



Australian Government

IP Australia

Intellectual Property Reform In Australia

January 2013

A summary of important legislative changes

PATENTS

TRADE MARKS

DESIGNS

PLANT BREEDER'S RIGHTS

Robust intellectual property rights delivered efficiently

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PBR

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Introduction

The aim of this guide is to help you understand some of the key changes in *The Intellectual Property Laws Amendment Act 2012* (the Raising the Bar) Act. We hope it helps you to prepare for the changes which will come into effect on 15 April 2013.

This guide also outlines the key changes contained in the draft *Intellectual Property Laws Amendment Regulations* which build on the reforms in the Act. It is intended that these changes will also come into effect on 15 April 2013.

The purpose of these legislative reforms is to strike a balance between public and private interests. This is intended to provide Australia's IP system with a more robust framework to support and encourage innovation.

The Raising the Bar Act addresses six key areas:

- Raising the quality of granted patents: the new standards will be more closely aligned with international standards, giving innovators more certainty when applying in Australia and other jurisdictions.
- Free access to patented inventions for regulatory approvals and research: ensuring experimentation and approval for generic manufacturers is not delayed or negatively impacted by patents. This gives certainty to researchers and manufacturers and allows them to work without worrying about patent litigation.
- Reducing delays in resolution of patent and trade mark applications: the Act tightens up the procedures for patent and trade mark oppositions and patent divisional applications.
- Assisting the operations of the IP profession: the Act allows Australian patent and trade marks attorneys to incorporate. This gives them greater freedom in their business.
- Improving mechanisms for trade mark and copyright enforcement: the Act increases the penalties for trade mark infringement, bringing them into line with penalties for copyright infringement. Other changes will make it harder for counterfeiters, by improving the system for confiscating goods at the border.
- Simplifying the IP system: the Act gets rid of unnecessary hurdles and simplifies the application process. These changes are designed to make the IP system easier to use in a global setting.

For a comprehensive overview of the provisions in the Act please refer to the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 Explanatory Memorandum at www.comlaw.gov.au.

Legislation changes

This section outlines key changes to the Australian Patents Act 1990, Trade Marks Act 1995, Designs Act 2003 and Plant Breeder's Rights Act 1994 made by the Raising the Bar Act.

Schedule 1 - Raising the quality of granted patents

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Patents Act 1990

Inventive and innovative step

Subsections 7(2) and 7(4) – removes the geographical limitation on the common general knowledge when assessing inventive step in a standard patent application and innovative step in an innovation patent.

Subsection 7(3) – removes the requirement that prior art documents for inventive step be limited to only those documents that would have been ‘ascertained, understood and regarded as relevant’ by the skilled person.

These amendments ensure that all information that was publicly available at the priority date of the claimed invention is taken into account and increase consistency between the standard set for inventive step in Australia and elsewhere.

Usefulness

Section 7A – inserts the requirement that a specific, substantial and credible use for the invention is disclosed in the patent specification.

These amendments will strengthen the test for usefulness and prevent the claiming of speculative inventions that would require further experimentation to put the invention into practice.

Provisional specification

Subsection 40(1) – raises the standard for disclosure in provisional specifications. A provisional application will only provide a valid priority date for an invention later claimed in a complete application if the provisional specification discloses the invention in a manner that is clear and complete enough for the invention to be performed by a person skilled in the relevant art. This sets a similar standard to that required for disclosure in a complete application.

Disclosure in patent applications

Paragraph 40(2)(a) – replaces the full description requirement with the requirement that the specification discloses the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art. This better aligns the Australian requirement for disclosure in a complete specification with requirements elsewhere and ensures that the description provides sufficient information to make the invention across the full width of the claims.

Fair basis

Subsection 40(3) – replaces ‘fair basis’ with the requirement that the claims are fully supported by the description. This better aligns the Australian standards for claim scope with overseas standards.

Priority dates

Subsection 43(2) – aligns the standard for disclosure in a priority document with the standard for disclosure in a complete specification by requiring that the priority document discloses the invention in a manner that is clear and complete enough for the invention to be performed by a person skilled in the relevant art. This ensures that an applicant cannot secure a priority date based on a speculative or incomplete disclosure. This is the same as the disclosure standard in a provisional application and aligns Australian standards for disclosure in priority documents with most other jurisdictions.

Preliminary Search and Opinion (PSO)

Section 43 - allows the Commissioner to conduct a PSO on a standard application. An applicant will be able to request a PSO on a complete application. This will be similar to an international search and opinion and will provide applicants and the public with early information about the likely patentability of inventions where no search and examination report is likely to be made available from another office.

Examination and re-examination of standard patents

Sections 45, 98, 101G, 101M – expand the grounds considered during examination of a standard patent application, a standard patent and an innovation patent, and during opposition of an innovation patent, to include usefulness and prior use. This ensures that the Commissioner can examine on all of the substantive grounds available during opposition and court revocation proceedings.

Standard of proof

Sections 49, 60, 100A, 101, 101B, 101E, 101F, 101N - set the requirement that the higher standards of balance of probabilities is applied by the Commissioner when considering each of the substantive patentability criteria during examination, opposition proceedings and re-examination of standard patent applications, standard patents and innovation patents.

Amendments not allowable

Section 102 – prevents amendment of a complete specification to insert matter that extends beyond what was disclosed at the time of filing of the complete specification. This prevents a patentee from gaining protection of an invention that was not adequately disclosed in the complete application when it was filed.

This requirement will not apply to amendments to correct a clerical error or obvious mistake, or to include details of a micro-organism deposit under the Budapest Treaty.

The amendment also provides for regulations to be made making any amendment, other than an amendment directed by the court under section 105, non-allowable when court proceedings are pending.

Section 114 – provides a mechanism for dealing with situations where a non-allowable amendment is inadvertently allowed by the Commissioner. It provides for claims relying on such an amendment to be given the priority date prescribed by the Regulations. Generally this will be the date the amendment was made.

Section 114A – specifies that, where a non-allowable amendment is inadvertently allowed, an objection of lack of inventive step cannot be taken to an invention claimed in the amended specification in light of an invention disclosed in the application prior to amendment.

Amending definitions

Section 3 - inserts 'preliminary search and opinion' (PSO) into the list of definitions.

