

# IPRIA Australian Developments in IP

Update August 2007

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*If a link cannot be accessed, please copy and paste the address into your browser.*

## PATENTS

### **Amendments to be made to Patents Act 1990 in response to ACIP Report ‘Patents and Experimental Use’**

On **6 August 2007**, the Government announced amendments will be made to the Patents Act 1990 in response to the Advisory Council on Intellectual Property (ACIP) Report ‘Patents and Experimental Use’ published October 2005. The Government has accepted in principle ACIP’s recommendation that Australian patent law be changed to allow for a European-type provision which exempts from infringement “acts done for experimental purposes relating to the subject matter of the invention”. Such acts include: “determining how the invention works; determining the scope of the invention; determining the validity of the claims; seeking an improvement to the invention”. Also accepted was ACIP’s recommendation that the Government “consider reviewing the impact on Australian industry of the absence of an exception from infringement for activities undertaken prior to the end of the initial patent term relating to obtaining regulatory approval”. This practice is often referred to as ‘springboarding’. At present, Australia has a limited springboarding provision for pharmaceuticals.

To view the Government’s response to the ACIP Report, click here  
<http://www.ipaustralia.gov.au/pdfs/news/20070708.pdf>

### **Consultation Paper released on the patent search result disclosure regime**

On **16 May 2007**, IP Australia released a Consultation Paper proposing amendments to the search result disclosure regime set out in regulations made under subsection 45(3) and section 101D of the Patents Act 1990. Developments in the availability of foreign patent office search and examination results over the Internet have lead IP Australia to consider whether further simplifications to the search result disclosure regime are now possible. The Consultation Paper sought views on whether it is appropriate to remove the obligation for applicants and patentees to inform the patent office of the results of documentary searches. Comments were due by 13 June 2007.

To access the Consultation Paper, click here  
[http://www.ipaustralia.gov.au/pdfs/news/Consultation%20Paper%20-%20s%2045\(3\)%20changes.pdf](http://www.ipaustralia.gov.au/pdfs/news/Consultation%20Paper%20-%20s%2045(3)%20changes.pdf)

## COPYRIGHT

### **WIPO Copyright Treaty and WIPO Performances and Phonograms Treaty come into force**

The WIPO Copyright Treaty and WIPO Performances and Phonograms Treaty came into force in Australia on **26 July 2007**. Due to changes made to Australian copyright law by the Digital Agenda Amendment Act 2004 and the US Free Trade Agreement Implementation Act 2004, Australia has already fulfilled most of its obligations under the treaties. However, the operation of amendments to Part IX of the Copyright Act 1968 relating to moral rights of performers in the US Free Trade Agreement Implementation Act 2004 was reliant on the WIPO Performances and Phonograms Treaty coming into operation. The amendments give new moral rights to individual performers in relation to live performances and live performances fixed in sound

recordings where the performance or recording was made after the commencement of the amendments. The moral rights include the right of attribution of performership, the right not to have performership falsely attributed, and the right of integrity of performership.

For more information, click here (see Note 2)

[http://www.austlii.edu.au/au/legis/cth/consol\\_act/ca1968133/notes.html](http://www.austlii.edu.au/au/legis/cth/consol_act/ca1968133/notes.html)

## DESIGNS

### **Designs Examiners' Manual - updates available**

The Australian Designs Office Manual of Practice and Procedure (Designs Act 2003) is under construction. On **31 July 2007**, IP Australia announced that material is presently available on formalities in Part 1, and further content has been added to Part 2 (Examination) including searching, examination and some other practices. Further information is under development and will be published when available.

For more information, click here

[http://www.ipaustralia.gov.au/resources/manuals\\_designs.shtml](http://www.ipaustralia.gov.au/resources/manuals_designs.shtml)

## TRADE MARKS AND OTHER INDICATIONS

### **Amended legislation and examination practice in relation to divisional trade mark applications**

New provisions for divisional trade mark applications came into effect on 27 March 2007. According to an IP Australia Official Notice dated **26 July 2007**, the intent of the amended legislation was for the goods/services of the divisional application to be clearly divided from those of the parent application and to avoid duplication. A number of divisional applications filed on or after 27 March 2007 have been invalid. To avoid submitting an invalid divisional application, applicants must:

- specify the goods and/or services to remain in the parent [section 46(1)(c) Trade Marks Act 1995] on the divisional application at the time of filing; and
- ensure that there is no overlap between the goods and/or services of the parent and the divisional applications.

