

IPRIA Australian Developments in IP

Update March 2008

Welcome to the IPRIA Australian Developments in IP Bulletin for March 2008. The following items are also available on our website. The page can be viewed in full at http://www.ipria.org/developments_in_ip/domestic/index.html

If you are not able to access the links please copy and paste the address into your browser.

COPYRIGHT

Review of new format shifting exceptions

On 22 January 2008, the Attorney-General's Department released an Issues Paper on the copying of films and photographs into a different format for private use. Public submissions were invited on the operation of two new copyright exceptions that permit such 'format shifting': sections 47J and 110AA of the *Copyright Act 1968*. The exceptions were introduced by the *Copyright Amendment Act 2006*, which also requires a review of the operation of these provisions by 31 March 2008. Submissions were due by **29 February 2008**.

To access the Issues Paper, click here

[http://www.ag.gov.au/www/agd/rwpattach.nsf/VAP/\(756EDFD270AD704EF00C15CF396D6111\)~CLB+-+Review+of+sections+47J+and+110AA+of+the+Copyright+Act+-+2008.DOC/\\$file/CLB+-+Review+of+sections+47J+and+110AA+of+the+Copyright+Act+-+2008.DOC](http://www.ag.gov.au/www/agd/rwpattach.nsf/VAP/(756EDFD270AD704EF00C15CF396D6111)~CLB+-+Review+of+sections+47J+and+110AA+of+the+Copyright+Act+-+2008.DOC/$file/CLB+-+Review+of+sections+47J+and+110AA+of+the+Copyright+Act+-+2008.DOC)

Guidelines released for bodies seeking prescription as a key cultural institution

On **25 January 2008** guidelines were published on the Attorney-General's Department website to assist bodies seeking to be prescribed as 'key cultural institutions' under the *Copyright Act 1968*. The new provisions, introduced by the *Copyright Amendment Act 2006*, add to existing provisions which enable libraries and archives to make copies of materials in their collections for preservation and other purposes. Under sections 51B, 100BA and 112AA of the *Copyright Act 1968*, Australia's key cultural institutions can now make up to three copies of items of historical or cultural significance in their collection for preservation. Libraries and archives with a statutory function to develop and maintain a collection, such as the National Library of Australia, are already considered to be key cultural institutions.

To access the guidelines, click here

[http://www.ag.gov.au/www/agd/rwpattach.nsf/VAP/\(454DFAFE2D6830FB1D0597823A67B5D6\)~Guidelines+for+prescription+as+a+key+cultural+institution+under+the+Copyright+Act+~+Word+document.DOC/\\$file/Guidelines+for+prescription+as+a+key+cultural+institution+under+the+Copyright+Act+~+Word+document.DOC](http://www.ag.gov.au/www/agd/rwpattach.nsf/VAP/(454DFAFE2D6830FB1D0597823A67B5D6)~Guidelines+for+prescription+as+a+key+cultural+institution+under+the+Copyright+Act+~+Word+document.DOC/$file/Guidelines+for+prescription+as+a+key+cultural+institution+under+the+Copyright+Act+~+Word+document.DOC)

Review of the extension of legal deposit

On 3 December 2007, the Attorney-General's Department released its 'Discussion Paper on the Extension of Legal Deposit'. The current legal deposit scheme requires Australian publishers of 'library material' (paper-based publications) to deposit copies of such material with the National Library of Australia. The department called for

comments on the feasibility of extending the scheme to include audiovisual and electronic materials. Comments were due **11 January 2008**.

To access the Discussion Paper, click here

http://www.dbcde.gov.au/data/assets/pdf_file/0003/75486/Legal_Deposit_discussion_paper.pdf

Copyright infringement notice guidelines revised

The Attorney-General's Department, in consultation with the Australian Federal Police and the Commonwealth Director of Public Prosecutions, has been developing guidelines to assist law enforcement with the administration of the Copyright Infringement Notice Scheme. Introduced by amendments to the criminal offence provisions of the *Copyright Act 1968*, which came into force in January 2007, the scheme creates alternatives to prosecution in relation to strict liability copyright offences. These include the issuing of an infringement notice, and forfeiture of infringing copies and devices. In response to submissions received in October 2007, it was reported in **January 2008** that the draft guidelines have undergone further revision. It is anticipated that the guidelines will be finalised in the first half of 2008.

