



Patents Act 1990

No. 83 of 1990

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Patents Act 1990

No. 83 of 1990

An Act relating to patents of inventions

[Assented to 30 October 1990]

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

CHAPTER 1—INTRODUCTORY

Short title

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

Commencement

2. (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.

Definitions

3. 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:

application	foreign vessel	permit
approved form	infringement	petty patent
associated technology	proceedings	pharmaceutical
Australia	interested party	substance
Australian continental shelf	international application	prescribed court
authority	international depositary	prescribed depositary institution
basic application	authority	prior art base
Budapest Treaty	international filing	prior art information
claim	date	prohibition order
commencing day	invention	provisional specification
Commissioner	legal practitioner	receiving Office
compensable person	legal representative	re-examination
complete specification	licence	Register
compulsory licence	main invention	registered
Continental Shelf Convention	marketing approval	relevant authority
Convention applicant	marketing approval certificate	relevant international application
Convention application	modified examination	relevant proceedings
Convention country	nominated person	rules relating to micro-organisms
deposit requirements	non-infringement declaration	Safeguards Act
depositary institution	<i>Official Journal</i>	sealed
Deputy Commissioner	patent	specification
Director	patent application	standard patent
divisional application	patent area	State
eligible person	patent of addition	Statute of Monopolies
employee	Patent Office	supply
examination	patent request	Territory
exclusive licensee	patentable invention	therapeutic use
exploit	patented process	this Act
Federal Court	patented product	work
file	patentee	1952 Act
foreign aircraft	PCT	1989 Amending Act.
foreign land vehicle	PCT application	

What are typical steps in getting and maintaining a patent?

4. The following tables contain charts showing most of the typical steps involved in getting and maintaining a standard patent and petty patent. The charts are intended for use only as general introductory illustrations and are not intended to have any other effect. If there is any inconsistency between any matter contained in the charts and a provision of this Act or the regulations, the provision prevails.

TABLE 1—GETTING AND MAINTAINING A STANDARD PATENT

Fee payable.

A complete application must be associated with a provisional application within the prescribed period.

Provisionals which lapse at this stage are not published.

Applicant may be required to correct deficiencies. Application will lapse if applicant does not comply.

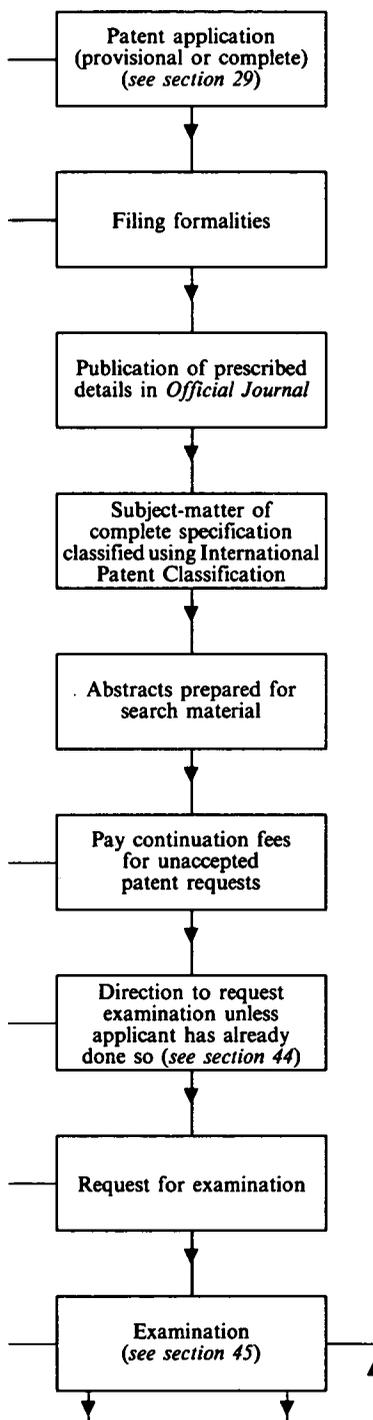
Continuation fees are prescribed and payable under the regulations.

Applications lapse if continuation fees are not paid (see section 142).

Applicant must request examination as directed or application will lapse (see section 142).

Fee payable.

Application lapses if patent request and complete specification not accepted within the prescribed period (see section 142).



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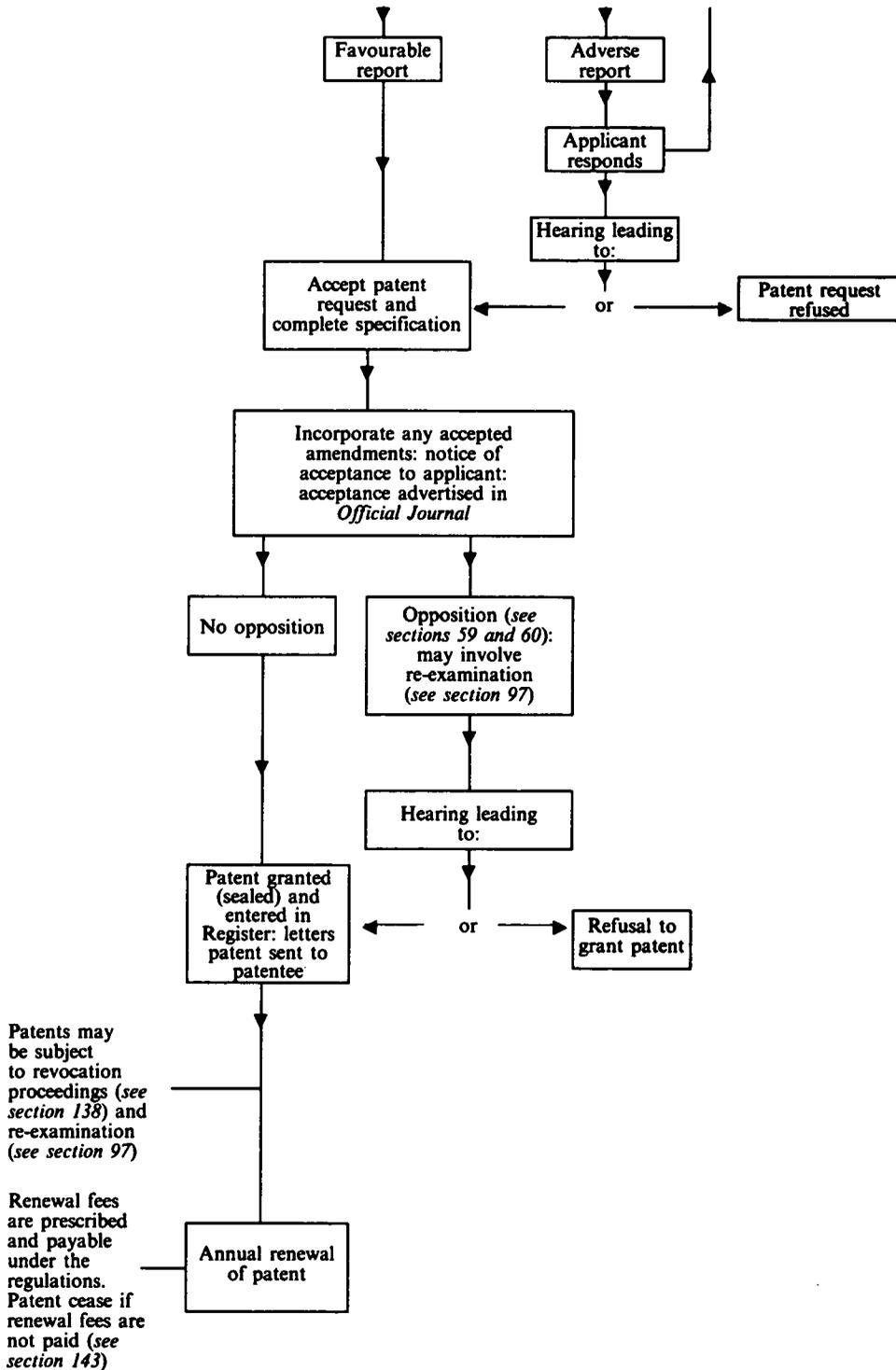


