



Patents Amendment Act 2001

No. 160, 2001



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An Act to amend the *Patents Act 1990*, and for related purposes

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No. 160, 2001

An Act to amend the *Patents Act 1990*, and for related purposes

[Assented to 1 October 2001]

The Parliament of Australia enacts:

1 Short title

This Act may be cited as the *Patents Amendment Act 2001*.

2 Commencement

- (1) Subject to this section, this Act commences on the day on which it receives the Royal Assent.
- (2) Subject to subsection (3), Schedule 1 commences on a day to be fixed by Proclamation.

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- (3) If Schedule 1 does not commence under subsection (2) within the period of 6 months beginning on the day on which it receives the Royal Assent, it commences on the first day after the end of that period.
 - (4) Schedule 2 is taken to have commenced immediately after the commencement of the *Patents Amendment (Innovation Patents) Act 2000*.

3 Schedule(s)

Subject to section 2, each Act that is specified in a Schedule to this Act is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this Act has effect according to its terms.

Schedule 1—Amendments commencing on Proclamation

Part 1—Amendments relating to novelty, inventive step and innovative step

Patents Act 1990

1 Paragraph 7(1)(b)

Omit “in the patent area”.

3 Subsection 7(2)

Omit all the words from and including “either” to the end of the subsection, substitute “.”.

4 Subsection 7(3)

Repeal the subsection, substitute:

(3) The information for the purposes of subsection (2) is:

- (a) any single piece of prior art information; or
- (b) a combination of any 2 or more pieces of prior art information;

being information that the skilled person mentioned in subsection (2) could, before the priority date of the relevant claim, be reasonably expected to have ascertained, understood, regarded as relevant and, in the case of information mentioned in paragraph (b), combined as mentioned in that paragraph.

6 Paragraph 7(5)(b)

Omit “in the patent area”.

7 Subsection 45(1A)

Omit “anywhere in the patent area”, substitute “(whether in or out of the patent area)”.

8 Subsection 48(1A)

Omit “anywhere in the patent area”, substitute “(whether in or out of the patent area)”.

Schedule 1 Amendments commencing on Proclamation

Part 1 Amendments relating to novelty, inventive step and innovative step

9 Subsection 98(2)

Omit “anywhere in the patent area”, substitute “(whether in or out of the patent area)”.

10 Subsection 101B(3)

Omit “anywhere in the patent area”, substitute “(whether in or out of the patent area)”.

11 Subsection 101G(5)

Omit “anywhere in the patent area”, substitute “(whether in or out of the patent area)”.

12 Schedule 1 (subparagraph (a)(ii) of the definition of *prior art base*)

Omit “in the patent area”, substitute “, whether in or out of the patent area”.

13 Application

The amendments made by this Part apply in relation to:

- (a) patents for which the complete application is made on or after the day on which this Schedule commences; and
- (b) the making of complete applications for patents on or after the day on which this Schedule commences.

Part 2—Other amendments

Patents Act 1990

14 Subsection 45(3)

Repeal the subsection, substitute:

- (3) The applicant must inform the Commissioner, in accordance with the regulations, of the results of any documentary searches, whether conducted in Australia or elsewhere, for the purposes of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside Australia that are carried out by or on behalf of the applicant, or the applicant's predecessor in title, prior to the grant of the patent.

15 Subsection 49(1)

Repeal the subsection, substitute:

- (1) Subject to section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent, if:
 - (a) the Commissioner is satisfied that the invention, so far as claimed, satisfies the criteria mentioned in paragraph 18(1)(b); and
 - (b) the Commissioner considers that:
 - (i) there is no lawful ground of objection (other than a ground in respect of paragraph 18(1)(b)) to the request and specification; or
 - (ii) any such ground of objection has been removed.

16 Subsection 61(1)

Omit "The Commissioner must", substitute "".

17 Subsection 97(1)

Repeal the subsection, substitute:

- (1) Subject to this section and the regulations, if:
 - (a) a request and complete specification relating to an application for a patent has been accepted; and

(b) the patent has not been granted;
the Commissioner may re-examine the complete specification.

18 After section 100

Insert:

Note: The heading to section 101 is replaced by the heading “**Revocation of patent—re-examination after grant**”.

19 Section 101D

Repeal the section, substitute:

101D Commissioner to be given information on searches

The patentee must inform the Commissioner, in accordance with the regulations, of the results of any documentary searches, whether conducted in Australia or elsewhere, for the purposes of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside Australia that are carried out by or on behalf of the patentee, or the patentee’s predecessor in title, prior to the issue of a certificate of examination in respect of the patent.

20 Paragraph 101E(a)

Repeal the paragraph, substitute:

- (a) after examining a patent under section 101B, the Commissioner decides in writing that he or she is satisfied that the invention, so far as claimed, complies with paragraph 18(1A)(b); and
- (aa) after so examining the patent, the Commissioner also decides in writing that he or she considers that:
 - (i) a ground for the revocation of the patent (other than a ground in respect of paragraph 18(1A)(b)) has not been made out; or
 - (ii) any such ground has been removed; and

21 Paragraph 102(2A)(b)

Omit “a decision under paragraph 101E(a)”, substitute “”.

