulations, where a trade mark application is advertised before the commencement of the Schedule, but the opposition period does not lapse until after the commencement date, the period to do the first step in opposing an application (filing a notice of intention to oppose) shall remain at the 3 months period. In this situation only, the references in the new Regulation to 2 months will be taken to be 3 months. The opponent would then be required to file a statement of grounds and particulars within one month of filing the notice of intention to oppose.

Where a trade mark application is advertised for acceptance on or after the day of commencement of the Schedule, a potential opponent will have 2 months to file a notice of intention to oppose and then a further month from that filing date in which to file a statement of grounds and particulars as required under new regulation.

The application provision for this item also provides for the moving from the ‘serve-and-file’ regime to the ‘file-and-give’ regime for documents filed after commencement. Consistent with the application provisions for the Patents Regulations as discussed at item 4, regulation 23.36(2) of Part 1 (above), the amended provisions are to apply to opposition proceedings commenced before the commencement date of the Schedule where a document or evidence is not served before the commencement date but the document or evidence is required to be served on or after the commencement date of the Schedule.

Item 3 – The amendments made by the items and regulations of Schedule 3 and listed in this item provide the Registrar with the power to direct the form, number of copies and the means by which documents and evidence are filed in opposition proceedings.

These changes will apply in relation to all opposition proceedings on foot, regardless of whether they were commenced before, on or after the day of commencement of the Schedule.

Item 4 – The amendments made by the items and regulations of Schedule 3 and listed in this item relate to the Registrar holding a hearing of the opposition matter. The new Regulation formalise the filing of summaries of submissions by the parties to opposition proceedings. Consistent with the application provisions for the Patents Regulations as discussed at item 3, regulation 23.36(2) of Part 1 (above), the amended provisions are to apply to all opposition proceedings where the Registrar has not set a hearing date, or issued a notice of hearing to the parties before commencement of the Schedule.

The application provision for this item also includes references to specific regulations:

- not applying in some circumstances;
- being taken to be a reference to particular current regulations; and
- including conditions of particular current regulations.

This is to ensure that the current regulations and the new regulations are able to operate together in situations where an opposition proceeding that commenced before the commencement date of the Schedule is to have specific new regulations applied to it.

Item 5 – The amendments made by the items and regulations of Schedule 3 and listed in this item relate to the power of the Registrar to grant an extension of time for a party to provide evidence in an opposition proceeding. Consistent with the application provisions for the Patents Regulations as discussed at item 2, regulation 23.36(2) of Part 1 above, the amended provisions are to apply to opposition proceedings commenced before the commencement date of the Schedule and a request for an extension of time is made for an evidentiary period that started on or after the commencement date of the Schedule.

Regulation 22.9 (2) – transitional provisions for Schedule 4

Amendments of Trade Mark Regulations 1995

The amendments at items [31] to [48] concern amendments relating to the trade marks attorney profession that allow for the incorporation of trade marks attorneys, professional indemnity insurance and attorney discipline and suspension. With the exception of item [41], these amendments do not require application provisions. This is consistent with Schedule 4 to the Act.

The amendment at item [41] introduces a suspension scheme for individual attorneys who have been charged with a serious offence.

The attorney suspension provisions will apply to charges laid on or after the commencement of the Regulation, regardless of whether the alleged offence occurred before or after commencement of the provisions.

Regulation 22.9 (3) – transitional provisions for Part 3, Schedule 6

Amendments of Trade Mark Regulations 1995

The amendments made by item [96] relate to amendments to the Trade Marks Regulations to clarify that the Registrar has the discretion to decide the means by which a person may be heard.

The changes will made by this item will apply to a hearing for which the Registrar has issued a hearing notice, or an invitation to be heard, on or after the day of commencement of the Schedule.

The remaining items in Part 3, Schedule 6 do not require application provisions, consistent with the related provisions of the Act. The default application provided for by the *Acts Interpretation Act 1901* should apply.

Part 3 – Designs Regulations 2004

Regulation 12.05 – transitional provisions for Part 1, Schedule 6

Amendments of Designs Regulations 2004

The amendments made by item [3] relate to amendments to the Designs Regulations to clarify that the Registrar has the discretion to decide the means by which a person may be heard.

