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HOUSE OF REPRESENTATIVES

PATENTS AMENDMENT (PATENT COOPERATION TREATY) BILL 1979

NOTES ON CLAUSES

(Circulated by the Minister for Productivity,
the Honourable Ian Macphee)

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General Description of the Bill

The Bill is intended to amend the Patents Act 1952 as the Principal Act to enable the procedures specified in the Patent Cooperation Treaty to be adopted as an optional application procedure in obtaining a standard patent or a petty patent as provided by the Act.

Essentially, the Bill provides for:-

- . recognition of applications which satisfy the requirements of the Treaty (international applications), and which specify Australia as a country in which protection is sought, as applications for a patent (i.e. a standard patent or petty patent) under the Patents Act;
- . deferment of the lodgment of the application documents and the commencement of proceedings in the Patent Office in accordance with the times specified in the Treaty;
- . publication of international applications under the Patents Act on the basis of the receipt in the Patent Office of a copy of the application published under the Treaty.

Introduction

1. Clauses 1 and 2 of the Bill provide for the short title and commencement of the legislation. Clause 2 provides that the approval given to Australian accession to the Patent Cooperation Treaty under clause 3 will date from the date of

assent. This clause further provides that the procedures for the lodgment of applications introduced by the Bill will commence when the Treaty enters into force for Australia. By the terms of the Treaty, the entry into force takes place three months after the deposit of the instrument of accession.

Schedule

2. Clauses 4 and 6 number the present Schedule to the Patents Act as Schedule 1. Clause 7 introduces the English text of the Patent Cooperation Treaty, including the Regulations under the Treaty as amended, as Schedule 2.

International Applications

3. Clause 5 introduces an additional Part, Part IV A, into the Patents Act. The purpose of this Part is to introduce into the Patents Act the provisions necessary for implementing the procedures specified in the Patent Cooperation Treaty in accordance with the terms of the Treaty contained in Schedule 2. Broadly, Part IV A provides that an international application which is lodged in accordance with the Treaty, either in Australia or in any other country party to the Treaty, and which designates Australia as a State in which protection is desired, will be treated as an application for a patent under the Patents Act. Because the present provisions of the Patents Act do not conform to all the requirements of the Treaty, a number of particular amendments are necessary to ensure that the lodgment, prosecution and publication of international applications under the Patents Act will conform to the requirements of the Treaty. These amendments are contained in proposed sections 58A to 58K of the Patents Act.

Interpretation

4. Sub-section 58A(1) introduces a number of terms derived from the Patent Cooperation Treaty into the Patents Act:

"international application" means an application filed under the Treaty (see Article 2(vii) of the Treaty);

"international filing date" is the date of receipt of an international application in the appropriate receiving Office in accordance with Article 11 of the Treaty. That date may be subsequently revised as a result of the late lodgment of drawings in accordance with Article 14;

"priority date" of an international application is defined in the terms of the Treaty. Under the Treaty, the priority date is determined on the basis of the priority entitlement under the Paris Convention for the Protection of Industrial Property, an entitlement which is presently available to applicants under Part XVI of the Patents Act. However, the Treaty also permits priority to be claimed on the basis of an earlier application in the same country as that in which protection is sought. This situation is provided for in section 58F;

"receiving Office" is also defined in the terms of the Treaty and means the national Office or the inter-governmental organisation with which the international application has been filed (Article 2(xv)).

5. Sub-section 58A(2) identifies the terms "description, drawings and claims" used in the Patents Act in relation to an international application with the corresponding terms used in the Treaty.

International Applications

6. Sub-section 58B(1) provides that the Patents Act applies only to international applications which have been accorded an international filing date under the Treaty and which also specify Australia as a country in which protection is sought.

7. Sub-section 58B(2) provides that an international application to which the previous sub-section applies is to be treated as an application under the Patents Act for a standard patent unless the application indicates that the protection sought is a petty patent. Both kinds of protection are presently provided by the Act as optional alternatives. Paragraph (b) equates the description, claims and drawings required under the Treaty with a complete specification for the purposes of the Patents Act, and defines the international filing date as the date of lodgment of the application for the purposes of the Patents Act.

8. Sub-section 58B(3) provides for an international application to which the section applies to be treated as an application for a petty patent where the applicant so requests.

9. Sub-sections 58B(4) and (5) give effect to the obligation on the Patent Office under Article 25 of the Treaty to review a decision by a receiving Office, not to accord an

international application seeking protection in Australia an international filing date. The basis for review is that the failure to accord an international filing date was, in the opinion of the Commissioner, the result of an error or omission by the receiving Office. Where such review is favourable, the international application is to be treated under the Patents Act as though it had been accorded an international filing date, the notional date being the date which the Commissioner considers should have been accorded under the Treaty.

Modified application of Act to international applications

10. Section 58C defines the extent to which international applications which satisfy the requirements of the Treaty are to be treated as satisfying the requirements of the Patents Act. In accordance with the Treaty, the section also provides for deferment of the processing of international applications within the Patent Office and the publication of international applications under the Patents Act.

11. Sub-section 58C(1) relieves an international application of a number of requirements prescribed under section 35 of the Patents Act since a receiving Office will apply essentially similar requirements in determining whether the application complies with the Treaty. The sub-section does not relieve the application of being directed to a manner of new manufacture or one invention (section 35(1)(a) and (b)).

12. Sub-sections 58C(2) and (3) make clear that the recognition of the description, drawings and claims under

section 58C as a complete specification or a petty patent specification does not remove the requirement for compliance with the requirements of section 40, i.e. that the specification fully describe the invention and end with a claim or claims clearly and succinctly defining the invention and which are fairly based on the matter described.

