

# Patents

No. 34 of 1969

An Act to amend the *Patents Act* 1952–1966.

[Assented to 14 June 1969]

**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* 1969.

Short title  
and citation.

(2.) The *Patents Act* 1952–1966\* 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* 1952–1969.

2.—(1.) Sections 1, 2, 6 and 7, sub-section (1.) of section 11 and sections 13, 22, 25, 29, 30, 31, 33, 39, 40, 41 and 44 of this Act shall come into operation on the day on which this Act receives the Royal Assent.

Commence-  
ment.

(2.) The remaining provisions of this Act shall come into operation on a date to be fixed by Proclamation.

3. Section 3 of the Principal Act is amended by omitting the words—

Parts.

“ Part V.—Opposition (Sections 59–61).”

and inserting in their stead the words—

“ Part V.—Opposition (Sections 59–60).”.

4. Section 5 of the Principal Act is amended by omitting from sub-section (4.) the words “ and any reference in this Act to a priority date indicated in a claim includes a reference to such a priority date ”.

Application  
of Act.

5. Section 6 of the Principal Act is amended—

Definitions.

(a) by inserting before the definition of “ Examiner ” the following definition:—

“ ‘ examination ’, in relation to an application for a patent and the complete specification lodged in respect of the application, means an examination of the application and complete specification in accordance with section forty-eight of this Act or a modified examination of the application and complete specification, and ‘ examine ’ has a corresponding meaning;” and

\* Act No. 42, 1952, as amended by No. 14, 1954; No. 3, 1955; No. 107, 1960; No. 84, 1962; and No. 93, 1966.

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

“ ‘modified examination’, in relation to an application for a patent and the complete specification lodged in respect of the application, means an examination of the application and complete specification in accordance with section fifty-two C of this Act;”.

Who may apply for patent.

6. Section 34 of the Principal Act is amended by adding at the end thereof the following sub-section:—

“(4.) Where, at any time before a patent has been granted, a person would, if the patent were then granted, be entitled, by virtue of an assignment or agreement made by the applicant or one of the applicants for the patent, or by operation of law, to the patent or to the interest of the applicant in the patent or to an undivided share in the patent or in that interest—

- (a) the Commissioner may, upon a request being made as prescribed, direct that the application is to proceed in the name of the person or in the names of the person and the applicant or the other joint applicant or applicants, as the case requires; and
- (b) upon such a direction being given, this Act applies as if the person were the applicant or one of the joint applicants, as the case requires.”.

Form of application.

7. Section 35 of the Principal Act is amended by inserting before paragraph (a) of sub-section (1.) the following paragraph:—

“(aa) shall be in respect of a manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies;”.

Each claim of complete specification to have a priority date.

8. Section 44 of the Principal Act is amended by omitting sub-section (2.) and inserting in its stead the following sub-section:—

“(2.) Where a claim of a complete specification defines more than one form of an invention, the claim shall, for the purposes of the application of the provisions of this Act relating to the priority date of the claim, be deemed to constitute a separate claim in relation to each form of the invention that is so defined.”.

Priority dates.

9. Section 45 of the Principal Act is amended—

(a) by inserting after sub-section (3.) the following sub-section:—

“(3A.) The priority date of a claim of a complete specification accompanying an application made by virtue of sub-section (1.) of section forty-nine A of this Act, 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 forty-nine or section fifty-two D of this Act or would be excluded if an amendment included in a statement of proposed amendments lodged under either of those sections were 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.”; and

(b) by inserting after sub-section (4.) the following sub-section:—

“(4A.) Where a patent has been revoked in circumstances referred to in section one hundred and seven of this Act, the priority date of a claim of a complete specification lodged in respect of an application made after the revocation by virtue of that section, being a claim fairly based on matter disclosed in the complete specification of the revoked patent, is the date that would have been the priority date of that claim if that claim were a claim of the complete specification of the revoked patent.”.

10. Sections 47, 48, 48A, 49 and 49A of the Principal Act are repealed and the following sections inserted in their stead:—

“47. An applicant may, at any time before the expiration of five years after the date of lodgment of the complete specification or the expiration of two years after the date fixed under sub-section (2.) of section two of the *Patents Act* 1969, whichever is the later, request the making of an examination of the application and complete specification. Request for examination.

