

## **IPRIA Australian Developments in IP**

Update November 2006

Welcome to the IPRIA **Australian Developments in IP Bulletin for November 2006**. 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](http://www.ipria.org/developments_in_ip/domestic/index.html)

### **GENERAL IP**

#### **Upcoming IP symposium hosted by the Australian Government and APEC**

A symposium titled 'Trading Ideas - The Future of IP in Asia Pacific' will be held in Sydney on **28-30 January 2007**. It will be hosted by the Australian Government in collaboration with the Asia Pacific Economic Cooperation (APEC). Session topics include: 'International IP Asset Management', 'IP and Regional Trade Agreements' and 'Copyright and the Challenges Posed by Digital Technologies'.

For more information, click here

[www.tradingideas.org](http://www.tradingideas.org)

#### **Consultation Papers regarding the Intellectual Property Laws Amendment Act 2006**

IP Australia has released two Consultation Papers on the Intellectual Property Laws Amendment Act 2006 (Amendment Act) which received Royal Assent on 27 September 2006. The first Consultation Paper, "New close down provisions", is on Schedule 12 to the Amendment Act. The changes are to clarify the effect of the Designs Office, the Patent Office, the Plant Breeder's Rights Office and the Trade Marks Office, and any of their State sub-offices, not being open for business. The second Consultation Paper, "New system for accessing trade mark documents", is on Schedule 4 to the Amendment Act which will amend the Trade Marks Act 1995 to make prescribed documents relating to trade marks available for public inspection at an early stage in the trade mark application process. Written comments regarding the Consultation Papers were due by **27 October 2006**.

For more information and to access the Consultation Papers, click here

[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#48](http://www.ipaustralia.gov.au/resources/news_new.shtml#48)

#### **IP Australia's review of fees**

On 26 September 2006, IP Australia completed a review of its fees and charges for designs, patents, plant breeder's rights and trade marks. IP Australia seeks to introduce the draft changes through amendments to regulations, for a target implementation date of February 2007. Written comments on the review were due by **25 October 2006**.

For more information and to access the draft fee changes, click here

[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#42](http://www.ipaustralia.gov.au/resources/news_new.shtml#42)

#### **ALRC releases Issues Paper 'Review of Privacy'**

On **9 October 2006**, the Australian Law Reform Commission (ALRC) released an Issues Paper 'Review of Privacy'. Commissioner in charge of the Inquiry, Professor Les McCrimmon, said a major issue for the ALRC was the complexity of privacy regulations. "What exemptions should apply to the news media? How should breaches of privacy law be dealt with? What protections should apply to information that flows across international borders? These are just some of the 142 questions posed in the Issues Paper," Prof McCrimmon said. The ALRC will now begin a period of public consultation, and will meet with interested persons and organisations across Australia. Further consultation documents will be released later this year. A final report is due to be completed in March 2008.

For more information and to access the Issues Paper, click here

<http://www.alrc.gov.au/>

### **Department of Industry, Tourism and Resources releases its 'Intellectual Property Scorecard 2000-2004'**

On **18 October 2006**, the Department of Industry, Tourism and Resources released its 'Intellectual Property Scorecard 2000-2004'. The Scorecard shows a comparison of intellectual property protection activity in Australia, the USA and the EU in 2000-2004.

For more information and to access the Scorecard, click here

<http://www.industry.gov.au/content/itrinternet/cmscontent.cfm?objectid=2ACAE961-078F-EB47-FE229CB36D010059&indexPages=/content/whatsnew.cfm>

## **COPYRIGHT**

### **Government issues response to Report on TPM exceptions**

The Australian Government has issued its response to the House of Representatives Standing Committee on Legal and Constitutional Affairs Report on technological protection measures (TPMs) exceptions under the Australia-US Free Trade Agreement. The Government accepted several of the Committee's 37 recommendations, including the maintenance of the existing exceptions and that the circumvention of region coding technological measures will not be an offence under the new TPM liability scheme.

To access the Government's response, click here

[http://www.ag.gov.au/agd/WWW/rwpattach.nsf/VAP/\(4341200FE1255EFC59DB7A1770C1D0A5\)~Government+response+to+LACA+TPMS+\(final\).DOC/\\$file/Government+response+to+LACA+TPMS+\(final\).DOC](http://www.ag.gov.au/agd/WWW/rwpattach.nsf/VAP/(4341200FE1255EFC59DB7A1770C1D0A5)~Government+response+to+LACA+TPMS+(final).DOC/$file/Government+response+to+LACA+TPMS+(final).DOC)

### **Copyright Amendment Bill 2006 introduced to Parliament**

On **19 October 2006**, the Copyright Amendment Bill 2006 was introduced to Parliament. The Bill legalises 'time shifting', allowing people in their homes to copy a television or radio broadcast for personal use so that it may be played at a later time and 'format shifting', allowing owners of legitimate copies of specified copyright material to copy it (and the underlying content) in a different format for personal use – i.e. VHS to DVD, CD to MP3. In addition to these two exceptions for private copying, further new specific exceptions will be added to permit:

