

**Documents tabled on 12 March 2008:
(previously tabled on 15 August 2007)**

**National Interest Analysis [2008] ATNIA 2
with attachment on consultation**

**Patent Law Treaty, done at Geneva on 1 June 2000
[2007] ATNIF 19**

NATIONAL INTEREST ANALYSIS: CATEGORY 1 TREATY

SUMMARY PAGE

Patent Law Treaty, done at Geneva on 1 June 2000 [2007] ATNIF 19

Nature and timing of proposed treaty action

1. The proposed treaty action is accession to the *Patent Law Treaty* (the PLT) by Australia, pursuant to Article 20(4).
2. The treaty was done at Geneva on 1 June 2000 and came into force generally on 28 April, 2005.
3. Accession is proposed to be undertaken by Australia as soon as practicable after the completion of domestic processes. It would enter into force for Australia three months after Australia deposits its instrument of ratification (Article 21(2)).

Overview and national interest summary

4. The PLT applies to national and regional applications for patents, patents of addition and divisional applications. It harmonises and streamlines formal procedures for obtaining and maintaining a patent similarly to the way the *Trademark Law Treaty* [1998] ATS 3 and the newer *Singapore Treaty on the Law of Trademark* [2007] ATNIF 18 do so for trade marks. The PLT does not harmonise substantive requirements of national patent law, and therefore provides no substantive obligations regarding the protection of patents.
5. Patent applicants and owners already benefit within Australia because Australia's legislation and practices are already in line with the PLT.
6. Important benefits of Australia's accession to the PLT lie in the positive example it would provide for its trading partners and in the ability it would give Australia to encourage non-members to simplify and harmonise their domestic patent systems to be consistent with the PLT. As a consequence, Australian patent holders seeking to protect and commercialise their inventions in foreign markets will reap the benefits of greater harmonisation, flexibility and security.
7. Accession to the PLT would be consistent with Australia's history as a leading member of the intellectual property community in the region, and would serve to further enhance Australia's reputation. Accession to the PLT will also enable Australia to influence further enhancement of the treaty through participation in the Assembly created under Article 17 of the PLT. This would include the ability to contribute to the further development of the Model International Forms.

Reasons for Australia to take the proposed treaty action

8. Australia has been at the forefront of international negotiations aimed at harmonising and normalising the administration of intellectual property rights.
9. Australia has been a member of the *Patent Cooperation Treaty* [1980] ATS 6 (PCT) since 31 March 1980. The PCT reduces the time, cost and complexity of applying for patent protection by providing a mechanism for a single application to have effect in a number of countries. However not all countries are party to the PCT and some applicants choose to file directly with individual countries. This can be a time consuming and costly exercise.
10. The PLT complements the PCT and is a major step towards further harmonisation of patent law. The PLT was adopted at a Diplomatic Conference on 1 June 2000 and entered into force on 28 April 2005. It seeks to streamline and harmonise formal requirements set by national and regional patent offices for the filing and processing of national and regional patent applications, and therefore to make such procedures more user-friendly. The PLT does not harmonize substantive requirements of patent law.
11. Inventors seeking patent protection must ensure their applications meet certain formal requirements in the various domestic systems. The PLT simplifies and harmonises the formal requirements that the Contracting Parties can apply in relation to patent applications and establishes important safeguards against loss of rights on procedural grounds. More specifically, in simplifying and standardising the requirements, the PLT offers patent applicants and patent offices a number of advantages including use of standardised forms that reduce the risk of error; simplified procedures leading to cost reductions for inventors, applicants, patent attorneys and patent offices; and enhanced legal certainty for applicants filing in their home country and abroad. The economies of member states also stand to benefit from the harmonisation of IP systems as technology transfer is facilitated and foreign investment is encouraged.
12. Seventeen countries are now party to the PLT. There are forty-six signatories to the treaty including a number of the major countries in which Australian applicants seek protection, such as the USA and France, as well as the European Patent Office. A number of these signatories are now considering or preparing for ratification to the treaty. For example, ratification is currently under consideration by the US Senate.
13. Australia already provides a patent system that is substantially PLT compliant, and hence provides significant benefits to local and foreign applicants in this country. Accession to the PLT by other countries and regional patent organisations, including Australia's major trading partners, will be a significant benefit to Australians applying for patent protection overseas, particularly those who do not use the PCT system. A significant benefit of Australia acceding to the PLT is therefore the positive example it would provide for other countries to sign up.
14. The PLT also establishes an Assembly, the powers of which include the power to amend the Regulations annexed to the PLT and to determine to what extent rules from the PCT will apply under the PLT. The Assembly has already taken several decisions in pursuance of these powers. An additional benefit of Australia acceding to the PLT is therefore an ability to influence further enhancement of the treaty of this kind through participation in the Assembly.

