

PATENTS.

No. 107 of 1960.

An Act to amend the *Patents Act* 1952-1955.

[Assented to 16th December, 1960.]

BE it enacted by the Queen's Most Excellent Majesty, the Senate, and the House of Representatives of the Commonwealth of Australia, as follows:—

**Short title
and citation.**

- 1.—(1.) This Act may be cited as the *Patents Act* 1960.
- (2.) The *Patents Act* 1952-1955* is in this Act referred to as the Principal Act.
- (3.) The Principal Act, as amended by this Act, may be cited as the *Patents Act* 1952-1960.

**Commence-
ment.**

- 2.—(1.) Sections one, two, eight, eleven, twenty, twenty-one and twenty-six of this Act shall come into operation on the day on which this Act receives the Royal Assent.
- (2.) The remaining sections of this Act shall come into operation on a date to be fixed by Proclamation.

**Application of
Act.**

3. Section five of the Principal Act is amended by omitting from sub-section (2.) the words " Subject to sub-section (2.) of section one hundred and seventy-six of this Act, this " and inserting in their stead the word " This ".

* Act No. 42, 1952, as amended by No. 14, 1954; and No. 3, 1955.

4. Section six of the Principal Act is amended—

Definitions.

(a) by inserting after the definition of “Australia” the following definition:—

“ ‘Convention application’ means an application in relation to which Part XVI. applies; ”; and

(b) by inserting after the definition of “patent” the following definition:—

“ ‘patent of addition’ means letters patent for an invention granted under Part VII. of this Act or under Division 6 of Part IV. of the repealed Acts; ”.

5. Section thirty-four of the Principal Act is amended—

Who may apply for patent.

(a) by omitting from paragraph (f) of sub-section (1.) the word “or” (last occurring); and

(b) by inserting after that paragraph the following paragraph:—

“ (fa) a person who would, if a patent were granted upon an application made by a person referred to in any of the preceding paragraphs, be entitled to have the patent assigned to him; or ”.

6. Section thirty-five of the Principal Act is amended by omitting sub-section (3.) and inserting in its stead the following sub-section:—

Form of application.

“ (3.) A declaration setting out the facts relied on to support the application shall be lodged before acceptance of the application. ”.

7. Sections forty-two and forty-three of the Principal Act are repealed and the following section is inserted in their stead:—

“ 42. Where—

(a) an application was accompanied by a specification purporting to be a complete specification; and

(b) the applicant, within twelve months after the date of the application and before the application and the complete specification have been accepted, requests the Commissioner to treat the specification as a provisional specification,

Complete specification may be treated as provisional in certain circumstances.

the Commissioner may direct that the specification be treated as a provisional specification and, in that case, the specification shall, for the purposes of this Act, be deemed to be, and at all times to have been, a provisional specification. ”.

8. Section forty-seven of the Principal Act is repealed and the following section inserted in its stead:—

“ 47.—(1.) An Examiner shall, in respect of each application, report whether the application and complete specification comply with the requirements of this Act.

Examination of applications and complete specifications.

“(2.) The report made under the last preceding sub-section shall include a report whether the priority date of each claim of the complete specification, as indicated by the applicant, is the priority date of that claim as determined by this Act.”

Report by
Examiner as
to novelty.

9. Section forty-eight of the Principal Act is amended—

- (a) by omitting from sub-section (1.) the words “ the case ” and inserting in their stead the word “ respect ”; and
- (b) by omitting sub-section (3.).

10. Sections fifty-two, fifty-three and fifty-four of the Principal Act are repealed and the following sections inserted in their stead:—

Acceptance of
application
and complete
specification.

“ 52.—(1.) If the Commissioner is satisfied that there is no lawful ground of objection to an application and complete specification, or that the grounds of objection to an application and complete specification have been removed, the Commissioner shall, subject to sub-section (3.) of this section, accept the application and complete specification.

“(2.) If the Commissioner is not so satisfied, he may refuse to accept the application and complete specification.

“(3.) The Commissioner shall, if the applicant so requests, postpone acceptance of an application and complete specification until such date, not being after the time for acceptance as provided by section fifty-four of this Act, as the applicant specifies.

“(4.) When an application and complete specification have been accepted, the Commissioner shall forthwith—

- (a) give notice in writing of the acceptance to the applicant; and
- (b) advertise the acceptance in the *Official Journal*.