TABLE 2—GETTING AND MAINTAINING A PETTY PATENT

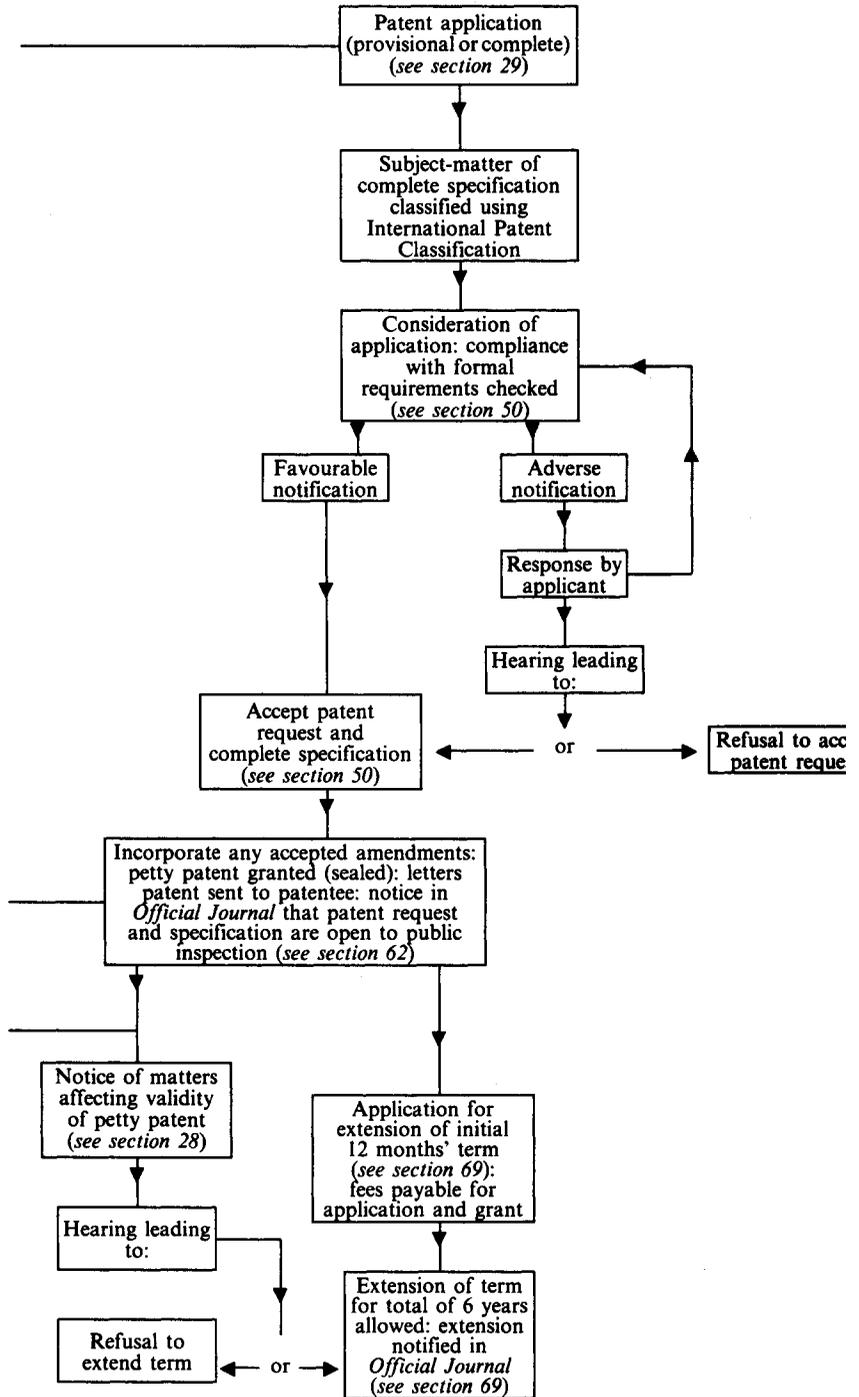
Fee payable.

A complete application must be associated with a provisional application within the prescribed period.

Provisionals which lapse at this stage are not published.

Initial term is 12 months (see section 68).

Petty patents may be subject to revocation (see section 138) and re-examination (see section 97).



Associated applications

5. 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]

Deposit requirements

6. 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 depository 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 depository institution from which samples of the micro-organism are obtainable as provided by the rules relating to micro-organisms; and
 - (ii) the date on which the relevant deposit was made; 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 depository institution as provided by those rules.

[Note: see sections 41 and 42]

Novelty and inventive step

7. (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 in the patent area 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.

(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 in the patent area before the priority date of the relevant claim, whether that knowledge is considered separately or together with either of the kinds of information mentioned in subsection (3), each of which must be considered separately.

(3) For the purposes of subsection (2), the kinds of information are:

- (a) prior art information made publicly available in a single document or through doing a single act; and
- (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 in the patent area would treat them as a single source of that information;

being information that the skilled person mentioned in subsection (2) could, before the priority date of the relevant claim, be reasonably expected to have ascertained, understood and regarded as relevant to work in the relevant art in the patent area.

[Notes: (1) For the meaning of “document” see section 25 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 subsection 98 (1).]

Disclosure in basic applications

8. Subject to the regulations, account must not be taken, for the purposes of this Act, of a disclosure in a specification or other document filed in respect of, and at the same time as, a basic application unless the following documents are filed within the prescribed period:

- (a) a copy of the specification or document;
- (b) if the specification or document is not in English—a translation of the specification or document into English.

[Note: “basic application” is defined in Schedule 1: see also Part 2 of Chapter 8.]

Secret use

9. 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.

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

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

10. (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 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: see also Chapter 8.*]

Act binds the Crown

11. (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.

Application of Act

12. This Act extends to:

- (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.

CHAPTER 2—PATENT RIGHTS, OWNERSHIP AND VALIDITY

PART 1—PATENT RIGHTS

Exclusive rights given by patent

13. (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.

Assignment of patent

14. (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.

PART 2—OWNERSHIP

Who may be granted a patent?

15. (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.

Co-ownership of patents

16. (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.

(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.

Directions to co-owners

17. (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.

PART 3—VALIDITY

Division 1—Validity

Patentable inventions

18. (1) Subject to subsection (2), a patentable invention is an invention that, 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.

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

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

Certificate of validity

19. (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.

Validity of patent not guaranteed

20. (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.

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

21. 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.

Division 2—Matters not affecting validity

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

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

Validity not affected by publication etc. after priority date

23. 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.

Validity not affected by certain publication or use

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

- (a) any information made publicly available, through any publication or use of the invention 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
- (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 patent 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, 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 of 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).

Validity: patents of addition .

25. 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.

Validity not affected in certain cases involving amendments

26. (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.

(2) Except in the case of an amendment made in contravention of section 112, 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.

Division 3—Notice of matters affecting validity

Notice of matters affecting validity of standard patents

27. (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.

Notice of matters affecting validity of petty patents

28. (1) A person may, within the prescribed period after the grant of a petty patent, notify the Commissioner, in accordance with the regulations, that the person asserts, for reasons stated in the notice, that the petty patent is invalid on one or more of the following grounds:

- (a) that the patentee was not entitled to be granted the petty patent;
- (b) that the invention is not a patentable invention because it does not comply with paragraph 18 (1) (a) or (b);
- (c) that the specification does not comply with subsection 40 (2) or (3).

(2) 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.

(3) If the Commissioner becomes aware, otherwise than by a notification under subsection (1), of any matter that may affect the validity of a petty patent on one or more of the grounds mentioned in that subsection, the Commissioner must inform the patentee in writing of the matter.

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

CHAPTER 3—FROM APPLICATION TO ACCEPTANCE

PART 1—PATENT APPLICATIONS

Division 1—Applications

Application for patent

29. (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.*]

Filing date

30. A patent application is to be taken to have been made on the filing date determined under the regulations.

Joint applicants

31. 2 or more persons (within the meaning of section 29) may make a joint patent application.

Disputes between applicants etc.

32. If a dispute arises between any 2 or more interested parties 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 parties, make any determinations the Commissioner thinks fit for enabling the application to proceed in the name of one or more of the parties alone, or for regulating the manner in which it is to proceed, or both, as the case requires.

Applications by opponents etc.

33. (1) Where:

- (a) the grant of a standard patent is opposed; and
- (b) the Commissioner decides, under section 60, that the opponent is an eligible person in relation to the invention, so far as claimed in any claim, but that there is no other reason that a patent should not be granted;

the Commissioner may, if a complete application is made by the opponent under section 29, grant the opponent a patent for the invention, so far as so claimed, and the claims of that patent have the same priority date as that of the first-mentioned claim.

(2) Where:

- (a) a person gives the Commissioner a notice under section 28 in relation to a petty patent; and
- (b) the Commissioner decides under section 69 to refuse to grant an extension of the term of a petty patent on the ground, or on grounds that include the ground, that the patentee was not entitled to be granted the petty patent; and
- (c) the Commissioner is satisfied that the person who gave the notice is an eligible person in relation to the invention, so far as claimed in any claim;

the Commissioner may, if a complete application is made by the person under section 29, grant the person a petty patent for the invention, so far as so claimed, and the claims of that petty patent have the same priority date as that of the first-mentioned claim.

Applications by eligible persons arising out of court proceedings

34. (1) Where, in any proceedings in a court relating to a patent, the court is satisfied that a person other than the patentee is an eligible person in relation to the invention, so far as claimed in any claim, the court may, in addition to any other order it may make in the proceedings, by order, declare the person to be an eligible person in relation to that invention, so far as so claimed.

