

# PATENTS.

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No. 84 of 1962.

An Act to amend the Law relating to Patents of Inventions.

[Assented to 14th December, 1962.]

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

1.—(1.) This Act may be cited as the *Patents Act* 1962.

Short title  
and citation.

(2.) The *Patents Act* 1952–1960\* 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* 1952–1962.

2.—(1.) Sections one and two, sub-section (2.) of section thirty and section thirty-one of this Act shall come into operation on the day on which this Act receives the Royal Assent.

Commence-  
ment.

(2.) Section twenty-six of this Act shall be deemed to have come into operation on the first day of May, One thousand nine hundred and fifty-four.

(3.) The remaining provisions of this Act shall come into operation on such respective dates as are fixed by Proclamation.

3. Section

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\* Act No. 42, 1952, as amended by No. 14, 1954; No. 3, 1955; and No. 107, 1960.

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 Section forty-two of the Principal Act is repealed and the following section inserted in its stead:—

Complete specification to be treated as provisional.

“42.—(1.) Where an application was accompanied by a specification purporting to be a complete specification, the applicant may, within twelve months after the date of the application, unless the application and complete specification have been accepted or have become open to public inspection, request the Commissioner to treat the specification as a provisional specification.

“(2.) Upon such a request being made, 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.”.

Examination of applications and complete specifications.

4. Section forty-seven of the Principal Act is amended by omitting sub-section (1.) and inserting in its stead the following sub-section:—

“(1.) The Examiner shall, in respect of each application, report—

(a) whether the application and complete specification comply with the requirements of this Act; and

(b) whether acceptance of the application and complete specification might be refused under section one hundred and fifty-five of this Act.”.

5. Section forty-nine of the Principal Act is repealed and the following sections are inserted in its stead:—

Additional report where specification amended.

“48A. Where a complete specification has been amended under Part VIII. after an examiner has made a report under the last two preceding sections in respect of that specification and before the specification has become open to public inspection, an examiner shall, in so far as the specification has been so amended, ascertain and report as provided by those sections and this Act applies to a report so made as though it were a report under those sections.

Action on Examiner's report.

“49.—(1.) If the Examiner reports adversely to an application or specification under any of the last three preceding sections, the applicant may lodge at the Patent Office a statement in writing of proposed amendments of the application or specification for the purpose of removing the grounds of objection.

“(2.) An Examiner shall report on the application or specification as proposed to be amended as if it were an original application or specification and shall also report whether the proposed amendments are allowable.

“(3.) If

“(3.) If the Examiner reports adversely under the last preceding sub-section, the applicant may amend the statement of proposed amendments for the purpose of removing the grounds of objection and the last preceding sub-section thereupon applies as if the amended statement were a statement lodged under sub-section (1.) of this section.

“(4.) An amendment of the application or specification is not allowable if it is not for the purpose of removing a ground of objection.

“(5.) An amendment of the specification (not being an amendment for the purpose of correcting a clerical error or an obvious mistake) is not allowable—

- (a) if the specification would, as a result of the amendment, claim matter not in substance disclosed in the specification as lodged; or
- (b) if a claim of the specification would not, as a result of the amendment, in substance fall within the scope of the claims of the specification before amendment.

“(6.) If the Commissioner is satisfied that a proposed amendment is an allowable amendment, or that proposed amendments are allowable amendments, and, if made, would remove a lawful ground of objection, or lawful grounds of objection, to the application or specification under any of the last three preceding sections, the Commissioner shall, before accepting the application, allow the amendment or amendments, which shall thereupon be deemed to be made.

“(7.) If the application or specification is not amended as provided by the last preceding sub-section so as to remove all lawful grounds of objection, the Commissioner may direct that the applicant lodge a statement of proposed amendments to the satisfaction of the Commissioner within such time as the Commissioner allows.

“(8.) If the Commissioner is satisfied that the amendments set out in a statement lodged in pursuance of a direction under the last preceding sub-section are allowable amendments and, if made, would remove all, or all the remaining, lawful grounds of objection to the application and specification, the Commissioner shall, before accepting the application, allow the amendments, which shall thereupon be deemed to be made.

“(9.) An appeal lies to the Appeal Tribunal from a direction of the Commissioner under sub-section (7.) of this section.

“49A.—(1.) The applicant may make a separate application for a patent for an invention—

- (a) that has been excluded by an amendment made under the last preceding section; or

(b) that

Division of  
application  
after objection.

(b) that would be excluded if an amendment included in a statement of proposed amendments lodged under the last preceding section were made.

“(2.) An application made by virtue of the last preceding sub-section shall be accompanied by a complete specification.

