



# **Intellectual Property Laws Amendment (PCT Translations and Other Measures) Regulations 2019**

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I, General the Honourable Sir Peter Cosgrove AK MC (Ret'd), Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following regulations.

Dated 21 March 2019

Peter Cosgrove  
Governor-General

By His Excellency's Command

Karen Andrews  
Minister for Industry, Science and Technology

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## 1 Name

This instrument is the *Intellectual Property Laws Amendment (PCT Translations and Other Measures) Regulations 2019*.

## 2 Commencement

- (1) Each provision of this instrument specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.

Commencement information		
Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
1. Sections 1 to 4 and anything in this instrument not elsewhere covered by this table	The day after this instrument is registered.	26 March 2019
2. Schedule 1	The day after the end of the period of 6 months beginning on the day this instrument is registered.	25 September 2019
3. Schedule 2	The day after this instrument is registered.	26 March 2019

Note: This table relates only to the provisions of this instrument as originally made. It will not be amended to deal with any later amendments of this instrument.

- (2) Any information in column 3 of the table is not part of this instrument. Information may be inserted in this column, or information in it may be edited, in any published version of this instrument.

## 3 Authority

This instrument is made under the following:

- (a) the *Designs Act 2003*;
- (b) the *Patents Act 1990*.

## 4 Schedules

Each instrument that is specified in a Schedule to this instrument is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this instrument has effect according to its terms.

## Schedule 1—PCT translations

### *Patents Regulations 1991*

#### **1 Paragraph 2.7(b)**

Repeal the paragraph, substitute:

- (b) if the document is not in English, a copy of a translation of the document into English; and

#### **2 Subparagraph 3.1(2)(c)(iii)**

Omit “and a related certificate of verification”.

#### **3 Paragraph 3.2C(2)(aa)**

Omit “relates; and”, substitute “relates.”.

#### **4 Paragraph 3.2C(2)(b)**

Repeal the paragraph.

#### **5 Subparagraph 3.5A(3)(b)(iii)**

Omit “together with a related certificate of verification”.

#### **6 Subparagraph 3.5AB(2)(b)(ii)**

Repeal the subparagraph, substitute:

- (ii) if the application is not filed in English and has not been published in English under Article 21 of the PCT—a translation into English of the specification of the PCT application as filed (with or without any rectifications under Rule 91 of the PCT) has been filed; and

#### **7 Subregulation 3.5AC(3)**

Omit “If”, substitute “Subject to subregulation (3A), if”.

#### **8 After subregulation 3.5AC(3)**

Insert:

*Translation of Article 19 amendment into English*

(3A) If:

- (a) a PCT application was amended under Article 19 of the PCT; and
  - (b) the application was amended before the applicant met the requirements of subsection 29A(5) of the Act; and
  - (c) the amendment has not been published in English under Article 21 of the PCT; and
  - (d) a translation of the amendment into English is filed no later than when the applicant meets the requirements of subsection 29A(5) of the Act;
- the description, drawings and claims contained in the application are taken to have been amended on the day the translation of the amendment into English was filed.

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**9 Subregulation 3.5AC(5)**

Omit “If”, substitute “Subject to subregulations (5A) and (6), if”.

**10 After subregulation 3.5AC(5)**

Insert:

*Translation of Article 34 amendment into English*

(5A) If:

- (a) a PCT application in respect of which Australia has been elected under Chapter II of the PCT has been amended under Article 34 of the PCT; and
- (b) an international preliminary examination report is established before the applicant meets the requirements of subsection 29A(5) of the Act; and
- (c) the amendment has not been published in English under Article 21 of the PCT; and
- (d) a translation of the amendment into English is filed no later than when the applicant meets the requirements of subsection 29A(5) of the Act;

the description, drawings and claims contained in the application are taken to have been amended on the day the translation of the amendment into English was filed.

**11 At the end of regulation 3.5AC**

Add:

*Correction of incorrect translations*

- (8) If the applicant for a PCT application becomes aware of an error or omission in the translation of an amendment mentioned in subregulation (3A) or (5A), the applicant may file a corrected translation of the amendment.
- (9) If the Commissioner reasonably believes that the translation of an amendment mentioned in subregulation (3A) or (5A) does not accurately reflect the amendment, the Commissioner may, by notification to the applicant, require the applicant to do either of the following:
  - (a) file a corrected translation of the amendment and a certificate of verification for the corrected translation;
  - (b) file a certificate of verification for the translation.
- (10) If an applicant is given a notification under subregulation (9), the applicant must comply with the notification within 2 months after the day the notification is given.
- (11) For the purposes of paragraph 142(2)(f) of the Act, a PCT application lapses if:
  - (a) the applicant for the PCT application is given a notification under subregulation (9); and
  - (b) the applicant does not comply with the notification within the period required by subregulation (10).