“47A.—(1.) Where a complete specification has been lodged in respect of an application and the Commissioner considers it desirable to give a direction under this section on all or any of the grounds specified in the next succeeding sub-section, he may, at any time before the expiration of five years after the date of lodgment of the complete specification or the expiration of two years after the date fixed under sub-section (2.) of section two of the *Patents Act* 1969, whichever is the later, by notice in writing given to the applicant, direct the applicant to request the making of an examination of the application and complete specification. Power of Commissioner to direct applicant to request examination.

“(2.) The grounds referred to in the last preceding sub-section are—

- (a) that the Commissioner considers it expedient to give the direction having regard to the progress made in the examination of applications lodged before the date of lodgment of the application concerned;
- (b) that the Commissioner considers it to be in the public interest to give the direction; and
- (c) that the Commissioner considers it expedient to give the direction having regard to the examination of another application.

“(3.) Where the Commissioner gives a direction to an applicant under this section, he shall at the same time inform the applicant of the ground or grounds on which the direction is given.

Any person may require Commissioner to direct applicant to request examination.

“47B.—(1.) At any time before the expiration of five years after the date on which a complete specification has been lodged in respect of an application or the expiration of two years after the date fixed under sub-section (2.) of section two of the *Patents Act* 1969, whichever is the later, a person other than the applicant may, by notice in writing lodged at the Patent Office, require the Commissioner to direct the applicant to request the making of an examination of the application and complete specification and, unless the applicant has already made, or been directed to make, such a request, the Commissioner shall, upon receipt of the notice, by notice in writing given to the applicant, direct the applicant accordingly.

“(2.) The last preceding sub-section does not apply in relation to an application and complete specification unless the application and complete specification have become open to public inspection.

Application to lapse if request not made.

“47C. Where an applicant does not request the making of an examination of the application and complete specification—

- (a) before the expiration of five years after the date of lodgment of the complete specification or the expiration of two years after the date fixed under sub-section (2.) of section two of the *Patents Act* 1969, whichever is the later; and
- (b) where he has been directed by the Commissioner to make the request—before the expiration of six months after the date on which the direction was given,

the application shall lapse.

Application to lapse if continuation fee not paid.

“47D.—(1.) Subject to this section, an application shall lapse if the applicant fails, within the prescribed time, to pay a fee prescribed for the purposes of this section (in this section and the next succeeding section referred to as a ‘continuation fee’).

“(2.) If an applicant fails to pay a continuation fee within the prescribed time, he may apply to the Commissioner for an extension of the time for making that payment, and the Commissioner shall extend the time accordingly, but the time for making a payment shall not be extended for more than six months.

Restoration of lapsed application.

“47E.—(1.) Where an application has lapsed under either of the last two preceding sections, the Commissioner shall advertise that fact in the *Official Journal*.

“(2.) The applicant may make an application (in this section referred to as ‘the application for restoration’) to the Commissioner for the restoration of the lapsed application.

“(3.) The application for restoration shall—

- (a) in the case of an application that lapsed under section forty-seven C of this Act—be accompanied by a request for the making of an examination of the lapsed application and the complete specification and contain a statement of the circumstances that led to the failure to make the request within the prescribed time; or
- (b) in the case of an application that lapsed under the last preceding section—be accompanied by the unpaid continuation fee and contain a statement of the circumstances that led to the failure to pay the fee within the prescribed time.

“(4.) If the Commissioner is satisfied that the failure to make the request or to pay the continuation fee, as the case may be, within the prescribed time was unintentional and resulted from an error or omission on the part of the applicant or of his agent or attorney or from circumstances beyond the control of the applicant and that there has been no undue delay in the making of the application for restoration, the Commissioner shall advertise the application for restoration in the *Official Journal*, but if he is not so satisfied, he shall refuse the application for restoration.

“(5.) A person interested may, within such time as is prescribed, give notice to the Commissioner of opposition to the restoration and shall serve a copy of the notice on the applicant.

“(6.) If notice of opposition is not so given, the Commissioner shall restore the lapsed application.

“(7.) If notice of opposition is so given, the Commissioner shall hear the case and either restore the lapsed application or refuse the application for restoration.

“(8.) Where a lapsed application is restored 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 contract or otherwise to avail themselves, of the subject-matter of the lapsed application after the lapse of the application was advertised in the *Official Journal* and before the date of the first advertisement of the application for restoration.

“(9.) Proceedings shall not be taken in pursuance of section fifty-four C of this Act in respect of any act or thing done during the period from and including the date on which the application for the patent lapsed to and including the date of the restoration of the application.