(2) The Commissioner must, if a complete application is made under section 29 by a person so declared, grant the person a patent for

the invention, so far as claimed in any claim of the patent mentioned in subsection (1), and the claims of that patent have the same priority date as that of the first-mentioned claim.

Applications by eligible persons following revocation by Commissioner

35. (1) Where the Commissioner:

- (a) revokes a patent under section 137; and
- (b) is satisfied, on application made by a person other than the former patentee in accordance with the regulations, that the person is an eligible person in relation to the invention concerned, so far as claimed in any claim;

the Commissioner may declare in writing that the person is such an eligible person and, if a complete application is made by the person under section 29, grant the person a patent for the invention, so far as so claimed, and the claims of that patent have the same priority date as that of the first-mentioned claim.

(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.

Other applications by eligible persons

36. (1) Where:

- (a) a patent application has been made and, in the case of a complete application, the patent request and complete specification have not been accepted; and
- (b) the Commissioner is satisfied, on application made by a person in accordance with the regulations, that the nominated person is not an eligible person in relation to an invention disclosed in a specification filed in relation to the application but that some other person is an eligible person in relation to the invention as so disclosed;

the Commissioner may (whether or not the patent application lapses or is withdrawn) declare in writing that the other person is such an eligible person.

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

(3) If a complete application is made under section 29 by a person so declared, the priority date of the claims of a patent granted to the person for the invention must be determined under the regulations.

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

Complete application may be treated as provisional

37. (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.

Time for making complete application

38. (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.

(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.*]

Divisional applications

39. (1) Where a complete patent application is made (but has not lapsed or been refused or withdrawn), the applicant may, in accordance with the regulations, make a further complete application for a standard patent or a petty patent for an invention:

(a) disclosed in the specification filed in respect of the first-mentioned application; and

(b) where the first-mentioned application is for a standard patent and at least 3 months have elapsed since the publication of a notice of acceptance of the relevant patent request and specification in the *Official Journal*—falling within the scope of the claims of the accepted specification.

(2) A patentee of a petty patent may, in accordance with the regulations, make a further complete application for a petty patent or a standard patent in respect of an invention disclosed in the complete specification filed in respect of the application on which the first-mentioned petty patent was sealed.

(3) In this section:

“**applicant**” has the same meaning as in section 38.

Division 2—Specifications

Specifications

40. (1) A provisional specification must describe the invention.

(2) A complete specification must:

- (a)** describe the invention fully, including 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 a petty patent—end with a single claim, or a single independent claim and not more than 2 dependent claims, defining the invention.

(3) The claim or claims must be clear and succinct and fairly based on the matter described in the specification.

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

Specifications: micro-organisms

41. (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:

- (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.]

Micro-organisms ceasing to be reasonably available

42. (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.

(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.*]

Division 3—Priority dates

Priority dates

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

(2) The priority date of a claim is:

- (a) the date of filing of the specification; or
- (b) where the regulations provide for the determination of a different date as the priority date—the date determined under the regulations.

(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.

PART 2—EXAMINATION OF PATENT REQUESTS AND SPECIFICATIONS

Division 1—Examination

Request for examination

44. (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.

Examination

45. (1) Where an applicant asks for an examination of a patent request and complete specification, the Commissioner must examine the request and specification and report on:

- (a) whether the specification complies with section 40; 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) and (b); and
- (c) such other matters (if any) as are prescribed.

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

(3) The Commissioner may, from time to time, by notice in writing, direct the applicant to inform the Commissioner of the results of the searches specified in the notice, being searches carried out in a foreign country by a specified patent office or organisation in respect of a corresponding application filed outside Australia.

Request for deferment of examination

46. (1) Where:

- (a) a complete application for a standard patent has been made; and
- (b) a prescribed application for a patent has been made in a prescribed foreign country; and
- (c) a patent has not been granted in respect of the prescribed application; and
- (d) the applicant has been directed by the Commissioner to ask for an examination of the patent request and specification relating to the application mentioned in paragraph (a), being a direction given on a ground prescribed for the purposes of this paragraph;

the applicant may, instead of asking for an examination as directed, ask for deferment of the examination.

(2) A request for deferment must be made in accordance with the regulations.

(3) Where a request for deferment is made:

- (a) the examination of the patent request and specification must be deferred accordingly; and
- (b) the application does not lapse merely because of failure by the applicant to ask for an examination in accordance with the Commissioner's direction.

Division 2—Modified examination

Request for modified examination

47. (1) Where:

- (a) a complete application for a standard patent has been made; and
- (b) a patent has been granted in a prescribed foreign country in respect of a prescribed application made in that country;

the applicant may, instead of asking for an examination, ask for a modified examination of the patent request and specification relating to the application.

(2) The applicant may withdraw a request for a modified examination at any time before acceptance of the patent request and specification and ask for an examination under section 44 instead.

Modified examination

48. (1) Where an applicant asks for a modified examination of a patent request and complete specification, the Commissioner must examine the request and specification and report on:

- (a) whether, to the best of his or her knowledge, the invention, so far as claimed, satisfies the criteria mentioned in paragraphs 18 (1) (a) and (b); and
- (b) such other matters (if any) as are prescribed.

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

PART 3—ACCEPTANCE

Acceptance of patent request: standard patent

49. (1) Subject to section 51, if the Commissioner considers that there is no lawful ground of objection to a patent request and complete specification relating to an application for a standard patent, or that any such ground of objection has been removed, the Commissioner must accept the request and specification.

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

(3) The Commissioner must, if asked to do so by the applicant in writing, postpone acceptance of a patent request and complete specification until such day as the applicant specifies.

(4) The applicant cannot, for the purposes of subsection (3), specify a day that is after the end of the period prescribed for the purposes of paragraph 142 (2) (e).

(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) The notice mentioned in paragraph (5) (b) must:

- (a) if the patent request and complete specification have been subjected to a modified examination—include a statement to the effect that the acceptance has resulted from a modified examination; and
- (b) if the patent request and complete specification have not already become open to public inspection—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 the reasons for the refusal and publish a notice of the refusal in the *Official Journal*.

Consideration and acceptance of patent request: petty patent

50. (1) Where a complete application for a petty patent is made, the Commissioner must consider the patent request and the complete specification and, for that purpose, may make such investigations as the Commissioner thinks fit.

(2) If the Commissioner is satisfied that there is a lawful ground of objection to the patent request or complete specification, the Commissioner must, by notice in writing:

- (a) notify the applicant of the ground of objection; and
- (b) advise the applicant that unless he or she asks leave to amend the patent request or complete specification, or files a written statement contesting the objection, within the time specified by the Commissioner, the application will lapse.

(3) Subject to section 51, if the Commissioner considers that there is no lawful ground of objection to the patent request or complete specification, or that any such ground of objection has been removed, the Commissioner must accept the request and specification.

(4) If subsection (3) does not apply, the Commissioner may, after giving the applicant a reasonable opportunity to be heard, refuse to accept the request and specification.

(5) Where the Commissioner refuses to accept a patent request and complete specification relating to an application for a petty patent, the Commissioner must notify the applicant of the reasons for the refusal and publish a notice of the refusal in the *Official Journal*.

Application or grant may be refused in certain cases

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

- (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 which 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 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.

Appeal

52. An appeal lies to the Federal Court against a decision of the Commissioner under this Part.

CHAPTER 4—PUBLICATION

Publication of certain information about applicants etc.

53. Where a patent application is made, the Commissioner must publish in the *Official Journal* the prescribed information about the applicant and the application.

Notice of publication

54. (1) Where a complete specification filed in respect of an application for a 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:

- (a) a divisional application (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 (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 (other than a PCT application) is made in respect of an original application that is a PCT application; and
- (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.

Documents open to public inspection

55. (1) Where a notice is published under section 54, 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 a petty 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 90, 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.

Certain documents not to be published

56. (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 prescribed for the purposes of subsection (1) must be given to the Commissioner, who is entitled to be heard on the application.

Effect of publication of complete specification

57. (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.

(2) If a complete specification in relation to an application for a petty patent becomes open to public inspection before a patent is granted on the application, the applicant has the same rights as he or she would have had if a petty patent for the invention had been granted on the day when the specification became open to public inspection.

(3) Neither subsection (1) nor (2) gives the applicant a right to start proceedings in respect of the doing of an act unless:

- (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) or (2) in respect of an act done after the complete specification became open to public inspection but before:

- (a) in the case of a standard patent—the patent request was accepted; or
- (b) in the case of a petty patent—the petty patent was granted on the application;

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

Result of search may be disclosed

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

CHAPTER 5—OPPOSITION

Opposition to grant of standard patent

59. 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 not entitled to a grant of a patent for the invention;
- (b) that the invention is not a patentable invention because it does not comply with paragraph 18 (1) (a) or (b);
- (c) that the specification filed in respect of the complete application does not comply with subsection 40 (2) or (3).

Hearing and decision by Commissioner

60. (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.

