

IPRIA Australian Developments in IP

Update November 2007

Welcome to the IPRIA [Australian Developments in IP Bulletin](#) for November 2007. The following items are also available on our website. The page can be viewed in full at http://www.ipria.org/developments_in_ip/domestic/index.html

PATENTS

Patents Amendment Regulations 2007 (No. 1) enter into force

On 16 May 2007, IP Australia published a Consultation Paper seeking views on proposed changes to the Patents Regulations 1991 under subsection 45(3) and section 101D of the Patents Act 1990. As a result of the generally favourable feedback received, the Patents Regulations 1991 have been amended to remove the requirement to inform the Commissioner of Patents of the results of documentary searches by, or on behalf of, foreign patent offices. The amending legislation, the Patents Amendment Regulations 2007 (No. 1) entered into force on **22 October 2007**. Also amended is the time for lodging notices to the Commissioner of matters affecting the validity of patents under section 27(1) of the Patents Act 1990. Notices may be filed up to three months from the date of advertisement of acceptance, rather than up to the date of acceptance, as was previously the case.

To access the Official Notice by IP Australia, click here

<http://www.ipaustralia.gov.au/pdfs/news/ON20071018%20Patents%20Amendments%20Regulations.pdf>

To access the Position Paper by IP Australia, 'Overview of responses to the public consultation paper *Removal of the obligation to lodge search results under subsection 45(3) and section 101D of the Patents Act 1990*', click here

<http://www.ipaustralia.gov.au/pdfs/news/2007-10-18%20Overview%20of%20responses.pdf>

Consultation Paper released regarding exchange of patent documents with WIPO and IP offices

On 19 September 2007, IP Australia released a Consultation Paper titled 'Exchanging Information on Patent Applications'. The purpose of the Consultation Paper is to inform stakeholders of the amendments IP Australia is proposing to introduce to the Patents Regulations 1991 to:

- extend the circumstances under which the Commissioner of Patents may make priority and other documents available to the World Intellectual Property Organization (WIPO) and other IP offices; and
- further reduce the circumstances where applicants are required to routinely file documents with IP Australia when the documents are not immediately required by IP Australia or, if required, are available from another IP office.

Submissions regarding the Consultation Paper were due by **17 October 2007**.

To access the Consultation Paper, click here

<http://www.ipaustralia.gov.au/pdfs/news/Consultation%20Paper%20on%20Exchanging%20Patent%20Information.pdf>

TRADE MARKS

Request for comment on the future of the Madrid Protocol

On 10 September 2007, IP Australia announced that it is seeking comment from trade mark owners and their representatives on issues relating to the operation of the Madrid Protocol in the context of ongoing international consideration of the future development of the Madrid system. Comments were to be received by **9 November 2007** in order for them to be considered when IP Australia contributes to a WIPO Secretariat paper at the end of 2007. However, as some of the issues will be discussed later in 2008, input at a later time would also be very useful.

For more information, click here

http://www.ipaustralia.gov.au/resources/news_new.shtml#53

PATENT AND TRADE MARK ATTORNEYS

Consultation Paper on companies acting as patent or trade mark attorneys

On 17 October 2007, IP Australia released a Consultation Paper which considers a scheme that removes the current bar on a company carrying on business as a patent attorney. The proposed model provides for individual patent attorneys to retain personal responsibility for discipline and complaints; a Code of Conduct to apply to all individual attorneys within a company; and an incorporated patent attorney company must have at least one director who is a registered patent attorney. In addition, there is a compulsory requirement for all patent attorneys whether they are incorporated or not to have professional indemnity insurance. The Consultation Paper also sets out the amendments required to put the model in place to allow companies to describe themselves as trade marks attorneys. Written comments on the Consultation Paper are sought by **30 November 2007**.

To access the Consultation Paper, click here

<<http://www.ipaustralia.gov.au/pdfs/news/Consultation%20paper%20for%20patent%20attorney%20incorporation%20-%20October%202007.pdf>>

DOMAIN NAMES

auDA releases remaining geographic names in com.au and net.au

In 2005, the .au Domain Administration Ltd (auDA) held a ballot for the allocation of geographic names in com.au and net.au. Under auDA policy a 'geographic name' is defined as any location with an Australian postcode, as listed on the Australia Post postcode database. This includes suburb and town names, plus a number of other names such as airports and universities. A number of geographic names were not allocated in the ballot and remained on auDA's Reserved List. These names were released on **21 October 2007** on a first come, first served basis, subject to normal policy rules.

