

IPRIA Australian Developments in IP

Update July 2009

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Australian Government responds to Resale Royalty Right for Visual Artists Bill 2008

On **28 May 2009**, the Australian Government responded to the report of the House of Representatives Standing Committee on Climate Change, Water, Environment and the Arts on the inquiry into the Resale Royalty Right for Visual Artists Bill 2008, as tabled on 20 February 2009. The Bill is intended to create a resale royalty right in Australia for visual artists and establish a statutory scheme to enforce the right and collect and distribute royalties. In its response, the Government agreed to review the scheme within five years of the commencement date. It also agreed to expand the definition of an artwork in the scheme to include forms of fine art textiles, installations, fine art jewellery, artist's books, carvings, and multimedia artworks. After considering the views of the Committee and stakeholders, the Government sought further legal advice relating to the prospective application of the scheme. The Bill is expected to be debated in the House of Representatives this sitting period.

For more information, click here

<http://www.alp.org.au/media/0509/msart280.php>

PATENTS

IP Australia releases Consultation Paper directed at improving the balance in the patent system

On 27 March 2009, IP Australia released a Consultation Paper titled 'Getting the Balance Right: Toward a Stronger and More Efficient IP Rights System'. It is the first in a series of Consultation Papers by IP Australia aimed at improving 'the fit and function' of the country's IP system. The proposals in the Paper are directed at improving the balance in the patent system by:

- raising the thresholds set for grant of a patent in Australia and better aligning Australia's patentability standards with standards in regions which are our major trading partners – such as Japan, US and Europe; and
- improving the scope and stringency of examination to reduce inconsistencies and give greater certainty in the validity of granted patents.

The closing date for submissions on the Consultation Paper was **8 May 2009**.

To access the Consultation Paper, click here

http://www.ipaustralia.gov.au/pdfs/news/ip_reforms_balance.pdf

IP Australia releases Consultation Paper on experimental patent use

On 27 March 2009, IP Australia released a Consultation Paper titled 'Exemptions to Patent Infringement: Toward a Stronger and More Efficient IP Rights System'. The objective of the proposals in the Paper is to implement a statutory exemption that provides for certain experimental activities to be carried out without such activities constituting an infringement of a patent. The *Patents Act 1990* does not contain a specific research or experimental use exception and IP Australia 'is not aware of any legal cases in Australia where experimental use was argued as a defence against infringement litigation'. As a consequence it is unclear whether an experimental use exemption exists in Australia, and if it does, the extent to which it applies. The Paper sets out a proposal for an experimental use statutory exemption that is limited only to research use of an invention and does not extend to commercial exploitation of a patented invention. The closing date for submissions was **8 May 2009**.

To access the Consultation Paper, click here

http://www.ipaustralia.gov.au/pdfs/news/ip_reforms_exemptions.pdf

IP Australia releases Consultation Paper on resolving patent opposition proceedings faster

On 18 June 2009, IP Australia released a Consultation Paper titled 'Resolving Patent Opposition Proceedings Faster: Toward a Stronger and More Efficient IP Rights System'. Stakeholders have indicated agreement that opposition processes should be quick and efficient, and that present processes are often unsatisfactory, being both too long and too expensive. They have indicated that proceedings are sometimes deliberately extended, and that the objective of the opponent can sometimes be delay. The proposals for reform of the patent opposition process outlined by IP Australia include the following:

- where a party does not intend to rely on evidence in the opposition, it would be able to serve a notice to that effect;
- the existing opposition extension-of-time provisions for providing evidence would be repealed. Any extension of the periods to serve evidence would be by direction of the Commissioner; and
- the further evidence provisions would be repealed. Parties would be able to provide any document to IP Australia at any stage, however, they would not be entitled to serve this information as 'further evidence' in an opposition.

The closing date for submissions regarding the Consultation Paper is **17 August 2009**.

