

## **IPRIA Australian Developments in IP Update September 2008**

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### **COPYRIGHT**

#### **Productivity Commission to review copyright restrictions on parallel importation of books**

The Council of Australian Governments announced on 3 July 2008 that the Productivity Commission will undertake a review of restrictions on parallel importation of books. 'Parallel importation' refers to importation of works which have been legitimately manufactured or purchased overseas. Parallel importation of books generally requires the permission of the Australian copyright owner, unless: the book was first published overseas and has not been published in Australia within 30 days of its first publication overseas, or the Australian copyright owner cannot fulfil a local order within 90 days.

For more information, click here

<http://www.pc.gov.au/projects/study/books>

#### **Review of new format shifting exceptions tabled**

The Attorney-General's Department has now completed its 'Review of Copyright Exceptions for Private Copying of Photographs and Films'. The review relates to the operation of two new copyright exceptions that permit photographs and films to be copied in a different format for private use, subject to certain conditions: sections 47J and 110AA of the *Copyright Act 1968*. These exceptions have been in force since December 2006. The report of the review was tabled in Parliament on **18 June 2008**.

To access the report, click here

<http://www.ag.gov.au/copyrightexceptions>

### **PATENTS**

#### **Advisory Council on Intellectual Property (ACIP) calls for submissions on patentable subject matter Issues Paper**

ACIP has released an Issues Paper on its review of patentable subject matter, which focuses on the 'manner of manufacture' test, and the historical requirement that an invention must not be 'generally inconvenient'. Matters covered by the Paper include:

- the evolution of Australian law on patentable subject matter from the 1959 High Court decision *National Research Development Corporation v Commissioner of Patents* to today;
- Australia's international obligations regarding patentable subject matter; and
- identification of the main issues for further discussion.

Submissions may be made to the Council up until **19 September 2008**.

For more information and to access the Issues Paper, click here  
<http://www.acip.gov.au/reviews.html##subject>

### **IP Australia and the Korean Intellectual Property Office (KIPO) agree to establish mutual search and examination authorities**

IP Australia has agreed to designate KIPO as an International Search Authority (ISA) and International Preliminary Examination Authority for applications under the Patent Cooperation Treaty (PCT). IP Australia is currently the only ISA Australian applicants can use for international search and examination of their PCT patent applications. The arrangement was announced on **1 September 2008**, and is likely to come into effect in early 2009.

For more information, click here  
[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#44](http://www.ipaustralia.gov.au/resources/news_new.shtml#44)

### **IP Australia recognised as International Search and Examination Authority by United States Patent and Trademark Office (USPTO)**

On **25 July 2008**, IP Australia announced that it will be designated as an international search and examination authority for PCT applications filed with the USPTO. This arrangement follows the conclusion of a pilot program between IP Australia and the USPTO involving search and examination of PCT applications covering a range of technology areas. IP Australia is already an international search and examination authority for 17 countries including the Republic of Korea, New Zealand, Singapore, India and Malaysia.

For more information, click here  
[http://www.ipaustralia.gov.au/pdfs/news/USPTO\\_IPA\\_Pressrelease.pdf](http://www.ipaustralia.gov.au/pdfs/news/USPTO_IPA_Pressrelease.pdf)

## **PATENT AND TRADE MARK ATTORNEYS**

### **Changes to the patent and trade mark attorney regulatory and discipline regimes**

Amendments have been made to the *Patents Regulations 1991* and the *Trade Marks Regulations 1995* changing the requirements for professional registration and the disciplinary regime under which patent and trade marks attorneys practice. In summary, the changes include:

- compulsory continuing professional development;
- skills-based pre-registration employment requirements for patent attorneys;
- a condition that prospective patent attorneys be qualified in a field of science or technology that contains potentially patentable subject matter;
- simplification of the disciplinary regime; and
- key definitions of misconduct amended to bring them into line with definitions used by the broader legal profession.

The amendments came into force on **1 July 2008**.

For more information, click here  
<http://www.ipaustralia.gov.au/pdfs/news/2008-06-20,%20Online%20official%20notice,%20Patents%20and%20Trade%20Marks%20Attorney%20registration.pdf>

## **PLANT BREEDER'S RIGHTS (PBR)**

### **ACIP publishes Options Paper on review of enforcement of PBR**

ACIP has published an Options Paper as part of its review of the enforcement of PBR in Australia. Matters covered in the Paper include:

- issues that may impact on substantive PBR laws, such as exclusive/extended rights, exhaustion of PBR, and pre-grant enforcement;
- procedural options to assist enforcement of PBR, such as the extension of the jurisdiction of the Federal Magistrates Court to cover PBR matters and the availability of civil and criminal sanctions; and
- remedies to assist enforcement of PBR, such as improved evidence collection mechanisms and inspection orders, exemplary damages, and border protection.