13. Sub-section 58C(4) defers, as required by the Treaty, the operation of sections 47A and 47B of the Patents Act under which the Commissioner may direct an applicant for a standard patent to request examination. The Treaty prescribes two alternative periods of deferment depending upon whether an applicant requests an international preliminary examination under the Treaty (paragraph (b)) in addition to the provision of an international search (paragraph (a)).

14. Sub-section 58C(5) makes corresponding provision for delaying the consideration of an international application for a petty patent.

15. Sub-section 58C(6) provides for voluntary withdrawal of an international application in the same manner as is presently provided for applications under the Patents Act in section 37. The sub-section also provides for withdrawal of an international application where withdrawal is effected under the Treaty.

16. Sub-sections 58C(7) and (8) provide for the publication of international applications under the Patents Act. The present provisions for the publication of applications for a standard patent (sections 54A and 54B) and petty patent applications (section 62) are not applicable, in view of the international publication of international applications by the International

Bureau. However, by virtue of Article 29 of the Treaty, a country may recognise publication as occurring on the date on which a copy of the international application published by the International Bureau is received in the patent office of that country. As publication in Australia is the only publication recognised by the Patents Act, this course has been adopted in sub-section 58C(8). Under the Treaty, the documents of a published application may be in English, French, German, Russian or Japanese; an English-language abstract of the invention, however, is always provided.

17. Sub-section 58C(9) provides for the publication of international applications in the circumstances where the application has been reviewed by the Commissioner under Article 25 of the Treaty. In some cases, such applications will be published under the Treaty and provisions for publication corresponding to those in sub-section 58C(8) are applicable (paragraph (a)). However, in the circumstances of sub-section 58B(4), the international application will not be published by the International Bureau and special provisions for publication under the Patents Act are required (paragraph (b)). Essentially, these provisions correspond to the present provisions for the publication of applications for a standard patent [see sub-sections 58G(2) and (3)]⁷. The provisions for publication of petty patents are not applicable to international applications, being inconsistent with the Treaty.

18. Sub-section 58C(10) makes the entitlement of an applicant to request or take any action under the Patents Act

in relation to an international application subject to the receipt in the Patent Office of a copy of the application, a verified English translation of the application if not in the English language and the payment of the prescribed fees.

19. Sub-section 58C(11) excludes the application of section 176 to international applications. That section provides for regulations prescribing fees and defines the consequences of non-payment of fees, the latter provisions being inconsistent with the Treaty. The power to prescribe fees in respect of international applications is provided by section 58J.

20. Sub-section 58C(12) provides that the provisions of the Patents Act and Regulations generally shall apply to international applications except as otherwise provided by Part IV A or regulations made pursuant to section 58J. The specific reference to Part XVI of the Patents Act makes clear that international applications may claim Convention priority.

Effects of publication of international application

21. Section 58D provides that sections 54C and 54D prescribing the effects of publication of complete specifications and petty patent specifications, respectively, shall apply to international applications. By virtue of sections 54C and 54D, an applicant for a standard patent or a petty patent is provided with the same rights as a patentee in relation to infringement following publication except that infringement proceedings may not be instituted until a patent has been granted.

Conversion to ordinary patent applications

22. Section 58E provides for an international application

lodged, and seeking protection, in Australia which is not accorded a filing date under the Treaty to be treated as an ordinary application under the Act, when so requested by the applicant. The applicant may request that the application be treated as an application for a standard patent or an application for a petty patent. Where such request is made, this section provides for the description, claims and drawings of the international application to be treated as a complete specification or petty patent specification, as appropriate, and for certain requirements to have been complied with, corresponding to those previously specified in sub-section 58C(1).

Preservation of provisional specification priorities

23. Section 58F provides that, where an international application to which the Act applies includes a claim fairly based on matter disclosed in a previously lodged provisional specification and the international application is lodged within 12 months of the date of lodgment of the provisional specification, the applicant may claim a priority date corresponding to the date of lodgment of the provisional specification. This provision enables Australian applicants to obtain the same entitlement to priority under the Treaty as is presently provided by the lodgment of a complete-after-provisional specification.

Notifications in the Official Journal of Patents
in respect of international applications

24. Sub-section 58E(1) provides for notification in the Official Journal of Patents of the receipt in the Australian Patent Office of international applications which have been published by the International Bureau under the Treaty. A

major effect of this provision is to advise the public of the publication of international applications in Australia under section 58C.

25. Sub-sections 58G(2) and (3) provide for notification of the publication of international applications to which the Patents Act applies and which the Commissioner is satisfied will not be published under the Treaty. Unless earlier publication is requested by the applicant, notification will occur on the expiry of a period of 18 months after the earliest priority date.

26. Sub-section 58G(4) provides that the copy of the international application and such other documents as are prescribed shall become open to public inspection upon the notification of publication in the Official Journal.

Evidence of matters arising under the Treaty

27. Section 58H provides for the issuance of certificates by the Commissioner as regards the performance or non-performance of actions in relation to international applications. This section corresponds to the present provisions of sub-section 29(3) and is intended to facilitate the proof of any matters that may need to be proved in proceedings relating to international applications.

Regulations

28. Section 58J provides for making regulations under section 177 in relation to international applications to which section 58B applies. Paragraph 58J(b) specifically provides for making regulations which exclude or vary the operation of the

provisions of the Patents Act in relation to international applications to which the Act applies. This provision is necessary to exclude a number of provisions in the regulations, in particular, those prescribing times for performing specific actions in relation to applications, and which are inconsistent with the requirements of the Treaty, from applying to international applications under the Act.

Schedule

29. Clause 5 changes the present Schedule heading to "Schedule 1" in view of the addition of a second Schedule by Clause 6 consisting of the English text of the Patent Cooperation Treaty and Regulations. Clause 6 adds Schedule 2 to the Act.