



Australian Government

IP Australia

Discovery House, Phillip ACT 2606

PO Box 200, Woden ACT 2606

Australia

Phone: 1300 651 010

International Callers: +61-2 6283 2999

Facsimile: +61-2 6283 7999

Email: [assist@ipaustralia.gov.au](mailto:assist@ipaustralia.gov.au)

Website: [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

Published online on 18 October 2007

### Official Notice

## **Changes to regulations made under sections 27(1), 45(3) and 101D of the *Patents Act 1990***

The following official notice is about amendments to the regulations made under sections 27(1), 45(3) and 101D of the *Patents Act 1990*. With effect from 22 October 2007, the amendment regulations substantially remove the requirement for applicants and patentees to inform the Commissioner of Patents of the results of documentary searches by, or on behalf of, foreign patent offices. The amendment regulations also allow notices of matters affecting the validity of a standard patent to be filed up to three months from the date of advertisement of acceptance of an application.

On 16 May 2007, IP Australia published a [consultation paper](#) seeking views on proposed changes to regulations made under subsection 45 (3) and section 101D of the *Patents Act 1990* (Cth). An overview of the submissions, and IP Australia's position on some of the issues raised, has been published. See [What's New](#).

As a result of the generally favourable nature of the feedback received, the *Patents Regulations 1991* (Cth) have been amended to substantially remove the requirement to inform the Commissioner of Patents (the Commissioner) of the results of documentary searches by, or on behalf of, foreign patent offices. The amending legislation, the *Patents Amendment Regulations 2007 (No. 1)* (Cth), commences on 22 October 2007.

In general, from 22 October 2007, there will no longer be an obligation to inform the Commissioner of the results of documentary searches. The only exception to this is that, if the final date by which an applicant or patentee was required to inform the Commissioner of the results of a search under the regulations was before 22 October 2007, and the Commissioner was not informed of the results of the search by that final date, the results of that search remains outstanding. The amending legislation does not excuse any past failure to comply with the disclosure obligations.

In addition, it is now possible to file notices under subsection 27 (1) of the *Patents Act* up to three months from the date of advertisement of acceptance, rather than up to the date of acceptance, as was previously the case.

A detailed explanation of the operation of the provisions follows.

## **1. Provisions affecting information relating to search results**

### **1.1 Effect of the amending legislation**

Under the amending legislation, all documentary searches are prescribed on the following applications and patents, so that there is no obligation to inform the Commissioner of the results of any documentary searches:

- for standard patents—if the request for examination was made on or after 22 October 2007;
- for innovation patents—if the Commissioner decides to examine, or if the patentee or any other person requests examination of, the specification on or after 22 October 2007.

Otherwise, if the final date for informing the Commissioner of the results of a search (see below) occurs on or after 22 October 2007, the search is prescribed, so that information does not have to be provided to the Commissioner.

However, if this final date occurred prior to 22 October 2007, and the Commissioner was not informed of the results of the search, practitioners should note that the amending legislation does not affect the existing obligation to inform the Commissioner of the results of the search.

### **1.2 Operation of the provisions**

Subsection 45 (3) of the *Patents Act 1990* requires applicants to inform the Commissioner, in accordance with the regulations, of the results of a range of foreign patent office searches. Regulation 3.17A of the *Patents Regulations 1991* prescribes the manner in which applicants are required to inform the Commissioner of the results of searches. Under paragraph 45 (3) (a) of the Patents Act, the requirement does not apply to searches prescribed in the regulations. Regulation 3.17B of the Patents Regulations prescribes the searches in respect of which applicants are not required to inform the Commissioner. Section 101D of the Patents Act and regulations 9A.2A and 9A.2B of the Patents Regulations provide similar requirements for innovation patents.

Subregulations 3.17A (4), 3.17A (5) and 9A.2A (2) of the Patents Regulations prescribe the time by which applicants and patentees are required to inform the Commissioner of the results of documentary searches. These provisions effectively specify the latest date by which an applicant or patentee is able to inform the Commissioner of the results of a documentary search, although applicants and patentees are free to inform the Commissioner prior to this date. In some cases, an application must be made and an appropriate fee paid in order for an applicant to avail themselves of the latest possible time by which to inform the Commissioner (subregulations 3.17A (5) to (7) of the Patents Regulations).

If an applicant or patentee fails to inform the Commissioner of the results of the documentary searches, the provisions of subsection 102 (2C) apply, and a patentee might be prevented from making certain amendments to their patent, potentially jeopardising its validity.

#### **1.2.1 Requests for examination made on or after 22 October 2007**

All documentary searches are prescribed on the following applications and patents, so that there is no obligation to inform the Commissioner of the results of any documentary searches:

- for standard patents—if the request for examination was made on or after 22 October 2007 (new subregulation 3.17B (3));
- for innovation patents—if the Commissioner decides to examine, or if the patentee or any other person requests examination of, the specification on or after 22 October 2007 (new subregulations 9A.2B (3) and (5)).

