

AUSTRALIAN PATENT OFFICE

AS

DESIGNATED (OR ELECTED) OFFICE

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List of abbreviations:

Office: Australian Patent Office

APA: Australian Patents Act

APR: Australian Patents Regulations

Sec.: Section of the Patents Act

Reg.: Regulation of the Patents Regulations

SUMMARY**Designated
(or elected) Office****SUMMARY****AU****AUSTRALIAN PATENT OFFICE****AU****Summary of requirements for entry into the national phase**

| | |
|---|--|
| Time limits applicable for entry into the national phase: | Under PCT Article 22(3): 31 months from the priority date Under PCT Article 39(1)(b): 31 months from the priority date |
| Translation of international application required into: ¹ | English |
| Required contents of the translation for entry into the national phase: ¹ | Under PCT Article 22: Description, claims (if amended, as amended only), any text matter of drawings Under PCT Article 39(1): Description, claims, any text matter of drawings (if any of those parts has been amended, only as amended by the annexes to the international preliminary examination report) |
| Is a copy of the international application required? | A copy is required only if the applicant expressly requests an earlier start of the national phase under PCT Article 23(2) at a time when the applicant has not received Form PCT/IB/308 and the Office has not received a copy of the international application from the International Bureau under PCT Article 20 |
| National fee: | Currency: Australian dollar (AUD) Filing fee: ¹ AUD 370 ² 570 ³ |
| Exemptions, reductions or refunds of the national fee: | None |
| Special requirements of the Office (PCT Rule 51 <i>bis</i>): ⁴ | Name of the inventor if it has not been furnished in the “Request” part of the international application ⁵ Statement or notice as to the applicant’s entitlement to apply for and be granted a patent ⁵ Statement or notice as to the applicant’s entitlement to claim priority of the earlier application ⁵ Address for service in Australia or New Zealand (but no representation by an agent is required) Verification of translation ⁶ |
| Who can act as agent? | Any person registered to practice as a patent attorney before the Office |
| Does the Office accept requests for restoration of the right of priority (PCT Rule 49 <i>ter.2</i>)? | Yes, the Office applies national requirements to such requests |

¹ Must be furnished or paid within the time limit applicable under PCT Article 22 or 39(1).

² This fee is applicable where the following approved means for specific transactions are used: eServices or Business to Business (B2B). For further details, see www.ipaustralia.gov.au/patents/understanding-patents/time-and-costs

³ This fee is applicable where other means such as mail or at a counter are used for specific transactions. For further details, see www.ipaustralia.gov.au/patents/understanding-patents/time-and-costs

⁴ If not already complied with within the time limit applicable under PCT Article 22 or 39(1), the Office will invite the applicant to comply with the requirement within a time limit fixed in the invitation.

⁵ This requirement may be satisfied if the corresponding declaration has been made in accordance with PCT Rule 4.17.

⁶ A verified translation is only required upon request by the Commissioner.

THE PROCEDURE IN THE NATIONAL PHASE

- APR Reg. 3.5AC(9),
3.5AF(2D)
1.3 definition of
"certificate of
verification"
- AU.01 TRANSLATION (VERIFICATION).** A verification of the translation of the international application or of any amendments under PCT Articles 19 or 34 need only be furnished to the Office if the Commissioner specifically requires the applicant to do so. This only occurs if there is a reasonable belief that the translation into English does not accurately reflect the document in its original language. The required certificate of verification of the translation of the international application consists of a simple signed and dated statement, which can be made by any person.
- APR Reg. 3.5AC(8)
3.5AC(9)(a)
3.5AF(2C),
3.5AF(2D)(a)
- AU.02 TRANSLATION (CORRECTION).** Errors in the translation of the international application can be corrected with reference to the text of the international application as filed (see National Phase, paragraphs 6.002 and 6.003). This can be done when the applicant becomes aware of an error or omission, or in response to the Commissioner requiring verification of a translation.
- AU.03 FEES (MANNER OF PAYMENT).** The manner of payment of the fees indicated in the Summary and in this Chapter is outlined in Annex AU.I.
- APR Reg. 3.2C(2)(a)(i)
- AU.04 ADDRESS FOR SERVICE.** An applicant, irrespective of whether or not he is a national of or a resident in Australia, is not required to be represented by an agent, but he is required to have an address for service (of notices and other communications) in Australia or New Zealand. The applicant must supply such an address in order to continue proceedings before the Office. Any applicant may be represented by a patent attorney authorized to practice before the Office and the address for service should normally be that of a registered patent attorney. A list of registered patent attorneys is available upon request from the Office.
- APA Sec. 142(2)(d)
143(a)
APR Reg. 13.3
13.6
22.2
- AU.05 RENEWAL FEE.** A continuation (renewal) fee must be paid to maintain the application. The first continuation fee falls due four years from the international filing date (fourth anniversary fee); thereafter a continuation fee becomes due on each anniversary of the international filing date. Payment can be made at any time up to the due date or together with the payment of a fee for extension of time, within six months from the final date. The amounts of the continuation fees and of the fees for extension of time are indicated in Annex AU.I.
- APA Sec. 44
45
APR Reg. 3.15
- AU.06 REQUEST FOR EXAMINATION.** The Office will grant a standard patent only after examination as to patentability, the procedure for which is started only upon request.
- APR Reg. 3.15
3.16
- AU.07 TIME LIMIT FOR REQUESTING EXAMINATION.** Examination must be requested within five years from the international filing date or, where the Office directs the applicant to request examination, within two months of the date of the notice of the Office to that effect.
- APR Reg. 22.2
22.2C
- AU.08 FEE FOR REQUESTING EXAMINATION.** The request for examination is only effective if a fee for requesting examination has been paid. The amount of this fee is indicated in Annex AU.I.
- APA Sec. 142(2)(e)
APR Reg. 13.4
- AU.09 TIME LIMIT TO HAVE AN APPLICATION ACCEPTED.** An application for which an examination request has been made before 15 April 2013 has to have been accepted within 21 months from the date of the first examination report. An application for which an examination request has been made on or after 15 April 2013 has to have been accepted within 12 months from the date of the first examination report.