“(3.) The Commissioner may direct that the priority date of a claim of the complete specification accompanying an application so made shall be such date as the Commissioner determines, being a date not later than the date of the separate application and not earlier than the priority date of the claim excluded by the amendment, or that would be excluded if an amendment included in the statement of proposed amendments were made, or, if two or more claims were or would be so excluded, not earlier than the priority date of whichever of those claims had the earlier or earliest priority date.

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

Single patent  
for cognate  
inventions.

6. Section fifty of the Principal Act is amended—

(a) by omitting from sub-section (1.) the words “, if the inventions described in those provisional specifications are so related as to constitute one invention,”; and

(b) by omitting sub-section (2.) and inserting in its stead the following sub-section:—

“(2.) The Examiner shall report whether the inventions described in the provisional specifications, in so far as those inventions are included in the claims of the complete specification, are so related as to constitute one invention.”.

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

Voluntary  
division of  
application.

“ 51.—(1.) A person who has made an application for a patent (not being an application that has lapsed or has been refused or withdrawn) may, at any time before the application has been accepted, make one or more further applications in respect of an invention disclosed in the provisional specification or complete specification lodged in respect of the first-mentioned application.

“(2.) A further application may not be made by virtue of the last preceding sub-section—

(a) in respect of an invention disclosed in a provisional specification lodged more than twelve months before the date of that application and being an invention that is not disclosed in the complete specification; or

(b) in

(b) in respect of an invention disclosed in a complete specification—after the expiration of twelve months after the complete specification became open to public inspection.

“(3.) An application made by virtue of sub-section (1.) of this section shall be accompanied by a complete specification.”.

8. Section fifty-two of the Principal Act is amended by omitting sub-sections (5.), (6.) and (7.).

Acceptance of application and complete specification.

9. After section fifty-four of the Principal Act the following sections are inserted:—

“54A.—(1.) The Commissioner shall, at the request of the applicant, in respect of a complete specification that has not become open to public inspection—

Publication of complete specification.

(a) if a period of three months has elapsed since the complete specification was lodged—forthwith; or

(b) if that period has not elapsed—forthwith after the expiration of that period,

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

“(2.) Where a period of eighteen months has elapsed since a complete specification was lodged and the specification has not become open to public inspection, the Commissioner shall, unless the application has lapsed or has been refused or withdrawn, forthwith publish in the *Official Journal* a notification that the complete specification is open to public inspection.

“(3.) Where a separate application is made by virtue of sub-section (1.) of section forty-nine A of this Act, or a further application is made by virtue of sub-section (1.) of section fifty-one of this Act, and, at the time the application is lodged, the complete specification lodged in respect of the original application is open to public inspection, the Commissioner shall forthwith publish in the *Official Journal* a notification that the complete specification lodged in respect of the separate or further application is open to public inspection.

“(4.) Where a separate application has been made by virtue of sub-section (1.) of section forty-nine A of this Act, or a further application has been made by virtue of sub-section (1.) of section fifty-one of this Act, and either—

(a) the acceptance of the application is to be advertised in the *Official Journal* or a notification is to be published in the *Official Journal* that the complete specification lodged in respect of the application is open to public inspection; or

(b) the

- (b) the acceptance of the original application is to be advertised in the *Official Journal* or a notification is to be published in the *Official Journal* that the complete specification lodged in respect of the original application is open to public inspection,

the Commissioner shall also publish in the *Official Journal* a notification that—

- (c) the original application; or  
 (d) the separate or further application,  
 respectively, is open to public inspection.

“(5.) Where an order is in force under section one hundred and thirty-one of this Act in relation to an application at a time when, but for this sub-section, a notification that the complete specification lodged in respect of the application is open to public inspection would be published under this section, the notification shall not be published until the order is revoked.

Documents  
open to public  
inspection.

“54B.—(1.) When—

- (a) acceptance of an application and complete specification has been advertised in the *Official Journal*; or  
 (b) a notification that an application or a complete specification is open to public inspection has been published in the *Official Journal*,

the following documents are, subject to this Act, open to public inspection—

- (c) the application;  
 (d) the provisional specification (if any);  
 (e) the complete specification;  
 (f) the declaration lodged in respect of the application under sub-section (3.) of section thirty-five of this Act; and  
 (g) 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.

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

“(3.) When a complete specification, or a complete specification as amended, has become open to public inspection under this section, that specification, or that specification as amended, shall be deemed to have been published.

Effect of  
publication of  
complete  
specification.