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

**Examination  
of application  
and complete  
specification.**

“ 48.—(1.) Subject to section fifty-two c of this Act, where an applicant requests, in pursuance of this Act, the making of an examination of the application and complete specification, an Examiner shall make an examination of the application and complete specification in accordance with this section.

“ (2.) The Examiner shall 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 could be refused under section one hundred and fifty-five of this Act.

“ (3.) In respect of the complete specification, the Examiner—

- (a) shall ascertain and report whether the invention, so far as claimed in any claim, is the subject of a claim of the complete specification of another application for a patent lodged in Australia, being a claim having a priority date earlier than the priority date of the first-mentioned claim;
- (b) shall ascertain and report whether the invention, so far as claimed in any claim, has been published before the priority date of that claim in a specification lodged in respect of an application for a patent made in Australia within fifty years before that date;
- (c) shall ascertain and report whether the invention, so far as claimed in any claim, is the subject of a claim of earlier priority date contained in the complete specification of a patent;
- (d) shall ascertain and report whether the invention, so far as claimed in any claim, has, before the priority date of the claim, been published in Australia in any other document (not being a document referred to in paragraph (a) of sub-section (1.) of section one hundred and fifty-eight of this Act) to which, or that is included in a class of documents to which, he is, or Examiners generally are, directed to have regard by the Commissioner; and
- (e) shall report whether, to the best of his knowledge, the invention, so far as claimed in any claim, was novel on the priority date of the claim and, if he reports that the invention was not novel on that date, shall specify the reasons for that report.

“ (4.) The reference in paragraph (a) of the last preceding sub-section to an application does not include a reference to an application that has lapsed or has been refused or withdrawn or to an application upon which a patent has been granted and the reference in paragraph (c) of that sub-section to a patent does not include a reference to a patent that is not in force.

“(5.) In making a report under sub-section (3.) of this section, an Examiner shall have regard to any matter of which notice has been duly given to the Commissioner under section fifty-seven of this Act and, for the purposes of paragraph (e) of sub-section (3.) of this section, any such matter shall be deemed to be within the knowledge of the Examiner.

“48A. Where a complete specification has been amended under Part VIII. after an Examiner has made a report under the last preceding section 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 that section, and this Act applies to a report so made as if it were a report under that section.

Additional  
report where  
specification  
amended.

“49.—(1.) If an Examiner reports adversely to an application or specification under either of the last two preceding sections, the applicant may lodge at the Patent Office a statement in writing of proposed amendments of the application or specification.

Action on  
Examiner's  
report on  
examination.

“(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 the Examiner reports adversely under the last preceding sub-section, the applicant may amend the statement of proposed amendments 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 specification (not being an amendment for the purpose of correcting a clerical error or an obvious mistake) is not allowable if the specification would, as a result of the amendment, claim matter not in substance disclosed in the specification as lodged.

“(5.) If the Commissioner is satisfied that a proposed amendment is an allowable amendment, or that proposed amendments are allowable amendments, and that, if that amendment or those amendments were made, all lawful grounds of objection to the application or specification under the last two preceding sections would be removed, the Commissioner shall allow the amendment or amendments, which shall thereupon be deemed to be made.

“(6.) If the application or specification is not amended as provided by the last preceding sub-section, the Commissioner may, by notice in writing given to the applicant, direct that the applicant lodge a statement of proposed amendments to the satisfaction of the Commissioner within such time as the Commissioner allows.

“(7.) 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 that, if those amendments

were made, all lawful grounds of objection to the application and specification under the last two preceding sections would be removed, the Commissioner shall allow the amendments which shall thereupon be deemed to be made.

“(8.) An appeal lies to the Appeal Tribunal from a direction of the Commissioner under sub-section (6.) of this section.

Division of  
application  
after objection.

“49A.—(1.) The applicant may make a separate application for a patent for an invention falling within the scope of a claim—

- (a) that has been excluded by an amendment made under section forty-nine or section fifty-two D of this Act; or
- (b) that would be excluded if an amendment included in a statement of proposed amendments lodged under either of those sections were made.

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

Single patent  
for cognate  
inventions.

11.—(1.) Section 50 of the Principal Act is amended—

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

“(1A.) Where the applications were lodged by the same applicant, the applications shall, subject to section fifty A of this Act, be treated for the purposes of this Act as if they constituted one application made by that applicant.

“(1B.) Where the applications were lodged by different applicants, the applications shall, subject to section fifty A of this Act, be treated for the purposes of this Act as if they constituted one application made jointly by those applicants.”; and

(b) by omitting sub-section (5.).

