

Dear Consultation Group Members

On Tuesday 12 July 2011, the PCG discussed IP Australia's practice of not requiring the prescribed fee for filing some requests for leave to amend complete specifications before their examination is requested. These are those requests where it is indicated that the amendments are filed in anticipation of examination. This practice is however inconsistent with the *Patents Regulations 1991* (see item 222 of Part 2 of Schedule 7) and has created confusion for applicants, administrative staff and examiners.

IP Australia proposes to amend the regulations to clarify that the consideration of amendments can be deferred, and no fee required, for filing a request for leave to amend a complete specification before its examination is requested—if the request *clearly* indicates that the Commissioner is to defer considering the request until examination. As a result, the amendment would not be considered until examination. If there is no such clear indication that deferred consideration is sought, the prescribed fee would remain payable, and the request would be considered shortly after it is made.

This would give applicants the flexibility to request amendments for consideration shortly after they are made, or for consideration during examination. It would also give certainty about IP Australia's practice.

This would be achieved by inserting a new regulation into Chapter 10 of the Patents Regulations to provide that a request for leave to amend a complete specification is taken to be filed *immediately* after the applicant files the request for examination of the patent request and complete specification. This would only apply, if *all* of the following conditions are met:

- the complete specification relates to an application for a *standard* patent
- the applicant has not filed any request for examination of the patent request and complete specification relating to the application
- the request is for leave to amend the complete specification
- the request indicates that the Commissioner is to defer considering the request until the Commissioner examines the patent request and complete specification.

IP Australia seek any comments you may wish to make on the proposed regulation by **COB Wednesday 28 September 2011**. Should you have any questions regarding the proposal, please contact me on the number below. The draft regulations will be circulated to the group towards the end of September for comment. IP Australia would propose 1 January 2012 for commencement of the proposed regulation, and that it would apply to requests for leave to amend filed on or after that date.

Kind regards

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