To access the Consultation Paper, click here

http://www.ipaustralia.gov.au/pdfs/news/resolving_patent_oppositions_faster.pdf

IP Australia releases Consultation Paper on resolving patent divisional applications faster

On 18 June 2009, IP Australia released a Consultation Paper titled 'Resolving Divisional Applications Faster: Toward a Stronger and More Efficient IP Rights System'. Australia's patent legislation permits applicants to file 'divisional' patent applications for additional inventions disclosed in their earlier parent application(s). Divisional provisions permit applicants to 'divide' out multiple inventions into separate applications without losing their priority rights. In order to reduce the delays associated with resolution of divisional applications, IP Australia proposes the following reforms:

- applicants would be directed to request examination soon after filing of a divisional, and examination will commence more quickly after the request is filed;
- the prosecution of divisional applications would be actively managed to ensure an early determination;
- the times available for filing a divisional application following acceptance and for amending the patent request form to claim divisional status would be reduced; and
- applicants would need to seek leave to withdraw an opposed application.

The closing date for submissions on the Consultation Paper is **17 August 2009**.

To access the Consultation Paper, click here

http://www.ipaustralia.gov.au/pdfs/news/consultation_resolving_divisional_applications_faster.pdf

PCT rule changes commence on 1 July 2009

As of **1 July 2009**, a number of Patent Cooperation Treaty (PCT) rule changes come into effect. These changes include amendments to guidelines when filing sequence listings and their associated fees. Changes have also been made to rules 46.5 and 66.8 in regard to filing amendments. Rule 29.4 has also been amended referring to the Notification of intent to make a declaration under Article 14 (4).

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new.shtml#31

TRADE MARKS AND OTHER INDICATIONS

IP Australia releases Consultation Paper on resolving trade mark opposition proceedings faster

On 18 June 2009, IP Australia released a Consultation Paper titled 'Resolving Trade Mark Opposition Proceedings Faster: Toward a Stronger and More Efficient IP Rights System'. To be an effective option for competitors, opposition procedures must be swift and inexpensive, particularly in comparison to court proceedings. Trade mark opposition procedures must also be as simple and straightforward as possible. According to IP Australia, there are concerns that present opposition processes do not meet these aims. The proposals for reform put forward include the following:

- a statement of grounds and particulars to accompany a notice of opposition;
- a 'cooling off' period may be requested at any time after the notice of opposition and statement of grounds and particulars is filed; and
- parties appearing before the Registrar would be required to provide a summary of submissions prior to a hearing.

The closing date for submissions regarding the Consultation Paper is **17 August 2009**.

To access the Consultation Paper, click here

http://www.ipaustralia.gov.au/pdfs/news/resolving_tm_oppositions_faster.pdf

GENERAL IP

Intellectual Property Law Amendment Regulations commence on 1 July 2009

The Intellectual Property Law Amendment Regulations 2009 (No.1) were signed by

the Governor-General on 24 June 2009. The Amendment Regulations came into effect on **1 July 2009**. The main purpose of the Amendment Regulations is to update the English text of the rules made under the Patent Cooperation Treaty (PCT) to reflect recent changes to the PCT. They will also align the various requirements for declarations in the designs, patents and trade marks legislation in accordance with current government recommendations and make a number of minor typographical corrections.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new.shtml#30

Dr Francis Gurry lecture on ‘Intellectual Property, Innovation and Creativity - Future Global Directions’

Dr Francis Gurry will present a public lecture on the above topic at the Melbourne Law School on **3 August 2009**. Dr Gurry is the Director General of the World Intellectual Property Organization. He is the highest-ranking Australian official in a United Nations agency, and only the third to ever head a UN agency. Dr Gurry is making his first official visit to Australia since his election as Director General last year. Melbourne Law School presents this free lecture in conjunction with The Institute of Patent and Trade Mark Attorneys of Australia (IPTA), and with the support of IP Australia. Registrations are essential.

