Date Introduced: 7 April 1981
House: House of Representatives
Presented by: Hon. David Thomson, M.C., M.P., Minister for Science and Technology

Short Digest of Bill

Purpose

To amend the Patents Act 1952 to:

(a) make provision for extension of time for filing documents

(b) relax the conditions for making divisional applications

(c) enable the making of regulations providing for disciplinary control of patent attorneys, and

(d) enable the making of regulations to give effect to the regulations annexed to the Patent Co-operation Treaty 1970.

Background

The present provisions of the Patents Act 1952 allow the Commissioner of Patents, in certain circumstances to extend the time prescribed for the doing of an act or the taking of a step in relation to an application for a patent or in proceedings under the Act, other than proceedings in a court. Recent decisions of the Administrative Appeals Tribunal have been to the effect that the existing provisions for extension of time are not applicable to the time within which the Commissioner of Patents may accept a patent application under Section 54 nor to the time prescribed for the lodging of applications under international conventions as provided for in Part XVI of the Act. Also doubt has been cast as to whether the existing legislation enables a valid extension of time to be granted for lodging a complete specification under Section 41. The Bill contains specific provisions enabling these extensions to be granted and also provides a general power of extension for the lodging of documents in times of postal delays.
Other matters that the Bill covers include an extension of the period under Section 51 in which application may be made for division of a patent application (divisional applications), provision for the making of regulations with respect to the professional conduct of patent attorneys and, by amendment of Section 58A, providing a power to implement by regulation the Regulations incorporated in the Patents Co-operation Treaty by adoption by the Assembly of the Patent Co-operation Union from time to time.

Main Provisions

Clause 3 inserts a definition of 'patent application' including an application for a petty patent. This follows the introduction of the system of petty patents by the Patents Amendment Act 1979.

The provisions relating to the time within a complete specification may be lodged in respect of a patent application are amended by clauses 6 and 7. Clause 6 inserts a new sub-section 41(3) enabling a complete specification to be lodged notwithstanding that a patent application has lapsed. Clause 7 inserts a new section 41A making provision for the extension of time for lodging complete specification. The conditions under which this extension may be granted and the procedures to be followed are set out in sub-sections 41A(2) to 41A(9) inclusive. The new sub-section 41A(10) provides that where an application for extension of time is refused the date of lodging the complete specification will be deemed to be the date of lodging of a further patent application.

Where an application is made to the Administrative Appeals Tribunal for review of a decision of the Commissioner refusing to grant an extension, sub-section 41A(11) preserves the rights of the applicant under sub-section 41A(10)(d) until the expiration of three months after the final judicial determination of the application for review.

Special provision preserving priority rights of persons who made divisional applications under the former section 49A is made by insertion of a new sub-section 45(3A) by clause 8 (see also transitional provisions in clause 32).

Section 50A is amended by clause 9 to take into account extensions of time which may be granted under the new section 41A.
The provisions relating to the voluntary division of patents contained in section 51 are extended by clause 10 for a period of three months after advertisement of acceptance of a standard application or advertisement of sealing of a petty patent.

Clause 13 by amending section 58C empowers the Commissioner to seal a petty patent on an international application for a petty patent.

New sub-sections 67(2A) and 67(2B) are inserted by clause 14. The effect of these provisions is to prevent an extension of time under the new Sections 41A or 142AAA being used as a vehicle for extending the term of a patent.

The new section 135A introduced by clause 19 enables the making of disciplinary regulations governing the conduct of patent attorneys. In the explanatory memorandum accompanying the Bill it is stated that this power "has been requested by the profession".

Provisions relating to the extension of time for lodging applications under international conventions are made by way of amendments to sections 141 and 142 and insertion of a new section 142AAA by clauses 20, 21 and 22 respectively.

Consequential amendments to Section 160 as a result of the specific provisions for extension of time discussed above are made by clause 27.

The "catch-all" provision to cope with late lodgement of documents attributable to postal delays is contained in the new Section 172B inserted by clause 28.

Clause 33 of the Bill contains provisions retrospectively validating extensions of time granted under Section 160 which might otherwise be held to have been not within the power of the Commissioner. In anticipation of third parties being deprived of property by virtue of the foregoing clause provision is made for payment of compensation to the person who suffers the loss of property rights by the person who acquires those rights. The compensation provision which is contained in clause 34 is expressed in the explanatory memorandum to be necessitated by section 51 (xxxi) of the Constitution.

By amendment of section 58A, clause 12 enables the implementation by regulation of the Regulations that have been, or will subsequently be, incorporated in the Patents Co-operation Treaty by adoption by the Assembly of the Patents Co-operation Union.
Procedural amendments relating to the jurisdiction and powers of courts as contained in Part XVII of the Act are made by clauses 23, 24 and 25 and clause 26 extends the jurisdiction of the Administrative Appeals Tribunal to decisions of the Commissioner under the new sections 41A, 142AAA and 1728 as well as decisions on the opposition to the grant of a patent under sections 59 and 82.

For further information, if required, contact:

30 April 1981

Law & Government Group
LEGISLATIVE RESEARCH SERVICE