Patents Act 1990

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About this compilation

This compilation

This is a compilation of the *Patents Act 1990* that shows the text of the law as amended and in force on 26 February 2015 (the ***compilation date***).

This compilation was prepared on 5 March 2015.

The notes at the end of this compilation (the ***endnotes***) include information about amending laws and the amendment history of provisions of the compiled law.

Uncommenced amendments

The effect of uncommenced amendments is not shown in the text of the compiled law. Any uncommenced amendments affecting the law are accessible on ComLaw (www.comlaw.gov.au). The details of amendments made up to, but not commenced at, the compilation date are underlined in the endnotes. For more information on any uncommenced amendments, see the series page on ComLaw for the compiled law.

Application, saving and transitional provisions for provisions and amendments

If the operation of a provision or amendment of the compiled law is affected by an application, saving or transitional provision that is not included in this compilation, details are included in the endnotes.

Modifications

If the compiled law is modified by another law, the compiled law operates as modified but the modification does not amend the text of the law. Accordingly, this compilation does not show the text of the compiled law as modified. For more information on any modifications, see the series page on ComLaw for the compiled law.

Self-repealing provisions

If a provision of the compiled law has been repealed in accordance with a provision of the law, details are included in the endnotes.

Contents

Chapter 1—Introductory 1

1 Short title ... 1
2 Commencement ... 1
3 Definitions ... 1
5 Associated applications ... 4
6 Deposit requirements ... 4
7 Novelty, inventive step and innovative step ... 5
7A Meaning of useful ... 6
9 Secret use ... 7
10 Certain international applications to be taken to have been given an international filing date ... 8
11 Act binds the Crown ... 8
12 Application of Act ... 8
12A Application of the *Criminal Code* ... 9

Chapter 2—Patent rights, ownership and validity 10

Part 1—Patent rights 10

13 Exclusive rights given by patent ... 10
14 Assignment of patent ... 10

Part 2—Ownership 11

15 Who may be granted a patent? ... 11
16 Co-ownership of patents ... 11
17 Directions to co-owners ... 12

Part 3—Validity 13

Division 1—Validity 13

18 Patentable inventions ... 13
19 Certificate of validity ... 14
20 Validity of patent not guaranteed ... 15
21 Validity not implied by making or refusal of non-infringement declaration ... 15

Division 2—Matters not affecting validity 16

22A Validity not affected by who patent is granted to ... 16
22 Invalidity in relation to one claim not to affect validity in relation to other claims ... 16

ComLaw Authoritative Act C2015C00060

23 Validity not affected by publication etc. after priority date ... 16
24 Validity not affected by making information available in certain circumstances ... 16
25 Validity: patents of addition ... 17
26 Validity not affected in certain cases involving amendments ... 17

Division 3—Notice of matters affecting validity 19

27 Notice of matters affecting validity of standard patents ... 19
28 Notice of matters affecting validity of innovation patents ... 19

Chapter 3—From application to acceptance 21

Part 1—Patent applications 21

Division 1—Applications 21

29 Application for patent—general rules ... 21
29A Applications for patents—special rules for PCT applications ... 21
29B Applications for patents—special rules for Convention applications ... 22
30 Filing date ... 23
31 Joint applicants ... 23
32 Disputes between applicants etc. ... 23
33 Applications by opponents etc. ... 24
34 Applications by eligible persons arising out of Court proceedings ... 26
35 Applications by eligible persons following revocation by Commissioner ... 27
36 Other applications by eligible persons ... 28
37 Complete application may be treated as provisional ... 29
38 Time for making complete application ... 29

Division 2—Specifications 30

40 Specifications ... 30
41 Specifications: micro-organisms ... 30
42 Micro-organisms ceasing to be reasonably available ... 32

ComLaw Authoritative Act C2015C00060

Division 3—Priority dates 34
43 Priority dates 34
43AA Disclosure in basic applications 35

Part 2—Examination of standard patent requests and specifications 37

Division 1A—Preliminary search and opinion 37
43A Preliminary search and opinion 37

Division 1—Examination 38
44 Request for examination 38
45 Examination 38

Part 3—Acceptance 40

Division 1—Acceptance of standard patents 40
49 Acceptance of patent request: standard patent 40
49A Postponing acceptance of patent request: standard patent 41
50 Application or grant may be refused in certain cases 41
50A Revocation of acceptance 42
51 Appeal 43

Division 2—Acceptance of innovation patents 44
52 Formalities check and acceptance of innovation patents 44

Chapter 4—Publication 45
53 Publication of certain information about applicants etc. 45
54 Notice of publication 45
55 Documents open to public inspection 47
56 Certain documents not to be published 48
56A Publication and inspection of PCT applications 48
57 Effect of publication of complete specification 48
58 Result of search may be disclosed 49

Chapter 5—Opposition to grant of standard patent 50
59 Opposition to grant of standard patent 50
60 Hearing and decision by Commissioner 50

ComLaw Authoritative Act C2015C00060

Chapter 6—Grant and term of patents 52

Part 1—Grant 52

61 Grant of standard patent 52
62 Grant and publication of innovation patent 52
63 Joint patentees 53
64 Grant: multiple applications 53
65 Date of patent 53

Part 2—Term 55

67 Term of standard patent 55
68 Term of innovation patent 55

Part 3—Extension of term of standard patents relating to pharmaceutical substances 56

70 Applications for extension of patent 56
71 Form and timing of an application 57
72 Notification and public inspection of application 58
73 Withdrawal of application 58
74 Acceptance or refusal of application 58
75 Opposition to grant of extension 59
76 Grant of extension 59
76A Notification of extension to the Secretary, Health and Family Services 60
77 Calculation of term of extension 60
78 Exclusive rights of patentee are limited if extension granted 61
79 Rights of patentee if extension granted after patent expires 61
79A Commissioner not to make decision if court proceedings pending 62

Chapter 6A—Divisional applications 63

79B Divisional applications prior to grant of patent 63
79C Divisional applications for innovation patents may be made after grant of an innovation patent 64

Chapter 7—Patents of addition 65

80 Chapter does not apply to innovation patents 65
81 Grant of patent of addition 65

ComLaw Authoritative Act C2015C00060

82 Revocation of patent and grant of patent of addition instead 65
83 Term of patent of addition 66
85 Revocation of patent for main invention 67
86 Renewal fees not payable 67
87 Fees payable where patent of addition becomes an independent patent 67

Chapter 9—Re-examination of standard patents 68
96A Chapter does not apply to innovation patents 68
97 Re-examination of complete specifications 68
98 Report on re-examination 69
99 Statement by applicant or patentee 69
100 Copies of report to be given to court 69
100A Refusal to grant patent—re-examination before grant 69
101 Revocation of patent—re-examination after grant 70

Chapter 9A—Examination, re-examination and opposition-innovation patents 72

Part 1—Examination of innovation patents 72
101A Examination may be requested or Commissioner may decide to examine 72
101B Examination of an innovation patent 72
101C How and when examination to be carried out 73
101E Certificate of examination 73
101EA Revocation of certificate of examination 74
101F Revocation of innovation patents following examination under section 101B 75

Part 2—Re-examination of innovation patents 77
101G Re-examination of complete specifications of innovation patents 77
101H Patentee statements 78
101J Revocation of innovation patent following re-examination 78
101K Relevant proceedings and re-examination 79
101L Copies of report to be given to court 79

Part 3—Opposition to innovation patents 80
101M Opposition to innovation patent 80

ComLaw Authoritative Act C2015C00060

101N Hearing and decision by the Commissioner 80
101P Relevant proceedings and opposition 81

Chapter 10—Amendments 82

Part 1—Amendments that are not allowable 82

102 What amendments are not allowable? 82
103 Consent of mortgagee or exclusive licensee needed 83

Part 2—Amendments of patent requests, specifications and other filed documents 85

104 Amendments by applicants and patentees 85
105 Amendments directed by court 85
106 Amendments directed by Commissioner: patents 86
107 Amendments directed by Commissioner: applications for standard patents 87
109 Appeal 88

Part 3—Miscellaneous 89

110 Advertisement of amendment of complete specification 89
112 Pending proceedings 89
112A Decisions on appeal 89
113 Persons claiming under assignment or agreement 89
114 Priority date of claims of certain amended specifications 90
114A Objection cannot be taken to certain amended specifications 90
115 Restriction on recovery of damages etc. 91
116 Interpretation of amended specifications 91

Chapter 11—Infringement 92

Part 1—Infringement and infringement proceedings 92

117 Infringement by supply of products 92
118 Infringement exemptions: use in or on foreign vessels, aircraft or vehicles 92
119 Infringement exemptions: prior use 93
119A Infringement exemptions: acts for obtaining regulatory approval of pharmaceuticals 95

ComLaw Authoritative Act C2015C00060

119B Infringement exemptions: acts for obtaining regulatory approval (non-pharmaceuticals) 96
119C Infringement exemptions: acts for experimental purposes 96
120 Infringement proceedings 97
121 Counter-claim for revocation of patent 97
121A Burden of proof—infringement of patent for a process 98
122 Relief for infringement of patent 98
123 Innocent infringement 99

Part 2—Non-infringement declarations 100
124 Interpretation 100
125 Application for non-infringement declaration 100
126 Proceedings for non-infringement declarations 100
127 Effect of non-infringement declarations 101

Part 3—Unjustified threats of infringement proceedings 102
128 Application for relief from unjustified threats 102
129 Court's power to grant relief if threats related to a standard patent or standard patent application 102
129A Threats related to an innovation patent application or innovation patent and court's power to grant relief 103
130 Counter-claim for infringement 104
131 Notification of patent not a threat 104
132 Liability of legal practitioner or patent attorney 104

Chapter 12—Compulsory licences and revocation of patents 105
133 Compulsory licences 105
134 Revocation of patent after grant of compulsory licence 107
135 Reasonable requirements of the public 107
136 Orders to be consistent with international agreements 108
136A Dealing with allegation of contravention of application law 108
137 Revocation on surrender of patent 109
138 Revocation of patents in other circumstances 109
139 Parties to proceedings 110

ComLaw Authoritative Act C2015C00060

140 Commissioner to be given copies of orders 110

Chapter 13—Withdrawal and lapsing of applications and ceasing of patents 111

141 Withdrawal of applications 111
142 Lapsing of applications 111
143 Ceasing of patents 112
143A Ceasing of innovation patents 112
143B Payment of fees 113

Chapter 14—Contracts 114

144 Void conditions 114
145 Termination of contract after patent ceases to be in force 115
146 Effect of Chapter 115

Chapter 15—Special provisions relating to associated technology 117

147 Certificate by Director as to associated technology 117
148 Lapsing etc. of applications 118
149 Revocation of direction 118
150 Restoration of lapsed application 118
151 Reinstatement of application as an international application 119
152 Notice of prohibitions or restrictions on publication 120
153 Effect of order 121

Chapter 16—Jurisdiction and powers of courts 122

154 Jurisdiction of Federal Court 122
155 Jurisdiction of other prescribed courts 122
156 Exercise of jurisdiction 123
157 Transfer of proceedings 123
158 Appeals 123
159 Commissioner may appear in appeals 124
160 Powers of Federal Court 124

ComLaw Authoritative Act C2015C00060

Chapter 17—The Crown 125

Part 1—Introductory 125

161 Nominated persons and patentees....125
162 Commonwealth and State authorities....125

Part 2—Exploitation by the Crown 126

163 Exploitation of inventions by Crown....126
164 Nominated person or patentee to be informed of exploitation....126
165 Remuneration and terms for exploitation....127
165A Exploitation of invention to cease under court order....127
166 Previous agreements inoperative....127
167 Sale of products....128
168 Supply of products by Commonwealth to foreign countries....128
169 Declarations that inventions have been exploited....129
170 Sale of forfeited articles....129

Part 3—Acquisitions by and assignments to the Crown 130

171 Acquisition of inventions or patents by Commonwealth....130
172 Assignment of invention to Commonwealth....130

Part 4—Prohibition orders 131

173 Prohibition of publication of information about inventions....131
174 Effect of prohibition orders....131
175 Disclosure of information to Commonwealth authority....132
176 International applications treated as applications under this Act....132

Chapter 18—Miscellaneous offences 133

177 False representations about the Patent Office....133
178 False representations about patents or patented articles....133
182 Officers not to traffic in inventions....134
183 Unauthorised disclosure of information by employees etc....135
184 Other unauthorised disclosures of information....135

ComLaw Authoritative Act C2015C00060

185 Commissioner etc. not to prepare documents or search records ... 135

Chapter 19—The Register and official documents 137
186 Register of Patents ... 137
187 Registration of particulars of patents etc. ... 137
188 Trusts not registrable ... 138
189 Power of patentee to deal with patent ... 138
190 Inspection of Register ... 138
191 False entries in Register ... 139
191A Commissioner's power to rectify register ... 139
192 Orders for rectification of Register ... 140
193 Inspection of documents ... 141
194 Information obtainable from Commissioner ... 141
195 Evidence—the Register ... 141
196 Evidence—unregistered particulars ... 142
197 Evidence—certificate and copies of documents ... 142
197AA Evidence of matters arising under PCT ... 143

Chapter 20—Patent Attorneys 144

Part 1—Registration, privileges and professional conduct 144
198 Registration of patent attorneys ... 144
199 Deregistration ... 146
200 Privileges ... 146
200A Designated Manager ... 147

Part 2—Offences 148
201 Acting or holding out without being registered ... 148
201A When a person carries on business, practises or acts as a patent attorney ... 150
201B Incorporated patent attorney must have a patent attorney director ... 151
202 Documents prepared by legal practitioners ... 152
202A Documents prepared by a member of a partnership ... 153
202B Documents prepared by incorporated patent attorneys and incorporated legal practices ... 153
203 Attendance at patent attorney's office ... 153
204 Time for starting prosecutions ... 154

ComLaw Authoritative Act C2015C00060

Chapter 21—Administration 155

205 Patent Office and sub-offices 155
206 Patent Office seal 155
207 Commissioner of Patents 155
208 Deputy Commissioner of Patents 155
209 Delegation of Commissioner's powers and functions 156
210 Commissioner's powers 156
210A Sanctions for non-compliance with Commissioner's requirements 158
211 Recovery of costs awarded by Commissioner 159

Chapter 22—Miscellaneous 160

212 Copies of examination reports to be communicated 160
213 Making and signing applications etc. 160
214 Filing of documents 160
215 Death of applicant or nominated person 160
216 Exercise of discretionary power by Commissioner 161
217 Assessors 161
218 Costs where patent invalid in part 161
219 Security for costs 161
220 Costs of attendance of patent attorney 162
221 Service of documents 162
222 Publication of *Official Journal* etc. 162
222A Doing act when Patent Office reopens after end of period otherwise provided for doing act 162
223 Extensions of time 163
224 Review of decisions 166
225 Conduct of employees and agents of natural persons 167
226 Documents open to public inspection do not infringe copyright 168
227 Fees 169
227A Professional Standards Board for Patent and Trade Marks Attorneys 170
228 Regulations 171

Chapter 23—Transitional and savings provisions 177

231 Application of Part III of 1989 Amending Act 177
233 Patents granted under 1952 Act 177

ComLaw Authoritative Act C2015C00060

234 Applications under 1952 Act 177
235 Other applications and proceedings under 1952 Act 179
236 Micro-organisms 179
237 Orders, directions etc. under 1952 Act 179
238 The Commissioner and Deputy Commissioner 179
239 The Register of Patents and Register of Patent Attorneys 179
240 Registered patent attorneys 180

Schedule 1—Dictionary 181

Endnotes 192

Endnote 1—About the endnotes 192

Endnote 2—Abbreviation key 193

Endnote 3—Legislation history 194

Endnote 4—Amendment history 199

ComLaw Authoritative Act C2015C00060

An Act relating to patents of inventions

Chapter 1—Introductory

1 Short title

This Act may be cited as the *Patents Act 1990*.

2 Commencement

(1) Subject to subsection (2), this Act commences on a day to be fixed by Proclamation.

(2) If this Act does not commence under subsection (1) within the period of 6 months beginning on the day on which it receives the Royal Assent, it commences on the first day after the end of that period.

3 Definitions

The following expressions are defined, for the purposes of this Act or of a particular Chapter of this Act, in the dictionary in Schedule 1:

ComLaw Authoritative Act C2015C00060

Section 3

application
approved form
associated technology
Australia
Australian continental shelf
Australian Register of Therapeutic Goods
authority
basic application
Budapest Treaty
certified
claim
commencing day
Commissioner
company
compensable person
complete specification
compulsory licence
Convention applicant
Convention application
Convention country
deposit requirements
depositary institution
Deputy Commissioner
Designated Manager
Director
director
eligible person
employee
examination
exclusive licensee
exploit
Federal Court
file
foreign aircraft
foreign land vehicle
foreign vessel
formalities check
incorporated legal practice
incorporated patent attorney
infringement proceedings
innovation patent
intellectual property advice
interested party
international application
international depositary authority
international filing date
invention
legal practitioner
legal representative
licence
main invention
nominated person
non-infringement declaration
Official Journal
patent
patent application
patent area
patent attorney
director
patent of addition
Patent Office
patent request
patentable invention
patented process
patented product
patentee
patents work
PCT
PCT application
permit
pharmaceutical substance
PPSA security interest
preliminary search and opinion
prescribed court
prescribed depositary institution
prior art base
prior art information
Professional Standards Board
prohibition order
provisional specification
receiving Office
re-examination
Register
registered
registered patent attorney
related company group
relevant authority
relevant international application
relevant proceedings
rules relating to micro-organisms
Safeguards Act

ComLaw Authoritative Act C2015C00060

specification
standard patent
State
Statute of
    Monopolies
supply
Territory
therapeutic use
this Act
work
1952 Act
1989 Amending Act

ComLaw Authoritative Act C2015C00060

5 Associated applications

For the purposes of this Act, a complete application is to be taken to be associated with a provisional application if, and only if, the patent request filed in respect of the complete application identifies the provisional application and contains a statement to the effect that the applications are associated.

[*Note: see sections 29 and 38*]

6 Deposit requirements

For the purposes of this Act, the deposit requirements are to be taken to be satisfied in relation to a micro-organism to which a specification relates if, and only if:

(a) the micro-organism was, on or before the date of filing of the specification, deposited with a prescribed depositary institution in accordance with the rules relating to micro-organisms; and

(b) the specification includes, at that date, such relevant information on the characteristics of the micro-organism as is known to the applicant; and

(c) at all times since the end of the prescribed period, the specification has included:

(i) the name of a prescribed depositary institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and

(iii) the file, accession or registration number of the deposit given by the institution; and

(d) at all times since the date of filing of the specification, samples of the micro-organism have been obtainable from a prescribed depositary institution as provided by those rules.

[*Note: see sections 41 and 42*]

ComLaw Authoritative Act C2015C00060

7 Novelty, inventive step and innovative step

Novelty

(1) For the purposes of this Act, an invention is to be taken to be novel when compared with the prior art base unless it is not novel in the light of any one of the following kinds of information, each of which must be considered separately:

(a) prior art information (other than that mentioned in paragraph (c)) made publicly available in a single document or through doing a single act;

(b) prior art information (other than that mentioned in paragraph (c)) made publicly available in 2 or more related documents, or through doing 2 or more related acts, if the relationship between the documents or acts is such that a person skilled in the relevant art would treat them as a single source of that information;

(c) prior art information contained in a single specification of the kind mentioned in subparagraph (b)(ii) of the definition of ***prior art base*** in Schedule 1.

Inventive step

(2) For the purposes of this Act, an invention is to be taken to involve an inventive step when compared with the prior art base unless the invention would have been obvious to a person skilled in the relevant art in the light of the common general knowledge as it existed (whether in or out of the patent area) before the priority date of the relevant claim, whether that knowledge is considered separately or together with the information mentioned in subsection (3).

(3) The information for the purposes of subsection (2) is:

(a) any single piece of prior art information; or

(b) a combination of any 2 or more pieces of prior art information that the skilled person mentioned in subsection (2) could, before the priority date of the relevant claim, be reasonably expected to have combined.

ComLaw Authoritative Act C2015C00060

Innovative step

(4) For the purposes of this Act, an invention is to be taken to involve an innovative step when compared with the prior art base unless the invention would, to a person skilled in the relevant art, in the light of the common general knowledge as it existed (whether in or out of the patent area) before the priority date of the relevant claim, only vary from the kinds of information set out in subsection (5) in ways that make no substantial contribution to the working of the invention.

(5) For the purposes of subsection (4), the information is of the following kinds:

(a) prior art information made publicly available in a single document or through doing a single act;

(b) prior art information made publicly available in 2 or more related documents, or through doing 2 or more related acts, if the relationship between the documents or acts is such that a person skilled in the relevant art would treat them as a single source of that information.

(6) For the purposes of subsection (4), each kind of information set out in subsection (5) must be considered separately.

[*Notes: (1) For the meaning of* ***document*** *see section 2B of the Acts Interpretation Act 1901.*

(2) See also the definitions of ***prior art base*** *and* ***prior art information*** *in Schedule 1: see also paragraph 18(1)(b) and section 98.*]

7A Meaning of useful

(1) For the purposes of this Act, an invention is taken not to be useful unless a specific, substantial and credible use for the invention (so far as claimed) is disclosed in the complete specification.

ComLaw Authoritative Act C2015C00060

(2) The disclosure in the complete specification must be sufficient for that specific, substantial and credible use to be appreciated by a person skilled in the relevant art.

(3) Subsection (1) does not otherwise affect the meaning of the word ***useful*** in this Act.

9 Secret use

For the purposes of this Act, the following acts are not to be taken to be secret use of an invention in the patent area:

(a) any use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her predecessor in title to the invention, for the purpose of reasonable trial or experiment only;

(b) any use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her predecessor in title to the invention, being use occurring solely in the course of a confidential disclosure of the invention by or on behalf of, or with the authority of, the patentee, nominated person, or predecessor in title;

(c) any other use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her predecessor in title to the invention, for any purpose other than the purpose of trade or commerce;

(d) any use of the invention by or on behalf of the Commonwealth, a State, or a Territory where the patentee or nominated person, or his or her predecessor in title to the invention, has disclosed the invention, so far as claimed, to the Commonwealth, State or Territory;

(e) any use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her predecessor in title to the invention, for any purpose, if a complete application is made for the invention within the prescribed period.

[*Note: See also paragraph 18(1)(d)*]

ComLaw Authoritative Act C2015C00060

10 Certain international applications to be taken to have been given an international filing date

(1) Where:

(a) an international application specifies Australia as a designated State under Article 4(1)(ii) of the PCT; and

(b) the receiving Office does not give the application an international filing date; and

(c) the Commissioner is satisfied, on the balance of probabilities, that the application should, under Article 25(2)(a) of the PCT, be treated as if it had been given an international filing date;

the application is to be taken, for the purposes of this Act, to have been given an international filing date under Article 11 of the PCT.

(2) This section does not apply to an international application that was not filed in the receiving Office in English unless a translation of the application into English, verified in accordance with the regulations, has been filed.

(3) Where this section applies, the international filing date of the application is to be taken to be the date that, in the opinion of the Commissioner, should have been given to the application as its international filing date under the PCT.

[*Note:* ***international filing date*** *is defined in Schedule 1.*]

11 Act binds the Crown

(1) This Act binds the Crown in right of the Commonwealth, of each of the States, of the Australian Capital Territory, of the Northern Territory and of Norfolk Island.

(2) Nothing in this Act makes the Crown liable to be prosecuted for an offence.

12 Application of Act

This Act extends to:

ComLaw Authoritative Act C2015C00060

(a) each external Territory; and
(b) the Australian continental shelf; and
(c) the waters above the Australian continental shelf; and
(d) the airspace above Australia, each external Territory and the Australian continental shelf.

12A Application of the *Criminal Code*

Chapter 2 of the *Criminal Code* applies to all offences created by this Act.

Note: Chapter 2 of the *Criminal Code* sets out the general principles of criminal responsibility.

ComLaw Authoritative Act C2015C00060

Chapter 2—Patent rights, ownership and validity

Part 1—Patent rights

13 Exclusive rights given by patent

(1) Subject to this Act, a patent gives the patentee the exclusive rights, during the term of the patent, to exploit the invention and to authorise another person to exploit the invention.

(2) The exclusive rights are personal property and are capable of assignment and of devolution by law.

(3) A patent has effect throughout the patent area.

14 Assignment of patent

(1) An assignment of a patent must be in writing signed by or on behalf of the assignor and assignee.

(2) A patent may be assigned for a place in, or part of, the patent area.

ComLaw Authoritative Act C2015C00060

Part 2—Ownership

15 Who may be granted a patent?

(1) Subject to this Act, a patent for an invention may only be granted to a person who:

(a) is the inventor; or

(b) would, on the grant of a patent for the invention, be entitled to have the patent assigned to the person; or

(c) derives title to the invention from the inventor or a person mentioned in paragraph (b); or

(d) is the legal representative of a deceased person mentioned in paragraph (a), (b) or (c).

(2) A patent may be granted to a person whether or not he or she is an Australian citizen.

16 Co-ownership of patents

(1) Subject to any agreement to the contrary, where there are 2 or more patentees:

(a) each of them is entitled to an equal undivided share in the patent; and

(b) each of them is entitled to exercise the exclusive rights given by the patent for his or her own benefit without accounting to the others; and

(c) none of them can grant a licence under the patent, or assign an interest in it, without the consent of the others.

(2) Where a patented product, or a product of a patented method or process, is sold by any of 2 or more patentees, the buyer, and a person claiming through the buyer, may deal with the product as if it had been sold by all the patentees.

ComLaw Authoritative Act C2015C00060

(3) This section does not affect the rights or obligations of a trustee or of the legal representative of a deceased person, or rights or obligations arising out of either of those relationships.

17 Directions to co-owners

(1) Where there are 2 or more patentees, the Commissioner may, on the application of any of them, give such directions in accordance with the application as the Commissioner thinks fit, being directions about:
  (a) a dealing with the patent or an interest in it; or
  (b) the grant of licences under the patent; or
  (c) the exercise of a right under section 16 in relation to the patent.

(2) If a patentee fails to do anything necessary to carry out a direction under subsection (1) within 14 days after being asked in writing to do so by one of the other patentees, the Commissioner may, on the application of one of those other patentees, direct a person to do it in the name and on behalf of the defaulting patentee.

(3) Before giving a direction, the Commissioner must give an opportunity to be heard:
  (a) in the case of an application by a patentee or patentees under subsection (1)—to the other patentee or patentees; and
  (b) in the case of an application under subsection (2)—to the defaulting patentee.

(4) The Commissioner must not give a direction that:
  (a) affects the rights or obligations of a trustee or of the legal representative of a deceased person, or rights or obligations arising out of either of those relationships; or
  (b) is inconsistent with the terms of an agreement between the patentees.

ComLaw Authoritative Act C2015C00060

Part 3—Validity

Division 1—Validity

18 Patentable inventions

Patentable inventions for the purposes of a standard patent

(1) Subject to subsection (2), an invention is a patentable invention for the purposes of a standard patent if the invention, so far as claimed in any claim:

(a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and

(b) when compared with the prior art base as it existed before the priority date of that claim:

(i) is novel; and

(ii) involves an inventive step; and

(c) is useful; and

(d) was not secretly used in the patent area before the priority date of that claim by, or on behalf of, or with the authority of, the patentee or nominated person or the patentee's or nominated person's predecessor in title to the invention.

Patentable inventions for the purposes of an innovation patent

(1A) Subject to subsections (2) and (3), an invention is a patentable invention for the purposes of an innovation patent if the invention, so far as claimed in any claim:

(a) is a manner of manufacture within the meaning of section 6 of the Statute of Monopolies; and

(b) when compared with the prior art base as it existed before the priority date of that claim:

(i) is novel; and

(ii) involves an innovative step; and

(c) is useful; and

ComLaw Authoritative Act C2015C00060

(d) was not secretly used in the patent area before the priority date of that claim by, or on behalf of, or with the authority of, the patentee or nominated person or the patentee's or nominated person's predecessor in title to the invention.

(2) Human beings, and the biological processes for their generation, are not patentable inventions.

Certain inventions not patentable inventions for the purposes of an innovation patent

(3) For the purposes of an innovation patent, plants and animals, and the biological processes for the generation of plants and animals, are not patentable inventions.

(4) Subsection (3) does not apply if the invention is a microbiological process or a product of such a process.

[*Note: see also sections 7 and 9*.]

19 Certificate of validity

(1) In any proceedings in a court in which the validity of a patent, or of a claim, is disputed, the court may certify that the validity of a specified claim was questioned.

(2) If a court issues a certificate, then, in any subsequent proceedings for infringement of the claim concerned, or for the revocation of the patent so far as it relates to that claim, the patentee, or any other person supporting the validity of the claim is, on obtaining a final order or judgment in his or her favour, entitled to full costs, charges and expenses as between solicitor and client, so far as that claim is concerned.