To view the IP Australia Official Notice, click here

<http://www.ipaustralia.gov.au/pdfs/news/TMDivisionals20070726.pdf>

### **Trade Marks Office Manual of Practice and Procedure - revision of Parts 22 and 28**

On **9 July 2007**, IP Australia announced that Parts 22 and 28 of the Trade Marks Office Manual of Practice and Procedure have been amended. The amendments reflect revised office practice in relation to the application of section 41 (capable of distinguishing) and the provisions relating to honest concurrent use, prior use or other circumstances.

To view the IP Australia Official Notice, click here

<http://www.ipaustralia.gov.au/pdfs/news/MDB-OLS%20Manual%20parts%2022%20and%2028%20ON.pdf>

## DOMAIN NAMES

### **auDA's 2007 Names Policy Panel releases Issues Paper for public comment**

The 2007 Names Policy Panel of the .au Domain Administration Ltd (auDA) is currently reviewing the policy framework for .au domain names, including:

- whether .au should be opened up to direct registrations (eg. domainname.au);
- whether the policy rules for domain names should be changed; and

- whether registrants should be allowed to sell their .au domain names.

On **18 May 2007**, the Panel released an Issues Paper that sets out the current situation and invited comment on suggestions and options for change. The closing date for submissions was 15 June 2007.

For more information, click here

<http://www.auda.org.au/news-archive/auda-18052007/>

## **RESEARCH AND FUNDING**

### **\$80 million to be granted under Federal Government's Innovation Investment Fund**

On **21 June 2007**, Australian Industry Minister Ian Macfarlane announced that \$80 million is to be put towards Australian innovation under the Federal Government's Innovation Investment Fund (IIF3). The investment will be made through four \$20 million funds provided to new venture capital managers to invest in innovations ranging from clean energy to communications technology. IIF3 is a \$200 million program to promote the commercialisation of Australian R&D through the development of new fund managers in early stage investing. A further six fund managers will be licensed over the next four years. Each will be provided with \$20 million of Australian Government funding. This will be matched by a minimum dollar-for-dollar investment by the private sector. According to Mr Macfarlane, the passage of the Early Stage Venture Capital Limited Partnerships legislation in June 2007 will further stimulate the venture capital industry by exempting domestic and foreign investors in early stage venture capital limited partnerships from income and capital gains tax.

For more information, click here

<http://www.minister.industry.gov.au/index.cfm?event=object.showContent&objectID=4B97DCBE-0162-77AD-155FAE1315796E9B>

## **PARLIAMENTARY COMMITTEES**

### **SENATE STANDING COMMITTEE ON ENVIRONMENT, COMMUNICATIONS, INFORMATION TECHNOLOGY AND THE ARTS**

#### **Inquiry into the provisions of the Communications Legislation Amendment (Information Sharing and Datacasting) Bill 2007**

The Senate referred the Communications Legislation Amendment (Information Sharing and Datacasting) Bill 2007 to the Senate Standing Committee on Environment, Communications, Information Technology and the Arts for inquiry and report by **30 July 2007**. The Bill would amend the Australian Communications and Media Authority Act 2005 to authorise the disclosure of certain information by the Australian Communications and Media Authority to the Minister for Communications, Information Technology and the Arts, Departments, government agencies and regulatory bodies. The Bill also contains measures concerning the allocation of datacasting transmitter licences, including in relation to channel A and channel B datacasting transmitter licences. The Standing Committee sought written submissions from interested individuals and organisations regarding the Bill. Submissions were due by 13 July 2007.

For more information regarding the inquiry, click here

[http://www.aph.gov.au/senate/committee/ecita\\_ctte/info\\_sharing07/index.htm](http://www.aph.gov.au/senate/committee/ecita_ctte/info_sharing07/index.htm)

## **GENERAL IP**

### **Australian Government to target cyber-crime**

On **19 July 2007**, Attorney-General Philip Ruddock announced that the Australian Government has allocated \$73.6 million in this year's Budget for a range of e-security initiatives under the E-Security National Agenda. According to Mr Ruddock: "With more government services online and more money being transacted over the Internet, we are seeing an increasing trend towards the professionalisation of cyber-crime." The initiatives proposed include increased resources to help the Australian Federal Police combat cyber-crime and strengthening government systems to increase the security of information provided by the Australian public. Agencies involved in the E-Security National Agenda include the Attorney-General's Department, Defence Signals Directorate, the Australian Federal Police, the Department of Communications, Information Technology and the Arts, and the Department of Finance and Administration's Australian Government Information Management Office.