To access the draft guidelines, click here

[http://www.ag.gov.au/www/agd/rwpattach.nsf/VAP/\(756EDFD270AD704EF00C15CF396D6111\)~Draft+Copyright+Infringement+Notice+Scheme+Guidelines.doc/\\$file/Draft+Copyright+Infringement+Notice+Scheme+Guidelines.doc](http://www.ag.gov.au/www/agd/rwpattach.nsf/VAP/(756EDFD270AD704EF00C15CF396D6111)~Draft+Copyright+Infringement+Notice+Scheme+Guidelines.doc/$file/Draft+Copyright+Infringement+Notice+Scheme+Guidelines.doc)

TRADE MARKS AND OTHER INDICATIONS

Change of renewal period for trade marks

As of **28 March 2008**, in accordance with amendments to the legislation incorporated in the *Trade Marks Amendment Act 2006*, the period in which a trade mark can be renewed after it is due will reduce from 12 months to 6 months. This brings the grace period for renewals under the *Trade Marks Act 1995* in line with those allowed under the *Patents Act 1990* and the *Designs Act 2003*. Trade marks due for renewal on or before 27 March 2008 will still be able to be renewed for up to 12 months afterwards. There is no change to the 12 month period prior to the renewal due date.

To access the Official Notice, click here

<http://www.ipaustralia.gov.au/pdfs/news/Trade%20Marks%20Amendment%20Bill%202006%20-%20AOJTM%2029%20June%202006.pdf>

Position paper on incorporation of patent and trade marks attorneys released

On **16 January 2008**, IP Australia released a Position Paper in response to feedback received regarding its consultation paper 'Incorporation of Patent and Trade Marks Attorneys'. The consultation paper was released to the public on 17 October 2007 with comments due on 30 November 2007. The Position Paper provides an overview of the nine submissions received, which focussed largely on the issue of professional indemnity insurance. According to IP Australia, the submissions 'indicated that there was a uniform level of support to the proposal to legislate to allow for the incorporation of patent and trade marks attorneys.' IP Australia will now seek the Australian government's consideration of this proposal and its approval to amend the relevant legislation.

To access the Position Paper, click here

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

Stage one of IP Australia-IPONZ comparative trade mark examination project complete

On **9 November 2007**, it was reported that the first stage of a project exploring the potential for alignment of trade marks examination practices between IP Australia and the Intellectual Property Office of New Zealand (IPONZ) has been completed. Stage 1 of the project included a comparison of 200 applications examined during 2005, practice guidelines from each office, and the cross-class search lists of both countries. The findings resulted in the alignment of a number of practice differences and both offices have agreed to go ahead with Stage 2 of the project. The second stage, expected to be completed by April 2008, will include:

- a concurrent examination of 300 trade mark applications;
- completion of a paper considering common examination considerations of both offices; and
- the setting up of a permanent consultation process between the two offices for dealing with technical matters relating to trade marks examination.

For more information, click here

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

DOMAIN NAMES

auDA approves implementation plan for new .au registrant transfers policy

On 13 December 2007, the .au Domain Administration Ltd (auDA) board accepted the final report of the 2007 Names Policy Panel, which recommended a number of changes to the .au policy framework. One recommendation was that the Transfers (Change of Registrant) Policy be relaxed to allow a registrant to transfer their domain name licence to another eligible entity. On **26 February 2008**, the auDA Board approved an implementation plan for the new transfers policy, which will allow registrants to transfer their domain name after a period of 6 months. The implementation timetable has not yet been finalised but auDA anticipates that the new policy will be introduced in mid-2008.