“(5.) Where—

- (a) a period of two years has elapsed since a complete specification was lodged in respect of an application; and
- (b) the application and complete specification have not been accepted,

the Commissioner shall forthwith publish in the *Official Journal* a notification that the complete specification is open to public inspection.

“(6.) When—

- (a) acceptance of an application and complete specification has been advertised in the *Official Journal* in pursuance of sub-section (4.) of this section; or

(b) a notification that the complete specification is open to public inspection has been published in the *Official Journal* in pursuance of the last preceding sub-section, the following documents shall, subject to this Act, be open to public inspection:—

- (c) the application as lodged;
- (d) if the application as lodged has been amended, that application as so amended;
- (e) the provisional specification (if any);
- (f) the complete specification as lodged;
- (g) if the complete specification as lodged has been amended, that specification as so amended;
- (h) the declaration lodged in respect of the application under sub-section (3.) of section thirty-five of this Act; and
- (i) in the case of a Convention application, the documents referred to in sub-sections (3.) and (4.) of section one hundred and forty-three of this Act.

“(7.) When a complete specification has become open to public inspection under the last preceding sub-section, it shall be deemed to have been published.

“(8.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.

“53. Where an application and complete specification have not been accepted within the time for acceptance as provided by the next succeeding section, the application shall lapse. Lapsing of application.

“54.—(1.) Subject to this section, the time within which an application and complete specification may be accepted is twenty-one months from the date on which the first report of the Examiner on the complete specification was sent to the applicant. Time for acceptance.

“(2.) Where—

- (a) an appeal under any of the provisions of this Act has been instituted in respect of an application; or
- (b) in the case of an application for a patent of addition, an appeal under any of the provisions of this Act has been instituted in respect of either that application or the application for the original patent,

the time within which the application and complete specification may be accepted is extended until the expiration of three months after the determination of the appeal or until the expiration of such further time as the Appeal Tribunal allows.

“(3.) Where the applicant has died, the Commissioner may extend, until the expiration of such further time as he determines, the time within which the application and complete specification may be accepted.

“(4.) Where an Examiner reports adversely to a complete specification under paragraph (a) of sub-section (1.) of section forty-eight of this Act, the Commissioner may defer acceptance of the application and complete specification until the expiration of three months after—

(a) the date on which a patent was sealed on the other application referred to in that paragraph; or

(b) the date on which that other application lapsed or was refused or withdrawn,

as the case may be.”.

Certain documents not to be published.

11. Section fifty-five of the Principal Act is amended by inserting in paragraph (a) of sub-section (1.), before the word “specification”, the word “complete”.

Notice of opposition to applicant and hearing.

12. Section sixty of the Principal Act is amended by omitting from sub-section (3.) the words “the application of the actual inventor, or of some other person referred to in section thirty-four of this Act,” and inserting in their stead the word “application”.

Grant of patent of addition.

13. Section seventy-three of the Principal Act is amended by omitting from sub-section (1.) the words “(in this Act referred to as a ‘patent of addition’)”.

14. Section seventy-eight of the Principal Act is repealed and the following section inserted in its stead:—

Nature of amendments allowable.

“78.—(1.) Except for the purpose of correcting a clerical error or an obvious mistake, an amendment of a specification under this Part is not allowable—

(a) after publication of the complete specification—if a claim of the specification as amended would not in substance fall within the scope of the claims of the specification before amendment; and

(b) at any time—if the specification as amended would claim matter not in substance disclosed in the specification as lodged.

“(2.) An amendment of a specification under this Part is not allowable after acceptance if, by reason of making the amendment, the specification would not comply with the requirements of section forty of this Act.”.

15. Section eighty-one of the Principal Act is repealed and the following section inserted in its stead:—

Advertisement of request.

“81.—(1.) The Commissioner may, if he is of opinion that the request for leave to amend should not be allowed, refuse the request.

“(2.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under the last preceding sub-section.

“(3.) If the Commissioner does not refuse the request, or if, on appeal from a decision of the Commissioner refusing the request, the Appeal Tribunal reverses the decision of the Commissioner, the Commissioner shall, unless the complete specification has not been published, advertise particulars of the request in the *Official Journal*.”