For more information, click here

[http://www.ag.gov.au/agd/WWW/MinisterRuddockHome.nsf/Page/Media\\_Releases\\_2007\\_Third\\_Quarter\\_1\\_502007 - 19 July 2007 - Australian Government to target cyber-crime](http://www.ag.gov.au/agd/WWW/MinisterRuddockHome.nsf/Page/Media_Releases_2007_Third_Quarter_1_502007_-_19_July_2007_-_Australian_Government_to_target_cyber-crime)

### **Discussion of IP issues at ninth round of negotiations for Australia-China FTA**

The ninth round of the Australia-China Free Trade Agreement (FTA) negotiations was held from **18 to 22 June 2007** in Beijing. The draft text of the proposed FTA was discussed. Regarding IP, Australia tabled additional draft text covering two issues that have been raised by Australian industry: the establishment of a possible bilateral consultative mechanism on IP issues and the protection of confidential information provided by enterprises when applying for tenders or regulatory approval. China used a significant part of the meeting to reiterate its strong concerns regarding the scope and content of Australia's draft IP chapter. While there are signs of convergence on a few of the draft provisions, the IP negotiations remain characterised by two strongly divergent competing visions for what constitutes an appropriate IP chapter. The tenth negotiating round is tentatively scheduled for late October 2007 in Canberra.

For more information, click here

[http://www.dfat.gov.au/geo/china/fta/070629\\_subscriber\\_update.html](http://www.dfat.gov.au/geo/china/fta/070629_subscriber_update.html)

### **IP enforcement budget increase**

On **12 June 2007**, Parliamentary Secretary to the Minister for Industry, Tourism and Resources Bob Baldwin announced that the Australian Government would fund more than \$12.4 million over the next two years to enable the Australian Federal Police and the Commonwealth Director of Public Prosecutions to more effectively target trade mark and copyright crime.

For more information, click here

<http://www.ipaustralia.gov.au/pdfs/news/CMR07-318.pdf>

### **ALRC inquiry into client legal privilege**

In November 2006, the Attorney-General of Australia asked the ALRC to inquire into the application of legal professional privilege to the coercive information-gathering powers of Commonwealth bodies—such as the Australian Federal Police, the Australian Crime Commission, the Australian Securities and Investments Commission and federal Royal Commissions. The ALRC has since released an Issues Paper – *Client Legal Privilege and Federal Investigatory Bodies* (Issues Paper 33). The closing date for submissions to Issues Paper 33 was **4 June 2007**. A more detailed Discussion Paper, which will contain preliminary proposals for reform is planned for release in late August/early September 2007. The final report to the Attorney-General, containing recommendations for reform, is due on 3 December 2007 and will be publicly available after its tabling in federal parliament.

For more information, click here

<http://www.alrc.gov.au/inquiries/current/privilege/index2.htm>

**Public consultation: patent, trade marks & WIPO treaties**

On **22 May 2007**, IP Australia announced it was seeking comments on whether Australia should ratify the Singapore Treaty on the Law of Trademarks (Singapore Treaty), accede to the Patent Law Treaty (PLT) and formally accept amendments designed to streamline the administrative provisions of several other World Intellectual Property Organization (WIPO) treaties. The Singapore Treaty and the PLT harmonise many formality and procedural requirements relating to the administration of patents and trade marks. As a result of a process of constitutional reform, the WIPO General Assemblies in 2003 agreed to amend the administrative provisions of a number of other treaties, including seven to which Australia is a party. The amendments introduce no substantive changes to Australia's current obligations under these treaties. The amendments include the abolition of the WIPO Conference and a change in the frequency of the ordinary sessions of the WIPO General Assembly and the other Assemblies of the Unions administered by WIPO from every two years to once a year. Comments were due to IP Australia by 30 June 2007.

For more information, click here

[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#36](http://www.ipaustralia.gov.au/resources/news_new.shtml#36)