- APR Reg. 22.2 AU.10 **FEE FOR RESPONDING TO AN EXAMINATION REPORT.** For applications for which an examination request has been made on or after 15 April 2013, no response fees are payable.
- APR Reg. 22.22
22.21 AU.11 **ACCEPTANCE FEE.** A fee is required to be paid upon acceptance of the application. The amount of this fee is indicated in Annex AU.I.
- APR Reg. 3.15(2) AU.12 **ENTITLEMENT.** All requests for examination filed on or after 15 April 2013 must include a statement or notice as to the applicant's entitlement to apply for and be granted a patent, and to claim priority of the earlier application. These requirements may be taken to have been met if the applicant includes in the request the relevant declarations in accordance with PCT Rule 4.17.
- APA Sec. 43AA
APR Reg. 3.14D
22.15A AU.13 **PRIORITY DOCUMENT (TRANSLATION).** A verified translation into English (see paragraph AU.01) of any priority document need only be furnished to the Office if the Commissioner specifically requests the applicant to do so. This will only occur when the translation is necessary to determine the validity of the application.
- Verification of the translated priority document is only required to be furnished to the Office if the Commissioner specifically requires the applicant to do so. This only occurs if there is a reasonable belief that the translation into English does not accurately reflect the priority document in its original language. The required certificate of verification of the translation of the priority document consists of a simple signed and dated statement, which can be made by any person.
- PCT Art. 28
41
APA Sec. 102
104
APR Chapter 10 AU.14 **AMENDMENT OF THE APPLICATION; TIME LIMITS.** The applicant may make the following modifications to his application before the Office (subject, in the case of voluntary amendment, to the payment of the fee for voluntary amendments indicated in Annex AU.I):
- (i) prior to acceptance:
 - correction of clerical errors and obvious mistakes;
 - such modifications as do not result in the claiming or disclosure of new matter (beyond the disclosure of the international application as filed);
 - (ii) after acceptance:
 - correction of clerical errors and obvious mistakes;
 - such modifications as do not result in the claiming or disclosure of new matter (beyond the disclosure of the international application as filed) and do not broaden the scope of the claims existing before the modifications.
- PCT Art. 25
PCT Rule 51
APA Sec. 10
APR Reg. 3.5AB AU.15 **REVIEW UNDER ARTICLE 25 OF THE PCT.** The applicable procedure is outlined in paragraphs 6.018 to 6.021 of the National Phase. Before any adverse decision is made, the applicant is always afforded the opportunity of being heard. Review of an adverse decision can be obtained from the Federal Court of Australia.
- PCT Art. 24(2)
48(2) AU.16 **EXCUSE OF DELAYS IN MEETING TIME LIMITS.** Reference is made to paragraphs 6.022 to 6.027 of the National Phase.
- APA Sec. 223
APR Reg. 8.3(4)
22.11 AU.17 If, due to an error or omission on the part of the applicant, his agent or attorney, or due to circumstances beyond the control of the person concerned, the applicant has failed to observe a time limit which is prejudicial to his rights, or the Commissioner is satisfied that the person took due care as required by the circumstances, to ensure the doing of the act within that time, he may request the Office to extend the time limit even though that time has already expired. The request must be presented in writing, and establish the facts on which the request is based in a declaration and also must be accompanied by a fee (for the amount of the fee, see Annex AU.I).