Sections 10(1)(c), 35(1)(b), 36(1)(c), 52(2), 74(1), 74(3), 103(2), 106(1)(b), 106(4), 107(1)(b), 107(4), 150(2), 151(2), 215(3), 223(2A)9b, 223(6A) amend existing references to the Commissioner being 'satisfied' to confirm that the standard of proof is the 'balance of probabilities'.

Application provisions

Raised examination standards, expanded examination grounds and the higher standard of proof will apply to:

- standard patent applications and innovation patents filed before commencement where the request for examination was made on or after the day of commencement
- innovation patents where the Commissioner has decided to examine the patent on or after commencement
- standard and innovation patent applications filed on or after commencement
- innovation patents granted on or after commencement if the application relating to the patent was filed before commencement.

Raised disclosure standards for provisional applications will apply to provisional applications filed on or after commencement.

Expanded re-examination grounds will apply to all standard patent applications and standard and innovation patents regardless of when the application was made or the patent granted.

The Commissioner will be able to conduct a preliminary search and opinion on any standard complete application filed on or after commencement. Similarly, an applicant will be able to request a PSO on any application filed on or after commencement.

The new standards for amendments will apply to requests to amend made on or after commencement relating to:

- standard patents granted, and innovation patents certified on or after commencement
- standard patent applications and innovation patents filed before commencement where the request for examination was made on or after commencement
- innovation patents where the Commissioner has decided to examine the patent on or after commencement.

This approach strikes a balance between having the changes apply as soon as possible with not unduly disadvantaging applicants and gives applicants control over whether their applications are examined under the old or new standards.

Schedule 2 - Free access to patented inventions for regulatory approvals and research

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PATENTS ACT 1990

Regulatory use exemption

Section 119B – introduces an exemption from patent infringement for activities undertaken for the purpose of obtaining information required for regulatory approval. This provides a regulatory use exemption for all technologies, with the exception of regulatory activities relating to pharmaceutical patents, which are already exempt under section 119A.

Research exemption

Section 119C – introduces an exemption from patent infringement for experimental activities relating to patented inventions.

The exemption will apply to all research activities where the predominant purpose of those activities are to gain new knowledge, or test a supposition or principle about the invention or improve on, or modify the invention.

Application provisions

The changes will apply to any acts for experimental or regulatory approval purposes done on or after the date of commencement.

Schedule 3 - Reducing delays in resolution of patent and trade mark applications

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PATENTS ACT 1990

Patent oppositions – amendments directed by courts

Section 105 – enables a court to consider and decide on any proposed amendments to a patent application during an appeal from a decision of the Commissioner. This means that where an applicant has amended their application subsequent to the Commissioner's decision the court can consider the amended specification.

Section 112A – consequential on changes to section 105 above. It specifies that only the Court can deal with amendments to an application during an appeal to the Court against a decision of the Commissioner relating to that application. This will prevent the same issues being dealt with by different decision makers.

Section 26 – consequential amendment to include reference to amendments that are in contravention of new section 112A.

The changes apply to amendments made on, before or after commencement if the Commissioner has not dealt with the amendments at commencement.

Patent oppositions – withdrawal of applications

Section 141 – allows the Commissioner to refuse an applicant's request for leave to withdraw their opposed patent application. The Commissioner can then refuse withdrawal of an opposed application where the applicant has filed a divisional application claiming the same, or substantially the same, invention. This ensures that an applicant cannot defer resolution of an invention claimed in an opposed application by withdrawing the opposed application and continuing its prosecution as a divisional application.

Section 224 – consequential amendment providing a right of appeal to the Administrative Appeals Tribunal for a decision of the Commissioner to refuse leave to withdraw a patent application under section 141.

The changes apply to notice of withdrawal filed on or after commencement in respect of patent applications made before, on or after commencement.

Patent oppositions – Commissioner’s powers & sanctions of a failure to comply

Section 210 – introduces a new higher threshold test that must be satisfied before the Commissioner can exercise her powers to summon witnesses, or require the production of documents. This will permit the Commissioner to reject requests for her to exercise her powers where she believes that the material is of limited relevance to the proceedings. The changes clarify that the Commissioner’s powers extend to entities outside of Australia, but only where that entity is a party to proceedings before the Commissioner.

Section 210A – introduces new non-criminal sanction for non-compliance with an exercise of the Commissioner’s powers under section 210. This provision gives the Commissioner flexibility to apply a sanction appropriate to the particular circumstances and to the person’s role and interest in the proceedings.

Section 61 – consequential amendment to include reference to new section 210A. This allows that refusal to grant a patent may be used as sanction against a patent applicant who is non-compliant with the Commissioner’s requirements to appear as a witness.

Sections 179 to 181 – repeals the criminal sanctions for failure to comply with a summons, a refusal to give evidence before the Commissioner, or failure to produce documents required by the Commissioner; consequential to new section 210A.

The changes apply to in relation to powers exercised by the Commissioner on or after commencement.

Divisional applications – standard patents

Section 79B – allows for the Patent Regulations 1991 to prescribe additional requirements for filing a divisional application. These will include restricting the time of filing of divisionals to within 3 months of acceptance of the parent and restricting conversion of an application into a divisional to within 3 months of acceptance of the parent or no later than acceptance of the divisional. This ensures the divisional applications cannot be filed or converted late in opposition proceedings.

The changes apply to divisional applications made on or after commencement.

Divisional applications – innovation patents

Section 79C – allows for the Patent Regulations 1991 to prescribe particulars that are required when a divisional innovation application is filed, including that details about the parent be provided. This promotes transparency.

The changes apply to divisional applications made on or after commencement.

TRADE MARKS ACT 1995

Trade Mark oppositions – Notice of Opposition

Section 52 – allows for the Trade Marks Regulations 1995 to prescribe additional requirements for the commencement of opposition proceedings. The changes remove the requirement that the opponent serves a Notice of Opposition on the trade mark applicant. The opponent will file the Notice of Opposition with the Trade Marks Office, which will send a copy of the notice to the applicant. The Trade Marks Regulations 1995 will specify that an opponent is required to file a Notice of Intention and a Statement of Grounds and Particulars, on which they intend to oppose the trade mark application. The particulars will describe the material facts and must be filed within 1 month of filing the Notice of Intention to Oppose.

