Australian Government
IP Australia

Patents Trade Marks Designs Plant Breeder's Rights

Delivering a world leading IP system

# Exposure Draft of the Intellectual Property Laws Amendment Bill 2017: Draft Explanatory Memorandum

November 2016



# Introduction

This draft Explanatory Memorandum accompanies an Exposure Draft of the Intellectual Property Laws Amendment Bill 2017, which is proposed to amend a range of intellectual property (IP) laws.

The proposed amendments in the Bill assume that amendments in Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* have come into effect, which is expected to occur on 24 February 2017.

You will also note a legislative instrument has been referred to under Part 9 of the Bill – Computerised decision-making, which is yet to be developed. Further public consultation will be undertaken prior to the making of this legislative instrument.

IP Australia invites interested parties to make written submissions on the Exposure Draft Bill and this draft Explanatory Memorandum by **COB 6 February 2017.**

**Written submissions should be sent to** consultation@ipaustralia.gov.au.

For accessibility reasons, please submit responses by email in Word, RTF, or PDF format.

The contact officer is Lisa Bailey, who may be contacted on (02) 6222 3695, or via lisa.bailey@ipaustralia.gov.au.

# Privacy Notice

Personal information collected during this public consultation is collected for the purposes of gaining stakeholder insights and comment on the proposed amendments to the Intellectual Property Rights legislation and regulations, and is protected by the Privacy Act 1988.

Your submission, along with any personal information you provide as part of that submission, will be published on IP Australia's website. Information published online may be accessed world-wide, including by overseas entities. IP Australia will not able to control any subsequent use under the Privacy Act, nor are you able to seek redress under that Act for the actions of any overseas entities.

Please advise IP Australia in writing if you would prefer that your submission, or any part of your submission, not be published on our website.

Your personal information may also be used by IP Australia or disclosed to interested parties, including but not limited to, the Department of Industry, Innovation and Science and the relevant Ministers' offices for the purpose of briefing on the results of the consultation in general and/or about specific issues on which you have commented. IP Australia may also contact you by telephone or email to discuss your submission.

IP Australia will not otherwise use or disclose your personal information without your consent, unless authorised or required by or under law.

If you do not provide your contact details, IP Australia may not be able to make full use of your submission.

All personal information you provide is handled in accordance with IP Australia's Privacy Policy.

The Privacy Policy contains relevant information, including:

- how you may seek access to and correction of the personal information we hold;
- how you may make a complaint about a breach of the Privacy Act and how we will deal with your complaint; and
- IP Australia's Privacy Contact Officer details.

By making a public submission, you provide your consent to your personal information being handled in accordance with this privacy notice and the IP Australia Privacy Policy.

# Contents

# INTELLECTUAL PROPERTY LAWS AMENDMENT BILL 2017

# OUTLINE

The objective of the intellectual property (IP) rights system is to support innovation by encouraging investment in research and technology in Australia, and by helping Australian businesses benefit from their good ideas. The purpose of this Bill is to improve and streamline the administration of the Australian IP system to reduce regulatory costs and to better meet the needs of businesses dealing with the system.

The Bill's amendments to the *Copyright Act 1968*, *Designs Act 2003*, *Olympic Insignia Protection Act 1987*, *Patents Act 1990, Plant Breeder's Rights Act 1994* and *Trade Marks Act 1995* are set out in Schedule 1.

## *Schedule 1: Aligning and streamlining the IP system*

The patents, trade marks, designs and plant breeder's rights (PBR) systems have a number of different administrative processes and rules specific to each IP right. A number of these differences are unnecessary or too onerous. Some processes take too long to resolve. This needlessly increases complexity, uncertainty and cost for users of the IP system.

This Bill will align and streamline the processes for obtaining, maintaining and challenging IP rights. Using similar processes for the different IP rights will make the IP system simpler and assist businesses dealing with more than one right. A simpler IP system will decrease administration costs for the Australian Government and reduce the regulatory burden for businesses that use it. The Bill will also enable greater use of electronic systems to manage and monitor IP rights.

This Bill will reduce delays that can have a significant impact on the interests of IP owners and third parties. Some delays can lead to a prolonged period of uncertainty over the freedom to operate in a particular market. As a result, businesses can incur significant costs arising from lost opportunities and having to adopt alternative strategies. Conversely, some of these delays impose unnecessary regulatory costs on IP rights owners. Reducing timeframes where possible will reduce such costs for all parties.

In Australia, a large percentage of IP applicants and owners are small to medium enterprises (SMEs). SMEs play a vital creative and entrepreneurial role in the Australian economy. However, SMEs lack the resources of larger firms, leaving them particularly vulnerable to red tape and uncertainty. Reducing complexity and delays in the IP system will particularly assist SMEs.

This Bill will clarify elements of the law regarding the ownership of IP rights, and strengthen protection against unjustified threats of infringement action. For example, the Bill will address current uncertainty over the ownership of PBR rights where there are multiple breeders involved or where there are mistakes or omissions on the Register. Small businesses, who are particularly strong users of the trade marks, designs and PBR systems will benefit from the increased certainty and the removal of unnecessary costs in these areas.

This Bill corrects a number of references and administrative processes. This Bill also addresses a small number of errors and inconsistencies in the IP legislation. For example, some of the amendments will ensure compliance with a Bilateral Arrangement for the trans-Tasman regulation of patent attorneys, which is due to come into effect in February 2017. The amendments will ensure that the general public has access to relevant attorney details, so that they can verify that the attorney is registered to practice in Australia or New Zealand. This Bill also corrects an error in the legislation by aligning the time frame in which incorporated attorney firms or individual natural persons can be prosecuted for attorney offences.

Collectively, the above changes will improve service delivery, reduce unnecessary delays and enable a simplified and efficient IP rights system for those who use it, particularly small businesses.

# Preliminary Matters

## Notes on clauses

### Clause 1: Short title

Upon enactment, the Bill will be known as the *Intellectual Property Laws Amendment Act 2017*.

### Clause 2: Commencement

A number of provisions in the Bill will commence on a single day to be fixed by Proclamation or 12 months after this Bill receives Royal Assent. This will enable the necessary regulation and system changes, and amendments to the Federal Court Rules, to be made before commencement. Proclamation provides IP Australia with the flexibility to commence the provisions before the 12 months period ends if this better aligns with the launch of major information technology systems and so would minimise the costs of implementation. These provisions comprise the following in Schedule 1:

- Part 1 relating to renewals and terminology
- Part 2 relating to re-examination and re-consideration
- Part 4 relating to written requirements
- Part 5 relating to the filing requirements
- Part 6 relating to Official Journals
- Part 7 relating to amendments of applications or other documents
- Part 8 relating to signature requirements
- Part 9 relating to computerised decision-making
- Part 10 relating to addresses and service of documents
- Part 11 relating to examination of patent requests and specifications
- Part 12 relating to requirements for patent documents
- Part 13 relating to acceptance of trade mark applications
- Part 14 relating to registration of designs
- Part 15 relating to unjustified threats of infringement
- Part 19 relating to publishing personal information of registered patent or trade marks attorneys.

A number of provisions commence immediately after the commencement of other provisions due to their dependency on those provisions. These provisions comprise the following in Schedule 1:

- Part 3 relating to extensions of time
- Part 16 relating to ownership of Plant Breeder's Rights and entries in the Register
- Part 17 relating to trade mark oppositions
- Part 21 relating to the Secretary's role in the Plant Breeder's Rights Act

A number of provisions in the Bill will commence the day after the Bill receives the Royal Assent. These provisions involve no or minor system and practice changes, so their immediate commencement will realise their benefits as soon as possible. The provisions comprise the following in Schedule 1:

- Part 18 relating to seizure notices
- Part 20 relating to prosecutions
- Part 22 relating to updating references to Designs Act
- Part 23 relating to the abolition of the Plant Breeder's Rights Advisory Committee.