(2.) Section 50 of the Principal Act is amended by omitting from sub-section (2.) the words “The Examiner” and inserting in their stead the words “Where a request has been made for the making of an examination of the applications and the complete specification, the Examiner”.

Procedure  
where single  
patent not  
granted.

12. Section 50A of the Principal Act is amended—

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

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

“(ca) the request for the making of an examination of the applications and the cancelled complete specification shall, for the purposes of the operation of this Act in relation to each application and the complete specification lodged in respect of that application under the last preceding paragraph, be treated as if it were a request by the applicant for the making of an examination of



the application and of that complete specification and had been made on the date of lodgment of that complete specification; and ”.

13. Section 51 of the Principal Act is amended by omitting sub-section (1.) and inserting in its stead the following sub-section:—

Voluntary  
division of  
application.

“ (1.) An applicant for a patent (not being an applicant in respect of 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.”.

14. After section 52 of the Principal Act the following sections are inserted:—

“ 52A.—(1.) Where a Convention application has been made and—

(a) a patent has been granted in a prescribed Convention country in respect of an application made in that country that—

Request for  
modified  
examination of  
application and  
complete  
specification.

(i) constitutes the basic application or one of the basic applications for the purposes of Part XVI.; or

(ii) claimed a priority in that country based on an application made in another country that constitutes the basic application or one of the basic applications for the purposes of that Part; and

(b) the specification of that patent is in the English language,

the applicant, instead of requesting the making of an examination of the application and the complete specification in accordance with section forty-eight of this Act, may request, as prescribed, the making of a modified examination of the application and complete specification.

“ (2.) The request is of no effect unless it is accompanied by a copy of the specification of the patent granted in the prescribed Convention country, being a copy certified by the official chief or head of the Patent Office in that country or otherwise verified to the satisfaction of the Commissioner.

“ (3.) Where the text and drawings (if any) of the complete specification lodged in respect of the application, or of that specification as amended under Part VIII., are not, apart from matters of form, the same as the text and drawings (if any) of the specification of the patent granted in the prescribed Convention country, the applicant shall lodge with the request a statement in writing of proposed amendments for the purpose of making the text and drawings (if any) of the complete specification the same, apart from matters of form, as the text and drawings (if any) of the specification that accompanied the request.

“ (4.) At any time before acceptance of the application and complete specification, the applicant may withdraw the request and may request

the making of an examination of the application and complete specification in accordance with section forty-eight of this Act.

Request for  
deferment of  
examination of  
an application  
and complete  
specification.

“ 52B.—(1.) Where—

- (a) a Convention application has been made;
- (b) an application for protection in respect of an invention (in this section referred to as a ‘ foreign application ’) has been made in a prescribed Convention country, being an application that—
  - (i) constitutes the basic application or one of the basic applications for the purposes of Part XVI.; or
  - (ii) claims a priority in that country based on an application made in another country that constitutes the basic application or one of the basic applications for the purposes of that Part;
- (c) a patent has not been granted in respect of the foreign application; and
- (d) the applicant has been directed by the Commissioner under section forty-seven A of this Act to request the making of an examination of the application and complete specification, being a direction given on a ground that is not, or on grounds that do not include, either of the grounds specified in paragraphs (b) and (c) of sub-section (2.) of that section,

the applicant, instead of requesting the making of an examination of the application and complete specification, may request, as prescribed, the deferment of the examination of the application and complete specification.

“ (2.) Where an applicant makes a request in accordance with the last preceding sub-section, paragraph (b) of section forty-seven C of this Act does not apply in relation to the application.

“ (3.) Where—

- (a) the applicant does not request the making of an examination of the application and complete specification before the expiration of nine months after the date on which the request for deferment was lodged in the Patent Office; and
- (b) the application has not previously lapsed under section forty-seven C of this Act,

the application shall lapse.

“ (4.) Section forty-seven E of this Act applies in relation to an application that has lapsed under the last preceding sub-section as it applies in relation to an application that has lapsed under section forty-seven C of this Act

Modified  
examination of  
application  
and complete  
specification.

“ 52C.—(1.) Where an applicant requests the making of a modified examination of the application and complete specification, an Examiner shall make an examination of the application and complete specification in accordance with this section.