Section 54 – provides the Registrar with the power to dismiss an opposition proceeding in prescribed circumstances. The Trade Marks Regulations 1995 will specify that the power to dismiss exists where an opponent does not comply with their obligation to file a Statement of Grounds and Particulars.

Section 66 – provides that the general amendment power conferred by section 66 does not apply to Notices of Opposition. The Notice of Intention to Oppose and Statement of Grounds and Particulars will be prescribed documents under section 52. The Regulations will only permit amendment of these documents under tightly controlled circumstances. This will ensure that complete information relevant to the opposition proceedings is provided early.

Section 96 – amends the provisions relating to filing of Notices of Opposition to allow for the Regulations to prescribe the manner, form and timing of filing a Notice of Opposition. The changes only apply to oppositions before the Registrar. Oppositions before a court will continue to follow existing court procedures and court rules. The changes will align the processes for opposing the removal of a trade mark with the processes for opposing an application to register a trade mark under section 52.

Trade Mark oppositions – Notice of Intention to Defend & the lapsing of trade marks applications

Section 52A – introduces a new requirement for trade marks applicants to file a notice stating their intention to defend their application in the opposition proceedings. The penalty for not filing a notice will be the application lapsing under new section 54A. This allows an uncontested opposition to be resolved sooner.

Section 54A – allows for the lapsing of a trade mark application where a trade marks applicant fails to file a notice of intention to defend under new section 52A. If an applicant inadvertently fails to file a Notice of Intention to Defend, they will be able to seek an extension of time to file that notice under the Trade Marks Act 1995.

Section 55 – consequential amendment to ensure that ‘lapsed’ applications, under new section 54A, are treated in the same way as discontinued or dismissed applications.

Section 68 – clarifies that the Registrar is obliged to register a trade mark application where the opposition has been dismissed under section 54. Also inserts a ‘note’ that an opposed application will lapse where a Notice of Intention to Defend is not filed.

Section 11 – consequential amendment to include reference to ‘lapsing’ under new section 54A.

Trade Mark oppositions – Non-use & removal of a trade mark from the Register

Section 99A – provides the Registrar with the power to dismiss an opposition to a non-use application in prescribed circumstances. The Trade Marks Regulations 1995 will specify that the power to dismiss exists where an opponent does not comply with their obligation to file a statement of grounds and particulars.

Section 97 – consequential amendment clarifying that the Registrar must remove a trade mark from the Register of Trade Marks if an opposition to an application to remove the trade mark from the Register for non-use has been dismissed under section 99A.

Regulation making powers

Section 231 – introduces a new broader power to make regulations in respect of opposition proceedings, which is consistent with the current opposition regulations making power in the Patents Act 1990.

Application provisions

The changes to trade mark opposition proceedings relate to oppositions commenced on or after commencement.

Schedule 4 - Assisting the operations of the IP profession

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PATENTS ACT 1990

Registration of patent attorneys – for individuals & companies

Section 198 – introduces provisions for a company to be registered as a patent attorney. This will give greater flexibility to patent attorneys by allowing them to practise through a corporate structure. The Patent Regulations 1991 will specify additional registration requirements for both individual and incorporated patent attorneys. A key requirement for a company registered as a patent attorney is that a director of the company must be a registered patent attorney. Consequential changes are also made to ensure that certain registration requirements for individuals will continue to only apply to natural persons.

Section 132 - ensures that the protection from liability that section 132 provides to registered patent attorneys is not limited to natural persons.

Client-attorney privilege

Section 200 – allows for the client-attorney privilege to cover communications between clients and foreign intellectual property professionals who are authorised to perform work similar to the work done by their Australian counterparts.

Disclosure of information to the Australian Securities and Investment Commission (ASIC)

Section 183 – allows the Designated Manager (currently the Director General of IP Australia) to provide information about incorporated patent attorneys to ASIC. The information must be relevant to the functions of ASIC, such as allegations of fraud on the part of the incorporated patent attorney or company.

Offences & sanctions under the Patents Act 1990

Section 201 – removes the prohibition on a company from acting or describing itself as a patent attorney.

It continues to be an offence for a company to carry on a business, practice or act as a patent attorney, or patent agent, if it is not registered as an attorney. The existing offence

provisions for individuals and partnerships have been re-worded to make them clearer.

Section 201A – makes consequential changes to the definition of carry on a business, practices or acting as a patent attorney to allow for the registration of companies as patent attorneys under section 198. It also introduces the concept of ‘patents work’ to allow for the changes to client-attorney privilege under section 200.

Section 201B – introduces sanctions for incorporated patent attorneys that fail to meet their registration requirements to have a registered patent attorney director. It is intended to prevent the provision of patent services where no qualified attorney is in charge. The scheme also provides powers for the Designated Manager to appoint a patent attorney director to an incorporated patent attorney, where the company has lost its patent attorney director in unforeseen circumstances.

Section 202B – introduces a new offence for an incorporated patent attorney or incorporated legal practice, where an employee or member prepares a patent specification, or associated document, without either being a registered patent attorney or under the supervision or instruction of an individual who is a registered patent attorney.

Section 203 – introduces a sanction to prevent registered patent attorneys from acting or describing themselves as patent attorneys unless an individual patent attorney is physically present at the office and managing the patents work.

Penalties for offences under the Patents Act 1990

Changes have been made to a number of sections to express penalty amounts in ‘penalty units’ rather than as dollar amounts. Currently, section 4AA of the Crimes Act 1914 defines a ‘penalty unit’ as being AU\$110.00.

The updated sections are: 177, 178, 182, 201, 201B, 202, 202B and 203.

Assessing the conduct of patent attorneys

Section 228 – clarifies that registered patent attorneys are legally bound by professional standards set by the Professional Standards Board for Patent and Trade Marks Attorneys (PSB). The Patent Regulations 1991 will refer to the required professional standards as a Code of Conduct, which may be updated from time to time.

Updating defined phrases

Section 3 – inserts a number of phrases to the list of definitions. These phrases are necessary for the changes to the Patents Act 1990 that are mentioned above.

Schedule 1 – inserts definitions for the new phrases listed in section 3. The new definitions are for: ‘company’, ‘director’, ‘incorporated legal practice’, ‘incorporated patent attorney’, ‘patent attorney director’, ‘patents work’, ‘related company group’ and ‘intellectual property advice’.