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

CHAPTER 6—GRANT AND TERM OF PATENTS

PART 1—GRANT

Grant of standard patent

61. (1) The Commissioner must grant a standard patent, by sealing a standard patent in the approved form, 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.

Grant and publication of petty patent

62. (1) Where the Commissioner accepts a patent request and complete specification filed in respect of an application for a petty patent, the Commissioner must grant a petty patent by sealing a petty patent in the approved form.

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

- (a) the petty patent has been granted; and
- (b) where the patent request and complete specification relating to the petty patent application are not already open to public inspection—the patent request and complete specification are open to public inspection.

Joint patentees

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

Grant: multiple applications

64. (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) a patent application 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 patent cannot be granted on the application.

Date of patent

65. The date of a patent is:

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

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

Sealing of duplicate of patent

66. The Commissioner may seal a duplicate of a patent if satisfied that the patent is lost, stolen, damaged or destroyed.

PART 2—TERM

Term of standard patent

67. The term of a standard patent is 16 years from the date of the patent.

Term of petty patent

68. The term of a petty patent is:

- (a) the period of 12 months beginning on the date of sealing of the patent; and
- (b) if an extension of the term of the patent is granted—an additional period beginning on the day immediately following the end of that 12 months' period and ending at the end of 6 years after the date of the patent.

PART 3—EXTENSION OF TERM

Division 1—Petty patents

Extension of term of petty patent

69. (1) A patentee of a petty patent may apply to the Commissioner, in accordance with the regulations, for an extension of the term of the petty patent.

(2) The Commissioner must decide an application in accordance with the regulations.

(3) The Commissioner must not grant an extension without giving each person who has given the Commissioner a notice under section 28 in relation to the petty patent a reasonable opportunity to be heard.

(4) The Commissioner must not refuse to grant an extension of the term of a petty patent that the Commissioner is satisfied is invalid unless the Commissioner has, where appropriate, given the applicant a reasonable opportunity to amend the relevant patent request or complete specification, or both, for the purpose of removing the grounds of the invalidity and the applicant has failed to do so.

(5) Where 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*.

(6) Where the Commissioner refuses to grant an extension, the Commissioner must:

- (a) give the applicant written notice of the refusal and of the reasons for it; and
- (b) publish a notice of the refusal in the *Official Journal*.

(7) An appeal lies to the Federal Court against a refusal by the Commissioner to grant an extension.

(8) A person who has given the Commissioner a notice under section 28 in relation to a petty patent may appeal to the Federal Court against a decision of the Commissioner to grant an extension of the term of the petty patent.

Division 2—Standard patents

Application for extension of term of patent relating to a pharmaceutical substance

70. (1) Where:

- (a) a pharmaceutical substance is in substance disclosed in the complete specification of a standard patent and in substance falls within the scope of the claim or claims of that complete specification; and
- (b) the patentee has requested the issue of a marketing approval certificate in respect of that substance;

the patentee may, by notice in writing in the approved form given to the Commissioner not later than 12 months before the end of the term of the patent, apply for an extension of the term of the patent in respect of that substance and any other pharmaceutical substance which is in substance disclosed in the specification and in substance falls within the scope of the claim or claims of the specification.

(2) Where a patentee applies for an extension of the term of a patent, the patentee must send a copy of the application to the Secretary to the Department of Community Services and Health.

(3) Where a patentee applies for an extension of the term of a patent, the Commissioner must publish in the *Official Journal* a notice stating that the application has been made and is open to public inspection.

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

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

Application for extension to lapse in certain circumstances

71. An application for an extension of the term of a patent lapses if the applicant does not, within the prescribed period, give the Commissioner:

- (a) a marketing approval certificate in respect of the pharmaceutical substance to which the application relates; and
- (b) a proposed claim or claims.

Issue of marketing approval certificate

72. Where:

- (a) a patentee asks the Secretary to the Department of Community Services and Health, in writing, for the issue of a marketing approval certificate in respect of a pharmaceutical substance; and
- (b) the Secretary to the Department of Community Services and Health has approved the marketing of that substance, or a product containing that substance, in Australia;

the Secretary must immediately give a marketing approval certificate in the approved form to the patentee in respect of that substance.

Advertisement of application for extension

73. Where:

- (a) a patentee applies for an extension of the term of a patent; and
- (b) the patentee gives the Commissioner the documents referred to in section 71;

the Commissioner must publish in the *Official Journal* a notice to the effect that the Commissioner proposes to consider the application.

Opposition to extension

74. The Minister, the Secretary to the Department of Community Services and Health or a person interested may, within the prescribed period and in accordance with the regulations, oppose the grant of an extension of the term of a patent on either one or both of the following grounds, but on no other ground:

- (a) that the application for the extension, the marketing approval certificate, or the proposed claim or claims, is or are not in accordance with this Act;
- (b) that the proposed claim or claims claim matter other than the pharmaceutical substance or substances to which the application relates.

Determination of application for extension

75. (1) The Commissioner may determine an application for an extension of the term of a patent even though the term of the patent has expired.

(2) Where the time for opposing the grant of an extension of the term of a patent has expired, the Commissioner must, if satisfied that:

- (a) the application for the extension, the marketing approval certificate and the proposed claim or claims are in accordance with this Act; and
- (b) the proposed claim or claims do not claim matter other than the pharmaceutical substance or substances to which the application relates;

grant an extension of the term of the patent for a period of 4 years in relation to the proposed claim or claims, but if not so satisfied, the Commissioner must, subject to subsection (3), refuse to grant an extension of the term of the patent.

(3) The patentee may, within such period as the Commissioner allows, amend the proposed claim or claims.

(4) If, after amendments are made under subsection (3), the Commissioner is satisfied as to the matters referred to in subsection (2), the Commissioner must grant an extension of the term of the patent for a period of 4 years in relation to the proposed claim or claims, but if the Commissioner is not so satisfied the Commissioner must refuse to grant an extension of the term of the patent.

(5) Where the Commissioner grants, or refuses to grant, an extension of the term of a patent, the Commissioner must publish in the *Official Journal* a notice setting out the terms of the decision.

(6) The Commissioner must not grant, or refuse to grant, an extension of the term of a patent unless the Commissioner has given the applicant, and any person who opposed the grant of the extension under section 74, a reasonable opportunity of being heard.

(7) Where relevant proceedings in relation to a patent are pending, the Commissioner must not determine an application for an extension of the term of the patent without the leave of the court.

Limitation on infringement proceedings

76. Where the term of a patent has been extended, proceedings for infringement of the patent cannot be instituted in respect of an act done more than 2 years after the day on which the term of the patent expired unless the act constitutes sale, offering for sale, or distribution for a purpose other than obtaining marketing approval, of the pharmaceutical substance or substances concerned.

Rights of patentee

77. Where:

- (a) a patentee applies for an extension of the term of a patent; and
- (b) before the application is determined, the term of the patent expires; and

(c) the extension is granted;
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 commencing on the expiration of the term of the patent and ending on the day on which the extension is granted as if the extension had been granted at the time when the act was done.

Appeals

78. An applicant for an extension of the term of a patent, or a person who has opposed or proposes to oppose the extension, may appeal to the Federal Court:

- (a) against a decision of the Secretary to the Department of Community Services and Health under section 72 to give or not to give a marketing approval certificate; or
- (b) against a decision of the Commissioner under subsection 75 (2) or (4) granting or refusing to grant an extension of the term of the patent.

Delegation

79. The Secretary to the Department of Community Services and Health may, by signed instrument, delegate to an officer of that Department all or any of the powers and functions of the Secretary under this Division.

CHAPTER 7—PATENTS OF ADDITION

Chapter does not apply to petty patents

80. This Chapter does not apply in relation to petty patents.

Grant of patent of addition

81. (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 sealed before the patent for the main invention is sealed.

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

Revocation of patent and grant of patent of addition instead

82. (1) Where:

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

Term of patent of addition

83. (1) A patent of addition remains in force for so long as the patent for the main invention remains in force.

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

(3) The extended term of a patent of addition begins at the end of the term of the patent for the main invention.

Non-extension of term of patent for main invention

84. If the term of a patent of addition is extended under Chapter 6 and the patent for the main invention is not extended, the patent of addition becomes an independent patent.

Revocation of patent for main invention

85. (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.

Renewal fees not payable

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

Fees payable where patent of addition becomes an independent patent

87. 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.

CHAPTER 8—PCT APPLICATIONS AND CONVENTION APPLICATIONS

PART 1—PCT APPLICATIONS

PCT applications

88. (1) Subject to this section, a PCT application must, for the purposes of this Act other than this Part, be treated as a complete application under this Act for a standard patent.

(2) Where:

- (a)** a PCT application contains an indication under Article 43 of the PCT that the application is, as far as Australia is concerned, for the grant of a petty patent; or
- (b)** before making a request for examination under section 44 or 48, the applicant files a written request signed by the applicant that the PCT application be treated as an application for a petty patent;

the application must be treated, for the purposes of this Act other than this Part, as a complete application under this Act for a petty patent.