Comments on the options paper were due by **18 July 2008**.

For more information and to access the Options Paper, click here  
<http://www.acip.gov.au/reviews.html#pbr>

### **Release of 'Assessment Framework for Requests to Extend the Duration of PBR Protection'**

In **July 2008** the Government released an 'Assessment Framework for Requests to Extend the Duration of PBR Protection' regarding the assessment of applications for extension of the duration of PBR protection for a plant taxon beyond the statutory period of 20 or 25 years (depending on the plant variety). The Framework provides that an application for extension of PBR protection should, among other matters, include:

- the length of the requested extension and reasons why this length is sought;
- whether the application is permanent or only for a defined period; and
- the taxon in respect of which the extension is sought and reasons why that taxon is chosen.

To access the framework, click here  
[http://www.ipaustralia.gov.au/pdfs/plantbreed/PBR\\_extension\\_framework.pdf](http://www.ipaustralia.gov.au/pdfs/plantbreed/PBR_extension_framework.pdf)

## **DOMAIN NAMES**

### **Review of competition model for the Australian domain name industry**

The Australian Domain Name Administrator's competition model for the Australian domain name industry is currently under review. An Issues Paper was released in June 2008 setting out the current situation and canvassing the issues and possible options for change, with a focus on:

- the method of registry operator selection/appointment post-2010;
- the policy and process for registrar accreditation;
- the status and regulation of resellers; and
- the policy and process for transfers between registrars/resellers.

Submissions closed on **1 August 2008**, and draft recommendations will be made available for further public comment before the release of a final report.

For more information and to access the Issues Paper, click here  
<http://www.auda.org.au/news-archive/auda-30062008/>

## **RESEARCH AND FUNDING**

### **Review of Australia's Cooperative Research Centres (CRC) program released**

A review of Australia's CRC program was released on 5 August 2008. CRCs are cooperative endeavours between research organisations (such as universities) and research users from industry sectors to undertake long-term research and related postgraduate training. The CRC program was established in 1990 and 168 CRCs have since been established. The review makes recommendations in relation to matters such as funding and frequency of selection rounds, objectives of the program, and broadening of participation. The review was due to report to the Government by **29 August 2008**.

For more information, click here

<http://minister.industry.gov.au/Carr/Pages/GOVERNMENTWELCOMESRELEASEOFRCREVIEW.aspx>

### **Opening of national Innovative Regions Centre**

On **21 August 2008** the Government announced the opening of a national Innovative Regions Centre, based in Geelong, Victoria, which will provide advice and services to help regionally based small and medium-sized enterprises (SMEs) 'become more innovative, efficient and competitive'. Services provided by the Centre include:

- the provision of grants to address areas of a business that are identified for improvement/growth;
- facilitation of access to other companies that may be able to offer mentoring, private investment and business partnerships; and
- assistance with accessing government programs, including export development grants and market intelligence from Austrade.

For more information, click here

<http://minister.industry.gov.au/Carr/Pages/NATIONALINNOVATIVEREGIONSCENTREUPANDRUNNING.aspx>

### **Report of national research commercialisation survey and associated case studies published**

In **June 2008** the Government released a National Survey of Research Commercialisation (NSRC), which contains information on commercialisation activity in Australian publicly funded research institutions, universities, and medical research institutes for the years 2000 to 2002. Case studies of IP commercialisation by survey respondents have also been published as a companion volume to the NSRC, to reflect the range of commercialisation activities undertaken by publicly funded Australian research institutions.

To access the survey and case studies, click here

[http://www.dest.gov.au/sectors/research\\_sector/publications\\_resources/profiles/National\\_Survey\\_of\\_Research\\_Commercialisation.htm](http://www.dest.gov.au/sectors/research_sector/publications_resources/profiles/National_Survey_of_Research_Commercialisation.htm)

## GENERAL IP

### **Release of Intellectual Property Scorecard 2002-2006**

The 2002-2006 edition of the Government's IP Scorecard was released on **9 July 2008**, and reveals 'steady growth' in Australian innovation, but relatively low levels of business investment in R&D. According to the latest data, medical engineering is now one of the top five technology patenting areas in Australia, and the handling and printing technology areas have overtaken civil engineering, building and mining which have traditionally been Australia's leading area of technological advantage in terms of patenting intensity. The IP Scorecard uses data obtained from IP Australia, the US Patent and Trademark Office, and the European Patent Office.