For more information, click here

<http://www.ada.org.au/news-archive/ada-09102007/>

auDA Panel releases draft recommendations on .au domain names for public consultation

auDA's 2007 Names Policy Panel 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 6 September 2007, the Panel released its draft recommendations for public consultation. The closing date for submissions was **19 October 2007**. The Panel is due to provide its final recommendations to the auDA Board in November 2007.

For more information, click here

<http://www.ada.org.au/news-archive/ada-06092007/>

auDA reviews community geographic domain names policy

auDA is conducting a 12 month review of the 'Policy Rules and Guidelines for Community Geographic Domain Names (CGDNs) (2006-04)'. CGDNs are domain names registered within the eight Australian state and territory second-level domains: act.au, qld.au, nsw.au, nt.au, sa.au, tas.au, vic.au, wa.au. The purpose is to preserve Australian geographic names for use by the relevant local community. CGDNs may only be registered as third-level domain names (eg. carlton.vic.au) and their use is restricted to community websites that reflect community interests such as local business, tourism, historical information, culture, sporting groups, local events and news. The closing date for submissions was **28 September 2007**.

For more information, click here

<http://www.ada.org.au/news-archive/ada-28082007/>

auDA reviews .au Dispute Resolution Policy

The purpose of the .au Dispute Resolution Policy (auDRP) is to provide a cheaper, speedier alternative to litigation for the resolution of disputes between the registrant of a .au domain name and a party with competing rights in the domain name. The auDRP commenced on 1 August 2002. After 5 years of operation, auDA is reviewing the auDRP to ensure that it remains an effective and appropriate dispute resolution mechanism. In August 2007, auDA released an Issues Paper which summarises auDRP operations to date and invites comments. The closing date for submissions was **21 September 2007**.

For more information, click here

<http://www.ada.org.au/reviews/audrp-2007/>

PRIVACY

ALRC releases Discussion Paper on privacy

On 12 September 2007, the Australian Law Reform Commission (ALRC) released Discussion Paper 72, 'Review of Australian Privacy Law', as part of its inquiry into privacy. The Discussion Paper puts forward numerous proposals for amendments to privacy laws and highlights the impact that changing technologies and social practices are having on privacy. The Discussion Paper also contains other proposals, including the development of a statutory tort of privacy, removal of certain exceptions from the

Privacy Act 1988 and the development of a comprehensive credit reporting system. The Discussion Paper contains 301 proposals for reform and 46 questions about aspects of the inquiry. The deadline for submissions or comment is **7 December 2007**.

For more information about the ALRC privacy inquiry, click here
<http://www.alrc.gov.au/inquiries/current/privacy/index.htm>

RESEARCH AND FUNDING

Advisory group appointed for Food Innovation Grants Programme

On 12 October 2007, the Minister for Agriculture, Fisheries and Forestry, Peter McGauran, announced that an advisory group has been appointed to assess grant applications under the Australian Government's new \$54 million Food Innovation Grants Programme. Under the Programme, grants are available for Australian-based food industry consortiums or food businesses working either individually or in cooperation with research providers to undertake projects focused on R&D, innovation, and cutting edge products and technology. Preliminary applications for the second round of the Programme closed on **8 November 2007**.

For more information, click here
<http://www.maff.gov.au/releases/07/07163pm.html>

National Survey of Research Commercialisation 2003-2004 report released

On **31 August 2007**, the National Survey of Research Commercialisation (NSRC) 2003-2004 report was released by the Department of Education, Science and Training. The NSRC collects data and information on commercialisation activity in Australian publicly funded research institutions including the CSIRO, other publicly funded research institutions, universities, and medical research institutes. The report provides new data for the years 2003 and 2004, as well as incorporating trends from 2000 to 2004. Over the five years that data has been collected, the results include:

- invention disclosures (occurring 'when a device, material, or method that is novel and useful is made known to research management within [an] institution') increased by 77%;
- patents and plant breeder rights issued worldwide increased by 79%;
- licences, options and assignments yielding income per year increased by 36%;
- start-up companies operational at the end of each year nearly tripled, with the value of institutional equity in start ups increasing by 41%; and
- commercialisation staff increased by 74%.

For more information, click here
<http://www.dest.gov.au/Ministers/Media/Bishop/2007/08/B002310807.asp#>

GENERAL IP

Australia to be a third party in WTO dispute on IP between US and China

On **7 October 2007**, the Minister for Trade, Warren Truss, announced that Australia has decided to participate as a third party in the World Trade Organisation (WTO) dispute brought by the United States against China on the protection and enforcement of IP rights. Several other WTO members – including Mexico, Japan and the European Communities – have also decided to become third parties. According to Mr

Truss, the case raises important commercial and systematic issues in relation to WTO rules on IP protection, including the meaning of counterfeiting or piracy ‘on a commercial scale’. ‘Participation as a third party does not mean we are taking sides in the case’, Mr Truss said. ‘It does, however, allow us to register our views on the legal issues raised in the dispute.’

