

THE PARLIAMENT OF THE COMMONWEALTH OF AUSTRALIA
HOUSE OF REPRESENTATIVES

(As read a first time)

PATENTS AMENDMENT BILL 1981

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SCHEDULE

FORMAL AMENDMENTS

1980-81

THE PARLIAMENT OF THE COMMONWEALTH OF AUSTRALIA

HOUSE OF REPRESENTATIVES

Presented and read a first time, 7 April 1981

(*Minister for Science and Technology*)

A BILL

FOR

An Act to amend the *Patents Act 1952*, and for related purposes

5 BE IT ENACTED by the Queen, and the Senate and the House of Representatives of the Commonwealth of Australia, as follows:

Short title, &c.

1. (1) This Act may be cited as the *Patents Amendment Act 1981*.

(2) The *Patents Act 1952*¹ is in this Act referred to as the Principal Act.

Commencement

10 2. (1) Sections 1 and 2 shall come into operation on the day on which this Act receives the Royal Assent.

(2) Sections 3, 4, 13, 15, 16, 17, 19, 23, 24, 25, 29 and 31 shall come into operation on the twenty-eighth day after the day on which this Act receives the Royal Assent.

15 (3) Section 8 and sub-section 32 (1) shall be deemed to have come into operation immediately after the commencement of section 17 of the *Patents Amendment Act 1979*.

(4) The remaining provisions of this Act shall come into operation on such date as is, or such respective dates as are, fixed by Proclamation.

Interpretation

3. Section 6 of the Principal Act is amended by inserting after the definition of "patent" the following definition:

"'patent application' means an application for a standard patent or an application for a petty patent;"

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References to prescribed court

4. Section 6A of the Principal Act is amended by omitting paragraph (a) and substituting the following paragraph:

"(a) in relation to the institution of an appeal or other proceeding, as a reference to a prescribed court having jurisdiction with respect to matters arising under this Act in respect of which the appeal or other proceeding is instituted; and"

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Crown to be bound

5. Section 7 of the Principal Act is amended by omitting "and of the several States" and substituting ", of each of the States, of the Northern Territory and of Norfolk Island".

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Time for lodging complete specification

6. Section 41 of the Principal Act is amended—

(a) by omitting from sub-section (1) "section" and substituting "sections 41A and"; and

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(b) by adding at the end thereof the following sub-section:

"(3) A complete specification may be lodged in respect of a patent application notwithstanding that the patent application has lapsed by virtue of sub-section (2), but the lodging of the complete specification does not, of itself, affect the operation of that sub-section in respect of the patent application."

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7. After section 41 of the Principal Act the following section is inserted:

Extension of time for lodging complete specification

"41A. (1) Subject to this section, where, by reason of—

(a) an error or omission on the part of an applicant for a standard patent or of his agent or attorney; or

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(b) circumstances beyond the control of an applicant for a standard patent,

a complete specification was not lodged in respect of the patent application within the period of 12 months referred to in sub-section 41 (1), the Commissioner may, upon the application of the applicant, extend the period within which a complete specification may be lodged in respect of the patent application for such further period (in this section referred to as 'the extension period') as is specified in the application under this sub-section.

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“(2) The Commissioner may, under sub-section (1), extend the period within which a complete specification may be lodged in respect of a patent application although—

- (a) the patent application has lapsed by virtue of sub-section 41 (2); or
- (b) the extension period has expired.

“(3) In determining whether to grant an application under sub-section (1), the Commissioner shall have regard to—

- (a) the nature of the error, omission or circumstances, as the case requires, upon which the application is founded;
- (b) the reason for that error or omission or those circumstances, as the case requires;
- (c) the time at which the application under sub-section (1) was made;
- (d) the length of the extension period; and
- (e) such other matters as he considers relevant.

“(4) Where—

- (a) an application is made under sub-section (1) in respect of a patent application;
- (b) the extension period has expired, or will expire, not more than 3 months after the expiration of the period of 12 months referred to in sub-section 41 (1); and
- (c) a complete specification was not lodged in respect of the patent application before the making of the application under sub-section (1) and is not lodged at the same time as the application under sub-section (1),

the following provisions have effect:

- (d) the Commissioner shall not consider the application under sub-section (1) until a complete specification is lodged in respect of the patent application;
- (e) if a complete specification is not lodged in respect of the patent application within the extension period, the application under sub-section (1) lapses.

“(5) Where an application is made under sub-section (1) in respect of a patent application and the extension period has expired, or will expire, more than 3 months after the expiration of the period of 12 months referred to in sub-section 41 (1)—

- (a) the Commissioner shall forthwith advertise the application under sub-section (1) in the *Official Journal*;
- (b) unless a complete specification was lodged in respect of the patent application before the making of the application under sub-section (1) or is lodged at the same time as the application under sub-section (1), a complete specification shall be lodged in respect of the patent application within the extension period and, if such a complete specification is not so lodged, the application under sub-section (1) lapses;

- (c) where a complete specification has been, or is, lodged in respect of the patent application, the Commissioner shall, in accordance with sub-section (6), publish in the *Official Journal* a notification that the complete specification is open to public inspection;
- (d) the Commissioner shall not consider the application under sub-section (1) until the expiration of such period as is prescribed after the publication in the *Official Journal* of the notification referred to in paragraph (c); and 5
- (e) a person may, as prescribed, oppose the granting of the application under sub-section (1). 10

“(6) The Commissioner shall publish the notification referred to in paragraph (5) (c)—

- (a) where, before the making of the application under sub-section (1), a period of 3 months had elapsed since the complete specification was lodged—forthwith; or 15
- (b) in any other case—forthwith after the expiration of the period of 3 months after the date of lodgment of the complete specification.