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

(4) The filing date of a PCT application is to be taken to be its international filing date.

(5) For the purposes of this Act, an indication, in relation to a deposited micro-organism furnished under Rule 13 *bis.* 4, in relation to a PCT application, is to be taken to be included in the description contained in the PCT application even if the indication is contained in another document.

(6) The reference in subsection (5) to Rule 13 *bis.* 4 is a reference to Rule 13 *bis.* 4 of the Regulations mentioned in the definition of “PCT” in Schedule 1.

[Note: “international filing date” is defined in Schedule 1: see also section 10.]

Modified application of Act

89. (1) A PCT application is to be taken to comply with the prescribed requirements of this Act and the regulations that relate to patent applications but is not to be taken, merely because of section 88, to comply with any other such requirements that apply to it.

(2) The description, drawings and claims contained in a PCT application are not to be taken, merely because of section 88, to comply with the requirements of section 40.

(3) An applicant is not entitled to ask that any action be taken, or that he or she be allowed to take any action, under this Act in relation to a PCT application unless:

- (a)** if the application was not filed in the receiving Office in English—a translation of the application into English, verified in accordance with the regulations, has been filed; and
- (b)** in any case—the prescribed documents have been filed and the prescribed fees paid.

(4) If a translation of a PCT application has been filed, being a translation of the kind mentioned in paragraph (3) (a), the description and claims, and any matter associated with the drawings, contained in the application are to be taken to have been amended, on the day on which the translation was filed, by substituting the translation of the description, claims and matter for the original.

(5) Where:

- (a)** a PCT application has been amended under Article 19 of the PCT; or
- (b)** a PCT application in respect of which Australia has been elected under Chapter II of the PCT within the period specified in Article 39 of the PCT has been amended under Article 34 of the PCT; or
- (c)** a PCT application has been rectified under Rule 91 of the Regulations mentioned in the definition of “PCT” in Schedule 1;

the description, drawings and claims contained in the application are, for the purposes of this Act, to be taken to have been amended on the day on which that amendment or rectification was made.

Publication of PCT applications

90. A PCT application is to be taken to have become open to public inspection, and to have been published in Australia:

- (a)** where a notice in relation to the application is published under subsection 92 (1) or (2)—on the day on which the notice is so published; or

- (b) where a notice in relation to the application is published under subsection 92 (3)—on the day on which a copy of the application, as so published, is received in the Patent Office.

Application of certain provisions to PCT applications

91. For the purposes of applying section 57 to a PCT application, references to the complete specification becoming open to public inspection are references to the PCT application being taken to have become open to public inspection under section 90.

Notice of publication

92. (1) Where, in relation to a PCT application that has not lapsed, or been withdrawn or refused:

- (a) the applicant complies with subsection 89 (3); and
- (b) the applicant asks the Commissioner in writing to publish a notice in the *Official Journal* that the application is open to public inspection; and
- (c) the application is not already open to public inspection;

the Commissioner must publish a notice in the *Official Journal* stating that a copy of the application is open to public inspection.

(2) Where:

- (a) a PCT application that has not lapsed, or been withdrawn or refused, is to be treated as an application for a standard patent under this Act; and
- (b) the applicant complies with subsection 89 (3); and
- (c) the period of 18 months after the priority date of the application has ended; and
- (d) the application is not already open to public inspection;

the Commissioner must publish a notice in the *Official Journal* stating that a copy of the application is open to public inspection.

(3) Where:

- (a) a copy of a PCT application, as published under Article 21 of the PCT, is received in the Patent Office; and
- (b) the application has not lapsed, or been withdrawn or refused; and
- (c) a notice has not been published under subsection (1) or (2);

the Commissioner must publish a notice in the *Official Journal* specifying the date on which the copy was so received and stating that the copy is open to public inspection.

(4) Where a notice is published in the *Official Journal* under this section, a copy of the relevant application and of any other prescribed document is open to public inspection.

Evidence of matters arising under PCT

93. 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.

PART 2—CONVENTION APPLICATIONS

Convention applicants may make Convention applications

94. (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, within the prescribed period.

(2) Where 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.

Manner of making Convention application

95. (1) Subject to this section, a Convention application must be made and dealt with in the same way as any other patent application.

- (2) A patent request relating to a Convention application must:
- (a) include the prescribed particulars relating to the relevant basic application; and
 - (b) be accompanied by a complete specification.

(3) In addition to the complete specification, the prescribed documents must be filed within the prescribed period.

Withdrawn, abandoned or refused applications

96. (1) Where, at the time when a Convention application is made in respect of an invention:

- (a) an application has been made for protection in respect of the invention in a Convention country; and
- (b) the application has been withdrawn, abandoned or refused without becoming open to public inspection; and
- (c) the application has not been used as the basis of claiming a right of priority in a Convention country under a law of that country corresponding to this Part; and
- (d) a later application has been made by the same applicant for protection in respect of the invention in the Convention country in which the earlier application was made;

the applicant may ask the Commissioner to disregard the earlier application for the purposes of this Part.

- (2) Where an applicant makes a request under subsection (1):
 - (a) the earlier application must be disregarded; and
 - (b) neither the applicant nor any other applicant may use the earlier application as a basic application for the purposes of this Part.

CHAPTER 9—RE-EXAMINATION

Re-examination of complete specifications

97. (1) Subject to this section and the regulations, where the grant of a patent is opposed, 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.

(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 (1).

(5) Where:

- (a) the Commissioner has started to re-examine a complete specification relating to a patent under subsection (1) or (2); and
 - (b) relevant proceedings in relation to the patent are started;
- the Commissioner must not continue the re-examination.

Report on re-examination

98. (1) On re-examining a complete specification, the Commissioner must ascertain and report whether, to the best of his or her knowledge, the invention, so far as claimed in any claim and when compared with the prior art base as it existed immediately before the priority date of that claim:

- (a) is not novel; and
- (b) does not involve an inventive step.

(2) For the purposes of subsection (1), the prior art base is to be taken not to include information made publicly available through the doing of an act anywhere in the patent area.

[*Note: see also section 7.*]

Statement by applicant or patentee

99. (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.

Copies of report to be given to court

100. 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 (2), be given to the court that gave the direction.

Revocation of patent following re-examination

101. (1) Where the Commissioner makes an adverse report on a re-examination under subsection 97 (1), the Commissioner may, by notice in writing, revoke the patent, either wholly or so far as it relates to a particular claim, as the case requires.

(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.

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

CHAPTER 10—AMENDMENTS

PART 1—AMENDMENTS THAT ARE NOT ALLOWABLE

What amendments are not allowable?

102. (1) An amendment of a complete specification is not allowable if, as a result of the amendment, the specification would claim matter not in substance disclosed in the specification as filed.

(2) An amendment of a complete specification is not allowable after the specification has been accepted 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).

(3) This section does not apply to an amendment for the purpose of correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification.

Consent of mortgagee or exclusive licensee needed

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

PART 2—AMENDMENTS OF PATENT REQUESTS, SPECIFICATIONS AND OTHER FILED DOCUMENTS

Amendments by applicants and patentees

104. (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.

(3) Subject to the regulations, the Commissioner may allow an amendment subject to conditions.

(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.

Amendments directed by court

105. (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, the patent request or the complete specification in the manner specified in the order.

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

(3) The patentee 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 patentee must file a copy of an order within the prescribed period.

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

Amendments directed by Commissioner: patents

106. (1) Where:

- (a) a patent has been granted; and
- (b) the Commissioner is satisfied, on re-examination of the relevant complete specification, that the patent is invalid on grounds that could be removed by appropriate amendments of the specification;

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 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.

Amendments directed by Commissioner: patent applications

107. (1) Where:

- (a) a complete patent application has been made; and
- (b) the Commissioner is satisfied 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
- (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 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.

Amendments directed by Commissioner: extensions of term of petty patents

108. (1) Where:

- (a) a patentee of a petty patent has applied for an extension of the term of the petty patent; and
- (b) the Commissioner is satisfied that the petty patent is invalid on grounds that could be removed by appropriate amendments of the relevant patent request or complete specification;

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 request or 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 that the amendments set out in a statement (or an amended statement) are allowable and would, if made, remove the grounds on which the petty 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.

Appeal

109. An appeal lies to the Federal Court against a direction of the Commissioner under section 106, 107 or 108.

PART 3—MISCELLANEOUS

Advertisement of amendment of complete specification

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

Amendments relating to micro-organisms

111. None of the other provisions of this Part apply to an amendment of a complete specification relating to a micro-organism, being an amendment to which regulations made under paragraph 228 (2) (d) apply.

Pending proceedings

112. 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.

Persons claiming under assignment or agreement

113. (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.

(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.

Priority date of certain amended claims

114. (1) Where a claim of a complete specification claims matter that was in substance disclosed as a result of amending the specification, the priority date of the claim must be determined under the regulations.