TRADE MARKS ACT 1995

Registration of trade marks attorneys – for individuals & companies

Section 228A – introduces provisions for a company to be registered as a trade marks attorney. This will give greater flexibility to trade marks attorneys by allowing them to practise through a corporate structure. The Trade Marks Regulations 1995 will specify additional registration requirements for both individual and incorporated trade marks attorneys. A key requirement for a company registered as a trade marks attorney is that a director of the company must be a registered trade marks attorney. Consequential changes are also made to ensure that certain registration requirements for individuals will continue to only apply to natural persons.

Client-attorney privilege

Section 229 – allows for the client-attorney privilege to cover communications between clients and foreign intellectual property professionals who are authorised to perform work similar to the work done by their Australian counterparts.

Disclosure of information to the Australian Securities and Investment Commission (ASIC)

Section 229A – allows the Designated Manager to provide information about incorporated trade marks attorneys to ASIC. The information must be relevant to the functions of ASIC, such as allegations of fraud on the part of the incorporated trade marks attorney or company.

Offences & sanctions under the Trade Marks Act 1995

Section 156 – permits a company to use the title ‘trade marks attorney’, if it is a registered incorporated trade marks attorney. Similarly, incorporated trade marks or patent attorneys and incorporated legal practices will be permitted to use the title ‘trade marks agent’. However, it will continue to be an offence for any other company to use these titles. The existing offence provisions for individuals and partnerships have been re-structured to make them clearer.

Section 157 – introduces sanctions for incorporated trade marks attorneys that fail to meet their registration requirements to have a registered trade marks attorney director. It is intended to prevent the provision of trade marks services where no qualified attorney is in charge. The scheme also provides powers for the Designated Manager to appoint a trade marks attorney director to an incorporated trade marks attorney, where the company has lost its trade marks attorney director in unforeseen circumstances.

Assessing the conduct of trade marks attorneys

Section 231 – clarifies that registered trade marks attorneys are legally bound by professional standards set by the Professional Standards Board for Patent and Trade Marks Attorneys (PSB). The Trade Marks Regulations 1991 will refer to the required professional standards as a Code of Conduct, which may be updated from time to time.

Updating defined phrases

Readers Guide – inserts a number of phrases to the list of definitions. These phrases are necessary for the changes to the Trade Marks Act 1995 that are mentioned above.

Section 6 - inserts definitions for the new phrases listed in section 3. The new definitions are for: 'company', 'Designated Manager', 'incorporated legal practice', 'incorporated trade marks attorney', 'intellectual property advice', 'Professional Standards Board', 'trade marks attorney director' and 'trade marks work'.

Section 228A – repeals definitions of phrases that have now been included in section 6.

Schedule 5 - Improving mechanisms for trade mark and copyright enforcement

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TRADE MARKS ACT 1995

Notice of Seizure and Claim for Release of Goods

Section 134 – allows Customs to give a trade mark owner (objector), who lodges a Notice of Objection about imported goods, contact and other relevant information about the Australian importer (designated owner) and foreign supplier or exporter of the goods.

Sections 136 to 136E – revises the scheme for dealing with goods seized under a Notice of Objection. A designated owner who wants the seized goods back must make a 'claim for return' to Customs. The Trade Marks Regulations 1995 will specify that the claim for return will include information which would enable an objector to contact the designated owner and instigate legal proceedings for infringement. The seized goods will only be released to the designated owner if the objector consents, or does not institute legal proceedings, or a court finds that the seized goods are not infringing.

Section 137 – consequential amendments to align the section with the revised 'claim for return' scheme.

Inspection of seized goods

Section 134A – allows Customs to permit the objector to inspect or remove multiple samples of the seized goods. This is to provide a representative sample of the goods in question and allow the parties to make a more accurate determination as to whether the consignment contains infringing goods.

Forfeit & disposal of seized goods

Section 136A – provides that where no claim for release is made by the designated owner of the seized goods, under section 136, then the goods are forfeited to the Commonwealth.

Section 136E – provides that where a designated owner makes a claim for release but fails to collect the goods within 90 days, then the goods are forfeited to the Commonwealth.

This ensures that Customs is not required to store goods indefinitely.

Section 139 – allows Customs to deal with forfeited goods by disposing of them and ensures that designated owners of non-infringing goods can be compensated if their goods are disposed of by Customs. Introduces a 30 day holding period before forfeited goods can be disposed of. This time period ensures that designated owners of seized goods have adequate time in which to make a claim for their goods.

Trade Marks Offences & additional damages for Trade Mark infringement

Sections 145 to 149 – increase the penalties for existing indictable offences and re-structure the elements of the existing offence provisions to make them clearer. Introduces new corresponding summary offences after each indictable offence. Summary offences have lower fault elements and lower penalties.

Section 126 – provides the court with the discretion to award additional damages in infringement proceedings. Consistent with the approach in the Patents Act 1990, there is a list of specific factors to assist the courts as to when it may be appropriate to award additional damages.

Updating defined phrases

Readers Guide – inserts a number of phrases to the list of definitions. These phrases are necessary for the changes to the Trade Marks Act 1995 that are mentioned above.

Section 6 - inserts definitions for the new phrases listed in section 6. The new definitions are for: 'action period', 'claim period' and 'personal information'.



COPYRIGHT ACT 1968

Notice of Seizure and Claim for Release of Goods

Section 135AC – allows Customs to give a copyright owner (objector), who lodges a Notice of Objection about imported goods, contact and other relevant information about the Australian importer and foreign supplier or exporter of the goods. The changes also re-structure the existing provisions to provide clarity.

Section 135AEA to 135AFA – revises the scheme for dealing with copies of goods under a Notice of Objection. An importer who wants the seized copies back must make a 'claim for return' to Customs. The Copyright Regulations 1969 will specify that the claim for return will include information which would enable an objector to contact the importer and instigate legal proceedings for infringement. The seized goods will only be released to the importer if the objector consents, or does not institute legal proceedings, or a court finds that the seized copies are not infringing.

Inspection of seized goods

Section 135AD – clarifies that Customs can permit the objector to inspect or remove multiple samples of the seized goods. This is to provide a representative sample of the goods in question and allow the parties to make a more accurate determination as to whether the consignment contains infringing copies.