Obligations

15. As noted, the PLT provides obligations relating to the procedural aspects of applying for and maintaining patents. It does not oblige the protection of patents, nor does it set out any substantive aspects of patent protection (Article 2(2)). It seeks to harmonise the procedures for obtaining and maintaining patent rights across different jurisdictions. To this end, the PLT provides various obligations relating to a Contracting Party's system for processing patent applications.

16. Article 6 sets the maximum formal requirements that a Contracting Party can insist on with respect to a patent application. A Contracting Party is free to require less than the listed requirements, though it may require no more. This provision incorporates the formal requirements of an 'international application' under the PCT. The provision also obliges a patent office to notify the applicant when an application does not comply with the requirements and provide an opportunity for rectification.

17. The PLT restricts the ability to revoke a patent, once it is granted, because of a failure to meet any formal requirement in the application that were not picked up by the patent office during the application process (Article 10). Further, the PLT provides for the reinstatement of rights, including priority rights, in certain circumstances where a failure to meet a time limit was despite due care or (at the option of the contracting party) was unintentional (Article 12).

18. Article 5 obliges the patent office of a Contracting Party to accord a filing date to a patent application and sets out how the filing date is to be determined. The treaty also provides for the allocation of a filing date in circumstances where the application refers to an earlier filed application or where parts of the description or drawings are missing and are subsequently filed.

19. Pursuant to Article 7, patent offices may not require the applicant to appoint a local agent or legal representative for certain procedures, including filing an application for the purposes of obtaining a filing date and payment of fees including maintenance fees. The patent office may require the appointment of a local representative for all other dealings with the office.

20. Patent offices are prohibited from routinely requiring evidence of matters asserted in a patent application unless there is reason to doubt the veracity of a matter or the accuracy of a translation (Articles 6(6) and 8(4)(c)).

21. Contracting Parties can choose how they receive communications and whether they accept only electronic or paper correspondence or both. They must however accept paper communications for the purpose of complying with a time limit or for establishing the filing date (Article 8).

22. The PLT obliges all Contracting Parties to comply with the provisions of the *Paris Convention for the Protection of Industrial Property* [1972] ATS 12 (Paris Convention) that relate to patents. As Australia is already a party to the Paris Convention, this provides no new obligations for Australia.

23. There are also Regulations annexed to the PLT, which set out matters expressly delegated by the text of the Treaty to the Regulations, details useful for the implementation

of the Treaty, administrative matters, formal requirements for certain dealings with a patent office and Model International Forms to be used in dealings with a patent office (Article 14). As there is no statement to the contrary, the Regulations will be binding on Contracting Parties to the same extent as the rest of the PLT. However, the Regulations are clearly subsidiary, with the PLT expressly providing that it prevails in case of any conflict (Article 14(4)).

24. With respect to the Model International Forms set out in the Regulations, a Contracting Party may still use their own forms but are obliged to accept any dealing submitted using one of the model forms (Article 8(3)).

Implementation

25. IP Australia's legislation and practices are already compliant with the PLT.

26. No Commonwealth or State and Territory action is required to implement the PLT. Implementation will not affect the existing roles of the Commonwealth and States and Territories.

27. Further enhancement of IP Australia's computer system will be necessary. While IP Australia accepts paper and electronic communications for the purpose of both PCT and non-PCT applications, technical inconsistencies exist between the electronic systems. In some circumstances non-PCT communications which meet PCT electronic communication standards cannot be processed. Hence currently Rule 8(2)(a) of the Regulations is not fully satisfied. Changes to IP Australia's electronic communications systems are being planned so that non-PCT communications made in accordance with PCT requirements will be accepted in all cases.

Costs

28. Accession of the PLT would result in no cost to the Australian Commonwealth or State Governments. There are no contributions payable by Australia under the PLT. Increases in Australia's contribution to WIPO are not anticipated as Australia's contribution is not based on the number of treaties Australia joins.

29. IP Australia operates on a full cost recovery basis, and its activities are revenue neutral to Government. The cost of the computer enhancements and of attendance by IP Australia officials at any working group meetings will be met from within IP Australia's existing budget.

30. The PLT does not increase costs to industry and can potentially reduce costs for Australians wanting to protect their patents in other countries.