“54c. After a complete specification has become open to public inspection and until the sealing of a patent on the application, the applicant has, subject to section sixty-seven of this Act, the like privileges and rights as he would have had if a patent for the invention had been sealed on the date on which the complete specification became open to public inspection.”

10. Section fifty-five of the Principal Act is amended by omitting from paragraph (a) of sub-section (1.) the words " on an application or complete specification " and inserting in their stead the words " under this Act ". Certain documents not to be published.

11. Section fifty-seven of the Principal Act is repealed. Repeal of section fifty-seven.

12. Section fifty-nine of the Principal Act is amended by omitting sub-section (4.) and inserting in its stead the following sub-section:— Opposition to grant of patent.

" (4.) This section is subject to sections one hundred and fifty-eight and one hundred and fifty-nine of this Act."

13. Section sixty-seven of the Principal Act is amended— Date of patent.

(a) by omitting from sub-section (2.) the words " under sub-section (3.) of section forty-nine of this Act or under " and inserting in their stead the words " by virtue of sub-section (1.) of section forty-nine A of this Act or of "; and

(b) by omitting from sub-section (4.) the words " publication of the complete specification " and inserting in their stead the words " complete specification became open to public inspection ".

14. Sections seventy-eight and seventy-nine of the Principal Act are repealed and the following sections inserted in their stead:—

" 78.—(1.) An amendment under this Part is not allowable at any time, if, as a result of the amendment, the specification would claim matter not in substance disclosed in the specification as lodged. Nature of amendments allowable.

" (2.) An amendment under this Part is not allowable after the complete specification has become open to public inspection if, as a result of the amendment a claim of the specification would not in substance fall within the scope of the claims of the specification before amendment.

" (3.) The last two preceding sub-sections do not apply in respect of an amendment for the purpose of correcting a clerical error or an obvious mistake.

" (4.) An amendment under this Part is not allowable after the complete specification has become open to public inspection if, as a result of the amendment—

(a) the specification would not comply with the requirements of section forty of this Act; or

(b) the priority date of a claim as indicated would not be the priority date of that claim as determined by this Act.

" 79. An

Examination of request for amendment.

“79. An examiner shall ascertain and report whether—  
 (a) the request for leave to amend is as prescribed; and  
 (b) the amendment is allowable.”.

Advertisement of request.

15. Section eighty-one of the Principal Act is amended by omitting from sub-section (3.) the words “ been published ” and inserting in their stead the words “ become open to public inspection ”.

Notice of opposition.

16. Section eighty-two of the Principal Act is amended by omitting all the words after the word “ ground ” (first occurring) and inserting in their stead the words “ that the amendment is not allowable under section seventy-eight of this Act, but on no other ground, and shall serve a copy of the notice on the applicant or patentee.”.

Repeal of section eighty-seven.

17. Section eighty-seven of the Principal Act is repealed.

Repeal of section eighty-eight.

18. Section eighty-eight of the Principal Act is repealed.

Advertisement of amendment.

19. Section eighty-nine of the Principal Act is amended by omitting the words “ been published ” and inserting in their stead the words “ become open to public inspection ”.

Grounds of revocation.

20. Section one hundred of the Principal Act is amended—  
 (a) by omitting from paragraph (k) of sub-section (1.) the word “ and ”;  
 (b) by inserting after that paragraph the following paragraph:—  
     “ (ka) that allowance of an amendment under section forty-nine of this Act was obtained by fraud; and ”; and  
 (c) by omitting sub-section (4.) and inserting in its stead the following sub-section:—  
     “ (4.) This section is subject to sections one hundred and fifty-seven, one hundred and fifty-eight and one hundred and fifty-nine of this Act.”.

Declaration as to non-infringement.

21. Section one hundred and twenty of the Principal Act is amended by omitting sub-section (6.) and inserting in its stead the following sub-section:—

“ (6.) Proceedings for a declaration under this section may be taken at any time after the complete specification has become open to public inspection and references in this section to a patentee shall be read as including references to an applicant whose complete specification has become open to public inspection.”.

22. Section



**22.** Section one hundred and twenty-one of the Principal Act is amended—

Groundless threats of legal proceedings.

- (a) by omitting from paragraph (b) of sub-section (1.) the words “from the publication of the complete specification” and inserting in their stead the words “under section fifty-four c of this Act”; and
- (b) by inserting in sub-section (2.), after the word “patent”, the words “, or of an application for a patent,”.

**23.** Section one hundred and thirty-one of the Principal Act is amended by omitting from sub-section (3.) the word “published” and inserting in its stead the words “open to public inspection.”.

Prohibition of publication of information with respect to inventions.