The changes will made by these items, with the exception of new subregulation 11.22(1), will apply to a hearing for which the Registrar has issued a hearing notice, or an invitation to be heard, on or after the day of commencement of the Schedule.

The remaining items in Part 1, Schedule 6 do not require application provisions, consistent with the related provisions of the Act. The default application provided for by the *Acts Interpretation Act 1901* should apply.

Copyright Regulations 1969 and Trade Marks Regulations 1995

Miscellaneous – transitional arrangement for Schedule 5

Consistent with the changes in Schedule 5 of the Intellectual Property Laws Amendment (Raising the Bar) Act, no application provisions will be necessary for these corresponding regulations in Schedule 5. The default application provided for by the *Acts Interpretation Act 1901* should apply.

Statement of Compatibility with Human Rights

Prepared in accordance with Part 3 of the Human Rights (Parliamentary Scrutiny) Act 2011

Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013

This Legislative Instrument is compatible with the human rights and freedoms recognised or declared in the international instruments listed in section 3 of the *Human Rights (Parliamentary Scrutiny) Act 2011*.

Overview of the Legislative Instrument

This Legislative Instrument amends the *Copyright Regulations 1969*, the *Designs Regulations 2004*, the *Patents Regulations 1991*, and the *Trade Marks Regulations 1995* to reform the intellectual property (IP) rights system.

Most of the amendments are required to implement the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (the Raising the Bar Act). The objective of the intellectual property (IP) rights system is to support innovation by encouraging investment in research and technology in Australia and by helping Australian businesses benefit from their good ideas. The purpose of the Act is to make improvements to IP rights legislation to better meet these objectives.

The amendments make a number of changes to the regulations. The Regulation would implement the Raising the Bar Act by prescribing requirements under the provisions amended by the Raising the Bar Act and by specifying the administrative and technical details required to give effect to the policy of the Raising the Bar Act. The changes have been divided into the following Schedules (mirroring Schedules 1 and 3 – 6 of the Raising the Bar Act):

- Schedule 1 – Raising the quality of granted patents. The Regulation amend the *Patents Regulations 1991* (the Patents Regulations) to implement changes to the key tests for patentability.
- Schedule 3 – Reducing delays in the resolution of patent and trade mark applications. The Regulation amend the Patents Regulations and the *Trade Marks Regulations 1995* (the Trade Marks Regulations) to reduce delays in the resolution of patent and trade marks applications.
- Schedule 4 – Assisting the operations of the IP profession. The Regulation amend the Patents Regulations and the Trade Marks Regulations to implement changes to the Patents Act and the Trade Marks Act regarding the regulation of the patent attorney and trade marks attorney professions.
- Schedule 5 – Improving mechanisms for trade mark and copyright enforcement. The Regulation amend the Copyright Regulations and the Trade Marks Regulations regarding the Customs procedures for dealing with imports that are suspected of infringing IP rights.
- Schedule 6 – Simplifying the IP System. The Regulation amend the Patents Regulations, the Trade Marks Regulations, and the *Designs Regulations 2004*

(the Designs Regulations) to simplify processes and reduce the burdens on applicants and other users of the system.

The purpose of this Legislative Instrument is to support and encourage innovation in Australia by improving the existing Intellectual Property (IP) legislation, for the benefit of the Australian public.

Human rights implications

The Legislative Instrument engages the following human rights:

- The right to work (article 6 of the International Covenant on Economic Social and Cultural Rights (ICESCR))
- The right to the presumption of innocence (article 14(2) of the International Covenant on Civil and Political Rights (ICCPR))
- The right to privacy (article 17 of the ICCPR)
- The right to freedom of expression (article 19(2) of the ICCPR)

Right to work

Article 6 of ICESCR recognises the right to work, including the right of everyone to the opportunity to gain his living by work which he freely chooses and accepts. However, article 4 of ICESCR recognises that the right to work may be subject to such limitations as are determined by law, are compatible with the rights in ICESCR and are solely for the purpose of promoting the general welfare in a democratic society.

Chapters 20 of the Patents Act and Regulations, section 156 of the Trade Marks Act, and Part 20 of the Trade Marks Regulations regulates a class of IP professionals known as registered patent attorneys and registered trade marks attorneys. Attorneys provide IP advice to applicants and other businesses. Attorneys must meet certain technical, legal and character requirements to be registered. Once registered, they have various exclusive rights under the legislation.