PCT Rule 49ter(f)
APA Sec. 223

AU.18 RESTORATION OF THE RIGHT OF PRIORITY. A request for restoration of the right of priority will be treated under national law requirements, at the option of the applicant, as an application for an extension of time on the basis of the relevant act not being done despite due care, not being done due to circumstances beyond the control of the person concerned or because of an error or omission on the part of the person concerned or by his or her agent or attorney. Fees and other requirements associated with the request vary according to the criterion against which it is made. A request for restoration should be presented in writing, should indicate the criterion against which the request is made and be accompanied by the relevant fee (see “Fee for extension of time limit” in Annex AU.I). Preferably it should also be accompanied by a declaration setting out the circumstances and facts on which the request is based.

FEES

(Currency: Australian dollar)

Standard patent applications

| | | |
|---|------------------|------------------|
| Filing fee: | 370 ¹ | 570 ² |
| — national phase entry of a PCT application under paragraph 89(398b) of the Australian Patents Act | 370 ¹ | 570 ² |

Request for examination fee:

| | | |
|---|--|-----|
| (a) for examination under section 45 of the Australian Patents Act (normal examination): | | |
| (i) if the application is a PCT application for which the Australian Patent Office has issued an international preliminary examination report under PCT Article 35 | | 300 |
| (ii) all other applications | | 490 |

Fee for acceptance of a patent request and complete specification:

| | | |
|---|--|-----|
| (a) for acceptance | | 250 |
| (b) if more than 20 claims are contained in the specification at acceptance, for each claim in excess of 20 (but equal to or less than 30) | | 125 |
| (c) if more than 30 claims are contained in the specification at acceptance, for each claim in excess of 30 | | 250 |

Continuation/renewal fees

(becoming payable on each anniversary of the international filing date from the 4th onwards):

| | | |
|---|--------------------|---------------------|
| — on the 4 th anniversary | 300 ¹ | 350 ^{2, 3} |
| — on the 5 th anniversary | 315 ¹ | 365 ² |
| — on the 6 th anniversary | 335 ¹ | 385 ² |
| — on the 7 th anniversary | 360 ¹ | 410 ² |
| — on the 8 th anniversary | 390 ¹ | 440 ² |
| — on the 9 th anniversary | 425 ¹ | 475 ² |
| — on the 10 th anniversary | 490 ¹ | 540 ² |
| — on the 11 th anniversary | 585 ¹ | 635 ² |
| — on the 12 th anniversary | 710 ¹ | 760 ² |
| — on the 13 th anniversary | 865 ¹ | 915 ² |
| — on the 14 th anniversary | 1,050 ¹ | 1,100 ² |
| — on the 15 th anniversary | 1,280 ¹ | 1,330 ² |
| — on the 16 th anniversary | 1,555 ¹ | 1,605 ² |
| — on the 17 th anniversary | 1,875 ¹ | 1,925 ² |
| — on the 18 th anniversary | 2,240 ¹ | 2,290 ² |
| — on the 19 th anniversary | 2,650 ¹ | 2,700 ² |

Fee for extension of time limit:

| | | |
|---|--|-----|
| (a) where there is an error or omission on the part of the person concerned or his agent or attorney—for each or part of a month | | 100 |
| (b) for circumstances beyond the control of the person concerned—application for extension of time | | 100 |
| (c) where the Commissioner is satisfied that the person concerned took due care, as required by the circumstances, to ensure the doing of the act within that time—for each or part of a month | | 100 |

¹ This fee is applicable where the following approved means for specific transactions are used: eServices or Business to Business (B2B). For further details, see www.ipaustralia.gov.au/patents/understanding-patents/time-and-costs

² This fee is applicable where other means such as mail or at a counter are used for specific transactions. For further details, see www.ipaustralia.gov.au/patents/understanding-patents/time-and-costs

³ This fee is applicable to all patent applications whose fourth anniversary falls on or after 1 July 2012. Therefore, this fee is applicable to applications filed on or after 1 July 2008 or any granted patent with a date of patent on or after 1 July 2008.

(d) to pay continuation fee if the fee is not paid on or before the anniversary but is paid within 6 months of the anniversary—for each or part of a month for which the time is extended 100

Fee for voluntary amendments before request for examination is filed or after acceptance 250

Additional fee for voluntary amendments after acceptance, if the specification as proposed to be amended has more than 20 claims, and the effect of the amendment is to increase the number of claims, for each additional claim 110

The complete list of national fees for the Office is in Part 2 in Schedule 7 to the Australian Patents Regulations.

How can payment of fees be effected?

- (i) All fees must be paid to the Australian Patent Office.
- (ii) National fees must be paid by credit card, accounts for selected services, cash, check, money order, EFTPOS, EFT or direct debit in Australian dollars. Payments by bank transfer should be made to the following bank:

Beneficiary’s name: IP Australia Official Departmental Account
Bank name: National Australia Bank
Bank Account No.: 082-926 868711229
Bank Address: Woden Shopping Square ACT 2606
BIC/SWIFT code: NATAAU3303M