

EXPOSURE DRAFT



EXPOSURE DRAFT

Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018

I, General the Honourable Sir Peter Cosgrove AK MC (Ret'd), Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following regulations.

Dated 2018

Peter Cosgrove
Governor-General

By His Excellency's Command

Karen Andrews [**DRAFT ONLY—NOT FOR SIGNATURE**]
Minister for Industry, Science and Technology

EXPOSURE DRAFT

EXPOSURE DRAFT

Contents

1	Name.....	1
2	Commencement	1
3	Authority.....	1
4	Schedules.....	1
Schedule 1—Amendments		2
Part 1—Innovation patents		2
<i>Patents Regulations 1991</i>		2
Part 2—Crown use		3
<i>Patents Regulations 1991</i>		3
Part 3—Compulsory licences		4
<i>Patents Regulations 1991</i>		4
Part 4—Translations		5
<i>Patents Regulations 1991</i>		5
Part 5—Delegation		11
<i>Designs Regulations 2004</i>		11
<i>Patents Regulations 1991</i>		11
Part 6—Fees		12
<i>Patents Regulations 1991</i>		12
Part 7—Extension of time for acceptance		13
<i>Patents Regulations 1991</i>		13
Part 8—Application, transitional and saving provisions		14
<i>Patents Regulations 1991</i>		14

EXPOSURE DRAFT

1 Name

This instrument is the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018*.

2 Commencement

- (1) Each provision of this instrument specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.

Commencement information		
Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
1. Sections 1 to 4 and anything in this instrument not elsewhere covered by this table	The day after this instrument is registered.	
2. Schedule 1, Part 1	Immediately after Part 2 of Schedule 1 to the <i>Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2018</i> commences.	
3. Schedule 1, Parts 2 and 3	The day after this instrument is registered.	
4. Schedule 1, Part 4	Immediately after Schedule 8 to the <i>Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2018</i> commences.	
5. Schedule 1, Parts 5 to 8	The day after this instrument is registered.	

Note: This table relates only to the provisions of this instrument as originally made. It will not be amended to deal with any later amendments of this instrument.

- (2) Any information in column 3 of the table is not part of this instrument. Information may be inserted in this column, or information in it may be edited, in any published version of this instrument.

3 Authority

This instrument is made under the following:

- (a) the *Designs Act 2003*;
- (b) the *Patents Act 1990*.

4 Schedules

Each instrument that is specified in a Schedule to this instrument is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this instrument has effect according to its terms.

EXPOSURE DRAFT

Schedule 1 Amendments
Part 1 Innovation patents

Schedule 1—Amendments

Part 1—Innovation patents

Patents Regulations 1991

1 At the end of subregulation 3.2B(1)

Add:

- (i) if the application was converted from an application for a standard patent to an application for an innovation patent—the request to amend the patent request to convert the application was filed on a day that is before the day the term of the innovation patent, if granted, would have expired;
- (j) if the application is a divisional application under section 79B of the Act—the divisional application was filed on a day that is before the day the term of the innovation patent, if granted, would have expired;
- (k) the requirement specified in subsection 52(3) of the Act.

Note 1: Subsection 52(3) of the Act provides that it is a requirement of the formalities check that the date of the patent (if granted) would be a date before the day that subsection commences. Subsection 52(3) was inserted by the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Act 2018*.

Note 2: For the date of the patent, see section 65 of the Act and regulation 6.3.

2 Subregulation 3.2B(2)

Omit “or (h)”, substitute “, (h) or (k)”.

3 At the end of regulation 10.2B

Add:

- (8) An amendment of a patent request is not allowable if:
 - (a) the amendment would convert the patent application from an application for a standard patent to an application for an innovation patent; and
 - (b) the date of the patent (if granted) would be a date on or after the day this subregulation commences.

Note 1: This subregulation was inserted by the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018*.

Note 2: For the date of the patent, see section 65 of the Act and regulation 6.3.