22 After subsection 102(2B)

Insert:

Amendments not allowable if information not provided

- (2C) An amendment of a complete specification relating to a patent is not allowable if:
- (a) the patentee or the patentee's predecessor in title failed to ensure the provision to the Commissioner of the information required by subsection 45(3) or section 101D in relation to the patent; and
 - (b) the effect of the proposed amendment would be to remove a lawful ground of objection under paragraph 18(1)(b) or 18(1A)(b) to the specification arising from the existence of some or all of the information not provided.

23 Subsection 119(2)

Repeal the subsection, substitute:

- (2) Subject to subsection (3), subsection (1) does not apply if the person derived the subject-matter of the invention concerned from the patentee or the patentee's predecessor in title in the invention.
- (3) Subsection (2) does not prevent subsection (1) from applying if:
 - (a) the person derived the subject-matter of the invention concerned from information that was made publicly available by or with the consent of the patentee, or the predecessor in title of the patentee; and
 - (b) the making of that information publicly available was through any publication or use of the invention in the prescribed circumstances mentioned in paragraph 24(1)(a).
- (4) Subsection (1) does not apply if the person, before the relevant priority date, had stopped making the product or using the process (other than temporarily), or had abandoned (other than temporarily) the steps mentioned in paragraph (1)(b).

24 Paragraph 142(2)(b)

Repeal the paragraph.

25 Paragraph 143A(c)

Omit "a decision under paragraph 101E(a)", substitute "decisions under paragraphs 101E(a) and (aa)".

26 At the end of Chapter 13

Add:

27 After subsection 223(2)

Insert:

(2A) If:

- (a) a relevant act that is required to be done within a certain time is not done within that time; and
- (b) the Commissioner is satisfied that the person concerned took due care, as required in the circumstances, to ensure the doing of the act within that time;

the Commissioner must, on application made by the person concerned in accordance with the regulations and within the prescribed period, extend the time for doing the act.

(2B) An extension of time under subsection (2A) cannot exceed the period prescribed for the purposes of this subsection.

28 After subsection 223(3)

Insert:

29 Subsection 223(6)

Omit “A person”, substitute “Subject to subsection (6A), a person”.

30 Subsection 223(6)

Omit “granting”, substitute “granting under subsection (2) or (2A)”.

31 After subsection 223(6)

Insert:

(6A) If the Commissioner is satisfied that an application under subsection (2) or (2A) would not be granted even in the absence of opposition under subsection (6):

- (a) the Commissioner need not advertise the application in accordance with subsection (4); and
- (b) the application cannot be opposed, despite subsection (6); and
- (c) the Commissioner must refuse to grant the application.

32 Application

- (1) The amendments made by items 14 and 24 of this Schedule apply in relation to an application if the patent request and complete specification in relation to that application has not been accepted under subsection 49(1) of the *Patents Act 1990* before the commencement of this Schedule.
- (2) The amendment made by item 15 of this Schedule applies in relation to the acceptance of a patent request and complete specification under subsection 49(1) of the *Patents Act 1990* on or after the commencement of this Schedule.
- (3) The amendments made by items 16, 17 and 18 of this Schedule apply in relation to the grant of a patent on or after the commencement of this Schedule.
- (4) The amendment made by item 19 of this Schedule applies in relation to a patent unless the Commissioner has started examination of the patent under section 101B of the *Patents Act 1990* before the commencement of this Schedule.
- (5) The amendments made by items 20, 21 and 25 of this Schedule apply in relation to decisions of the Commissioner made under section 101E of the *Patents Act 1990* on or after the commencement of this Schedule.
- (6) The amendment made by item 23 of this Schedule applies in relation to a patent if the date of the patent is the date on which this Schedule commences or a later date.
- (7) The amendments made by items 27, 28, 29, 30 and 31 of this Schedule apply in relation to applications made under section 223 of the *Patents Act 1990* on or after the commencement of this Schedule.

33 Saving of regulations

- (1) Regulations in force for the purposes of a provision of the *Patents Act 1990* immediately before the day on which this Schedule commences continue to have effect on and after that day as if they had been made for the purposes of that provision as amended by this Schedule.
- (2) Subitem (1) does not prevent the repeal or amendment of regulations continued by that subitem.

Schedule 2—Amendments commencing after start of innovation patents scheme

Patents Act 1990

1 Subsection 48(1A)

Omit “paragraph (1)(c)”, substitute “paragraph (1)(b)”.

Note: This item corrects an incorrect cross-reference.

2 Subsection 101B(3)

Omit “paragraph 18A(1)(b)”, substitute “paragraph 18(1A)(b)”.

Note: This item corrects an incorrect cross-reference.

*[Minister’s second reading speech made in—
House of Representatives on 24 May 2001
Senate on 6 August 2001]*

(83/01)