

IPRIA Australian Developments in IP Update March 2009

Editor: Fiona Rotstein - Research Fellow, IPRIA and Lecturer, Melbourne Law School, University of Melbourne

Welcome to the IPRIA Australian Developments in IP Bulletin for March 2009. All IPRIA Bulletins are available to download on our website at <http://www.ipria.org/>

COPYRIGHT

Submissions Sought Regarding Resale Royalty Right for Visual Artists Bill 2008

On 27 November 2008, following the Minister's second reading speech, the House of Representatives resolved to refer the above Bill to the House of Representatives Climate Change, Water, Environment and the Arts Committee for consideration and an advisory report by 20 February 2009. Committee Chair Jennie George said that 'The Committee's task will be to encourage the public scrutiny of the Bill prior to the resumption of the Second Reading Debate in the House'. The Committee accepted submissions until **23 January 2009**.

For more information, click here

<http://www.aph.gov.au/house/committee/ccwea/resaleroyalty/media/media01.pdf>

PATENTS

Korean IP Office to Conduct International Search and Examination of PCT Applications

IP Australia recently announced that the Korean Intellectual Property Office (KIPO) has officially become an International Searching Authority and International Preliminary Examining Authority for Australian applicants filing under the Patent Cooperation Treaty (PCT). From **1 March 2009**, under an arrangement between IP Australia and KIPO, Australian applicants can choose to nominate KIPO or IP Australia to conduct international search and examination of their PCT applications.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new.shtml#12

Australia Joins the Patent Law Treaty

On **22 December 2008**, IP Australia announced that Australia's Ambassador and Permanent Representative to the WTO, Mr Bruce Gosper, deposited Australia's Accession to the Patent Law Treaty (PLT) with Dr Francis Gurry, Director General of WIPO. The aim of the PLT is 'to harmonise and streamline formal procedures in respect of national and regional patent applications and patents, and thus to make such procedures more user-friendly'. Among other issues, the Treaty contains provisions on the following:

- standardised requirements for obtaining a filing date in order for applicants to minimise the loss of the filing date;
- procedures for the avoidance of unintentional loss of substantive rights as a result of the failure to comply with formality requirements or time limit; and

- the establishment of standardised Model International Forms, which will have to be accepted by the Offices of all Contracting Parties.

For more information, click [here](#)

http://www.wipo.int/treaties/en/ip/plt/summary_plt.html

‘Do Patents Matter for Commercialisation?’ Public Seminars

IPRIA and the Institute of Patent and Trade Mark Attorneys of Australia (IPTA) will be holding free lunch-time seminars on the topic ‘Do Patents Matter for Commercialisation?’ Presented by Dr Paul Jensen, Senior Research Fellow, IPRIA, the seminars will be held in Perth, Adelaide and Sydney in the last two weeks of **May 2009**.

For more information, click [here](#)

‘Should Genes be Patented?’ Public Forum and Panel Discussion

IPRIA and the Melbourne Business School Centre for Ideas and the Economy will be holding a public discussion on the topic ‘Should Genes be Patented?’ The purpose of the event is to provide a forum for leading academics, government officials, business leaders and scientists from around Australia to discuss the issue of genetic patenting. The forum is free of charge and will take place at the Melbourne Business School on **24 April 2009**.

For more information, click [here](#)

TRADE MARKS AND OTHER INDICATIONS

Singapore Treaty on the Law of Trademarks Comes into Force

On 22 December 2008, IP Australia announced that Australia has joined the Singapore Treaty on the Law of Trademarks. Australia was the tenth State to ratify the Singapore Treaty, which allowed the Treaty to come into force on **16 March 2009**. Building on the Trademark Law Treaty of 1994 (TLT 1994), to which Australia is a Contracting Party, the new Treaty has a wider scope of application and addresses new developments in the field of communication technology. As compared with the TLT 1994, the Singapore Treaty:

- is applicable to all types of marks registrable under the law of a given Contracting Party;
- introduces relief measures in respect of time limits as well as provisions on the recording of trademark licenses; and
- establishes an Assembly of the Contracting Parties.

Other provisions of the Singapore Treaty (such as the requirements to provide for multi-class applications and registrations, and the use of the International (‘Nice’) Classification), closely follow the TLT 1994. The two treaties are separate, and may be ratified or adhered to independently.