“(2.) The Examiner shall report—

- (a) whether the request is as prescribed;
- (b) whether the application complies with the requirements of this Act other than the requirement of paragraph (a) of sub-section (1.) of section thirty-five of this Act;
- (c) whether the text and drawings (if any) of the complete specification, or of the complete specification as proposed to be amended under sub-section (3.) of section fifty-two A of this Act, are, apart from matters of form, the same as the text and drawings (if any) of the specification of the patent granted in the prescribed Convention country;
- (d) whether any proposed amendments of the complete specification that have been lodged under sub-section (3.) of section fifty-two A of this Act would be allowable under section forty-nine of this Act if that section were applicable; and
- (e) whether acceptance of the application and complete specification could be refused under section one hundred and fifty-five of this Act.

“(3.) Subject to the regulations, sub-sections (3.), (4.) and (5.) of section forty-eight of this Act have effect in relation to the examination of the complete specification in accordance with this section.

“(4.) The regulations may, either generally or in relation to applications included in such classes of applications as are specified in the regulations, exclude or modify the operation, for the purposes of the examination of applications and complete specifications in accordance with this section, of all or any of the provisions of the sub-sections of section forty-eight referred to in the last preceding sub-section.

“52D.—(1.) If the Examiner reports adversely under the last preceding section, the succeeding sub-sections of this section have effect.

Action on  
Examiner's  
report on  
modified  
examination.

“(2.) The applicant may do either or both of the following things:—

- (a) if the request is not as prescribed—he may lodge at the Patent Office an amended request for a modified examination of the application and complete specification;
- (b) he may lodge at the Patent Office a statement in writing of proposed amendments of the application or complete specification, or, if such a statement has been lodged under sub-section (3.) of section fifty-two A of this Act, amend the statement, for the purpose of—
  - (i) removing a ground of objection to the application under the last preceding section;
  - (ii) excluding a claim or claims of the complete specification and making any consequential amendments of any other claim of the specification; or

- (iii) making the text and drawings (if any) of the complete specification the same, apart from matters of form, as the text and drawings (if any) of the specification of the patent granted in the prescribed Convention country.

“(3.) Subject to the next succeeding sub-section, the Examiner shall report in accordance with the last preceding section as if the amended request for a modified examination were the original request for such an examination, or the statement or amended statement of proposed amendments had been lodged with the request for a modified examination, as the case may be, and shall also report whether the proposed amendments are allowable.

“(4.) The Examiner shall not report under the last preceding sub-section that the text of the complete specification, or of that specification as proposed to be amended under sub-section (3.) of section fifty-two A of this Act and sub-section (2.) of this section, is not the same as the text of the specification of the patent granted in the prescribed Convention country if those texts differ by reason only of amendments proposed to be made under sub-paragraph (ii) of paragraph (b) of sub-section (2.) of this section.

“(5.) If the Examiner reports adversely under sub-section (3.) of this section, sub-section (1.) of this section applies as if that report were a report under the last preceding section.

“(6.) If the Commissioner is satisfied that—

- (a) a proposed amendment is an allowable amendment, or proposed amendments are allowable amendments, under paragraph (b) of sub-section (2.) of this section;
- (b) the proposed amendment would be an allowable amendment, or the proposed amendments would be allowable amendments, under section forty-nine of this Act if that section were applicable; and
- (c) if the proposed amendment or the proposed amendments were made, all lawful grounds of objection to the application or specification under the last preceding section would be removed,

the Commissioner shall allow the amendment or amendments, which shall thereupon be deemed to be made.

“(7.) If the Commissioner is satisfied that there is no lawful ground of objection to the application and complete specification under the last preceding section, or that the grounds of objection to the application and complete specification under that section have been removed, the Commissioner shall accept the application and complete specification.

“(8.) If the Commissioner is not so satisfied, he may—

- (a) refuse to accept the application and complete specification; or
- (b) direct the applicant to lodge a statement of proposed amendments of the application and complete specification, or, if such a statement has been lodged under sub-section (3.) of section fifty-two A

of this Act or under paragraph (b) of sub-section (2.) of this section, amend the statement, to the satisfaction of the Commissioner within such time as the Commissioner allows.

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

“(10.) Section fifty-two of this Act (other than sub-section (4.) of that section) does not apply in relation to an application and complete specification that has been examined in accordance with the last preceding section and, for the purposes of the application of sub-section (4.) of section fifty-two of this Act in relation to such an application and complete specification, an advertisement in the *Official Journal* of the acceptance of the application and complete specification shall include a statement that the acceptance has resulted from a modified examination.

