Patents Amendment Regulations 2000 (No. 1)'

Statutory Rules 2000 No.2

I, WILLIAM PATRICK DEANE, Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following Regulations under the Patents Act 1990.

Dated 22 NOV 2000

WILLIAM DEANE
Governor-General

By His Excellency's Command

WARREN ENTSCH
Parliamentary Secretary to the Minister for Industry, Science and Resources
Contents

1 Name of Regulations
These Regulations are the Patents Amendment Regulations 2000 (No. 1).

2 Commencement
These Regulations commence as follows:
(a) on gazettal — regulations 1 to 3, and Schedule 1;
(b) on 1 January 2001 — Schedule 2;
(c) on 1 March 2001 — Schedule 3.

3 Amendment of Patents Regulations 1991
Schedules 1, 2 and 3 amend the Patents Regulations 1991.
Schedule 1  Amendments commencing on gazettal
(regulation 3)

[1]  Subregulation 1.6 (1)

   substitute

   (1) For section 8 of the Act, the prescribed period for a
       Convention application is:

       (a) for documents to which paragraph 8 (a) of the Act
           applies — from the date of making the application
           based on the basic application to immediately
           before acceptance; and

       (b) for documents to which paragraph 8 (b) of the Act
           applies:

           (i) if the application based on the basic
               application has been accepted — 3 months
               from the date on which the Commissioner
               requests the translation; or

           (ii) if the application based on the basic
                application has not yet been accepted —
                from the date on which the Commissioner
                requests the translation to immediately
                before acceptance.

   (1A) For section 8 of the Act, the prescribed period for a
        PCT application is:

        (a) if the application based on the basic application
            has been accepted — 3 months from the date on
            which the Commissioner requests the document;
            or

        (b) if the application based on the basic application
            has not yet been accepted — from the date on
            which the Commissioner requests the document to
            immediately before acceptance.
[2] Subregulation 3.1 (3)

*omit*

[3] Subparagraph 3.2 (2) (c)

*before*

*have*

*insert*

*unless it is in electronic form,*

[4] Subregulation 3.5 (3)

*omit*

[5] Paragraph 5.9 (2) (d)

*omit*

*amendment; or*

*insert*

*amendment.*

[6] Paragraph 5.9 (2) (e)

*omit*

[7] Paragraph 5.10 (2) (b)

*after*

*specifies;*

*insert*

*and*
[8] **After paragraph 5.10 (2) (b)**

*insert*

(c) after the party has served the application on the other party;

[9] **Subregulations 8.6 (2) and (3)**

*substitute*

(2) For subsection 95 (3) of the Act, a copy of the specification relating to the basic application that is certified by the official chief or head of the Patent Office of the Convention Country in which the basic application is made must be filed within the period from the day on which the application is made to immediately before acceptance.

[10] **Subregulation 10.2 (7)**

*omit*

2 months

*insert*

21 days, or any longer period up to 2 months allowed by the Commissioner,


*omit*

determined.

*insert*

determined;
[12]  **After paragraph 13.4 (1) (j)**

*insert*

(k) if the Commissioner requests a document under subparagraph 1.6 (1) (b) (ii) or paragraph 1.6 (1A) (b) — 5 months commencing on the date of the request.


*omit*

(j)

*insert*

(k)

[14]  **Schedule 2A, rule 4.10 (a)**

*after*

("priority claim")

*insert*

may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim

[15]  **Schedule 2A, rule 4.10 (a) (iii)**

*after*

Property

*insert*

or the Member of the World Trade Organization that is not party to that Convention

[16]  **Schedule 2A, rule 4.10 (b) (ii)**

*substitute*

(ii) where the earlier application is a regional application and at least one of the countries party to the regional patent treaty is neither party to the Paris Convention for the Protection of Industrial Property nor a
Member of the World Trade Organization, the priority claim shall indicate at least one country party to that Convention or one Member of that Organization for which that earlier application was filed.

[17] Schedule 2A, after rule 4.10 (c)

insert

(c) If, on September 29, 1999, paragraphs (a) and (b) as amended with effect from January 1, 2000, are not compatible with the national law applied by a designated Office, those paragraphs as in force until December 31, 1999, shall continue to apply after that date in respect of that designated Office for as long as the said paragraphs as amended continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by October 31, 1999. The information received shall be promptly published by the International Bureau in the Gazette.

[18] Schedule 3, after clause 11

insert

12. Amino acid sequences and nucleotide sequences

An amino acid sequence or a nucleotide sequence that is part of a specification may be filed in a format approved by the Commissioner on a compact disk or by other electronic means approved by the Commissioner.