For more information, click here

<http://www.auda.org.au/news-archive/auda-26022008/>

To access the Names Policy Panel report, click here

<http://www.auda.org.au/pdf/2007npp-final-report.pdf>

RESEARCH AND FUNDING

National seminar series on IP protection for businesses engaged in the export of goods and services launched

On 13 February 2008, the Minister for Innovation, Industry, Science and Research, Kim Carr, launched a national seminar series titled 'IP Passport – Helping Your Business Take Off Overseas'. The seminars, featuring speakers from IP Australia and IP lawyers, were a joint venture between IP Australia, the Australian Chamber of Commerce and Industry, and the State and Territory Chambers of Commerce and

Industry. The aim was to encourage small and medium sized Australian businesses to consider IP protection before exporting their goods and services overseas. Seminars ran from **18 February to 29 February 2008**.

For more information, click here

<http://minister.industry.gov.au/SenatortheHonKimCarr/Pages/PROTECTINGAUSSIEINNOVATIONSOVERSEAS.aspx>

Minister announces review of national innovation system

On 22 January 2008, the Minister for Innovation, Industry, Science and Research, Kim Carr, announced a review of the national innovation system. The review will examine the effectiveness of existing government support for innovation by looking at a number of innovation and industry assistance programs, and is to be conducted by an expert panel. The panel will consult nationally and provide a 'Green Paper' to the government detailing policy options by 31 July 2009. The Green Paper will be released for public comment and followed by a 'White Paper' response from the government. A series of stakeholder meetings has been scheduled for March 2008. Submissions are currently being accepted until **30 April 2008**.

For more information, click here

<http://www.innovation.gov.au/innovationreview/Pages/home.aspx>

GENERAL IP

ALRC releases report on client legal privilege in federal investigations

On **13 February 2008**, the Australian Law Reform Commission (ALRC) released Report 107, 'Privilege in Perspective: Client Legal Privilege in Federal Investigations'. The report is the culmination of a year-long public inquiry into the area. Included were references to patent attorney privilege as it is a privilege related to client legal privilege. The ALRC identified over 40 federal investigatory bodies with coercive information-gathering powers, as well as Royal Commissions, and highlighted the need for clarification of the application of privilege in light of the various pieces of legislation that address these powers. The key recommendations in the report include:

- the enactment of a statute of general application to cover aspects of the law and procedure governing client legal privilege claims in federal investigations;
- the setting out of procedures with respect to the making and resolution of privilege claims; and
- the extension of privilege, in defined circumstances, to include tax advice.

No specific recommendation was made about patent attorney privilege.

To access the ALRC Report, click here

<http://www.austlii.edu.au/au/other/alrc/publications/reports/107/>

Developments regarding Australia's Free Trade Agreements (FTAs)

Twelfth Round of ASEAN-Australia-New Zealand FTA negotiations

The twelfth round of the Association of Southeast Asian Nations (ASEAN)-Australia-New-Zealand FTA negotiations took place in Siem Reap, Cambodia, from **10 to 14**

December 2007. The Experts Group on IP met for the first time and made progress towards achieving agreement on a framework for taking IP issues forward. A consolidated draft text on IP was developed with a number of articles agreed in principle, including substantive articles on national treatment and government use of software.

For more information, click here

http://www.dfat.gov.au/trade/fta/asean/subscriber_updates/0801_update.html

Second round of Australia-Gulf Cooperation Council FTA negotiations

The second round of negotiations between Australia and the Gulf Cooperation Council (GCC) on an FTA took place in Riyadh from **20-22 November 2007**. The discussions included sessions on IP during which Australia and the GCC provided information about their respective IP systems.

For more information, click here

http://www.dfat.gov.au/trade/fta/gcc/Update_3.html

Third round of Australia-Japan FTA negotiations

The third round of FTA negotiations between Australia and Japan took place in Canberra from **5 to 8 November 2007**. Discussions on IP focussed on a detailed examination of Japan's draft text, and produced a better understanding of each side's regulatory regime. Additional information has been exchanged ahead of further detailed consideration of the draft text at the next round.

For more information, click here

http://www.dfat.gov.au/geo/japan/fta/newsletter_update/update_3.html

Second round of Australia-Chile FTA negotiations

The second round of FTA negotiations between Australia and Chile took place in Santiago from **8 to 12 October 2007**. IP was identified as a key area of divergence between the two sides and discussions have continued intersessionally with exchanges of information. Negotiations on IP will take place at the next round.

For more information, click here

<http://www.dfat.gov.au/geo/chile/fta/update2.html>