**24.** Section one hundred and forty-two of the Principal Act is amended—

Multiple priorities.

- (a) by omitting from sub-section (1.) the words “and those inventions are so related as to constitute one invention”; and
- (b) by omitting sub-sections (2.) and (3.) and inserting in their stead the following sub-sections:—

“(2.) The Examiner shall report whether those inventions, in so far as they are included in the claims of the complete specification, are so related as to constitute one invention.

“(3.) If the Commissioner is of opinion that those inventions, in so far as they are included in the claims of the complete specification, are so related as to constitute one invention, he may accept the application and grant one patent on the application.”.

**25.** After section one hundred and fifty-seven of the Principal Act the following section is inserted:—

“157A. The Commissioner, the Appeal Tribunal or a court may, in construing a complete specification as amended, refer to the specification without the amendment.”.

Construction of amended specification.

**26.** After section one hundred and fifty-eight of the Principal Act the following sections are inserted:—

“159.—(1.) It is not competent for a person, in an action or other proceeding, to take objection to an application that has been accepted, or a patent is not invalid, by reason that the complete specification claims an invention that was not the subject of the application or that was not described or claimed in the specification as lodged.

Certain objections not competent.

(2.) Except

“(2.) Except in the case of an amendment made in contravention of section eighty-five of this Act, it is not competent for a person, in an action or other proceeding, to take objection to an application that has been accepted, or a patent is not invalid, by reason only that an amendment of the complete specification has been made that was not allowable.

Priority date  
of certain  
amended  
claims.

“ 159A.—(1.) Where—

- (a) an application and complete specification have been accepted; and
- (b) in an action or other proceeding before the Commissioner, the Appeal Tribunal or a court, the Commissioner, Appeal Tribunal or court finds that a claim of the specification claims matter (in this sub-section referred to as ‘ the new matter ’) in substance disclosed in the specification as a result of amendment of the specification,

the Commissioner, Appeal Tribunal or court shall treat as the priority date of that claim the date on which a statement of proposed amendments was lodged under section forty-nine of this Act, or a request seeking leave to make amendments was made under Part VIII., as a result of the making of which amendments the complete specification disclosed the new matter.

“(2.) Where, in pursuance of the last preceding sub-section, the Commissioner, the Appeal Tribunal or a court is required to treat a certain date as the priority date of a claim, objection shall not be taken to the application, or the patent is not invalid, so far as the invention is claimed in that claim, on the ground that the invention as so claimed is obvious and does not involve an inventive step, having regard to any publication or use of an invention after the disclosure of the latter invention in the complete specification as lodged.

“(3.) Where—

- (a) an application (being an application made by virtue of sub-section (1.) of section forty-nine A of this Act or sub-section (1.) of section fifty-one of this Act) and complete specification have been accepted; and
- (b) in an action or other proceeding before the Commissioner, the Appeal Tribunal or a court, the Commissioner, Appeal Tribunal or court finds that a claim of the specification claims matter (in this sub-section referred to as ‘ the new matter ’) in substance disclosed in the complete specification lodged in respect of the original application as a result of amendment of that specification,

the

the Commissioner, Appeal Tribunal or court shall treat as the priority date of that claim the date on which a statement of proposed amendments was lodged under section forty-nine of this Act, or a request seeking leave to make amendments was made under Part VIII., as a result of the making of which amendments the complete specification lodged in respect of the original application disclosed the new matter.

“(4.) Where, in pursuance of the last preceding sub-section, the Commissioner, the Appeal Tribunal or a court is required to treat a certain date as the priority date of a claim, objection shall not be taken to the application, or the patent is not invalid, so far as the invention is claimed in that claim, on the ground that the invention as so claimed is obvious and does not involve an inventive step, having regard to any publication or use of an invention after the disclosure of the latter invention in the complete specification as lodged in respect of the original application.

“(5.) Where an amended specification discloses matter as a result of an amendment made to a statement of proposed amendments lodged under section forty-nine of this Act, sub-sections (1.) and (3.) of this section have effect as if for the reference to the date on which the statement of proposed amendments was lodged there were substituted a reference to the date on which that amendment was made.

“(6.) Where an amended complete specification discloses matter as a result of an amendment made to a request lodged under section seventy-seven of this Act seeking leave to amend the specification, sub-sections (1.) and (3.) of this section have effect as if the reference to the date on which a request seeking leave to make amendments was made under Part VIII. there were substituted a reference to the date on which the request was amended.

“(7.) Where a complete specification as lodged has been amended for the purpose of correcting a clerical error or an obvious mistake, the references in this section to the complete specification as lodged shall be deemed to be references to the complete specification as so amended.