Forfeit & disposal of seized goods

Section 135AEB – provides that where no claim for release is made by the importer of the seized goods, under section 135 AEA, then the goods are forfeited to the Commonwealth.

Section 135AFA – provides that where an importer makes a claim for release but fails to collect the goods within 90 days, then the goods are forfeited to the Commonwealth. This ensures that Customs is not required to store goods indefinitely.

Section 135AI – allows Customs to deal with forfeited goods by disposing of them and ensures that importers of non-infringing goods can be compensated if their copies are disposed of by Customs. Introduces a 30 day holding period before forfeited goods can be disposed of. This time period ensures that importers of seized goods have adequate time in which to make a claim for their goods.

Section 135AE –consequential amendments to remove the requirement that Customs must dispose of forfeited goods in the manner prescribed by the Copyright Regulations 1969. The disposal of forfeited goods is now dealt with by new section 135AI.

Review of decisions

Section 195B – provides a right of appeal to the Administrative Appeals Tribunal for a decision of Customs under the revised sections mentioned above.

Updating defined phrases

Section 134B – inserts a number of phrases that are necessary for the changes to the Copyright Act 1968 that are mentioned above. The new definitions are for: ‘action period’, ‘claim period’, ‘personal information’ and ‘working day’

Schedule 6 - Simplifying the IP system

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PATENTS ACT 1990

Extension of secret use & the grace period

Section 9 – allows that any use of the invention, within Australia, within 12 months of the filing of a complete application claiming the invention is not taken to be ‘secret use’.

The change applies to use of the invention on or after commencement.

Section 24 – provides that the ‘grace period’ applies for not only the publication or use of the invention by the patentee but also for circumstances where the patentee discloses work done, or a prototype that led directly to their invention within the prescribed period. The Patent Regulations 1991 will continue to specify that, for the ‘grace period’ to apply, a complete application must be filed within 12 months of the public disclosure of information.

The change applies to information made available on or after commencement.

Omnibus claims

Section 40 – prevents the use of omnibus claims except where the invention can only be defined by reference to a specific detail in the specification. For example, where reference to a spectroscopic profile or reference to a specific feature in a figure or drawing is the only way of defining the invention.

The change applies to applications where the request for examination was filed on or after commencement.

Disclosure in basic applications

Section 43AA – clarifies the requirements for making basic applications (an application made in a Convention country) available to the Commissioner and the circumstances in which the Commissioner will give account to the disclosures in those documents. These changes enable applicants to meet the Commissioner’s requirements through the use of the WIPO Digital Access Service.

Section 8 – consequential repeal of section 8 due to new section 43AA.

Examinations & search results – for both standard patents and innovation patents

Section 45 – allows the Commissioner to not examine and report on a PCT application where formality requirements prescribed in the Patent Regulations 1991 have not been met. The changes also repeal a requirement for the patent applicant to notify the Commissioner of certain patentability searches.

The change applies to applications made on or after commencement.

Sections 46 to 48 – repeal modified examination and deferral of examination.

Section 101D – repeal the requirement for innovation patentees to inform the Commissioner of certain patentability searches.

Section 102 – consequential repeal of sanction for non-compliance with section 45 and 101D, which have also been repealed.

Section 142 – consequential repeal of provisions for the lapsing of applications where examination has been deferred, due to repeal of section 46.

PCT & Convention applications

Sections 29A, 29B, 30, 38, 43, 56A and 197AA – restructures the Patents Act 1990 to co-locate provisions for PCT and Convention applications with the equivalent provisions for standard applications. The changes also clarify where aspects of the application process is governed by the Patent Regulations 1991. This results in the existing substantive requirements for complete applications being a more coherent and transparent legislative package that is easier for users to navigate.

Section 43 – provides that an earlier application, made in another convention country, must be disregarded if it was made within the prescribed period and has been withdrawn, abandoned or refused, without becoming open for public inspection or serving as a basis for claiming priority. The Patent Regulations 1991 will specify that the prescribed period is the period more than 12 months before the filing date of the PCT or Convention application from which the applicant wishes to claim priority.

The change applies to applications made on or after commencement.

Section 53 – clarifies that the existing requirement for the Commissioner to publish prescribed information about the applicant and the application in the Official Journal does not apply to PCT applications. The Patent Regulations 1991 will specify what information about PCT applications is to be published.

Section 55 – consequential amendment to include reference to section 56A.

Section 57 – clarifies that provisions relating to the effect of publication of a complete specification, also applies to PCT applications. The changes also update references to include section 56A.

Sections 141 and 142 – clarifies that the Patent Regulations 1991 specify the circumstances in which PCT applications are taken to be withdrawn, or to have lapsed.

Section 223 – clarifies that the provision relating to extensions of time where there has been an error or omission by the Patent Office, also applies to PCT applications in respect

of error or omissions relating to the PCT receiving office or International Bureau of WIPO. The Patent Regulations 1991 will specify any additional requirements for extensions of time.

Chapter 8 – repeals existing provisions for PCT and Convention applications to allow for the restructuring of the Patents Act 1990. These provisions have been re-enacted and co-located with provisions dealing with standard applications.

Section 10 – consequential repeal of reference to Chapter 8 due to repeal of entirety of Chapter 8 provisions.

Patent ownership & resolving disputes

Section 22A – clarifies that a patent is not invalid merely because the patent was granted to a person who was not entitled to it.

Section 32 – restricts section 32 to the settling of disputes, including ownership disputes, between jointly named patent applicants. The changes also clarify that the Commissioner may make a declaration, regarding the correctly entitled owner, whether or not the application is lapsed.

The change applies to disputes commenced on or after commencement.

Section 36 – restricts section 36 to the settling of ownership disputes between patent applicants and other interested parties. The changes give the Commissioner the discretionary power to direct in whose name, or names, the application is to proceed. The section will apply at any time until the granting of the patent. This permits the resolution of entitlement issues without forcing parties into opposition proceedings.

The change applies to any declarations made by the Commissioner in respect of ownership on or after commencement.

Section 138 – provides that a court must not revoke a patent for incorrect entitlement unless it is just and equitable to do so in all circumstances.