Item [14], of Schedule 4 to the Legislative Instrument (new regulation 20.28B) contains provisions allowing for the temporary suspension of the registration of a patent or trade marks attorney should the attorney be charged with a serious offence. A serious offence is defined as an offence relating to obtaining property or financial advantage by deception or fraudulent conduct, and is an offence against a law that is or would be considered an indictable offence of the Commonwealth, State or Territory (see items [10] and [38] of Schedule 4). The provisions allowing for the temporary suspension of an attorney's registration limit the right to work. However, the suspension provisions are clearly and objectively defined in this instrument and are thus determined by law.

They also pursue a legitimate aim, as the suspension of the attorney provides a mechanism for protecting the interests of the attorney's clients. The IP matters dealt with by an attorney may involve significant expenditure and financial risk on the part of the attorney's clients, who are made up of the Australian public. The suspension procedures therefore operate to promote the general welfare of Australian society.

Several legislative safeguards are also in place in relation to the suspension provisions. The suspension of an attorney is limited by items [14] and [41] of Schedule 4: the suspension must end if the charge is abandoned, the attorney is exonerated, the Disciplinary Tribunal for Patent and Trade Marks Attorneys decides not to continue the suspension or if the Designated Manager (the officer responsible for registering attorneys) considers it is no longer necessary. Items [23] and [45] ensure that the Administrative Appeals Tribunal can review any decision to suspend an attorney.

The ability to suspend an attorney charged with a serious offence is broadly similar to comparative legal frameworks, such as the existing ability to suspend a lawyer charged with a serious offence – see for example section 78 of the *Legal Profession Act 2004 (NSW)*, section 2.4.22 of the *Legal Profession Act 2004 (Vic)*, and section 63 of the *Legal profession Act 2007 (Qld)*.

Accordingly, these sections do not unreasonably limit the right to work, as the limitations are necessary in view of the greater public good, and reasonable and proportionate in their form with safeguards for review.

Right to presumption of innocence

The provisions permitting the Designated Manager to suspend the registration of an attorney charged with a serious offence (described above) could be seen to be prejudicial to the right to a presumption of innocence (Article 14(2) ICCPR).

The presumption of innocence relates to a criminal charge (Article 14(2) ICCPR). The suspension of the attorney is a separate matter to the criminal charge. The suspension itself is not a criminal charge. The suspension in no way affects how the charge is prosecuted and does not affect how the trial will be conducted. The purpose of the suspension is to protect the interests of the attorney's clients.

Right to Privacy

Article 17 of the ICCPR prohibits arbitrary or unlawful interference with a person's privacy, family, home or correspondence. Interferences with privacy may be permissible, provided that they are authorised by law and are not arbitrary. In order for an interference with the right to privacy not to be 'arbitrary', the interference must be for a reason consistent with the provisions, aims and objectives of the ICCPR and be reasonable in the particular circumstances. The United Nations Human Rights Committee has interpreted 'reasonableness' in this context to imply that 'any interference with privacy must be proportional to the end sought and be necessary in the circumstances of any given case'. The right to privacy will be engaged when personal information is collected, used, stored and shared.

The amendments in item [38] of Schedule 6 to the Regulation promote the right to privacy in Article 17 of the ICCPR.

Ordinarily documents filed in relation to a patent application become Open to Public Inspection (OPI) at various times, based on the provisions of Chapter 4 of the Patents Act and Chapter 4 of the Patents Regulations. However, occasionally parties file documents with the Commissioner of Patents that include sensitive personal information. For example, a declaration in support of an application for an extension of time under the Act may include explicit details of a personal illness suffered by the applicant that caused them to miss a deadline. On the face of it there is no need for the general public to have access to such information. However, there is limited provision under the current legislation to make such information non-OPI. If the Commissioner has reasonable grounds for believing that the document should be non-OPI, she can only make it non-OPI under the existing paragraph 4.3(2)(b) if the document has been required to be produced before the Commissioner under paragraph 210(c) of the Patents Act.