“(7) When a notification referred to in paragraph (5) (c) has been published in the *Official Journal*, the following documents are, subject to this Act, open to public inspection— 20

- (a) the application;
- (b) the provisional specification;
- (c) the complete specification; and
- (d) the declaration lodged under sub-section 35 (3) in respect of the patent application. 25

“(8) Where a document referred to in sub-section (7) is a document that is open to public inspection and that document has been or is amended, the document as so amended is, subject to this Act, also open to public inspection.

“(9) Where—

- (a) a patent application has lapsed by virtue of sub-section 41 (2); and 30
- (b) the Commissioner, under sub-section (1), extends the period within which a complete specification may be lodged in respect of the patent application,

such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves or took definite steps by way of contract or otherwise to avail themselves, of the invention the subject of the patent application by reason of the lapsing of the patent application. 35

“(10) Where—

- (a) an application is made under sub-section (1) in respect of an application for a standard patent (in this sub-section referred to as ‘the original patent application’); 40

(b) a complete specification in respect of the original application was lodged before the making of the application under sub-section (1), is lodged at the same time as the application under sub-section (1) or is lodged before the expiration of the extension period;

5 (c) the application under sub-section (1) is refused; and

(d) the applicant, within 3 months after the date of the Commissioner's decision on the application under sub-section (1) or within such further period as the Commissioner allows, lodges another application for a standard patent (in this sub-section referred to as 'the further patent application') together with an election, in the prescribed form, stating that he wishes to have the complete specification lodged in respect of the original patent application treated as a complete specification in respect of the further patent application,

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15 the further patent application shall be deemed to have been lodged on the date on which the complete specification was lodged and the complete specification shall be treated as a complete specification in respect of the further patent application.

20 "(11) Where an application has been made to the Administrative Appeals Tribunal for review of a decision of the Commissioner refusing to grant an application under sub-section (1), the period within which the applicant may lodge another application for a standard patent together with an election referred to in paragraph (10) (d) is extended until the expiration of 3 months after the determination or other disposal of the application for review or until the expiration of such further period as the Administrative Appeals Tribunal or the Federal Court of Australia or the High Court in any appeal arising out of a decision of the Administrative Appeals Tribunal on that application for review, as the case may be, allows."

Priority date of complete specification

30 8. Section 45 of the Principal Act is amended by inserting after sub-section (3) the following sub-section:

35 "(3A) The priority date of a claim of a complete specification accompanying an application made under sub-section 49A (1) of the *Patents Act* 1952, as in force at any time before the commencement of section 17 of the *Patents Amendment Act* 1979, being a claim fairly based on matter disclosed in the complete specification from which the invention has been excluded by an amendment made under section 49 or 52D or would have been excluded if an amendment included in a statement of proposed amendments lodged under either of those sections had been made, is the date that would have been the priority date of that claim if that claim were a claim of that last-mentioned specification."

Procedure where single patent not granted

40 9. Section 50A of the Principal Act is amended by inserting in paragraph (1) (d) "(other than an application in respect of which the Commissioner has, under sub-section 41A (1), extended the period within which a complete specification may be lodged)" after "applications".

Voluntary division of patents**10. (1) Section 51 of the Principal Act is amended—**

- (a) by inserting in sub-section (1) “or at any time after the application has been accepted and before the expiration of the period of 3 months after acceptance of the application has been advertised in the *Official Journal*” after “at any time before the application has been accepted”;
- (b) by omitting from sub-section (4) “the application has been accepted” and substituting “the expiration of the period of 3 months after acceptance of the application has been advertised in the *Official Journal*”;
- (c) by omitting from sub-section (5) “the application has been accepted” and substituting “the sealing of a petty patent on the application”; and
- (d) by inserting after sub-section (5) the following sub-section:

“(5A) A patentee of a petty patent may, at any time before the expiration of the period of 3 months after sealing of the petty patent, make an application for a petty patent or a standard patent or applications for petty patents or standard patents, in respect of an invention or inventions disclosed in the petty patent specification lodged in respect of the application on which the first-mentioned petty patent was sealed.”.

(2) The amendments of section 51 of the Principal Act made by sub-section (1) apply in relation to a further application for a standard patent or for a petty patent made after the commencement of this section whether the application for a standard patent or for a petty patent to which the further application relates was lodged before, or is lodged after, the commencement of this section.

Time for acceptance**11. (1) Section 54 of the Principal Act is amended—**

- (a) by omitting from sub-section (1) “12 months” and substituting “21 months”;
- (b) by adding at the end of sub-section (1) “, or such further period as the Commissioner allows under section 160”;
- (c) by omitting from sub-section (1A) “12 months” and substituting “21 months”;
- (d) by adding at the end of sub-section (1A) “or such further period as the Commissioner allows under section 160”; and
- (e) by omitting sub-section (1B).

