

Extension of Time Provisions in Australia

Almost every deadline set by the Patents Act 1990 or accompanying regulations can be extended under the liberal "extension of time" provisions in the Act. Certain deadlines can be extended in advance; others can be extended after the deadlines have passed.

The deadline for paying an annuity can be extended even after a patent or application has lapsed. It is also possible to extend the deadline for making a patent application claiming convention priority beyond the one year prescribed, and to extend the 21 month or 31 month deadlines for entering the Australian national phase of an international patent application.

In order to obtain an extension of time the failure to comply with the original deadline must have been unintentional and must have been due to an error or omission by the person concerned, or by their agent or attorney, or due to circumstances beyond the control of the person concerned.

The "error or omission" part of the provision can be satisfied where the failure to comply with the time limit was due to a simple failure on the part of the person responsible, or of an office system. Any genuine error or omission leading to a failure to comply with a time limit will usually satisfy the requirements. For instance, the deadline for entering the national phase has been extended where "Austria" was mistakenly designated in an international application instead of "Australia". However, non-compliance with a deadline merely due to financial difficulty is not deemed to be an acceptable excuse.

The "circumstances beyond the control" part of the provision may generally be considered as a **force majeure** or "act of God" requirement. For example, if failure to comply with the time limit was due to unavoidable loss of mail, or acts of war, the requirement may be satisfied.

In all cases, the applicant or patentee must demonstrate that they intended to meet the deadline at the time the deadline passed, and that reasonable steps were taken to ensure that the deadline would be met.

An application for an extension of time must be filed as soon as it is realised that there has been a failure to meet a deadline. Any delay in filing the application can be prejudicial. When making the application, all the steps which should have been taken before the deadline, including the payment of any official fee, must be completed. A substantial fee is payable for each month for which the extension of time is required.

The application must be supported within 2 months by evidence in the form of a statutory declaration or affidavit. Any delay in filing the evidence may also be prejudicial. The statutory declaration(s) supporting the application must detail the circumstances surrounding the failure to meet the deadline, and should be supported by documentary evidence. It is frequently necessary to have evidence from the person who decided to take the step before the deadline, including copies of any file notes or memos. It is almost always necessary to explain, in detail, the systems and procedures in place to ensure that a decision is put into effect.

The cause of the failure to meet the deadline must usually be explained, in detail, by the person responsible or the person who discovered the failure, and must be accompanied by copies of reminders and all other relevant documents. It can be fatal to the application if it becomes apparent that a full and frank disclosure has not been made. If you provide us with full details we will be able to identify suitable declarants, and to prepare suitably worded draft declarations for your approval and execution.

The longer the extension required the more expensive and difficult it will be to obtain. The Patent Office must take into account the public interest and, for instance, where a patent has lapsed for several years it can be very difficult to obtain an extension of time to pay renewal fees.



Where an application is made to extend a deadline for more than 3 months, the application will be advertised, and any interested person may oppose the application. Opposition will generally diminish the chances of an extension being granted. Typically, you will be required to provide exhaustive supplementary evidence and to attend a hearing in order to settle the opposition.

Where an application or patent is brought back into force as the result of a successful extension of time application, provision is made to compensate anyone who genuinely exploited the invention in the meantime without fraudulent intent. Such a person may be granted a non-exclusive licence as a result.

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