(2) Objection cannot be taken to a patent request or complete specification, and a patent is not invalid, on the ground that the invention, so far as claimed in a claim mentioned in subsection (1), does not involve an inventive step having regard to any publication or use of the invention after its disclosure in the complete specification as filed.

Restriction on recovery of damages etc.

115. (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).

Interpretation of amended specifications

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

CHAPTER 11—INFRINGEMENT

PART 1—INFRINGEMENT AND INFRINGEMENT PROCEEDINGS

Infringement by supply of products

117. (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.

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

118. 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
- (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.

Infringement exemptions: prior use

119. (1) Where, immediately before the priority date of a claim, a person:

- (a) was making a product or using a process claimed in that claim; or
- (b) had taken definite steps (whether by way of contract or otherwise) to make that product or use that process;

the person may, despite the grant of a patent for the product or process so claimed, make the product, or use the process, (or continue to do so) in the patent area, without infringing the patent.

(2) Subsection (1) does not apply if the person:

- (a) derived the subject-matter of the invention concerned from the patentee or the patentee's predecessor in title in the invention; or
- (b) before the relevant priority date, had stopped making the product or using the process (other than temporarily), or had abandoned (other than temporarily) the steps mentioned in paragraph (1) (b).

Infringement proceedings

120. (1) 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.

(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.

Counter-claim for revocation of patent

121. (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.

Relief for infringement of patent

122. (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.

(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.

Innocent infringement

123. (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.

PART 2—NON-INFRINGEMENT DECLARATIONS

Interpretation

124. In this Part:
“patentee” includes an exclusive licensee.

Application for non-infringement declaration

125. (1) A person who wishes to exploit an invention may apply to a prescribed court for a declaration that the exploitation of the invention would not infringe a claim of a particular complete specification.

(2) An application may be made:

- (a)** at any time after the complete specification has become open to public inspection; and
- (b)** whether or not the nominated person or patentee has made any assertion to the effect that the exploitation of the invention would infringe the claim.

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

Proceedings for non-infringement declarations

126. (1) A prescribed court must not make a non-infringement declaration unless a patent has been granted in respect of the relevant invention and:

(a) the applicant for the declaration:

- (i)** has asked the nominated person or patentee in writing for a written admission that the proposed exploitation would not infringe a claim of the complete specification; and
- (ii)** has given the nominated person or patentee full written particulars of the proposed exploitation; and
- (iii)** has undertaken to pay a reasonable sum for the nominated person's or patentee's expenses in obtaining advice about whether the proposed exploitation would infringe the claim; and

(b) the nominated person or patentee has refused or failed to make the admission.

(2) The validity of a claim cannot be questioned in proceedings for a non-infringement declaration.

(3) The costs of all parties in proceedings for a non-infringement declaration must be paid by the applicant for the declaration unless the court otherwise orders.

Effect of non-infringement declarations

127. If:

- (a)** a nominated person or patentee has given a person a written admission that the exploitation of an invention 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 exploiting the invention 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 exploitation of the invention 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 that exploitation.

PART 3—UNJUSTIFIED THREATS OF INFRINGEMENT PROCEEDINGS

Application for relief from unjustified threats

128. (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.

Court's power to grant relief

129. The court may grant an applicant under section 128 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 a patent had been granted.

Counter-claim for infringement

130. (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.

(4) The provisions of this Act relating to proceedings for the revocation of a patent apply, with the necessary changes, to an application under subsection (2).

Notification of patent not a threat

131. 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.

Liability of legal practitioner or patent attorney

132. A legal practitioner or a registered patent attorney is not liable to proceedings under section 128 in respect of an act done in his or her professional capacity on behalf of a client.

CHAPTER 12—COMPULSORY LICENCES AND REVOCATION OF PATENTS

Compulsory licences

133. (1) A person may apply to a prescribed 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.

(2) After hearing the application, the court may make the order if satisfied that:

- (a) the reasonable requirements of the public with respect to the patented invention have not been satisfied; and
- (b) the patentee has given no satisfactory reason for failing to exploit 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
- (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.

(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.

Revocation of standard patent after grant of compulsory licence

134. (1) Where a compulsory licence relating to a standard patent is granted, an interested person may apply to a prescribed 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) the reasonable requirements of the public with respect to the patented invention have not been satisfied; and
- (b) the patentee has given no satisfactory reason for failing to exploit the patent.

Reasonable requirements of the public

135. (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:
 - (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 sealed 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.

Orders to be consistent with international agreements

136. An order must not be made under section 133 or 134 that is inconsistent with a treaty between the Commonwealth and a foreign country.

Revocation on surrender of patent

137. (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.

Revocation of patents in other circumstances

138. (1) The Minister or any other person may apply to a prescribed court for an order revoking a patent.

(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;
- (b) that the invention is not a patentable invention;
- (c) that the patentee has contravened a condition in the patent;
- (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).

Parties to proceedings

139. (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.

Commissioner to be given copies of orders

140. 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.

CHAPTER 13—WITHDRAWAL AND LAPSING OF APPLICATIONS AND CEASING OF PATENTS

Withdrawal of applications

141. A patent application is to be treated as having been withdrawn if, and only if, the applicant lodges a written notice of withdrawal signed by the applicant.

Lapsing of applications

142. (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
- (b)** the applicant does not comply with a direction of the Commissioner under subsection 45 (3) within the time specified by the Commissioner under that subsection and the Commissioner directs that the application lapse; or
- (c)** the examination of the patent request and complete specification has been deferred under section 46 and the applicant does not ask for an examination within the period prescribed for the purposes of this paragraph; 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.

(3) A complete application for a 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.

(4) A complete application for a petty patent lapses if the applicant does not:

- (a)** comply with a direction of the Commissioner under section 108 within the time allowed by the Commissioner under that section; or

- (b) comply with a notice given to the applicant under subsection 50 (2) within the time specified by the Commissioner under that subsection.

Ceasing of patents

143. 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.

CHAPTER 14—CONTRACTS

Void conditions

144. (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.

(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.

(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.

Termination of contract after patent ceases to be in force

145. (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.

Effect of Chapter

146. 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
- (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.

CHAPTER 15—SPECIAL PROVISIONS RELATING TO ASSOCIATED TECHNOLOGY

Certificate by Director as to associated technology

147. (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.

Lapsing etc. of applications

148. (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*.

Revocation of direction

149. 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.

Restoration of lapsed application

150. (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 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 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*.

Reinstatement of application as an international application

151. (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 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
- (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 or for a petty 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.

Notice of prohibitions or restrictions on publication

152. (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.

Effect of order

153. (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) Where an order is in force in relation to an application for a petty 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 and 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.

CHAPTER 16—JURISDICTION AND POWERS OF COURTS

Jurisdiction of Federal Court

154. (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.

Jurisdiction of other prescribed courts

155. (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.

Exercise of jurisdiction

156. The jurisdiction of a prescribed court under section 154 or 155 is to be exercised by a single judge.

Transfer of proceedings

157. (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.

Appeals

158. (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).

(4) Except as otherwise provided by this section, an appeal does not lie against a judgment or order referred to in subsection (1).

Commissioner may appear in appeals

159. 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.

Powers of Federal Court

160. 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.

CHAPTER 17—THE CROWN

PART 1—INTRODUCTORY

Nominated persons and patentees

161. 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.

Commonwealth and State authorities

162. 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.

PART 2—EXPLOITATION BY THE CROWN

Exploitation of inventions by Crown

163. (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.

Nominated person or patentee to be informed of exploitation

164. 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.

Remuneration and terms for exploitation

165. (1) No remuneration is payable to a nominated person or patentee for the exploitation of an invention under subsection 163(1) if, before the priority date of the relevant claim, the invention was

recorded in a document by, or tested by or for, the relevant authority, unless the nominated person or patentee directly or indirectly communicated the invention to the relevant authority.

(2) Subject to subsection (1), the terms for the exploitation of the invention 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.

Previous agreements inoperative

166. 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 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.

Sale of products

167. (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.

Supply of products by Commonwealth to foreign countries

168. 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.

Declarations that inventions have been exploited

169. (1) 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.

Sale of forfeited articles

170. 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.

PART 3—ACQUISITIONS BY AND ASSIGNMENTS TO THE CROWN

Acquisition of inventions or patents by Commonwealth

171. (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.

Assignment of invention to Commonwealth

172. (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.

PART 4—PROHIBITION ORDERS

Prohibition of publication of information about inventions

173. (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 depository 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.

Effect of prohibition orders

174. (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.

(3) While a prohibition order is in force in relation to an application for a petty 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 and a patent must not be granted on the application.

Disclosure of information to Commonwealth authority

175. 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.

International applications treated as applications under this Act

176. 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 or for a petty 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.

CHAPTER 18—MISCELLANEOUS OFFENCES

False representations about the Patent Office

177. (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: \$3,000.