4 Before paragraph 22.11(4)(a)

Insert:

- (aa) filing of a request for an amendment to convert an application from an application for a standard patent to an application for an innovation patent on a day that is on or after the day the term of the innovation patent, if granted, would have expired;
- (ab) filing of a divisional application under section 79B of the Act for an innovation patent on a day that is on or after the day the term of the innovation patent, if granted, would have expired;

Part 2—Crown use

Patents Regulations 1991

5 Regulation 3.25E (heading)

Repeal the heading, substitute:

3.25E Grant of certification—exploitation for Crown purposes

6 Paragraph 3.25E(a)

Repeal the paragraph, substitute:

- (a) the person making the request is authorised by a relevant authority, under subparagraph 160A(1)(b)(ii) of the Act, to exploit the invention for the services of the relevant authority; and

7 Regulation 17.1

Repeal the regulation.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 3 Compulsory licences

Part 3—Compulsory licences

Patents Regulations 1991

8 Paragraph 3.25D(a)

Omit “to work”, substitute “to exploit”.

9 Subparagraph 12.1(2)(a)(iv)

Repeal the subparagraph, substitute:

- (iv) if the applicant relies on the ground mentioned in paragraph 133(2)(a) of the Act—facts supporting the making of the order, having regard to the matters mentioned in paragraphs 133(3)(a), (b) and (e) of the Act; and

Part 4—Translations

Patents Regulations 1991

10 Regulation 1.7

Repeal the regulation.

11 Paragraph 2.7(b)

Repeal the paragraph, substitute:

- (b) if the document is not in English, a copy of a translation of the document into English; and

12 Subparagraph 3.1(2)(c)(iii)

Omit “and a related certificate of verification”.

13 Paragraph 3.2C(2)(aa)

Omit “relates; and”, substitute “relates.”.

14 Paragraph 3.2C(2)(b)

Repeal the paragraph.

15 Paragraph 3.2C(7)(a)

Repeal the paragraph, substitute:

- (a) a reference in this regulation to subsection 29A(5) of the Act is taken to be a reference to subsection 89(3) of the Act, as in force immediately before 15 April 2013; and

16 Subparagraph 3.5A(3)(b)(iii)

Omit “together with a related certificate of verification”.

17 Subparagraph 3.5AB(2)(b)(ii)

Repeal the subparagraph, substitute:

- (ii) if the application is not filed in English and has not been published in English under Article 21 of the PCT—a translation into English of the specification of the PCT application as filed (with or without any rectifications under Rule 91 of the PCT) has been filed; and

18 Subregulation 3.5AC(3)

Omit “If”, substitute “Subject to subregulation (3A), if”.

19 After subregulation 3.5AC(3)

Insert:

Translation of Article 19 amendment into English

(3A) If:

- (a) a PCT application was amended under Article 19 of the PCT; and

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Translations

- (b) the application was amended before the applicant met the requirements of subsection 29A(5) of the Act; and
 - (c) the amendment has not been published in English under Article 21 of the PCT; and
 - (d) a translation of the amendment into English is filed no later than when the applicant meets the requirements of subsection 29A(5) of the Act;
- the description, drawings and claims contained in the application are taken to have been amended on the day the translation of the amendment into English was filed.

20 Subregulation 3.5AC(5)

Omit “If”, substitute “Subject to subregulation (5A) and (6), if”.

21 After subregulation 3.5AC(5)

Insert:

Translation of Article 34 amendment into English

(5A) If:

- (a) a PCT application in respect of which Australia has been elected under Chapter II of the PCT has been amended under Article 34 of the PCT; and
 - (b) an international preliminary examination report is established before the applicant meets the requirements of subsection 29A(5) of the Act; and
 - (c) the amendment has not been published in English under Article 21 of the PCT; and
 - (d) a translation of the amendment into English is filed no later than when the applicant meets the requirements of subsection 29A(5) of the Act;
- the description, drawings and claims contained in the application are taken to have been amended on the day the translation of the amendment into English was filed.

22 At the end of regulation 3.5AC

Add:

Correction of incorrect translations

- (8) If the applicant for a PCT application becomes aware of an error or omission in the translation of an amendment mentioned in subregulation (3A) or (5A), the applicant may file a corrected translation of the amendment.
- (9) If the Commissioner becomes aware of an error or omission in the translation of an amendment mentioned in subregulation (3A) or (5A), the Commissioner may, by notification to the applicant, require the applicant to file a corrected translation of the amendment.
- (10) If an applicant is given a notification under subregulation (9), the applicant must comply with the notification within 2 months after the day the notification is given.
- (11) For the purposes of paragraph 142(2)(f) of the Act, a PCT application lapses if:

- (a) the applicant for the PCT application is given a notification under subregulation (10); and
- (b) the applicant does not comply with the notification within the period required by subregulation (10).