Regulation Impact Statement

31. IP Australia has assessed the implementation of the PLT against criteria in The Best Practice Regulation Handbook. This regulatory option has no impact on business and individuals or on the economy and a Regulation Impact Statement or Business Cost Calculator report is not required.

Future treaty action

32. Subject to one exception, the PLT may only be revised by a conference of the Contracting Parties, the convocation of which will be decided by the Assembly (Article 19(1)). Any amendment of the PLT via this means will be subject to the Australian treaty process.

33. By way of exception, provisions dealing with the tasks of the Assembly (Article 17(2)) and frequency of the Assembly's meetings (Article 17(6)) may be amended by either a revision conference or by the Assembly (Article 19(2)). Where the Assembly amends either of these provisions, the amendment is to be adopted by a three-fourths majority and will enter into force for all Contracting Parties one month after three-fourths of the voting members have notified acceptance of it (Article 17(3)).

34. As such, an amendment to one of these two provisions may automatically become binding on Australia. Any such amendment will be considered as part of the Australian treaty process.

35. Pursuant to Article 14(2), the Assembly may amend the Regulations by a three-fourths majority, although a provision of the Regulations may provide that it can only be amended by unanimity. As there is no provision in the PLT to the contrary, amendments to the Regulations adopted by the Assembly will come into effect immediately. Amendments to the Regulations will therefore also automatically become binding on Australia once adopted by the Assembly. Any such amendments will be notified as part of the Australian treaty process.

36. As several elements of the PCT are incorporated into the PLT and the two instruments operate closely in practice, the Assembly of the PLT is empowered to decide, by a three-fourths majority, whether any relevant amendments made to the PCT will apply for the purposes of the PLT (Article 16(1)). Again, any such decision will come into effect immediately and will therefore automatically bind Australia. Any such decision will be notified as part of the Australian treaty process.

Withdrawal or Denunciation

37. Article 24 of the PLT provides for that any Contracting Party can denounce the Treaty by notification to the Director General of WIPO. The denunciation takes effect one year from the date on which the Director General has received the notification or any later date indicated in the notification. Any termination on the part of Australia will be subject to the Australian treaty process.

Contact Details

International Policy

Business Development and Strategy

IP Australia (Department of Innovation, Industry, Science and Research).

**Patent Law Treaty,
done at Geneva on 1 June 2000
[2007] ATNIF 19**

Consultation

1. IP Australia consults regularly with industry and professional organisations. Consultation includes meetings with groups such as the Inventors Associations, the Australian Manufacturers' Patents, Industrial Designs, Copyright and Trade Mark Association (AMPICTA), the Institute of Patent and Trade Mark Attorneys of Australia (IPTA), the Advisory Council on Intellectual Property and the Law Council. Such meetings include opportunities for exchanging information on IP Australia's activities. In particular the treaty actions regarding the Singapore Treaty on the Law of Trademarks, Patent Law Treaty and formal acceptance of the administrative amendments to several WIPO treaties were items on the agenda for meetings with AMPICTA, IPTA, the Minister's Advisory Committee on IP (ACIP) and the trade marks Combined Interest Group (CIG). CIG includes representatives from IPTA, AMPICTA and the Law Council of Australia. Favourable and supportive comments were received from these meetings.
2. IP Australia placed on its website a Public Consultation Notice in May 2007 regarding Australia's consideration of the Singapore Treaty, Patent Law Treaty and formal acceptance of the administrative amendments to several WIPO treaties. The Public Consultation Notice provided a general overview of these actions, advised the dates of free Information Sessions to be held in each mainland capital city and called for comments on the proposed treaty actions. A Public Consultation Paper with more detailed information on the Patent Law Treaty was also provided with the Public Consultation Notice
3. In May 2007, approximately 1200 people on IP Australia's "What's New" email list were notified by email of the potential treaty action and their attention was directed to the Public Consultation Notice and the Consultation papers. They included intellectual property professionals, academics, intellectual property owners and potential applicants as well as staff of State and federal government departments and agencies.
4. These consultations were also listed on the www.business.gov.au website in May 2007. This Business Consultation website allows the Australian Government to easily consult with business owners, associations and people interested in business.
5. Public Information Seminars were held around Australia in June 2007. IP Australia officials presented on each of the treaty actions. Attendees at these seminars were in favour of Australia joining the Patent Law Treaty particularly in view of the benefits to Australians seeking IP protection in other countries which also join the treaty.
6. The treaty has also been included on the twice yearly schedules of the Commonwealth-State/Territory Standing Committee on Treaties (SCOT) since 1997. The schedules allow the States and Territories to seek further information at the twice yearly meetings; however no State or Territory has sought further information from this committee.