(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.

False representations about patents or patented articles

178. (1) A person must not falsely represent that he or she, or another person, is the patentee of an invention.

Penalty: \$6,000.

(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: \$6,000.

(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.

Failure to comply with summons

179. A person who:

- (a)** is summoned by the Commissioner to appear as a witness; and
(b) has been offered payment of reasonable expenses;

must not, without lawful excuse, fail to comply with the summons.

Penalty: \$1,000.

Refusal to give evidence

180. A person who appears before the Commissioner must not, without lawful excuse, refuse:

- (a)** to be sworn or to make an affirmation; or
(b) to answer questions that the person is lawfully required to answer.

Penalty: \$3,000.

Failure to produce documents or articles

181. A person who:

(a) is required by the Commissioner to produce a document or article; and

(b) has been offered payment of reasonable expenses;

must not, without lawful excuse, fail to produce it.

Penalty: \$3,000.

Officers not to traffic in inventions

182. (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: \$6,000.

(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.

Unauthorised disclosure of information by employees etc.

183. 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.

Other unauthorised disclosures of information

184. 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.

Employees etc. not to prepare documents or search records

185. The Commissioner, a Deputy Commissioner or an employee must not:

(a) prepare, or help prepare, a document to be filed under this Act; or

(b) search the records of the Patent Office;

unless required or authorised to do so by this Act, a written direction of the Commissioner or an order of a court.

Penalty: \$1,000.

CHAPTER 19—THE REGISTER AND OFFICIAL DOCUMENTS

Register of Patents

186. (1) A Register of Patents is to be kept at the Patent Office.

(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.

Registration of particulars of patents etc.

187. Particulars of patents in force, and other prescribed particulars relating to patents (if any) must be registered.

Trusts not registrable

188. Notice of any kind of trust relating to a patent or licence is not receivable by the Commissioner and must not be registered.

Power of patentee to deal with patent

189. (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.

(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.

Inspection of Register

190. (1) The Register must be available for inspection at the Patent Office by any person during the hours that it is open for business.

(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.

False entries in Register

191. A person must not knowingly or recklessly:

- (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.

Orders for rectification of Register

192. (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.

(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.

Inspection of documents

193. 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.

Information obtainable from Commissioner

194. 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.

Evidence—the Register

195. (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.

Evidence—unregistered particulars

196. 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.

Evidence—certificate and copies of documents

197. (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:

“signed” means signed by the Commissioner.

CHAPTER 20—PATENT ATTORNEYS

PART 1—REGISTRATION, PRIVILEGES AND PROFESSIONAL CONDUCT

Registration of patent attorneys

198. (1) A Register of Patent Attorneys is to be kept at the Patent Office.

(2) The Commissioner must register as a patent attorney a person who:

- (a)** is an Australian citizen; and
- (b)** is at least 21; and
- (c)** has passed the prescribed subjects; and
- (d)** has the prescribed qualifications; and
- (e)** has been employed as prescribed, for not less than the prescribed period, by a patent attorney.

Deregistration

199. 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.

Privileges

200. (1) A 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 between a patent attorney and his or her client, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client.

(3) Nothing in this section authorises a 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.

PART 2—OFFENCES

Offences: unregistered persons etc.

201. (1) A person must not carry on business, practise or act as a patent attorney unless the person is a registered patent attorney or a legal practitioner.

Penalty: \$3,000.

(2) The members of a partnership must not carry on business, practise or act as patent attorneys unless each member is a registered patent attorney or a legal practitioner.

Penalty: \$3,000.

(3) A person must not describe himself or herself, or hold himself or herself out, or permit himself or herself to be described or held out, as a patent attorney, or agent for obtaining patents unless the person is a registered patent attorney.

Penalty: \$3,000.

(4) The members of a partnership must not describe themselves, or hold themselves out, or permit themselves to be described or held out, as patent attorneys, or agents for obtaining patents, unless each member is a registered patent attorney.

Penalty: \$3,000.

(5) A company must not carry on business, practise, act, describe itself or hold itself out, or permit itself to be described or held out, as a patent attorney or agent for obtaining patents.

Penalty: \$15,000.

(6) It is not an offence against subsection (1), (2) or (5) if the legal representative of a deceased patent attorney:

- (a) carries on the patent attorney's business for not more than 3 years after the patent attorney's death or for any further period allowed by a prescribed court; and
- (b) is a registered patent attorney, or employs a registered patent attorney to manage the business on his or her behalf.

(7) For the purposes of this section, a person or company is to be taken to carry on business as a patent attorney if the person or company undertakes in Australia, for gain:

- (a) to apply for or obtain patents in Australia or anywhere else; or
- (b) to prepare specifications or other documents for the purposes of this Act or the patent law of another country; or
- (c) to give advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.

Documents prepared by legal practitioners

202. 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: \$3,000.

Attendance at patent attorney's office

203. A registered patent attorney must not practise, act, or hold himself or herself out as practising or acting, as a patent attorney, at an office or place of business where specifications or other documents are prepared for the purposes of this Act, unless he or she, or another registered patent attorney, is in regular attendance at, and in continuous charge of, that office or place.

Penalty: \$3,000.

Time for starting prosecutions

204. Despite section 21 of the *Crimes Act 1914*, a prosecution for an offence against subsection 201 (1), (2), (3), (4) or (5), or section 202 or 203, may be started at any time within 5 years after the offence was committed.

CHAPTER 21—ADMINISTRATION

Patent Office and sub-offices

205. (1) For the purposes of this Act, there is to be an office called the Patent Office.

(2) There is to be a sub-office of the Patent Office in each State.

Patent Office seal

206. There is to be a seal of the Patent Office and impressions of the seal must be judicially noticed.

Commissioner of Patents

207. (1) There is to be a Commissioner of Patents.

(2) The Commissioner has, under the Minister, the administration of the Patent Office.

Deputy Commissioner of Patents

208. (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, except the Commissioner's powers of delegation under section 209.

(3) A power or function of the Commissioner under this Act, when exercised by a Deputy Commissioner, is to be taken, for the purposes of this Act, to have been exercised by the Commissioner.

(4) The exercise of a power or function of the Commissioner under this Act by a Deputy Commissioner does not prevent the exercise of the power or function by the Commissioner.

(5) Where, under this Act, the exercise of a power or function by the Commissioner, or the operation of a provision of this 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.

Delegation of Commissioner's powers and functions

209. (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 to an employee.

(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.

Commissioner's powers

210. 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.

Recovery of costs awarded by Commissioner

211. Costs awarded by the Commissioner against a party are recoverable as a debt.

CHAPTER 22—MISCELLANEOUS

Copies of examination reports to be communicated

212. 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.

Making and signing applications etc.

213. 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 person entitled under this Act to practise as a patent attorney.

Filing of documents

214. A document may be filed with the Patent Office by delivering the document to a sub-office of the Patent Office either personally or by post or by any other prescribed means.

Death of applicant or nominated person

215. (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 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 patent by substituting for the name of the patentee the name of the person to whom the patent should have been granted.

(4) An amendment by the Commissioner has effect, and is to be taken always to have had effect, accordingly.

Exercise of discretionary power by Commissioner

216. (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.

Assessors

217. 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.

Costs where patent invalid in part

218. 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.

Security for costs

219. 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.

Costs of attendance of patent attorney

220. Where, at the hearing of proceedings under this Act, a 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.

Service of documents

221. 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.

Publication of *Official Journal* etc.

222. (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.

Extensions of time

223. (1) Where, because of an error or omission by the Commissioner, a Deputy Commissioner or an employee, a relevant act that is required to be done within a certain time is not, or cannot be, done within that time, the Commissioner must extend the time for doing the act.

(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.

(3) The time allowed for doing a relevant act may be extended, whether before or after that time has expired.

(4) Where an application is made for an extension of time for more than 3 months, the Commissioner must advertise the application in the *Official Journal*.

(5) An application cannot be made under subsection (2) for an extension of time for more than 3 months in respect of an act or step

required to be done or taken for the purposes of Division 2 of Part 3 of Chapter 6.

(6) A person may, as prescribed, oppose the granting of 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 an extension of time for more than 3 months is granted for doing a relevant act, 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 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.

Review of decisions

224. (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 66, subsection 103 (2), section 113, subsection 137 (3), paragraph 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 Commissioner under Chapter 20 not to register a person who is a patent attorney; or

(c) a decision of the Director under subsection 147 (2) or (3), section 149 or subsection 152 (1).

(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*.

Conduct of directors, servants and agents

225. (1) Where it is necessary to establish, for the purposes of a prosecution for an offence under this Act, the state of mind of a company in relation to particular conduct, it is sufficient to show:

- (a) that the conduct was engaged in by a director, servant or agent of the company within the scope of his or her actual or apparent authority; and
- (b) that the director, servant or agent had the state of mind.