Effect of corrections

- (12) The filing of a corrected translation of an amendment of a PCT application in accordance with this regulation is not an amendment for the purposes of subsection 29A(3) of the Act.

23 After subregulation 3.5AF(2)

Insert:

Translations not published under Article 21 of PCT

- (2A) Subregulations (2B), (2C) and (2D) apply if:
 - (a) a PCT application is not filed in English; and
 - (b) the PCT application has not been published in English under Article 21 of the PCT.
- (2B) For the purposes of paragraph 29A(5)(a) of the Act, the requirement to file a translation of the PCT application into English is met if the applicant files a translation into English of the specification of the PCT application as filed (with or without any rectifications under Rule 91 of the PCT).

Correction of incorrect translations

- (2C) If the applicant for the PCT application becomes aware of an error or omission in the translation of the specification, the applicant may file a corrected translation of the specification.
- (2D) If the Commissioner becomes aware of an error or omission in the translation of the specification, the Commissioner may, by notification to the applicant, require the applicant to file a corrected translation of the specification.
- (2E) If an applicant is given a notification under subregulation (2D), the applicant must comply with the notification within 2 months after the day the notification is given.
- (2F) For the purposes of paragraph 142(2)(f) of the Act, a PCT application lapses if:
 - (a) the applicant for the PCT application is given a notification under subregulation (2E); and
 - (b) the applicant does not comply with the notification within the period required by subregulation (2E).

Effect of corrections

- (2G) An error or omission in a translation of a specification of a PCT application, or the filing of a corrected translation of a specification of a PCT application, does not have the effect that the requirements of subsection 29A(5) of the Act have not been met in relation to the application.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Translations

- (2H) The filing of a corrected translation of a specification of a PCT application in accordance with this regulation is not an amendment for the purposes of subsection 29A(3) of the Act.

24 Subregulation 3.5AF(4)

Omit “this regulation”, substitute “subregulations (1) and (3)”.

25 Paragraph 3.14D(1)(e)

Omit “and a certificate of verification of the translation”.

26 Paragraph 3.23(1)(c)

Omit “and a related certificate of verification”.

27 Paragraph 9.2(3)(b)

Omit “and a related certificate of verification”.

28 Paragraph 13.4(1)(b)

Repeal the paragraph, substitute:

- (b) if examination is requested on or after 15 April 2013 and paragraph (c) does not apply—12 months from the date of the first report (if any) under section 45 of the Act;
- (c) if:
 - (i) examination is requested on or after 15 April 2013; and
 - (ii) the applicant is notified under subregulation 3.5AC(9) or 3.5AF(2D) in relation to the application; and
 - (iii) the applicant complies with the notification within the period required by the relevant subregulation;
14 months from the date of the first report (if any) under section 45 of the Act;

29 Subparagraph 22.15(3)(b)(ii)

Repeal the subparagraph, substitute:

- (ii) if required by regulation 22.15A—a related certificate of verification.

30 After regulation 22.15

Insert:

22.15A Certificate of verification

- (1) This regulation applies if:
 - (a) a translation of a document into English is filed; and
 - (b) the Commissioner reasonably believes that the translation does not accurately reflect the contents of the document.
- (2) The Commissioner may, by notification given to the person who filed the document, require the person to file a certificate of verification for the translation within 2 months after the day the notification is given to the person, or such longer period as the Commissioner allows.