### Clause 3: Schedules

The Copyright Act, Designs Act, Olympic Insignia Protection Act, Patents Act, Plant Breeder's Rights Act and the Trade Marks Act are to be amended as set out in Schedule 1 to the Bill.

# Schedule 1—Amendments

# Part 1 – Renewals and terminology

# Division 1 - Amendments

## Introduction

Part 1 of Schedule 1 contains a number of amendments to better align the renewal regimes across the four IP rights administered by IP Australia. For example, at present designs, patents and trade mark applicants may pay renewal fees up to six months after the renewal date, as long as late fees are also paid. However, PBR applicants have no such renewal grace period and must pay renewal fees by the anniversary. The amendments also better align the terminology used for the status of IP rights. The four IP rights sometimes use different terminology for what is essentially the same status or process. The amendments reduce the complexity of the IP system for users.

## Designs Act 2003

### Items 1 and 2: Renewal of registration

[s 47]

Item 1 removes unnecessary words from subsection 47(2). The period in which the owner of a registered design may apply for renewal of the registration of the design continues to be prescribed in the regulations. It is intended that the regulations will prescribe the period to begin 12 months before the fifth anniversary of the filing date of the application and to end six months after that anniversary. Limiting renewals to no earlier than 12 months before the fifth anniversary encourages owners to only renew a registered design if it is commercially valuable to them around the time of the fifth anniversary, rather than renewing the design some years ahead. The proposed six month period after the fifth anniversary is equivalent to the six month 'renewal grace period' currently available under regulation 4.09 and for which a late fee will continue to apply to encourage prompt payment.

Item 2 uses more correct language in subsection 47(3). The Registrar must renew the registration of the design if the application satisfies the requirements prescribed by the regulations.

### Item 3: Status of renewed registered design

[s 47]

Item 3 clarifies the status of a registered design that has been renewed within the six month renewal grace period. There has been some uncertainty over whether a design that is renewed during the six month renewal grace period remains in force or ceases as of the fifth anniversary and is restored on the day of renewal. This amendment addresses this uncertainty by clarifying that the design does not cease during this period. Conversely, a registered design that is not renewed ceases as of the fifth year anniversary, not at the end of the renewal grace period. This approach is consistent with Australia's obligations under the Article 5*bis* of the Paris Convention for the Protection of Industrial Property (the Paris Convention).

# Patents Act 1990

## Items 4 and 5: Lapsing of a standard patent

[s 142]

Item 4 amends paragraph 142(2)(d) to clarify that a complete application for a standard patent lapses if the applicant does not pay within the prescribed period a continuation fee for the application, in relation to an anniversary of the date of the patent. It is intended that the regulations will prescribe the period to begin 12 months before the anniversary and to end six months after the anniversary. As for item 1, in relation to renewing registered designs, limiting the payment of continuation fees to no earlier than 12 months before each anniversary encourages owners to only continue an application that is commercially valuable to them around the time of the anniversary, rather than paying the continuation fees some years ahead. The proposed six month period is equivalent to the six month renewal grace period currently available under subregulation 13.3(1A) and for which a late fee will continue to apply. If the applicant does pay a continuation fee within the prescribed period, the application does not lapse and so remains in force.

Item 5 inserts new subsection 142(2A) to provide that, if the applicant does not pay a continuation fee within the prescribed period, the application lapses at the end of the anniversary concerned, not at the end of the prescribed renewal grace period.

As for designs, there has been some uncertainty over whether an application that is continued during the six month renewal grace period remains in force or lapses as of the anniversary and is restored on the day of continuation. These amendments help to address this uncertainty. If the continuation fee is paid during the prescribed period, the application does not lapse and so remains in force. This approach is consistent with recent court decisions and with Australia's obligations under Article 5*bis* of the Paris Convention.

## Items 6 to 8: Ceasing of a standard patent

[s 143]

Similar to items 4 and 5, these items amend section 143 to address some uncertainty over when a patent ceases. These items amend section 143 to clarify that a standard patent ceases if the patentee does not pay within the prescribed period a renewal fee in relation to an anniversary of the date of the patent. In these circumstances the patent ceases at the end of the anniversary concerned, not at the end of the prescribed renewal grace period. If the renewal fee is paid within the prescribed period the patent does not cease and so remains in force.

## Items 9 to 11: Ceasing of an innovation patent

[s 143A]

Similar to items 4 to 8, these items amend section 143A to address some uncertainty over when a patent ceases. They clarify that an innovation patent ceases if the patentee does not pay within the prescribed period a renewal fee in relation to an anniversary of the date of the patent. In these circumstances the patent ceases at the end of the anniversary concerned, not at the end of the prescribed renewal grace period. If the renewal fee is paid within the prescribed period the patent does not cease and so remains in force.

# Plant Breeder's Rights Act 1994

## Items 12 and 13: Duration of dependent PBR

[s 22]

These items are consequential to the amendments set out in items 19 to 21. They amend subsection 22(4) by replacing the specific term 'ceases' with the more general term 'ends'. As explained in the note at item 13, this ensures that the provision applies where a PBR ceases under section 51(2) (as proposed to be amended) or is revoked under section 50, 51, 52 (as proposed to be amended) or under section 54.

### Items 14 to 18, 23: Refusal of an application

[s 30]

These items amend section 30 to better align the terminology across the IP rights. At present, an application for PBR may be rejected under section 30. The amendments replace the term 'reject' with 'refuse'. This better aligns the terminology used for PBR with that used for patents and designs applications, which may be refused, and with the refusal to grant or register an IP right, as used in all four IP rights. The process and grounds for refusing PBR does not change. Consequential item 23 amends paragraph 77(1)(b)(v) to provide that a decision by the Registrar to accept or 'refuse' an application under section 30 may be reviewed by the Administrative Appeals Tribunal (AAT).

### Items 19 to 21: Ceasing of PBR

[s 51]

These items amend subsection 51 to better align the terminology across the IP rights. Currently, if the holder of a PBR fails to pay the prescribed annual renewal fee in the given time limit, they are 'taken to have surrendered the right' under subsection 51(2). This is in contrast to the other IP rights, when a right 'ceases' if the rights holder fails to pay renewal fees or otherwise renew the right.

Item 20 amends subsection 51(2) to provide that a PBR 'ceases' if the holder fails to pay the renewal fee within the prescribed period. Consequential items 19 and 21 amend the title of section 51 and replace the term 'surrender' with 'cessation' in paragraphs 51(3)(a) and (b). The amendments better align PBR with the other IP rights, simplifying the IP system.

The regulations will prescribe the period in which the renewal fee must be paid. As for designs and patents, it is intended that this will begin 12 months before the renewal anniversary and end six months after the anniversary. Limiting the payment of renewal fees to no earlier than 12 months before each anniversary encourages owners to only renew a PBR that is commercially valuable to them around the time of the anniversary, rather than paying the renewal fees some years ahead. The absence of a six month renewal grace period for PBR means that PBR owners may permanently lose their valuable rights by missing an anniversary. Introducing a renewal grace period with associated late fees will provide PBR owners with the same renewal safety net available to other IP rights owners.

### Items 22 and 24: Revocation on surrender of PBR

[ss 52, 77]

Item 22 amends section 52 to better align the terminology across the IP rights and to clarify the process involved in surrender of PBR. Currently, a PBR holder may at any time offer to surrender the PBR under section 52. This results in the PBR having a status of 'surrendered'. The process for dealing with such as request is not clearly set out in the legislation. In contrast, an offer to surrender a design or patent may result in the IP right being revoked by the Registrar of Designs or the Commissioner of Patents.

Item 22 amends section 52 to provide that a PBR holder may make an offer in the approved form to surrender that right. The Registrar may accept the offer, revoke the right and amend the Register. However, the Registrar must not revoke the PBR where there are relevant proceedings pending, unless the court, AAT, or all the relevant parties consent. Also, the Registrar must not revoke the PBR where there is a licence in force under section 19 to use the PBR, as this may be detrimental to the licence holder. If the

Registrar decides not to revoke the PBR, the Registrar must notify the PBR holder. These amendments simplify the IP system by better aligning terminology across the IP rights and clearly sets out the conditions under which PBR may be revoked on surrender.

