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Official Notice

Amendments to Patents Regulations 2004

On 25 November 2009, the Federal Executive Council made the *Intellectual Property Law Amendment Regulations 2009 (No.2)* (the IP Regulations). The IP Regulations will shortly be registered on the Federal Register of Legislative Instruments and copies will be available from the ComLaw website (www.comlaw.gov.au).

Amongst other matters, the IP Regulations will amend the *Patents Regulations 1991* (the Patents Regulations) to:

- facilitate the operation of the *Patents Act 1990* (the Patents Act) by enabling the Commissioner of Patents (the Commissioner) to fully participate in electronic document transfer arrangements
- clarify the formality requirements that generally apply to the filing of applications and requests with IP Australia—especially the need to supply key pieces of information
- enable the publishing of a substantial majority of search results filed under subsection 45(3) of the Patents Act from the date of commencement of the IP Regulations
- repeal a specific provision relating to electronic communications that is generally provided for under the *Electronic Transactions Act 1999*.

In detail the IP Regulations will amend the Patents Regulations by:

- Facilitating electronic document transfer arrangements—specifically:
 - Amending subregulation 1.3 (1) to add a definition for ***approved digital library***. The Commissioner will be able to approve a digital library by listing it in the Official Journal.
 - Amending the heading of regulation 1.6 to indicate its general applicability.
 - Inserting new regulation 1.6A to facilitate the operation of section 8 of the Patents Act through the use of approved digital libraries. The Commissioner can treat a patent document that the applicant has made available to the Commissioner via an approved digital library as though the document had been filed directly with the Commissioner by the applicant. Applicants will still be able to file copies of patent documents under the existing provisions if they so choose.
 - Amending regulation 3.22 to enable the Commissioner to give information and documents relating to patent applications that have become open to public inspection (OPI) to the International Bureau or a foreign patent office. The applicant's consent will still be required for the disclosure of applications, documents and information that is not OPI.

- Amending the heading of regulation 8.6 to indicate its general applicability.
- Inserting new regulation 8.6A to facilitate the operation of section 95 of the Patents Act through the use of approved digital libraries.
- Clarify the formality requirements—specifically:
 - Inserting new regulation 1.8 providing for the general requirements for the filing of applications and requests either in paper form (subregulation 1.8 (1)) or by using an electronic process (subregulation 1.8 (2)). These requirements include complying with directions and providing mandatory information.
 - Amending the wording of regulation 3.2A so that the formality requirements for making an application for a standard patent—including the patent request being in the approved form—are aligned with the formality requirements that currently apply for applications for innovation patents as set out in regulation 3.2B. If applicants for standard patents do not comply with the amended requirements, then their application will lapse.
 - Amending the definition of *document* for the purposes of regulation 22.16 as a consequence of the amended formality requirements set out in regulation 3.2A.
 - Amending the heading of Schedule 3 to the Patents Regulations to include reference to the amended formality requirements set out in regulation 3.2A.
- Repealing paragraph 4.3 (1) (d) so that the substantial majority of search results filed under subsection 45(3) of the Patents Act become OPI from the date of commencement of the IP Regulations. Following the amendment, if an applicant chooses to file search results which are associated with a case-file that is OPI, then the search results will be made OPI from the date that they are added to the case-file. If the associated case-file is not OPI, then the search results will be OPI from the date that the case-file is made OPI. It is intended that search results on case-files that are OPI—but have not been accepted—before the commencement date of the IP Regulations will be made OPI on the commencement date.
- Repealing regulation 22.8A which provides for facsimile transmission as a means of filing documents.

The amendments to the Patents Regulations will commence on 12 December 2009.

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