- fair dealings with copyright material by libraries, museums or archives;

- format-shifting of copyright material for non-commercial and teaching purposes by educational institutions;
- fair dealings with copyright material for the benefit of people with disability; and
- fair dealings with copyright material for the purpose of parody and satire

Criminal offence provisions in the Copyright Act 1968 will also be amended to create indictable, summary and strict liability offences with a range of available penalties. The Government has referred the Bill for consideration by the Senate Standing Committee on Legal and Constitutional Affairs.

For more information, click here.

[http://www.aph.gov.au/senate/committee/legcon\\_ctte/copyright06/index.htm](http://www.aph.gov.au/senate/committee/legcon_ctte/copyright06/index.htm)

Prior to the Bill's introduction and referral to the Senate Committee, the Attorney General's Department released five Exposure Drafts regarding various parts of the Bill. The Exposure Drafts concerned exceptions and other Digital Agenda review measures, enforcement provisions, unauthorised access to encoded broadcasts, Copyright Tribunal amendments, and Technological Protection Measures amendments and related Regulations.

To access the Exposure Drafts, click here

<http://www.ag.gov.au/agd/WWW/agdhome.nsf/AllDocs/1BA58E34F69DE3EECA2571E800083F81?OpenDocument>

### **Copyright Tribunal approves new background music licence fees**

On 3 October 2006 it was announced by APRA/AMCOS (the Australasian Performing Right Association and the Australasian Mechanical Copyright Owners Society) that the Copyright Tribunal has approved a new licence scheme for the use of background music for the retail sector. The new licence fees will apply to retailers and other types of businesses who use background music and will be phased in over three years commencing **1 December 2006**. The scheme will not include businesses in the hospitality and fitness industry, as APRA reached an agreement on the use of background music with these groups in 2005.

For more information, click here

[http://www.apra.com.au/news/media\\_centre/061003\\_APRA\\_Media\\_Release\\_Background\\_Music.pdf](http://www.apra.com.au/news/media_centre/061003_APRA_Media_Release_Background_Music.pdf)

## **PATENTS**

### **Consultation Paper regarding amendments to the Regulations under the PCT**

On 20 September 2006, IP Australia released a Consultation Paper regarding amendments to the Regulations under the Patent Cooperation Treaty (PCT) which are due to come into force on **1 April 2007**. The more significant amendments address the situation where a PCT application is filed with missing elements or parts; restoration of priority where an international application is filed up to two months after the end of the 12 month priority period; rectification of obvious mistakes; and addition of Korean patent documents to the minimum documentation to be searched. Written comments to the Consultation Paper were due by 19 October 2006.

For more information and to access the Consultation Paper, click here  
[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#40](http://www.ipaustralia.gov.au/resources/news_new.shtml#40)

### **Changes to the Patents Act 1990 under the Intellectual Property Laws Amendment Bill 2006**

After an inquiry by the Senate Economics Legislation Committee, the Intellectual Property Laws Amendment Bill 2006, which amends several intellectual property Acts, received Royal Assent on **27 September 2006**. Changes to the Patents Act 1990 contained in the Bill include:

- exemplary damages may be awarded by a court in patent infringement actions;
- amendment is made to the prior user defence;
- a compulsory licence is available as a remedy if a person has contravened the anti-competitive conduct provisions of the Trade Practices Act 1974;
- amendment is made to clarify when a divisional application from a granted innovation patent may be made; and
- wider springboarding provisions than those currently available are implemented by allowing springboarding on any pharmaceutical patent at any time. 'Springboarding' refers to using the subject matter of a patent to collect the data required to obtain regulatory approval of a generic version of the product to which the patent relates, during the life of the patent.

To access IP Australia's Official Notice regarding passage of the Bill, click here  
<http://www.ipaustralia.gov.au/pdfs/news/PassageofIPLawsBill.pdf>

### **Consultation Paper on ACIP Report 'Patents and Experimental Use'**

On 4 September 2006, IP Australia announced that an Interdepartmental Committee (IDC) has been established to draft a response to the Advisory Council on Intellectual Property (ACIP) Report 'Patents and Experimental Use' for consideration by the Government. As the recommendations in the ACIP Report differ slightly to the options proposed in the ACIP 'Patents and Experimental Use' Options Paper (published December 2004), the IDC has developed a Consultation Paper which provides a brief overview of the ACIP Report and its recommendations. Written comments regarding the Consultation Paper were due by **29 September 2006**.

