

PATENTS AMENDMENT ACT 1976

No. 162 of 1976

An Act to amend the *Patents Act* 1952 and for related purposes.

BE IT ENACTED by the Queen, and the Senate and House of Representatives of the Commonwealth of Australia, as follows:—

1. (1) This Act may be cited as the *Patents Amendment Act* 1976.¹

Short
title, &c.

(2) The *Patents Act* 1952² is in this Act referred to as the Principal Act.

2. (1) Sections 3, 4, 6, 7 and 10 shall come into operation on a date to be fixed by Proclamation, not being earlier than the day that is the commencing day for the purposes of the *Federal Court of Australia Act* 1976.

Commence-
ment.

(2) The remaining provisions of this Act shall come into operation on the day on which this Act receives the Royal Assent.¹

3. Section 6 of the Principal Act is amended by inserting after the definition of “patentee” the following definition:—

Definitions.

“ ‘prescribed court’ means the Supreme Court of a State, the Supreme Court of the Australian Capital Territory, the Supreme Court of the Northern Territory of Australia or the Supreme Court of Norfolk Island; ”.

4. After section 6 of the Principal Act the following section is inserted:—

“6A. A reference in this Act to a prescribed court shall be read—

References
to prescribed
court.

(a) in relation to the institution of an appeal or other proceeding, as a reference to a prescribed court having jurisdiction to hear and determine the appeal or other proceeding; and

(b) in relation to the exercise of jurisdiction, as a reference to a prescribed court exercising jurisdiction in accordance with section 146.”.

5. Section 8 of the Principal Act is repealed and the following section substituted:—

“8. (1) This Act extends to Norfolk Island.

Application
of Act to
Norfolk
Island.

“(2) An application for a patent is not receivable under a law (other than this Act) in force in Norfolk Island.”.

Proceedings
to be re-
moved from
State Court
to High
Court where
counter-
claim for
revocation.

6. (1) Section 116 of the Principal Act is repealed.

(2) Notwithstanding the repeal effected by this section, if an action or proceeding was removed, or required to be removed, into the High Court under section 116 of the Principal Act before the date of commencement of this section and had not been finally determined before that date—

- (a) if the provisions of sub-section (2) of that section had not been fully complied with, those provisions continue to apply in relation to the action or proceeding; and
- (b) the provisions of sections 41, 43, 44 and 46 of the *Judiciary Act* 1903, as amended and in force on the date of commencement of the *Patents Act* 1952, continue to apply in relation to the action or proceeding.

7. Part XVII of the Principal Act is repealed and the following Part substituted:—

“PART XVII—JURISDICTION AND POWERS OF COURTS

Jurisdiction
of
prescribed
courts.

“146. (1) Subject to sub-section (2), every prescribed court has jurisdiction to hear and determine proceedings that, under this Act, may be instituted in a prescribed court.

“(2) A prescribed court, being the Supreme Court of a Territory, does not have jurisdiction to hear and determine a proceeding referred to in sub-section (1) unless, at the time of the institution of the proceeding, the person instituting the proceeding, being an individual, is resident in the Territory, or, being a corporation, has its principal place of business in the Territory.

“(3) The jurisdiction of a prescribed court under this section shall be exercised by a single Judge.

Transfer of
proceedings.

“147. (1) A prescribed court in which proceedings have been instituted under this Act may, if the court thinks fit, upon application of a party made at any stage in the proceedings, by order, transfer the proceedings to another prescribed court having jurisdiction to hear and determine the proceedings.

“(2) Where proceedings are transferred from a court in pursuance of this section—

- (a) all documents filed of record in that court shall be transmitted by the Registrar or other proper officer of that court to the Registrar or other proper officer of the court to which the proceedings are transferred; and
- (b) the court to which the proceedings are transferred shall proceed as if the proceedings had been originally instituted in that court and as if the same proceedings had been taken in that court as

had been taken in the court from which the proceedings were transferred.

“148. (1) Subject to sub-section (2), an appeal lies to the Federal Court of Australia from a judgment or order of a prescribed court exercising jurisdiction under this Act.