(2) Subject to sub-section (3), the amendments made by paragraphs (1) (a), (c) and (e) apply to—

- (a) any patent application lodged after the commencement of this section;
- (b) any patent application lodged before the commencement of this section in respect of which no report of an Examiner was sent to the applicant before the commencement of this section;

- 5 (c) any patent application lodged before the commencement of this section in respect of which a report of an Examiner was sent, or reports of an Examiner were sent, to the applicant before the commencement of this section but in respect of which no report of an Examiner was sent to an applicant more than 21 months before the commencement of this section; and
- (d) any patent application lodged before the commencement of this section in respect of which—
- 10 (i) a report of an Examiner was sent, or reports of an Examiner were sent, under section 52c of the *Patents Act 1952*, to the applicant more than 21 months before the commencement of this section;
- 15 (ii) before the commencement of this section but not later than 21 months after the report, or the first of the reports, as the case may be, referred to in sub-paragraph (i) was sent to the applicant, the applicant requested the making of an examination in accordance with section 48; and
- 20 (iii) no report of an Examiner arising out of an examination made in accordance with section 48 was sent to the applicant more than 21 months before the commencement of this section.

(3) Nothing in sub-section (2) entitles a person to a refund of a fee that was paid before the commencement of this section in respect of an application for an extension of time under sub-section 54 (1b) of the *Patents Act 1952* as in force at any time before the commencement of this section.

25 **Interpretation**

12. Section 58A of the Principal Act is amended—

- (a) by omitting from sub-section (1) the definition of “Treaty” and substituting the following definition:

30 “ ‘Treaty’ means the *Patent Cooperation Treaty* done at Washington on 19 June 1970 (a copy of the English text of which is set out in Schedule 2), together with the Regulations annexed to that Treaty—

- 35 (a) as amended under Article 58 of that Treaty by the Assembly of the International Patent Cooperation Union on 14 April 1978, 3 October 1978 and 1 May 1979 (a copy of the English text of which Regulations, as so amended, is also set out in Schedule 2); and
- 40 (b) as affected by any other amendments made under Article 58 of that Treaty by the Assembly of the International Patent Cooperation Union, being amendments in respect of which a declaration has been made by the regulations made by virtue of sub-section (3).”; and

(b) by adding at the end thereof the following sub-sections:

“(3) Regulations made under section 177 may declare—

- (a) that amendments of the Regulations under the *Patent Cooperation Treaty* done at Washington on 19 June 1970 were adopted under Article 58 of that Treaty by the Assembly of the International Patent Cooperation Union on a specified date; 5
- (b) that the amendments set out in the regulations are the amendments so adopted by the Assembly; and
- (c) that the amendments were adopted with effect on and from a specified date or specified dates. 10

“(4) Regulations made by virtue of sub-section (3) are *prima facie* evidence of the matters stated in those regulations.

“(5) Where regulations made by virtue of sub-section (3) declare that amendments of the Regulations under the *Patent Cooperation Treaty* done at Washington on 19 June 1970 were adopted under Article 58 of that Treaty with effect on and from a specified date and the regulations made by virtue of sub-section (3) are notified in the *Gazette* after that date, the amendments of the Regulations under that Treaty shall, for the purposes of the definition of ‘Treaty’ in sub-section (1), be taken to have effect on and from the date on which the regulations made for the purposes of sub-section (3) are notified in the *Gazette*.”. 15 20

Modified application of Act to international applications

13. Section 58C of the Principal Act is amended by omitting from sub-section (7) “54A, 54B and 62A” and substituting “54A and 54B and sub-section 62A (2)”. 25

Date of patent, &c.

14. Section 67 of the Principal Act is amended by inserting after sub-section (2) the following sub-sections:

“(2A) Subject to this Act (other than sub-sections (1) and (2)), where the Commissioner has, under sub-section 41A (1), extended the period within which a complete specification may be lodged in respect of an application for a standard patent (in this sub-section referred to as ‘the patent application’)— 30

- (a) a patent granted on the patent application;
- (b) a patent granted by virtue of section 50 on the patent application and another patent application or other patent applications; or 35
- (c) a patent granted on a further application for a standard patent or for a petty patent, or further applications for standard patents or petty patents, made by virtue of section 51 in respect of an invention or inventions disclosed in the provisional specification or complete specification lodged in respect of the patent application or in respect 40

of an invention or inventions falling within the scope of the claims of the complete specification that was accepted in respect of the patent application,

5 shall be dated as of the last day on which a complete specification could, but for any extension under sub-section 41A (1), have been lodged in respect of the patent application.

10 “(2B) Subject to this Act (other than sub-sections (1) and (2)), where the Commissioner has, under sub-section 142AAA (1), extended, in relation to an application for a standard patent or for a petty patent (in this sub-section referred to as ‘the patent application’), the period of 12 months referred to in sub-section 141 (1) or 142 (1)—

(a) a patent granted on the patent application; or

15 (b) a patent granted on a further application for a standard patent or for a petty patent, or further applications for standard patents or petty patents, made by virtue of section 51 in respect of an invention or inventions disclosed in the provisional specification, the complete specification or the petty patent specification, as the case may be, lodged in respect of the patent application or, if the patent application is an application for a standard patent, in respect of an invention or
20 inventions falling within the scope of the claims of the complete specification that was accepted in respect of the patent application,

shall be dated as of the last day on which the patent application could, but for any extension granted under sub-section 142AAA (1), have been made as a Convention application.”.