*Effect of corrections*

- (12) The filing of a corrected translation of an amendment of a PCT application in accordance with this regulation is not an amendment for the purposes of subsection 29A(3) of the Act.

**12 After subregulation 3.5AF(2)**

Insert:

*Translations not published under Article 21 of PCT*

- (2A) Subregulations (2B), (2C) and (2D) apply if:
- (a) a PCT application is not filed in English; and
  - (b) the PCT application has not been published in English under Article 21 of the PCT.
- (2B) For the purposes of paragraph 29A(5)(a) of the Act, the requirement to file a translation of the PCT application into English is met if the applicant files a translation into English of the specification of the PCT application as filed (with or without any rectifications under Rule 91 of the PCT).

*Correction of incorrect translations*

- (2C) If the applicant for the PCT application becomes aware of an error or omission in the translation of the specification, the applicant may file a corrected translation of the specification.
- (2D) If the Commissioner reasonably believes that the translation of the specification does not accurately reflect the specification, the Commissioner may, by notification to the applicant, require the applicant to do either of the following:
- (a) file a corrected translation of the specification and a certificate of verification for the corrected translation;
  - (b) file a certificate of verification for the translation.
- (2E) If an applicant is given a notification under subregulation (2D), the applicant must comply with the notification within 2 months after the day the notification is given.
- (2F) For the purposes of paragraph 142(2)(f) of the Act, a PCT application lapses if:
- (a) the applicant for the PCT application is given a notification under subregulation (2D); and
  - (b) the applicant does not comply with the notification within the period required by subregulation (2E).

*Effect of corrections*

- (2G) An error or omission in a translation of a specification of a PCT application, or the filing of a corrected translation of a specification of a PCT application, does not have the effect that the requirements of subsection 29A(5) of the Act have not been met in relation to the application.
- (2H) The filing of a corrected translation of a specification of a PCT application in accordance with this regulation is not an amendment for the purposes of subsection 29A(3) of the Act.

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**13 Subregulation 3.5AF(4)**

Omit “this regulation”, substitute “subregulations (1) and (3)”.

**14 Paragraph 3.14D(1)(e)**

Omit “and a certificate of verification of the translation”.

**15 Paragraph 3.23(1)(c)**

Omit “and a related certificate of verification”.

**16 Paragraph 9.2(3)(b)**

Omit “and a related certificate of verification”.

**17 Paragraph 13.4(1)(b)**

Repeal the paragraph, substitute:

- (b) if examination is requested on or after 15 April 2013 and paragraph (c) does not apply—12 months from the date of the first report (if any) under section 45 of the Act;
- (c) if:
  - (i) examination is requested on or after 15 April 2013; and
  - (ii) notification is given to a person under subregulation 3.5AC(9), 3.5AF(2D) or 22.15A(2) in relation to the application on or after the date of the first report (if any) under section 45 of the Act; and
  - (iii) the person complies with the notification within the period required by the relevant subregulation;  
14 months from the date of the first report (if any) under section 45 of the Act;

**18 Subparagraph 22.15(3)(b)(ii)**

Repeal the subparagraph, substitute:

- (ii) if required by regulation 22.15A—a related certificate of verification.

**19 After regulation 22.15**

Insert:

**22.15A Certificate of verification and corrected translation**

- (1) This regulation applies if:
  - (a) a translation of a document into English is filed; and
  - (b) the Commissioner reasonably believes that the translation does not accurately reflect the contents of the document.
- (2) The Commissioner may, by notification given to the person who filed the document, require the person to do either of the following within 2 months after the day the notification is given to the person:
  - (a) file a corrected translation of the document and a certificate of verification for the corrected translation;
  - (b) file a certificate of verification for the translation.
- (3) If:

- (a) the notification is given in relation to an application for a standard patent; and
  - (b) the person to whom the notification is given is the applicant for the standard patent; and
  - (c) the person does not comply with the notification within the period specified in subregulation (2); and
  - (d) the application for the standard patent has not been accepted;
- the application for the standard patent lapses at the end of that period.
- (4) If an application lapses under subregulation (3), the Commissioner must:
- (a) advertise that fact in the *Official Journal*; and
  - (b) notify the applicant that the application has lapsed.
- (5) If:
- (a) the notification is given in relation to a translation filed as part of a notice of an assertion under subsection 27(1) or 28(1) of the Act; and
  - (b) the person to whom the notification is given does not comply with the notification within the period specified in subregulation (2);
- the Commissioner may take that fact into account in deciding how much weight (if any) to give to the notice of the assertion.
- (6) If:
- (a) the notification is given in relation to a translation filed as part of a request for re-examination of a complete specification; and
  - (b) the person to whom the notification is given does not comply with the notification within the period specified in subregulation (2);
- the Commissioner may decide not to re-examine the complete specification.
- (7) If:
- (a) the notification is given in relation to a translation of any other document; and
  - (b) the person to whom the notification is given does not comply with the notification within the period specified in subregulation (2);
- the Commissioner may take one or more of the actions listed in subregulation (8) in relation to the person if the Commissioner is satisfied, on the balance of probabilities, that it is appropriate in the circumstances to take the action.
- (8) The actions the Commissioner may take are:
- (a) if the person to whom the notification is given is an applicant for a patent—a refusal to grant the patent; or
  - (b) the drawing of an inference unfavourable to the person’s interest in proceedings before the Commissioner.
- (9) In deciding whether it is appropriate to take the action, the Commissioner must consider the following:
- (a) whether the person has a reasonable excuse for refusing or failing to comply with the notification;
  - (b) any other matter the Commissioner considers to be relevant.

## 20 Before regulation 23.50

Insert:

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**23.50A Amendments made by Schedule 1**

- (1) Subject to subregulation (2), the amendments of these Regulations made by Schedule 1 to the *Intellectual Property Laws Amendment (PCT Translations and Other Measures) Regulations 2019* apply in relation to translations filed after the commencement of that Schedule.
- (2) The amendments of regulation 3.5AF made by Schedule 1 to the *Intellectual Property Laws Amendment (PCT Translations and Other Measures) Regulations 2019* apply in relation to applications that meet the requirements of subsection 29A(5) of the Act after the commencement of that Schedule.

## Schedule 2—Other amendments

### Part 1—Delegation

#### *Designs Regulations 2004*

##### **1 Regulation 10.01**

Before “For subsection”, insert “(1)”.

##### **2 At the end of regulation 10.01**

Add:

- (2) The Registrar may delegate all or any of the Registrar’s powers or functions under paragraph 127(1)(a) or (c) of the Act to an employee of the Designs Office who holds or performs the duties of an Executive Level 1 position, or an equivalent or higher position.

#### *Patents Regulations 1991*

##### **3 Regulation 21.2**

Before “For”, insert “(1)”.

##### **4 Regulation 21.2**

Omit “210(a) and (c)”, substitute “210(1)(a) and (c)”.

##### **5 At the end of regulation 21.2**

Add:

- (2) The Commissioner may delegate all or any of the Commissioner’s powers or functions under paragraph 210(1)(a) or (c) of the Act to an employee of the Patent Office who holds or performs the duties of an Executive Level 1 position, or an equivalent or higher position.

Note: Under paragraphs 210(1)(a) and (c) of the Act, the Commissioner may summon witnesses and require the production of documents or articles.

## **Part 2—Fees**

### *Patents Regulations 1991*

#### **6 Clause 4 of Schedule 7 (table item 404)**

Repeal the item, substitute:

- 404        The international filing fee (where applicable, as reduced under item 403) and the handling fee are reduced in accordance with item 5 of the Schedule of Fees set out in the PCT.

## **Part 3—Extension of time for acceptance**

### ***Patents Regulations 1991***

#### **7 Paragraph 13.4(1)(f)**

Repeal the paragraph, substitute:

- (f) if a person has applied under subsection 36(1) of the Act for a declaration in relation to the patent request and complete specification—subject to subregulation (3), the period of 3 months from the day the Commissioner decides to make a declaration, or to refuse to make a declaration;

## **Part 4—Certificate of verification**

### *Patents Regulations 1991*

#### **8 Subregulation 1.3(1) (paragraph (a) of the definition of *certificate of verification*)**

Omit “accompanying”, substitute “relevant”.

## **Part 5—Spent provisions**

### *Patents Regulations 1991*

#### **9 Subregulation 3.2C(1) (note)**

Repeal the note.

#### **10 Subregulation 3.2C(7)**

Repeal the subregulation.

## **Part 6—Application, transitional and saving provisions**

### *Patents Regulations 1991*

#### **11 In the appropriate position in Chapter 23**

Insert:

## **Part 5—Amendments made by the Intellectual Property Laws Amendment (PCT Translations and Other Measures) Regulations 2019**

### **23.50 Amendment made by Part 3 of Schedule 2**

The amendment of regulation 13.4 made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (PCT Translations and Other Measures) Regulations 2019* applies in relation to:

- (a) applications made after the commencement of that Part; and
- (b) applications made but not decided before that commencement.