(3) Subsection (2) has effect subject to any direction by the court trying the proceedings.

ComLaw Authoritative Act C2015C00060

20 Validity of patent not guaranteed

(1) Nothing done under this Act or the PCT guarantees the granting of a patent, or that a patent is valid, in Australia or anywhere else.

(2) The Commonwealth, the Commissioner, a Deputy Commissioner, or an employee, is not liable because of, or in connection with, doing any act under this Act or the PCT, or any proceedings consequent on doing any such act.

21 Validity not implied by making or refusal of non-infringement declaration

The making of, or refusal to make, a non-infringement declaration in respect of a claim of a patent does not imply that the claim is valid.

ComLaw Authoritative Act C2015C00060

Division 2—Matters not affecting validity

22A Validity not affected by who patent is granted to

A patent is not invalid merely because:

(a) the patent, or a share in the patent, was granted to a person who was not entitled to it; or

(b) the patent, or a share in the patent, was not granted to a person who was entitled to it.

22 Invalidity in relation to one claim not to affect validity in relation to other claims

The invalidity of a patent in relation to a claim does not affect its validity in relation to any other claim.

23 Validity not affected by publication etc. after priority date

A patent is not invalid, so far as the invention is claimed in any claim, merely because of:

(a) the publication or use of the invention, so far as claimed in that claim, on or after the priority date of that claim; or

(b) the grant of another patent which claims the invention, so far as claimed in the first-mentioned claim, in a claim of the same or a later priority date.

24 Validity not affected by making information available in certain circumstances

(1) For the purpose of deciding whether an invention is novel or involves an inventive step or an innovative step, the person making the decision must disregard:

(a) any information made publicly available in the prescribed circumstances, by or with the consent of the nominated person or patentee, or the predecessor in title of the nominated person or patentee; and

ComLaw Authoritative Act C2015C00060

(b) any information made publicly available without the consent of the nominated person or patentee, through any publication or use of the invention by another person who derived the information from the nominated person or patentee or from the predecessor in title of the nominated person or patentee;

but only if a complete application for the invention is made within the prescribed period.

(2) For the purpose of deciding whether an invention is novel or involves an inventive step or an innovative step, the person making the decision must disregard:

(a) any information given by, or with the consent of, the nominated person or the patentee, or his or her predecessor in title, to any of the following, but to no other person or organisation:

(i) the Commonwealth or a State or Territory, or an authority of the Commonwealth or a State or Territory;

(ii) a person authorised by the Commonwealth or a State or Territory to investigate the invention; and

(b) anything done for the purpose of an investigation mentioned in subparagraph (a)(ii).

25 Validity: patents of addition

Objection cannot be taken to a patent request or complete specification in respect of an application for a patent of addition, and a patent of addition is not invalid, merely because the invention, so far as claimed, does not involve an inventive step, having regard to the publication or use of the main invention during the prescribed period.

26 Validity not affected in certain cases involving amendments

(1) Objection cannot be taken to a patent request and specification that have been accepted, and a patent is not invalid, merely because the specification claims an invention that was not the subject of the request, or that was not described or claimed in the specification as filed.

ComLaw Authoritative Act C2015C00060

Section 26

(2) Except in the case of an amendment made in contravention of section 112 or 112A, objection cannot be taken to a patent request and specification that have been accepted, and a patent is not invalid, merely because an amendment of the specification has been made that was not allowable.

ComLaw Authoritative Act C2015C00060

Division 3—Notice of matters affecting validity

27 Notice of matters affecting validity of standard patents

(1) A person may, within the prescribed period after a complete specification filed in relation to an application for a standard patent becomes open to public inspection, notify the Commissioner, in accordance with the regulations, that the person asserts, for reasons stated in the notice, that the invention concerned is not a patentable invention because it does not comply with paragraph 18(1)(b).

(2) The Commissioner must inform the applicant for the patent in writing of any matter of which the Commissioner is notified and send the applicant a copy of any document accompanying the notice.

(3) The Commissioner must otherwise consider and deal with a notice in accordance with the regulations.

(4) A notice and any document accompanying it are open to public inspection.

28 Notice of matters affecting validity of innovation patents

Person may give notice of invalidity of an innovation patent

(1) A person may notify the Commissioner that the person asserts, for reasons stated in the notice, that an innovation patent is invalid because the invention concerned does not comply with paragraph 18(1A)(b).

When notice may be given

(2) A notice may only be given to the Commissioner under subsection (1) in respect of an innovation patent within the prescribed period after an innovation patent has been granted.

ComLaw Authoritative Act C2015C00060

How notice must be given

(3) Notice must be given in accordance with the regulations.

Commissioner must inform patentee of notice given

(4) If the Commissioner receives a notice in respect of an innovation patent, the Commissioner must inform the patentee, in writing, of any matter of which the Commissioner is notified and send the patentee a copy of any document accompanying the notice.

Commissioner to deal with notice in accordance with regulations

(5) The Commissioner must otherwise consider and deal with a notice in accordance with the regulations.

ComLaw Authoritative Act C2015C00060

Chapter 3—From application to acceptance

Part 1—Patent applications

Division 1—Applications

29 Application for patent—general rules

(1) A person may apply for a patent for an invention by filing, in accordance with the regulations, a patent request and such other documents as are prescribed.

(2) An application may be a provisional application or a complete application.

(3) A patent request in relation to a provisional application must be in the approved form and accompanied by a provisional specification.

(4) A patent request in relation to a complete application must be in the approved form and accompanied by a complete specification.

(5) In this section:

person includes a body of persons, whether incorporated or not.

[*Note: see also section 5 for requirements relating to associated applications*.]

29A Applications for patents—special rules for PCT applications

(1) A PCT application is to be treated as a complete application under this Act for a standard patent.

(2) The description, drawings and claims contained in a PCT application are to be treated as a complete specification filed in respect of the application.

ComLaw Authoritative Act C2015C00060

(3) The specification of a PCT application is to be taken to be amended in the circumstances, on the day and in the manner as prescribed by the regulations.

(4) A PCT application is to be taken to comply with the prescribed requirements of this Act that relate to applications for standard patents, but is not to be taken, merely because of subsection (1) or (2), to comply with any other requirements of this Act.

(5) An applicant of a PCT application must do the following within the prescribed period:

(a) if the application was not filed in the receiving Office in English—file a translation of the application into English;

(b) in any case—file the prescribed documents and pay the prescribed fees.

Note: A failure to comply with this subsection may result in the PCT application lapsing: see paragraph 142(2)(f).

29B Applications for patents—special rules for Convention applications

Making Convention applications

(1) A Convention applicant in relation to a basic application may make a Convention application, or 2 or more such applicants may make a joint Convention application.

(2) If 2 or more basic applications for protection in respect of inventions have been made in one or more Convention countries, one Convention application may be made within the prescribed period by a Convention applicant in relation to those basic applications, or by 2 or more such entitled applicants jointly, in respect of the inventions disclosed in the basic applications.

(3) Subject to subsections (4) and (5), a Convention application must be made and dealt with in the same way as any other patent application.

(4) A patent request relating to a Convention application must:

ComLaw Authoritative Act C2015C00060

(a) include the prescribed particulars relating to the relevant basic application; and
(b) be accompanied by a complete specification.

Meaning of Convention country

(5) ***Convention country*** means a foreign country or region of a kind prescribed by the regulations.

(6) Despite subsection 14(2) of the *Legislative Instruments Act 2003*, regulations made for the purposes of subsection (1) may make provision in relation to a matter by applying, adopting or incorporating, with or without modification, any matter contained in any other instrument or other writing as in force or existing from time to time.

30 Filing date

A patent application (including a PCT application) is to be taken to have been made on the filing date determined under the regulations.

31 Joint applicants

2 or more persons (within the meaning of section 29) may make a joint patent application.

32 Disputes between applicants etc.

(1) If a dispute arises between any 2 or more joint applicants in relation to a patent application whether, or in what manner, the application should proceed, the Commissioner may, on a request made in accordance with the regulations by any of those applicants, make any determinations the Commissioner thinks fit for enabling the application to proceed in the name of one or more of the applicants alone, or for regulating the manner in which it is to proceed, or both, as the case requires.

ComLaw Authoritative Act C2015C00060

(2) The Commissioner may make a determination under subsection (1) whether or not the application has lapsed.

(3) The Commissioner must not make a determination under subsection (1) without first giving each joint applicant a reasonable opportunity to be heard.

33 Applications by opponents etc.

Opposition to standard patent if a person other than nominated person eligible for grant of patent

(1) If:

(a) an application has been made for a standard patent; and

(b) the grant of the standard patent is opposed under section 59 by one or more persons; and

(c) the Commissioner decides, under section 60, that:

(i) one or more opponents are eligible persons in relation to the invention, so far as claimed in any claim of the opposed patent application (the ***original claim***); and

(ii) the nominated person in respect of the application is not an eligible person in relation to the invention; and

(iii) there is no other reason that a patent should not be granted; and

(d) a complete application is made under section 29 by one or more of the eligible persons for a patent in relation to the invention;

the Commissioner may grant those eligible persons a patent jointly for the invention, so far as so claimed.

Opposition to standard patent if nominated person eligible for grant of patent with other persons

(2) If:

(a) an application has been made for a standard patent; and

(b) the grant of the patent is opposed under section 59 by one or more persons; and

ComLaw Authoritative Act C2015C00060

(c) the Commissioner decides, under section 60:

(i) that both the nominated person and one or more of the opponents are eligible persons in relation to the invention, so far as claimed in any claim of the opposed patent application (the ***original claim***); and

(ii) that there is no other reason that a patent should not be granted; and

(d) a complete application is made by one or more of the eligible persons under section 29 for a patent in relation to the invention;

the Commissioner may grant a patent for the invention, so far as so claimed, to those eligible persons jointly.

Opposition to innovation patent if patentee not entitled to grant of patent but another person is

(3) If:

(a) an innovation patent is opposed under section 101M by one or more persons;

(b) the Commissioner decides, under section 101N, that the patentee is not entitled to the grant of the patent; and

(c) the Commissioner decides that one or more of the opponents are eligible persons in relation to the invention the subject of the patent, so far as claimed in any claim of the patent (the ***original claim***); and

(d) a complete application is made by one or more of the eligible persons under section 29 for a patent in relation to the invention;

the Commissioner may grant an innovation patent for the invention, so far as so claimed, to those eligible persons.

Opposition to innovation patent if patentee entitled to grant of patent with other person

(4) If:

(a) an innovation patent is opposed under section 101M by one or more persons; and

ComLaw Authoritative Act C2015C00060

(b) the Commissioner decides that one or more of the opponents and the original patentee are eligible persons in relation to the invention the subject of the patent, so far as claimed in any claim of the patent (the ***original claim***); and

(c) a complete application is made by one or more of the eligible persons under section 29 for a patent in relation to the invention;

the Commissioner may grant an innovation patent for the invention, so far as so claimed, to those eligible persons jointly.

(5) If the Commissioner grants a patent under subsection (1), (2), (3) or (4), the claims of that patent granted have the same priority date as that of the original claim referred to in the respective subsection.

34 Applications by eligible persons arising out of Court proceedings

(1) If, in any proceedings in a court relating to a patent (the ***first patent***), the court is satisfied either:

(a) that one or more persons are eligible persons in relation to an invention so far as claimed in any claim of the patent (the ***original claim***) but that the patentee is not an eligible person; or

(b) that the patentee and another person or persons are eligible persons in relation to an invention so far as claimed in any claim of the first patent (the ***original claim***);

the court, in addition to any other order it may make in the proceedings, may, by order, declare that the persons who it is satisfied are eligible persons are eligible persons in relation to that invention so far as so claimed.

(2) Subject to subsection (3), if a complete application is made under section 29 by one or more declared persons, the Commissioner may grant a patent for the invention, so far as claimed in the original claim, to those declared persons jointly.

(3) If the Commissioner grants a patent under subsection (2), the claims of that patent have the same priority date as that of the original claim.

ComLaw Authoritative Act C2015C00060

35 Applications by eligible persons following revocation by Commissioner

(1) If the Commissioner:

(a) revokes a patent under section 137; and

(b) is satisfied, on the balance of probabilities:

(i) on application made by one or more persons in accordance with the regulations, that the persons are eligible persons in relation to the invention concerned, so far as so claimed in any claim of the revoked patent (the ***original claim***) and that the former patentee is not such an eligible person; or

(ii) on application made by one or more persons in accordance with the regulations, that the persons and the former patentee are eligible persons in relation to the invention concerned, so far as is claimed in any claim of the revoked patent (the ***original claim***);

the Commissioner may declare in writing that the eligible persons are such eligible persons.

(1A) If a complete application is made under section 29 by one or more of the declared persons, the Commissioner may grant a patent for the invention, so far as so claimed, to those declared persons jointly.

(1B) If the Commissioner grants a patent under subsection (1A), the claims of that patent have the same priority date as that of the original claim as referred to in subsection (1).

(2) The Commissioner must not make a declaration without first giving the former patentee a reasonable opportunity to be heard.

(3) An appeal lies to the Federal Court against a decision of the Commissioner making, or refusing to make, a declaration.

ComLaw Authoritative Act C2015C00060

36 Other applications by eligible persons

(1) If:

(a) a patent application has been made and, in the case of a complete application, the patent has not been granted; and

(b) an application for a declaration by the Commissioner is made by one or more persons (the ***section 36 applicants***) in accordance with the regulations; and

(c) the Commissioner is satisfied on the balance of probabilities, in relation to an invention disclosed in the specification filed in relation to the application for the patent:

(i) that the nominated person is not an eligible person, but that the section 36 applicants are eligible persons; or

(ii) that the nominated person is an eligible person, but that the section 36 applicants are also eligible persons;

the Commissioner may declare in writing that the persons who the Commissioner is satisfied are eligible persons are eligible persons in relation to the invention as so disclosed.

(2) The Commissioner may make a declaration under subsection (1) whether or not the patent application lapses or is withdrawn.

(3) The Commissioner must not make a declaration under subsection (1) without first giving the nominated person a reasonable opportunity to be heard.

(3A) The Commissioner may, after making a declaration under subsection (1), make any determination the Commissioner thinks fit for enabling the application to proceed in the name of one or more of the declared persons.

(4) If a complete application is made under section 29 by one or more of the declared persons, the priority date of the claims of a patent for the invention granted to the person, or persons, as the case may be, must be determined under the regulations.

(5) An appeal lies to the Federal Court against a decision by the Commissioner under this section.

ComLaw Authoritative Act C2015C00060

37 Complete application may be treated as provisional

(1) Where a complete application is made, the applicant may, at any time during the prescribed period, by written request, ask the Commissioner to direct that the application be treated as a provisional application.

(2) A person is not entitled to make a request if the patent request and specification filed in respect of the application have been accepted or have become open to public inspection.

(3) On receiving a request, the Commissioner must give a direction as asked.

(4) Where the Commissioner gives a direction, the complete application is to be taken, for the purposes of this Act, to be, and to have always been, a provisional application.

38 Time for making complete application

(1) If an applicant makes a provisional application, the applicant may make one or more complete applications associated with the provisional application at any time within the prescribed period.

(1A) A Convention application must be made within the prescribed period.

(2) In this section:

applicant includes a person entitled to make a request under section 113 in relation to the relevant patent application.

[*Note: see also section 5 for requirements relating to associated applications*.]

ComLaw Authoritative Act C2015C00060

Division 2—Specifications

40 Specifications

Requirements relating to provisional specifications

(1) A provisional specification must disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.

(2) A complete specification must:

(a) disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; and

(aa) disclose the best method known to the applicant of performing the invention; and

(b) where it relates to an application for a standard patent—end with a claim or claims defining the invention; and

(c) where it relates to an application for an innovation patent—end with at least one and no more than 5 claims defining the invention.

(3) The claim or claims must be clear and succinct and supported by matter disclosed in the specification.

(3A) The claim or claims must not rely on references to descriptions or drawings unless absolutely necessary to define the invention.

(4) The claim or claims must relate to one invention only.

41 Specifications: micro-organisms

(1) To the extent that an invention is a micro-organism, the complete specification is to be taken to comply with paragraph 40(2)(a), so far as it requires a description of the micro-organism, if the deposit requirements are satisfied in relation to the micro-organism.

(2) Where:

ComLaw Authoritative Act C2015C00060

(a) an invention involves the use, modification or cultivation of a micro-organism, other than the micro-organism mentioned in subsection (1); and

(b) a person skilled in the relevant art in the patent area could not reasonably be expected to perform the invention without having a sample of the micro-organism before starting to perform the invention; and

(c) the micro-organism is not reasonably available to a person skilled in the relevant art in the patent area;

the specification is to be taken to comply with paragraph 40(2)(a), so far as it requires a description of the micro-organism, if, and only if, the deposit requirements are satisfied in relation to the micro-organism.

(3) For the purposes of this section, a micro-organism may be taken to be reasonably available to a person even if it is not so available in the patent area.

(4) Where:

(a) the requirements specified in paragraph 6(c) or (d) cease to be satisfied in relation to a micro-organism; and

(b) steps are taken at a later time within the prescribed period in accordance with such provisions (if any) of the regulations as are applicable; and

(c) as a result of those steps, if the period during which those requirements are not satisfied is disregarded, those requirements would be satisfied at that later time;

those requirements are to be taken to have been satisfied during the period mentioned in paragraph (c), and such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention during that period.

[*Note: see also section 6 in relation to satisfaction of deposit requirements*.]

ComLaw Authoritative Act C2015C00060

42 Micro-organisms ceasing to be reasonably available

(1) Where:

(a) a complete application has been made for a patent, or a patent has been granted for an invention of a kind mentioned in paragraph 41(2)(a); and

(b) the relevant micro-organism was, at the date of filing of the complete specification, reasonably available (within the meaning of section 41) to a skilled person working in the relevant art in the patent area; and

(c) the micro-organism has ceased to be so available;

a prescribed court or the Commissioner, on application made in accordance with the regulations, or the Commissioner, on his or her own motion, may declare that the specification does not comply with section 40 unless the deposit requirements are satisfied in relation to the micro-organism.

(2) Where a declaration is made under subsection (1):

(a) this Act has effect in relation to the specification accordingly; and

(b) section 6 applies as if the references in that section to the date of filing of the specification were references to a date specified in the declaration for the purposes of this subsection.

(3) Subsection (2) does not limit the operation of section 223.

(4) Where:

(a) an application is made under subsection (1); or

(b) the Commissioner proposes to make a declaration under that subsection on his or her own motion;

the applicant for the patent, or the patentee, as the case may be, must be notified, in accordance with the regulations, of the application or proposal and is entitled to appear and be heard.

(5) A declaration by the Commissioner must be made in accordance with the regulations.

ComLaw Authoritative Act C2015C00060

(6) An office copy of a declaration by a prescribed court must be served on the Commissioner by the Registrar or other appropriate officer of the court.

(7) An appeal lies to the Federal Court against a decision of the Commissioner under subsection (1).

[*Note: see also section 6 in relation to satisfaction of deposit requirements*.]

ComLaw Authoritative Act C2015C00060

Division 3—Priority dates

43 Priority dates

(1) Each claim of a specification must have a priority date.

(2) The priority date of a claim is:
  (a) if subsection (2A) applies to the claim—the date determined under the regulations; or
  (b) otherwise—the date of the filing of the specification.

(2A) This subsection applies to a claim if:
  (a) prescribed circumstances apply in relation to the invention defined in the claim; and
  (b) a prescribed document discloses the invention in the claim in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.

(3) Where a claim defines more than one form of an invention, then, for the purposes of determining the priority date of the claim, it must be treated as if it were a separate claim for each form of the invention that is defined.

(4) The priority date of a claim of a specification may be different from the priority date of any other claim of the specification.

(5) If, at the time when a Convention application or a PCT application is made in respect of an invention:
  (a) an application (the ***earlier application***) has been made for protection in respect of the invention in a Convention country; and
  (b) the earlier application was made in the prescribed period; and
  (c) the earlier application has been withdrawn, abandoned or refused without becoming open to public inspection; and

ComLaw Authoritative Act C2015C00060

(d) the earlier application has not been used as the basis of claiming a right of priority in a Convention country under a law of that country; and

(e) a later application has been made by the same applicant for protection in respect of the invention in a Convention country;

the earlier application is taken, for the purposes of this Act, to have never been made.

Note: For the purposes of paragraph (e), the later application need not have been made in the same Convention country as the earlier application.

43AA Disclosure in basic applications

Prescribed documents relating to basic applications

(1) The regulations may prescribe documents that relate to a basic application.

Disclosures in prescribed documents may generally be taken into account

(2) Without limiting the documents or disclosures that may be taken into account for the purposes of this Act in relation to a basic application, account may be taken of a disclosure in a prescribed document that relates to a basic application.

Disclosures in prescribed documents must not be taken into account if Commissioner's requirement not complied with

(3) However, if the Commissioner makes a requirement under subsection (4) in relation to a prescribed document, account must not be taken, for the purposes of this Act, of a disclosure in the prescribed document unless the document has been made available by the prescribed means and within the prescribed period.

ComLaw Authoritative Act C2015C00060

Commissioner may require prescribed documents be made available

(4) The Commissioner may require that a prescribed document relating to a basic application be made available to the Commissioner by the prescribed means and within the prescribed period.

(5) The Commissioner may make a requirement under subsection (4) more than once in relation to the same prescribed document.

ComLaw Authoritative Act C2015C00060

Part 2—Examination of standard patent requests and specifications

Division 1A—Preliminary search and opinion

43A Preliminary search and opinion

(1) If a complete application for a standard patent has been made, the Commissioner may conduct a preliminary search and opinion in relation to the patent request and specification relating to the application.

(2) The preliminary search and opinion must be conducted in accordance with the regulations.

ComLaw Authoritative Act C2015C00060

Division 1—Examination

44 Request for examination

(1) Where a complete application for a standard patent has been made, the applicant may, within the prescribed period and in accordance with the regulations, ask for an examination of the patent request and specification relating to the application.

(2) Where a complete application has been made for a standard patent, the Commissioner may, on one or more of the prescribed grounds and in accordance with the regulations, direct the applicant to ask, within the prescribed period, for an examination of the patent request and complete specification relating to the application.

(3) Where the patent request and specification relating to a complete application for a standard patent are open to public inspection, a person may, in accordance with the regulations, require the Commissioner to direct the applicant to ask, within the prescribed period, for an examination of the request and specification.

(4) Where required under subsection (3), the Commissioner must give a direction accordingly, unless the applicant has already asked, or been directed to ask, for an examination of the patent request and specification.

45 Examination

(1) Subject to subsection (1A), if an applicant asks for an examination of a patent request and complete specification relating to an application for a standard patent, the Commissioner must examine the request and specification and report on:

(a) whether the specification complies with subsections 40(2) to (4); and

(b) whether, to the best of his or her knowledge, the invention, so far as claimed, satisfies the criteria mentioned in paragraphs 18(1)(a), (b) and (c); and

ComLaw Authoritative Act C2015C00060

(c) whether the invention is a patentable invention under subsection 18(2); and

(d) such other matters (if any) as are prescribed.

(1A) If a PCT application has been made and the prescribed requirements have not been met, the Commissioner may decline to examine the request and specification under subsection (1) until the requirements have been met.

(2) The examination must be carried out in accordance with the regulations.

ComLaw Authoritative Act C2015C00060

Part 3—Acceptance

Division 1—Acceptance of standard patents

49 Acceptance of patent request: standard patent

(1) Subject to section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent if the Commissioner is satisfied, on the balance of probabilities:

(a) that the specification complies with subsections 40(2) to (4); and

(b) that the invention, so far as claimed, satisfies the criteria mentioned in paragraphs 18(1)(a), (b) and (c); and

(c) that the invention is a patentable invention under subsection 18(2); and

(d) as to the matters (if any) prescribed under paragraph 45(1)(d).

(2) If subsection (1) does not apply, the Commissioner may refuse to accept the request and specification.

(5) Where the Commissioner accepts a patent request and complete specification relating to an application for a standard patent, the Commissioner must:

(a) notify the applicant in writing of the acceptance; and

(b) publish a notice of the acceptance in the *Official Journal*.

(6) If the patent request and complete specification have not already become open to public inspection, the notice mentioned in paragraph (5)(b) must include a statement to the effect that the patent request and specification are open to public inspection.

(7) Where the Commissioner refuses to accept a patent request and complete specification relating to an application for a standard patent, the Commissioner must notify the applicant in writing of

ComLaw Authoritative Act C2015C00060

the reasons for the refusal and publish a notice of the refusal in the *Official Journal*.

49A Postponing acceptance of patent request: standard patent

(1) The Commissioner may postpone acceptance of a patent request and complete specification:

(a) on his or her own initiative; or

(b) if requested to do so in writing by the applicant.

(2) If the Commissioner postpones acceptance on his or her own initiative, he or she must specify a day to which acceptance is postponed.

(3) If the Commissioner postpones acceptance following a request by the applicant, the Commissioner may specify a day to which acceptance is postponed.

(4) The day specified under subsection (2) or (3) cannot be a day that is after the end of the period prescribed for the purposes of paragraph 142(2)(e).

(5) If:

(a) acceptance is postponed under subsection (1) following a request by the applicant; and

(b) the Commissioner has not specified a day to which acceptance is postponed;

the Commissioner is not required to accept the patent request and complete specification unless the applicant withdraws the request in writing.

Note: If the applicant does not withdraw the request before the day prescribed by the regulations, the application lapses: see paragraph 142(2)(e).

50 Application or grant may be refused in certain cases

(1) The Commissioner may refuse to accept a request and specification relating to a standard patent, or to grant a standard patent:

ComLaw Authoritative Act C2015C00060

(a) for an invention the use of which would be contrary to law; or

(b) on the ground that the specification claims as an invention:

(i) a substance that is capable of being used as food or medicine (whether for human beings or animals and whether for internal or external use) and is a mere mixture of known ingredients; or

(ii) a process producing such a substance by mere admixture.

(2) The Commissioner may refuse to accept a specification relating to a standard patent containing a claim that includes the name of a person as the name, or part of the name, of the invention so far as claimed in that claim.

50A Revocation of acceptance

(1) The Commissioner may revoke the acceptance of a patent request and complete specification relating to an application for a standard patent if the Commissioner is satisfied, on the balance of probabilities, that:

(a) a patent has not been granted on the application; and

(b) the request and specification should not have been accepted, taking account of all the circumstances that existed when the request and specification were accepted (whether or not the Commissioner knew then of their existence); and

(c) it is reasonable to revoke the acceptance, taking account of all the circumstances.

(2) If the Commissioner revokes the acceptance:

(a) the patent request and complete specification are taken to have never been accepted; and

(b) the Commissioner must continue to examine, and report on, the application under section 45; and

(c) sections 49 and 50 continue to apply in relation to the request and specification.

ComLaw Authoritative Act C2015C00060

51 Appeal

An appeal lies to the Federal Court against a decision of the Commissioner under this Division (other than a decision under section 50A).

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Division 2—Acceptance of innovation patents

52 Formalities check and acceptance of innovation patents

(1) If a complete application for an innovation patent is made, the Commissioner must undertake a formalities check in respect of the application.

(2) If satisfied, on the balance of probabilities, that the application passes the formalities check, the Commissioner must accept the patent request and complete specification.

ComLaw Authoritative Act C2015C00060

Chapter 4—Publication

53 Publication of certain information about applicants etc.

(1) If a patent application (other than a PCT application) is made, the Commissioner must publish in the *Official Journal* the prescribed information about the applicant and the application.

(2) The regulations may make provision for and in relation to the publication of information relating to PCT applications.

54 Notice of publication

(1) Where a complete specification filed in respect of an application for a standard patent (other than a PCT application) has not become open to public inspection, the Commissioner must, if asked to do so by the applicant, publish, in accordance with the regulations, a notice in the *Official Journal* that the complete specification is open to public inspection.

(2) If subsection 41(2) applies to a specification, the applicant cannot make a request under subsection (1) in relation to the specification unless the specification includes the particulars mentioned in paragraph 6(c).

(3) Where:

(a) a complete specification has been filed in respect of an application for a standard patent (other than a PCT application); and

(b) the prescribed period has ended; and

(c) the specification is not open to public inspection;

the Commissioner must publish a notice in the *Official Journal* that the specification is open to public inspection, unless the application has lapsed or been refused or withdrawn.

(4) Where:

ComLaw Authoritative Act C2015C00060

(a) a divisional application for a standard patent provided for in section 79B (other than a PCT application) is made in respect of an original application, whether a PCT application or not; and

(b) the complete specification filed in respect of the original application was open to public inspection when the divisional application was made;

the Commissioner must publish a notice in the *Official Journal* that the complete specification filed in respect of the divisional application is open to public inspection.