The amendments address this by permitting the Commissioner to make any document non-OPI if the Commissioner has reasonable grounds for believing that the document should be non-OPI, regardless of whether the document was required to be produced before the Commissioner or not. This provides the Commissioner with an avenue to better protect the privacy of individuals where their sensitive personal information is included in documents filed with the Commissioner. Accordingly, this amendment promotes the right to privacy.

This instrument also limits the right to privacy. Schedule 5 to the Raising the Bar Act introduced changes to the *Copyright Act 1968* and the *Trade Marks Act 1995* to improve the provisions for dealing with imports that are suspected of infringing copyright or registered trade marks.

The current legislation sets up a scheme where the IP rights owner can lodge a ‘notice of objection’ with Australian Customs and Border protection Service (‘Customs and Border Protection’) in respect of a particular copyright or trade mark. Customs and Border Protection will then seize goods suspected of infringing those rights for a limited period of time, to permit the IP owner to institute infringement proceedings against the importer.

A problem with the current scheme is that importers may deliberately go underground during the action period (the period in which proceedings must be instituted, otherwise the seized copies or goods will be released); only to resurface to claim the suspected infringing goods after the action period has elapsed.

Schedule 5 to the Raising the Bar Act addresses this by instituting a claim for release scheme. If an importer wishes to reclaim goods after the end of the action period, they must first file a claim for release – a failure to file a valid claim for release will result in the seized goods being forfeited. The intention is that the claim form will provide sufficient information about the importer of the goods (or their Australian agent) to enable them to be contacted for the purposes of instituting infringement proceedings. The Customs and Border Protection CEO is authorised under the Acts to pass this information on to the rights owner.

Regulation 22B of the Copyright Regulations and regulation 13.5 of the Trade Marks Regulations (see items [1] and [2] of Schedule 5 to this Legislative Instrument)

prescribe the information that must be included in a valid claim for release. It includes:

- the importer or designated owner’s full name, home or business address and address for service
 - the importer or designated owner’s telephone number
- if the importer or designated owner’s home or business address is not in Australia:
 - an address for service for the person who is the importer’s agent in Australia
 - a telephone number for the person
 - information showing that the person agreed to be the importer’s agent

This legal regime pursues a legitimate aim, namely, to stop the current practice of those suspected of infringing trade marks or copyrights evading legal proceedings against them.

To the extent that the measures in the legislative instrument may limit the right to protection from arbitrary and unlawful interference with privacy in Article 17 of the ICCPR, the limitation is proportionate to achieving that legitimate objective. This is because IP rights owners need access to this personal information to allow them the opportunity to enforce their IP rights in the situation described above. Without such information the IP rights owner is deprived of the ability to enforce their legal rights. This regime provides a limited and reasonable manner of achieving this objective, with several safeguards in place. For example, the collection and dissemination of information will only occur in specified circumstances (where the goods are suspected of infringing a trade mark or copyright), only the Customs and Border Protection CEO has the power to seize goods, the Customs and Border Protection CEO may only seize copies or goods in the circumstances specified in section 135 of the Copyright Act and section 133 of the Trade Marks Act and disclosure of the information in the claim for release form will be limited to the IP rights owner or designated representative.

This limitation to article 17 of the ICCPR, set out in part in the Regulation, is clearly defined and authorised by Australian law. The defined nature and safeguards on the limitation indicates that it is proportionate to its objective, reasonable in all the circumstances and is not arbitrary.

Freedom of expression

The right to freedom of expression includes the right to seek, receive and impart information (art 19(2) ICCPR). The amendments in item [38] of Schedule 6 give the Commissioner the discretion to make certain information non-OPI (described in more detail above). The public will not receive that information and the Commissioner will not impart that information, except under section 56 of the Patents Act, which permits the Commissioner to grant inspection. The amendments limit the right to freedom of expression. Limitations on Article 19(2) can be made for specific purposes (in article 19(3)). The limitation in the amendments is consistent with article 19(3)(a). Allowing the Commissioner to make sensitive personal information non-OPI respects the rights or reputations of others and promotes the right to privacy in Article 17 as discussed

above. These amendments are a reasonable limitation on the right to freedom of expression.

Conclusion

This Legislative Instrument is compatible with human rights because it advances the protection of human rights, and to the extent that it also limits human rights, those limitations are reasonable, necessary and proportionate.

The Hon Greg Combet AM, Minister for Industry and Innovation