For more information and to assess the IDC Consultation Paper and the ACIP Report, click here

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

### **Review of innovation patent system**

On **15 August 2006**, the Australian Government released a Report 'Review of the Innovation Patent'. The Report concludes that the innovation patent system meets its objectives and that changes are not presently warranted. The Report finds that the innovation patent is predominately being used by Australian individuals and small-to-medium enterprises (SMEs) for less-knowledge intensive innovations. However, preliminary evidence also suggests that a significant proportion of innovation patents are being used to obtain a form of quick protection for higher-level inventions while a standard patent is being pursued. Therefore, one of the Report's recommendations is that IP Australia routinely assess the proportion of innovation patent applications that

appear to be used for 'tactical reasons' regarding higher-level inventions. Owing to the inadequate knowledge of the system by both applicants and other parties, IP Australia will be conducting awareness-raising programs in the future.

For more information and to access the Report, click here  
[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#31](http://www.ipaustralia.gov.au/resources/news_new.shtml#31)

## **TRADE MARKS**

### **Trade Marks Amendment Bill 2006 receives Royal Assent**

The Trade Marks Amendment Bill 2006 received Royal Assent on **23 October 2006**. The changes to the Trade Marks Act 1995 contained in the Bill include:

- the ability to conduct simple trade mark transactions over the phone;
- the owner of a trade mark may oppose, on the basis of absolute first use, the registration of a deceptively similar trade mark;
- registration of a trademark may be opposed on the ground that it has been applied for in bad faith;
- the requirements for opposition based upon a trade mark with a reputation in Australia will be less restrictive;
- only persons having a legal personality may apply for a trademark; and
- any person may make an application for a trade mark to be removed from the Register due to non-use, not just a person aggrieved.

While some of the provisions in the Trade Marks Amendment Act 2006 will come into force immediately upon Royal Assent, other provisions will commence six months later upon Proclamation (expected to be no earlier than 27 March 2007).

For IP Australia's Official Notice regarding passage of the Bill, click here  
<http://www.ipaustralia.gov.au/pdfs/news/MDB-OLS%20-%20TM%20Bill%20AOJTM%2026%20October06.pdf>

### **Consultation Papers regarding amendments to the Trade Marks Regulations 1995**

IP Australia released a Consultation Paper regarding amendments proposed to be made to the Trade Marks Regulations 1995 arising from Part 2 of Schedule 1 of the Trade Marks Amendment Bill 2006 as well as a number of other amendments that arise from the trade marks legislation review but are not dependent on the Bill. Submissions regarding the Consultation Paper were due by **1 November 2006**.

For more information and to access the Consultation Paper, click here  
[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#51](http://www.ipaustralia.gov.au/resources/news_new.shtml#51)

IP Australia also released a Consultation Paper regarding the changes to Part 17A of the Regulations being proposed by the Trade Marks Amendment Bill 2006. Submissions regarding this Consultation Paper were due by **27 October 2006**.

For more information and to access this Consultation Paper, click here  
[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#49](http://www.ipaustralia.gov.au/resources/news_new.shtml#49)

**Further addition of new terms to the ATMOSS Goods & Services search and to the Trade Marks Online Application Form picklist of goods and services**

IP Australia announced on **18 October 2006** the further addition of new terms to the ATMOSS Goods & Services search and to the Trade Marks Online Application Form picklist of goods and services.

For more information, click here.

[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#52](http://www.ipaustralia.gov.au/resources/news_new.shtml#52)

**PROFESSIONAL STANDARDS BOARD FOR PATENT AND TRADE MARKS ATTORNEYS**

**Consultation Papers on changes to Patent and Trade Marks Attorney regimes**

In October 2005, the Government issued its responses 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’ produced by the Professional Standards Board for Patent and Trade Marks Attorneys. IP Australia has the responsibility for implementing the Government responses and on 18 September 2006, produced two Consultation Papers regarding the regimes. Written comments regarding the Consultation Papers were due by **9 October 2006**.

For more information and to access the Consultation Papers, click here

[http://www.ipaustralia.gov.au/resources/news\\_new.shtml#37](http://www.ipaustralia.gov.au/resources/news_new.shtml#37)

**DOMAIN NAMES**

**Review of the .au internet domain by DCITA**

The Department for Communications, Information Technology and the Arts (DCITA) has released a Discussion Paper as part of a review of the .au internet domain. Public comment is sought on various issues including the administrative structure of the .au internet domain, naming structures, policy development, competitiveness and cost effectiveness, international participation and emerging technical issues. Submissions are due by close of business on **28 November 2006**.

For more information, click here

[http://www.dcita.gov.au/communications\\_for\\_business/news\\_and\\_events/review\\_of\\_the\\_structure\\_and\\_operation\\_of\\_the\\_.au\\_internet\\_domain](http://www.dcita.gov.au/communications_for_business/news_and_events/review_of_the_structure_and_operation_of_the_.au_internet_domain)