For more information, click here

<http://www.law.unimelb.edu.au/index.cfm?objectid=4B1D1CB1-B0D0-AB80-E28E8C05438EC230&DiaryID=4308>

Submissions called for Pacific Rim Innovation Conference

The Pacific Rim Innovation Conference 2010 will be held at the University of Melbourne on **21 and 22 January 2010**. The event is being organised by IPRIA, with support from the Institute of Innovation Research (Hitotsubashi University), the NUS Business School (National University of Singapore) and the University of Auckland Business School. This inaugural conference will foster an inter-disciplinary exchange of knowledge regarding the economics, management and law of innovation. The conference will focus on:

- the effectiveness of the IP system;
- markets for technology;
- the strategic management of R&D – within and between firms (eg ‘open innovation’);
- government innovation policies; and
- managing key challenges of the 21st Century (eg climate change, gene patents, nanotechnology).

Submissions are invited until 30 September 2009. Registration for the conference will open on 4 October 2009.

For more information, click here

<http://www.ipria.org/events/conf/PRI%20Conference/default.html>

Developments regarding Australia's Free Trade Agreements (FTAs)

Australia-GCC FTA negotiations continue

After an extended pause, initially due to scheduling problems and then a temporary suspension of FTA negotiations by the Gulf Cooperation Council (GCC), the third round of Australia's FTA negotiations with the GCC was held in Canberra from **24 to 26 February 2009**. Negotiations at this round were broad-ranging and built on the progress made at the second round (November 2007 in Riyadh). There were 'productive discussions' across most issues, and information was exchanged on each party's respective domestic arrangements concerning IP. The timing of a fourth round is yet to be confirmed but is expected to be around mid-year. The Department of Foreign Affairs and Trade (DFAT) welcomes submissions on issues relevant to the negotiation of an FTA with the GCC.

For more information, click here

http://www.dfat.gov.au/trade/fta/gcc/Update_4.html

Eighth negotiating round of Australia-Japan FTA

The eighth round of negotiations on the Australia-Japan FTA was held in Tokyo from **9 to 13 March 2009**. 'Good progress' was made in the IP chapter negotiations and substantial agreement has been reached on a majority of provisions. The parties also continued to make progress on the e-commerce chapter, and on dispute settlement and other legal and institutional issues. DFAT welcomes submissions regarding the Australia-Japan FTA negotiations.

For more information, click here

http://www.dfat.gov.au/geo/japan/fta/newsletter_update/update_8.html

First negotiating round of Australia-Republic of Korea FTA

On **18 May 2009**, Minister for Trade, Mr Simon Crean, and Minister for Trade of the Republic of Korea, Mr Kim Jong-hoon, opened the first round of negotiations of the Australia-Korea FTA in Melbourne. Officials then held four days of negotiations in Canberra. Overall, discussions were said to be 'positive'. Each side was constructive in its approach, and all major topic areas were canvassed. The two sides had 'useful exchanges' on topics including IP rights, competition policy, government procurement and legal and institutional issues. The second round of negotiations will be held in Seoul, most likely in September. DFAT welcomes input on issues of relevance to the Australia-Korea FTA negotiations.

For more information, click here

http://www.dfat.gov.au/geo/rok/fta/newsletter_090603.html

RESEARCH AND FUNDING

Submissions sought on ARC Centres of Excellence Consultation Paper

On 23 June 2009, Minister for Innovation, Industry, Science and Research, Senator Kim Carr, released a Consultation Paper on the Australian Research Council (ARC) Centres of Excellence scheme, and called for responses. The ARC is a statutory authority within the Australian Government's Innovation, Industry, Science and Research portfolio. Its mission is 'to deliver policy and programs that advance

Australian research and innovation globally and benefit the community.’ The Centres of Excellence scheme was established in 2003 to address designated National Research Priorities. The Centres of Excellence Consultation Paper outlines proposed changes to the scheme including:

- increasing the life-span of the Centres from five to seven years; and
- increasing the minimum allocation to \$1 million and the maximum to \$4 million per annum to each successful Centre.

The closing date for comments on the Consultation Paper is **21 July 2009**. It is proposed that a new round of Centres will be awarded in 2011.

For more information, click here

http://www.arc.gov.au/media/releases/media_23June09.htm