25 15. Section 113 of the Principal Act is repealed and the following section is substituted:

Infringement action may be instituted in a prescribed court

30 “113. An action or proceeding for infringement of a patent may be instituted in a prescribed court, but nothing in this section prevents such an action or proceeding being instituted in a court that is not a prescribed court.”.

Declaration as to non-infringement

16. Section 120 of the Principal Act is amended by omitting sub-section (2).

Groundless threats of legal proceedings

35 17. Section 121 of the Principal Act is amended by omitting sub-section (4) and substituting the following sub-section:

“(4) An action under this section may be instituted in a prescribed court, but nothing in this sub-section prevents such an action or proceeding being instituted in a court that is not a prescribed court.”.

40 18. Section 132 of the Principal Act is repealed and the following section is substituted:

Interpretation

“132. (1) In this Part, ‘State’ includes the Northern Territory.

“(2) In this Part, a reference to the Commonwealth shall be read as including a reference to an authority of the Commonwealth and a reference to a State shall be read as including a reference to an authority of a State.

“(3) This Part applies in relation to the Administration of Norfolk Island as if that Administration were a State.”.

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19. After section 135 of the Principal Act the following section is inserted:

Regulations with respect to the professional conduct of patent attorneys

“135A. (1) The regulations may make provision for and in relation to the control of the professional conduct of registered patent attorneys and the practice of the profession.

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“(2) Without limiting the generality of sub-section (1), the regulations may make provision for and in relation to—

- (a) the making of complaints, and the hearing of charges, against registered patent attorneys in relation to their professional conduct; and
- (b) the imposition of penalties on registered patent attorneys, including the issuing of a reprimand and the suspension or cancellation of registration.

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“(3) The regulations made for the purposes of this section may make provision for and in relation to—

- (a) the summoning of witnesses;
- (b) requiring persons to give evidence on oath (whether orally or otherwise);
- (c) the administering of oaths to persons giving evidence (whether orally or otherwise); and
- (d) requiring persons to produce documents or articles.”.

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Applications under international conventions

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20. Section 141 of the Principal Act is amended by inserting in sub-section (1) “or such further period as the Commissioner allows under sub-section 142AAA (1)” after “within 12 months after the date on which the basic application was made”.

Multiple priorities in respect of applications under international conventions

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21. Section 142 of the Principal Act is amended by inserting in sub-section (1) “or such further period as the Commissioner allows under sub-section 142AAA (1)” after “within 12 months from the date on which the earlier or earliest of those applications was made”.

22. (1) After section 142 of the Principal Act the following section is inserted:

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Extension of time for lodging applications under international conventions

“142AAA. (1) Subject to this section, where, by reason of circumstances beyond the control of the person who is entitled to make an application under sub-section 141 (1) or 142 (1) or of the persons who are entitled to make a joint

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application under sub-section 141 (1) or 142 (1), an application for a standard patent or a petty patent by that person or those persons was not lodged within the period of 12 months referred to in sub-section 141 (1) or 142 (1), whichever of those sub-sections is applicable, the Commissioner may, upon the application
5 of that person or those persons, extend, in relation to that application, that period of 12 months for such further period (in this section referred to as 'the extension period'), not being a period expiring more than 3 months after the expiration of that period of 12 months, as is specified in the application under this sub-section.

10 "(2) For the purposes of sub-section (1)—

- (a) circumstances shall not be taken to be beyond the control of a person or persons unless the circumstances are also beyond the control of any agent or attorney of that person or of those persons; and
- 15 (b) circumstances may be taken to be beyond the control of a person or persons notwithstanding that those circumstances involve an error or omission on the part of the person or any of the persons or on the part of an agent or attorney of the person or of those persons.

20 "(3) The Commissioner may, under sub-section (1), extend in relation to a patent application the period of 12 months referred to in sub-section 141 (1) or 142 (1) although the extension period has expired.

"(4) In determining whether to grant an application under sub-section (1), the Commissioner shall have regard to—

- (a) the nature of the circumstances upon which the application is founded;
- (b) the reason for those circumstances;
- 25 (c) the time at which the application under sub-section (1) was made;
- (d) the length of the extension period; and
- (e) such other matters as he considers relevant.

"(5) Where—

- 30 (a) an application is made under sub-section (1) in respect of a patent application; and
- (b) the patent application and either the complete specification or the petty patent specification, as the case requires, were not lodged before the making of the application under sub-section (1) and are not lodged at the same time as the application under sub-section (1),

35 the following provisions have effect:

- (c) the Commissioner shall not consider the application under sub-section (1) until the patent application and the relevant specification are lodged;
- 40 (d) if the patent application and the relevant specification are not lodged within the extension period, the application under sub-section (1) lapses.

“(6) Where the Commissioner, under sub-section (1), extends, in relation to a patent application, the period of 12 months referred to in sub-section 141 (1) or 142 (1), such provisions as are prescribed have effect for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention the subject of the patent application by reason of that application not having been made within that period of 12 months.”