- (3) If:
- (a) the notification is given in relation to an application for a standard patent; and
 - (b) the person to whom the notification is given is the applicant for the standard patent; and
 - (c) the person does not comply with the notification within the period specified in subregulation (2); and
 - (d) the application for the standard patent has not been accepted;
- the application for the standard patent lapses at the end of that period.
- (4) If an application lapses under subregulation (3), the Commissioner must:
- (a) advertise that fact in the *Official Journal*; and
 - (b) notify the applicant that the application has lapsed.
- (5) If:
- (a) the notification is given in relation to a translation filed as part of a notice of an assertion under subsection 27(1) or 28(1) of the Act; and
 - (b) the person to whom the notification is given does not comply with the notification within the period specified in subregulation (2);
- the Commissioner may take that fact into account in deciding how much weight (if any) to give to the notice of the assertion.
- (6) If:
- (a) the notification is given in relation to a translation filed as part of a request for re-examination of a complete specification; and
 - (b) the person to whom the notification is given does not comply with the notification within the period specified in subregulation (2);
- the Commissioner may decide not to re-examine the complete specification.
- (7) If:
- (a) the notification is given in relation to a translation of any other document; and
 - (b) the person to whom the notification is given does not comply with the notification within the period specified in subregulation (2);
- the Commissioner may take one or more of the actions listed in subregulation (8) in relation to the person if the Commissioner is satisfied, on the balance of probabilities, that it is appropriate in the circumstances to take the action.
- (8) The actions the Commissioner may take are:
- (a) if the person to whom the notification is given is an applicant for a patent—a refusal to grant the patent; or
 - (b) the drawing of an inference unfavourable to the person’s interest in proceedings before the Commissioner.
- (9) In deciding whether it is appropriate to take the action, the Commissioner must consider the following:
- (a) whether the person has a reasonable excuse for refusing or failing to comply with the notification;
 - (b) any other matter the Commissioner considers to be relevant.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 4 Translations

31 After subparagraph 22.26(2)(a)(va)

Insert:

(vb) subregulation 22.15A(2) (certificate of verification);

Part 5—Delegation

Designs Regulations 2004

32 Regulation 10.01

Before “For”, insert “(1)”.

33 At the end of regulation 10.01

Add:

- (2) The Registrar may delegate all or any of the Registrar’s powers or functions under paragraph 127(1)(a) or (c) of the Act to an employee of the Designs Office who holds or performs the duties of an Executive Level 1 position, or an equivalent or higher position.

Patents Regulations 1991

34 Regulation 21.2

Before “For”, insert “(1)”.

35 Regulation 21.2

Omit “210(a) and (c)”, substitute “210(1)(a) and (c)”.

36 At the end of regulation 21.2

Add:

- (2) The Commissioner may delegate all or any of the Commissioner’s powers or functions under paragraph 210(1)(a) or (c) of the Act to an employee of the Patent Office who holds or performs the duties of an Executive Level 1 position, or an equivalent or higher position.

Note: Under paragraphs 210(1)(a) and (c) of the Act, the Commissioner may summon witnesses and require the production of documents or articles.

EXPOSURE DRAFT

Schedule 1 Amendments

Part 6 Fees

Part 6—Fees

Patents Regulations 1991

37 Clause 4 of Schedule 7 (cell at table item 404, column 2)

Repeal the cell, substitute:

The international filing fee (where applicable, as reduced under item 403) and the handling fee are reduced in accordance with item 5 of the Schedule of Fees set out in the PCT.

Part 7—Extension of time for acceptance

Patents Regulations 1991

38 Paragraph 13.4(1)(f)

Repeal the paragraph, substitute:

- (f) if a person has applied under subsection 36(1) of the Act for a declaration in relation to the patent request and complete specification—subject to subregulation (3), the period of 3 months from the day the Commissioner decides to make a declaration, or to refuse to make a declaration;

EXPOSURE DRAFT

Schedule 1 Amendments

Part 8 Application, transitional and saving provisions

Part 8—Application, transitional and saving provisions

Patents Regulations 1991

39 In the appropriate position in Chapter 23

Insert:

Part 5—Amendments made by the Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018

23.50 Application of amendments

- (1) The amendments of regulation 3.25E made by Part 2 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018* apply in relation to requests made after the commencement of that Part.
- (2) The repeal of regulation 17.1 made by Part 2 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018* does not apply in relation to applications made before the commencement of that Part.
- (3) The amendment of regulation 3.25D made by Part 3 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018* applies in relation to orders made after the commencement of that Part.
- (4) The amendment of regulation 12.1 made by Part 3 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018* applies in relation to applications made after the commencement of that Part.
- (5) Subject to subregulation (6), the amendments of these Regulations made by Part 4 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018* apply in relation to translations filed after the commencement of that Part.
- (6) The amendments of regulation 3.5AF made by Part 4 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018* apply in relation to applications that meet the requirements of subsection 29A(5) of the Act after the commencement of that Part.
- (7) The amendment of regulation 13.4 made by Part 7 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018* applies in relation to:
 - (a) applications made after the commencement of that Part; and

EXPOSURE DRAFT

Amendments **Schedule 1**
Application, transitional and saving provisions **Part 8**

(b) applications made but not decided before that commencement.

EXPOSURE DRAFT