[19] Schedule 7, Part 2, item 3, paragraph (b)

omit of 30

insert of 30; and

[20] Schedule 7, Part 2, item 3, after paragraph (b)

insert (c) if the specification includes an amino acid $1 000
sequence or a nucleotide sequence filed on a compact disk or by other electronic means
Schedule 2

Amendments commencing on
1 January 2001
(regulation 3)

[1] Subregulation 1.4 (2)

*omit*

1 January 2000

*insert*

1 January 2001

[2] Schedule 2A, adoption and amendment dates following the heading

*omit*

and on September 29, 1999.

*insert*

, on September 29, 1999, on March 17, 2000 and on October 3, 2000.

[3] Schedule 2A, Schedule of fees, item 2, paragraph (a)

*omit*

8

*insert*

6

[4] Schedule 7, Part 4, item 2, paragraph (i)

*omit*

8

*insert*

6
[5] Schedule 7, Part 4, item 2, paragraph (ii)

*omit*

9

*insert*

7

[6] Schedule 7, Part 4, item 2, paragraph (ii)

*omit*

1120

*insert*

840
Schedule 3  Amendments commencing on 1 March 2001
(regulation 3)

[1] Subregulation 1.4 (2)

*omit*

1 January 2001

*insert*

1 March 2001

[2] Schedule 2A, subparagraph 4.1 (c) (ii)

*substitute*

(ii) a request to the receiving Office to prepare and transmit the priority document to the International Bureau where the application whose priority is claimed was filed with the national Office or intergovernmental authority which is the receiving Office,

(iii) declarations as provided in Rule 4.17.

[3] Schedule 2A, after paragraph 4.5 (d)

*insert*

(e) Where the applicant is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the applicant is so registered.

[4] Schedule 2A, paragraph 4.6 (a)

*after*

Rule 4.1 (a) (v)

*insert*

or (c) (i)

substitute

(a) If an agent is appointed, the request shall so indicate, and shall state the agent’s name and address.

(b) Where the agent is registered with the national Office that is acting as receiving Office, the request may indicate the number or other indication under which the agent is so registered.

[6] Schedule 2A, rule 4.8

omit
designated

insert

appointed


substitute

4.17 Declarations Relating to National Requirements Referred to in Rule 51bis.1 (a) (i) to (v)

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

(i) a declaration as to the identity of the inventor, as referred to in Rule 51bis.1 (a) (i);

(ii) a declaration as to the applicant’s entitlement, as at the international filing date, to apply for and be granted a patent, as referred to in Rule 51bis.1 (a) (ii);

(iii) a declaration as to the applicant’s entitlement, as at the international filing date, to claim priority of the earlier application, as referred to in Rule 51bis.1 (a) (iii);

(iv) a declaration of inventorship, as referred to in Rule 51bis.1 (a) (iv), which shall be signed as prescribed by the Administrative Instructions;

(v) a declaration as to non-prejudicial disclosures or exceptions to lack of novelty, as referred to in Rule 51bis.1 (a) (v).

4.18 Additional Matter

(a) The request shall contain no matter other than that specified in Rules 4.1 to 4.17, provided that the Administrative Instructions may permit, but cannot make mandatory, the inclusion in the request of any additional matter specified in the Administrative Instructions.
(b) If the request contains matter other than that specified in Rules 4.1 to 4.17 or permitted under paragraph (a) by the Administrative Instructions, the receiving Office shall ex officio delete the additional matter.

[8] Schedule 2A, after rule 26{sup}bis\{/sup}

insert

Rule 26{sup}rev\{/sup}
Correction or Addition of Declarations Under Rule 4.17

26{sup}rev.1 Correction or Addition of Declarations

The applicant may correct or add to the request any declaration referred to in Rule 4.17 by a notice submitted to the International Bureau within a time limit of 16 months from the priority date, provided that any notice which is received by the International Bureau after the expiration of that time limit shall be considered to have been received on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

26{sup}rev.2 Processing of Declarations

(a) Where the receiving Office or the International Bureau finds that any declaration referred to in Rule 4.17 is not worded as required or, in the case of the declaration of inventornship referred to in Rule 4.17 (iv), is not signed as required, the receiving Office or the International Bureau, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.

(b) Where the International Bureau receives any declaration or correction under Rule 26{sup}rev.1 after the expiration of the time limit under Rule 26{sup}rev.1, the International Bureau shall notify the applicant accordingly and shall proceed as provided for in the Administrative Instructions.