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(2) Section 142AAA of the *Patents Act* 1952 inserted by sub-section (1) of this section does not apply in relation to an application for a standard patent if, in proceedings under section 59 of the *Patents Act* 1952 that were commenced before 24 February 1981, the priority date of a claim of the complete specification lodged in respect of the application was called in question before that date on the ground of an invalidity in, or in connection with, the granting of an extension under section 160 of the *Patents Act* 1952.

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Jurisdiction of prescribed courts

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23. Section 146 of the Principal Act is amended—

- (a) by omitting sub-sections (1) and (2) and substituting the following sub-sections:

“(1) Subject to sub-section (2), every prescribed court has jurisdiction with respect to matters arising under this Act in respect of which actions or proceedings may, under this Act, be instituted in a prescribed court.

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“(2) The jurisdiction conferred by sub-section (1) on the Supreme Court of a Territory—

- (a) to the extent that it relates to an action or proceeding for the infringement of a patent or an action under section 120 or 121, or to a matter arising under this Act that may be heard and determined together with such an action or proceeding—is conferred to the extent that the Constitution permits; and

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- (b) in any other case—is conferred only in relation to an action or proceeding instituted by a natural person who is resident in the Territory, or a corporation that has its principal place of business in the Territory, at the time of the institution of the action or proceeding.”; and

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- (b) by omitting from sub-section (4) “proceedings under this Act, including provision prescribing the time within which any” and substituting “an action or proceeding under this Act, including provision prescribing the time within which any action or”.

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Transfer of proceedings

24. Section 147 of the Principal Act is amended—

- (a) by omitting from sub-section (1) “proceedings have been” and substituting “an action or proceeding has been”;

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- (b) by omitting from sub-section (1) “proceedings” (second, third and fourth occurring) and substituting “action or proceeding”; and

(c) by omitting sub-section (2) and substituting the following sub-section :

“(2) Where an action or proceeding is transferred from a court in pursuance of this section—

5 (a) all documents filed of record in that court shall be transmitted by the Registrar or other proper officer of that court to the Registrar or other proper officer of the court to which the action or proceeding is transferred; and

10 (b) the court to which the action or proceeding is transferred shall proceed as if the action or proceeding had been originally instituted in that court and as if the same proceedings had been taken in that court as had been taken in the court from which the action or proceeding was transferred.”.

Appeals

15 25. Section 148 of the Principal Act is amended by adding at the end of sub-section (1) “or 121”.

Application for review

26. Section 151 of the Principal Act is amended—

(a) by omitting paragraph (a) and substituting the following paragraph:

20 “(a) a decision of the Commissioner under section 41A or 47E, sub-section 59 (1), section 66, sub-section 77 (4), section 82 or 98, sub-section 106 (1) or section 142AAA, 154, 159C, 160 or 172B; or”; and

(b) by adding at the end thereof the following sub-section:

25 “(2) In this section, ‘decision’ has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.”.

Extension of times by reason of errors

27. (1) Section 160 of the Principal Act is amended—

(a) by omitting sub-section (3) and substituting the following sub-sections:

30 “(3) The time for the doing of an act or the taking of a step may be extended under sub-section (1) or (2) for a further period although—

(a) that time has expired;

(b) that time has previously been extended under this section or another provision of this Act;

35 (c) the act or step is in relation to a patent application that has lapsed; or

(d) that further period has expired.

“(3A) In determining whether to grant an application under sub-section (2), the Commissioner shall have regard to—

40 (a) the nature of the error, omission or circumstances, as the case requires, upon which the application is founded;

- (b) the reason for that error or omission or those circumstances, as the case requires;
 - (c) the time at which the application under sub-section (2) was made;
 - (d) the length of period for which the extension is sought; and 5
 - (e) such other matters as he considers relevant.”; and
- (b) by omitting sub-section (8) and substituting the following sub-section:

“(7) This section does not apply in relation to the doing of an act or the taking of a step under section 41, 41A, 47, 47A, 47B, 47C or 51, sub-section 52B (1) or section 141, 142 or 142AAA.”. 10

(2) The amendments made by sub-section (1) do not affect the hearing or determination of an application made under section 160 of the Principal Act before the commencement of this section.

(3) A person who made application under section 160 of the Principal Act before the commencement of this section for an extension of the time within which to do an act or take a step, being an application that was refused before, or is refused after, the commencement of this section, shall not, by reason only of the making or refusal of that application, be prevented from making a further application under any provision of the Principal Act as amended by this Act for an extension of the time within which to do that act or take that step. 15 20

28. After section 172A of the Principal Act the following section is inserted:

Time of delivery by post

“172B. Where the Commissioner is satisfied that—

- (a) an application or other document that is permitted or required by this Act to be lodged in the Patent Office or to be lodged with, or made to, the Commissioner is so lodged or made by post, or any fees that are permitted or required by this Act to be paid to the Commissioner are paid by post; 25
- (b) the application or other document was, or the fees were, sent to the Patent Office or the Commissioner by a properly addressed, prepaid letter; and 30
- (c) that letter was delivered at a time later than the time at which it would have been delivered in the ordinary course of post,

the Commissioner may, at any time before the expiration of the period of 3 months after the date of delivery of that letter, by instrument in writing, direct 35 that the application or other document or the fees, as the case may be, shall, for the purposes of this Act, be deemed to have been lodged in the Patent Office or lodged with, or made to, the Commissioner, or paid to the Commissioner, as the case may be, at such time as is specified in the direction, being the time at which that letter would, in the opinion of the Commissioner, have been delivered 40 in the ordinary course of post.”.