The change applies to orders made on or after commencement.

Acceptance & Revocation

Sections 49 and 49A – gives the Commissioner the discretion whether to allow a request to postpone acceptance or not. The Commissioner will also have the discretion to postpone acceptance, even if the applicant has not requested it. For example, where there is a dispute about ownership of a patent application underway, it may be more appropriate to postpone acceptance and then grant the patent to the correctly entitled person once the dispute is resolved.

Section 50A – gives the Commissioner the discretion to revoke acceptance of an application where an administrative error has resulted in acceptance of an application that should not have been accepted. Questions about the substantive quality of an accepted application will continue to be dealt with through provisions for re-examination or opposition.

The change applies to applications accepted on or after commencement.

Section 51 – consequential amendment clarifying that a decision to revoke acceptance under new section 50A is not appealable to the Federal Court.

Section 101EA – gives the Commissioner the discretion to revoke a decision to certify an innovation patent where the certificate of examination should not have been issued. Where certification is revoked the Commissioner will be able to amend the Register under new section 191A to remove details of the innovation patent from the Register.

The change applies to innovation patents certified on or after commencement.

Granting of Patents & rectification of the Register

Section 61 – alters the process for granting a patent. Particulars of the patent will be entered into the Register of Patents. Patents will no longer be affixed with a seal.

Section 62 – replaces the process for granting an innovation patent with a process for entering the particulars of the grant in the Register of Patents. Innovation patents will no longer be affixed with a seal.

Sections 66, 79C, 81 and 135 – consequential amendments to remove references to ‘seal’ or ‘sealed’ and replace them with ‘grant’ or ‘granted’. Changes also repeal provisions related to the sealing of a duplicate patent.

Section 105 – consequential amendment to remove references to ‘the patent’ as being a physical document. The new process for granting a patent is the entry of particulars in the Register of Patents under sections 61 and 62.

Section 191A – gives the Commissioner the power to declare who owns a patent and to amend the Register to correct an error or omission to correct ownership details.

Section 215 – consequential amendment to allow for details in the Register of Patents to be changed when a patentee dies.

The changes apply to patents granted on or after commencement.

Non-infringement declarations

Section 125 – clarifies that a person seeking a declaration need not have sought, or been granted, a patent themselves in order to utilise the provision. The changes also extend the cover of a declaration to past, present and future acts. Non-infringement declarations also may only be sought once the respondent’s standard patent has been granted, or innovation patent certified.

Section 126 – allows an applicant for a non-infringement declaration to challenge the validity and seek revocation of the respondent’s patent in the same proceedings. This will enable the courts to resolve all aspects of a patent dispute more efficiently. The changes also provide the court with the discretion to award costs.

Section 127 – consequential amendment to remove references that are made redundant by amendments to section 125.

The changes apply to applications for non-infringement declarations made on or after commencement.

Review of decisions

Section 224 – provides for merits review by the Administrative Appeals Tribunal (AAT) for a decision of the Commissioner to grant or refuse inspection or production of documents that are not Open to Public Inspection. Also consequential amendments to references to other sections of the Patents Act 1990 that have been amended or repealed.

Section 227 – consequential amendment to references to other sections of the Patents Act 1990 that have been amended or repealed.

Updating defined phrases

Removal of patent process flowchart & Treaty texts

Patent Office & sub-offices

OPI documents

Section 3 – revises definitions for phrases listed in section 3. Repeals definitions for: ‘foreign patent office’, ‘modified examination’ and ‘sealed’.

Schedule 1 – revises definitions for phrases listed in schedule 1. These definitions are for: ‘Budapest Treaty’, ‘Convention application’, ‘convention country’, ‘examination’, ‘foreign patent office’, ‘international filing date’, ‘modified examination’, ‘PCT application’, ‘prior art base’ and ‘sealed’.

Section 4 – removes the flowchart setting out the steps for getting a patent. The flowchart is out of date and has been superseded by information on IP Australia’s website.

Section 228 – removes the requirement that the full text of certain treaties be set out in the Patents Regulations 1991. The Patent Regulations 1991 will refer to internet addresses where authoritative versions of the Treaty texts may be sourced.

Section 205 – removes the requirement that there must be a sub-office of the Patents Office in each State. Provides flexibility to the Commissioner to discontinue sub-offices in the future when e-business channels are sufficiently reliable and having sub-offices becomes redundant.

Section 214 – consequential amendment which clarifies that there need not necessarily be sub-offices. Changes also clarify that ‘prescribed means’ is not limited to filing only at a sub-office but applies more generally and includes filing at the Patents Office.

Section 222A – consequential amendment which clarifies that there need not necessarily be sub-offices.

Section 226 – clarifies the exemption from copyright infringement for certain documents in certain circumstances. Extends the copyright exemption to the reproduction of the documents in a two dimensional form and communicating the document to the public. This will enable IP Australia to make most documents associated with a patent case file available to the public via the internet.

Regulation making powers

Section 228 – changes the regulation making powers to allow for the changes to the Patents Act 1990 that are mentioned above.



TRADE MARKS ACT 1995

Presumption of registrability

Section 41 – clarifies that the presumption of registrability, as provided for in section 33, applies to section 41. Changes restructure the existing provisions to place the focus on the characteristics that a mark must possess for it to be capable of distinguishing goods or services. If the Registrar is equally unsure of whether the mark is or is not capable of distinguishing, that doubt should be resolved in the applicant's favour. The amendments are not intended to alter the concepts of 'inherently adapted to distinguish', 'capable of distinguishing' and 'does or will distinguish'.

Jurisdiction of the courts

Sections 35, 56, 67, 83, 83A, 83D, 104, 190 to 197 – provide the Federal Magistrates' Court with the jurisdiction to hear and decide Trade Marks matters.

Trade Marks Office & sub-offices

Sections 199, 213 and 223 – remove the requirement that there must be a sub-office of the Trade Marks Office in each State. This provides flexibility to the Registrar to discontinue sub-offices in the future when e-business channels are sufficiently reliable and having sub-offices becomes redundant. Changes also clarify that 'prescribed means' is not limited to filing only at a sub-office but applies more generally and includes filing at the Trade Marks Office.

Section 27 – consequential amendment which clarifies that there need not necessarily be sub-offices.