For more information, click [here](#)

http://www.ipaustralia.gov.au/resources/news_new_archived_2008.shtml#61

Trade Mark Counterfeit - Review of Penalties and Additional Damages

IP Australia has recently completed a review of the penalty provisions in the Trade Marks Act 1995. This review was in response to a recommendation by the Advisory Council on Intellectual Property in the Review of Trade Mark Enforcement (2004) and to the changes made in 2007 to the penalties in the Copyright Act 1968. The review also considered additional damages in civil actions for trade marks. IP Australia released a paper to elicit comments on options which IP Australia is considering recommending to the Government. The options paper sought views on various issues, including:

- Are the criminal penalties under the Trade Marks Act 1995 sufficient to deter and punish trade mark counterfeiting?
- Are the current penalties consistent with the level of penalties applied for crimes of a corresponding gravity?
- Should provisions for additional damages be introduced in the Trade Marks Act 1995?

Written comments regarding the options paper were sought by **27 February 2009**.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new_archived_2008.shtml#58

Changes to Trade Mark Certificates of Registration

On **22 January 2009**, IP Australia announced that it has implemented changes to the format of the trade mark certificates of registration. The purpose of the changes is 'to improve the quality' of the product and provide a certificate that contains a coloured representation of the mark. Endorsements will be provided where appropriate.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new.shtml#5

PATENT AND TRADE MARK ATTORNEYS

'IP Professionals and Ethics' Public Seminars

IPRIA and IPTA will be holding free lunch-time seminars on the topic 'IP Professionals and Ethics'. The seminars will be presented by Dr Linda Haller, Melbourne Law School, The University of Melbourne and Dr Trevor Davies, Councillor and Fellow, IPTA and Partner, Allens Arthur Robinson Patent and Trade Marks Attorneys. The seminar was held on **9 March 2009** in Brisbane and will be held on **18 March 2009** (Melbourne) and **19 March 2009** (Sydney).

For more information, click [here](#)

GENERAL IP

Australian Exporters Eligible to Claim IP Expenses Under Austrade Program

From **1 July 2009**, Australian exporters may be able to partially recover the cost of IP protection under a recent amendment to the Export Market Development Grants (EMDG) scheme. Applicants may apply to recover the cost of granting, registering or extending rights under foreign laws in relation to eligible intellectual property, as well

as the cost of obtaining insurance to protect these rights. The EMDG scheme, administered by Austrade, is an Australian Government financial assistance program for Australian exporters who promote Australian made products overseas. Up to 50% of eligible export promotion expenses above \$10,000 may be reimbursed under the scheme.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new.shtml#2

‘Ambush Marketing Legislation Review’ Final Report Released

On **6 February 2009**, the final report of the ‘Ambush Marketing Legislation Review’ was released. IP Australia and the Department of Communications, Information Technology and the Arts commenced a review of the effectiveness and impact of:

- Chapter 3 of the Olympic Insignia Protection Act 1987 (Cth) (the ‘OIP Act’); and
- the Melbourne 2006 Commonwealth Games (Indicia and Images) Protection Act 2005 (Cth) (the ‘M2006 Act’) (together ‘the AML’).

The Review was conducted between March and May 2007 by Frontier Economics and IPRIA. The overall opinion expressed in the Review is that on the whole, both Chapter 3 of the OIP Act and the M2006 Act have been effective in achieving their stated aims. The Review is also of the opinion that, on balance, the impact of the AML has been generally positive. However, there are some qualifications to these overall findings, including in relation to:

- whether apparent reductions in ambush marketing are due to factors outside the AML;
- whether national sporting organisations and other peak bodies have been unduly hampered in their ability to attract their own sponsorships; and
- whether sufficient income generated from the rights granted under the AML has been returned to sport.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new.shtml#8

Ambush Marketing Public Seminars

IPRIA and IPTA will be holding free lunch-time seminars on ambush marketing. The seminars will be presented by Dr Owen Morgan, Senior Lecturer, The University of Auckland Business School and Ms Emily Hudson, PhD Candidate, Melbourne Law School, The University of Melbourne. The seminars will take place on **22 June 2009** (Sydney), **23 June 2009** (Brisbane), and **25 June 2009** (Melbourne).