Item 24 provides that the Registrar's decision under section 52 to revoke or not to revoke PBR is reviewable by the AAT.

# Trade Marks Act 1995

### Item 25: Reader's Guide

[Summary of this Act]

This item clarifies in the Reader's Guide to the Act that Parts 7, 8 and 9 also deal with how the registration of a trade mark may be revoked.

### Items 26 to 50, 53 to 63: Refusal of applications

[Appendix, ss 11, 31, 33, 35, 39, 40 to 44, 57, 58A, 63, 84C, 176, 177, 187]

These items amend a number of provisions to better align terminology across the IP rights. At present, an application for registration of a trade mark may be rejected under section 31. The amendments replace the term 'reject' with 'refuse' to better align with the terminology used in designs and patents (and PBR as proposed to be amended), where an application may be refused. The process and grounds for refusing an application, and for opposing registration, do not change.

### Item 51: Notice of renewal due

[s 76]

This item repeals the requirement for the Registrar to notify the registered owner of a trade mark that a renewal request is due. At present the Registrar must notify all owners that have not made a request at the prescribed period of two months before registration expires. This is regardless of whether the owner uses a trade mark attorney or annuity service that has its own renewal reminder system, and so does not need to receive such notices. By contrast, the designs, patents and PBR legislation does not require renewal reminder notices to be sent. This amendment removes the requirement to issue notices in all cases and instead it will be IP Australia's practice to issue reminder notices to those customers that need to or wish to receive them.

### Item 52: Cancellation of registration

[s 84]

This item amends subsection 84(1) to better align the terminology across the IP rights. At present a registered owner may request that their trade mark be cancelled. This amendment replaces such as request with an offer to surrender registration, which may result in cancellation. This amendment provides a process that is more consistent with designs, patents and PBR.

# Division 2 – Application and transitional provisions

### Item 64: Designs

Item 64(1) provides that the amendments to subsection 47(2) and (3) apply to applications for renewal made on or after commencement. Item 64(2) provides continuity in relation to the approved form for applications for renewal. That is, the regulations in force for the purposes of subsection 47(3) immediately before commencement continue to apply to subsection 47(3) as amended.

### Item 65: Patents

This item provides that all the amendments made in this Part apply in relation to anniversaries occurring on or after commencement and for which a continuation fee or renewal fee had not been paid before commencement. This means that any continuation or renewal fee that is due after commencement but has been paid before the prescribed period has been paid correctly. It is not subject to the new prescribed period. Also, the clarification of the status of an application or patent during the renewal grace period applies to anniversaries occurring on or after commencement.

### Item 66: PBR

Item 66(1) provides that the amendments to section 30, to replace the term 'reject' with 'refuse', apply to all pending and new applications as of commencement. Applications resolved immediately before commencement continue to be subject to the term 'reject'.

Item 66(2) provides that the amendments to subsection 51(2), to provide that a PBR 'ceases' if the annual fee is not paid within the prescribed period, apply to anniversaries occurring on or after commencement and for which the annual fee had not been paid before commencement. That is, any PBR for which the annual fee was not paid by the last day of payment before commencement remains known as 'surrendered'. Also, any annual fee due after commencement but paid before commencement has been paid correctly.

Similarly, item 66(3) provides that the consequential amendments to paragraphs 51(3)(a) and (b), to replace 'surrender' with 'cessation', apply to PBR that ceases on or after commencement. PBR that ends under subsection 51(2) before commencement remains known as 'surrendered'.

Item 66(4) provides that the amendments to section 52, to clarify the process and align the terminology for voluntarily surrendering PBR, apply to offers to surrender made on or after commencement. Offers to surrender made before commencement remain known as 'surrendered' and are not subject to the amended process.

### Item 67: Trade marks

Item 67(1) provides that the amendments to section 11, 31, 33, 39, 40, 41, 42, 43, 44 and 63, to replace the term 'reject' with 'refuse', apply to applications for registration made on or after commencement and to those made before commencement but still pending. Such applications may be refused by the Registrar rather than rejected. Applications made and decided on before commencement remain subject to the term 'reject'.

Item 67(2) provides continuity in relation to reports and responses that use the term 'reject'. For pending applications made before commencement, any adverse report of the Registrar under section 31 issued before commencement, and any response from the applicant before commencement, is taken to be in relation to grounds for 'refusing' the application. This avoids the Registrar or applicant having to re-issue reports and responses using the new terminology.

Item 67(3) provides that the amendments to section 35, to provide that the Registrar's decision to 'refuse' an application may be appealed to the courts, applies to decisions of the Registrar made on or after commencement. Appeals to decisions made before commencement continue to be in relation to decisions to 'reject' the application.

Item 67(4) provides that the amendments to section 84, to replace requests to cancel with offers to surrender, apply to offers made on or after commencement.

Items 67(5) and (6) provide continuity in relation to requests to cancel. A request to cancel that was pending immediately before commencement is taken to be an offer to surrender. Similarly, a notice given

by the Registrar to other parties before commencement in relation to a request to cancel is taken to be in relation to an offer to surrender. This avoids the parties having to re-issue requests or notices using the correct terminology.

Item 67(7) relates to the amendment to subsection 84C(5), to enable the Registrar to 'refuse' an application without examining it again after revoking registration and acceptance. It applies to revocation of acceptance on or after commencement. It also applies to revocation of acceptance before commencement where no decision to reject the application had been made by the Registrar before commencement. That is, the Registrar may decide to 'refuse' such an application after commencement.

Item 67(8) provides that the amendments to section 176 and 177, to replace 'reject' with 'refuse' in relation to certification trade marks, applies to applications for registration made on or after commencement, and to those made before commencement but still pending. As for item 67(1), such applications may be refused by the Registrar rather than rejected. Applications made and decided on before commencement remain subject to the term 'reject'.

Item 67(9) provides continuity for reports and responses in relation to certification trade marks that use the term 'reject'. As for item 67(2), any adverse report of the Registrar under section 31 issued before commencement, and any response from the applicant before commencement, is taken to be in relation to grounds for 'refusing' the application.

Similar to items 67(1) and (8), item 67(10) provides that the amendments to section 187, to replace 'reject' with 'refuse' in relation to defensive trade marks, applies to applications for registration made on or after commencement, and to those made before commencement but still pending. As with items 67(2) and (9), item 67(11) provides that any adverse report of the Registrar under section 31 issued before commencement, and any response from the applicant before commencement, is taken to be in relation to grounds for 'refusing' the application.

# Part 2 – Examination, re-examination and reconsideration

# Division 1 - Amendments

## Introduction

Part 2 of Schedule 1 contains a number of amendments to improve IP Australia's processes for reviewing IP rights applications and registrations. The designs, patents, plant breeder's rights and trade mark systems have mechanisms for the Registrar or Commissioner to review an accepted application or a registered/granted/certified right. Re-examination is a formal process for reviewing an IP right. Revocation is the act of cancelling the registration of the right, and may be the result of a re-examination. These mechanisms allow for review on the Registrar's or Commissioner's own initiative, or at the request of a third party.

The review mechanisms of the different IP rights essentially have the same purpose: to enable reconsideration of certain aspects of an accepted application or a granted IP right without the expense and delay in bringing opposition or court proceedings. However, the legislation and practices governing the review mechanisms have a number of problems and vary between the rights in a number of aspects, including:

- the steps in the process;
- the transparency of the process; and
- the payment of fees.

Unsuitable processes and unnecessary differences between the IP rights create inefficiencies for users of these mechanisms and increase administration costs for IP Australia. These items address these problems through a number of amendments.