(5) Where a divisional application for a standard patent provided for in section 79B (other than a PCT application) is made in respect of an original application that is not a PCT application and:

(a) a notice is published in the *Official Journal* that the complete specification filed in respect of the original application is open to public inspection; or

(b) a notice is published in the *Official Journal* that the complete specification filed in respect of the divisional application is open to public inspection;

the Commissioner must also publish in the *Official Journal* a notice that:

(c) where paragraph (a) applies—the complete specification filed in respect of the divisional application is open to public inspection; or

(d) where paragraph (b) applies—the complete specification filed in respect of the original application is open to public inspection.

(6) Where:

(a) a divisional application for a standard patent provided for in section 79B (other than a PCT application) is made in respect of an original application that is a PCT application; and

ComLaw Authoritative Act C2015C00060

(b) a notice is published in the *Official Journal* that the complete specification filed in respect of the original application is open to public inspection;

the Commissioner must also publish in the *Official Journal* a notice that the complete specification filed in respect of the divisional application is open to public inspection.

55 Documents open to public inspection

(1) Where a notice is published under section 54 or under subsection 62(3), the specification concerned, and such other documents (if any) as are prescribed, are open to public inspection.

(2) Where a notice is published under paragraph 49(5)(b) in relation to an application for a standard patent, or under subsection 62(2) in relation to the grant of an innovation patent, the following documents are open to public inspection:

(a) all documents (other than prescribed documents) filed in relation to the application or the patent, whether before or after the acceptance or grant;

(b) all documents (other than prescribed documents) filed, after the patent ceases, expires or is revoked, in relation to the former patent;

(c) copies of all documents relating to the application or patent (other than prescribed documents) given by the Commissioner to the applicant or patentee, or the former applicant or patentee;

being documents that have not already become open to public inspection.

(3) Subject to section 56A, a specification, or other document, is to be taken to have been published on the day on which it becomes open to public inspection unless it has been published otherwise before that day.

ComLaw Authoritative Act C2015C00060

56 Certain documents not to be published

(1) Except as otherwise provided by this Act, documents of the kind mentioned in section 55:

(a) must not be published or be open to public inspection; and

(b) are not liable to be inspected or produced before the Commissioner or in a legal proceeding unless the Commissioner, court, or any person having power to order inspection or production, directs that the inspection or production be allowed.

(2) Notice of an application for the production in legal proceedings of a document of the kind mentioned in section 55 must be given to the Commissioner, who is entitled to be heard on the application.

56A Publication and inspection of PCT applications

(1) The regulations may make provision for and in relation to the public inspection of PCT applications.

(2) Without limiting subsection (1), the regulations may make provision for and in relation to:

(a) notices regarding the opening of complete specifications relating to PCT applications to public inspection; and

(b) the circumstances in which PCT applications become open to public inspection.

57 Effect of publication of complete specification

(1) After a complete specification relating to an application for a standard patent has become open to public inspection and until a patent is granted on the application, the applicant has the same rights as he or she would have had if a patent for the invention had been granted on the day when the specification became open to public inspection.

(3) Subsection (1) does not give the applicant a right to start proceedings in respect of the doing of an act unless:

ComLaw Authoritative Act C2015C00060

(a) a patent is granted on the application; and

(b) the act would, if done after the grant of the patent, have constituted an infringement of a claim of the specification.

(4) It is a defence to proceedings under subsection (1) in respect of an act done:

(a) after the complete specification became open to public inspection; and

(b) before the patent request was accepted:

if the defendant proves that a patent could not validly have been granted to the applicant in respect of the claims (as framed when the act was done) that are alleged to have been infringed by the doing of the act.

(5) For the purposes of applying this section to a PCT application, references to the complete specification becoming open to public inspection are references to the PCT application becoming open to public inspection in accordance with regulations made for the purposes of section 56A.

58 Result of search may be disclosed

The Commissioner may disclose the result of any search made for the purpose of making a report under this Act.

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Chapter 5—Opposition to grant of standard patent

59 Opposition to grant of standard patent

The Minister or any other person may, in accordance with the regulations, oppose the grant of a standard patent on one or more of the following grounds, but on no other ground:

(a) that the nominated person is either:

(i) not entitled to a grant of a patent for the invention; or

(ii) entitled to a grant of a patent for the invention but only in conjunction with some other person;

(b) that the invention is not a patentable invention;

(c) that the specification filed in respect of the complete application does not comply with subsection 40(2) or (3).

60 Hearing and decision by Commissioner

(1) Where the grant of a standard patent is opposed, the Commissioner must decide the case in accordance with the regulations.

(2) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding a case.

(3) The Commissioner may, in deciding a case, take into account any ground on which the grant of a standard patent may be opposed, whether relied upon by the opponent or not.

(3A) If the Commissioner is satisfied, on the balance of probabilities, that a ground of opposition to the grant of the standard patent exists, the Commissioner may refuse the application.

(3B) The Commissioner must not refuse an application under this section unless the Commissioner has, where appropriate, given the applicant a reasonable opportunity to amend the relevant

ComLaw Authoritative Act C2015C00060

specification for the purpose of removing any ground of opposition and the applicant has failed to do so.

(4) The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

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Chapter 6—Grant and term of patents

Part 1—Grant

61 Grant of standard patent

(1) Subject to section 100A and paragraph 210A(2)(a), the Commissioner must grant a standard patent, by registering prescribed particulars of the patent in the Register, if:

(a) there is no opposition to the grant; or

(b) in spite of opposition, the Commissioner's decision, or the decision on appeal, is that a standard patent should be granted.

(2) A standard patent must be granted within the prescribed period.

(3) The Commissioner must notify the patentee that the standard patent has been granted.

62 Grant and publication of innovation patent

(1) If:

(a) the Commissioner accepts a patent request and complete specification filed in respect of an application for an innovation patent; and

(b) a prohibition order is not in force under subsection 152(3) or 173(1) in relation to the application;

the Commissioner must grant the innovation patent by registering prescribed particulars of the patent in the Register.

(2) If an innovation patent is granted, the Commissioner must publish a notice in the *Official Journal* stating that:

(a) the innovation patent has been granted; and

(b) the patent request and complete specification are open to public inspection.

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(3) If:

(a) a divisional application provided for in section 79B is made for an innovation patent; and

(b) a notice is published in the *Official Journal* that the complete specification filed in respect of the divisional application is open to public inspection;

the Commissioner must also publish in the *Official Journal* a notice that the complete specification filed in respect of the original application on which the divisional application is based is open to public inspection.

(4) The Commissioner must notify the patentee that the innovation patent has been granted.

63 Joint patentees

A patent may be granted to 2 or more nominated persons jointly.

64 Grant: multiple applications

(1) Subject to this section, where there are 2 or more applications for patents for identical, or substantially identical, inventions, the granting of a patent on one of those applications does not prevent the granting of a patent on any of the other applications.

(2) Where:

(a) an application for a standard patent claims an invention that is the same as an invention that is the subject of a patent and is made by the same inventor; and

(b) the relevant claim or claims in each of the complete specifications have the same priority date or dates;

a standard patent cannot be granted on the application.

65 Date of patent

The date of a patent is:

(a) the date of filing of the relevant complete specification; or

ComLaw Authoritative Act C2015C00060

(b) where the regulations provide for the determination of a different date as the date of a patent—the date determined under the regulations.

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Part 2—Term

67 Term of standard patent

The term of a standard patent is 20 years from the date of the patent.

68 Term of innovation patent

The term of an innovation patent is 8 years from the date of the patent.

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Part 3—Extension of term of standard patents relating to pharmaceutical substances

70 Applications for extension of patent

(1) The patentee of a standard patent may apply to the Commissioner for an extension of the term of the patent if the requirements set out in subsections (2), (3) and (4) are satisfied.

(2) Either or both of the following conditions must be satisfied:
  (a) one or more pharmaceutical substances *per se* must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification;
  (b) one or more pharmaceutical substances when produced by a process that involves the use of recombinant DNA technology, must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification.

(3) Both of the following conditions must be satisfied in relation to at least one of those pharmaceutical substances:
  (a) goods containing, or consisting of, the substance must be included in the Australian Register of Therapeutic Goods;
  (b) the period beginning on the date of the patent and ending on the first regulatory approval date for the substance must be at least 5 years.

Note: Section 65 sets out the date of a patent.

(4) The term of the patent must not have been previously extended under this Part.

(5) For the purposes of this section, the ***first regulatory approval date***, in relation to a pharmaceutical substance, is:
  (a) if no pre-TGA marketing approval was given in relation to the substance—the date of commencement of the first

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inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, the substance; or

(b) if pre-TGA marketing approval was given in relation to the substance—the date of the first approval.

(6) For the purposes of this section, ***pre-TGA marketing approval***, in relation to a pharmaceutical substance, is an approval (however described) by a Minister, or a Secretary of a Department, to:

(a) market the substance, or a product containing the substance, in Australia; or

(b) import into Australia, for general marketing, the substance or a product containing the substance.

71 Form and timing of an application

Form of application

(1) An application for an extension of the term of a standard patent must:

(a) be in the approved form; and

(b) be accompanied by such documents (if any) as are ascertained in accordance with the regulations; and

(c) be accompanied by such information (if any) as is ascertained in accordance with the regulations.

For this purpose, ***document*** includes a copy of a document.

Timing of application

(2) An application for an extension of the term of a standard patent must be made during the term of the patent and within 6 months after the latest of the following dates:

(a) the date the patent was granted;

(b) the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, any of the pharmaceutical substances referred to in subsection 70(3);

(c) the date of commencement of this section.

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72 Notification and public inspection of application

If a patentee makes an application for an extension of the term of a standard patent, the Commissioner must publish in the *Official Journal* a notice that the application has been made and is open to public inspection.

73 Withdrawal of application

(1) A patentee who has applied for an extension of the term of a standard patent may, by notice in writing to the Commissioner, withdraw the application.

(2) If an application for an extension of the term of a standard patent is withdrawn, the Commissioner must publish in the *Official Journal* a notice stating that the application has been withdrawn.

74 Acceptance or refusal of application

Acceptance

(1) If a patentee of a standard patent makes an application for an extension of the term of the patent, the Commissioner must accept the application if the Commissioner is satisfied, on the balance of probabilities, that the requirements of sections 70 and 71 are satisfied in relation to the application.

(2) If the Commissioner accepts the application, the Commissioner must:
   (a) notify the applicant in writing of the acceptance; and
   (b) publish a notice of the acceptance in the *Official Journal*.

Refusal

(3) The Commissioner must refuse to accept the application if the Commissioner is not satisfied, on the balance of probabilities, that the requirements of sections 70 and 71 are satisfied in relation to the application.

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(4) If the Commissioner refuses to accept the application, the Commissioner must:
   (a) notify the applicant in writing of the reasons for the refusal; and
   (b) publish a notice of the refusal in the *Official Journal*.

75 Opposition to grant of extension

(1) The Minister or any other person may, in accordance with the regulations, oppose the grant of an extension of the term of a standard patent on the ground that one or more of the requirements of sections 70 and 71 are not satisfied in relation to the application for the extension. The Minister or other person may not oppose the grant of the extension on any other ground.

(2) If the grant of an extension of the term of a standard patent is opposed, the Commissioner must decide the case in accordance with the regulations.

(3) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding a case.

(4) The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

76 Grant of extension

(1) The Commissioner must grant an extension of the term of a standard patent if:
   (a) there is no opposition to the grant; or
   (b) in spite of opposition, the Commissioner's decision, or the decision on appeal, is that the extension should be granted.

(2) If the Commissioner grants an extension, the Commissioner must notify the applicant in writing of the grant and publish a notice of the grant in the *Official Journal*.

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76A Notification of extension to the Secretary, Health and Family Services

In respect of each application for an extension approved by the Commissioner under section 76 in a financial year, the patent holder must lodge with the Secretary of the Department, before the end of the following financial year, a return setting out the following information:

(a) details of the amount and origin of any Commonwealth funds spent in the research and development of the drug which was the subject of the application; and

(b) the name of any body:

(i) with which the applicant has a contractual agreement; and

(ii) which is in receipt of Commonwealth funds; and

(c) the total amount spent on each type of research and development, including pre-clinical research and clinical trials, in respect of the drug which was the subject of the application.

77 Calculation of term of extension

(1) If the Commissioner grants an extension of the term of a standard patent, the term of the extension is equal to:

(a) the period beginning on the date of the patent and ending on the earliest first regulatory approval date (as defined by section 70) in relation to any of the pharmaceutical substances referred to in subsection 70(2);

reduced (but not below zero) by:

(b) 5 years.

Note: Section 65 sets out the date of a patent.

(2) However, the term of the extension cannot be longer than 5 years.

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78 Exclusive rights of patentee are limited if extension granted

If the Commissioner grants an extension of the term of a standard patent, the exclusive rights of the patentee during the term of the extension are not infringed:

(a) by a person exploiting:

(i) a pharmaceutical substance *per se* that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification; or

(ii) a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology, that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification;

for a purpose other than therapeutic use; or

(b) by a person exploiting any form of the invention other than:

(i) a pharmaceutical substance *per se* that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification; or

(ii) a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology, that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification.

79 Rights of patentee if extension granted after patent expires

If:

(a) a patentee applies for an extension of the term of a standard patent; and

(b) the term of the patent expires before the application is determined; and

(c) the extension is granted;

ComLaw Authoritative Act C2015C00060

the patentee has, after the extension is granted, the same rights to start proceedings in respect of the doing of an act during the period:

(d) commencing on the expiration of the term of the patent; and

(e) ending on the day on which the extension was granted;

as if the extension had been granted at the time when the act was done.

79A Commissioner not to make decision if court proceedings pending

If:

(a) a patentee of a standard patent applies for an extension of the term of the patent; and

(b) relevant proceedings in relation to the patent are pending;

the Commissioner must not make any decision under this Part in relation to the patent without the leave of the court.

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Chapter 6A—Divisional applications

79B Divisional applications prior to grant of patent

(1) If:

(a) a complete application (the ***first application***) for a patent is made; and

(b) the first application is not a divisional application for an innovation patent provided for in section 79C;

the applicant may make a further complete application for a patent for an invention disclosed in the specification filed in relation to the first application.

(2) The further complete application:

(a) must be made in accordance with the regulations made for the purposes of this subsection; and

(b) must include the prescribed particulars.

(3) The further complete application can only be made during the period:

(a) starting on the day the first application is made; and

(b) ending when any of the following happens:

(i) the first application lapses;

(ii) the first application is refused;

(iii) the first application is withdrawn;

(iv) a period prescribed by the regulations for the purposes of this subparagraph ends.

(4) In this section:

applicant has the same meaning as in section 38.

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79C Divisional applications for innovation patents may be made after grant of an innovation patent

Applications may be made

(1) A patentee of an innovation patent (the ***first patent***) may make a complete application for another innovation patent for a further invention disclosed in the first patent if the invention was disclosed in the complete specification filed in respect of the application on which the first patent was granted.

(1A) The further complete application:

(a) must be made in accordance with the regulations made for the purposes of this subsection; and

(b) must include the prescribed particulars.

(2) The patentee may make the further complete application only during the period:

(a) starting when an examination of the first patent begins; and

(b) ending when any of the following happens:

(i) the term of the first patent ends;

(ii) the first patent is revoked;

(iii) the first patent ceases;

(iv) a period prescribed by the regulations for the purposes of this subparagraph ends.

When does an examination begin?

(3) For the purposes of subsection (2), an examination of the patent begins:

(a) if the examination has been requested under paragraph 101A(b)—on the day the request was made; or

(b) if the Commissioner decided to examine the patent under paragraph 101A(a)—on the day the Commissioner made that decision.

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Chapter 7—Patents of addition

80 Chapter does not apply to innovation patents

This Chapter does not apply in relation to innovation patents.

81 Grant of patent of addition

(1) Where:

(a) a patent for an invention (in this Chapter called ***the main invention***) has been applied for or granted; and

(b) the applicant or patentee (or a person authorised by the applicant or patentee) applies for a further patent for an improvement in, or modification of, the main invention; and

(c) the application for that further patent is made in accordance with the regulations;

the Commissioner may, subject to this Act and the regulations, grant a patent of addition for the improvement or modification.

(2) A patent request and complete specification relating to an application for a patent of addition must not be examined before a request is made for the examination of the patent request and complete specification relating to the application for the patent for the main invention.

(3) A patent of addition must not be granted before the patent for the main invention is granted.

(4) An appeal lies to the Federal Court against a decision of the Commissioner under this section.

82 Revocation of patent and grant of patent of addition instead

(1) Where:

(a) an invention that is an improvement in, or modification of, a main invention is the subject of an independent patent; and

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(b) the patentee of the independent patent is also the patentee of the patent for the main invention;

the Commissioner may, on an application made by the patentee, revoke the independent patent and grant a patent of addition for the improvement or modification.

(2) A patent of addition granted under this section must be given the same date as the date of the independent patent that is revoked.

(3) An appeal lies to the Federal Court against a decision of the Commissioner refusing an application under this section.

83 Term of patent of addition

Usual term

(1) The general rule is that a patent of addition remains in force for so long as the patent for the main invention remains in force. However, this rule is subject to the exceptions set out in subsections (3) and (4).

(2) The term of a patent of addition may be extended under Part 3 of Chapter 6, even though the patent for the main invention is not extended under that Part.

Patent of addition extended

(3) If the term of a patent of addition is extended under Part 3 of Chapter 6:

(a) the extension begins at the end of the unextended term of the patent for the main invention; and

(b) when the extension begins, the patent of addition becomes an independent patent.

Patent for main invention extended

(4) If:

(a) the term of the patent for the main invention is extended under Part 3 of Chapter 6; and

ComLaw Authoritative Act C2015C00060

(b) the term of the patent of addition is not extended under that Part;

the term of the patent of addition expires at the end of the unextended term of the patent for the main invention.

85 Revocation of patent for main invention

(1) If the patent for the main invention is revoked by a prescribed court, or by the Commissioner under section 101 or 137, the patent of addition becomes an independent patent unless otherwise ordered by:

(a) where the patent is revoked by a prescribed court—that court; or

(b) in any other case—the Commissioner.

(2) Where a patent of addition becomes an independent patent under this section, its term cannot be more than the unexpired part of the term of the patent for the main invention.

86 Renewal fees not payable

A fee is not payable for the renewal of a patent of addition.

87 Fees payable where patent of addition becomes an independent patent

The fees payable after a patent of addition becomes an independent patent, and the dates when they become payable, are to be determined by reference to the date of the independent patent.

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Chapter 9—Re-examination of standard patents

96A Chapter does not apply to innovation patents

This Chapter does not apply in relation to innovation patents.

97 Re-examination of complete specifications

(1) Subject to this section and the regulations, if:

(a) a request and complete specification relating to an application for a patent has been accepted; and

(b) the patent has not been granted;

the Commissioner may re-examine the complete specification.

(2) Subject to this section and the regulations, where a patent has been granted, the Commissioner may, and must if asked to do so by the patentee or any other person, re-examine the complete specification.

(3) Where the validity of a patent is disputed in any proceedings before a prescribed court under this Act, the court may direct the Commissioner to re-examine the complete specification and the Commissioner must re-examine the specification accordingly.

(3A) The re-examination must be carried out in accordance with the regulations.

(4) Where relevant proceedings in relation to a patent are pending, the Commissioner must not re-examine the complete specification relating to the patent under subsection (2).

(5) Where:

(a) the Commissioner has started to re-examine a complete specification relating to a patent under subsection (2); and

ComLaw Authoritative Act C2015C00060

(b) relevant proceedings in relation to the patent are started;

the Commissioner must not continue the re-examination.

98 Report on re-examination

On re-examining a complete specification, the Commissioner must ascertain and report on:

(a) whether the specification does not comply with subsection 40(2) or (3); and

(b) whether, to the best of his or her knowledge, the invention, so far as claimed, does not satisfy the criteria mentioned in paragraph 18(1)(a), (b) or (c); and

(c) whether the invention is not a patentable invention under subsection 18(2).

99 Statement by applicant or patentee

(1) Where the Commissioner reports adversely on a complete specification, the applicant or patentee may, within the prescribed period, file a statement, in accordance with the regulations, disputing the whole or any part of the report.

(2) The applicant or patentee may file a statement whether or not the applicant or patentee takes steps to amend the complete specification, or files a statement of amendments in accordance with a direction under section 106 or 107.

100 Copies of report to be given to court

A copy of a report under section 98, and of any statement filed under section 99 in relation to the report, must, where the re-examination was directed under subsection 97(3), be given to the court that gave the direction.

100A Refusal to grant patent—re-examination before grant

(1) The Commissioner may refuse to grant a patent if the Commissioner:

ComLaw Authoritative Act C2015C00060

(a) makes an adverse report on a re-examination of the relevant specification under subsection 97(1); and

(b) is satisfied, on the balance of probabilities, that there is a lawful ground of objection to the specification.

(2) The Commissioner cannot refuse to grant a patent under this section unless the Commissioner:

(a) has given the applicant a reasonable opportunity to be heard; and

(b) has, where appropriate, given the applicant a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the applicant has failed to do so.

(3) The applicant may appeal to the Federal Court against a decision of the Commissioner under this section.

101 Revocation of patent—re-examination after grant

(1) The Commissioner may, by notice in writing, revoke a patent, either wholly or so far as it relates to a particular claim, if the Commissioner:

(a) makes an adverse report on a re-examination of the relevant specification under subsection 97(2); and

(b) is satisfied, on the balance of probabilities, that there is a lawful ground of objection to the relevant specification.

(2) The Commissioner must not revoke a patent under this section unless the Commissioner:

(a) has given the patentee a reasonable opportunity to be heard; and

(b) has, where appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the patentee has failed to do so.

(3) The Commissioner must not revoke a patent under this section while relevant proceedings in relation to that patent are pending.

ComLaw Authoritative Act C2015C00060

(4) The patentee may appeal to the Federal Court against a decision of the Commissioner under this section.

ComLaw Authoritative Act C2015C00060

Chapter 9A—Examination, re-examination and opposition-innovation patents

Part 1—Examination of innovation patents

101A Examination may be requested or Commissioner may decide to examine

After the grant of an innovation patent, the Commissioner:

(a) may, if the Commissioner decides to do so; and

(b) must, if asked to do so, in writing, by the patentee or any other person;

examine the complete specification relating to an innovation patent.

101B Examination of an innovation patent

What the Commissioner must do in examining a patent

(1) If the Commissioner decides, or is asked, to examine an innovation patent under section 101A, the Commissioner must:

(a) examine the complete specification relating to the patent to ascertain the matters set out in subsection (2); and

(b) report on those matters.

Matters for examination and report

(2) The matters in this subsection are whether:

(a) the specification complies with subsections 40(2) to (4); and

(b) the invention, so far as claimed, complies with paragraphs 18(1A)(a), (b) and (c); and

(c) the invention is a patentable invention under subsections 18(2) and (3); and

(d) the use of the invention would not be contrary to law; and

ComLaw Authoritative Act C2015C00060

(e) the patent does not claim as an invention a substance that is capable of being used as food or medicine (whether for human beings or animals and whether for internal or external use) and is a mere mixture of known ingredients; and

(f) the patent does not claim as an invention a process producing such a substance by mere admixture; and

(g) the patent does not contain a claim that includes the name of a person as the name, or part of the name, of the invention so far as it is claimed in that claim; and

(h) the patent does not claim an invention that is the same as an invention that is the subject of a patent and is made by the same inventor, where the relevant claim or claims in respect of each patent have the same priority date or dates; and

(i) the complete specification complies with such other matters (if any) as are prescribed for the purpose of this paragraph.

101C How and when examination to be carried out

The examination under section 101B must be carried out:

(a) in accordance with the regulations; and

(b) within the period prescribed.

101E Certificate of examination

(1) This section applies to an innovation patent if:

(a) after examining the patent under section 101B, the Commissioner decides in writing that he or she is satisfied, on the balance of probabilities, as to the following:

(i) the specification complies with subsections 40(2) to (4);

(ii) the invention, so far as claimed, complies with paragraphs 18(1A)(a), (b) and (c);

(iii) the invention is a patentable invention under subsections 18(2) and (3);

(iv) the use of the invention would not be contrary to law;

(v) the patent does not claim as an invention a substance that is capable of being used as food or medicine

ComLaw Authoritative Act C2015C00060

(whether for human beings or animals and whether for internal or external use) and is a mere mixture of known ingredients;

(vi) the patent does not claim as an invention a process producing such a substance by mere admixture;

(vii) the patent does not contain a claim that includes the name of a person as the name, or part of the name, of the invention so far as it is claimed in that claim;

(viii) the patent does not claim an invention that is the same as an invention that is the subject of a patent and is made by the same inventor, where the relevant claim or claims in respect of each patent have the same priority date or dates;

(ix) the complete specification complies with such other matters (if any) as are prescribed for the purpose of paragraph 101B(2)(i);

(b) the patent has not ceased under section 143A.

(2) If this section applies, the Commissioner must:

(a) notify the patentee and the person who requested the examination (if that person is not the patentee) that the patent has been examined and that a certificate of examination is to be issued; and

(b) publish a notice of the examination having occurred in the *Official Journal*; and

(c) issue a certificate of examination to the patentee in the approved form; and

(d) register the issue of the certificate.

(3) A decision under subsection (1) is not a legislative instrument.

101EA Revocation of certificate of examination

(1) The Commissioner may revoke a certificate of examination issued in relation to an innovation patent if the Commissioner is satisfied, on the balance of probabilities, that:

ComLaw Authoritative Act C2015C00060

(a) the certificate of examination should not have been issued, taking account of all the circumstances that existed when the certificate was issued (whether or not the Commissioner knew then of their existence); and

(b) it is reasonable to revoke the certificate, taking account of all the circumstances; and

(c) there are no relevant proceedings pending.

(2) If the Commissioner revokes the certificate:

(a) all of the provisions of section 101E are taken, after revocation, to have never operated in relation to the patent; and

(b) the Commissioner must continue to examine and report on the patent under section 101B; and

(c) sections 101E and 101F continue to apply in relation to the patent.

101F Revocation of innovation patents following examination under section 101B

(1) The Commissioner must revoke a patent if:

(a) the patent has been examined under section 101B; and

(b) section 101E does not apply to the patent; and

(c) the patent has not ceased under section 143A.

(2) If the Commissioner revokes the patent:

(a) the Commissioner must notify the patentee and the person who requested the examination (if that person is not the patentee) of the revocation; and

(b) register the revocation of the patent.

(3) The Commissioner must not revoke a patent under this section unless the Commissioner:

(a) has given the patentee a reasonable opportunity to be heard; and

(b) has, if appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the

ComLaw Authoritative Act C2015C00060

purposes of removing a ground for the revocation of the patent and the patentee has failed to do so.

(4) An appeal lies to the Federal Court against a decision of the Commissioner revoking a patent.

ComLaw Authoritative Act C2015C00060

Part 2—Re-examination of innovation patents

101G Re-examination of complete specifications of innovation patents

(1) Subject to subsections 101K(2) and (3) and the regulations, after an innovation patent has been certified, the Commissioner:

(a) may, if the Commissioner decides to do so; and

(b) must, if asked to do so, in writing, by the patentee or any other person;

re-examine the complete specification relating to the patent.

(1A) The re-examination must be carried out in accordance with the regulations.

(2) If the Commissioner re-examines an innovation patent under subsection (1):

(a) the Commissioner must re-examine the complete specification relating to the patent to determine if the patent is invalid and should be revoked because a ground set out in subsection (3) is made out; and

(b) the Commissioner must report on the grounds set out in subsection (3).

(3) The grounds for the revocation of the patent under subsection (2) are as follows:

(a) that the specification filed in respect of the complete application does not comply with subsection 40(2) or (3);

(b) that the invention, so far as claimed, does not comply with paragraph 18(1A)(a), (b) or (c);

(c) that the invention is not a patentable invention under subsection 18(2) or (3).

(4) There are no other grounds for the revocation of a patent under subsection (2).

ComLaw Authoritative Act C2015C00060

101H Patentee statements

(1) If the Commissioner reports that, after re-examining a patent under section 101G, a ground for the revocation of the patent has been made out, the patentee may, within the prescribed period, file a statement, in accordance with the regulations, disputing the whole or any part of the report.

(2) The patentee may file a statement whether or not the patentee takes steps to amend the complete specification, or files a statement of amendments in accordance with a direction under section 106.

101J Revocation of innovation patent following re-examination

(1) The Commissioner may, by notice in writing, revoke a patent, either wholly or so far as it relates to a particular claim, if the Commissioner:
  (a) makes an adverse report on a re-examination of the relevant specification under section 101G; and
  (b) is satisfied, on the balance of probabilities, that there is a ground of revocation of the patent.

(2) If the Commissioner revokes the patent:
  (a) the Commissioner must notify the patentee and the person who requested the examination (if that person is not the patentee) of the revocation; and
  (b) register the revocation of the patent.