For more information, click here

<http://minister.industry.gov.au/Carr/Pages/STEADYGROWTHININTELLECTUALPROPERTYAPPLICATIONS.aspx>

### **Involvement sought for project to incorporate IP into vocational education and training (VET)**

On **7 July 2008** IP Australia announced a national project to incorporate IP into training and qualifications in the national VET sector. Units of competency in IP are currently being developed for incorporation in business services qualifications, and these units will also be able to be included in qualifications by other industry groups. Contributions are being sought from persons interested in being involved in this project, either by providing expertise, or discussing industry needs.

For more information, click here:

[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#35](http://www.ipaustralia.gov.au/resources/news_new.shtml#35)

### **Release of study on IP protection usage by small and medium enterprises (SMEs)**

On **26 June 2008** the Government released a report regarding a 2005 study about the use of IP protection by Australian SMEs. The study focuses on:

- the relative IP application rates by SMEs in Australia compared with large Australian firms and SMEs in other industrialised nations;
- factors that inhibit the use of patenting and other forms of IP by SMEs, and how these factors impact on export performance; and
- the extent to which current IP protection and enforcement systems meets the needs of Australian SMEs.

For more information and to access the full report, click here

<http://www.innovation.gov.au/Section/Innovation/Pages/FactorsaffectingtheuseofIntellectualPropertyprotectionbySMEsinAustralia.aspx>

### **Developments regarding Australia's Free Trade Agreements (FTAs)**

#### **ASEAN-Australia-New Zealand negotiations completed**

The negotiations between the Association of Southeast Asian Nations (ASEAN), Australia and New Zealand for an FTA (AANZFTA) were concluded in Singapore on **28 August 2008**. AANZFTA is Australia's first multi-country plurilateral FTA, and

covers all sectors, including IP. Australia has a long-standing comprehensive FTA with New Zealand, and also has existing FTAs with Singapore and Thailand. The provisions of AANZFTA ensure that the Agreement can have no impact on those existing FTAs.

For more information, click here

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

#### **Sixth round of Australia-Japan FTA negotiations**

The sixth round of negotiations on the Australia-Japan FTA was held in Tokyo from **28 July to 1 August 2008**. The parties made progress on the IP chapter, with a focus on the consolidated draft negotiating text and proposals made by Australia and Japan. The next round of negotiations is scheduled for late October, in Canberra.

For more information, click here

[http://www.dfat.gov.au/geo/japan/fta/newsletter\\_update/update\\_6.html](http://www.dfat.gov.au/geo/japan/fta/newsletter_update/update_6.html)

#### **Eleventh round of Australia-China FTA negotiations**

The eleventh round of negotiations on the Australia-China Free FTA was held in Beijing from **16 to 20 June 2008**. Negotiations on the IP chapter recommenced in this round after China's request to not discuss IP at the 10th round. The parties spent two days discussing the text of the IP chapter, and agreed to intensify negotiations over the next few rounds. The next round of negotiations is expected to be held in September 2008.

For more information, click here

[http://www.dfat.gov.au/geo/china/fta/080627\\_subscriber\\_update.html](http://www.dfat.gov.au/geo/china/fta/080627_subscriber_update.html)

#### **Australia-Chile FTA Signed and Tabled**

Following the conclusion of negotiations, the Australia-Chile FTA was signed on 30 July 2008. Chapter 17 of the Agreement relates specifically to IP, and includes articles on trade marks, patents, domain names, copyright, and IP enforcement. The text of the Australia-Chile FTA was tabled in Parliament on **17 June 2008** as part of the domestic ratification processes, and the Agreement is expected to enter into force on 1 January 2009.

For more information and to access the full text of the treaty, click here

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

#### **Australia-India FTA Feasibility Study**

Australia and India have agreed to undertake a joint feasibility study on the merits of an FTA between the two countries. One aim of the study is to consider the development of a comprehensive policy framework, including the protection of IP rights. The study is due for completion **by the end of 2008** and the Government is currently accepting public submissions on the merits of the proposed FTA.

For more information, click here

<http://www.dfat.gov.au/geo/india/fta-study/index.html>

## **PRIVACY**

### **ALRC releases Privacy Report**

The ALRC released its report 'For Your Information: Australian Privacy Law and Practice' (ALRC 108) on **11 August 2008**. The report recommends 295 changes to privacy laws and practices, including:

- simplification and streamlining of privacy laws;
- the introduction of uniform privacy principles to apply to all federal, state and territory government agencies, and to the private sector;
- rationalisation of exemptions and exceptions to privacy laws;
- improved complaint handling and stronger penalties; and
- the introduction of a private cause of action for a serious invasion of privacy.

For more information, click here

<http://www.alrc.gov.au/media/2008/mr1108.html>