## Designs Act 2003

### Items 68 to 84: Designs Act

These items amend the Designs Act to provide a re-examination process for registered designs.

Currently it is possible for a design that has been examined and certified to be examined again on request or on the Registrar's initiative. This may result in revocation of the design. However, the process of such 'subsequent' examinations is not as transparent as it could be and is not aligned with the review mechanisms of the other IP rights. These items amend the Designs Act to create a formal re-examination process that may result in revocation of a registered design. The introduction of a re-examination process will better align the designs review process with the other three IP rights and clarify for users how a registered design may be reviewed.

### Item 68: Definition of *examination*

[s 5]

This item replaces the reference to section 65 in the definition of 'examination' with a more correct reference to section 63.

### Item 69: Definition of *re-examination*

[s 5]

This item inserts a definition of 're-examination' into the list of definitions in section 5. This definition is referenced by new Part 3A on the new re-examination process, as introduced by item 81.

### Item 70: Definition of *relevant parties*

[s 5]

This item provides a new definition of 'relevant parties' to include parties both in relation to the examination or re-examination of a design, as a consequence of the new re-examination process introduced by item 81.

### Item 71: Simplified outline

[s 9]

This item inserts 're-examining' into the outline of section 9 as a consequence of the new re-examination process being introduced by item 81.

### Item 72: Ceasing of registration

[s 48(1A)]

This item inserts new subsection 48(1A) to provide that a design automatically ceases if, at the end of the period prescribed for the re-examination process, the owner has not requested a hearing and there are grounds to revoke the design. This is similar to the cessation of the registration of a design during the examination process under subsection 48(1)(a). The prescribed period will be sufficient to resolve the majority of cases. This system of automatic cessation is to encourage owners to engage in the re-examination process and attempt to address the ground of revocation. While a decision to revoke may be appealed, there is no appeal against cessation. Revocation can only occur either under subsection 68G(1) after a hearing has been held or under subsection 68G(2) after amendments have been requested and the prescribed period has ended.

### Item 73: Ceasing of registration

[s 48]

This amendment is a consequence of the introduction of subsection 48(1A) by item 72. It provides that if a design ceases during examination under subsection 48(1), or during re-examination, any certificate of examination that was in force at the time the registration ceased is taken to be revoked at that time.

### Item 74: Chapter 5 – Examination and re-examination of designs

This item provides a new heading for Chapter 5 to reflect that it covers both the examination process and the new re-examination process.

### Items 75 to 77: Simplified outline

[s 62]

These items amend section 62 to account for the new re-examination process.

Item 76 also clarifies that designs may be examined or re-examined upon a court order. This aligns with section 63(1) and new section 68A(2)(b) introduced by item 81.

### Item 78: When examination is to be conducted

This item provides a new heading for Part 2 to reflect that examination may commence in more than one way.

### Item 79: Examination of design

[s 63]

This item inserts new subsection 63(2A) to provide that the examination provisions only apply where a certificate of examination has not been issued. After a design has been certified the new re-examination process may be used to review the registrability of the design.

### Item 80: How examination is to be conducted

This item provides a new heading for Part 3 to better reflect its contents.

### Item 81: Re-examination

[ss 68A, 68B, 68C, 68D, 68E, 68F, 68G]

This item inserts new provisions setting out the process for re-examination.

[s 68A]

Section 68A sets out how re-examination may commence after a certificate of examination has been issued. Subsection 68A(1) provides that the Registrar may re-examine the design on his or her own initiative. Subsection 68A(2) provides that if any person requests, or a court orders, that the Registrar re-examines the design, the Registrar must do so. This clear obligation on the Registrar makes the re-examination process transparent to users.

Subsections 68A(3) and 68A(4) provide that, if relevant proceedings in relation to a registered design are pending, the Registrar must not re-examine or continue to re-examine the registered design unless a court orders the Registrar to do so. It is appropriate that the Registrar wait for the outcome of relevant proceedings before commencing or proceeding with a re-examination.

[s 68B]

Section 68B provides that a request for re-examination must satisfy any requirements prescribed by the regulations. It is expected that the requirements will include that the request must be in the approved form and set out the grounds on which re-examination is sought.

[s 68C]

Section 68C sets out what the Registrar must do in re-examining a registered design. The Registrar must consider whether a ground for revocation exists. The grounds for revocation of the registration of a

registered design are: (a) the design is not a registrable design; (b) any other ground prescribed by the regulations. These grounds are the same as those considered by the Registrar during examination under subsection 65(2).

[s 68D]

Section 68D sets out what the Registrar must do if no ground for revocation exists. If re-examination has been conducted on the Registrar's own initiative or by court order, and the Registrar is satisfied that no ground for revocation has been made out, the Registrar must make a determination to that effect and notify the relevant parties. Relevant parties are to be defined in section 5 (per item 70). As the re-examination was not requested by another person there is no need to provide that person with the opportunity to dispute the Registrar's finding.

Where re-examination has been conducted on request, and the Registrar considers that there is no ground for revocation, subsection 68D(3) allows a relevant party to file a statement disputing the Registrar's finding. Subsection 68D(4) provides that the Registrar may give a copy of the statement to each other relevant party. This provides a fair and transparent process. Subsection 68D(5) provides that if no statement is filed, or both a statement is filed and the Registrar remains satisfied that no ground for revocation has been made out, the Registrar must notify the relevant parties of the determination. The Registrar's determination may be appealed to the Federal Court or the Federal Circuit Court.

[s 68E]

Section 68E sets out what the Registrar must do when a ground for revocation exists. Subsection 68E(1) provides that if the Registrar is satisfied that a ground for revocation of the registration of the design has been made out, the Registrar must notify the relevant parties to that effect. Subsection 68E(2) allows the registered owner of the design to then do one or more of three things: (a) file a statement disputing the ground for revocation; (b) request that the Registrar amend the Register; (c) file a request for a hearing.

Subsection 68E(3) sets out that, if the registered owner files a statement disputing the ground for revocation, the Registrar must reconsider the ground for revocation. If the Registrar considers that a ground for revocation still exists, the Registrar must notify the registered owner, who may provide further responses to the Registrar.

Subsections 68E(4) to 68E(7) sets out the process for requesting amendment of the Register. Subsection 68E(4) requires that a request must be made in accordance with the regulations. Subsection 68E(5) provides that the Registrar must consider and deal with the request in the manner prescribed by the regulations. Subsection 68E(6) sets out the restrictions on amendments, mirroring those in subsection 66(6) in regards to examination. An amendment must not increase the scope of the design registration; or alter the scope of the registration by the inclusion of matter that was not in substance disclosed in the original design application, representations or other documents. Subsection 68E(7) provides that if the Registrar is satisfied that the ground for revocation would not be removed, the Registrar may notify each other relevant party of the details of the proposed amendments. This enables a transparent process where appropriate. The notifying of amendments that would remove the ground for revocation is dealt with under section 68F.

[s 68F]

Section 68F sets out the process for amending the Register. If the proposed amendments would remove the ground for revocation, the Registrar must notify the relevant parties about the amendments and give them an opportunity to be heard. If the Registrar remains satisfied that the amendments would remove the ground, the Registrar must record the amendments and notify the relevant parties. However, if after hearing the parties the Registrar considers that the ground is not removed, the registered owner may

respond or request other amendments under section 68E. The Registrar's decision on amendments may be appealed to the Federal Court or the Federal Circuit Court. This provides a fair and transparent amendment process for all the parties.

[s 68G]

Section 68G sets out the process for revoking registration.

Subsection 68G(1) provides that, if a hearing has been held and grounds for revocation exist, the Registrar must revoke the design.

Subsection 68G(2) provides for the circumstances where if, in the course of re-examining a registered design, the Registrar has provided the registered owner with notification that a ground for revocation has been made out and the registered owner requests amendments, the Registrar considers that these overcome the grounds for revocation, the prescribed period ends without the design ceasing under subsection 48(1A) or a hearing being requested, but then after hearing the relevant parties the Registrar considers that there are grounds to revoke. In this situation the Registrar must revoke the design. This ensures that a design for which there are grounds to revoke does not remain registered.