Fees

29. Section 176 of the Principal Act is amended—

(a) by inserting after sub-section (1) the following sub-section:

5 “(1A) Without limiting the generality of sub-section (1), different fees may be prescribed in respect of the doing of an act, or the taking of a step, according to the time at which the act is done or the step taken, as the case may be.”; and

(b) by adding at the end thereof the following sub-section:

10 “(5) The regulations may make provision for the remission of, or for exempting persons from the payment of, the whole or any part of a fee.”.

Regulations

30. Section 177 of the Principal Act is amended by inserting after paragraph (ac) the following paragraph:

15 “(ad) requiring persons to furnish statutory declarations in relation to patent applications or patents or in proceedings under this Act (not being proceedings in a court);”.

Formal amendments

31. The Principal Act is amended as set out in the Schedule.

Transitional

20 32. (1) Notwithstanding the repeal of section 49A of the *Patents Act* 1952 effected by section 17 of the *Patents Amendment Act* 1979, the provisions of that first-mentioned section continue to apply, after the commencement of this sub-section, in relation to applications made by virtue of that first-mentioned section before the commencement of this sub-section as if that first-mentioned section had not been repealed.

(2) This section applies to an invention if—

30 (a) the invention falls within the scope of a claim of the complete specification of an application for a patent that was accepted before 1 July 1979 but in respect of which a patent was not sealed before that date; and

(b) the invention was, before 1 July 1979, excluded from the complete specification by an amendment under section 49 or 52D of the *Patents Act* 1952.

35 (3) An application for a standard patent may be made, before the expiration of a period of 6 months after the day on which this Act received the Royal Assent, in respect of an invention to which this section applies by a person who is entitled or by persons who are entitled, in accordance with section 34 of the *Patents Act* 1952, to make an application for a patent for the invention.

40 (4) An application under sub-section (3) may be made whether or not a patent has been sealed in respect of the application referred to in paragraph (2) (a).

(5) An application for a standard patent made by virtue of sub-section (3) shall be accompanied by a complete specification.

(6) The fee payable in respect of the making of an application under sub-section (3) is \$40 together with—

- (a) if the number of sheets comprising the specification, including any drawings contained in the specification exceeds 10—\$2 for each sheet in excess of 10; and
- (b) if the number of claims exceeds 10—\$4 for each claim in excess of 10.

(7) The Commissioner may, in his discretion, remit the whole or part of any fee that would, but for this sub-section, be payable in respect of the making of an application under sub-section (3).

(8) Notwithstanding anything contained in section 45 or 45A of the *Patents Act* 1952, the priority date of a claim of a complete specification accompanying an application made by virtue of sub-section (3), being a claim fairly based on matter disclosed in the complete specification from which the invention was excluded by an amendment made under section 49 or 52D of the *Patents Act* 1952, is the date that would have been the priority date of that claim if that claim were a claim of that last-mentioned specification.

(9) Subject to the provisions of the *Patents Act* 1952 other than sub-section 67 (1) of that Act, a patent granted on an application made by virtue of sub-section (3) of this section shall be dated as of the date of lodgement of the complete specification referred to in paragraph (2) (a).

(10) Where an application for a patent for an invention is made by virtue of sub-section (3), such provisions as are prescribed have effect for the protection or compensation of persons who avail themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention by reason of the repeal effected by section 17 of the *Patents Amendment Act* 1979.

(11) The Governor-General may make regulations for the purposes of sub-section (10).

Validation, &c.

33. (1) Subject to this section, no patent, and no act or step in relation to an application for a patent or in proceedings under the *Patents Act* 1952, whether granted, done or taken, as the case may be, before or after the commencement of this section, shall be deemed to be, or ever to have been, invalid or otherwise affected in its validity or operation, and no priority date of a claim of a complete specification or a petty patent specification, whether lodged before or after the commencement of this section, shall be deemed to be, or ever to have been, affected by reason only of any invalidity in, or in connection with, the granting of an extension under section 160 of the *Patents Act* 1952 before the commencement of this section.

(2) Where, in any proceedings under section 59 of the *Patents Act* 1952 that were commenced before 24 February 1981, the priority date of a claim of a complete specification was called in question before that date on the ground of an invalidity in, or in connection with, the granting of an extension under section 160 of the *Patents Act* 1952—

- (a) sub-section (1) does not apply in relation to that priority date; and
- (b) in any proceedings under the *Patents Act* 1952 (whether instituted before or after the commencement of this section) in which that priority date is called in question on the ground of an invalidity in, or in connection with, the granting of that extension, the effect of section 160 of that Act in relation to that priority date shall be determined without regard to the provisions of this Act other than this sub-section.

