

EXPLANATORY STATEMENT

Select Legislative Instrument 2008 No. 178

Issued by the Authority of the Minister for Innovation, Industry, Science and Research

Patents Act 1990

Patents Amendment Regulations 2008 (No. 1)

Section 228 of the *Patents Act 1990* (the Act) provides, in part, that the Governor-General may make regulations—not inconsistent with the Act—prescribing matters required or permitted by the Act to be prescribed, or matters necessary or convenient for carrying out or giving effect to the Act.

Paragraph 228(2)(t) of the Act allows the Governor-General to make regulations modifying the operation of the Act in relation to applications made under the Patent Cooperation Treaty (PCT). The PCT provides for the cooperation between member countries in the filing, searching and examination of applications for the protection of inventions. In addition, subsection 228(5) of the Act requires the Governor-General to make regulations setting out the English text of the PCT as in force for Australia on the commencing day of the Act, and afterwards such regulations as are necessary to keep that English text up-to-date.

The Regulations make amendments to Schedule 2A to the *Patents Regulations 1991* (the Principal Regulations) to implement changes under the PCT Rules as agreed by the Assembly of the PCT in October 2007. These changes are purely of an administrative nature and are intended to simplify the application procedure for applicants.

The Regulations also implement changes to the Schedule of Fees as agreed to by an Extraordinary Session of the Assembly of the PCT Union held in Geneva on 31 March 2008. The changes to the Schedule reduce the filing fee for applicants from certain specified developing countries. Similar amendments have been made to Part 4 of Schedule 7 of the Principal Regulations to reflect the PCT Rule changes.

The Act specifies no conditions that need to be met before the power to make the Regulations may be exercised.

The Regulations are a legislative instrument for the purposes of the *Legislative Instruments Act 2003*.

The Regulations are taken to have commenced on 1 July 2008 as this is the date that the amendments to the PCT Rules were specified to commence. For the purposes of subsection 12(2) of the *Legislative Instruments Act 2003*, which generally prohibits the making of Regulations that take effect from a date before registration, the Australian Government Solicitor has confirmed that the Regulations would not disadvantage any

person nor impose any liability on any person (other than the Commonwealth). Therefore, the retrospective application of the Regulations would not contravene subsection 12(2) of the *Legislative Instruments Act 2003*.

Details of the Regulations are in Attachment A.

In accordance with section 17 of the *Legislative Instruments Act 2003*, IP Australia has undertaken consultation with; peak intellectual property organisations; industry associations; and patent attorneys. The stakeholders listed supported the regulatory changes.

The proposed Regulations will commence on the 1 July 2008.

ATTACHMENT

Details of the proposed *Patents Amendment Regulations 2008 (No.1)*

Regulation 1 identifies the Regulations as the *Patents Amendment Regulations 2008 (No. 1)*.

Regulation 2 specifies that the Regulations will be taken to have commenced on 1 July 2008.

Regulation 3 specifies that Schedule 1 amends the *Patents Regulations 1991* (the Principal Regulations).

Regulation 4 outlines the transitional provisions for a smooth transition to the new arrangements below.

Schedule 1 – Amendments

Item 1 adds the date 1 July 2008 to the table of amendments for the Patent Cooperation Treaty (PCT) as found in the beginning of Schedule 2A. This table identifies the dates of all amendments made to the PCT since its creation.

Items 2 to 12 amends the Principal Regulations as a result of the thirty sixth session of the International Patent Cooperation Union meeting in Geneva from 24 September to 3 October 2007.

The changes:

- allow the International Searching Authority to take into account the results of an earlier search carried out by another International Searching Authority or any national office – (Items 2,3,4,5,6,7,8,9,12);
- give receiving offices the authority to extend the time period for the applicant to pay the fee for requesting restoration of the right of priority – (Item 10); and
- clarify that international publication can only be reliably prevented by way of an express withdrawal prior to completion of technical preparations for international publication – (Item 11).

Item 13 amends the Schedule of Fees under Schedule 2A to the Principal Regulations to include the fee changes agreed at the extraordinary PCT Union meeting of 31 March 2008. These fees are paid for the benefit of the International Bureau of WIPO and reduce the quantum of the filing fee and also allow for a further fee reduction for certain specified developing countries.

Item 14 amends Part 4 of Schedule 7 to the Principal Regulations to reflect the changes made to the PCT fees in item 13. These fees are payable for the benefit of the International Bureau of WIPO.