Subsection 68G(3) requires the Registrar to publish a notice stating that the registration of design has been revoked and that the design is taken never to have been registered. This mirrors subsection 68(3) in regards to revocation after examination.

Subsection 68G(4) provides that the Registrar must not revoke a design while relevant proceedings are pending, similar to subsection 68(5) in regards to examination.

Subsection 68G(5) provides that the Registrar's decision to revoke a design may be appealed to the Federal Court or the Federal Circuit Court, similar to subsection 68(6) in regards to revocation after examination.

### Items 82 and 83: Certain material may be provided to Registrar

[s 69]

Item 82 expands subsection 69(1) to provide that certain material may be provided to the Registrar even if a person has not made an examination request, or a re-examination request.

Item 83 expands subsection 69(4) to provide that the Registrar is not required to examine a design under Part 3, or re-examine a design under Part 3A, when certain material is provided.

### Item 84: Amendments of Registrar

[s 115]

This item amends paragraph 115(a) to account for the new re-examination process. It provides that, if the Registrar decides to revoke a design under a number of situations including during re-examination, or a court orders a revocation, the Registrar must make an entry in the Register stating that the registration of the design has been revoked and that the design is taken never to have been registered.

## Patents Act 1990

### Items 85 to 100: Patents Act

These items amend the Patents Act to improve the re-examination process.

Re-examination is available for both standard and innovation patents. Re-examination may be initiated by the Commissioner at any time, or requested by third parties at any time after grant (for standard patents) or certification (for innovation patents). Re-examination involves a report being issued to both the applicant/patentee and the requestor, with the applicant being given the opportunity to provide a written statement before the Commissioner decides the outcome of the re-examination. After re-examination the Commissioner may refuse an accepted application or may revoke a granted patent. Re-examination of a standard patent is completed when certain conditions are met. However, no conditions exist for the conclusion of re-examination of an innovation patent other than the possibility of the Commissioner initiating revocation proceedings.

There are several problems with this approach:

- the process is unrealistic in that it assumes that only a single re-examination report is issued by the Commissioner, and that the applicant has a single opportunity to respond;
- the timeframes for re-examination and means by which issues are to be resolved are not clear; and
- there is no equivalent mechanism to complete re-examination on an innovation patent in the same manner as a standard patent.

These items amend the re-examination process for standard and innovation patents to allow for multiple reports and responses from the applicant within a fixed time period. This provides a realistic iterative process with a clear fixed timeframe to resolve issues.

### Items 85 and 86: When re-examination ends

These items amend subsection 97(3) to provide when the re-examination of a standard patent ends. This provides for clear and the timely conclusion of the re-examination process.

### Items 85 and 98: Court directed re-examination

[ss 97, 101K]

These items insert new subsections 97(3AA) and 101K(1A) to provide that if a re-examination is directed by a court, it may also be ended by a court direction. This is to enable a court to obtain a first re-examination report from the Commissioner and then stop re-examination so the court proceedings can continue.

### Items 86 and 94: Re-examination of specifications

[ss 97(3A), 101G(1A)]

These amendments provide that the regulations may prescribe when the re-examination ends in relation to a standard patent and an innovation patent. This enables a clearer period for the resolution of issues during re-examination.

### Item 87: Re-examination of complete specifications

[s 97]

This item repeals subsection 97(5) because relevant proceedings is to be prescribed in the regulations as one of the conditions on which re-examination ends.

### Items 88 to 90 and 95: Reports on re-examination

[ss 98, 101G]

These items amend sections 98 and section 101G to provide that there may be more than one re-examination report for standard and innovation patents. Items 89, 90 and 95 insert new subsections 98(2) and 101G(5) to make it clear that re-examination of standard and innovation patents can involve multiple reports and responses. The Commissioner must give a copy of a report to the applicant or patentee.

### Item 91: Statement by applicant or patentee

[s 99]

This item substitutes a new section 99 to provide that, before the re-examination of a standard patent ends, the applicant or patentee may file a statement disputing the whole or any part of the Commissioner's adverse report. The filing of the statement may be made regardless of whether voluntary amendments under subsection 104(1), or amendments by direction under section 106 or 107, are filed.

### Item 92: Refusal to grant patent

[s 100A]

This item amends subsection 100A(2) to add the condition that, before grant, the Commissioner cannot refuse to grant a standard patent unless the re-examination has ended. Conditions for the revocation of a granted patent are provided by section 101 as amended by item 93 below.

### Item 93: Revocation of patent

[s 101]

Similar to item 92, this item amends subsection 101(2) to add the condition that, after grant, the Commissioner must not revoke a standard patent unless the re-examination has ended.

### Item 96: Statement by patentee

[s 101H]

This item substitutes a new section 101H to provide that, before the re-examination of an innovation patent ends, the patentee may file a statement disputing the whole or any part of the Commissioner's report on revocation of the patent. This mirrors section 99 for standard patents.

### Item 97: Revocation of innovation patent

[s 101J]

This item amends subsection 101J(3) to add the condition that the Commissioner must not revoke an innovation patent unless the re-examination has ended. This mirrors the provision of section 101(2) as amended by item 93 above for standard patents.

### Item 99: Relevant proceedings and re-examination

[s 101K(3)]

This item substitutes a new subsection 101K(3) to set out a condition when the Commissioner must not re-examine an innovation patent. Similar to the repeal of subsection 97(5) for standard patents, this amendment removes the requirement for the Commissioner to discontinue re-examination if relevant proceedings are started, as this will be covered in the regulations prescribing when re-examination ends for the purposes of subsection 101G(1A).

At present, complexities arise if there is an opposition pending and re-examination is requested for the same patent. As it is most efficient to complete the opposition first, the new subsection 101K(3) provides that if an opposition is pending, the Commissioner must not re-examine the innovation patent. A similar provision is not necessary for standard patents because under subsection 97(1) the Commissioner has the discretion whether to re-examine an accepted specification and would not do so if an opposition is pending.

### Item 100: Copies of report to be given to court

[s 101L]

This item is a consequence of item 95 introducing subsection 101G(5). This item replaces a reference in section 101L to provide that a copy of the multiple reports issued during re-examination directed by a court must be given to the court that gave the direction.

## Plant Breeder's Rights Act 1994

### Items 101 to 114: Plant Breeder's Rights Act

The PBR Act does not have explicit provisions for re-examination, although re-examination is the usual result of pre- or post-grant oppositions, particularly if a further test growing is required under paragraph 37(1)(c). The PBR Act allows for revocation of a granted PBR and outlines in section 50 a number of steps to be followed. However, the process is not as transparent as it could be and is not aligned with the review mechanisms of the other IP rights.

These items amend the PBR Act to create a formal re-examination process that may result in revocation of a granted right under section 50. Additionally, in accordance with Part 21 of this Bill, the relevant powers of the Secretary of the Department of Industry, Innovation and Science under the PBR Act are devolved to the Registrar of PBR.

### Item 101: Definitions

[s 3]

This item inserts a definition of 'relevant proceedings' into section 3. This definition is referenced by new subsection 49A(3) to determine when re-examination must not occur. Relevant proceedings are those in a court or in the AAT that relate to the grant, infringement or revocation of PBR.

### Items 102 to 107: Terminology

[ss 37, 48]

Items 102 to 106 replace the term 'revocation' with 're-examination' in various provisions as a consequence of the re-examination process being introduced by item 108. Item 107 similarly amends paragraph 48(2)(a) to replace the concept of applying for revocation with requesting re-examination under new section 49A.

## Item 108: Re-examination of Plant Breeder's Right

[ss 49A, 49B, 49C]

This item inserts new provisions setting out the process for re-examination.