[9] Schedule 2A, after rule 47.1 (a{sup}bis\{/sup})

insert

(a{sup}bis\{/sup}) The notification under paragraph (a{sup}bis\{/sup}) shall include any declaration referred to in Rule 4.17 (i) to (iv), and any correction thereof under Rule 26{sup}rev.1, which was received by the International Bureau before the expiration of the time limit under Rule 26{sup}rev.1, provided that the designated Office has informed the International Bureau that the applicable national law requires the furnishing of documents or evidence relating to the matter to which the declaration relates.
[10] **Schedule 2A, rule 48.2 (a) (ix)**

substitute

(ix) any information concerning a priority claim considered not to have been made under Rule 25bis.2 (b), the publication of which is requested under Rule 25bis.2 (c),

(x) any declaration referred to in Rule 4.17 (v), and any correction thereof under Rule 26bis.1, which was received by the International Bureau before the expiration of the time limit under Rule 26bis.1.

[11] **Schedule 2A, rule 48.2 (b) (iii)**

substitute

(iii) the abstract; if the abstract is both in English and in another language, the English text shall appear first,

(iv) an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26bis.1.

[12] **Schedule 2A, rule 51bis.1 (a)**

substitute

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

(i) any document relating to the identity of the inventor,

(ii) any document relating to the applicant's entitlement to apply for or be granted a patent,

(iii) any document containing any proof of the applicant's entitlement to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed,

(iv) where the international application designates a State whose national law requires that national applications be filed by the inventor, any document containing an oath or declaration of inventorship,

(v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.
[13] Schedule 2A, rule 51bis.1 (d)

substitute

(d) The national law applicable by the designated Office may, in accordance with Article 27 (2) (ii), require that the translation of the international application furnished by the applicant under Article 22 be:

(i) verified by the applicant or the person having translated the international application in a statement to the effect that, to the best of his knowledge, the translation is complete and faithful;

(ii) certified by a public authority or sworn translator, but only where the designated Office may reasonably doubt the accuracy of the translation.

(e) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish a translation of the priority document, provided that such a translation may only be required where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

(f) If, on March 17, 2000, the proviso in paragraph (e) is not compatible with the national law applied by the designated Office, that proviso shall not apply in respect of that Office for as long as that proviso continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

[14] Schedule 2A, rule 51bis.2

substitute

51bis.2. Certain Circumstances in Which Documents or Evidence May Not Be Required

(a) Where the applicable national law does not require that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1 (a) (i)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17 (i), is contained in the request or is submitted directly to the designated Office;

(ii) relating to the applicant’s entitlement, as at the international filing date, to apply for and be granted a patent (Rule 51bis.1 (a) (ii)), if a declaration as to that matter, in accordance with Rule 4.17 (ii), is contained in the request or is submitted directly to the designated Office;

(iii) relating to the applicant’s entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51bis.1 (a) (iii)), if a declaration as to that matter, in accordance with Rule 4.17 (iii), is
 contained in the request or is submitted directly to the designated Office.

(b) Where the applicable national law requires that national applications be filed by the inventor, the designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51(2) (a) (i)) (other than a document containing an oath or declaration of inventorship (Rule 51(2) (a) (iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request;

(ii) relating to the applicant’s entitlement, as at the international filing date, to claim priority of an earlier application (Rule 51(2) (a) (iii)), if a declaration as to that matter, in accordance with Rule 4.17 (iii), is contained in the request or is submitted directly to the designated Office;

(iii) containing an oath or declaration of inventorship (Rule 51(2) (a) (iv)), if a declaration of inventorship, in accordance with Rule 4.17 (iv), is contained in the request or is submitted directly to the designated Office.

(c) If, on March 17, 2000, paragraph (a) is not compatible, in relation to any item of that paragraph, with the national law applied by the designated Office, paragraph (a) shall not apply in respect of that Office in relation to that item for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

51(2) Opportunity to Comply with National Requirements

(a) Where any of the requirements referred to in Rule 51(2) (a) (i) to (iv) and (c) to (e), or any other requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27 (1) or (2), is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the designated Office shall invite the applicant to comply with the requirement within a time limit which shall not be less than two months from the date of the invitation. Each designated Office may require that the applicant pay a fee for complying with national requirements in response to the invitation.

(b) Where any requirement of the national law applicable by the designated Office which that Office may apply in accordance with Article 27 (6) or (7) is not already fulfilled during the same period within which the requirements under Article 22 must be complied with, the applicant shall have an opportunity to comply with the requirement after the expiration of that period.

(c) If, on March 17, 2000, paragraph (a) is not compatible with the national law applied by the designated Office in relation to the time limit referred to in that paragraph, the said paragraph shall not apply in respect of that Office in relation to that time limit for as long as the said paragraph continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by November 30, 2000. The information received shall be promptly published by the International Bureau in the Gazette.

*omit*

designated

*insert*

appointed

[16] Schedule 2A, rule 66.7 (b)

*after*

Authority may

*insert*

, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33 (1).

Notes