“52E. The provisions of this Act relating to a modified examination of an application and complete specification do not affect the operation of sections fifty-nine and one hundred of this Act.”

Modified examination not to affect opposition to, or revocation of, grant of patent.

15. Section 54 of the Principal Act is amended—

Time for acceptance.

(a) by omitting sub-section (1.) and inserting in its stead the following sub-sections:—

“(1.) Subject to this section, the period within which an application and complete specification may be accepted is twelve months after the date on which the first report of the Examiner arising out of the examination of the application and complete specification was sent to the applicant, whether that report arose out of an examination made in accordance with section forty-eight of this Act or out of a modified examination.

“(1A.) Subject to the succeeding provisions of this section, if an applicant has requested the making of a modified examination of an application and complete specification but has withdrawn that request and has requested the making of an examination of the application and complete specification in accordance with section forty-eight of this Act, the period within which the application and complete specification may be accepted is twelve months after the date on which the first report of the Examiner arising out of the examination of the application and complete specification made in accordance with section forty-eight of this Act was sent to the applicant.

“(1B.) The Commissioner may extend the period within which an application and complete specification may be accepted, whether or not that period has expired, but an extension of time under this sub-section shall not be granted for a period expiring more than twenty-one months after the date referred to in sub-section (1.) of this section.”; and

- (b) by omitting from sub-section (4.) the words " sub-section (1.) of " and inserting in their stead the words " sub-section (3.) of ".

Effect of  
publication  
of complete  
specification.

16. Section 54c of the Principal Act is amended—

- (a) by inserting after the words " subject to " the words " this section, to sub-section (9.) of section forty-seven E of this Act and to "; and
- (b) by adding at the end thereof the following sub-sections:—

" (2.) The last preceding sub-section does not give to the applicant a right to bring an action or proceeding in respect of the doing of an act unless the act would, if it had been done after the sealing of the patent that was granted on the application, have constituted an infringement of a claim of the complete specification to which that patent relates.

" (3.) It is a defence to an action or proceeding brought under sub-section (1.) of this section in respect of the doing of an act after the complete specification became open to public inspection but before the application was accepted if the defendant establishes that a patent could not validly have been granted in respect of the claim of the complete specification, as framed at the time when the act was done, that is alleged to have been infringed by the doing of that act."

Result of  
search may be  
disclosed.

17. Section 56 of the Principal Act is amended by inserting before the words " section forty-eight " the words " sub-section (3.) of ".

18. After section 56 of the Principal Act the following section is inserted:—

Notice to  
Commissioner  
of matters  
affecting  
validity of  
patent.

" 57.—(1.) At any time after a notification that a complete specification is open to public inspection has been published in the *Official Journal* and before acceptance of the application and complete specification has been advertised in the *Official Journal*, any person may, by notice in writing lodged at the Patent Office and accompanied by such documents as are prescribed, inform the Commissioner of any matter—

- (a) that has been published in a document in Australia before the priority date of a claim of that specification as so open to public inspection; and
- (b) that the person asserts would, if a patent were granted in respect of the invention so far as claimed in that claim, affect the validity of that patent on a ground specified in paragraph (e), (f) or (g) of section one hundred of this Act.

" (2.) The Commissioner shall give notice in writing to the applicant of any matter to which a notice given to the Commissioner under the last preceding sub-section relates.

" (3.) Any document that accompanied a notice given to the Commissioner under sub-section (1.) of this section is open to public inspection."

19. Section 59 of the Principal Act is amended by inserting after sub-section (2.) the following sub-section:—

“(2A.) Where a person (in this sub-section referred to as ‘the opponent’) lodges notice of opposition to the grant of a patent on the ground specified in paragraph (c) of sub-section (1.) of this section and a request has not been made for the making of an examination of the other application referred to in that paragraph and the complete specification lodged in respect of that application, then if—

(a) where the opponent is the person, or one of the persons, who lodged the other application—such a request is not made within three months after the notice of opposition was lodged; or

(b) in any other case—such a request is not made within the period referred to in the last preceding paragraph and the opponent does not, within that period, give notice to the Commissioner under section forty-seven B of this Act requiring him to direct the person who lodged the other application to make such a request,

the notice of opposition, so far as it relates to that ground, shall be deemed to have been withdrawn and a further notice of opposition to the grant of the patent on that ground is not receivable.”.

Opposition to grant of patent.