Updating defined phrases

Removal of Treaty text & list of convention countries

Section 6 – revises the definition of 'convention country' and removes the requirement that countries be individually listed in the Trade Marks Regulations 1995. Instead the Trade Marks Regulations 1995 will refer to internet addresses where authoritative lists of convention countries may be sourced.

Section 225 – consequential repeal due to change in definition of 'convention country' in section 6.

D

DESIGNS ACT 2003

Jurisdiction of the courts

Sections 28, 50, 52, 54, 67, 68, 82, 83A, 84 to 89 – changes provide the Federal Magistrates' Court with the jurisdiction to hear and decide designs matters.

Designs sub-offices & the filing of documents

Section 125 – removes the requirement that there must be a sub-office of the Designs Office in each State. Provides flexibility to the Registrar to discontinue sub-offices in the future when e-business channels are sufficiently reliable.

Section 136A – consequential amendment which clarifies that there need not necessarily be sub-offices.

Section 144 – consequential amendment to clarify that 'prescribed means' is not limited to filing only at a sub-office but applies more generally and includes filing at the Designs Office.

Updating defined phrases

Sections 5 and 5A – insert and revise definitions for phrases listed in section 5. The new definitions are for: 'convention country', 'Federal Court' and 'prescribed court'.

PBR

PLANT BREEDER'S RIGHTS ACT 1994

Updating defined phrases & removal of Treaty text

Section 3 – revises definition for the phrase 'convention' listed in section 3. Also removes the requirement that the full text of the International Convention for the Protection of New Varieties of Plants (UPOV Convention) be set out in Schedule 1.

Section 43 – revises definitions for a number of phrases to ensure they are consistent with the UPOV Convention. These definitions are for: 'authority', 'territory' and 'variety'.

Schedule 1 – consequential repeal due to changes to section 3 and the removal of the requirement to set out the full text of the UPOV Convention.

Regulation changes

This section highlights some of the important changes to the draft Regulations. They build on the reforms covered in the Act. Changes to IP Australia's administrative processes will also flow from these amendments.

A full list of the final regulations will be available on IP Australia's website in March 2013.

Schedule 1 - Raising the quality of granted patent



PATENTS REGULATIONS 1991

Search at Examination

Revises the fee structure for examination of standard patent applications filed in Australia. The regulations will introduce a search fee of \$1400 which will be payable if a full search needs to be conducted at examination. The new fee structure will reflect the amount of original work done by examiners and the degree to which examiners rely on work done under the PCT or by foreign patent offices.

We will provide further guidance closer to the commencement date on implementation of the search fee.

Preliminary Search and Opinion

Provides a voluntary option for applicants to request a Preliminary Search and Opinion (PSO), conducted by IP Australia. The PSO will be similar to a PCT international search, and will have a fee of \$2200. A PSO can be requested on a complete application at any time before examination is requested.

Please note that no regulation changes were made for Schedule 2 of the *Australian Intellectual Property Laws Amendment (Raising the Bar) Act 2012*.

Schedule 3 - Reducing delays in resolution of patent and trade mark applications



PATENTS REGULATIONS 1991

Patent oppositions

The changes to the Patents Regulations are intended to reduce delays in resolving opposition proceedings.

Notice of Opposition scheme

There are two main types of opposition – substantive and procedural. Procedural oppositions are generally less complex than substantive oppositions and require less time to prepare and file documents.

The time period for filing a Notice of Opposition in substantive oppositions has been maintained as 3 months.

The time period for filing a Notice of Opposition in procedural oppositions is now 2 months.

The different time periods for commencing opposition will enable less complex procedural oppositions to be resolved faster.

Statement of Grounds and Particulars

Changes require that documents referred to in the Statement of Grounds and Particulars, such as prior art citations, be provided at the same time as the Statement, rather than with the evidence in support.

Providing the applicant with the documents at the time of filing the Statement of Grounds and Particulars will help resolve oppositions sooner, as the applicant would have a better idea of whether the case against them was strong or weak and whether they wish to continue to pursue their application.

Extension of Time for filing evidence

A new test has been introduced to determine whether an extension of time for filing evidence is justified.

In order to extend the time period the Commissioner must be satisfied that the party seeking the extension has acted promptly and diligently at all times and has made all reasonable efforts to comply with time limits for filing evidence; or if there are exceptional circumstances that warrant an extension.

Procedural oppositions

The Commissioner will have the ability to direct, on a case-by-case basis, the procedures for a procedural opposition, including directing timeframes for filing evidence.

Procedural oppositions are those filed under regulation 5.10.

Hearings

Changes will clarify that the Commissioner may decide on their own initiative to hold a hearing. The Commissioner also has discretion whether the hearing is conducted orally or by written submissions.

Changes formalise the timeframe for filing the summaries of submissions. The opponent will be required to file a summary at least 10 business days before the hearing date. The applicant will be required to file their summary 5 business days before the hearing date.

The Commissioner will give the summaries to the alternate party as soon as practicable. This should result in swifter and more efficient pre-hearing process to the benefit of all participants.

Change to method of providing evidence between parties

Removes the requirement for parties to serve documents and evidence on the other party in an opposition proceeding. Parties will only be required to file documents and evidence with the Patents Office. The Patents Office will give the relevant documents to the other party and notify them of the start of any future time periods for filing documents and evidence to support their case.

Divisional applications

Deadlines for filing applications

Changes will prescribe earlier deadlines for filing divisional applications. A divisional application for a standard patent will not be able to be filed later than 3 months from the day on which the notice of acceptance of the first application is published.

Particulars to be included with applications

The new regulations prescribe particulars that are required to be provided with the divisional application. This will include information that identifies the original application from which the application is derived.



TRADE MARK REGULATIONS 1995

Trade Mark oppositions

The changes to the Trade Marks Regulations are intended to reduce delays in resolving opposition proceedings.

These changes are applicable to oppositions to registration, amendment after particulars published, removal of trade marks from the Register for non-use, International Registrations Designating Australia and extensions of time, corresponding to parts 5, 6, 9, 17A and 21 of the Regulations, respectively.

Notice of Opposition scheme

The new Notice of Opposition scheme separates the notice into two components – a Notice of Intention to Oppose and a Statement of Grounds and Particulars.