Section 49A sets out how re-examination may commence and end. Subsection 49A(1) provides that the Registrar may re-examine the PBR in a plant variety on his or her own initiative. This is similar to how the Secretary may currently revoke PBR on his or her own initiative under section 50. Subsection 49A(2) provides that, if a person whose interests are affected by the grant of the PBR in a variety makes a request in the approved form that the Registrar re-examine the PBR, and pays the fee, the Registrar must do so. Currently, under subsection 50(8) a person whose interests are affected by the grant of PBR may apply to the Secretary for the revocation of that right, however there is no clear obligation on the Secretary to consider such an application. This amendment helps to make the re-examination process transparent to users.

Subsection 49A(3) provides that, if relevant proceedings in relation to a PBR are pending, as defined in section 3, the Registrar must not re-examine the PBR. It is appropriate that the Registrar wait for the outcome of relevant proceedings before commencing or proceeding with a re-examination.

Subsection 49A(4) provides that re-examination ends at a time prescribed in the regulations. This is to ensure that the issue is resolved in a timely manner.

Section 49B sets out how re-examination is to be conducted. Subsection 49B(1) provides that, if the Registrar re-examines on his or her own initiative, the Registrar must consider those matters referred to in paragraph 44(1)(b) as the Registrar considers appropriate. This allows the Registrar to more efficiently focus on those criteria for grant of PBR that are at issue, rather than be obliged to re-examine each and every criteria. Similarly, subsection 49B(2) provides that, if the Registrar re-examines on request from a person, the Registrar must consider those matters referred to in paragraph 44(1)(b) as specified in the person's request, and such other matters the Registrar considers appropriate.

Subsection 49B(3) provides that the Registrar may produce multiple reports in relation to the re-examination of PBR in a plant variety. Subsection 49C(1) enables the grantee to give a statement to the Registrar disputing an adverse report. These provisions enable the Registrar and grantee to provide each other with multiple reports and responses to resolve the issues. Subsections 49B(4) and 49C(2) require the Registrar to give copies of the reports and the grantee's statements to the other parties, to provide a transparent process.

## Item 109: Revocation of PBR

[s 50]

This item substitutes a new subsection 50(1) to set out the provisions when the Registrar must revoke. Subsection 50(1) provides that, after a re-examination has ended, and facts existed that, if known before the grant, would have resulted in the refusal to grant that right; or the grantee has failed to pay a fee for the right within 30 days after the notification, the Registrar must revoke PBR in the variety. Requiring re-examination to end first ensures that the grantee has sufficient time to resolve any issues.

Subsection 50(1A) deals with the revocation of a declaration that a plant variety is essentially derived from another plant variety, as previously dealt with under subsection 50(1).

However, under current subsections 50(4) and 50(5), the Registrar must give the grantee, or the right assignee, particulars of the grounds of the proposed revocation, and they have 30 days to make a written statement to the Registrar in relation to the proposed revocation.

### Item 110: Revocation of PBR

[s 50]

This item repeals subsection 50(8) as no longer needed because item 108 provides that an interested person may request re-examination under subsection 49A(2).

### Item 111: Revocation of PBR

[s 50]

This item removes a reference to subsection 50(8) as a consequence of item 110. The payment of a fee when requesting re-examination is now dealt with in subsection 49A(2).

### Items 112 and 113: Revocation of PBR

[s 50]

These items insert a new subsection to separately provide that if the Registrar decides not to revoke PBR in a plant variety where paragraph (1)(a) applies; and a person had requested the re-examination, the Registrar must notify that person of the decision and the reason within seven days of making that decision. As a consequence, item 112 removes reference to the Registrar making such a decision from subsection 50(10).

These amendments better differentiate in the legislation between revocation of PBR and revocation of a declaration of essential derivation. They also account for the Registrar deciding not to revoke PBR in light of any written statement provided by the grantee to the Registrar under paragraph 50(4)(b).

### Item 114: Revocation of PBR

[s 77]

This item replaces the term ‘revocation’ with ‘re-examination’ as a consequence of the re-examination process introduced by item 108. The Registrar’s decision under paragraph 37(2B)(b) to not proceed with a request for re-examination may be reviewed by the AAT.

## Trade Marks Act 1995

### Items 115 and 116: Revocation of acceptance and registration

[ss 38, 84A]

These amendments improve transparency of the processes for revocation of acceptance of a trade mark application and for revocation of registration. Item 115 relates to revocation of acceptance and item 116 relates to revocation of registration.

Section 38 provides that the Registrar may revoke acceptance of an application. Section 84A provides that the Registrar may revoke registration of a trade mark. Items 115 and 116 introduce new subsections to provide that a revocation of acceptance or registration may be initiated by the Registrar or requested by a person. If the latter, the request must be in the approved form; and set out the grounds on which the revocation is sought. It is intended that a person requesting revocation must also pay a fee, to be set out in the regulations, to reflect the service being provided.

If the request meets these requirements the Registrar must consider whether to revoke. If, for example, grounds for revocation are not provided with the request, then the Registrar is under no obligation to consider it. The Registrar must notify the relevant parties of the decision to revoke or not to revoke the acceptance or registration and the reasons for the decision. These requirements clarify the obligations on the Registrar, and provide a more transparent revocation process.

Item 116 also repeals subsection 84A(6) as being inconsistent with the new requirement on the Registrar to consider a properly made request for revocation of registration.

# Division 2 – Application, saving and transitional provisions

### Item 117: Designs

Item 117(1) provides that the new re-examination provisions inserted by Part 3A of Chapter 5 apply to all designs registered before, on or after the commencement. That is, any certified design may be re-examined under the new re-examination provisions.

Item 117(2) provides that if, before commencement, an examination request or a court order had been made, or the Registrar had initiated examination, new subsection 63(2A) does not apply in relation to the design. That is, the 'subsequent' examination under section 63 of a certified design is not precluded and so may continue.

### Item 118: Patents

This item provides that the amendments to the patent re-examination provisions apply to all re-examinations instituted by the Commissioner on or after the commencement, on his or her own initiative, or on request, or by court order. All re-examinations instituted by the Commissioner before commencement continue to follow the previous law.

### Item 119: PBR

Item 119(1) provides that the new re-examination provisions inserted by Division 1A of Part 4 apply to PBR in a plant variety granted before, on or after the commencement. That is, any granted PBR may be re-examined under the new re-examination provisions.

Item 119(2) provides, however, section 50 of the *Plant Breeder's Rights Act 1994*, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to any of the following situations occurred before that commencement:

(a) a notice mentioned in paragraph 50(1)(b) that the grantee had failed to pay fee; or

(b) particulars of the grounds of a proposed revocation given to a person under paragraph 50(4)(a); or

(c) an application for revocation of PBR or of a declaration of essential derivation made under subsections 50(8) or (9).

Item 119(3) provides that the amendments do not affect the validity of a revocation made before the commencement.

### Item 120: Trade marks

Item 120(1) provides that the new revocation provisions in section 38 apply to acceptances on or after the commencement, regardless of whether the applications for registrations were made before, on or after the commencement.

Item 120(2) provides that the new revocation provisions in section 84A apply to registrations on or after the commencement. Acceptances and registrations before commencement continue to follow the current law before amendments.

# Part 3 – Extensions of time and protection of third parties

# Division 1 – Amendments

## Introduction

IP rights holders and applicants can apply to extend a number of time periods in the IP legislation under various circumstances. Some extensions are required under international treaties. The extension of time system needs to balance the interest of IP applicants and rights owners, who may risk losing their rights by not completing actions on time, with the interests of third parties, who need certainty about whether IP rights are in force.

There are three broad issues with the extension of time system. The first issue is the differences in the number and types of extensions available between the IP rights. This increases complexity and confusion as to which extension is applicable and what evidence is required for supporting the request in a given situation. The second issue is the administrative burden placed on customers and IP Australia. Short extensions rarely have a significant impact on third parties, yet require the same declarations from applicants and assessment by IP Australia as long extensions. The third issue is that the protection for third parties that used an invention or trade mark while the IP application or right was lapsed or ceased can be inadequate or burdensome to obtain.