(3) Where—

(a) proceedings are brought in a court for an infringement of a patent (including proceedings brought by virtue of sub-section 54C (1) or 54D (1) of the *Patents Act* 1952);

(b) the court finds that—

(i) an infringement of the patent was committed at a time before the commencement of this section; and

(ii) the patent would have been invalid at the time of the infringement, or would, if it had been sealed before the infringement, have been invalid at that time, but for sub-section (1); and

(c) the defendant in those proceedings satisfies the court that, in committing the infringement, he acted on the view that the patent was invalid, or that a patent could not validly be granted on the application on which the patent mentioned in paragraph (a) was granted, as the case may be, by reason of invalidity in, or in connection with, the granting of an extension under section 160 of the *Principal Act* before the commencement of this section,

the court shall not award damages, make an order for an account of profits or make an order for costs against the defendant in respect of the infringement.

(4) A reference in this section to a patent being invalid shall, in the case of a standard patent, be read as including a reference to the patent being invalid in so far as it relates to a claim or claims of the complete specification.

35 Compensation

34. (1) If the operation of this Act (including the operation of any provision of the *Principal Act* as amended by this Act, being a provision of the *Principal Act* amended by this Act) results in the acquisition of property from a person for the benefit of another person, being an acquisition of property within the meaning of paragraph 51 (xxxi) of the Constitution, that second-mentioned person is liable to pay that first-mentioned person such compensation as is determined by agreement between those persons, or, in the absence of agreement, by action brought by that first-mentioned person against that second-mentioned person in the Supreme Court of a State or Territory.

(2) The Supreme Courts of the States have jurisdiction, and the Supreme Courts of the Territories have jurisdiction to the extent that the Constitution permits, with respect to matters arising under this section in respect of which actions may be brought in those Courts under this section.

SCHEDULE
FORMAL AMENDMENTS

Section 31

Provision	Amendment
Section 6 (definition of "the Register")	Omit "(1) of section 20", substitute "20 (1)".
Paragraph 48 (3) (d)	Omit "(a) of sub-section (1) of section 158", substitute "158 (1) (a)".
Sub-section 48 (4)	(a) Omit "(a) of sub-section (3)", substitute "(3) (a)". (b) Omit "(c) of that sub-section", substitute "(3) (c)".
Sub-section 48 (5)	Omit "(e) of sub-section (3)", substitute "(3) (e)".
Sub-section 49A (12)	(a) Omit "(b) of sub-section (11)", substitute "(11) (b)". (b) Omit "(d) of that sub-section", substitute "(11) (d)".
Sub-section 50A (1)	Omit "(3) of section 50", substitute "50 (3)".
Sub-section 50A (2)	Omit "(c) of sub-section (1)", substitute "(1) (c)".
Paragraph 52B (1) (d)	Omit "(b) and (c) of sub-section (2) of that section", substitute "47A (2) (b) and (c)".
Sub-section 52B (2)	Omit "(b) of section 47c", substitute "47c (b)".
Paragraph 52c (2) (b)	Omit "(b) of sub-section (1) of section 35", substitute "35 (1) (b)".
Paragraph 52c (2) (c)	Omit "(3) of section 52A", substitute "52A (3)".
Paragraph 52c (2) (d)	Omit "(3) of section 52A", substitute "52A (3)".
Sub-section 52c (3)	Omit "(3), (4) and (5) of section 48", substitute "48 (3), (4) and (5)".
Paragraph 52D (2) (b)	Omit "(3) of section 52A", substitute "52A (3)".
Sub-section 52D (4)	(a) Omit "(3) of section 52A", substitute "52A (3)". (b) Omit "(ii) of paragraph (b) of sub-section (2)", substitute "(2) (b) (ii)".
Paragraph 52D (6) (a)	Omit "(b) of sub-section (2) of this section", substitute "(2) (b)".
Paragraph 52D (8) (b)	(a) Omit "(3) of section 52A", substitute "52A (3)". (b) Omit "(b) of sub-section (2)", substitute "(2) (b)".
Sub-section 52D (10)	Omit "(4) of section 52", substitute "52 (4)".
Sub-section 54 (4)	Omit "(a) of sub-section (3) of section 48", substitute "48 (3) (a)".
Paragraph 54A (4) (e)	Omit "(i) of paragraph (a)", substitute "(a) (i)".
Paragraph 54A (4) (f)	Omit "(ii) of paragraph (a)", substitute "(a) (ii)".
Paragraph 54A (4) (g)	Omit "(i) of paragraph (b)", substitute "(b) (i)".
Paragraph 54A (4) (h)	Omit "(ii) of paragraph (b)", substitute "(b) (ii)".
Paragraph 54A (4) (j)	Omit "(i) of paragraph (c)", substitute "(c) (i)".
Paragraph 54A (4) (k)	Omit "(ii) of paragraph (c)", substitute "(c) (ii)".
Paragraph 54A (4) (l)	Omit "(i) of paragraph (d)", substitute "(d) (i)".
Paragraph 54A (4) (m)	Omit "(ii) of paragraph (d)", substitute "(d) (ii)".
Paragraph 54B (1) (f)	Omit "(3) of section 35", substitute "35 (3)".
Paragraph 54B (1) (g)	Omit "(3) and (4) of section 143", substitute "143 (3) and (4)".
Paragraph 54B (2) (c)	Omit "(3) of section 35", substitute "35 (3)".
Paragraph 54B (2) (d)	Omit "(3) and (4) of section 143", substitute "143 (3) and (4)".
Sub-section 54c (1)	Omit "(9) of section 47E", substitute "47E (9)".
Section 56	Omit "(3) of section 48", substitute "48 (3)".
Paragraph 57 (1) (b)	Omit "(e), (f) or (g) of section 100", substitute "100 (e), (f) or (g)".
Paragraph 58B (4) (a)	Omit "(a) of sub-section (1)", substitute "(1) (a)".
Sub-section 58c (1)	(a) Omit "(c), (d), (e) and (f) of sub-section (1) of section 35", substitute "35 (1) (c), (d), (e) and (f)". (b) Omit "(2) of section 35", substitute "35 (2)". (c) Omit "(a) or (b) of sub-section (1) of section 35", substitute "35 (1) (a) or (b)".
Sub-section 58c (2)	Omit "(1) or (2) of section 40", substitute "40 (1) or (2)".
Sub-section 58c (3)	Omit "(1A) or (2) of section 40", substitute "40 (1A) or (2)".
Paragraph 58c (9) (b)	Omit "(2) or (3) of section 58c", substitute "58c (2) or (3)".
Sub-section 58D (1)	Omit "(8) or (9) of section 58c", substitute "58c (8) or (9)".
Sub-section 58D (2)	Omit "(8) or (9) of section 58c", substitute "58c (8) or (9)".
Sub-section 58E (2)	(a) Omit "(c), (d), (e) and (f) of sub-section (1) of section 35", substitute "35 (1) (c), (d), (e) and (f)". (b) Omit "(2) of section 35", substitute "35 (2)". (c) Omit "(a) or (b) of sub-section (1) of section 35", substitute "35 (1) (a) or (b)".
Sub-section 58E (3)	Omit "(1) or (2) of section 40", substitute "40 (1) or (2)".
Sub-section 58E (4)	Omit "(1A) or (2) of section 40", substitute "40 (1A) or (2)".
Paragraph 58G (2) (b)	Insert "public" before "inspection".
Paragraph 58J (a)	Omit "the" (first occurring).
Sub-section 59 (2)	(a) Omit "(c) of sub-section (1)", substitute "(1) (c)". (b) Omit "(d) of that sub-section", substitute "(1) (d)".

