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Official Notice

Amendment to the Patents Regulations and Patents Act concerning National Phase Entry and the effect of amendments made under the PCT

Amendments to the Patents Regulations have been made and are expected to come into effect on 23rd December 2004. This notice provides an overview of the amendments.

The primary purpose of these amendments is to change the way amendments to a PCT application are treated as amendments to the Australian application. The need for these changes arises as a result of the frequent occurrence of late receipt of International Preliminary Examination Reports under Chapter II of the PCT (IPER). The late receipt has led to difficulties where at times the examiner does not know what the content of the specification is; concern by applicants with examination commencing without the IPER; and serious issues of uncertainty when an application is accepted based on a set of claims when there are later amendments under Art. 34 of the PCT.

The primary change introduced by these amendments to the Regulations is that amendments made under Art.34 of the PCT are treated as being part of the Australian specification only if the IPER is established before national phase entry in Australia. Similarly, amendments under Art. 19, and rectifications under Rule 91 are treated as being part of the Australian specification only if they are made before national phase entry in Australia.

Despite these changes, there will be situations where the examiner is aware that Preliminary Examination has been Demanded, but is unable to determine whether an IPER was established before national phase entry. [And for existing applications where Preliminary Examination has been Demanded but the Commissioner has not been able to obtain a copy of the IPER, the examiner is unable to determine the content of the specification.] The secondary change introduced by these amendments to the Regulations is to provide a statutory basis for the Examiner to raise an objection in these circumstances, and to provide options for the applicant to deal with the situation – including abandonment of any Art. 34 amendments.

Finally, the regulations have been amended to exclude the possibility of withdrawal of an Innovation Patent application in the period between acceptance and grant (to avoid administrative difficulties that arise if withdrawal occurs in that period), and to provide for AAT review of decisions to correct the Register or a Patent under regulation 10.7.

It should be noted that these regulations have the effect of amending certain provisions of the *Patents Act 1990* – under the regulation making power of s.228(2)(t). Practitioners need to be aware that not all consolidations include the amendments effected by way of the regulations – depending on the source of the consolidation. Sections of the Act that are amended in some manner by the Regulations include sections 45, 48, 53, 89, 90, 92, 141, 142, and 223.

The following is a more detailed summary of the changes to the legislation and their practical impact.

Amendment of s.89 of the Act

Section 89 of the Act has been amended to alter the basis on which amendments under Arts 19 and 34, and rectifications under Rule 91, are treated as being part of the Australian complete specification.

1. Amendments made under Art. 19 or Rule 91 of the PCT are only taken to be part of the Australian complete specification if the amendments were made before national phase entry occurred. S.89(5)(b) is deleted, with Art. 34 amendments now being dealt with in new ss.89(6) and (7).
2. A new s.89(6) has been added. It sets the general rule that amendments under Art.34 of the PCT are only taken to be part of the Australian complete specification if the International Preliminary Examination Report [IPER] is *established* before national phase entry occurred. Note that the date of filing the Article 34 amendments is not relevant – as is the possibility that some were made before national phase entry, and others made after national phase entry. The determining date is the date of establishment of the IPER – which is specified in the IPER.
3. A new s.89(7) has been added to provide that the Art. 34 amendments do not apply to the Australian complete specification if the applicant, in certain circumstances, abandons those amendments. A precondition for the applicant abandoning Art. 34 amendments is the existence of an examiner's objection relating to the unavailability of the IPER – either during examination under s.45 or 48, or in consideration of amendments under s.104.

These amendments apply to all PCT applications that enter the national phase on or after the commencement date.

NOTE: Applications filed in a foreign language are required to have a translation to enter the national phase [s.89(3)(a)]. For applications that enter the national phase after the commencement of these regulations, there can be no possibility of amendments being made after national phase entry having the effect of amending the Australian complete specification. Consequently the translation of the specification filed for national phase entry is the current Australian complete specification by reason of s.89(4) – irrespective of any Art. 19 or Art. 34 amendments, or rectifications under Rule 91. However, this is NOT the case for applications that have entered the national phase before the commencement of these regulations, where due account must be taken of any Art. 19 or Art 34 amendments, or rectifications under Rule 91, that occur after national phase entry.

Amendment of s.45 and 48 of the Act, and of Regulation 10.2

Situations can arise where the Commissioner is aware of the possibility of a Preliminary Examination Report having been established, but where the Commissioner is unable to obtain a copy of that report to ascertain whether any Art. 34 amendments were made, or whether (in the context of the new regime) that report was established before national phase entry. Sections 45 and 48, and Regulation 10.2, have been amended to allow the Commissioner to formally raise this as an objection.

The pre-conditions for the examiner raising an objection are as follows:

For non-expedited examination (both Full and Modified):

- A Demand under the PCT was filed before national phase entry;
- At least 3 months after national phase entry, the Commissioner asks the International Bureau for a copy of the IPER; and
- The International Bureau advises that the IPER is not available.
[s.45(1AA), 48(1AA)]

For Expedited examination:

- If the Commissioner does not have a copy of the IPER [s.45(1AB), 48(1AB)]

NOTE: Practitioners requesting examination be expedited on a PCT application in the national phase should consider including the information referred to in s.45(1AC) or 48(1AC) at the time of making that request.

For voluntary amendments before examination:

- If the Commissioner does not have a copy of the IPER [R. 10.2(1)(c)]

Where the examiner reports on the non-availability of the IPER, the objection can be overcome as follows:

- Provide a copy of the IPER (including any Art. 34 amendments)
- Advise that no Demand was made under Art. 31
- Advise that no amendments were made under Art. 34; or
- Advise that the Demand was filed, or the IPER established, after national phase entry
- Elect to abandon any amendments that may have been made under Art. 34 [s.45(1AC), 48(1AC), r.10.2(3)]

These amendments apply to all existing applications that had not been accepted prior to the commencement date.

Practical affect of the amendments

These amendments are intended to remove uncertainty about the content of a PCT national phase application when it is examined, as well as uncertainties that could arise if Art. 19 or Art. 34 amendments were made after the Australian complete application had been examined and accepted.

There is a significant backfile of applications where the Commissioner is aware that a Demand has been filed, but has been unable to obtain a copy of an IPER. For all applications that have entered the national phase before the commencement date, amendments made under Art. 34 will continue to amend the Australian complete specification – even if made after national phase entry. The Commissioner anticipates issuing examination reports for this backfile in the New Year. In practical terms, for such cases applicants will need to either:

- Provide a copy of the IPER (including any Art. 34 amendments)
- Advise that no amendments were made under Art. 34; or
- Elect to abandon any amendments that may have been made under Art. 34

Practitioners are advised, with respect to the option to abandon amendments, that while s.89(7) only applies to applications that enter the national phase after the commencement date, a request to abandon any amendments made under Art. 34 for ‘backfile’ applications will be treated as a request under s.104 having the same effect.

Other amendments

Two other amendments of a procedural nature are also made:

- New regulation 13.1B precludes withdrawal of an application for an innovation patent in the period between acceptance and grant.

- Regulation 22.26(2)9a)(vaa) has been added to allow application for review by the Administrative Appeals Tribunal of decisions to amend the Register.

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