16. Section eighty-two of the Principal Act is amended by omitting the words “Where the request has been advertised, the Attorney-General or a person interested may, at any time within three months after the date of the first advertisement” and inserting in their stead the words “Where particulars of the request have been advertised, the Attorney-General or a person interested may, at any time within three months after the date of the advertisement”.

Notice of
opposition.

17. Section eighty-five of the Principal Act is amended by inserting after the word “apply” the words “, in the case of a request by a patentee for leave to amend his complete specification,”.

No amendment
where action
pending.

18. Section one hundred and seven of the Principal Act is amended—

(a) by omitting from sub-section (1.) the words “the application of the actual inventor or of a person referred to in section thirty-four of this Act,” and inserting in their stead the word “application”; and

(b) by inserting after sub-section (2.) the following sub-section:—

“(2A.) An appeal lies to the Appeal Tribunal from a determination of the Commissioner under the last preceding sub-section.”.

Grant of
patent where
patent revoked.

19. Section one hundred and eight of the Principal Act is amended—

(a) by inserting in sub-section (3.), after the word “as”, the words “, subject to this Part,”; and

(b) by inserting after that sub-section the following sub-section:—

“(3A.) In an order under the last preceding sub-section, the Court shall direct that the licence to be granted—

(a) shall be a licence that does not confer on the licensee, or on the licensee and persons authorized by him, the right to make, use, exercise and vend the patented invention to the exclusion of all other persons, including the patentee; and

Compulsory
licences.

(b) shall be a licence assignable only in connexion with an enterprise or goodwill in connexion with which the licence is used.”.

Registration
of patent
attorneys.

20. Section one hundred and thirty-three of the Principal Act is amended by omitting from sub-section (3.) the word “ may ” and inserting in its stead the word “ shall ”.

Privileges.

21. Section one hundred and thirty-four of the Principal Act is amended by inserting after sub-section (1.) the following sub-section:—

“ (1A.) A communication between a patent attorney and his client is privileged to the same extent as a communication between a solicitor and his client.”.

22. Section one hundred and forty-one of the Principal Act is repealed and the following section inserted in its stead:—

Applications
under
International
Conventions.

“ 141.—(1.) Where an application for a patent or similar protection in respect of an invention (in this Part referred to as ‘ the basic application ’) has been made in a Convention country and a person, being a person referred to in section thirty-four of this Act, who—

- (a) is the applicant in the Convention country;
- (b) is the assignee of the applicant in the Convention country;
- (c) is the legal representative of the applicant in the Convention country or of his assignee; or
- (d) has the consent of the applicant in the Convention country or of a person who is his assignee or legal representative,

makes an application, or two or more of such persons make a joint application, for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim fairly based on matter disclosed in the basic application, is the date of making of the basic application.

“ (2.) Where two or more applications have been made for a patent or similar protection in respect of the invention in one or more Convention countries, the period of twelve months referred to in the last preceding sub-section shall be reckoned from the date on which the earlier or earliest of those applications was made.”.

Multiple
priorities.

23. Section one hundred and forty-two of the Principal Act is amended by omitting from sub-section (1.) the words “ any or all of the persons referred to in sub-section (1.) of the last preceding section ” and inserting in their stead the words “ a person referred to in sub-section (1.) of the last preceding section, or by two or more of such persons jointly,”.

24. After section one hundred and forty-two of the Principal Act the following section is inserted:—

“ F42AA. Notwithstanding anything contained in either of the last two preceding sections, where—

Withdrawn application not to be used as basic application in certain circumstances.

- (a) an application has been made for a patent or similar protection in respect of an invention in a Convention country;
- (b) the application has been withdrawn, abandoned or refused without becoming open to public inspection;
- (c) the application has not been used as the basis for claiming a right of priority in a Convention country under the law of that country corresponding to this Part; and
- (d) a later application has been made by the same applicant for a patent or similar protection in respect of that invention in the Convention country in which the earlier application was made,

the applicant may request the Commissioner to disregard the earlier application for the purposes of the last two preceding sections and, if he so requests—

- (e) the earlier application shall be so disregarded; and
- (f) neither the applicant nor any other person is capable of making use of the earlier application as a basic application for the purposes of this Part.”