(3) The Commissioner must not revoke a patent under this section unless:
  (a) the Commissioner has given the patentee a reasonable opportunity to be heard; and
  (b) the Commissioner has considered the statement made by the patentee under section 101H (if any); and
  (c) the Commissioner has, if appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any ground for revocation and the patentee has failed to do so.

ComLaw Authoritative Act C2015C00060

(4) The Commissioner must not revoke a patent under this section while relevant proceedings in relation to that patent are pending.

(5) The patentee may appeal to the Federal Court against a decision of the Commissioner under this section.

101K Relevant proceedings and re-examination

(1) If the validity of an innovation patent is disputed in any proceedings before a prescribed court under this Act, the court may direct the Commissioner to re-examine the complete specification relating to the patent. If so directed, the Commissioner must re-examine the specification accordingly.

(2) If relevant proceedings in relation to an innovation patent are pending, the Commissioner must not re-examine the complete specification relating to the patent.

(3) If:

(a) the Commissioner has started to re-examine a complete specification relating to an innovation patent; and

(b) relevant proceedings in relation to the patent are started;

the Commissioner must not continue the re-examination.

101L Copies of report to be given to court

A copy of a report under paragraph 101G(2)(b), and of any statement filed under section 101H in relation to the report, must, if the re-examination was directed under subsection 101K(1), be given to the court that gave the direction.

ComLaw Authoritative Act C2015C00060

Part 3—Opposition to innovation patents

101M Opposition to innovation patent

The Minister, or any other person, may, in accordance with the regulations, oppose an innovation patent that has been certified and seek the revocation of it, on one or more of the following grounds of invalidity, but on no other:

(a) that the patentee is either:
  (i) not entitled to the patent; or
  (ii) entitled to the patent but only in conjunction with some other person;

(b) that the complete specification does not comply with subsection 40(2) or (3);

(c) that the invention is not a patentable invention because it does not comply with paragraph 18(1A)(a), (b) or (c);

(d) that the invention is not a patentable invention under subsection 18(2) or (3).

101N Hearing and decision by the Commissioner

(1) If an innovation patent has been opposed under section 101M, the Commissioner must decide the case in accordance with the regulations.

(2) The Commissioner must give the opponent and the patentee a reasonable opportunity to be heard before deciding the case.

(3) The Commissioner may, in deciding whether to revoke the patent, take into account any ground on which the grant of an innovation patent may be opposed, whether relied upon by the opponent or not.

(4) Subject to subsection (6), if the Commissioner is satisfied, on the balance of probabilities, that a ground exists for the revocation of

ComLaw Authoritative Act C2015C00060

an innovation patent, the Commissioner may revoke the patent in writing either wholly or so far as it relates to a particular claim.

(5) If the Commissioner revokes the patent:
  (a) the Commissioner must notify the patentee and the opponent of the revocation; and
  (b) register the revocation of the patent.

(6) The Commissioner must not revoke a patent under this section unless the Commissioner has, where appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any ground for revocation and the patentee has failed to do so.

(7) The patentee, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

101P Relevant proceedings and opposition

If relevant proceedings in relation to an innovation patent are pending, the Commissioner must not make a decision under this Part in relation to the patent without the leave of the court.

ComLaw Authoritative Act C2015C00060

Chapter 10—Amendments

Part 1—Amendments that are not allowable

102 What amendments are not allowable?

Amendment of complete specification not allowable if amended specification claims or discloses matter extending beyond that disclosed in certain documents

(1) An amendment of a complete specification is not allowable if, as a result of the amendment, the specification would claim or disclose matter that extends beyond that disclosed in the following documents taken together:

(a) the complete specification as filed;

(b) other prescribed documents (if any).

Certain amendments of complete specification are not allowable after relevant time

(2) An amendment of a complete specification is not allowable after the relevant time if, as a result of the amendment:

(a) a claim of the specification would not in substance fall within the scope of the claims of the specification before amendment; or

(b) the specification would not comply with subsection 40(2) or (3).

*Meaning of **relevant time***[1]

(2A) For the purposes of subsection (2), ***relevant time*** means:

(a) in relation to an amendment proposed to a complete specification relating to a standard patent—after the specification has been accepted; or

[1] This heading has been placed in the correct position.

ComLaw Authoritative Act C2015C00060

(b) in relation to an amendment proposed to a complete specification relating to an innovation patent—after the Commissioner has made a decision under paragraph 101E(1)(a) in respect of the patent.

Amendment of innovation patent request not allowable in certain circumstances

(2B) An amendment to a patent request relating to an innovation patent application is not allowable if:

(a) the patent application was provided for in section 79C; and

(b) the effect of the proposed amendment would be to convert the application from an application for an innovation patent to an application for a standard patent.

Amendments of a kind prescribed by regulations not allowable

(2D) An amendment of a patent request or a complete specification is not allowable if it is of a kind prescribed by regulations made for the purposes of this section.

Section does not apply in certain cases

(3) This section does not apply to an amendment for the purposes of:

(a) correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification; or

(b) complying with paragraph 6(c) (about deposit requirements).

103 Consent of mortgagee or exclusive licensee needed

(1) Where a person is registered as the mortgagee or exclusive licensee of a patent, an amendment of the complete specification is not allowable unless the mortgagee or licensee has consented, in writing, to the amendment.

(2) If a mortgagee or licensee refuses to consent to a proposed amendment, the Commissioner may, on the application of the applicant or patentee, if satisfied on the balance of probabilities

ComLaw Authoritative Act C2015C00060

Section 103

that the consent has been unreasonably refused, direct that the consent of the mortgagee or licensee is not necessary.

ComLaw Authoritative Act C2015C00060

Part 2—Amendments of patent requests, specifications and other filed documents

104 Amendments by applicants and patentees

(1) An applicant for a patent or a patentee, may, subject to this Act, and subject to and in accordance with the regulations, ask the Commissioner for leave to amend the relevant patent request or complete specification, or any other filed document, for any purpose including either or both of the following:

(a) removing a lawful ground of objection to the request or specification, whether that objection is raised in the course of an examination or re-examination or otherwise;

(b) correcting a clerical error or an obvious mistake.

(2) Where an applicant or patentee asks for leave to amend a patent request or complete specification, or any other filed document, the Commissioner must consider and deal with the request in accordance with the regulations.

(4) The Minister or any other person may, subject to and in accordance with the regulations, oppose allowing an amendment.

(5) The Commissioner must not allow an amendment that is not allowable under section 102.

(6) On the allowance of an amendment, the amendment is to be taken to have been made.

(7) An appeal lies to the Federal Court, against a decision of the Commissioner allowing, or refusing to allow, a requested amendment, other than a prescribed decision.

105 Amendments directed by court

Order for amendment during relevant proceedings

ComLaw Authoritative Act C2015C00060

Section 106

(1) In any relevant proceedings in relation to a patent, the court may, on the application of the patentee, by order direct the amendment of the patent request or the complete specification in the manner specified in the order.

Order for amendment during an appeal

(1A) If an appeal is made to the Federal Court against a decision or direction of the Commissioner in relation to a patent application, the Federal Court may, on the application of the applicant for the patent, by order direct the amendment of the patent request or the complete specification in the manner specified in the order.

Orders for amendment generally

(2) An order under subsection (1) or (1A) may be made subject to such terms (if any) as to costs, advertisements or otherwise, as the court thinks fit.

(3) The applicant for an order under subsection (1) or (1A) must give notice of an application for an order to the Commissioner, who is entitled to appear and be heard, and must appear if the court directs.

(4) A court is not to direct an amendment that is not allowable under section 102.

(5) The applicant must file a copy of an order within the prescribed period.

(6) On the filing of a copy of an order, the patent request or complete specification is to be taken to have been amended in the manner specified in the order.

106 Amendments directed by Commissioner: patents

(1) Where:

(a) a patent has been granted; and

ComLaw Authoritative Act C2015C00060

(b) the Commissioner is satisfied, on the balance of probabilities, that the patent is invalid on grounds that could be removed by appropriate amendments of the specification following:

(i) in the case of a standard patent—re-examination of the patent; or

(ii) in the case of an innovation patent—examination of, re-examination of, or opposition to, the patent;

the Commissioner may, in accordance with the regulations, direct the patentee to file, within such time as the Commissioner allows, a statement of proposed amendments of the specification for the purpose of removing those grounds.

(2) The Commissioner must not give a direction without first giving the patentee a reasonable opportunity to be heard.

(3) A patentee may, in accordance with the regulations, amend a statement of amendments.

(4) If the Commissioner is satisfied, on the balance of probabilities, that the amendments set out in a statement (or an amended statement) are allowable and would, if made, remove the grounds on which the patent is invalid, the Commissioner must allow the amendments.

(5) On the allowance of an amendment, the amendment is to be taken to have been made.

107 Amendments directed by Commissioner: applications for standard patents

(1) Where:

(a) a complete application for a standard patent has been made; and

(b) the Commissioner is satisfied, on the balance of probabilities, that there are lawful grounds of objection to the patent request or complete specification, but that those grounds of objection could be removed by appropriate amendments of the request or specification; and

ComLaw Authoritative Act C2015C00060

(c) the applicant has not taken action to amend the request or specification so as to remove those grounds of objection;

the Commissioner may, in accordance with the regulations, direct the applicant to file, within such time as the Commissioner allows, a statement of proposed amendments of the request or specification for the purpose of removing those grounds of objection.

(2) The Commissioner must not give a direction without first giving the applicant a reasonable opportunity to be heard.

(3) An applicant may, in accordance with the regulations, amend a statement of amendments.

(4) If the Commissioner is satisfied, on the balance of probabilities, that the amendments set out in a statement (or an amended statement) are allowable and would, if made, remove all lawful grounds of objection to the patent request and complete specification, the Commissioner must allow the amendments.

(5) On the allowance of an amendment, the amendment is to be taken to have been made.

109 Appeal

An appeal lies to the Federal Court against a direction of the Commissioner under section 106 or 107.

ComLaw Authoritative Act C2015C00060

Part 3—Miscellaneous

110 Advertisement of amendment of complete specification

An amendment of a complete specification that is open to public inspection must be notified in the *Official Journal*.

112 Pending proceedings

A complete specification relating to a patent must not be amended, except under section 105, while relevant proceedings in relation to the patent are pending.

112A Decisions on appeal

A complete specification relating to a patent application must not be amended, except under section 105, if:

(a) an appeal against a decision or direction of the Commissioner has been made to the Federal Court in relation to the specification; and

(b) the appeal, and any proceedings resulting from it, have not been finally determined, withdrawn or otherwise disposed of.

113 Persons claiming under assignment or agreement

(1) Where, before a patent is granted, a person would, if the patent were then granted, be entitled under an assignment or agreement, or by operation of law, to:

(a) the patent or an interest in it; or

(b) an undivided share in the patent or in such an interest;

the Commissioner may, on a request made by the person in accordance with the regulations, direct that the application proceed in the name of the person, or in the name of the person and the applicant or the other joint applicant or applicants, as the case requires.

ComLaw Authoritative Act C2015C00060

(2) Where the Commissioner gives a direction:
  (a) the person is to be taken to be the applicant, or a joint applicant, as the case requires; and
  (b) the patent request is to be taken to have been amended so as to request the grant of a patent to the person, either alone or as a joint patentee, as the case requires.

114 Priority date of claims of certain amended specifications

(1) This section applies if:
  (a) a complete specification has been amended; and
  (b) the amendment was not allowable under subsection 102(1); and
  (c) as a result of the amendment, a claim of the amended specification claims an invention that:
    (i) was not disclosed by the complete specification as filed in a manner that was clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; but
    (ii) is disclosed in that manner by the amended specification.

(2) If this section applies, the priority date of the claim must be determined under the regulations.

114A Objection cannot be taken to certain amended specifications

(1) This section applies if:
  (a) a complete specification (the ***original specification***) has been amended; and
  (b) the amendment was not allowable under subsection 102(1); and
  (ba) as a result of the amendment, a claim of the amended specification claims an invention that was not disclosed by the original specification as filed in a manner that was clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; and

ComLaw Authoritative Act C2015C00060

(c) after the filing date of the original specification there is a publication or use of the invention as described in the original specification.

(2) If this section applies, objection cannot be taken to the amended specification, and a patent is not invalid, on the ground that the invention, so far as claimed in the amended specification and having regard to the publication or the use of the invention described in the original specification, does not involve:

(a) in the case of a standard patent—an inventive step; or

(b) in the case of an innovation patent—an innovative step.

115 Restriction on recovery of damages etc.

(1) Where a complete specification is amended after becoming open to public inspection, damages shall not be awarded, and an order shall not be made for an account of profits, in respect of any infringement of the patent before the date of the decision or order allowing or directing the amendment:

(a) unless the court is satisfied that the specification without the amendment was framed in good faith and with reasonable skill and knowledge; or

(b) if the claim of the specification that was infringed is a claim mentioned under subsection 114(1).

(2) Subsection (1) has effect subject to subsections 57(3) and (4).

116 Interpretation of amended specifications

The Commissioner or a court may, in interpreting a complete specification as amended, refer to the specification without amendment.

ComLaw Authoritative Act C2015C00060

Chapter 11—Infringement

Part 1—Infringement and infringement proceedings

117 Infringement by supply of products

(1) If the use of a product by a person would infringe a patent, the supply of that product by one person to another is an infringement of the patent by the supplier unless the supplier is the patentee or licensee of the patent.

(2) A reference in subsection (1) to the use of a product by a person is a reference to:

(a) if the product is capable of only one reasonable use, having regard to its nature or design—that use; or

(b) if the product is not a staple commercial product—any use of the product, if the supplier had reason to believe that the person would put it to that use; or

(c) in any case—the use of the product in accordance with any instructions for the use of the product, or any inducement to use the product, given to the person by the supplier or contained in an advertisement published by or with the authority of the supplier.

118 Infringement exemptions: use in or on foreign vessels, aircraft or vehicles

The rights of a patentee are not infringed:

(a) by using the patented invention on board a foreign vessel, in the body of the vessel, or in the machinery, tackle, apparatus or other accessories of the vessel, if the vessel comes into the patent area only temporarily or accidentally and the invention is used exclusively for the needs of the vessel; or

ComLaw Authoritative Act C2015C00060

(b) by using the patented invention in the construction or working of a foreign aircraft or foreign land vehicle, or in the accessories of the aircraft or vehicle, if the aircraft or vehicle comes into the patent area only temporarily or accidentally.

119 Infringement exemptions: prior use

(1) A person may, without infringing a patent, do an act that exploits a product, method or process and would infringe the patent apart from this subsection, if immediately before the priority date of the relevant claim the person:

(a) was exploiting the product, method or process in the patent area; or

(b) had taken definite steps (contractually or otherwise) to exploit the product, method or process in the patent area.

Note 1: This section applies in relation to a patent granted as a result of an application filed on or after the commencement of Schedule 6 to the *Intellectual Property Laws Amendment Act 2006* (which repealed and substituted this section).

Note 2: Section 119 of this Act as in force before the commencement of that Schedule continues to apply in relation to patents granted as a result of earlier applications.

(2) Subsection (1) does not apply if, before the priority date, the person:

(a) had stopped (except temporarily) exploiting the product, method or process in the patent area; or

(b) had abandoned (except temporarily) the steps to exploit the product, method or process in the patent area.

Limit for product, method or process derived from patentee

(3) Subsection (1) does not apply to a product, method or process the person derived from the patentee or the patentee's predecessor in title in the patented invention unless the person derived the product, method or process from information that was made publicly available:

ComLaw Authoritative Act C2015C00060

(a) by or with the consent of the patentee or the patentee's predecessor in title; and
(b) in the prescribed circumstances mentioned in paragraph 24(1)(a).

Exemption for successors in title

(4) A person (the ***disposer***) may dispose of the whole of the disposer's entitlement under subsection (1) to do an act without infringing a patent to another person (the ***recipient***). If the disposer does so, this section applies in relation to the recipient as if the references in subsections (1), (2) and (3) to the person were references to:
(a) the disposer; or
(b) if the disposer's entitlement arose because of one or more previous applications of this subsection—the first person:
(i) who was entitled under subsection (1) (applying of its own force) to do an act without infringing the patent; and
(ii) to whom the disposer's entitlement is directly or indirectly attributable.

Definition

(5) In this section:

exploit includes:
(a) in relation to a product:
(i) make, hire, sell or otherwise dispose of the product; and
(ii) offer to make, hire, sell or otherwise dispose of the product; and
(iii) use or import the product; and
(iv) keep the product for the purpose of doing an act described in subparagraph (i), (ii) or (iii); and
(b) in relation to a method or process:
(i) use the method or process; and

ComLaw Authoritative Act C2015C00060

(ii) do an act described in subparagraph (a)(i), (ii), (iii) or (iv) with a product resulting from the use of the method or process.

119A Infringement exemptions: acts for obtaining regulatory approval of pharmaceuticals

(1) The rights of a patentee of a pharmaceutical patent are not infringed by a person exploiting an invention claimed in the patent if the exploitation is solely for:

(a) purposes connected with obtaining the inclusion in the Australian Register of Therapeutic Goods of goods that:

(i) are intended for therapeutic use; and

(ii) are not medical devices, or therapeutic devices, as defined in the *Therapeutic Goods Act 1989*; or

(b) purposes connected with obtaining similar regulatory approval under a law of a foreign country or of a part of a foreign country.

(2) Subsection (1) does not apply to the export from Australia of goods for purposes described in paragraph (1)(b) unless the term of the patent has been extended under Part 3 of Chapter 6 and the goods consist of or contain:

(a) a pharmaceutical substance *per se* that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification; or

(b) a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology, that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification.

Note: Part 3 of Chapter 6 provides for the extension of the term of standard patents claiming pharmaceutical substances.

(3) In this section:

pharmaceutical patent means a patent claiming:

ComLaw Authoritative Act C2015C00060

(a) a pharmaceutical substance; or
(b) a method, use or product relating to a pharmaceutical substance, including any of the following:
(i) a method for producing a raw material needed to produce the substance;
(ii) a product that is a raw material needed to produce the substance;
(iii) a product that is a pro-drug, metabolite or derivative of the substance.

119B Infringement exemptions: acts for obtaining regulatory approval (non-pharmaceuticals)

(1) A person may, without infringing a patent, do an act that would infringe the patent apart from this subsection, if the act is done solely for:
(a) purposes connected with obtaining an approval required by a law of the Commonwealth or of a State or Territory to exploit a product, method or process; or
(b) purposes connected with obtaining a similar approval under a law of another country or region.

(2) This section does not apply in relation to a pharmaceutical patent within the meaning of subsection 119A(3).

119C Infringement exemptions: acts for experimental purposes

(1) A person may, without infringing a patent for an invention, do an act that would infringe the patent apart from this subsection, if the act is done for experimental purposes relating to the subject matter of the invention.

(2) For the purposes of this section, ***experimental purposes*** relating to the subject matter of the invention include, but are not limited to, the following:
(a) determining the properties of the invention;
(b) determining the scope of a claim relating to the invention;

ComLaw Authoritative Act C2015C00060

(c) improving or modifying the invention;
(d) determining the validity of the patent or of a claim relating to the invention;
(e) determining whether the patent for the invention would be, or has been, infringed by the doing of an act.

120 Infringement proceedings

(1) Subject to subsection (1A), infringement proceedings may be started in a prescribed court, or in another court having jurisdiction to hear and determine the matter, by the patentee or an exclusive licensee.

(1A) Infringement proceedings in respect of an innovation patent cannot be started unless the patent has been certified.

(2) If an exclusive licensee starts infringement proceedings, the patentee must be joined as a defendant unless joined as a plaintiff.

(3) A patentee joined as a defendant is not liable for costs unless the patentee enters an appearance and takes part in the proceedings.

(4) Infringement proceedings must be started within:
(a) 3 years from the day on which the relevant patent is granted; or
(b) 6 years from the day on which the infringing act was done;
whichever period ends later.

121 Counter-claim for revocation of patent

(1) A defendant in infringement proceedings may apply by way of counter-claim in the proceedings for the revocation of the patent.

(2) The provisions of this Act relating to proceedings for the revocation of a patent apply, with the necessary changes, to a counter-claim.

ComLaw Authoritative Act C2015C00060

121A Burden of proof—infringement of patent for a process

(1) This section applies only to a patent for a process for obtaining a product.

(2) If, in proceedings for infringement of a patent started by the patentee or the exclusive licensee:

(a) the defendant alleges that he or she has used a process different from the patented process to obtain a product (***defendant's product***) identical to the product obtained by the patented process; and

(b) the court is satisfied that:

(i) it is very likely that the defendant's product was made by the patented process; and

(ii) the patentee or exclusive licensee has taken reasonable steps to find out the process actually used by the defendant but has not been able to do so;

then, in the absence of proof to the contrary the onus for which is on the defendant, the defendant's product is to be taken to have been obtained by the patented process.

(3) In deciding how the defendant is to adduce evidence for the purposes of subsection (2), the court is to take into account the defendant's legitimate interests in having business and manufacturing secrets protected.

122 Relief for infringement of patent

(1) The relief which a court may grant for infringement of a patent includes an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

(1A) A court may include an additional amount in an assessment of damages for an infringement of a patent, if the court considers it appropriate to do so having regard to:

(a) the flagrancy of the infringement; and

(b) the need to deter similar infringements of patents; and

ComLaw Authoritative Act C2015C00060

(c) the conduct of the party that infringed the patent that occurred:
  (i) after the act constituting the infringement; or
  (ii) after that party was informed that it had allegedly infringed the patent; and
(d) any benefit shown to have accrued to that party because of the infringement; and
(e) all other relevant matters.

(2) On the application of either party, the court may make such order for the inspection of any thing in or on any vehicle, vessel, aircraft or premises, and may impose such terms and give such directions about the inspection, as the court thinks fit.

123 Innocent infringement

(1) A court may refuse to award damages, or to make an order for an account of profits, in respect of an infringement of a patent if the defendant satisfies the court that, at the date of the infringement, the defendant was not aware, and had no reason to believe, that a patent for the invention existed.

(2) If patented products, marked so as to indicate that they are patented in Australia, were sold or used in the patent area to a substantial extent before the date of the infringement, the defendant is to be taken to have been aware of the existence of the patent unless the contrary is established.

(3) Nothing in this section affects a court's power to grant relief by way of an injunction.

ComLaw Authoritative Act C2015C00060

Part 2—Non-infringement declarations

124 Interpretation

In this Part:

patentee includes an exclusive licensee.

125 Application for non-infringement declaration

(1) A person who has done, is doing, or is intending to do an act may apply to a prescribed court for a declaration that the doing of the act does not, or would not, infringe a patent.

(2) An application may be made:
  (a) for a declaration in relation to an invention claimed in a standard patent—at any time after the patent has been granted; and
  (b) for a declaration in relation to an innovation patent—at any time after the patent has been certified; and
  (c) whether or not the patentee has made any assertion to the effect that the doing of the act has or would infringe the claim.

(3) The patentee must be joined as a respondent in the proceedings.

126 Proceedings for non-infringement declarations

(1) A prescribed court must not make a non-infringement declaration unless:
  (a) the applicant for the declaration:
    (i) has asked the patentee in writing for a written admission that the doing of the act has not infringed, or would not infringe, the patent; and
    (ii) has given the patentee full written particulars of the act done, or proposed to be done; and

ComLaw Authoritative Act C2015C00060

(iii) has undertaken to pay a reasonable sum for the patentee's expenses in obtaining advice about whether the act has infringed or would infringe the claim; and

(b) the patentee has refused or failed to make the admission.

(2) The court may make orders as to costs as the court thinks fit.

127 Effect of non-infringement declarations

If:

(a) a patentee has given a person a written admission that the doing of an act has not infringed, or would not infringe, a claim, or a prescribed court has made a non-infringement declaration in respect of an invention; and

(b) the patentee later gets an injunction restraining the person from doing the act as specified in the admission, or the declaration is revoked;

the person is not liable:

(c) to account to the patentee for any profits, made by the person before the date on which the injunction was granted or the declaration was revoked, from the doing of the act as specified in the admission or declaration; or

(d) to pay damages for any loss suffered by the patentee before that date as a result of the doing of that act.

ComLaw Authoritative Act C2015C00060

Part 3—Unjustified threats of infringement proceedings

128 Application for relief from unjustified threats

(1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with infringement proceedings, or other similar proceedings, a person aggrieved may apply to a prescribed court, or to another court having jurisdiction to hear and determine the application, for:

(a) a declaration that the threats are unjustifiable; and

(b) an injunction against the continuance of the threats; and

(c) the recovery of any damages sustained by the applicant as a result of the threats.

(2) Subsection (1) applies whether or not the person who made the threats is entitled to, or interested in, the patent or a patent application.

129 Court's power to grant relief if threats related to a standard patent or standard patent application

If an application under section 128 for relief relates to threats made in respect of a standard patent or an application for a standard patent, the court may grant the applicant the relief applied for unless the respondent satisfies the court that the acts about which the threats were made infringed, or would infringe:

(a) a claim that is not shown by the applicant to be invalid; or

(b) rights under section 57 in respect of a claim that is not shown by the applicant to be a claim that would be invalid if the patent had been granted.

ComLaw Authoritative Act C2015C00060

129A Threats related to an innovation patent application or innovation patent and court's power to grant relief

Certain threats of infringement proceedings are always unjustifiable

(1) If:

(a) a person:

(i) has applied for an innovation patent, but the application has not been determined; or

(ii) has an innovation patent that has not been certified; and

(b) the person, by means of circulars, advertisements or otherwise, threatens a person with infringement proceedings or other similar proceedings in respect of the patent applied for, or the patent, as the case may be;

then, for the purposes of an application for relief under section 128 by the person threatened, the threats are unjustifiable.

Courts power to grant relief in respect of threats made by the applicant for an innovation patent or the patentee of an uncertified innovation patent

(2) If an application under section 128 for relief relates to threats made in respect of an innovation patent that has not been certified or an application for an innovation patent, the court may grant the applicant the relief applied for.

Courts power to grant relief in respect of threats made by the patentee of a certified innovation patent

(3) If an application under section 128 for relief relates to threats made in respect of a certified innovation patent, the court may grant the applicant the relief applied for unless the respondent satisfies the court that the acts about which the threats were made infringed, or would infringe, a claim that is not shown by the applicant to be invalid.

ComLaw Authoritative Act C2015C00060

130 Counter-claim for infringement

(1) The respondent in proceedings under section 128 may apply, by way of counter-claim, for relief to which the respondent would be entitled in separate proceedings for an infringement by the applicant of the patent to which the threats relate.

(2) Where the respondent applies by way of counter-claim, the applicant may, without making a separate application under Chapter 12, apply in the proceedings for the revocation of the patent.

(3) The provisions of this Act relating to infringement proceedings apply, with the necessary changes, to a counter-claim.

Note: Infringement proceedings cannot be commenced in respect of an innovation patent unless the patent has first been certified (see subsection 120(1A)).

(4) The provisions of this Act relating to proceedings under section 138 for the revocation of a patent apply, with the necessary changes, to an application under subsection (2).

Note: Revocation proceedings under section 138 cannot be commenced in respect of an innovation patent unless the patent has first been certified (see subsection 138(1A)).

131 Notification of patent not a threat

The mere notification of the existence of a patent, or an application for a patent, does not constitute a threat of proceedings for the purposes of section 128.

132 Liability of legal practitioner or patent attorney

A legal practitioner or a registered patent attorney is not liable to proceedings under section 128 in respect of an act done in a professional capacity on behalf of a client.

ComLaw Authoritative Act C2015C00060

Chapter 12—Compulsory licences and revocation of patents

133 Compulsory licences

(1) Subject to subsection (1A), a person may apply to the Federal Court, after the end of the prescribed period, for an order requiring the patentee to grant the applicant a licence to work the patented invention.

(1A) A person cannot apply for an order in respect of an innovation patent unless the patent has been certified.

(2) After hearing the application, the court may, subject to this section, make the order if satisfied that:

(a) all the following conditions exist:

(i) the applicant has tried for a reasonable period, but without success, to obtain from the patentee an authorisation to work the invention on reasonable terms and conditions;

(ii) the reasonable requirements of the public with respect to the patented invention have not been satisfied;

(iii) the patentee has given no satisfactory reason for failing to exploit the patent; or

(b) the patentee has contravened, or is contravening, Part IV of the *Competition and Consumer Act 2010* or an application law (as defined in section 150A of that Act) in connection with the patent.

(3) An order must direct that the licence:

(a) is not to give the licensee, or a person authorised by the licensee, the exclusive right to work the patented invention; and

ComLaw Authoritative Act C2015C00060

(b) is to be assignable only in connection with an enterprise or goodwill in connection with which the licence is used;

and may direct that the licence is to be granted on any other terms specified in the order.