(2) Any conduct engaged in on behalf of a company by a director, servant or agent of the company 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 company, unless it establishes that it took reasonable precautions and exercised due diligence to avoid the conduct.

(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 section 5, 6, 7 or 7A, or subsection 86 (1), of the *Crimes Act 1914*, 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 (1) or (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.

(8) A reference in this section to a director of a company includes a reference to a constituent member of a body corporate incorporated for a public purpose by a law of the Commonwealth, of a State or of a Territory.

(9) A reference in this section to engaging in conduct includes a reference to failing or refusing to engage in conduct.

Reproduction of published specifications does not infringe copyright

226. The reproduction in 2 dimensions of the whole or part of a provisional or complete specification that is open to public inspection does not constitute an infringement of any copyright subsisting under the *Copyright Act 1968* in any literary or artistic work.

Fees

227. (1) The prescribed fees are payable.

(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) Where a fee is payable in respect of the doing of an act by the Commissioner, the Commissioner must not do the act until the fee has been paid.

(4) Subject to subsection (5), where a fee is payable in respect of the doing of an act by a person other than the Commissioner, or a fee is payable in respect of the filing of a document, the act is to be taken to have been done, or the document is to be taken to have been filed, in spite of the failure to pay the fee.

(5) Where the Commissioner notifies the person concerned, or his or her patent attorney, in accordance with the regulations, of the failure

to pay the fee, the act is not to be taken to have been done, or the document is not to be taken to have been filed, before the day on which the fee is paid.

Regulations

228. (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.

(2) Without limiting subsection (1), that subsection includes the power to make regulations:

- (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
- (d) making provision for and in relation to the amendment of a complete specification to include the matters mentioned in paragraph 6 (c); 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
- (f) making provision for and in relation to the amendment of a patent to correct a clerical error or an obvious mistake; 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

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- (j) empowering the Commissioner to direct an applicant for a 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
- (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;
 - (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:

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- (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, 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
 - (u) making provision for and in relation to the destruction of documents relating to applications for patents filed not less than 25 years before the time of destruction; 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.

(5) The Governor-General is to make regulations setting out the English texts of the Budapest Treaty and the PCT as in force for Australia on the commencing day, and afterwards such regulations as are necessary to keep those English texts in an up-to-date form.

(6) The Governor-General may make regulations setting out the English text of a treaty relating to the protection of inventions to which Australia is a party (other than the Budapest Treaty or the PCT), being the English text of the treaty as in force for Australia when the regulations are made, and afterwards such regulations as are necessary to keep that English text in an up-to-date form.

(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.

Consequential amendments

229. The Acts specified in Schedule 2 are amended as set out in that Schedule.

Repeal

230. The *Patents Act 1952* is repealed.

CHAPTER 23—TRANSITIONAL AND SAVINGS PROVISIONS

Application of Part III of 1989 Amending Act

231. Nothing in this Act affects the continued operation of Part III of the 1989 Amending Act.

Application of this Act: extensions of term

232. The term of a patent cannot be extended under Division 2 of Part 3 of Chapter 6 of this Act if the term of the patent was extended under Part IX of the 1952 Act, as in force before or after the commencement of the 1989 Amending Act.

Patents granted under 1952 Act

233. (1) Subject to this Chapter, 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.

Applications under 1952 Act

234. (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
- (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.

Other applications and proceedings under 1952 Act

235. (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.

Micro-organisms

236. Sections 41 and 42 of this Act do not apply in relation to a specification lodged before 7 July 1987.

Orders, directions etc. under 1952 Act

237. 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.

The Commissioner and Deputy Commissioner

238. 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.

The Register of Patents and Register of Patent Attorneys

239. (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.

Registered patent attorneys

240. 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.

SCHEDULE 1

Section 3

DICTIONARY

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, within the meaning of the Continental Shelf Convention, adjacent to the coast of Australia (including the coast of any island forming part of a State or Territory);

“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;

“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;

“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;

SCHEDULE 1—continued

“complete specification” means a specification filed in respect of a complete patent application;

“compulsory licence” means a licence granted under an order made under section 131;

“Continental Shelf Convention” means the Convention called “Convention on the Continental Shelf” signed at Geneva on 29 April 1958, a copy of the English text of which is set out in Schedule 1 to the *Petroleum (Submerged Lands) Act 1967*;

“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
- (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 2 of Chapter 8;

“Convention country” means a foreign country declared by the regulations to be a Convention country for the purposes of this Act;

“deposit requirements” means the requirements specified in paragraphs 6 (a) to (d), inclusive;

“depository 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;

“Director” means the Director of Safeguards;

“divisional application” means a further application for a patent under section 39;

“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 an officer or employee within the meaning of the *Public Service Act 1922* and is employed under the control of the Commissioner; or
- (b) is not such an officer or employee but performs services, under the control of the Commissioner, for or on behalf of the Commonwealth;

“examination”, in relation to a patent request and a complete specification relating to an application for a standard patent, means an

SCHEDULE 1—continued

examination of the request and specification under section 45, or a modified examination of the request and specification;

“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;

“infringement proceedings” means proceedings for infringement of a patent;

“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:

- (a) the date given to the international application as its international filing date under Article 11 of the PCT; or
- (b) if that date is revised under Article 14 of the PCT—that international filing date as so revised;

[See also section 10]

“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;

SCHEDULE 1—continued

“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;

“marketing approval”, in relation to a pharmaceutical substance, means the approval of the Secretary to the Department of Community Services and Health for the marketing of the substance, or a product containing the substance, in Australia;

“marketing approval certificate”, in relation to a pharmaceutical substance, means a certificate by the Secretary to the Department of Community Services and Health certifying that he or she has approved the marketing of that substance, or a product containing that substance, in Australia;

“modified examination”, in relation to a patent request and complete specification relating to an application for a standard patent, means an examination of the request and specification under section 48;

“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 123 (1);

“Official Journal” means the official journal mentioned in section 222;

“patent” means a standard patent or a petty patent;

“patent application” means an application for a standard patent or an application for a petty 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 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 84;

“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;

SCHEDULE 1—continued

“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;

“patentee” means the person for the time being entered in the Register as the grantee or proprietor of a patent;

“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;

“PCT application” means an international application:

(a) in which Australia is specified as a designated State under Article 4 (1) (ii) of the PCT; and

(b) which has been given an international filing date;

“permit”, in Chapter 15, has the same meaning as in the Safeguards Act;

“petty patent” means letters patent for an invention granted under section 62;

“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;

“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:

(i) information in a document, being a document publicly available anywhere in the patent area; and

(ii) information made publicly available through doing an act anywhere in the patent area; and

SCHEDULE 1—continued

- (iii) where the invention is the subject of a standard patent or an application for a standard patent—information in a document publicly available outside the patent area; and
- (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 after the priority date of the claim under consideration; and
 - (C) the information was contained in the specification on its filing date and when it was published;

[*Note: For the meaning of “document” see section 25 of the Acts Interpretation Act 1901.*]

“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;

“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 the re-examination of a complete specification under Chapter 9;

“Register” means the Register of Patents mentioned in section 186;

“registered” means:

- (a) in relation to a patent—entered in the Register of Patents; or
- (b) in relation to a patent attorney—entered in the Register of Patent Attorneys;

“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

SCHEDULE 1—continued

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*;

“sealed” means sealed with the seal of the Patent Office;

“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 this Act, but does not include a petty patent;

“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 supply by way of sale, exchange, lease, hire or hire-purchase;

“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*.

SCHEDULE 2

CONSEQUENTIAL AMENDMENTS

Companies Act 1981

Paragraph 204 (5) (d):

Omit “1952”, substitute “1990”.

Designs Act 1906

Subsection 4 (1) (definition of “Official Journal”):

Omit the definition, substitute the following definition:

“ ‘*Official Journal*’ has the same meaning as in the *Patents Act 1990*.”.

Industry, Technology and Commerce Legislation Amendment Act (No. 2) 1989

Subsection 2 (3):

Omit “*Patents Act 1989*”, substitute “*Patents Act 1990*”.

Jurisdiction of Courts (Cross-vesting) Act 1987

Schedule:

Omit “*Patents Act 1952*”, substitute “*Patents Act 1990*”.

Nuclear Non-Proliferation (Safeguards) Act 1987

Paragraph 23 (6) (a):

Omit “1952”, substitute “1990”.

Paragraph 26 (4) (a):

Omit “1952”, substitute “1990”.

Sales Tax Assessment Act (No. 1) 1930

Paragraph 3A (7) (b):

Omit “1952”, substitute “1990”.

Trade Marks Act 1955

Subsection 6 (1) (definition of “the Official Journal”):

Omit the definition, substitute the following definition:

“ ‘*Official Journal*’ has the same meaning as in the *Patents Act 1990*.”.

Section 138:

Repeal the section.

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*[Minister's second reading speech made in—
Senate on 29 May 1990
House of Representatives on 10 October 1990]*