25. Section one hundred and forty-two A of the Principal Act is amended by omitting the words “ an application under either of the last two preceding sections ” and inserting in their stead the words “ a Convention application ”.

Partial priorities.

26.—(1.) Section one hundred and forty-three of the Principal Act is amended by omitting sub-sections (1.) and (2.) and inserting in their stead the following sub-sections:—

Manner of making Convention application.

“ (1.) A Convention application—

- (a) shall, subject to the next succeeding paragraph, be made and proceeded with in the same manner as an ordinary application under this Act; and
- (b) shall be accompanied by a complete specification.

“ (2.) The complete specification accompanying a Convention application may include a claim the priority date of which is the date of lodgment of that complete specification.”

(2.) The amendment made by the last preceding sub-section shall be deemed to have come into operation on the first day of May, One thousand nine hundred and fifty-four.

Disclosure in
Convention
applications.

27. Section one hundred and forty-five of the Principal Act is amended by omitting from paragraph (b) the words “application under this Part” and inserting in their stead the words “Convention application”.

28. Section one hundred and sixty of the Principal Act is repealed and the following section inserted in its stead:—

Extension of
times by
reason of
errors.

“160.—(1.) Where, by reason of an error or omission on the part of an officer or person employed in the Patent Office, an act or step in relation to an application for a patent or in proceedings under this Act (not being proceedings in a court) required to be done or taken within a certain time has not been so done or taken, the Commissioner shall extend the time for doing the act or taking the step.

“(2.) Where, by reason of—

- (a) an error or omission on the part of the person concerned or of his agent or attorney; or
- (b) circumstances beyond the control of the person concerned,

an act or step in relation to an application for a patent or in proceedings under this Act (not being proceedings in a court) required to be done or taken within a certain time has not been so done or taken, the Commissioner may, upon application by the person concerned, but subject to this section, extend the time for doing the act or taking the step.

“(3.) The time for the doing of an act or the taking of a step may be extended under either of the last two preceding sub-sections although that time has expired.

“(4.) Where an application for extension of time under sub-section (2.) of this section is made more than three months after the expiration of the time allowed for the doing of the act or the taking of the step, the Commissioner shall advertise the application in the *Official Journal*.

“(5.) A person may, as prescribed, oppose the granting of the application.

“(6.) Where an extension of time is granted under this section, 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 application for the patent concerned by reason of the act or step in relation to which the extension was granted not having been done or taken within the time allowed.

“(7.) An appeal lies to the Appeal Tribunal from a decision of the Commissioner under this section.”.

29. Section one hundred and seventy-six of the Principal Act is repealed and the following section inserted in its stead:—

“176.—(1.) There shall be paid to the Commissioner such fees as are prescribed. Fees.

“(2.) Where a fee is payable in respect of the doing of an act by the Commissioner, the Commissioner shall not do that act until the fee has been paid.

“(3.) Where a fee is payable in respect of the doing of an act by a person other than the Commissioner, or a fee is payable in respect of the lodging of a document, the act shall be deemed to have been done, or the document shall be deemed to have been lodged, notwithstanding the failure to pay the fee unless, within seven days after the doing of the act or the lodging of the document, the Commissioner sends notice of the failure to pay the fee to the person doing the act or lodging the document, or to his patent attorney, in which case the act shall be deemed not to have been done, or the document shall be deemed not to have been lodged, until the fee has been paid.”.

30.—(1.) Where an application, complete specification and provisional specification (if any) have become open to public inspection under the *Patents Act* 1952 or under that Act as amended, the additional documents referred to in sub-section (6.) of section fifty-two of the Principal Act as amended by this Act shall also be open to public inspection. Transitional provisions.

(2.) The enactment of section fifty-four of the Principal Act as amended by this Act does not operate so as to extend the time for acceptance of an application and complete specification which, before the commencement of this section, had lapsed under section fifty-four of the Principal Act.

(3.) Where, before the date of commencement of this section, the Commissioner had, under sub-section (3.) of section forty-eight of the *Patents Act* 1952, or of that Act as amended, deferred acceptance of an application and complete specification and the application had not lapsed before that date, the Commissioner may further defer acceptance until the expiration of three months after—

- (a) the date on which a patent is sealed on the other application referred to in that sub-section; or
- (b) the date on which that other application lapses or is refused or withdrawn,

as the case may be.