(3B) If the patented invention cannot be worked by the applicant without his or her infringing another patent:

(a) the court is to make the order only if the court is further satisfied that the patented invention involves an important technical advance of considerable economic significance on the invention (***other invention***) to which the other patent relates; and

(b) the court must further order that the patentee of the other invention:

(i) must grant to the applicant a licence to work the other invention insofar as is necessary to work the patented invention; and

(ii) is to be granted, if he or she so requires, a cross-licence on reasonable terms to work the patented invention; and

(c) the court must direct that the licence granted by the patentee of the other invention may be assigned by the applicant:

(i) only if he or she assigns the licence granted in respect of the patented invention; and

(ii) only to the assignee of that licence.

(4) An order operates, without prejudice to any other method of enforcement, as if it were embodied in a deed granting a licence and executed by the patentee and all other necessary parties.

(5) The patentee is to be paid in respect of a licence granted to the applicant under an order:

(a) such amount as is agreed between the patentee and the applicant; or

(b) if paragraph (a) does not apply—such amount as is determined by the Federal Court to be just and reasonable having regard to the economic value of the licence and the desirability of discouraging contraventions of Part IV of the

ComLaw Authoritative Act C2015C00060

Competition and Consumer Act 2010 or an application law (as defined in section 150A of that Act).

(6) The patentee or the Federal Court may revoke the licence if:

(a) the patentee and the licensee are agreed, or the court on application made by either party finds, that the circumstances that justified the grant of the licence have ceased to exist and are unlikely to recur; and

(b) the legitimate interests of the licensee are not likely to be adversely affected by the revocation.

134 Revocation of patent after grant of compulsory licence

(1) Where a compulsory licence relating to a patent is granted, an interested person may apply to the Federal Court, after the end of the prescribed period, for an order revoking the patent.

(2) After hearing the application, the court may make the order if satisfied that:

(a) both:

(i) the reasonable requirements of the public with respect to the patented invention have not been satisfied; and

(ii) the patentee has given no satisfactory reason for failing to exploit the patent; or

(b) the patentee is contravening Part IV of the *Competition and Consumer Act 2010* or an application law (as defined in section 150A of that Act) in connection with the patent.

135 Reasonable requirements of the public

(1) For the purposes of sections 133 and 134, the reasonable requirements of the public with respect to a patented invention are to be taken not to have been satisfied if:

(a) an existing trade or industry in Australia, or the establishment of a new trade or industry in Australia, is unfairly prejudiced, or the demand in Australia for the patented product, or for a product resulting from the patented process, is not reasonably met, because of the patentee's failure:

ComLaw Authoritative Act C2015C00060

(i) to manufacture the patented product to an adequate extent, and supply it on reasonable terms; or

(ii) to manufacture, to an adequate extent, a part of the patented product that is necessary for the efficient working of the product, and supply the part on reasonable terms; or

(iii) to carry on the patented process to a reasonable extent; or

(iv) to grant licences on reasonable terms; or

(b) a trade or industry in Australia is unfairly prejudiced by the conditions attached by the patentee (whether before or after the commencing day) to the purchase, hire or use of the patented product, the use or working of the patented process; or

(c) if the patented invention is not being worked in Australia on a commercial scale, but is capable of being worked in Australia.

(2) If, where paragraph (1)(c) applies, the court is satisfied that the time that has elapsed since the patent was granted has, because of the nature of the invention or some other cause, been insufficient to enable the invention to be worked in Australia on a commercial scale, the court may adjourn the hearing of the application for the period that the court thinks sufficient for that purpose.

136 Orders to be consistent with international agreements

An order must not be made under section 133 or 134 that is inconsistent with a treaty between the Commonwealth and a foreign country.

136A Dealing with allegation of contravention of application law

Proceedings under section 133 or 134 involving an allegation of contravention of an application law that is a law of a State must be dealt with as if the law were a law of the Commonwealth.

Note: Those proceedings are in the Federal Court, which can only exercise the judicial power of the Commonwealth. This section lets the court

ComLaw Authoritative Act C2015C00060

deal comprehensively with the proceedings without the need for a court of the State to determine whether the application law has been contravened.

137 Revocation on surrender of patent

(1) A patentee may, at any time, by written notice to the Commissioner, offer to surrender the patent.

(2) The Commissioner must give notice of an offer in accordance with the regulations.

(3) After hearing all interested persons who notify the Commissioner in accordance with the regulations of their wish to be heard, the Commissioner may accept the offer and revoke the patent.

(4) Where relevant proceedings in relation to a patent are pending, the Commissioner must not accept an offer to surrender the patent without either the leave of the court or the consent of the parties to the proceedings.

(5) Where a compulsory licence is in force in relation to a patent, the Commissioner must not accept an offer to surrender the patent.

138 Revocation of patents in other circumstances

(1) Subject to subsection (1A), the Minister or any other person may apply to a prescribed court for an order revoking a patent.

(1A) A person cannot apply for an order in respect of an innovation patent unless the patent has been certified.

(2) At the hearing of the application, the respondent is entitled to begin and give evidence in support of the patent and, if the applicant gives evidence disputing the validity of the patent, the respondent is entitled to reply.

(3) After hearing the application, the court may, by order, revoke the patent, either wholly or so far as it relates to a claim, on one or more of the following grounds, but on no other ground:

(a) that the patentee is not entitled to the patent;

ComLaw Authoritative Act C2015C00060

(b) that the invention is not a patentable invention;

(d) that the patent was obtained by fraud, false suggestion or misrepresentation;

(e) that an amendment of the patent request or the complete specification was made or obtained by fraud, false suggestion or misrepresentation;

(f) that the specification does not comply with subsection 40(2) or (3).

(4) A court must not make an order under subsection (3) on the ground that the patentee is not entitled to the patent unless the court is satisfied that, in all the circumstances, it is just and equitable to do so.

139 Parties to proceedings

(1) The patentee, and any person claiming an interest in the patent as exclusive licensee or otherwise, are parties to any proceedings under section 133, 134 or 138.

(2) In any proceedings under section 133, 134 or 138:

(a) the applicant must serve a copy of the application on the Commissioner; and

(b) the Commissioner may appear and be heard in the proceedings.

140 Commissioner to be given copies of orders

An office copy of an order made under this Chapter must be served on the Commissioner by the Registrar or other appropriate officer of the court that made the order.

ComLaw Authoritative Act C2015C00060

Chapter 13—Withdrawal and lapsing of applications and ceasing of patents

141 Withdrawal of applications

(1) A patent application, other than a PCT application, may be withdrawn if all of the following conditions are met:

(a) the applicant lodges a written notice of withdrawal signed by the applicant;

(b) if the application has been opposed under section 59—the Commissioner has consented to the withdrawal;

(c) if the regulations prescribe a period within which an application must not be withdrawn—the withdrawal will not occur within the prescribed period.

(2) The regulations may prescribe circumstances in which PCT applications may be withdrawn, or are to be taken to be withdrawn.

142 Lapsing of applications

(1) A provisional application for a patent lapses at the end of the period prescribed for the purpose of section 38 or, if that period is extended, at the end of the period as so extended.

(2) A complete application for a standard patent lapses if:

(a) the applicant does not ask for an examination of the patent request and complete specification within the relevant period prescribed for the purposes of subsection 44(1), (2) or (3), as the case requires; or

(d) the applicant does not pay a continuation fee for the application within the period prescribed for the purposes of this paragraph; or

(e) the patent request and complete specification are not accepted within the period prescribed for the purposes of this paragraph; or

ComLaw Authoritative Act C2015C00060

(f) if the application is a PCT application—prescribed circumstances apply to the application.

(3) A complete application for a standard patent lapses if the applicant does not comply with a direction of the Commissioner under section 107 within the time allowed by the Commissioner under that section.

143 Ceasing of patents

A standard patent ceases if the patentee:

(a) does not pay a renewal fee for the patent within the prescribed period; or

(b) does not file the prescribed documents (if any) within the prescribed period.

143A Ceasing of innovation patents

An innovation patent ceases if:

(a) the fee for filing the request and accompanying specification relating to an application for an innovation patent is not paid in accordance with the regulations; or

(b) after an examination of the patent has been requested under paragraph 101A(b), the patentee does not pay the prescribed fee for the examination within the prescribed period; or

(c) the Commissioner does not make a decision under paragraph 101E(1)(a) within the period prescribed for the purposes of this paragraph; or

(d) the patentee does not pay a renewal fee for the patent within the prescribed period; or

(e) the patentee does not comply with a direction of the Commissioner under section 106 within the time allowed by the Commissioner under that section.

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143B Payment of fees

To avoid doubt, a reference in this Chapter to the payment of a continuation fee or renewal fee by the applicant or patentee is taken to include a reference to the payment of that fee by a person other than the applicant or patentee.

ComLaw Authoritative Act C2015C00060

Chapter 14—Contracts

144 Void conditions

(1) A condition in a contract relating to the sale or lease of, or a licence to exploit, a patented invention is void if the effect of the condition would be:

(a) to prohibit or restrict the buyer, lessee or licensee from using a product or process (whether patented or not) supplied or owned by a person other than the seller, lessor or licensor, or a nominee of the seller, lessor or licensor; or

(b) to require the buyer, lessee or licensee to acquire a product not protected by the patent from the seller, lessor or licensor, or a nominee of the seller, lessor or licensor.

(1A) A condition in a contract relating to the sale or lease of, or a licence to exploit, an invention the subject of an innovation patent is void if the effect of the condition would be to:

(a) prohibit the buyer, lessee or licensee from applying for examination of the patent; or

(b) impose restrictions on the circumstances in which the buyer, lessee or licensee may apply for examination of the patent.

(2) Subsection (1) does not apply if:

(a) the seller, lessor or licensor proves that, at the time the contract was made, the buyer, lessee or licensee had the option of buying the product, or obtaining a lease or licence, on reasonable terms without the condition; and

(b) the contract entitles the buyer, lessee or licensee to be relieved of the liability to comply with the condition on giving the other party 3 months' notice in writing and paying, in compensation for the relief:

(i) in the case of a sale—such sum as is fixed by an arbitrator appointed by the Minister; or

(ii) in the case of a lease or licence—such rent or royalty as is so fixed for the rest of the term of the contract.

ComLaw Authoritative Act C2015C00060

(3) A person is not stopped from applying for or obtaining relief in any proceedings under this Act merely because of an admission made by the person about the reasonableness of terms offered to the person as mentioned in paragraph (2)(a).

(4) It is a defence to proceedings for infringement of a patent that the patented invention is, or was when the proceedings were started, the subject of a contract containing a provision, inserted by the patentee, that is void under this section.

(5) If the patentee offers the other parties to a contract mentioned in subsection (4) a new contract that does not contain the void condition but that otherwise gives the parties the same rights as the existing contract, then, whether or not the other parties accept the new contract in place of the existing contract, subsection (4) ceases to apply, but the patentee is not entitled to damages or an account of profit for an infringement of the patent committed before the offer of the new contract.

145 Termination of contract after patent ceases to be in force

(1) A contract relating to the lease of, or a licence to exploit, a patented invention may be terminated by either party, on giving 3 months' notice in writing to the other party, at any time after the patent, or all the patents, by which the invention was protected at the time the contract was made, have ceased to be in force.

(2) Subsection (1) applies despite anything to the contrary in that contract or in any other contract.

146 Effect of Chapter

Nothing in this Chapter:

(a) affects a condition in a contract that prohibits a person from selling products other than those of a particular person; or

(b) validates a contract that would otherwise be invalid; or

(c) affects a right to terminate a contract, or to terminate a condition of a contract, being a condition exercisable independently of this section; or

ComLaw Authoritative Act C2015C00060

(d) affects a condition in a contract for the lease of, or a licence to exploit, a patented product, that reserves to the lessor or licensor the right to supply new parts of the patented product that are required to put or keep it in repair.

ComLaw Authoritative Act C2015C00060

Chapter 15—Special provisions relating to associated technology

147 Certificate by Director as to associated technology

(1) Where the Commissioner considers that a specification in respect of an application may contain information of a kind referred to in the definition of ***associated technology*** in subsection 4(1) of the Safeguards Act, the Commissioner must give the Director written notice to that effect together with a copy of the patent request and specification.

(2) On receiving a notice, the Director may, if satisfied that the specification contains information of that kind, issue a certificate to that effect.

(3) Where the Director is satisfied that:

(a) the possession by the applicant or the nominated person of the associated technology containing the information was not in accordance with a permit; or

(b) the communication of the information involved in making the application was not in accordance with an authority;

the Director may include in the certificate:

(c) if the application is not a relevant international application—a direction that the application should lapse; or

(d) if the application is a relevant international application—a direction that the application should not be treated as an international application.

(4) Where the Director issues a certificate, the Director must give a copy of it to the Commissioner who must give a copy to the applicant.

ComLaw Authoritative Act C2015C00060

148 Lapsing etc. of applications

(1) Where:

(a) the Commissioner receives a copy of a certificate under subsection 147(2) in relation to an application; and

(b) the certificate includes a direction under subsection 147(3);

then, upon receipt by the Commissioner of that copy:

(c) if the application is not a relevant international application—the application lapses; or

(d) if the application is a relevant international application—the application must cease to be treated as an international application.

(2) Where an application has lapsed under this section, the Commissioner must publish a notice to that effect in the *Official Journal*.

149 Revocation of direction

Where under section 148 an application has lapsed, or has ceased to be treated as an international application, because of a direction by the Director under section 147, the applicant may apply in writing to the Director for the revocation of the direction and the Director may revoke the direction.

150 Restoration of lapsed application

(1) Where an application has lapsed under section 148, the applicant may, in writing, ask the Commissioner to restore it.

(2) On receiving a request, the Commissioner must restore the application if satisfied, on the balance of probabilities, that:

(a) the relevant direction of the Director is no longer in force; and

(b) there is no other reason not to do so.

ComLaw Authoritative Act C2015C00060

(3) Where the Commissioner restores an application, the Commissioner must publish a notice to that effect in the *Official Journal*.

(4) Where an application is restored under this section, such provisions as are prescribed have effect for the protection or compensation of persons who exploited (or took definite steps by contract or otherwise to exploit) the relevant invention after the lapse of the application and before the day on which its restoration was notified in the *Official Journal*.

(5) Proceedings cannot be started under section 57 in respect of anything done during the period from and including the day on which the application lapsed to and including the day on which its restoration was notified in the *Official Journal*.

151 Reinstatement of application as an international application

(1) Where a relevant international application has ceased to be treated as an international application under section 148, the applicant may ask the Commissioner in writing to reinstate it.

(2) On receiving a request, the Commissioner must reinstate the application as an international application if satisfied, on the balance of probabilities, that:

(a) the relevant direction of the Director is no longer in force; and

(b) there is no other reason not to do so.

(3) Where the Commissioner reinstates an application as an international application, the application must be treated as an international application.

(4) Where:

(a) the relevant international application specifies Australia as a designated State; and

(b) the Commissioner cannot reinstate the application merely because, under the PCT, it is to be considered as having been withdrawn; and

ComLaw Authoritative Act C2015C00060

(c) the applicant files, within the prescribed period, a written request signed by the applicant that the application be treated as an application under this Act for a standard patent; and

(d) the applicant files any prescribed documents and pays the prescribed fee;

then, except as otherwise prescribed:

(e) the application must be treated as requested; and

(f) the description, claims and drawings in the application must be treated as a complete specification filed in respect of the application; and

(g) the application and complete specification must be treated as having been filed on the date on which the relevant international application was filed.

152 Notice of prohibitions or restrictions on publication

(1) Where the Director issues a certificate under section 147 in relation to an application, the Director may give written notice to the Commissioner of any prohibitions or restrictions on the publication or communication of the information in the specification, or in a relevant abstract, that the Director considers appropriate.

(2) On receiving a notice, the Commissioner must take such steps as are necessary or expedient to give effect to it.

(3) Without limiting the generality of subsection (2), the Commissioner may, by written order, prohibit or restrict the publication or communication of information about the subject-matter of the application, whether generally or in relation to a particular person or class of persons.

(4) A person must not, except in accordance with the written consent of the Commissioner, publish or communicate information in contravention of an order.

Penalty: Imprisonment for 2 years.

ComLaw Authoritative Act C2015C00060

153 Effect of order

(1) Where an order is in force in relation to an application for a standard patent, the application may proceed up to the acceptance of the patent request and complete specification, but the complete specification must not be made open to public inspection, the acceptance must not be notified in the *Official Journal* and a patent must not be granted on the application.

(2) While an order is in force in relation to an application for an innovation patent, the application may proceed up to the acceptance of the patent request and complete specification but a patent must not be granted on the application.

(3) Where an order in relation to an application for a standard patent has been revoked after the acceptance of the patent request and complete specification, the acceptance must be notified in the *Official Journal* within the prescribed period.

(4) Nothing in this Act prevents disclosing information about an invention to the Director for the purpose of obtaining advice on whether an order should be made, amended or revoked.

ComLaw Authoritative Act C2015C00060

Chapter 16—Jurisdiction and powers of courts

154 Jurisdiction of Federal Court

(1) The Federal Court has jurisdiction with respect to matters arising under this Act.

(2) The jurisdiction of the Federal Court to hear and determine appeals against decisions or directions of the Commissioner is exclusive of the jurisdiction of any other court except the jurisdiction of the High Court under section 75 of the Constitution.

(3) A prosecution for an offence against this Act must not be started in the Federal Court.

155 Jurisdiction of other prescribed courts

(1) Each prescribed court (other than the Federal Court) has jurisdiction with respect to matters arising under this Act in respect of which proceedings may, under this Act, be started in a prescribed court.

(2) The jurisdiction conferred by subsection (1) on the Supreme Court of a Territory is conferred:

(a) in the case of proceedings for the infringement of a patent or proceedings under subsection 125(1) or section 128, or a matter arising under this Act that may be heard and determined in the course of such proceedings—to the extent that the Constitution permits; and

(b) in any other case—only in relation to proceedings instituted by a natural person who is resident in the Territory, or a corporation that has its principal place of business in the Territory, at the time the proceedings are started.

ComLaw Authoritative Act C2015C00060

156 Exercise of jurisdiction

The jurisdiction of a prescribed court under section 154 or 155 is to be exercised by a single judge.

157 Transfer of proceedings

(1) A prescribed court in which proceedings under this Act have been started may, on the 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 a court transfers proceedings to another court:

(a) all documents of record relevant to those proceedings filed in the transferring court shall be sent to the other court by the Registrar or other appropriate officer of the transferring court; and

(b) the other court shall proceed as if the proceedings had been started in the other court and as if the same steps in the proceedings had been taken there as had been taken in the transferring court.

158 Appeals

(1) An appeal lies to the Federal Court against a judgment or order of:

(a) another prescribed court exercising jurisdiction under this Act; or

(b) any other court in proceedings under subsection 120(1) or section 128.

(2) Except with the leave of the Federal Court, an appeal does not lie to the Full Court of the Federal Court against a judgment or order of a single judge of the Federal Court in the exercise of its jurisdiction to hear and determine appeals from decisions or directions of the Commissioner.

(3) With the special leave of the High Court, an appeal lies to the High Court against a judgment or order referred to in subsection (1).

ComLaw Authoritative Act C2015C00060

(4) Except as otherwise provided by this section, an appeal does not lie against a judgment or order referred to in subsection (1).

159 Commissioner may appear in appeals

The Commissioner may appear and be heard at the hearing of an appeal to the Federal Court against a decision or direction of the Commissioner even if the Commissioner is not a party to the appeal.

160 Powers of Federal Court

On hearing an appeal against a decision or direction of the Commissioner, the Federal Court may do any one or more of the following:

(a) admit further evidence orally, or on affidavit or otherwise;

(b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence before the Commissioner;

(c) order an issue of fact to be tried as it directs;

(d) affirm, reverse or vary the Commissioner's decision or direction;

(e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;

(f) order a party to pay costs to another party.

ComLaw Authoritative Act C2015C00060

Chapter 17—The Crown

Part 1—Introductory

161 Nominated persons and patentees

A reference in this Chapter to a nominated person or to a patentee includes a reference to the successor in title of the nominated person or patentee or an exclusive licensee of the nominated person or patentee.

162 Commonwealth and State authorities

A reference in this Chapter to the Commonwealth includes a reference to an authority of the Commonwealth and a reference to a State includes a reference to an authority of a State.

ComLaw Authoritative Act C2015C00060

Part 2—Exploitation by the Crown

163 Exploitation of inventions by Crown

(1) Where, at any time after a patent application has been made, the invention concerned is exploited by the Commonwealth or a State (or by a person authorised in writing by the Commonwealth or a State) for the services of the Commonwealth or the State, the exploitation is not an infringement:

(a) if the application is pending—of the nominated person's rights in the invention; or

(b) if a patent has been granted for the invention—of the patent.

(2) A person may be authorised for the purposes of subsection (1):

(a) before or after any act for which the authorisation is given has been done; and

(b) before or after a patent has been granted for the invention; and

(c) even if the person is directly or indirectly authorised by the nominated person or patentee to exploit the invention.

(3) Subject to section 168, an invention is taken for the purposes of this Part to be exploited for services of the Commonwealth or of a State if the exploitation of the invention is necessary for the proper provision of those services within Australia.

164 Nominated person or patentee to be informed of exploitation

As soon as practicable after an invention has been exploited under subsection 163(1), the relevant authority must inform the applicant and the nominated person, or the patentee, of the exploitation and give him or her any information about the exploitation that he or she from time to time reasonably requires, unless it appears to the relevant authority that it would be contrary to the public interest to do so.

ComLaw Authoritative Act C2015C00060

165 Remuneration and terms for exploitation

(2) The terms for the exploitation of the invention (including terms concerning the remuneration payable to the nominated person or the patentee) are such terms as are agreed, or determined by a method agreed, between the relevant authority and the nominated person or the patentee or, in the absence of agreement, as are determined by a prescribed court on the application of either party.

(3) For the purposes of subsection (2), the terms, or the method, may be agreed before, during or after the exploitation.

(4) When fixing the terms, the court may take into account any compensation that a person interested in the invention or the patent has received, directly or indirectly, for the invention from the relevant authority.

165A Exploitation of invention to cease under court order

(1) A prescribed court may, on the application of the nominated person or the patentee, declare that the exploitation of the invention by the Commonwealth or the State is not, or is no longer, necessary for the proper provision of services of the Commonwealth or of the State if the court is satisfied that, in all the circumstances of the case, it is fair and reasonable to make the declaration.

(2) The court may further order that the Commonwealth or the State is to cease to exploit the invention:

(a) on and from the day specified in the order; and

(b) subject to any conditions specified in the order.

In making the order, the court is to ensure that the legitimate interests of the Commonwealth or of the State are not adversely affected by the order.

166 Previous agreements inoperative

An agreement or licence (whether made or given before or after the commencement of this Act) fixing the terms on which a person other than the Commonwealth or a State may exploit an invention

ComLaw Authoritative Act C2015C00060

is inoperative with respect to the exploitation, after the commencement of this Act, of the invention under subsection 163(1), unless the agreement or licence has been approved:

(a) if the relevant authority is the Commonwealth—by the Minister; or

(b) if the relevant authority is a State—by the Attorney-General of the State.

167 Sale of products

(1) The right to exploit an invention under subsection 163(1) includes the right to sell products made in exercise of that right.

(2) Where under subsection 163(1) the sale of products is not an infringement of:

(a) a patent; or

(b) a nominated person's rights in the products;

the buyer, and any person claiming through the buyer, is entitled to deal with the products as if the relevant authority were the patentee or the nominated person.

168 Supply of products by Commonwealth to foreign countries

Where the Commonwealth has made an agreement with a foreign country to supply to that country products required for the defence of the country:

(a) the use of a product or process by the Commonwealth, or by a person authorised in writing by the Commonwealth, for the supply of that product is to be taken, for the purposes of this Chapter, to be use of the product or process by the Commonwealth for the services of the Commonwealth; and

(b) the Commonwealth or the authorised person may sell those products to the country under the agreement; and

(c) the Commonwealth or the authorised person may sell to any person any of the products that are not required for the purpose for which they were made.

ComLaw Authoritative Act C2015C00060

169 Declarations that inventions have been exploited

(1) Subject to subsection (4), a patentee who considers that the patented invention has been exploited under subsection 163(1) may apply to a prescribed court for a declaration to that effect.

(2) In proceedings under subsection (1):
  (a) the alleged relevant authority is the defendant; and
  (b) the alleged relevant authority may apply by way of counter-claim in the proceedings, for the revocation of the patent.

(3) The provisions of this Act relating to the revocation of patents apply, with the necessary changes, to a counter-claim.

(4) An application under subsection (1) in respect of an innovation patent cannot be made unless the patent has been certified.

170 Sale of forfeited articles

Nothing in this Chapter affects the right of the Commonwealth or a State, or of a person deriving title directly or indirectly from the Commonwealth or a State, to sell or use an article forfeited under a law of the Commonwealth or the State.

ComLaw Authoritative Act C2015C00060

Part 3—Acquisitions by and assignments to the Crown

171 Acquisition of inventions or patents by Commonwealth

(1) The Governor-General may direct that a patent, or an invention that is the subject of a patent application, be acquired by the Commonwealth.

(2) When a direction is given, all rights in respect of the patent or the invention are, by force of this subsection, transferred to and vested in the Commonwealth.

(3) Notice of the acquisition must be:
  (a) given to the applicant and the nominated person, or the patentee; and
  (b) published in the *Official Journal* and the *Gazette* unless, in the case of the acquisition of an invention that is the subject of an application for a patent, a prohibition order, or an order under section 152, is in force in respect of the application.

(4) The Commonwealth must pay a compensable person such compensation as is agreed between the Commonwealth and the person or, in the absence of agreement, as is determined by a prescribed court on the application of either of them.

172 Assignment of invention to Commonwealth

(1) An inventor, or an inventor's successor in title, may assign the invention, and any patent granted or to be granted for the invention, to the Commonwealth.

(2) The assignment and all covenants and agreements in the assignment are valid and effectual, even if valuable consideration has not been given for the assignment, and may be enforced by proceedings in the name of the Minister.

ComLaw Authoritative Act C2015C00060

Part 4—Prohibition orders

173 Prohibition of publication of information about inventions

(1) Subject to any directions of the Minister, the Commissioner may, if it appears to the Commissioner to be necessary or expedient to do so in the interests of the defence of the Commonwealth, by written order:

(a) prohibit or restrict the publication of information about the subject-matter of an application for a patent (including an international application); or

(b) prohibit or restrict access to a micro-organism deposited for the purposes of section 41 with a prescribed depositary institution situated in Australia.

(2) A person must not contravene a prohibition order except in accordance with the written consent of the Commissioner.

Penalty: Imprisonment for 2 years.

(3) A reference in subsection (1) to giving access to a micro-organism includes a reference to giving a sample of the micro-organism.

174 Effect of prohibition orders

(1) While a prohibition order is in force in relation to an application for a standard patent, the application may proceed up to the acceptance of the patent request and complete specification, but the complete specification must not be made open to public inspection, the acceptance must not be notified in the *Official Journal* and a patent must not be granted on the application.

(2) Where a prohibition order in relation to an application for a standard patent is revoked after the acceptance of the patent request and complete specification, the acceptance must be notified in the *Official Journal* within the prescribed period.

ComLaw Authoritative Act C2015C00060

(3) While a prohibition order is in force in relation to an application for an innovation patent, the application may proceed up to the acceptance of the patent request and complete specification, but a patent must not be granted on the application.

175 Disclosure of information to Commonwealth authority

Nothing in this Act prevents disclosing information about an invention, or giving access to, or a sample of, a micro-organism to a department or authority of the Commonwealth for the purpose of obtaining advice on whether a prohibition order should be made, amended or revoked.

176 International applications treated as applications under this Act

Where:

(a) an international application specifies Australia as a designated State; and

(b) as a result of a prohibition order or of anything done in reliance on section 175, the application is, under the PCT, to be considered as having been withdrawn; and

(c) the applicant files, within the prescribed period, a written request signed by the applicant that the application be treated as an application under this Act for a standard patent; and

(d) the applicant files any prescribed documents and pays the prescribed fee;

then, except as otherwise prescribed:

(e) the application must be treated as requested; and

(f) the description, claims and drawings in the application must be treated as a complete specification filed in respect of the application; and

(g) the application and specification must be treated as having been filed on the date on which the international application was filed.

ComLaw Authoritative Act C2015C00060

Chapter 18—Miscellaneous offences

177 False representations about the Patent Office

(1) A person must not use, in connection with his or her business, words that would reasonably lead to the belief that his or her office is, or is officially connected with, the Patent Office.

Penalty: 30 penalty units.

(2) Without limiting subsection (1), a person who:

(a) places, or allows to be placed, on the building in which his or her office is situated; or

(b) uses when advertising his or her office or business; or

(c) places on a document, as a description of his or her office or business;

the words "Patent Office" or "Office for obtaining patents", or words of similar import, whether alone or together with other words, is guilty of an offence against that subsection.