Appeals from prescribed courts.

“(2) Where the judgment or order of a prescribed court appealed from was pronounced or made in the exercise of its jurisdiction to hear and determine appeals from decisions or directions of the Commissioner, an appeal to the Federal Court of Australia does not lie without leave of that Court.

“(3) An appeal lies to the High Court, with special leave of the High Court, from a judgment or order referred to in sub-section (1).

“(4) Except as provided in the foregoing provisions of this section, no appeal lies from a judgment or order referred to in sub-section (1).

“149. A prescribed court may grant to the Commissioner leave to intervene in an appeal to the court.

Intervention by Commissioner.

“150. Upon the hearing of an appeal from a decision or direction of the Commissioner, the prescribed court may—

Powers of prescribed courts.

- (a) if it thinks fit, call in the aid of an assessor specially qualified to assist it in the hearing and determination of the appeal;
- (b) admit further evidence, either orally or upon affidavit or otherwise;
- (c) permit the examination and cross-examination of witnesses, including witnesses who gave evidence orally or upon affidavit or otherwise at the hearing before the Commissioner;
- (d) order an issue of fact to be tried in such manner as it directs;
- (e) affirm, reverse or modify the decision or direction appealed from;
- (f) give such judgment, or make such order, as in all the circumstances it thinks fit, or refuse to make an order; and
- (g) order a party to pay costs to another party.”.

8. The Principal Act is amended by inserting before Part XVIII the following Part:—

“PART XVIII—APPLICATIONS FOR REVIEW OF CERTAIN DECISIONS BY ADMINISTRATIVE APPEALS TRIBUNAL

“151. An application may be made to the Administrative Appeals Tribunal for a review of—

Application for review.

- (a) a decision of the Commissioner under—
 - (i) section 47E, 98, 154, 159C or 160; or

(ii) sub-section (4) of section 77 or sub-section (1) of section 106; or

(b) a decision of the Commissioner under Part XV not to register a person who has applied for registration as a patent attorney under that Part,

made on or after the commencement of this Part.

Con-
stitution of
Tribunal.

“151A. Notwithstanding sub-section (1) of section 21 of the *Administrative Appeals Tribunal Act* 1975, the Administrative Appeals Tribunal shall, for the purpose of the exercise of its powers in relation to an application under paragraph (a) of sub-section (1) of section 151, be constituted by a presidential member sitting alone.”

Con-
sequential
amend-
ments.

9. (1) The Principal Act is amended by omitting sub-sections 47E (10), 77 (5), 98 (6), 106 (2), 154 (5), 159C (5) and 160 (7).

(2) The amendments made by this section do not affect any appeal instituted under any of the provisions referred to in sub-section (1) before the commencement of this section, or anything arising out of, or any proceeding incidental to or connected with, any such appeal.

Further
amendments
of Principal
Act.

10. (1) The Principal Act is amended as set out in the Schedule.

(2) The amendments made by this section do not affect any proceedings instituted, under the Principal Act or under the regulations in force under the Principal Act, in the High Court (whether as the Appeal Tribunal under the Principal Act or otherwise) before the date of commencement of this section, or anything arising out of, or any proceeding incidental to or connected with, any such proceeding.

Amendment
of
Admini-
strative
Appeals
Tribunal
Act.

11. (1) The Schedule to the *Administrative Appeals Tribunal Act* 1975³ is amended by omitting sub-clause (1) of clause 24.

(2) Notwithstanding the amendment made by this section, applications may be made in accordance with the provision omitted by this section in respect of decisions given on or after 1 July 1976 and before the commencement of this section.

SCHEDULE

Section 10

FURTHER AMENDMENTS OF PRINCIPAL ACT

1. In each of the following provisions of the Principal Act the words “a prescribed court” are substituted for the words “the Appeal Tribunal”, wherever occurring in the provision or, where so indicated, occurring as specified in relation to the provision:—

Section 49 (8), 50 (6), 52 (8), 52D (9), 60 (5) (second occurring), 63 (4), 66 (3) (c), 73 (4), 81 (2), 84 (second occurring), 98 (6) (first occurring), 155 (2), 159C (2), 163 (2) and 170 (first occurring).