For more information, click [here](#)

Intellectual Property Amendment Regulations Come Into Force

The Intellectual Property Amendment Regulations 2008 (No. 1) were signed by the Governor-General on 12 December 2008 and came into force on **1 January 2009**. The main purpose of the Amendment Regulations is to amend the Patents Regulations 1991. The amendments include:

- reducing the circumstances where applicants have to routinely file copies of documents with IP Australia that might not be required in the patent examination process;

- standardising the various prescribed time periods that apply following the Commissioner issuing a request to the applicant to file copies of various patent documents - the time period is now three months from the date of the request; and
- enabling the exchange of patent documents with foreign patent offices irrespective of the document's publication status, but this exchange will occur only at the request of the applicant or otherwise with the consent of the applicant.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new_archived_2008.shtml#60

IP Australia to Continue its Role Until End of 2017

On **22 December 2008**, it was announced that Australia's Ambassador and Permanent Representative to the WTO, Mr Bruce Gosper, signed a new agreement to enable IP Australia to continue its role as an International Searching Authority and International Preliminary Examining Authority until the end of 2017. IP Australia has held this role since 1980.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new_archived_2008.shtml#61

Developments Regarding Australia's Free Trade Agreements (FTAs)

Australia-Chile FTA Comes into Force

On **6 March 2009**, the Australia-Chile FTA came into force. Chapter 17 of the FTA on IP reinforces, and in some circumstances builds on, the parties' existing rights and obligations under the WTO Agreement on Trade Related Aspects of Intellectual Property Rights. Chile has agreed to ratify or take reasonable steps to ratify a number of international IP agreements to which Australia is already a signatory, such as the International Convention for the Protection of New Plant Varieties 1961 (last revised 1991) and the Patent Cooperation Treaty (1970). Australia and Chile have also agreed to treat each other's citizens no worse than they treat their own citizens in respect of all intellectual property rights covered by the chapter ('national treatment'). Finally, the chapter contains a number of specific obligations on protection of trade marks, patents, copyright and geographical indications as well as detailed enforcement provisions.

For more information, click here

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

Australia and Korea to launch FTA negotiations

On **5 March 2009**, Australia and Korea agreed to launch bilateral FTA negotiations. The announcement follows the conclusion of preparatory talks between the parties in Seoul from 13 to 15 October 2008, and a feasibility study released in April 2008 on the merits of an Australia-Korea FTA. The Department of Foreign Affairs and Trade welcomes public submissions on the expected economic, regional, social, cultural, regulatory and environmental impacts of an FTA with Korea. Submissions may build on or refer to submissions made during the joint non-government feasibility study on a bilateral FTA.

For more information, click here

<http://www.dfat.gov.au/geo/rok/fta/index.html>

Australia Signs ASEAN-Australia-New Zealand FTA

On **27 February 2009**, Australia signed the Association of South East Asian Nations (ASEAN)-Australia-New Zealand Free Trade Agreement (AANZFTA). Chapter 13 of the AANZFTA on IP contains a number of specific obligations on protection of IP rights, government use of software and transparency. This includes an obligation on parties to endeavour to make available on internet databases all pending and registered trade mark rights in their respective jurisdictions. The chapter contains detailed provisions for cooperation between the parties to assist in the implementation of the IP provisions. These include:

- the exchange of information on infringement of IP rights;
- the promotion of efficiency and transparency in IP administration and registration systems; and
- the establishment of a Committee on Intellectual Property to monitor the implementation of the FTA's IP provisions.

It is expected that AANZFTA will enter into force in the second half of 2009 and, in any event, no later than 1 January 2010.

For more information, click here

<http://www.dfat.gov.au/trade/fta/asean/aanzfta/index.html>

Progress Towards a FTA with Indonesia

On **19 February 2009**, the Minister for Trade, Simon Crean, and Indonesia's Minister for Trade, Dr Mari E Pangestu, met in Sydney for talks aimed at strengthening the countries' trade and investment relationship. The Ministers welcomed the final draft of the Joint Feasibility Study on an Indonesia-Australia FTA. The study found that a comprehensive FTA would build on the foundation of the ASEAN-Australia New Zealand FTA and provide worthwhile gains for both countries.

For more information, click here

http://www.trademinister.gov.au/releases/2009/sc_013.html

Thirteenth Round of Australia-China FTA Negotiations

The thirteenth round of negotiations on the Australia-China FTA was held in Beijing from **1 to 5 December 2008**. The parties had 'two useful days discussion' on the combined draft text of the chapter on IP. There remain areas where there is substantial distance between the positions of the two sides, but the chapter is said to be 'taking shape'. The two sides have agreed in principle to hold the next round of negotiations in the first quarter of 2009.

For more information, click here

http://www.dfat.gov.au/geo/china/fta/081217_subscriber_update.html