These items address these issues through a number of amendments.

The main changes are:

- repeal the 'despite due care' extension for patents;
- remove the Commissioner's and Registrar's discretion for all general extensions, for all rights. This will simplify the process and ensure compliance with the Patent Law Treaty and Patent Cooperation Treaty;
- require all requests for extensions to be filed within two months of the removal of the cause of the failure to comply, to ensure there are no unreasonable delays;
- improve the compensation for third parties that use inventions when a patent lapsed or ceased to reduce the burden on third parties;
- expand the protection against infringement for third parties that use a trade mark while it was ceased to include while a trade mark application was lapsed;
- introduce a streamlined process for short extensions, but ensure IP Australia can review and remake a decision on an extension of time;
- prevent applicants from obtaining consecutive 'short' extensions for the same action;
- provide general extensions and corresponding third party protection for PBRs.

## Designs Act 2003

### Item 121: List of definitions

[s 5]

This item adds new terms "new day", "original day" and "relevant act" to the list of definitions in the Designs Act.

"Original Day" will mean the day before the end of which the relevant act was originally required to be done.

"New day" carries the meaning given by paragraph 137A(2)(b) as inserted by item 127. This is the day specified by the applicant before the end of which the applicant seeks to do the relevant act.

The concepts of original day and new day are introduced to ensure that the length of extensions are based on the initial due date for a relevant act, rather than on the most recent extended day. This is to prevent users from abusing the system by obtaining consecutive 'short' extensions for the same action to avoid fees and appropriate scrutiny.

Extensions of time are available for all "relevant acts", which are all actions except for those prescribed in the regulations or court proceedings.

## Items 122 and 123: Period of lapsing and review by AAT

[s 33, s 136]

These items provide more appropriate references to the relevant extension of time provisions under the amended Act.

## Items 124 to 126: Extensions of time – errors/omissions by the Registrar etc

[s 137]

Items 124 and 125 amend the heading and formatting for new section 137 to restructure the extension of time provisions. Item 126 amends section 137 so that it only deals with extensions of time relating to an error or omission made by the Registrar or Deputy Registrar; an employee of the Designs Office or a person providing or proposing to provide, services for the benefit of the Designs Office. Section 137 will set out the same provisions as current subsection 137(1). This extension ensures that applicants and owners are not disadvantaged by errors made by IP Australia. Requests for extensions of time for deadlines missed because of errors or omissions by the applicant, or circumstances beyond the applicant's control, are dealt with under new section 137A inserted by item 127.

## Item 127: Extensions of time – new provisions

[s 137A, s 137B, s 137C, s 137D, s 137E]

Item 127 replaces current subsections 137(2) to (7) repealed by item 126 above with new general extension of time provisions.

- ***Extensions of time – errors/omission by applicant or agent or circumstances beyond control***

New section 137A deals with extensions of time sought because of an error or omission made by the applicant; or because of circumstances beyond the applicant's control. Extensions are only available for relevant acts as defined in section 5 by item 121 above.

Subsections 137A(1) and (2) set out the requirements for an application for an extension of time. The application must be made in accordance with the regulations, be made within the prescribed period, and be accompanied by the prescribed fee. It is intended that the regulations will prescribe a period of two months from either the applicant becoming aware of the error or omission or from the circumstances which prevented the act from being done in time, ceasing to exist. The two-month period is itself able to be extended where warranted. This will ensure that requests for extensions of time are filed promptly. The application must also specify the day (the *new day*) before the end of which the applicant seeks to do the relevant act; set out the ground on which the application is made (that is, either of the above situations);

and include a statement justifying the extension sought. The statement will need to specify details of the error or omission made, or of the circumstances beyond the control of the applicant.

Currently, in accordance with paragraph 11.13(1)(b) of the regulations, all applications for extensions of time require a signed declaration to support them. For new paragraph 137A(2)(a), it is intended that the regulations will prescribe that an application must be in an approved form. A declaration will be needed when it is required by the approved form. IP Australia proposes to only require declarations for extensions longer than three months. For short extensions, a statement justifying the extension will be sufficient. These amendments will simplify the process for short extensions of time.

- ***Extensions of time – extension sought is 3 months or less***

New section 137B provides a streamlined process for situations where the extension period sought is three months or less.

— *New automatic acceptance of requests*

Short extensions rarely have a significant impact on third parties, yet currently require the same supporting signed declaration from applicants and the same assessment by IP Australia as long extensions. Where IP Australia has insufficient time to consider an extension request before the requested period ends, the process of informing the requestor that a longer period must be requested and a larger fee paid can sometimes be repeated, causing unnecessary costs and delays.

To address the administrative burden on customers and IP Australia, these items introduce a streamlined process for applications for short extensions of three months or less.

Applications for extensions will be automatically checked by a computer system under the provisions of section 135A as inserted by Part 9 of the Intellectual Property Laws Amendment Bill 2017. If the application meets the requirements of subsection 137A(2) it will be published without being assessed by a person.

Subsection 137B(1) requires the Registrar to publish various details about the application for a short extension, in accordance with new section 148A (that is, on IP Australia's website or by any other electronic means).

Examples are provided at the end of 137B(1) to demonstrate how the length of extensions will be calculated. Where the applicant seeks a further extension that results in the new day being more than three months from the original day, the further extension is treated as a long extension under section 137C.

Currently, short extensions are not advertised before grant and may not be opposed by another person. The amendments made by item 127 will allow a person to object to the grant of a short extension. As provided by new subsection 137B(2), he or she may do so by giving a notice of objection in accordance with the regulations. It is intended that the regulations will provide that the notice of objection must be made in the approved form and within a prescribed period of one month beginning from the date of publishing the application for an extension of time under subsection 137B(1). This amendment will improve the transparency of short extensions for third parties. If the extension needed to include the objection period is longer than three months then it is subject to the long extension provisions of section 137C.

— *No objections*

If there are no objections, subsection 137B(4) provides that the Registrar must grant an extension and specify the period of the extension; or refuse to grant an extension. As noted above, IP Australia proposes to automate this process. It is anticipated that the majority of applications for short extensions of time will not be objected to, resulting in a more efficient process.

Subsection 137B(5) requires the Registrar to notify the applicant of his or her decision on the application.

— *Objections*

Subsection 137B(6) sets out the obligations on the Registrar if there are objections to the grant of extension. An objection is simpler than an opposition and does not invoke the opposition procedures in Chapter 11 of the Designs Regulations. However, paragraph 137B(6)(a) provides the applicant and each person who objected, an opportunity to be heard on the matter.

A person who is a delegate of the Registrar will assess the application and grant the extension or refuse to grant the extension under paragraph 137B(6)(b). Assessment of the application by a delegate of the Registrar is warranted where a third party has objected to the grant of the extension. The Registrar must give a copy of the notice of objection to the applicant as quickly as reasonably possible under subsection 137B(3).

Subsection 137B(7) provides that the Registrar must notify the applicant and each person who objects to the grant of the extension of his or her decision on the application.

— *Grounds for extension*

At present, when considering whether to grant an extension, the Registrar must take into account a number of factors. These include the purpose of the extension, private and public interests, whether there was an unnecessary delay in seeking the extension, and whether third party protection is available when a ceased design was exploited. This complicates the process for all parties without changing the outcome in most cases.

To address this problem, the amendments remove the Registrar's discretion on whether to grant extensions by replacing 'the Registrar may extend the time' with 'the Registrar must extend the time'. Subsection 137B(8) provides that the Registrar must extend the time if all criteria are met. This simplifies the decision making process for all parties. If the criteria are not met, subsection 137B(9) provides that the Registrar must refuse to extend the time for doing an act.