SCHEDULE—continued

2. In each of the following provisions of the Principal Act the words “the prescribed court” are substituted for the words “the Appeal Tribunal”, wherever occurring in the provision or, where so indicated, occurring as specified in relation to the provision:—

Sections 54 (2), 60 (5) (first occurring), 66 (3) (e), 81 (3), 84 (first occurring), 98 (6) (second occurring) and 170 (second and third occurring).

3. In each of the following provisions of the Principal Act the words “a prescribed court” are substituted for the words “the High Court”, wherever occurring in the provision or, where so indicated, as specified in relation to the provision:—

Sections 32 (1) and (2), 90 (1), 95 (1), (5), (6) and (12) (first, second and fourth occurring), 99, 103, 108, 109, 115, 120 (1) and (3), 125 (5), 126, 129 (3), 138 and 167.

4. In each of the following provisions of the Principal Act the words “the prescribed court” are substituted for the words “the High Court”, wherever occurring in the provision or, where so indicated, occurring as specified in relation to the provision:—

Sections 32 (3), 91, 92, 93, 94, 95 (9) and (12) (third occurring), 120 (4), 122 (2) and 125 (6).

5. The Principal Act is further amended as set out below:—

| Provision | Amendment |
|-----------------------------------|--|
| Section 66 (1) | Omit “High Court”, substitute “Commissioner”. |
| Section 86 | Omit “, Justice” (wherever occurring). |
| Section 94 | Omit “Court” (wherever occurring), substitute “court”. |
| Section 95 (6) | Omit “shall be made as prescribed by Rules of Court”. |
| Section 95 (7) | Omit the sub-section, substitute the following sub-section:— “(7) A person interested may, in the case of an application to a prescribed court or to the Commissioner, within such time and in such manner as are prescribed by the regulations, give notice of opposition to the granting of the application and shall serve a copy of the notice on the applicant.” |
| Sections 95 (9), 108, 109 and 110 | Omit “Court” (wherever occurring), substitute “court”. |
| Section 113 | Omit “the High Court”, substitute “every prescribed court”. |
| Sections 117 and 118 | Omit “, Justice” (wherever occurring). |
| Sections 120 (2) and 121 (4) | Omit “the High Court”, substitute “every prescribed court”. |
| Section 122 (2) | Omit “the provisions of section one hundred and sixteen of this Act and”. |
| Section 151 (a) (i) | After “47E,” insert “66,”. |
| Section 157A | Omit “, the Appeal Tribunal”. |
| Section 158 (1) (b) | Omit “, Appeal Tribunal or court”, substitute “or the prescribed court”. |
| Section 159A (1) | (a) Omit “, the Appeal Tribunal or a court”, substitute “or prescribed court”. (b) Omit “, Appeal Tribunal or court” (wherever occurring), substitute “or the prescribed court”. |
| Section 159A (2) | Omit “, the Appeal Tribunal or a court”, substitute “or the prescribed court”. |
| Section 159A (3) | (a) Omit “, the Appeal Tribunal or a court”, substitute “or a prescribed court”. (b) Omit “, Appeal Tribunal or court” (wherever occurring), substitute “or the prescribed court”. |
| Section 159A (4) | Omit “, the Appeal Tribunal or a court”, substitute “or the prescribed court”. |
| Section 166 | Omit “, Justice” (wherever occurring). |
| Section 177 (ac) | Omit “to the Appeal Tribunal”. |

NOTES

1. Act No. 162, 1976; assented to 9 December 1976.
2. Act No. 42, 1952, as amended. For previous amendments *see* Act No. 14, 1954; No. 3, 1955; No. 107, 1960; No. 84, 1962; No. 93, 1966; No. 34, 1969; No. 216, 1973 (as amended by No. 20, 1974); and No. 91, 1976.
3. Act No. 91, 1975, as amended.