“159B. Where an amendment is made under this Act to a complete specification after the specification became open to public inspection, damages shall not be awarded, and an order shall not be made for an account of profits, in an action for an infringement of the patent occurring before the date of the decision or order allowing or directing the amendment—

Restriction  
on recovery  
of damages,  
&c.

(a) unless the court is satisfied that the specification without the amendment was framed in good faith and with reasonable skill and knowledge; or

(b) if

- (b) if the claim of the specification in respect of which the infringement is found is a claim in respect of which the court is required, by virtue of sub-section (1.) or sub-section (3.) of the last preceding section, to treat a certain date as the priority date.”.

Extension of times by reason of errors.

27. Section one hundred and sixty of the Principal Act is amended by omitting sub-section (4.) and inserting in its stead the following sub-section:—

“(4.) Where an application is made under sub-section (2.) of this section for an extension of time for more than three months, the Commissioner shall advertise the application in the *Official Journal*.”.

Transitional provisions with respect to action on Examiner's report.

28.—(1.) Where, before the commencement of this section, an Examiner has reported adversely to an application or specification under section forty-seven or section forty-eight of the *Patents Act* 1952, or of that Act as amended, and—

- (a) the applicant has amended the application or specification for the purpose of removing the grounds of objection; or  
 (b) the Commissioner has given a direction under sub-section (2.) of section forty-nine of the *Patents Act* 1952, or of that Act as amended,

the provisions of section forty-nine of the *Patents Act* 1952–1962 do not apply in relation to the application or specification and the provisions of sub-sections (1.), (2.) and (4.) of section forty-nine of the *Patents Act* 1952–1960 continue to apply in relation to the application or specification as if this Act had not been enacted.

(2.) Nothing in the last preceding sub-section affects the application to or in relation to an application or specification referred to in that sub-section of the provisions of the *Patents Act* 1952–1962 other than the provisions of section forty-nine of that Act but, in the application of section forty-nine A of that Act, the reference in sub-section (1.) of that section to an amendment made under the section last preceding that section shall be read as a reference to an amendment made under section forty-nine of the *Patents Act* 1952 or of that Act as amended before the commencement of this section.

Transitional provisions with respect to publication.

29.—(1.) Where—

- (a) before the commencement of this section, a separate or further application made by virtue of sub-section (3.) of section forty-nine or sub-section (1.) of section fifty-one of the *Patents Act* 1952, or of that Act as amended, became open to public inspection; and  
 (b) the

(b) the application in relation to which the separate or further application was made is not, at the commencement of this section, open to public inspection, the application in relation to which the separate or further application was made shall, upon the commencement of this section, become open to public inspection.

(2.) Where, before the commencement of this section—

(a) an application has become open to public inspection; and

(b) a separate or further application has been made by virtue of sub-section (3.) of section forty-nine or sub-section (1.) of section fifty-one of the *Patents Act* 1952, or of that Act as amended, in relation to the first-mentioned application,

and the separate or further application is not, at the commencement of this section, open to public inspection, the separate or further application shall, upon the commencement of this section, become open to public inspection.

(3.) Where an application has become open to public inspection under this section, the documents referred to in paragraphs (c) to (g) (inclusive) of sub-section (1.) of section fifty-four B of the *Patents Act* 1952–1962 are open to public inspection and the provisions of sub-sections (2.) and (3.) of the latter section have effect as if the application had become open to public inspection under sub-section (1.) of that section.

30.—(1.) The references in sub-section (4.) of section fifty-four A and sub-section (2.) of section sixty-seven of the *Patents Act* 1952–1962 to a separate application made by virtue of sub-section (1.) of section forty-nine A of that Act shall be read as including a reference to a separate application made by virtue of sub-section (3.) of section forty-nine of the *Patents Act* 1952, or of that Act as amended.

Transitional provisions with respect to divisional applications.

(2.) The reference in sub-section (3.) of section one hundred and fifty-nine A of the *Patents Act* 1952–1962 to a separate application made by virtue of sub-section (1.) of section forty-nine A of that Act shall be read as including a reference to a separate application made by virtue of sub-section (3.) of section forty-nine of the *Patents Act* 1952, or of that Act as amended.

31. The references in sub-sections (1.) and (3.) of section one hundred and fifty-nine A of the *Patents Act* 1952–1962 to the date on which a statement of proposed amendments was lodged under section forty-nine of that Act shall be read as including references to the date on which amendments were made under sub-section (1.) or (2.) of section forty-nine of the *Patents Act* 1952, or of that Act as amended.

Transitional provisions with respect to amendments.