178 False representations about patents or patented articles

(1) A person must not falsely represent that he or she, or another person, is the patentee of an invention.

Penalty: 60 penalty units.

(1A) A person must not falsely represent that he or she, or another person, is the patentee of an innovation patent that has been certified.

Penalty: 60 penalty units.

(2) A person must not falsely represent that an article sold by him or her is patented in Australia, or is the subject of an application for a patent in Australia.

Penalty: 60 penalty units.

ComLaw Authoritative Act C2015C00060

(3) Without limiting subsection (2):

(a) a person is to be taken to represent that an article is patented in Australia if the word "patent" or "patented", the words "provisional patent", or any other word or words implying that a patent for the article has been obtained in Australia, are stamped, engraved or impressed on, or otherwise applied to, the article; and

(b) a person is to be taken to represent that an article is the subject of an application for a patent in Australia if the words "patent applied for" or "patent pending", or any other word or words implying that an application for a patent for the article has been made in Australia, are stamped, engraved or impressed on, or otherwise applied to, the article.

(4) A prosecution must not be started for an offence against subsection (1) or (2) without the consent of the Minister, or a person authorised by the Minister.

182 Officers not to traffic in inventions

(1) The Commissioner, a Deputy Commissioner or an employee must not buy, sell, acquire or traffic in:

(a) an invention or patent, whether granted in Australia or anywhere else; or

(b) a right to, or licence under, a patent, whether granted in Australia or anywhere else.

Penalty: 60 penalty units.

(2) A purchase, sale, acquisition, assignment or transfer made or entered into in contravention of this section is void.

(3) This section does not apply to the inventor or to an acquisition by bequest or devolution by law.

ComLaw Authoritative Act C2015C00060

183 Unauthorised disclosure of information by employees etc.

(1) The Commissioner, each Deputy Commissioner and each employee must not disclose information about a matter that has been or is being dealt with under this Act or the 1952 Act unless required or authorised to do so by this Act, a written direction of the Commissioner or an order of a court.

(2) The Designated Manager may disclose to the Australian Securities and Investments Commission information (including personal information within the meaning of the *Privacy Act 1988*) that is:

(a) relevant to the functions of the Commission; and

(b) obtained by the Designated Manager as a result of the performance of functions and duties, or the exercise of powers, in relation to incorporated patent attorneys.

184 Other unauthorised disclosures of information

A person to whom section 71 of the Safeguards Act applies must not disclose information about a matter that has been or is being dealt with under this Act or the 1952 Act unless required or authorised to do so by the Safeguards Act, this Act, a written direction of the Director or an order of a court.

Penalty: Imprisonment for 2 years.

185 Commissioner etc. not to prepare documents or search records

The Commissioner, a Deputy Commissioner or an employee must not:

(a) prepare, or help to prepare:

(i) a specification; or

(ii) any other document relating to a specification (other than a document which is in an approved form);

unless the Commissioner, Deputy Commissioner or the employee is the inventor in respect of the specification; or

(b) search the records of the Patent Office otherwise than in his or her official capacity.

ComLaw Authoritative Act C2015C00060

Section 185

Penalty: 10 penalty units.

ComLaw Authoritative Act C2015C00060

Chapter 19—The Register and official documents

186 Register of Patents

(1) A Register of Patents is to be kept at the Patent Office. The Register is to contain 2 parts as follows:

(a) a part dealing with standard patents; and

(b) a part dealing with innovation patents.

(2) The Register may be kept wholly or partly by use of a computer.

(3) If the Register is kept wholly or partly by use of a computer:

(a) references in this Act to an entry in the Register are to be read as including references to a record of particulars kept by use of the computer and comprising the Register or part of the Register; and

(b) references in this Act to particulars being registered, or entered in the Register, are to be read as including references to the keeping of a record of those particulars as part of the Register by use of the computer; and

(c) references in this Act to the rectification of the Register are to be read as including references to the rectification of the record of particulars kept by use of the computer and comprising the Register or part of the Register.

187 Registration of particulars of patents etc.

(1) Particulars of standards patents in force, and other prescribed particulars relating to standard patents (if any), must be registered in that part of the Register dealing with standard patents.

(2) Particulars of innovation patents in force, and other prescribed particulars relating to innovation patents (if any), must be registered in that part of the Register dealing with innovation patents.

ComLaw Authoritative Act C2015C00060

188 Trusts not registrable

Notice of any kind of trust relating to a patent or licence is not receivable by the Commissioner and must not be registered.

189 Power of patentee to deal with patent

(1) A patentee may, subject only to any rights appearing in the Register to be vested in another person, deal with the patent as the absolute owner of it and give good discharges for any consideration for any such dealing.

(2) This section does not protect a person who deals with a patentee otherwise than as a purchaser in good faith for value and without notice of any fraud on the part of the patentee.

(2A) Despite subsection (1), the recording in the Register of a right that is a PPSA security interest does not affect a dealing with a patent.

(3) Equities in relation to a patent may be enforced against the patentee except to the prejudice of a purchaser in good faith for value.

(4) Subsection (3) does not apply in relation to an equity that is a PPSA security interest.

Note: The *Personal Property Securities Act 2009* deals with the rights of purchasers of personal property (including intellectual property such as patents) that is subject to PPSA security interests. That Act also provides for the priority and enforcement of PPSA security interests. See the following provisions of that Act:

(a) Part 2.5 (taking personal property free of security interests);

(b) Part 2.6 (priority between security interests);

(c) Chapter 4 (enforcement of security interests).

190 Inspection of Register

(1) The Register must be available for inspection at the Patent Office by any person during the hours that it is open for business.

ComLaw Authoritative Act C2015C00060

(2) If a record of particulars is kept by use of a computer, subsection (1) is to be taken to be complied with, to the extent that the Register consists of those particulars, by giving members of the public access to a computer terminal which they can use to inspect the particulars, either on a screen or in the form of a computer printout.

191 False entries in Register

A person must not:

(a) make a false entry in the Register; or

(b) cause a false entry to be made in the Register; or

(c) tender in evidence a document that falsely purports to be a copy of or extract from an entry in the Register.

Penalty: Imprisonment for 2 years.

191A Commissioner's power to rectify register

(1) The Commissioner may rectify the Register if the Commissioner is satisfied, on the balance of probabilities, whether on application or otherwise, of any of the following:

(a) the omission of an entry from the Register;

(b) an entry made in the Register without sufficient cause;

(c) an entry wrongly existing in the Register;

(d) an error or defect in an entry in the Register.

(2) The Commissioner must, on application, make a declaration as to a person's entitlement to a patent, or a share in a patent, if the Commissioner is satisfied, on the balance of probabilities, that the Register does not properly record a person's entitlement to a patent, or a share in a patent:

(a) because the patent, or a share in the patent, was granted to a person who was not entitled to it; or

(b) because the patent, or a share in the patent, was not granted to a person who was entitled to it; or

(c) for any other reason.

ComLaw Authoritative Act C2015C00060

(3) If the Commissioner makes a declaration under subsection (2), the Commissioner must rectify the Register accordingly.

(4) The Commissioner must not make a declaration, or rectify the Register, under this section without first giving the following persons a reasonable opportunity to be heard:

(a) the person whose entitlement is not properly recorded by the Register;

(b) any person whose entitlement to the patent, or a share in the patent, is recorded in the Register.

(5) The Commissioner must not make a declaration or rectify the Register under this section while relevant proceedings in relation to the patent are pending.

(6) An appeal lies to the Federal Court against a decision of the Commissioner:

(a) to make, or refuse to make, a declaration; or

(b) to rectify, or not rectify, the Register;

under this section.

192 Orders for rectification of Register

(1) A person aggrieved by:

(a) the omission of an entry from the Register; or

(b) an entry made in the Register without sufficient cause; or

(c) an entry wrongly existing in the Register; or

(d) an error or defect in an entry in the Register;

may apply to a prescribed court for an order to rectify the Register.

(2) On hearing an application, the court may:

(a) decide any question which it is necessary or expedient to decide in connection with the rectification of the Register; and

(b) make any order it thinks fit for the rectification of the Register.

ComLaw Authoritative Act C2015C00060

(3) The Commissioner:
  (a) must be given notice of an application; and
  (b) may appear and be heard in the proceedings; and
  (c) must appear if directed to do so by the court.

(4) An office copy of an order must be served on the Commissioner by the Registrar or other appropriate officer of the court.

(5) On receiving an office copy of an order, the Commissioner must rectify the Register accordingly.

193 Inspection of documents

All documents filed in connection with the registration of prescribed particulars under section 187 must be available for inspection at the Patent Office by any person during the hours when it is open for business.

194 Information obtainable from Commissioner

The Commissioner may give any person information about:
  (a) a patent; or
  (b) an application for a patent that is open to public inspection; or
  (c) any prescribed document or matter.

195 Evidence—the Register

(1) The Register is *prima facie* evidence of any particulars registered in it.

(2) If the Register is wholly or partly kept by use of a computer, a document signed by the Commissioner reproducing in writing all or any of the particulars comprising the Register, or that part of it, is admissible in any proceedings as *prima facie* evidence of those particulars.

(3) This section does not apply in relation to any particulars registered in the Register in relation to a PPSA security interest.

ComLaw Authoritative Act C2015C00060

Note: Certain particulars relating to registrations in respect of PPSA security interests under the *Personal Property Securities Act 2009* are admissible in evidence: see section 174 of that Act.

196 Evidence—unregistered particulars

(1) A document in respect of which particulars have not been entered in the Register is not admissible in any proceedings in proof of the title to a patent or to an interest in a patent unless:

(a) the court or tribunal before which the proceedings are brought otherwise directs; or

(b) the proceedings are:

(i) for an order under section 192; or

(ii) to enforce equities in relation to a patent or licence.

(2) However, subsection (1) does not restrict the admissibility in any proceedings of a document in relation to a PPSA security interest.

Note: Certain particulars relating to registrations in respect of PPSA security interests under the *Personal Property Securities Act 2009* are admissible in evidence: see section 174 of that Act.

197 Evidence—certificate and copies of documents

(1) A signed certificate to the effect that:

(a) anything required or permitted by this Act or the 1952 Act to be done or not to be done had or had not been done on a date specified in the certificate; or

(b) a document in the Patent Office or its library was available for public inspection on a date specified in the certificate;

is *prima facie* evidence of the matters in the certificate.

(2) A signed copy of or signed extract from the Register is admissible in any proceedings as if it were the original.

(3) A signed copy of or signed extract from a document in the Patent Office or its library is admissible in any proceedings as if it were the original.

(4) In this section:

ComLaw Authoritative Act C2015C00060

signed means signed by the Commissioner.

197AA Evidence of matters arising under PCT

A certificate signed by the Commissioner in relation to an international application, certifying that:

(a) any matter or thing required or permitted by or under this Act or the PCT to be made or done has been made or done; or

(b) any matter or thing required by or under this Act or the PCT not to be made or done has not been made or done;

is prima facie evidence of the matters contained in the certificate.

ComLaw Authoritative Act C2015C00060

Chapter 20—Patent Attorneys

Part 1—Registration, privileges and professional conduct

198 Registration of patent attorneys

(1) A Register of Patent Attorneys is to be kept by the Designated Manager.

Note: ***Designated Manager*** is defined by section 200A.

(2) The Register of Patent Attorneys may be kept wholly or partly by use of a computer.

(3) If the Register of Patent Attorneys is kept wholly or partly by use of a computer, references in this Act to an entry in the Register of Patent Attorneys are to be read as including references to a record of particulars kept by use of the computer and comprising the Register of Patent Attorneys or part of the Register of Patent Attorneys.

Registration of individuals

(4) The Designated Manager must register as a patent attorney an individual who:

(a) is ordinarily resident in Australia; and

(b) holds such qualifications as are specified in, or ascertained in accordance with, the regulations; and

(c) has been employed as prescribed for not less than the prescribed period; and

(d) is of good fame, integrity and character; and

(e) has not been convicted of a prescribed offence during the previous 5 years; and

(f) is not under sentence of imprisonment for a prescribed offence; and

ComLaw Authoritative Act C2015C00060

(g) meets any other requirements prescribed by the regulations.

The registration is to consist of entering the individual's name in the Register of Patent Attorneys.

(5) A qualification specified in, or ascertained in accordance with, regulations made for the purposes of paragraph (4)(b) may consist of passing an examination conducted by the Professional Standards Board. This subsection does not limit paragraph (4)(b).

(6) Paragraphs (4)(e) and (f) do not limit paragraph (4)(d).

(7) For the purposes of this section, an individual is taken to be ***ordinarily resident*** in Australia if:

(a) the individual has his or her home in Australia; or

(b) Australia is the country of his or her permanent abode even though he or she is temporarily absent from Australia;

but the individual is taken not to be ordinarily resident in Australia if he or she resides in Australia for a special or temporary purpose only.

(8) A reference in this section to conviction of an offence includes a reference to the making of an order under section 19B of the *Crimes Act 1914*, or a corresponding provision of a law of a State or a Territory, in relation to the offence.

Registration of companies

(9) The Designated Manager must register as a patent attorney a company that:

(a) has at least one patent attorney director; and

(b) has given the Designated Manager written notice in the approved form of its intention to act as a patent attorney; and

(c) meets the requirements (if any) prescribed by the regulations.

The registration is to consist of entering the company's name in the Register of Patent Attorneys.

(10) A company registered as a patent attorney is an ***incorporated patent attorney***.

ComLaw Authoritative Act C2015C00060

(11) A ***patent attorney director*** of a company is an individual who is both:

(a) a registered patent attorney; and

(b) a validly appointed director of the company.

199 Deregistration

The name of a person registered as a patent attorney may be removed from the Register of Patent Attorneys in the prescribed manner and on the prescribed grounds.

200 Privileges

(1) A registered patent attorney:

(a) is entitled to prepare all documents, transact all business and conduct all proceedings for the purposes of this Act; and

(b) has such other rights and privileges as are prescribed.

(2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client.

(2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.

(2B) A reference in subsection (2) or (2A) to a registered patent attorney includes a reference to an individual authorised to do patents work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided.

(2C) ***Intellectual property advice*** means advice in relation to:

(a) patents; or

ComLaw Authoritative Act C2015C00060

(b) trade marks; or
(c) designs; or
(d) plant breeder's rights; or
(e) any related matters.

(3) Nothing in this section authorises a registered patent attorney to prepare a document to be issued from or filed in a court or to transact business, or conduct proceedings, in a court.

200A Designated Manager

For the purposes of this Act, a person is the Designated Manager if the person occupies, or is acting in, a position that:
(a) is usually occupied by an SES employee; and
(b) has been declared by the Secretary of the Department, in writing, to be the position of Designated Manager.

ComLaw Authoritative Act C2015C00060

Part 2—Offences

201 Acting or holding out without being registered

Individuals

(1) An individual commits an offence if:
  (a) the individual carries on business, practises or acts as a patent attorney; and
  (b) the individual is not a registered patent attorney or a legal practitioner.

Penalty: 30 penalty units.

(2) An individual commits an offence if:
  (a) the individual describes himself or herself, or holds himself or herself out, or permits himself or herself to be described or held out, as a patent attorney or agent for obtaining patents; and
  (b) the individual is not a registered patent attorney.

Penalty: 30 penalty units.

Partnerships

(3) A member of a partnership commits an offence if:
  (a) the member carries on business, practises or acts as a patent attorney; and
  (b) none of the members of the partnership is a registered patent attorney or a legal practitioner.

Penalty: 30 penalty units.

(4) A member of a partnership commits an offence if:
  (a) the member describes the partnership, or holds the partnership out, or permits the partnership to be described or

ComLaw Authoritative Act C2015C00060

held out, as a patent attorney, or agent for obtaining patents; and

(b) none of the members of the partnership is a registered patent attorney.

Penalty: 30 penalty units.

Companies

(5) A company commits an offence if:

(a) the company carries on business, practises or acts as a patent attorney; and

(b) the company is not a registered patent attorney or incorporated legal practice.

Penalty: 150 penalty units.

(6) A company commits an offence if:

(a) the company describes itself, or holds itself out, or permits itself to be described or held out, as a patent attorney, or agent for obtaining patents; and

(b) the company is not a registered patent attorney.

Penalty: 150 penalty units.

Exception—legal representatives

(7) Subsections (1), (3) and (5) do not apply in relation to the business of a registered patent attorney who is deceased if the business:

(a) is carried on, within 3 years of the death of the patent attorney, or such further time allowed by a prescribed court, by the legal representative of the deceased registered patent attorney; and

(b) is managed by a registered patent attorney on behalf of the legal representative.

Note: The defendant bears an evidential burden in relation to the matters in subsection (7). See subsection 13.3(3) of the *Criminal Code*.

ComLaw Authoritative Act C2015C00060

Exception—employees

(8) Subsections (1) and (2) do not apply in relation to anything done by a person, as an employee, for:

(a) his or her employer; or

(b) if the person's employer is a member of a related company group—another member of the group.

Note: The defendant bears an evidential burden in relation to the matters in subsection (8). See subsection 13.3(3) of the *Criminal Code*.

Exception—related company groups

(9) Subsections (5) and (6) do not apply in relation to anything done by a member of a related company group for another member of the group.

Note: The defendant bears an evidential burden in relation to the matter in subsection (9). See subsection 13.3(3) of the *Criminal Code*.

Whether a company is related to another company

(10) For the purposes of this section, the question of whether a company is related to another company is to be determined in the same manner as that question is determined under the *Corporations Act 2001*.

201A When a person carries on business, practises or acts as a patent attorney

(1) For the purposes of section 201, a person is taken to carry on business, practise or act as a patent attorney if, and only if, the person does, or undertakes to do, patents work in Australia.

(2) ***Patents work*** means one or more of the following done, on behalf of someone else, for gain:

(a) applying for or obtaining patents in Australia or anywhere else;

(b) preparing specifications or other documents for the purposes of this Act or the patent law of another country;

ComLaw Authoritative Act C2015C00060

(c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.

201B Incorporated patent attorney must have a patent attorney director

Offence—failing to notify lack of patent attorney director

(1) An incorporated patent attorney commits an offence if the incorporated patent attorney:
   (a) does not have a patent attorney director; and
   (b) does not notify the Designated Manager of that within 7 days.

   Penalty: 150 penalty units.

Offence—acting after 7 days without patent attorney director

(2) An incorporated patent attorney commits an offence if the incorporated patent attorney:
   (a) does not have a patent attorney director; and
   (b) has not had a patent attorney director during the previous 7 days; and
   (c) carries on business, practises or acts as a patent attorney.

   Penalty: 150 penalty units.

Designated Manager may appoint a registered patent attorney

(3) If an incorporated patent attorney does not have a patent attorney director, the Designated Manager may, by writing, appoint another registered patent attorney to take charge of the patents work of the incorporated patent attorney.

(4) The appointment may be made only with the consent of the other registered patent attorney.

ComLaw Authoritative Act C2015C00060

Effect of appointment

(5) A registered patent attorney holding an appointment under subsection (3) (the ***appointed attorney***) is taken, for the purposes of this Act, to be a patent attorney director of the incorporated patent attorney.

(6) However, for the purposes of the *Corporations Act 2001*:

(a) the appointed attorney is not a director of the incorporated patent attorney only because:

(i) the appointed attorney takes charge of the patents work of the incorporated patent attorney; and

(ii) the appointed attorney is taken, for the purposes of this Act, to be a patent attorney director of the incorporated patent attorney; and

(b) the Designated Manager is not a director of the incorporated patent attorney only because the Designated Manager appointed the appointed attorney.

Designated Manager may remove incorporated patent attorney from Register

(7) If an incorporated patent attorney does not have a patent attorney director, the Designated Manager may remove the incorporated patent attorney from the Register.

202 Documents prepared by legal practitioners

A legal practitioner must not prepare a specification, or a document relating to an amendment of a specification, unless:

(a) the practitioner is acting under the instructions of a registered patent attorney; or

(b) the amendment has been directed by an order under section 105.

Penalty: 30 penalty units.

ComLaw Authoritative Act C2015C00060

202A Documents prepared by a member of a partnership

A person who is:

(a) a member of a partnership; and

(b) not a registered patent attorney;

must not prepare a specification, or a document relating to an amendment of a specification, unless:

(c) the person is acting under the instructions or supervision of a registered patent attorney; or

(d) the amendment has been directed by an order under section 105.

Penalty: 30 penalty units.

202B Documents prepared by incorporated patent attorneys and incorporated legal practices

An incorporated patent attorney or an incorporated legal practice commits an offence if:

(a) an employee or member of the incorporated patent attorney or incorporated legal practice prepares a specification, or a document relating to an amendment of a specification; and

(b) the employee or member is not a registered patent attorney; and

(c) the specification or document is not prepared:

(i) under the instructions or supervision of an individual who is a registered patent attorney; or

(ii) as directed by an order under section 105.

Penalty: 150 penalty units.

203 Attendance at patent attorney's office

A registered patent attorney commits an offence if:

(a) the registered patent attorney practises, acts, or holds himself, herself or itself out as practising or acting, as a patent attorney, at an office or place of business where

ComLaw Authoritative Act C2015C00060

specifications or other documents are prepared for the purposes of this Act; and

(b) there is not an individual who is a registered patent attorney:

(i) in regular attendance at that office or place; and

(ii) in continuous charge of the patents work done at that office or place.

Penalty: 30 penalty units.

204 Time for starting prosecutions

Despite section 15B of the *Crimes Act 1914*, a prosecution for an offence against subsection 201(1), (2), (3), (4) or (5), or section 202, 202A or 203, may be started at any time within 5 years after the offence was committed.

ComLaw Authoritative Act C2015C00060

Chapter 21—Administration

205 Patent Office and sub-offices

(1) For the purposes of this Act, there is to be an office called the Patent Office.

(2) The Commissioner may establish one or more sub-offices of the Patent Office as the Commissioner considers appropriate.

(3) The Commissioner may abolish any such sub-offices.

206 Patent Office seal

There is to be a seal of the Patent Office and impressions of the seal must be judicially noticed.

207 Commissioner of Patents

(1) There is to be a Commissioner of Patents.

(2) The Commissioner has such powers and functions as are conferred on him or her under this Act or any other Act.

208 Deputy Commissioner of Patents

(1) There is to be at least one Deputy Commissioner of Patents.

(2) Subject to any direction by the Commissioner, a Deputy Commissioner has all the powers and functions of the Commissioner under this Act or any other Act, except the Commissioner's powers of delegation under section 209.

(3) A power or function of the Commissioner under this Act or any other Act, when exercised by a Deputy Commissioner, is to be taken, for the purposes of this Act or any other Act, to have been exercised by the Commissioner.

ComLaw Authoritative Act C2015C00060

(4) The exercise of a power or function of the Commissioner under this Act or any other Act by a Deputy Commissioner does not prevent the exercise of the power or function by the Commissioner.

(5) Where, under this Act or any other Act, the exercise of a power or function by the Commissioner, or the operation of a provision of this Act or any other Act, is dependent on the opinion, belief or state of mind of the Commissioner in relation to a matter, that power or function may be exercised by a Deputy Commissioner, and that provision may operate, as the case may be, on the opinion, belief or state of mind of the Deputy Commissioner in relation to that matter.

209 Delegation of Commissioner's powers and functions

(1) The Commissioner may, by instrument, signed by him or her, delegate all or any of the Commissioner's powers or functions under this Act or any other Act to a prescribed employee, or a prescribed class of employees.

(2) A delegate must, if so required by the instrument of delegation, exercise or perform a delegated power or function under the direction or supervision of the Commissioner or an employee specified in the instrument.

210 Commissioner's powers

Commissioner's powers

(1) The Commissioner may, for the purposes of this Act:
  (a) summon witnesses; and
  (b) receive written or oral evidence on oath or affirmation; and
  (c) require the production of documents or articles; and
  (d) award costs against a party to proceedings before the Commissioner.

ComLaw Authoritative Act C2015C00060

Exercise of power to summon witnesses

(2) The Commissioner must not summon a witness under paragraph (1)(a) unless:

(a) the Commissioner is satisfied, on the balance of probabilities, of the following matters:

(i) the witness has a substantial interest in the proceedings before the Commissioner;

(ii) the witness is likely to provide oral evidence of substantial relevance to a matter before the Commissioner;

(iii) receiving oral evidence from the witness is necessary or desirable in all the circumstances; and

(b) the Commissioner notifies the witness of the actions the Commissioner may take under section 210A if the witness fails or refuses to comply with the summons.

(3) The Commissioner may summon a witness under paragraph (1)(a) whether the witness is in or out of the patent area.

Exercise of power to require production of document or article

(4) The Commissioner must not require a person to produce a document or article under paragraph (1)(c) unless:

(a) the Commissioner is satisfied, on the balance of probabilities, of the following matters:

(i) the person has a substantial interest in the proceedings before the Commissioner;

(ii) the document or article is likely to be of substantial relevance to a matter before the Commissioner; and

(b) the Commissioner notifies the person of the actions the Commissioner may take under section 210A if the person fails or refuses to comply with the requirement.

(5) The Commissioner may require a person to produce a document or article under paragraph (1)(c) whether the person is in or out of the patent area.

ComLaw Authoritative Act C2015C00060

Exercise of powers in relation to bodies corporate

(6) The Commissioner's powers in subsection (1) to make a requirement of a person extend, if the person is a body corporate, to making that requirement of any person who is an officer, agent or employee of the body corporate.

210A Sanctions for non-compliance with Commissioner's requirements

(1) The Commissioner may take one or more of the actions listed in subsection (2) in relation to a person if:

(a) the Commissioner summons the person to appear as a witness under paragraph 210(1)(a) or requires the person to produce a document or article under paragraph 210(1)(c); and

(b) the person refuses or fails to comply with the summons or requirement; and

(c) the Commissioner is satisfied, on the balance of probabilities, that it is appropriate in the circumstances to take the action.

(2) The actions the Commissioner may take are:

(a) if the person is an applicant for a patent—a refusal to grant the patent (see subsection 61(1); and

(b) the drawing of an inference unfavourable to the person's interest in proceedings before the Commissioner; and

(c) actions of a kind that are prescribed by the regulations.

(3) 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 summons or requirement;

(b) whether the person has been offered payment of reasonable expenses associated with complying with the summons or requirement;

(c) any other matter the Commissioner considers to be relevant.

ComLaw Authoritative Act C2015C00060

211 Recovery of costs awarded by Commissioner

Costs awarded by the Commissioner against a party are recoverable as a debt.

ComLaw Authoritative Act C2015C00060

Chapter 22—Miscellaneous

212 Copies of examination reports to be communicated

A copy of each report relating to an examination or a re-examination under this Act must, subject to Chapters 15 and 17, be given to the applicant or patentee, as the case requires.

213 Making and signing applications etc.

An application, notice or request required or permitted under this Act to be made or signed by a person may be made or signed, on behalf of that person, by a registered patent attorney.

214 Filing of documents

A document may be filed with the Patent Office by:

(a) delivering the document to the Patent Office or a sub-office of the Patent Office (if any) either personally or by post; or

(b) any other prescribed means.

215 Death of applicant or nominated person

(1) If an applicant dies before a patent is granted on the application, his or her legal representative may proceed with the application.

(2) If a nominated person dies before a patent is granted on the application, the patent may be granted to his or her legal representative.

(3) Where, at any time after a patent is granted, the Commissioner is satisfied, on the balance of probabilities, that the patentee had died (or, in the case of a body corporate, had ceased to exist) before the patent was granted, the Commissioner may amend the Register by substituting for the name of the patentee the name of the person to whom the patent should have been granted.

ComLaw Authoritative Act C2015C00060

(4) An amendment by the Commissioner has effect, and is to be taken always to have had effect, accordingly.

216 Exercise of discretionary power by Commissioner

(1) The Commissioner must not exercise a discretionary power under this Act adversely to any person applying for the exercise of that power without first giving that person a reasonable opportunity to be heard.

(2) Subsection (1) does not apply in relation to the Commissioner's power to direct an applicant to request an examination.

217 Assessors

A prescribed court may, if it thinks fit, call in the aid of an assessor to assist it in the hearing and trial or determination of any proceedings under this Act.

218 Costs where patent invalid in part

In any proceedings in which the validity of a patent is disputed, the court may, if it is satisfied that some of the claims in the complete specification which are alleged to be invalid are not invalid but that other claims are invalid, apportion the costs between the parties to the proceedings as it thinks just.

219 Security for costs

If a person who neither resides nor carries on business in Australia:

(a) gives notice of opposition under this Act; or

(b) appeals to the Federal Court;

the Commissioner or the Federal Court, as the case may be, may require the person to give security for the costs of the proceeding or appeal and, where such security is not given to the satisfaction of the Commissioner or the Federal Court, as the case may be, may dismiss the proceeding or appeal.

ComLaw Authoritative Act C2015C00060

220 Costs of attendance of patent attorney

Where, at the hearing of proceedings under this Act, a registered patent attorney attends in court for the purpose of assisting a party in the conduct of the hearing and an order is made for payment of the costs of that party, those costs may include an allowance for that attendance.