20. Section 60 of the Principal Act is amended by omitting sub-section (2.) and inserting in its stead the following sub-section:—

“(2.) In so deciding the case the Commissioner may take into account a ground of opposition specified in the last preceding section whether relied upon by the opponent or not.”.

Notice of opposition to applicant and hearing.

21. Section 61 of the Principal Act is repealed.

Notice of opposition may be given on basis that indicated priority date is incorrect.

22. Section 63 of the Principal Act is amended by omitting paragraph (b) of sub-section (1.).

Refusal of assignee or joint applicant to proceed.

23. Section 73 of the Principal Act is amended by inserting after sub-section (2.) the following sub-section:—

“(2A.) An application for a patent of addition and the complete specification lodged in respect of that application shall not be examined before a request is made for the making of an examination of the application for the patent for the main invention and of the complete specification lodged in respect of that application.”.

Grant of patent of addition.

24. Section 78 of the Principal Act is amended by omitting sub-section (4.) and inserting in its stead the following sub-section:—

“(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, the specification would not comply with the requirements of section forty of this Act.”.

Nature of amendments allowable.

Application for restoration of patents that have ceased.

**25. Section 97 of the Principal Act is amended—**

(a) by omitting sub-section (1.) and inserting in its stead the following sub-section:—

“ (1.) Where a patent has ceased (whether before or after the commencement of the *Patents Act 1969*) by reason of failure to pay a prescribed fee within the prescribed time—

(a) the patentee;

(b) if the patentee has died—the legal representative of the deceased patentee; or

(c) a person who would, if the patent had not ceased, have been entitled to the patent,

may apply to the Commissioner for the restoration of the patent.”; and

(b) by omitting from sub-section (3.) the word “ patentee ” and inserting in its stead the words “ applicant for the restoration of the patent ”.

Grounds of revocation.

**26. Section 100 of the Principal Act is amended by inserting in paragraph (ka) of sub-section (1.), after the word “ forty-nine ”, the words “ or section fifty-two D ”.**

Petition may be presented on basis that indicated priority date is incorrect.

**27. Section 101 of the Principal Act is repealed.**

Grant of patent where patent revoked.

**28. Section 107 of the Principal Act is amended by omitting sub-sections (2.) and (2A.).**

Applications under International Conventions.

**29. Section 141 of the Principal Act is amended by omitting from sub-sections (1.) and (2.) the words “ a patent or similar ”.**

Multiple priorities.

**30. Section 142 of the Principal Act is amended—**

(a) by omitting from sub-section (1.) the words “ patents or similar ”; and

(b) by omitting sub-sections (2.), (3.) and (5.).

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

**31. Section 142AA of the Principal Act is amended by omitting from paragraphs (a) and (d) the words “ a patent or similar ”.**

Priority dates may be amended.

**32. Section 156 of the Principal Act is repealed.**

Invention not anticipated or patent not invalid in certain cases.

**33. Section 158 of the Principal Act is amended by omitting from sub-paragraph (ii) of paragraph (a) of sub-section (1.) the words “ a patent or similar ”.**



**34. Section 159A of the Principal Act is amended—**

Priority date of certain amended claims.

- (a) by omitting from sub-section (1.) the words “ 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 ” and inserting in their stead the words “ the new matter was disclosed in a statement of proposed amendments of the complete specification lodged under section forty-nine, section fifty-two A or section fifty-two D of this Act or in a request made under Part VIII. seeking leave to make amendments of the complete specification ”;
- (b) by omitting from sub-section (3.) the words “ 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 ” and inserting in their stead the words “ the new matter was disclosed in a statement of proposed amendments of the complete specification lodged in respect of the original application, being a statement lodged under section forty-nine, section fifty-two A or section fifty-two D of this Act, or in a request made under Part VIII. seeking leave to make amendments of that complete specification ”; and
- (c) by inserting in sub-section (5.), after the words “ section forty-nine ”, the words “, section fifty-two A or section fifty-two D ”.

**35. Section 159B of the Principal Act is amended by adding at the end thereof the following sub-section:—**

Restriction on recovery of damages, &c.

“ (2.) This section has effect subject to sub-sections (2.) and (3.) of section fifty-four c of this Act.”

**36. After section 159B of the Principal Act the following section is inserted:—**

**“ 159C.—(1.) Where—**

Applications for licences.