To view Mr Truss’ media release, click here

http://www.trademinister.gov.au/releases/2007/wtt104_07.html

To view a WTO summary of the dispute as at 20 August 2007, click here

http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds362_e.htm

Australian Government releases final response to the ‘Inquiry into Pathways to Technological Innovation’ report

In **September 2007**, the Australian Government released its final response to the House of Representatives Science & Innovation Standing Committee ‘Inquiry into Pathways to Technological Innovation’ report. The Committee, chaired by Petro Georgiou MP, released its report in June 2006. The Government tabled an interim response in November 2006. Reviewing the 18 recommendations in the report, the Government’s final response includes the following:

- the Government does not support the recommendation that the Attorney General request the Advisory Council on Intellectual Property to review Australia’s IP system to determine the capacity for reduction in misuse of the system;
- the Government supports in principle the recommendation that it review IP legislation according to National Competition Policy Agreements and establish an IP legislation system of periodic re-review; and
- the Government does not support the recommendation that it implement additional support mechanisms to specifically assist the progression of innovation through pathways other than the formation of start-up companies.

To access the Government’s response, click here

<http://www.aph.gov.au/house/committee/scin/randd/govtresponse/18sep07.pdf>

Developments regarding Australia’s Free Trade Agreements (FTAs)

Eleventh round of ASEAN-Australia-New Zealand FTA negotiations

The eleventh round of the Association of Southeast Asian Nations (ASEAN)-Australia-New Zealand FTA negotiations took place in Kuala Lumpur from **24 to 28 September 2007**. AESAN confirmed their agreement to the inclusion of a separate chapter on IP.

For more information, click here

http://www.dfat.gov.au/trade/fta/asean/subscriber_updates/0710_update.html

Tenth round of Australia-China FTA negotiations

The tenth round of the Australia-China FTA negotiations were held in Canberra from **22 to 26 October 2007**. While the parties narrowed their differences on some issues and made changes to the proposed text of the agreement, overall progress in the

negotiations continued to be slow. At China's request, talks on IP were put on hold until the next round.

For more information, click here

http://www.dfat.gov.au/geo/china/fta/071101_subscriber_update.html

Second round of Australia-Japan FTA negotiations

The second round of the Australia-Japan FTA negotiations took place in Tokyo from **6 to 10 August 2007**. The round began intensive discussion on the comprehensive list of issues to be discussed as part of the FTA, which were agreed at the first round. This involved eighteen sessions over five days, including a session on IP. The Department of Foreign Affairs and Trade (DFAT) continues to welcome submissions on issues relevant to the negotiation of an Australia-Japan FTA.

For more information, click here

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

First substantive round of Australia-Chile FTA negotiations

The first substantive round of Australia-Chile FTA negotiations was held in Canberra from **7 to 9 August 2007**. As expected by the parties, discussions on IP were 'challenging' but Australia used the opportunity 'to reiterate to Chile the importance ... of including substantive, high quality IP provisions in our FTA'.

For more information, click here

<http://www.dfat.gov.au/geo/chile/fta/update1.html>

First substantive round of Australia-Gulf Cooperation Council FTA negotiations

The first substantive round of the Australia-Gulf Cooperation Council FTA was held in Canberra from **31 July to 1 August 2007**. The Gulf Cooperation Council (GCC) comprises Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates. The GCC has agreed that the FTA will cover IP rights protection but Australia will need to do more work to ensure that commitments in this area are 'commercially meaningful'. DFAT continues to welcome written comments regarding the Australia-GCC FTA negotiations.

For more information, click here

http://www.dfat.gov.au/trade/fta/gcc/Update_2.html

Australia-Indonesia FTA feasibility study

DFAT is calling for submissions and comments on issues relevant to a joint feasibility study regarding the merits of an FTA between Australia and Indonesia. The feasibility study commenced in **August 2007** and is expected to be completed by the middle of 2008.

For more information, click here

<http://www.dfat.gov.au/geo/indonesia/ia-fta.html>

Australia-India FTA feasibility study

On **31 August 2007**, the Minister for Trade, Warren Truss, announced that Australia and India have agreed to undertake a joint feasibility study into the merits of a FTA

between the two countries. The Australian Government will consult widely in Australia, including with the States and Territories, relevant industry bodies and other stakeholders during the feasibility study.

For more information, click here

http://www.trademinister.gov.au/releases/2007/wtt094_07.html