SCHEDULE—continued

Provision	Amendment
Sub-section 59 (2A) . . .	Omit "(c) of sub-section (1)", substitute "(1) (c)".
Sub-section 60 (4) . . .	Omit "(c) of sub-section (1) of section 59", substitute "59 (1) (c)".
Paragraph 68B (2) (a) . . .	Omit "(a) of section 68A", substitute "68A (a)".
Sub-section 68B (3) . . .	(a) Omit "Patents", substitute "Patent". (b) Omit "(b), (c), (d), (e), (f) and (g) of sub-section (1) of section 100", substitute "100 (1) (a), (b), (c), (d), (e), (f) and (g)".
Sub-sections 68B (5), (6) and (7)	Omit "(b), (c), (d), (e), (f) and (g) of sub-section (1) of section 100", substitute "100 (1) (b), (c), (d), (e), (f) and (g)".
Sub-section 95 (3) . . .	Omit "(b) of sub-section (2)", substitute "(2) (b)".
Sub-section 100 (2) . . .	Omit "(e) or (g) of sub-section (1)", substitute "(1) (e) or (g)".
Sub-section 100 (3) . . .	Omit "(1) of sub-section (1)", substitute "(1) (1)".
Sub-section 110 (2) . . .	Omit "(c) of sub-section (1)", substitute "(1) (c)".
Sub-section 112 (3) . . .	Omit "(a) of sub-section (2)", substitute "(2) (a)".
Sub-section 126 (1) . . .	Omit "(1) of 125", substitute "125 (1)".
Sub-section 142 (1) . . .	Omit "(1) of section 141", substitute "141 (1)".
Sub-paragraph 151 (a) (ii) . . .	Omit "(4) of section 77 or sub-section (1) of section 106", substitute "77 (4) or 106 (1)".
Paragraph 158 (1) (j) . . .	Omit "(iv) of paragraph (i)", substitute "(i) (iv)".
Sub-section 158 (2) . . .	Omit "(c), (d), (e) and (f) of sub-section (1)", substitute "(1) (c), (d), (e) and (f)".
Paragraph 159B (1) (b) . . .	Omit "(1) or sub-section (3) of section 159A", substitute "159A (1) or (3)".
Sub-section 159B (2) . . .	Omit "(2) and (3) of section 54c", substitute "54c (2) and (3)".
Paragraph 159C (1) (b) . . .	Omit "(1) of section 57", substitute "57 (1)".
Sub-section 159C (2) . . .	(a) Omit "(2) of section 57", substitute "57 (2)". (b) Omit "(b) of sub-section (1)", substitute "(1) (b)".
Sub-section 160 (8) . . .	Omit "(1) of section 52B", substitute "52B (1)".

NOTE

1. No. 42, 1952, as amended. For previous amendments, see No. 14, 1954; No. 3, 1955; No. 107, 1960; No. 84, 1962; No. 93, 1966; No. 34, 1969; No. 216, 1973 (as amended by No. 20, 1974); Nos. 91 and 162, 1976; No. 131, 1978; and Nos. 9, 19 and 188, 1979.