221 Service of documents

Where this Act provides for a document to be served on, or given or sent to, a person and the person has given the Commissioner an address in Australia for service of documents, the document may be served on, or given or sent to, the person by post to that address.

222 Publication of *Official Journal* etc.

(1) The Commissioner shall issue periodically an official journal containing such matters as are prescribed and such other matters (if any) as the Commissioner thinks fit.

(2) The Commissioner must make arrangements for selling copies of the *Official Journal*, and of complete specifications which are open to public inspection.

(3) The Commissioner may prepare, publish and sell such documents relating to inventions and patents as the Commissioner thinks fit.

222A Doing act when Patent Office reopens after end of period otherwise provided for doing act

(1) If the last day of a period provided by this Act (except this section) for doing an act is a day when the Patent Office, or a sub-office of the Patent Office (if any), is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.

(2) For the purposes of this section, the Patent Office, or a sub-office of the Patent Office, is taken not to be open for business on a day:

ComLaw Authoritative Act C2015C00060

(a) declared by regulations to be a day on which the office or sub-office is not open for business; or

(b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office or sub-office is not open for business.

Declarations

(3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.

(4) A declaration mentioned in paragraph (2)(b):

(a) may be made before, on or after the day; and

(b) is not a legislative instrument.

Relationship with other law

(5) This section has effect despite the rest of this Act.

(6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

Exception for prescribed act

(7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

223 Extensions of time

(1) The Commissioner must extend the time for doing a relevant act that is required to be done within a certain time if the act is not, or cannot be, done within that time because of an error or omission by:

(a) the Commissioner or a Deputy Commissioner; or

(b) an employee; or

ComLaw Authoritative Act C2015C00060

(c) a person providing, or proposing to provide, services for the benefit of the Patent Office; or

(d) the receiving Office; or

(e) the International Bureau of the World Intellectual Property Organization.

(2) Where, because of:

(a) an error or omission by the person concerned or by his or her agent or attorney; or

(b) circumstances beyond the control of the person concerned;

a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Commissioner may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.

(2A) If:

(a) a relevant act that is required to be done within a certain time is not done within that time; and

(b) the Commissioner is satisfied, on the balance of probabilities, that the person concerned took due care, as required in the circumstances, to ensure the doing of the act within that time;

the Commissioner must, on application made by the person concerned in accordance with the regulations and within the prescribed period, extend the time for doing the act.

(2B) An extension of time under subsection (2A) cannot exceed the period prescribed for the purposes of this subsection.

(3) The time allowed for doing a relevant act may be extended, whether before or after that time has expired.

(3A) Despite subsection (3), the time allowed for doing a relevant act may be extended under subsection (2A) only after that time has expired.

(4) The Commissioner must advertise in the *Official Journal*:

(a) an application made for an extension of time for more than 3 months; or

ComLaw Authoritative Act C2015C00060

(b) an application made for an extension of time for doing a prescribed relevant act in prescribed circumstances.

(6) Subject to subsection (6A), a person may, as prescribed, oppose the granting under subsection (2) or (2A) of the application.

(6A) If the Commissioner is satisfied, on the balance of probabilities, that an application under subsection (2) or (2A) would not be granted even in the absence of opposition under subsection (6):

(a) the Commissioner need not advertise the application in accordance with subsection (4); and

(b) the application cannot be opposed, despite subsection (6); and

(c) the Commissioner must refuse to grant the application.

(7) Where:

(a) a patent application lapses, or a patent ceases, because of a failure to do one or more relevant acts within the time allowed; and

(b) the time for doing that act or those acts is extended;

the application or patent must be treated as having been restored.

(8) Where:

(a) a provisional patent application lapses under subsection 142(1) at the end of the period prescribed for the purposes of section 38; and

(b) that period is extended;

the application must be treated as if it had not lapsed.

(9) Where the Commissioner grants:

(a) an extension of more than 3 months for doing a relevant act; or

(b) an extension of time for doing a prescribed relevant act in prescribed circumstances;

ComLaw Authoritative Act C2015C00060

the prescribed provisions have effect for the protection or compensation of persons who, before the day on which the application for extension of time is advertised under subsection (4), exploited (or took definite steps by way of contract or otherwise to exploit) the invention concerned because of the failure to do the relevant act within the time allowed, the lapsing of the patent application or the ceasing of the patent, as the case may be.

(10) Infringement proceedings cannot be brought in respect of an infringement committed:

(a) between the day on which the patent application lapses and the day on which it is restored; or

(b) between the day on which the patent ceases and the day on which it is restored.

(11) In this section:

relevant act means an action (other than a prescribed action) in relation to a patent, a patent application, or any proceedings under this Act (other than court proceedings), and includes the making of a Convention application within the time allowed for making such applications.

224 Review of decisions

(1) Application may be made to the Administrative Appeals Tribunal for review of:

(a) a decision of the Commissioner under section 10, 17, 32, 33 or 52, subsection 56(1)(b), 74(3) or 103(2), section 113, subsection 137(3), paragraph 141(1)(b) or 142(2)(b), subsection 150(2), 151(2), 152(2) or 152(3), or section 173, 215 or 223; or

(b) a decision of the Designated Manager under section 198 not to register a person as a patent attorney; or

(c) a decision of the Director under subsection 147(2) or (3), section 149 or subsection 152(1).

ComLaw Authoritative Act C2015C00060

(2) Where a person who makes a decision mentioned in subsection (1) gives the person or persons affected by the decision written notice of the making of the decision, the notice must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for review of the decision to which the notice relates by or on behalf of the person or persons whose interests are affected by the decision.

(3) Failure to comply with subsection (2) in relation to a decision does not affect the validity of the decision.

(4) In this section:

decision has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

225 Conduct of employees and agents of natural persons

(3) Where it is necessary to establish, for the purposes of a prosecution for an offence under this Act, the state of mind of a person other than a company in relation to particular conduct, it is sufficient to show:

(a) that the conduct was engaged in by a servant or agent of the person within the scope of his or her actual or apparent authority; and

(b) that the servant or agent had the state of mind.

(4) Any conduct engaged in on behalf of a person other than a company by the person's servant or agent within the scope of his or her actual or apparent authority is to be taken, for the purposes of a prosecution for an offence under this Act, to have been engaged in also by the person, unless the person establishes that he or she took reasonable precautions and exercised due diligence to avoid the conduct.

(5) A reference in this section to an offence under this Act includes a reference to an offence created by:

ComLaw Authoritative Act C2015C00060

(a) section 6 of the *Crimes Act 1914* that relates to this Act or the regulations; or

(b) section 11.1, 11.2, 11.2A, 11.4 or 11.5 of the *Criminal Code* that relates to this Act or the regulations.

(6) Where:

(a) a person other than a company is convicted of an offence under this Act; and

(b) the person would not have been convicted of the offence but for subsections (3) and (4);

the person is not liable to be punished by imprisonment for that offence.

(7) A reference in subsection (3) to the state of mind of a person includes a reference to:

(a) the knowledge, intention, opinion, belief or purpose of the person; and

(b) the person's reasons for the intention, opinion, belief or purpose.

(9) A reference in this section to engaging in conduct includes a reference to failing or refusing to engage in conduct.

Note: For provisions relating to proof of offences by bodies corporate, see Part 2.5 of the *Criminal Code*.

226 Documents open to public inspection do not infringe copyright

(1) If a document mentioned in subsection (2) is open to public inspection, doing any of the following in relation to the whole or part of the document does not constitute an infringement of any copyright subsisting under the *Copyright Act 1968* in any literary or artistic work:

(a) reproducing the document in two-dimensional form;

(b) communicating (within the meaning of that Act) the document to the public;

(c) translating (within the meaning of that Act) the document.

(2) The documents are:

ComLaw Authoritative Act C2015C00060

(a) a provisional specification; and
(b) a complete specification; and
(c) a prescribed document.

(3) If a reproduction of an unpublished work is made as a result of a document being open to public inspection, the supply or communication of the reproduction does not constitute the publication of the work for the purposes of the *Copyright Act 1968*.

227 Fees

(1) The prescribed fees are payable in accordance with the regulations.

(2) Without limiting subsection (1), different fees may be prescribed in respect of the doing of an act according to the time when the act is done.

(3) The regulations may provide for the consequences (for the purposes of this Act) of failing to pay a fee in accordance with the regulations.

Note: Some provisions of this Act provide expressly or implicitly for the consequences of failing to pay a fee (for example, see subsections 29A(5) and 142(2), section 143, subsection 151(4) and section 176). Regulations cannot provide for consequences inconsistent with those provisions.

(4) In particular, the regulations may provide that, for the purposes of this Act:
(a) an act is not to be done, or is taken not to have been done, if the fee for doing the act is not paid in accordance with the regulations; or
(b) a document is not filed, or is taken not to have been filed, if the fee for filing the document is not paid in accordance with the regulations; or
(c) a patent application lapses, or is taken to have lapsed, if the fee for filing the request and accompanying specification is not paid in accordance with the regulations.

(5) Subsection (4) does not limit subsection (3).

ComLaw Authoritative Act C2015C00060

227A Professional Standards Board for Patent and Trade Marks Attorneys

(1) The Professional Standards Board for Patent and Trade Marks Attorneys is established.

(2) The Professional Standards Board has the following functions:

(a) such functions as are conferred on the Professional Standards Board by this Act or the *Trade Marks Act 1995*;

(b) such functions as are conferred on the Professional Standards Board by regulations made for the purposes of any of the following provisions:

(i) paragraph 198(4)(b) of this Act (which deals with the qualifications of patent attorneys);

(ii) section 199 of this Act (which deals with the deregistration of patent attorneys);

(iii) paragraph 228(2)(r) of this Act (which deals with the professional conduct of patent attorneys);

(iv) paragraph 228A(4)(a) of the *Trade Marks Act 1995* (which deals with the qualifications of trade marks attorneys);

(v) section 228B of the *Trade Marks Act 1995* (which deals with the deregistration of trade marks attorneys);

(vi) paragraph 231(2)(ha) of the *Trade Marks Act 1995* (which deals with the professional conduct of trade marks attorneys);

(c) to do anything incidental to or conducive to the performance of any of the above functions.

(3) The regulations may make provision for and in relation to:

(a) the constitution and membership of the Professional Standards Board; and

(b) the manner in which the Professional Standards Board is to perform its functions; and

ComLaw Authoritative Act C2015C00060

(c) the procedure to be followed at or in relation to meetings of the Professional Standards Board, including (but not limited to) matters with respect to:

(i) the convening of meetings of the Board; and

(ii) the number of members of the Board who are to constitute a quorum; and

(iii) the selection of a member of the Board to preside at a meeting of the Board; and

(iv) the manner in which questions arising at a meeting of the Board are to be decided.

(4) A member of the Professional Standards Board is to be paid such remuneration as is determined by the Remuneration Tribunal. If no determination of that remuneration by the Tribunal is in operation, the member is to be paid such remuneration as is prescribed.

(5) A member of the Professional Standards Board is to be paid such allowances as are prescribed.

(6) Subsections (4) and (5) have effect subject to the *Remuneration Tribunal Act 1973*.

228 Regulations

(1) The Governor-General may make regulations, not inconsistent with this Act:

(a) prescribing matters required or permitted by this Act to be prescribed; and

(b) prescribing matters necessary or convenient to be prescribed for carrying out or giving effect to this Act; and

(c) prescribing matters necessary or convenient to be prescribed for the conduct of any business relating to the Patent Office; and

(d) for the purpose of carrying out or giving effect to the Budapest Treaty; and

(e) for the purpose of carrying out or giving effect to the PCT, whether in relation to PCT applications or otherwise.

ComLaw Authoritative Act C2015C00060

(2) Without limiting subsection (1), that subsection includes the power to make regulations:

(aa) making provision for and in relation to:

(i) the procedures for conducting a preliminary search and opinion in relation to a patent request and complete specification; and

(ii) the reports to be made in relation to the preliminary search and opinion; and

(a) making provision for and in relation to the procedures for the examination of a patent request and complete specification and the re-examination of a complete specification; and

(b) making provision for and in relation to the reports to be made in relation to an examination and a re-examination; and

(c) making provision for and in relation to the amendment of patent requests, provisional and complete specifications, and other filed documents:

(i) to correct a clerical error or obvious mistake; or

(ii) to remove a lawful ground of objection, whether the objection is raised in the course of examination or re-examination or otherwise; or

(iii) for any other purpose; and

(e) making provision for and in relation to the amendment of an entry in the Register to correct a clerical error or an obvious mistake, or for any other purpose; and

(g) making provision for and in relation to the preparation, filing and publication of abstracts of complete specifications; and

(h) making provision for and in relation to opposition proceedings; and

(ha) setting out the formalities checking process for innovation patents including, in particular, the following matters:

(i) specifying the formalities requirements (including compliance with the requirements of subsections 18(2) and (3)) that must be met in respect of an application for an innovation patent; and

(ii) empowering the Commissioner to direct an applicant for an innovation patent to do such things as are necessary

ComLaw Authoritative Act C2015C00060

to ensure that the application is in accordance with the requirements of the regulations relating to the preparation of documents for filing; and

(iii) providing for the lapsing of the application if such a direction is not complied with within a time specified in the regulations; and

(iv) providing for the restoration of an application that has so lapsed; and

(i) setting out the checking process for PCT applications including, in particular, the following matters:

(i) specifying the requirements that must be met in respect of a PCT application, once the requirements of subsection 29A(5) have been met;

(ii) empowering the Commissioner to direct an applicant to do such things as are necessary to ensure that the PCT application is in accordance with those requirements;

(iii) providing for the lapsing of the PCT application if such a direction is not complied with within a time specified in the regulations;

(j) empowering the Commissioner to direct an applicant for a standard patent to do such things as are necessary to ensure that the complete specification is in accordance with the requirements of the regulations relating to the preparation of documents for filing and:

(i) providing for the lapsing of the application if such a direction is not complied with within a time specified in the regulations; and

(ii) providing for the restoration of an application that has so lapsed; and

(k) empowering the Commissioner to hear and determine the question whether a person is an interested person for the purpose of doing any act permitted to be done under this Act by an interested person; and

(m) providing for appeals against decisions of the Commissioner made under the regulations; and

ComLaw Authoritative Act C2015C00060

(n) making provision for and in relation to the practice and procedure of prescribed courts in proceedings under this Act, including provision prescribing the time within which any proceeding may be started or anything else may be done, and providing for the extension of any such time; and

(p) requiring persons to make statutory declarations in relation to patent applications or patents or in proceedings under this Act (not being court proceedings); and

(q) making provision for and in relation to the making of a declaration, or the doing of an act, under this Act on behalf of a person who, because of infancy or physical or mental disability, is unable to make the declaration or do the act; and

(r) for the control of the professional conduct of registered patent attorneys and the practice of the profession and, for that purpose, making provision for and in relation to all or any of the following:

(i) making complaints, and hearing charges, against registered patent attorneys about their professional conduct;

(ia) assessing the professional conduct of registered patent attorneys by reference to standards of practice established by the Professional Standards Board from time to time;

(ii) imposing penalties on registered patent attorneys, including issuing a reprimand and suspending or cancelling registration;

(iii) summoning witnesses;

(iv) requiring persons to give evidence on oath (whether orally or otherwise);

(v) administering oaths to persons giving evidence (whether orally or otherwise);

(vi) requiring persons to produce documents or articles; and

(s) making provision for and in relation to:

(i) the deposit for the purposes of this Act, the Budapest Treaty, or both, of micro-organisms with prescribed depositary institutions and the storage and testing of,

ComLaw Authoritative Act C2015C00060

and furnishing of samples of, micro-organisms by those institutions; and

(ii) the charging of fees by prescribed depositary institutions situated in Australia in relation to the matters described in subparagraph (i); and

(iii) the making of reports by prescribed depositary institutions situated in Australia in relation to those matters; and

(iv) the powers and functions of the Commissioner in relation to prescribed depositary institutions with respect to those matters; and

(t) modifying the operation of this Act in relation to PCT applications that are treated as patent applications under this Act by excluding, varying, or substituting different provisions for, specified provisions of this Act; and

(w) making provision for and in relation to the refund, in specified circumstances, of the whole or part of a fee paid in respect of the filing of a document; and

(y) making provision for and in relation to the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a fee; and

(z) prescribing penalties for offences against the regulations not exceeding a fine of $1,000; and

(za) making such transitional and savings provisions as are necessary or convenient as a result of the repeal of the 1952 Act and the enactment of this Act.

(3) The regulations may make provision for matters referred to in paragraph (2)(s) by empowering the Commissioner, on behalf of the Commonwealth, to enter into agreements with prescribed depositary institutions with respect to those matters.

(4) Regulations made under paragraph (2)(s) and subsection (3) may make different provision with respect to different matters dealt with by or under those regulations, but this subsection shall not be taken to limit a power to make regulations conferred by any other provision of this Act.

ComLaw Authoritative Act C2015C00060

(7) Despite the repeal of the 1952 Act by this Act, regulations made under paragraph (2)(za) may provide for the continued operation of specified provisions of the 1952 Act in relation to prescribed persons or matters, or in prescribed circumstances.

ComLaw Authoritative Act C2015C00060

Chapter 23—Transitional and savings provisions

231 Application of Part III of 1989 Amending Act

Nothing in this Act affects the continued operation of Part III of the 1989 Amending Act.

233 Patents granted under 1952 Act

(1) Subject to this Chapter and the regulations, this Act applies in relation to a standard patent or a petty patent granted under the 1952 Act as if the patent had been granted under this Act.

(2) A patent mentioned in subsection (1) does not have effect in any place in which it did not have effect immediately before the commencing day.

(3) Chapter 9 of this Act does not apply in relation to a patent mentioned in subsection (1).

(4) Objection cannot be taken to a patent mentioned in subsection (1), and such a patent is not invalid, so far as the invention is claimed in any claim, on any ground that would not have been available against the patent under the 1952 Act.

234 Applications under 1952 Act

(1) Where, before the commencing day:

(a) a patent application and provisional specification had been lodged under the 1952 Act; and

(b) a complete specification had not been lodged under that Act in respect of the application; and

ComLaw Authoritative Act C2015C00060

(c) the application had not been withdrawn;

then, subject to this Chapter and the regulations, this Act applies in relation to the application on and after that day as if it were a provisional application under this Act.

(2) Where, before the commencing day:

(a) a patent application had been lodged under the 1952 Act; and

(b) a complete specification, or a petty patent specification, had been lodged under that Act in respect of the application; and

(c) the application had not been withdrawn or finally dealt with;

then, subject to this Chapter and the regulations, this Act applies on and after that day:

(d) in relation to the application as if it were a complete application made under this Act; and

(e) in relation to the petty patent specification as if it were a complete specification filed under this Act in respect of the application.

(3) Chapter 5 of this Act does not apply in relation to an application mentioned in subsection (2), but Part V of the 1952 Act, as in force immediately before the commencing day, continues to apply in relation to such an application.

(4) Chapter 9 of this Act does not apply in relation to:

(a) an application mentioned in subsection (2); or

(b) a patent granted on such an application.

(5) Objection cannot be taken to:

(a) an application mentioned in subsection (2); or

(b) a patent granted on such an application;

and such a patent is not invalid, so far as the invention is claimed in any claim, on any ground that would not have been available against the application or patent, as the case may be, under the 1952 Act.

(6) A petty patent specification to which subsection (2) applies cannot be amended under this Act so as to include more than one claim.

ComLaw Authoritative Act C2015C00060

235 Other applications and proceedings under 1952 Act

(1) Subject to this Chapter and the regulations, this Act applies, on and after the commencing day, to any application, request, action or proceeding made or started under the 1952 Act and not finally dealt with or determined under that Act before that day as if the application, request, action or proceeding had been made or started under a corresponding provision of this Act.

(2) Subsection (1) does not apply in relation to an application covered by section 234 of this Act.

236 Micro-organisms

Sections 41 and 42 of this Act do not apply in relation to a specification lodged before 7 July 1987.

237 Orders, directions etc. under 1952 Act

Any report, order or direction made or given under the 1952 Act and in force immediately before the commencing day continues to have effect on and after that day as if it had been made or given under a corresponding provision of this Act.

238 The Commissioner and Deputy Commissioner

The persons holding office as Commissioner of Patents and Deputy Commissioner of Patents immediately before the commencing day continue to hold those respective offices on and after that day.

239 The Register of Patents and Register of Patent Attorneys

(1) On and after the commencing day, the Register of Patents under the 1952 Act is to be taken to form part of the Register of Patents under this Act.

(2) On and after the commencing day, the Register of Patent Attorneys under the 1952 Act is to be taken to form part of the Register of Patent Attorneys under this Act.

ComLaw Authoritative Act C2015C00060

240 Registered patent attorneys

This Act applies, on and after the commencing day, in relation to a person who was, immediately before that day, a registered patent attorney under the 1952 Act as if the person had been registered as a patent attorney under this Act.

ComLaw Authoritative Act C2015C00060

Schedule 1—Dictionary

Section 3

In this Act, unless the contrary intention appears:

application, in Chapter 15, means a patent application, and includes a relevant international application.

approved form means a form approved by the Commissioner for the purposes of the provision in which the expression appears.

associated technology has the same meaning as in the Safeguards Act.

Australia includes each external Territory.

Australian continental shelf means the continental shelf adjacent to the coast of Australia (including the coast of any island forming part of a State or Territory).

Australian Register of Therapeutic Goods means the register maintained under section 9A of the *Therapeutic Goods Act 1989*.

authority, in Chapter 15, has the same meaning as in the Safeguards Act.

basic application means an application for protection in respect of an invention, being an application made in a Convention country.

Budapest Treaty means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure signed at Budapest on 28 April 1977, as that treaty is in force for Australia from time to time, together with the Regulations annexed to that treaty, as those Regulations are in force for Australia from time to time.

Note: The text of the Treaty is set out in Australian Treaty Series 1987 No. 9 ([1987] ATS 9). In 2011, the text of a Treaty in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website (www.austlii.edu.au).

certified, in respect of an innovation patent other than in section 19, means a certificate of examination issued by the Commissioner under paragraph 101E(2)(c) in respect of the patent.

ComLaw Authoritative Act C2015C00060

claim means:

(a) when used as a noun in relation to a patent—a claim (including a dependent claim) of the specification relating to the complete application on which the patent was granted; and

(b) when used as a noun otherwise than in relation to a patent—a claim (including a dependent claim) of a complete specification; and

(c) when used as a verb—to claim in a claim (including a dependent claim) of a complete specification.

commencing day means the day on which this Act commences.

Commissioner means the Commissioner of Patents.

company means a company registered under the *Corporations Act 2001*.

compensable person means:

(a) in relation to a patent acquired by the Commonwealth—the patentee and any person recorded in the Register as having an interest in the patent; and

(b) in relation to an invention that is the subject of a patent application and is so acquired—the nominated person in relation to the application.

complete specification means (other than in section 116) a specification filed in respect of a complete patent application or, if the specification has been amended, the complete specification as amended.

compulsory licence means a licence granted under an order made under section 133.

Convention applicant, in relation to a basic application, means a person (or a body of persons, whether incorporated or not) who:

(a) has made the basic application; or

(b) is the assignee of that applicant; or

(c) would, on the grant of a patent on that application, be entitled to have the patent assigned to the person; or

ComLaw Authoritative Act C2015C00060

(d) is the legal representative of a person mentioned in paragraph (a), (b) or (c); or

(e) has the consent of a person mentioned in paragraph (a), (b), (c) or (d) to make a Convention application based on that basic application.

Convention application means a patent application made under Part 1 of Chapter 3.

Convention country has the meaning given by section 29B.

deposit requirements means the requirements specified in paragraphs 6(a) to (d), inclusive.

depositary institution means a body or institution that receives, accepts and stores micro-organisms and furnishes samples of micro-organisms.

Deputy Commissioner means a Deputy Commissioner of Patents.

Designated Manager has the meaning given by section 200A.

Director means the Director of Safeguards.

director of a company has the same meaning as in the *Corporations Act 2001*.

eligible person, in relation to an invention, means a person to whom a patent for the invention may be granted under section 15.

employee means a person, other than the Commissioner or a Deputy Commissioner, who:

(a) is a person engaged under the *Public Service Act 1999* and is employed in the Patent Office; or

(b) is not such a person but performs services, in the Patent Office, for or on behalf of the Commonwealth.

examination means:

(a) in relation to a patent request and a complete specification relating to a standard patent—an examination of the request and specification under section 45; or

ComLaw Authoritative Act C2015C00060

(b) in relation to an innovation patent—an examination of the complete specification relating to the patent under section 101B.

exclusive licensee means a licensee under a licence granted by the patentee and conferring on the licensee, or on the licensee and persons authorised by the licensee, the right to exploit the patented invention throughout the patent area to the exclusion of the patentee and all other persons.

exploit, in relation to an invention, includes:

(a) where the invention is a product—make, hire, sell or otherwise dispose of the product, offer to make, sell, hire or otherwise dispose of it, use or import it, or keep it for the purpose of doing any of those things; or

(b) where the invention is a method or process—use the method or process or do any act mentioned in paragraph (a) in respect of a product resulting from such use.

Federal Court means the Federal Court of Australia.

file means file with the Patent Office.

foreign aircraft means an aircraft registered in a prescribed foreign country.

foreign land vehicle means a land vehicle owned by a person ordinarily resident in a prescribed foreign country.

foreign vessel means a vessel registered in a prescribed foreign country.

formalities check means, in respect of an application for an innovation patent, the checking process undertaken under section 52 using the process set out in the regulations.

incorporated legal practice means a body corporate recognised under a law of the Commonwealth, a State or a Territory as an incorporated legal practice (however described).

incorporated patent attorney has the meaning given by subsection 198(10).

ComLaw Authoritative Act C2015C00060

infringement proceedings means proceedings for infringement of a patent.

innovation patent means letters patent for an invention granted under section 62.

intellectual property advice has the meaning given by subsection 200(2C).

interested party, in relation to a patent application, means the applicant or a joint applicant, or a person who claims to be entitled to the grant of a patent on the application, either alone or jointly with another person.

international application has the same meaning as in the PCT.

international depositary authority has the same meaning as in the Budapest Treaty.

international filing date, in relation to an international application, means the date given to the international application as its international filing date under the PCT.

invention means any manner of new manufacture the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies, and includes an alleged invention.

legal practitioner means a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory.

legal representative, in relation to a deceased person, means a person to whom probate of the will of the deceased person, letters of administration of the estate of the deceased person, or any other similar grant, has been granted, whether in Australia or anywhere else, but does not include such a person who, under the terms of the grant, is not entitled to do an act in relation to which the expression is used.

licence means a licence to exploit, or to authorise the exploitation of, a patented invention.

main invention has the meaning given in section 81.

ComLaw Authoritative Act C2015C00060

nominated person means the person identified in a patent request as the person to whom the patent is to be granted.

non-infringement declaration means a declaration mentioned in subsection 125(1).

Official Journal means the official journal mentioned in section 222.

patent means a standard patent or an innovation patent.

patent application means an application for a standard patent or an application for an innovation patent.

patent area means:

(a) Australia; and

(b) the Australian continental shelf; and

(c) the waters above the Australian continental shelf; and

(d) the airspace above Australia and the Australian continental shelf.

patent attorney director has the meaning given by subsection 198(11).

patent of addition means letters patent for an invention granted under Chapter 7 and includes, for the purposes of section 25, a patent of addition that has become an independent patent under section 83.

Patent Office means the Patent Office established under this Act.

patent request means a request for the grant of a patent to a nominated person.

patentable invention means an invention of the kind mentioned in section 18.

patented process means a process in respect of which a patent has been granted and is in force.

patented product means a product in respect of which a patent has been granted and is in force.

ComLaw Authoritative Act C2015C00060

patentee means the person for the time being entered in the Register as the grantee or proprietor of a patent.

patents work has the meaning given by subsection 201A(2).

PCT means the Patent Cooperation Treaty signed at Washington on 19 June 1970, as that treaty is in force for Australia from time to time, together with the Regulations annexed to that treaty, as those Regulations are in force for Australia from time to time.

Note: The text of the Treaty is set out in Australian Treaty Series 1980 No. 6 ([1980] ATS 6). In 2011, the text of a Treaty in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website (www.austlii.edu.au).

PCT application means an international application in which Australia is specified as a designated State under Article 4(1)(ii) of the PCT.

permit, in Chapter 15, has the same meaning as in the Safeguards Act.

pharmaceutical substance means a substance (including a mixture or compound of substances) for therapeutic use whose application (or one of whose applications) involves:

(a) a chemical interaction, or physico-chemical interaction, with a human physiological system; or

(b) action on an infectious agent, or on a toxin or other poison, in a human body;

but does not include a substance that is solely for use in *in vitro* diagnosis or *in vitro* testing.

