

IPRIA Australian Developments in IP

Update November 2005

Welcome to the **IPRIA Australian Developments in IP Bulletin** for November 2005. The following is a summary of featured updates on the website. The page can be viewed in full at

http://www.ipria.org/developments_in_ip/domestic/index.html

PATENTS

Report on Patents and Experimental Use

ACIP has released a report on patents and experimental use, which examines whether some types of patents are constraining research and development in Australia, and whether current laws need to be amended.

The report found that the law in Australia is still uncertain on whether researchers needed the permission of the patent owner before they could experiment on patented inventions. Although current industry practice allows certain types of experimentation on patented inventions, business practices are still subject to change.

ACIP recommends that patent law be changed to make it clear that research done for experimental purposes does not infringe patents, as long as it does not unreasonably conflict with the normal exploitation of a patent.

http://www.ipria.org/developments_in_ip/domestic/Developments%20by%20Body.html#Experiment

Review of the innovation patent issues paper

The innovation patent was introduced in 2001 as part of the Australian Government's Backing Australia's Ability initiative. The main objective of the innovation patent system was to encourage innovation, particularly in Australian Small to Medium Enterprises, by providing industrial property rights for lower level inventions. The Government intended to review the innovation patent system within five years of its introduction. IP Australia has prepared an issues paper for public consultation as the first step of the review process.

Comments and submissions on the paper, or on the innovation patent system generally, are due to IP Australia by 16 December 2005.

http://www.ipria.org/developments_in_ip/domestic/Developments%20by%20Body.html#Issues

Review of the patent grace period

The 12 month grace period for patents was introduced on 1 April 2002 as part of the Backing Australia's Ability initiative. The grace period protects patents from invalidation by publication of the invention made by, or with the consent of, the patent applicant, or owner during the 12 month period prior to the filing date of the application. Grace period protection only applies in Australia.

At the time of introduction, the Government committed to review the grace period two years later. IP Australia released a discussion paper and nine submissions were received in response. The review has now been completed.

http://www.ipria.org/developments_in_ip/domestic/Developments%20by%20Body.html#Grace

COPYRIGHT

Public hearings on copyright and access protection

House Standing Committee on Legal and Constitutional Affairs

On 19 July 2005 the Attorney-General, The Hon Philip Ruddock MP, asked the Committee to inquire into and report on *technological protection measures (TPM) exceptions*. The Committee has been asked to report by the end of February 2006.

Copyright owners commonly use TPMs, in the form of regional coding on DVDs and encryption of software, to protect their product against copyright infringement. TPMs can be circumvented by various means, and under the FTA, Australia is required to implement a new scheme introducing civil and criminal offences to prevent such circumvention.

The House of Representatives Standing Committee on Legal and Constitutional Affairs held several public hearings on November 15-16, 2005, on copyright and access protection. Attended by both owners and users of copyright, the hearings examined the circumvention of protection measures controlling access to copyright material under the AUSFTA.

http://www.ipria.org/developments_in_ip/domestic/Developments%20by%20Area.html#Hearings

DESIGNS

Emerging issues in Designs Act

Since the *Designs Act 2003* came into effect in June 2004, three issues relating to the current operation and possible future development of the Act and its processes have been raised by stakeholders. These issues relate to:

- harmonisation of Australian design registration with international practices;
- a grace period prior to application for design registration to permit the promotion, testing and sale of a design for a specified period; and
- the current structure of design fees.

IP Australia seeks the views of a wide range of stakeholders on these issues, to allow preliminary consideration of these matters for possible future policy development of the designs registration process. Comments from stakeholders and interested parties are requested before 12 November 2005.

http://www.ipria.org/developments_in_ip/domestic/Developments%20by%20Area.html#Designs

US and Australian patent offices launch pilot project on international search and examination services

On October 26, 2005, the U.S. Patent and Trademark Office (USPTO) and IP Australia, Australia's national patent office, initiated a pilot project to test the feasibility of IP Australia performing search and examination services for the USPTO on international applications filed with the USPTO under the Patent Cooperation Treaty (PCT). The pilot is part of ongoing USPTO efforts to bring down the growing backlog of U.S. national patent applications waiting to be examined.

http://www.ipria.org/developments_in_ip/domestic/Developments%20by%20Body.html#Pilot

PROFESSIONAL STANDARDS BOARD

Better dispute resolution and professional development for patent and trade mark attorneys

Parliamentary Secretary to the Minister for Industry Tourism and Resources, Warren Entsch, has released the Government Response to the Review of the Regulatory Regime for Patent and Trade Marks Attorneys and the Review of the Discipline Regime for Patent and Trade Marks Attorneys. The response is significant because the Government has accepted the recommendation to introduce continuing professional education as a pre-requisite for renewal of registration, and has also supported the use of mediation, where appropriate, in disputes between clients and their attorneys.

http://www.ipria.org/developments_in_ip/domestic/Developments%20by%20Body.html#profstandards