- (a) a claim of a complete specification lodged in respect of an application for a patent has been amended;
- (b) before the date of the amendment, a person gave to the Commissioner a notice under sub-section (1.) of section fifty-seven of this Act in relation to the invention so far as claimed in that claim; and
- (c) after the date on which the notice was given but before the date of the amendment, that person availed himself, or took definite steps

by way of contract or otherwise to avail himself, of the invention so far as claimed in that claim on the basis that a patent could not validly be granted in relation to that claim,

that person may apply, as prescribed, to the Commissioner for the grant of a licence to make, use, exercise and vend the invention except in so far as the making, using, exercising or vending would constitute an infringement of a claim that was included in the specification before the amendment and in relation to which a patent has been validly granted.

“(2.) A licence shall not be granted under the last preceding sub-section if the Commissioner or the Appeal Tribunal, as the case may be, is satisfied that a statement proposing the amendment was lodged at the Patent Office with reasonable diligence after notice was given to the applicant for the patent under sub-section (2.) of section fifty-seven of this Act of the matters to which the notice referred to in paragraph (b) of sub-section (1.) of this section related.

“(3.) The regulations may make provision for and in relation to the hearing and determination of applications under sub-section (1.) of this section.

“(4.) A licence granted under this section shall be on such terms as the Commissioner thinks just.

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

Extension of times by reason of errors.

37. Section 160 of the Principal Act is amended by adding at the end thereof the following sub-section:—

“(8.) This section does not apply in relation to the doing of an act or the taking of a step under section forty-seven, section forty-seven A, section forty-seven B, section forty-seven C or sub-section (1.) of section fifty-two B of this Act.”.

Exercise of discretionary power by Commissioner.

38. Section 162 of the Principal Act is amended by adding at the end thereof the following sub-section:—

“(2.) The last preceding sub-section does not apply in relation to the power of the Commissioner to give a direction under section forty-seven A or section forty-seven B of this Act.”.

39. After section 172 of the Principal Act the following section is inserted:—

Service of documents.

“172A. Where this Act provides for a notice, direction or other document to be served on, or given or sent to, a person and the person has furnished to the Commissioner an address in Australia for service of documents, the notice, direction or other document may be served on, or given or sent to, the person by post to that address.”.

Fees.

40. Section 176 of the Principal Act is amended by adding at the end thereof the following sub-section:—

“(4.) The regulations may make provision for the refund, in circumstances specified in the regulations, of the whole or any part of a fee paid in respect of the lodgment of a document at the Patent Office.”.

**41.** Section 177 of the Principal Act is amended by omitting paragraph (ab) and inserting in its stead the following paragraphs:— Regulations.

“(ab) empowering the Commissioner to direct an applicant for a patent to do such things as are necessary to ensure that the complete specification is in accordance with the requirements of the regulations relating to the preparation of documents for lodgment at the Patent Office and—

- (i) providing for the lapsing of the application if such a direction by the Commissioner is not complied with within a time specified in the regulations; and
- (ii) making provision for and in relation to the restoration of an application that has so lapsed;

“(ac) making provision for and in relation to appeals to the Appeal Tribunal from decisions of the Commissioner made under the regulations;”.

**42.—(1.)** The amendments of the Principal Act made by sections 4, 5 and 8 to 10 (inclusive), sub-section (2.) of section 11, sections 12, 14 and 15, paragraph (a) of section 16 and sections 17 to 21 (inclusive), 23, 24, 26 to 28 (inclusive), 30, 32, 34, 36, 37 and 38 of this Act apply in relation to applications for patents other than an application in respect of which a copy of the first report of an Examiner on the complete specification was sent to the applicant before the date fixed under sub-section (2.) of section 2 of this Act. Restricted application of certain amendments.

(2.) The amendments of the Principal Act made by paragraph (b) of section 16 and section 35 of this Act apply in relation to applications for patents other than an application in respect of which the complete specification became open to public inspection before the date fixed under sub-section (2.) of section 2 of this Act.

**43.** Where a claim of a complete specification lodged in respect of an application in relation to which the amendments referred to in sub-section (1.) of the last preceding section apply contains a reference to the date that the applicant considers to be the priority date of the claim, the Commissioner may amend the specification by omitting the reference to that date from the claim. Power of Commissioner to amend complete specifications to omit references to priority dates of claims.

**44.** At any time after this Act receives the Royal Assent and before the date fixed under sub-section (2.) of section 2 of this Act regulations may be made under the Principal Act as amended by this Act as if the provisions of this Act referred to in that sub-section had come into operation on the date on which this Act receives the Royal Assent, but regulations so made shall not come into operation before the date fixed under that sub-section. Making of regulations.