PPSA security interest (short for Personal Property Securities Act security interest) means a security interest within the meaning of the *Personal Property Securities Act 2009* and to which that Act applies, other than a transitional security interest within the meaning of that Act.

Note 1: The *Personal Property Securities Act 2009* applies to certain security interests in personal property. See the following provisions of that Act:

(a) section 8 (interests to which the Act does not apply);

(b) section 12 (meaning of ***security interest***);

(c) Chapter 9 (transitional provisions).

ComLaw Authoritative Act C2015C00060

Note 2: For the meaning of ***transitional security interest***, see section 308 of the *Personal Property Securities Act 2009*.

preliminary search and opinion, in relation to a patent request and complete specification relating to an application for a standard patent, means search and opinion under section 43A.

prescribed court means the Federal Court, the Supreme Court of a State, the Supreme Court of the Australian Capital Territory, the Supreme Court of the Northern Territory or the Supreme Court of Norfolk Island.

prescribed depositary institution means:

(a) an international depositary authority, whether in or outside Australia; or

(b) any other depositary institution in Australia that is prescribed for the purposes of this paragraph.

prior art base means:

(a) in relation to deciding whether an invention does or does not involve an inventive step or an innovative step:

(i) information in a document that is publicly available, whether in or out of the patent area; and

(ii) information made publicly available through doing an act, whether in or out of the patent area.

(b) in relation to deciding whether an invention is or is not novel:

(i) information of a kind mentioned in paragraph (a); and

(ii) information contained in a published specification filed in respect of a complete application where:

(A) if the information is, or were to be, the subject of a claim of the specification, the claim has, or would have, a priority date earlier than that of the claim under consideration; and

(B) the specification was published on or after the priority date of the claim under consideration; and

(C) the information was contained in the specification on its filing date.

*[Note: For the meaning of **document** see section 2B of the Acts Interpretation Act 1901.]*

ComLaw Authoritative Act C2015C00060

prior art information means:

(a) for the purposes of subsection 7(1)—information that is part of the prior art base in relation to deciding whether an invention is or is not novel; and

(b) for the purposes of subsection 7(3)—information that is part of the prior art base in relation to deciding whether an invention does or does not involve an inventive step; and

(c) for the purposes of subsection 7(5)—information that is part of the prior art base in relation to deciding whether an invention does or does not involve an innovative step.

Professional Standards Board means the Professional Standards Board for Patent and Trade Marks Attorneys established by section 227A.

prohibition order means an order under section 173.

provisional specification means a specification filed in respect of a provisional patent application.

receiving Office has the same meaning as in the PCT.

re-examination means:

(a) in relation to a complete specification relating to an application for a standard patent—the re-examination of the complete specification under Chapter 9; and

(b) in relation to an innovation patent—the re-examination of the innovation patent under Part 2 of Chapter 9A.

Register means the Register of Patents mentioned in section 186.

registered, in relation to a patent, means entered in the Register of Patents.

registered patent attorney means a person registered as a patent attorney under this Act.

related company group means a group of 2 or more companies, where each member of the group is related to each other member of the group.

ComLaw Authoritative Act C2015C00060

relevant authority means:

(a) in relation to the exploitation of an invention by or for the Commonwealth—the Commonwealth; and

(b) in relation to the exploitation of an invention by or for a State—that State.

relevant international application, in Chapter 15, means an international application in relation to which the Patent Office is the receiving Office (even if Australia is not specified in the application as a designated State under Article 4(1)(ii) of the PCT).

relevant proceedings, in relation to a patent, means court proceedings:

(a) for infringement of the patent; or

(b) for revocation of the patent; or

(c) in which the validity of the patent, or of a claim, is in dispute.

rules relating to micro-organisms means such provisions of the Budapest Treaty, and such provisions made by or under regulations made under section 228, as are applicable.

Safeguards Act means the *Nuclear Non-Proliferation (Safeguards) Act 1987*.

specification, in relation to an international application, means the description, claims and drawings contained in the application.

standard patent means letters patent for an invention granted under section 61.

State, in Chapter 17, includes the Australian Capital Territory, the Northern Territory and Norfolk Island.

Statute of Monopolies means the Imperial Act known as The Statute of Monopolies.

supply includes:

(a) supply by way of sale, exchange, lease, hire or hire-purchase; and

(b) offer to supply (including supply by way of sale, exchange, lease, hire or hire-purchase).

ComLaw Authoritative Act C2015C00060

Territory means a Territory in which this Act applies or to which this Act extends.

therapeutic use means use for the purpose of:

(a) preventing, diagnosing, curing or alleviating a disease, ailment, defect or injury in persons; or

(b) influencing, inhibiting or modifying a physiological process in persons; or

(c) testing the susceptibility of persons to a disease or ailment.

this Act includes the regulations.

work, in relation to a patented invention, means:

(a) where the invention is a product—make or import the product; or

(b) where the invention is a method or process—use the method or process or do any act mentioned in paragraph (a) in respect of a product resulting from such use.

1952 Act means the *Patents Act 1952*.

1989 Amending Act means the *Patents Amendment Act 1989*.

ComLaw Authoritative Act C2015C00060

Endnotes

Endnote 1—About the endnotes

The endnotes provide information about this compilation and the compiled law.

The following endnotes are included in every compilation:

Endnote 1—About the endnotes
Endnote 2—Abbreviation key
Endnote 3—Legislation history
Endnote 4—Amendment history

Endnotes about misdescribed amendments and other matters are included in a compilation only as necessary.

Abbreviation key—Endnote 2
The abbreviation key sets out abbreviations that may be used in the endnotes.

Legislation history and amendment history—Endnotes 3 and 4
Amending laws are annotated in the legislation history and amendment history.

The legislation history in endnote 3 provides information about each law that has amended (or will amend) the compiled law. The information includes commencement details for amending laws and details of any application, saving or transitional provisions that are not included in this compilation.

The amendment history in endnote 4 provides information about amendments at the provision (generally section or equivalent) level. It also includes information about any provision of the compiled law that has been repealed in accordance with a provision of the law.

Misdescribed amendments
A misdescribed amendment is an amendment that does not accurately describe the amendment to be made. If, despite the misdescription, the amendment can be given effect as intended, the amendment is incorporated into the compiled law and the abbreviation "(md)" added to the details of the amendment included in the amendment history.

If a misdescribed amendment cannot be given effect as intended, the amendment is set out in the endnotes.

ComLaw Authoritative Act C2015C00060

Endnote 2—Abbreviation key

A = Act
ad = added or inserted
am = amended
amdt = amendment
c = clause(s)
C[x] = Compilation No. x
Ch = Chapter(s)
def = definition(s)
Dict = Dictionary
disallowed = disallowed by Parliament
Div = Division(s)
exp = expires/expired or ceases/ceased to have effect
F = Federal Register of Legislative Instruments
gaz = gazette
LI = Legislative Instrument
LIA = *Legislative Instruments Act 2003*
(md) = misdescribed amendment
mod = modified/modification
No. = Number(s)
o = order(s)
Ord = Ordinance
orig = original
par = paragraph(s)/subparagraph(s)/sub-subparagraph(s)
pres = present
prev = previous
(prev…) = previously
Pt = Part(s)
r = regulation(s)/rule(s)
Reg = Regulation/Regulations
reloc = relocated
renum = renumbered
rep = repealed
rs = repealed and substituted
s = section(s)/subsection(s)
Sch = Schedule(s)
Sdiv = Subdivision(s)
SLI = Select Legislative Instrument
SR = Statutory Rules
Sub-Ch = Sub-Chapter(s)
SubPt = Subpart(s)
underlining = whole or part not commenced or to be commenced

ComLaw Authoritative Act C2015C00060

Endnote 3—Legislation history

Act	Number and year	Assent	Commencement	Application, saving and transitional provisions
Patents Act 1990	83, 1990	30 Oct 1990	30 Apr 1991 (s 2(2))	
Industry, Technology and Commerce Legislation Amendment Act 1991	66, 1991	15 June 1991	s 26: 30 Apr 1991 (s 2(4))	—
Industry, Technology and Regional Development Legislation Amendment Act 1994	58, 1994	9 Apr 1994	Sch: 29 June 1994 (s 2 and gaz 1994, No S211)	—
Industry, Science and Technology Legislation Amendment Act 1994	108, 1994	12 July 1994	s 16–19: 12 July 1994 (s 2(1))	—
Patents (World Trade Organization Amendments) Act 1994	154, 1994	13 Dec 1994	s 4–7 and 12: 1 July 1995 (s 2) Remainder: 10 Jan 1995 (s 2)	s 3, 7, 8, 10, 12, 13, 17
Intellectual Property Laws Amendment Act 1998	100, 1998	27 July 1998	Sch 1 and 2 (items 10–32): 27 Jan 1999 (s 2(3), (5)) Sch 3: 27 July 1998 (s 2(1))	Sch 1 (item 8), Sch 2 (items 31, 32) and Sch 3 (item 4)
Public Employment (Consequential and Transitional) Amendment Act 1999	146, 1999	11 Nov 1999	Sch 1 (items 728–730): 5 Dec 1999 (s 2(1), (2) and gaz 1999, No S584)	—
Patents Amendment (Innovation Patents) Act 2000	140, 2000	24 Nov 2000	Sch 1 and 2: 24 May 2001 (s 2(2))	Sch 2

Act	Number and year	Assent	Commencement	Application, saving and transitional provisions
as amended by				
Trade Marks and Other Legislation Amendment Act 2001	99, 2001	22 Aug 2001	Sch 2: 24 May 2001 (s 2(3))	—
Intellectual Property Laws Amendment Act 2003	48, 2003	26 June 2003	Sch 2 (item 8): 24 May 2001 (s 2(1) item 5)	—
Corporations (Repeals, Consequentials and Transitionals) Act 2001	55, 2001	28 June 2001	s 4–14 and Sch 3 (item 401): 15 July 2001 (s 2(1) and gaz 2001, No S285)	s 4–14
Industry, Science and Resources Legislation Amendment (Application of Criminal Code) Act 2001	140, 2001	1 Oct 2001	s 4 and Sch 1 (items 86–98): 2 Oct 2001 (s 2)	s 4
Patents Amendment Act 2001	160, 2001	1 Oct 2001	Sch 1: 1 Apr 2002 (s 2(3)) Sch 2: 24 May 2001 (s 2(4))	Sch 1 (items 13, 32, 33)
Intellectual Property Laws Amendment Act 2003	48, 2003	26 June 2003	Sch 1 (item 2): 24 July 2003 (s 2(2)) Sch 2 (items 1–5): 26 Aug 2003 (s 2(3))	Sch 2 (item 5)
US Free Trade Agreement Implementation Act 2004	120, 2004	16 Aug 2004	Sch 8: 16 Aug 2004 (s 2(1) item 8)	Sch 8 (item 3)
Statute Law Revision Act 2005	100, 2005	6 July 2005	Sch 1 (items 31–37): 24 May 2001 (s 2(1) item 20)	—

Endnote 3—Legislation history

Act	Number and year	Assent	Commencement	Application, saving and transitional provisions
Intellectual Property Laws Amendment Act 2006	106, 2006	27 Sept 2006	Sch 5, 6, 8 and 9: 28 Sept 2006 (s 2(1) items 7, 9) Sch 7: 25 Oct 2006 (s 2(1) item 8) Sch 10 and 12 (item 4): 27 Mar 2007 (s 2(1) items 10, 12) Sch 16 (item 1): 4 Oct 2002 (s 2(1) item 14)	Sch 5 (item 2), Sch 6 (item 2), Sch 7 (item 4), Sch 8 (item 9), Sch 9 (item 2) and Sch 10 (item 3)
Personal Property Securities (Consequential Amendments) Act 2009	131, 2009	14 Dec 2009	Sch 2 (items 8–15): 30 Jan 2012 (s 2(1) item 1)	Sch 2 (item 15)
Crimes Legislation Amendment (Serious and Organised Crime) Act (No. 2) 2010	4, 2010	19 Feb 2010	Sch 10 (item 22): 20 Feb 2010 (s 2(1) item 13)	—
Statute Law Revision Act 2010	8, 2010	1 Mar 2010	Sch 1 (item 39): 1 Mar 2010 (s 2(1) item 4)	—
Personal Property Securities (Corporations and Other Amendments) Act 2010	96, 2010	6 July 2010	Sch 3 (item 16): 30 Jan 2012 (s 2(1) item 13)	—
Trade Practices Amendment (Australian Consumer Law) Act (No. 2) 2010	103, 2010	13 July 2010	Sch 6 (items 1, 82): 1 Jan 2011 (s 2(1) items 3, 5)	—
Statute Law Revision Act 2011	5, 2011	22 Mar 2011	Sch 7 (items 108, 109): 19 Apr 2011 (s 2(1) item 18)	—

ComLaw Authoritative Act C2015C00060

Endnote 3—Legislation history

Act	Number and year	Assent	Commencement	Application, saving and transitional provisions
Acts Interpretation Amendment Act 2011	46, 2011	27 June 2011	Sch 2 (items 905–907) and Sch 3 (items 10, 11): 27 Dec 2011 (s 2(1) items 7, 12)	Sch 3 (items 10, 11)
Intellectual Property Laws Amendment (Raising the Bar) Act 2012	35, 2012	15 Apr 2012	Sch 1, Sch 3 (items 1–16, 32(1)–(6), 33), Sch 4 (items 1–36) and Sch 6 (items 23–86, 88–103, 133, 134): 15 Apr 2013 (s 2(1) items 2, 4, 5, 7) Sch 2 and Sch 6 (item 87): 16 Apr 2012 (s 2(1) items 3, 6)	Sch 1 (items 55, 56), Sch 2 (item 2), Sch 3 (items 32(1)–(6), 33) and Sch 6 (items 133, 134)
Statute Law Revision Act 2013	103, 2013	29 June 2013	Sch 4 (items 17, 18): 29 June 2013 (s 2(1) item 16)	—
Statute Law Revision Act (No. 1) 2014	31, 2014	27 May 2014	Sch 1 (items 53, 54): 24 June 2014 (s 2(1) item 2)	—

ComLaw Authoritative Act C2015C00060

Endnote 3—Legislation history

Act	Number and year	Assent	Commencement	Application, saving and transitional provisions
Intellectual Property Laws Amendment Act 2015	8, 2015	25 Feb 2015	Sch 1: awaiting commencement (s 2(1) item 2) Sch 2: awaiting commencement (s 2(1) item 3) Sch 4 (items 5–58, 81–83): awaiting commencement (s 2(1) item 5) Sch 5 (items 5, 7): 26 Feb 2015 (s 2(1) item 6) Sch 5 (item 8, 18): 15 Apr 2013 (s 2(1) items 7, 9) Sch 5 (items 9–17, 19–21): awaiting commencement (s 2(1) items 8, 10) Sch 5 (item 22): 25 Feb 2015 (s 2(1) item 11)	Sch 1 (item 36), Sch 4 (items 81–83), Sch 5 (items 7, 22)

ComLaw Authoritative Act C2015C00060

Endnote 4—Amendment history

Provision affected	How affected
Chapter 1	
s 3	am No 108, 1994; No 154, 1994; No 100, 1998; No 140, 2000; No 48, 2003; No 131, 2009; No 35, 2012; No 8, 2015
s 4	rs No 140, 2000
	rep No 35, 2012
s 6	am No 100, 1998
s 7	am No 140, 2000; No 160, 2001; No 46, 2011; No 35, 2012
s 7A	ad No 35, 2012
s 8	rep No 35, 2012
s 9	am No 35, 2012
s 10	am No 35, 2012
s 12A	ad No 140, 2001
Chapter 2	
Part 3	
Division 1	
s 18	am No 140, 2000
s 20	am No 8, 2015
Division 2	
s 22A	ad No 35, 2012
s 24	am No 140, 2000; No 8, 2010; No 35, 2012, No 8, 2015
s 26	am No 35, 2012
Division 3	
s 28	rs No 140, 2000
Chapter 3	
Part 1	
Division 1	
s 29	am No 35, 2012

ComLaw Authoritative Act C2015C00060

Endnote 4—Amendment history

Provision affected	How affected
s 29A	ad No 35, 2012
	am No 8, 2015
s 29B	ad No 35, 2012
	am No 8, 2015
s 30	am No 35, 2012
s 32	am No 35, 2012
s 33	rs No 140, 2000
s 34	rs No 140, 2000
s 35	am No 140, 2000; No 35, 2012
s 36	rs No 140, 2000
	am No 35, 2012; No 31, 2014
s 38	am No 35, 2012
s 39	rep No 140, 2000
Division 2	
s 40	am No 140, 2000; No 106, 2006; No 35, 2012; No 8, 2015
s 41	am No 8, 2015
Division 3	
s 43	am No 140, 2000; No 35, 2012; No 8, 2015
s 43AA	ad No 35, 2012
Part 2	
Part 2 heading	rs No 140, 2000
Division 1A	
Division 1A	ad No 35, 2012
s 43A	ad No 35, 2012
Division 1	
s 45	am No 140, 2000; No 160, 2001; No 48, 2003; No 35, 2012
s 46	rep No 35, 2012
Division 2	rep No 35, 2012
s 47	rep No 35, 2012
s 48	am No 140, 2000; No 160, 2001
	rep No 35, 2012

ComLaw Authoritative Act C2015C00060

Provision affected	How affected
Part 3	
Division 1	
Division 1 heading	ad No 140, 2000
s 49	am No 140, 2000; No 160, 2001; No 35, 2012
s 49A	ad No 35, 2012
s 50	rs No 140, 2000
s 50A	ad No 35, 2012
s 51	rs No 140, 2000
	am No 35, 2012
Division 2	
Division 2 heading	ad No 140, 2000
s 52	rs No 140, 2000
	am No 35, 2012
Chapter 4	
s 53	rs No 35, 2012
s 54	am No 140, 2000
s 55	am No 140, 2000; No 35, 2012
s 56	am No 66, 1991
s 56A	ad No 35, 2012
s 57	am No 140, 2000; No 35, 2012; No 31, 2014
Chapter 5	
Chapter 5 heading	rs No 140, 2000
s 59	am No 140, 2000; No 120, 2004
s 60	am No 35, 2012
Chapter 6	
Part 1	
s 61	am No 160, 2001; No 35, 2012
s 62	rs No 140, 2000
	am No 35, 2012
s 64	am No 140, 2000
s 66	am No 140, 2000

Endnote 4—Amendment history

Provision affected	How affected
	rep No 35, 2012
Part 2	
s 67	am No 154, 1994
s 68	rs No 140, 2000
Part 3	
Part 3 heading	rs No 140, 2000
Division 1 heading	rep No 154, 1994
	ad No 100, 1998
	rep No 140, 2000
Division 1	rep No 140, 2000
s 69	rep No 140, 2000
Division 2 heading	rep No 140, 2000
Division 2	rep No 154, 1994
	ad No 100, 1998
s 70	rep No 154, 1994
	ad No 100, 1998
	am No 100, 2005: No 5, 2011; No 8, 2015
s 71	rep No 154, 1994
	ad No 100, 1998
	am No 8, 2015
s 72	rep No 154, 1994
	ad No 100, 1998
s 73	rep No 154, 1994
	ad No 100, 1998
s 74	rep No 154, 1994
	ad No 100, 1998
	am No 35, 2012
s 75	rep No 154, 1994
	ad No 100, 1998
s 76	rep No 154, 1994
	ad No 100, 1998

Provision affected	How affected
s 76A	ad No 100, 1998
s 77	rep No 154, 1994
	ad No 100, 1998
s 78	rep No 154, 1994
	ad No 100, 1998
	am No 106, 2006
s 79	rep No 154, 1994
	ad No 100, 1998
s 79A	ad No 100, 1998
	am No 100, 2005
Chapter 6A	
Chapter 6A	ad No 140, 2000
s 79B	ad No 140, 2000
	rs No 35, 2012
s 79C	ad No 140, 2000
	am No 106, 2006; No 35, 2012
Chapter 7	
s 80	rs No 140, 2000
s 81	am No 35, 2012
s 83	am No 154, 1994
	rs No 100, 1998
	am No 100, 2005
s 84	rep No 154, 1994
Chapter 8	rep No 35, 2012
s 88	am No 140, 2000
	rep No 35, 2012
s 89	am No 140, 2000
	rep No 35, 2012
s 90	rep No 35, 2012
s 91	rep No 35, 2012
s 92	rep No 35, 2012

ComLaw Authoritative Act C2015C00060

Endnote 4—Amendment history

Provision affected	How affected
s 93	rep No 35, 2012
s 94	rep No 35, 2012
s 95	rep No 35, 2012
s 96	rep No 35, 2012
Chapter 9	
Chapter 9 heading	rs No 140, 2000
s 96A	ad No 140, 2000
s 97	am No 66, 1991; No 160, 2001; No 35, 2012
s 98	am No 140, 2000; No 160, 2001
	rs No 35, 2012
s 99	am No 140, 2000
s 100	am No 66, 1991
s 100A	ad No 160, 2001
	am No 35, 2012
s 101	am No 66, 1991; No 160, 2001; No 35, 2012
Chapter 9A	
Chapter 9A	ad No 140, 2000
Part 1	
s 101A	ad No 140, 2000
s 101B	ad No 140, 2000
	am No 160, 2001
	rs No 35, 2012
s 101C	ad No 140, 2000
s 101D	ad No 140, 2000
	rs No 160, 2001; No 48, 2003
	rep No 35, 2012
s 101E	ad No 140, 2000
	am No 160, 2001; No 8, 2015
	rs No 35, 2012
s 101EA	ad No 35, 2012
s 101F	ad No 140, 2000

Provision affected	How affected
	am No 35, 2012
Part 2	
s 101G	ad No 140, 2000
	am No 160, 2001; No 35, 2012
s 101H	ad No 140, 2000
s 101J	ad No 140, 2000
	am No 35, 2012
s 101K	ad No 140, 2000
s 101L	ad No 140, 2000
Part 3	
s 101M	ad No 140, 2000
	rs No 35, 2012
s 101N	ad No 140, 2000
	am No 35, 2012
s 101P	ad No 140, 2000
Chapter 10	
Part 1	
s 102	am No 140, 2000; No 160, 2001; No 35, 2012
s 103	am No 35, 2012
Part 2	
s 104	am No 120, 2004
s 105	am No 35, 2012
s 106	am No 140, 2000; No 35, 2012
s 107	am No 140, 2000; No 35, 2012
s 108	rep No 140, 2000
s 109	am No 140, 2000
Part 3	
s 111	rep No 140, 2000
s 112A	ad No 35, 2012
s 114	am No 140, 2000
	rs No 35, 2012

Endnote 4—Amendment history

Provision affected	How affected
s 114A	ad No 140, 2000
	am No 35, 2012
Chapter 11	
Part 1	
s 119	am No 160, 2001
	rs No 106, 2006
	am No 8, 2015
s 119A	ad No 106, 2006
s 119B	ad No 35, 2012
s 119C	ad No 35, 2012
s 120	am No 140, 2000
s 121A	ad No 154, 1994
s 122	am No 106, 2006
Part 2	
s 125	rs No 35, 2012
s 126	am No 140, 2000
	rs No 35, 2012
s 127	rs No 35, 2012
Part 3	
s 129	rs No 140, 2000
s 129A	ad No 140, 2000
s 130	am No 140, 2000
s 132	am No 35, 2012
Chapter 12	
Part 1	
Part 1	ad No 8, 2015
s 132A	ad No 8, 2015
Part 2	
Part 2 heading	ad No 8, 2015
s 132B	ad No 8, 2015

ComLaw Authoritative Act C2015C00060

Provision affected	How affected
s 133	am No 154, 1994; No 140, 2000; No 106, 2006; No 103, 2010; No 8, 2015
s 134	am No 140, 2000; No 106, 2006; No 103, 2010; No 8, 2015
s 135	am No 35, 2012
s 136A	ad No 106, 2006
Part 3	
Part 3	ad No 8, 2015
Division 1	
Division 1	ad No 8, 2015
s 136B	ad No 8, 2015
s 136C	ad No 8, 2015
Division 2	
Division 2	ad No 8, 2015
s 136D	ad No 8, 2015
s 136E	ad No 8, 2015
s 136F	ad No 8, 2015
s 136G	ad No 8, 2015
s 136H	ad No 8, 2015
Division 3	
Division 3	ad No 8, 2015
s 136J	ad No 8, 2015
Division 4	
Division 4	ad No 8, 2015
s 136K	ad No 8, 2015
s 136L	ad No 8, 2015
s 136M	ad No 8, 2015
Part 4	
Part 4 heading	ad No 8, 2015
s 136N	ad No 8, 2015
s 137	am No 8, 2015
s 138	am No 140, 2000; No 120, 2004; No 35, 2012

ComLaw Authoritative Act C2015C00060

Endnote 4—Amendment history

Provision affected	How affected
Part 5	
Part 5 heading	ad No 8, 2015
s 138A	ad No 8, 2015
s 139	am No 8, 2015
Chapter 13	
s 141	rs No 140, 2000
	am No 35, 2012
s 142	am No 140, 2000; No 160, 2001; No 35, 2012
s 143A	ad No 140, 2000
	am No 160, 2001; No 35, 2012
s 143B	ad No 160, 2001
Chapter 14	
s 144	am No 140, 2000
Chapter 15	
s 150	am No 35, 2012
s 151	am No 140, 2000; No 35, 2012
s 153	am No 140, 2000
Chapter 17	
Part 2	
s 163	am No 154, 1994
s 165	am No 154, 1994
s 165A	ad No 154, 1994
s 169	am No 140, 2000
Part 4	
s 174	am No 140, 2000
s 176	am No 140, 2000
Chapter 18	
s 177	am No 35, 2012
s 178	am No 140, 2000; No 35, 2012; No 8, 2015
s 179	am No 140, 2001
	rep No 35, 2012

ComLaw Authoritative Act C2015C00060

Provision affected	How affected
s 180	am No 140, 2001
	rep No 35, 2012
s 181	am No 140, 2001
	rep No 35, 2012
s 182	am No 35, 2012
s 183	am No 35, 2012; No 8, 2015
s 185	rs No 100, 1998
Chapter 19	
s 186	am No 140, 2000
s 187	rs No 140, 2000
s 189	am No 131, 2009
s 191	am No 140, 2001
s 191A	ad No 35, 2012; No 8, 2015
s 195	am No 131, 2009
s 196	am No 131, 2009
s 197AA	ad No 35, 2012
Chapter 20	
Part 1	
s 198	rs No 100, 1998
	am No 35, 2012; No 8, 2015
s 199	am No 8, 2015
s 200	am No 100, 1998; No 35, 2012
s 200A	ad No 100, 1998
	rs No 146, 1999
	am No 5, 2011
Part 2	
s 201	am No 100, 1998; No 55, 2001
	rs No 35, 2012
s 201A	ad No 35, 2012
s 201B	ad No 35, 2012
s 202	am No 35, 2012

Endnote 4—Amendment history

Provision affected	How affected
s 202A	ad No 100, 1998
s 202B	ad No 35, 2012
s 203	rs No 35, 2012
s 204	am No 100, 1998; No 140, 2000
Chapter 21	
s 205	am No 35, 2012
s 207	am No 58, 1994
s 208	am No 58, 1994
s 209	am No 58, 1994; No 8, 2015
s 210	am No 35, 2012
s 210A	ad No 35, 2012
Chapter 22	
s 213	am No 100, 1998
s 214	rs No 35, 2012
	am No 8, 2015
s 215	am No 35, 2012
s 220	am No 100, 1998
s 221	am No 8, 2015
s 222A	ad No 106, 2006
	am No 35, 2012
s 223	am No 66, 1991; No 154, 1994; No 140, 2000; No 160, 2001; No 48, 2003; No 35, 2012; No 8, 2015
s 224	am No 100, 1998; No 140, 2000; No 35, 2012; No 8, 2015
s 225	am No 140, 2001; No 4, 2010
s 226	rs No 35, 2012
s 227	am No 100, 1998; No 140, 2000; No 35, 2012; No 8, 2015
s 227AA	ad No 8, 2015
s 227AB	ad No 8, 2015
s 227A	ad No 100, 1998
	am No 8, 2015
s 228	am No 140, 2000; No 35, 2012; No 8, 2015

ComLaw Authoritative Act C2015C00060

Provision affected	How affected
s 229	rep No 103, 2013
s 230	rep No 103, 2013
Chapter 23	
s 232	rep No 154, 1994
s 233	am No 66, 1991
Schedule 1	
Schedule 1	am No 66, 1991; No 58, 1994; No 108, 1994; No 154, 1994; No 100, 1998; No 146, 1999; No 140, 2000; No 160, 2001; No 48, 2003; No 106, 2006; No 131, 2009; No 96, 2010; No 46, 2011; No 35, 2012; No 8, 2015
Schedule 2	rep No 103, 2013

ComLaw Authoritative Act C2015C00060