The Notice of Opposition is taken to have been filed when both components are filed.

The Statement of Grounds and Particulars gives an applicant an early indication of the opposition case they will likely meet.

Changes introduce a new time period to file the first component – the Notice of Intention to Oppose, as 2 months from when the trade mark application is advertised for acceptance. The second component – the Statement of Grounds and Particulars is then filed 1 month from the filing of the Notice of Intention to Oppose.

Notice of Intention to Defend

Changes introduce the Notice of Intention to Defend, as trade mark applicants sometimes do not defend their applications after a Notice of Opposition has been filed. The Notice of Intention to Defend must be filed within 1 month from the day the applicant is given a copy of the Statement of Grounds and Particulars.

If the applicant fails to file the Notice of Intention to Defend the trade mark application will lapse.

Extension of Time for filing evidence

A new test has been introduced to determine whether an extension of time for filing evidence is justified.

In order to extend the time period the Registrar must be satisfied that the party seeking the extension has acted promptly and diligently at all times and has made all reasonable efforts to comply with time limits for filing evidence; or if there are exceptional circumstances that warrant an extension.

Time period for filing evidence in reply

The time period for applicant's to file evidence in reply will be reduced from 3 to 2 months.

This improves the opposition process by condensing the prescribed periods for filing evidence.

Cooling-off period for negotiating

The regulations introduce a new 'cooling-off' period to facilitate genuine negotiations between parties during opposition proceedings.

A cooling-off period can be requested at any time after the complete Notice of Opposition has been filed. All parties involved in the opposition must agree to the cooling-off period.

The cooling-off period allows for the opposition to be suspended for an initial period of 6 months up to a maximum of 12 months.

Procedural oppositions

The Registrar will have the ability to direct, on a case-by-case basis, the procedures for a procedural opposition, including directing times for filing evidence.

Procedural oppositions are those filed under regulations 6.6 and 21.20B.

Hearings

Changes will clarify that the Registrar may decide on their own initiative to hold a hearing. The Registrar also has discretion whether the hearing is conducted orally or by written submissions.

Changes formalise the timeframe for filing the summaries of submissions. The opponent will be required to file a summary at least 10 business days before the hearing date. The applicant will be required to file their summary 5 business days before the hearing date.

The Registrar will give the summaries to the alternate party as soon as practicable. This should result in swifter and more efficient pre-hearing processes to the benefit of all participants.

Change to method of providing evidence between parties

Removes the requirement for parties to serve documents and evidence on the other party in an opposition proceeding. Parties will only be required to file documents and evidence with the Trade Marks Office. The Trade Marks Office will give the relevant documents to the other party and notify them of the start of any future time periods for filing documents and evidence to support their case.

D

DESIGNS REGULATIONS 2004

Designs oppositions

Change to method of providing evidence between parties

Removes the requirement for parties to serve documents and evidence on the other party in an opposition proceeding. Parties will only be required to file documents and evidence with the Designs Office. The Designs Office will give the relevant documents to the other party and notify them of the start of any future time periods for filing documents and evidence to support their case.

Schedule 4 - Assisting the operations of the IP profession



PATENTS REGULATIONS 1991 & TRADE MARKS REGULATIONS 1995

Incorporation

The Intellectual Property Laws Amendment (Raising the Bar) Act allows attorneys to practice through a corporate structure. Companies will be able to be registered as incorporated patent attorneys or incorporated trade marks attorneys. This amendment will give attorneys more options as to how they structure their businesses and align these structures with those available to similar professions particularly the legal profession.

Incorporated attorneys will be required to maintain adequate and appropriate professional indemnity insurance as well as ensuring that the company has at least one registered patent attorney director for incorporated patent attorneys and at least one registered trade marks attorney director for incorporated trade marks attorneys.

Attorney charged with a serious offence

In relation to individual registered attorneys, there is a provision in the Regulations to permit the Designated Manager to suspend an attorney charged with a serious offence.

Schedule 5 - Improving mechanisms for trade mark and copyright enforcement



TRADE MARKS REGULATIONS 1995 & COPYRIGHT REGULATIONS 1969

Notice of seizure and claim for release of copies or goods

The Australian Customs and Border Protection Service (Customs) has the power to seize and hold imported goods that infringe copyright and registered trade marks where the IP right owner has lodged a Notice of Objection with Customs.

Changes are made to the information that an importer must provide to Customs when making a claim for the release of seized copies or goods. This information will include the importer's full name, addresses and telephone number.

Customs will then be able to provide the importer's details to the IP right owner, enabling the IP right owner to start infringement proceedings if necessary.

Schedule 6 - Simplifying the IP system



PATENTS REGULATIONS 1991

Period for directions to request examination

The time period for an applicant to request examination following a direction from the Commissioner will be reduced from 6 to 2 months.

The reduced time period will apply to all directions issued, under subsection 44(2) of the Patents Act, on or after 15 April 2013.

This change strikes a balance between giving the applicant sufficient time to decide whether they wish to have their application examined and reducing delays that are not in the public interest.

Examination to acceptance period reduced

In order to provide earlier resolution of patent applications, the time period for applicants to obtain acceptance of their application will be reduced from 21 to 12 months from the date of the first examination report. This 12 month period is the total period in which an applicant has to resolve issues with their application and gain acceptance of the application – it is not a response time.

The reduced time period will apply to all requests for examination made on or after 15 April 2013.

Notice of Entitlement

Changes provide that an applicant must provide a Notice of Entitlement at the time examination of the application is requested.

Early filing of the Notice of Entitlement benefits the general public by providing an early indication of the basis of entitlement claimed and encourages early resolution of entitlement issues.

Hearings

Changes clarify that the Commissioner has the discretion to determine whether an oral hearing is conducted or written submissions are provided for certain matters.

TM

TRADE MARK REGULATIONS 1995

Hearings

Changes clarify that the Registrar has the discretion to determine whether an oral hearing is conducted or written submissions are provided for certain matters.

D

DESIGNS REGULATIONS 2004

Hearings

Changes clarify that the Registrar has the discretion to determine whether an oral hearing is conducted or written submissions are provided for certain matters.

For further information

IP Australia's website will be updated frequently with more information about implementation of these changes. Visit www.ipaustralia.gov.au

ipaaustralia.gov.au

January 2013