### 1.2.2 Requests for examination made prior to 22 October 2007

For applications for *standard patents*—if the request for examination was made prior to 22 October 2007—a documentary search, of which the applicant has not already informed the Commissioner, is prescribed (so that information need not be given to the Commissioner) if the latest of the following dates had not occurred prior to 22 October 2007:

- the day six months after the search was completed (new subparagraph 3.17B (2) (c) (i)); or
- the day six months after the applicant asked for examination (new subparagraph 3.17B (2) (c) (ii)); or
- the day three months after a notice of acceptance was published (new subparagraph 3.17B (2) (c) (iii)).

For *innovation patents*—if the Commissioner decided to examine an innovation patent prior to 22 October 2007—a documentary search, of which the patentee has not already informed the Commissioner, is prescribed (so that information need not be given to the Commissioner) if the latest of the following dates had not occurred prior to 22 October 2007:

- the day three months after the search was completed (new subparagraph 9A.2B (2) (d) (i)); or
- the day three months after the Commissioner told the patentee about the decision to examine (new subparagraph 9A.2B (2) (d) (i)).

For *innovation patents*—if the patentee or another person asked for examination prior to 22 October 2007—a documentary search, of which the patentee has not already informed the Commissioner, is prescribed (so that information need not be given to the Commissioner) if the latest of the following dates had not occurred prior to 22 October 2007:

- if the patentee asked for the examination – the day three months after the search is completed (new paragraph 9A.2B (4) (d)); or
- if a person other than the patentee asked for the examination – the later of the following dates:
  - o the day three months after the documentary search is completed (new subparagraph 9A.2B (4) (e) (i)); or
  - o the day on which the patentee paid their portion of the examination fee (new subparagraph 9A.2B (4) (e) (ii)).

### **1.3 Failure to inform the Commissioner of the results of searches before 22 October 2007**

Please note if the latest of the relevant dates for providing the results of a search was *prior to* 22 October 2007, and the Commissioner had not been informed of the results of that search, the applicant or patentee must *still inform the Commissioner of the search results*. This will be so, unless the search happens to be prescribed by *other* provisions in the Patents Regulations—i.e. in subregulations 3.17B (1) and 9A.2B (1). If the search is not prescribed in subregulations 3.17B (1) and 9A.2B (1) of the Patents Regulations, the applicant or patentee will, on 22 October 2007, already have failed to inform the Commissioner of the results within the relevant prescribed latest time. The consequences of subsection 102 (2C) of the Patents Act will apply, unless the applicant or patentee successfully applies for an extension of time under section 223 of the Patents Act to inform the Commissioner. Any such application must be accompanied by the appropriate fees.

## 2. Time for lodging notices under section 27 of the Patents Act

Under subsection 27 (1) of the Patents Act, a person may notify the Commissioner of matters affecting the validity of a standard patent. This notice must be filed within the period prescribed in the regulations. Prior to commencement of the amending legislation, regulation 2.5 of the Patents Regulations prescribed this period as commencing on the day when the specification becomes open to public inspection, and ending immediately before acceptance. Also, subregulation 3.18 (4) of the Patents Regulations provided that the Commissioner must consider a notice filed under subsection 27 (1) of the Patents Act for the purposes of examination of the patent request and complete specification.

The amending legislation amends regulation 2.5 of the Patents Regulations, to provide that the period for filing a notice under subsection 27 (1) of the Patents Act now ends three months after the date of publication of the notice of acceptance. This extends the time in which such notices may be filed.

The amending legislation also amends subregulation 3.18 (4) of the Patents Regulations to provide that the Commissioner is only obliged to consider a notice filed under subsection 27 (1) of the Patents Act for the purposes of examination of the application if that notice was filed prior to acceptance. If a notice is filed after acceptance, it may instead form the basis of a pre-grant re-examination under subsection 97 (1) of the Patents Act.

The aim of this amendment is to increase the validity of granted patents. It is a means for any interested party to bring relevant material to the attention of the Commissioner. Although under this amendment a notice under subsection 27 (1) of the Patents Act can now be filed after acceptance, and in fact within the period in which a notice of opposition is able to be filed, this is not intended to be a substitute for interested parties instigating post-acceptance opposition proceedings.

It should be emphasised that re-examination prior to grant is at the discretion of the Commissioner. The Commissioner may elect *not* to re-examine an application, even although material has been filed under subsection 27 (1) of the Patents Act after acceptance. The notifier has no means of mandating that the Commissioner conduct re-examination. Also, unlike an opposition, re-examination is an *ex parte* proceeding. The person filing the notice has no further right or opportunity to make submissions in relation to the material filed, and no standing to appeal from, or to challenge, the Commissioner's decision. Nor can they provide the Commissioner with witness statements or other evidence to assist consideration of the notified material.

There is no fee for filing a notice under subsection 27 (1) of the Patents Act. Nor is there a fee for a re-examination under subsection 97 (1) of the Patents Act. IP Australia will monitor the use of post-acceptance notices filed under subsection 27 (1) of the Patents Act to ensure that this policy aim is achieved.

To view the regulations, see [www.comlaw.gov.au](http://www.comlaw.gov.au).

**Contact:** IP Australia  
**Phone:** 1300 651 010  
**Fax:** +61 2 6283 7999  
**E-mail:** [assist@ipaaustralia.gov.au](mailto:assist@ipaaustralia.gov.au)  
**Web:** [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

For publication in the *Australian Official Journal of Patents* on 1 November 2007