— *Beginning of extension*

Subsection 137B(10) provides that the beginning of the extension period granted under this section is the day after the original day. This ensures that subsequent extensions are calculated from the original due date rather than from the last extended date.

- ***Extension of time – extension sought is more than 3 months***

New section 137C inserts provisions for extensions of more than three months. This type of request will continue to follow the current process, where a person with the Registrar's delegation will assess the request before advertising it to give third parties an opportunity to oppose it. New subsection 137C(1) provides that the Registrar must publish, in accordance with section 148A, various details about the application for an extension.

Examples are provided at the end of this subsection to demonstrate the application of this provision.

As for current subsection 137(5), subsection 137C(2) provides that a person may oppose the grant of an extension within one month of publication, as prescribed by the regulations.

Similar to current subsection 137(6), subsection 137C(4) provides an exception to the above process. Where the Registrar considers that an extension would not be granted, the Registrar must not make a publication under subsection (1), and must refuse to grant an extension.

— *No opposition*

If no-one opposes, subsection 137C(5) provides that the Registrar must grant an extension and specify the period of the extension; or refuse to grant an extension.

Subsection 137C(6) requires the Registrar to notify the applicant of his or her decision on the application.

— *Opposition*

If there is an opposition to the extension application, subsection 137C(3) requires the Registrar to give a copy of the notice of opposition to the applicant as quickly as reasonably possible.

Subsection 137C(7) sets out the obligations on the Registrar if one or more persons oppose the grant of an extension. Paragraph (7)(a) provides that the Registrar must grant, or refuse to grant, an extension; and if an extension is granted, the Registrar must specify the period of the extension under paragraph (7)(b).

An opposition to the grant of an extension of time of more than three months continues to invoke the opposition procedures under Regulation 11.24.

Subsection 137C(8) provides that the Registrar must notify the applicant and each person who opposed the grant of the extension of his or her decision on the application.

— *Grounds for extension*

Similar to short extensions, the amendments remove the Registrar's discretion on whether to grant extensions so that subsection 137C(9) provides that the Registrar must extend the time where the criteria are met.

Where the criteria are not met, subsection 137C(10) provides that the Registrar must refuse to extend the time for doing an act.

— *Beginning of extension*

Similar to short extensions, subsection 137C(11) provides that the beginning of the extension period granted under this section is the day after the original day. This ensures that subsequent extensions are calculated from the original due date rather than from the last extended date.

- ***Extensions before or after time for doing relevant act expired***

Similar to current subsection 137(3), new section 137D provides that an extension of time may be granted whether before or after the time for doing an act has ended. This is to protect owners from the complete loss of designs rights due to missed deadlines. However, once the applicant becomes aware of a missed deadline because of an error or omission of the applicant, or circumstances beyond the control of the applicant, the applicant will have the obligation to file a request for an extension of time within the prescribed period, which is intended to be set at two months in the regulations for paragraph 137A(2)(e). This is to ensure there are no unreasonable delays.

- ***Giving notice of extension***

New section 137E sets out the obligations on the Registrar when an extension of time is granted. The Registrar must publish, in accordance with section 148A (that is, on IP Australia's website, or by any other electronic means), details of the extension as the Registrar considers appropriate.

### Items 128 to 131: Consequences of extension and protection of third parties

[s 138, s 139]

These items are consequential to the amendments set out in item 121, which specifies the definition of a *relevant act* in section 5.

Consequences of an extension and protection of third parties continue to operate under the current provisions of sections 138 and 139 respectively.

## Patents Act 1990

### Items 132 to 134: List of definitions

[s 3]

These items add new terms “new day”, “original day” and “relevant act” to the list of definitions. Their meanings are given in Schedule 1 as amended by item 145 below. These terms are referenced by sections 223A, 223B and 223C inserted by item 143.

The new terms are introduced to provide that applicants cannot obtain consecutive short extensions for the same act. Whether an extension is short or long is calculated from the initial date the act was due to be done, not from the last extended date.

### Items 135, 136, 138 and 139: Protection of third parties

[s 41, s 150]

These items improve the protection of third parties in relation to patent applications for micro-organisms and patent applications for associated technology as defined in the *Nuclear Non-Proliferation (Safeguards) Act 1987*.

Items 135 and 136 amend section 41 which relates to applications that lapse as a result of not meeting the micro-organism deposit requirements and are subsequently restored.

Items 138 and 139 amend section 150 which relates to ‘secret’ defence related applications that lapse and are subsequently restored.

The new subsections provide a person with the right to exploit the invention or to ‘dispose’ of the whole of the right to another person without infringing the patent if that person had started to exploit or took definite steps to exploit the invention after the application had lapsed but before it is subsequently restored. However, this right excludes the granting of a licence to another person to exploit the invention.

A person that disposes of the invention to another person no longer has a right to exploit it. This is to ensure that the right to exploit is limited to the person who uses the invention while the patent has lapsed before it is restored, or to the person this right is disposed to.

### Item 137: Consequential Amendments

[s 42]

This item amends subsection 42(3) to include references to new sections 223A to 223H introduced by item 143.

## Items 140 and 141: Extensions of time – errors/omissions by Commissioner etc.

[s 223]

Item 140 amends the heading for new section 223 to restructure the extension of time provisions. New section 223 will continue to deal with errors or omissions made by the Commissioner or person at the Patents Office, Receiving Office or International Bureau as currently set out in subsection 223(1). This extension ensures that applicants and owners are not disadvantaged by errors made by IP Australia or the International Bureau. Requests for extensions of time for deadlines missed because of errors or omissions by the applicant, or circumstances beyond the applicant's control, are dealt with under new section 223A inserted by item 143.

Item 141 inserts a note at the end of new section 223 to make a reference to the meaning of a *relevant act* which is defined in Schedule 1 as amended by item 145. Extensions are only available under section 223 for relevant acts, which are all acts under the legislation except for those prescribed in the regulations.

## Items 142 and 143: Extensions of time – new provisions

[s 223A, s 223B, s 223C, s 223D, s 223E, s 223F, s 223G, s 223H]

Item 142 repeals current subsections 223(2) to (11) and item 143 replaces these with new provisions.

- ***Extensions of time – error/omission by applicant or agent or circumstances beyond control***

New section 223A deals with extensions of time sought because of an error or omission by the applicant; or because of circumstances beyond the applicant's control.

Currently, extensions are available under subsection 223(2A) where a person does not do an act in time despite taking due care. This extension was primarily introduced to ensure consistency with Article 12 of the Patent Law Treaty and Regulation 49.6 of the Patent Cooperation Treaty. It has been little used by applicants and it complicates the extension of time system. These items remove this type of extension. To ensure consistency with international obligations, the amendments outlined below require applications to be filed promptly and remove the Commissioner's discretion to grant extensions of time for an error or omission.

New subsections 223A(1) and (2) set out the requirements for an application for an extension of time. Similar to Designs, it is intended that the regulations will prescribe a period of two months from either the applicant becoming aware of the error or omission or from the circumstances which prevented the act from being done in time, ceasing to exist.

Currently, all applications for extensions of time are required to be accompanied by a signed declaration. Paragraph 223A(2)(a) provides that the application must be in an approved form. Paragraph 223A(2)(e) provides that a declaration is needed only if it is required by the approved form. An extension longer than three months will require a declaration. For short extensions, a statement justifying the extension will be sufficient. These amendments will simplify the process for short extensions of time.

- ***Extensions of time – extension sought is 3 months or less***

New section 223B provides a streamlined process for situations where the extension period sought is three months or less.

— *New automatic acceptance of requests*

Similar to Designs, applications for short extensions will be automatically checked by a computer system under the provisions of section 223J as inserted by Part 9 of the Intellectual Property Laws Amendment Bill 2017. If the application meets the requirements of subsection 223A(2) it will be published without being assessed by a person.

Currently, short extensions are not advertised before grant and cannot be opposed by another person. Under the amendments, a person may object to the grant of a short extension by giving a notice of objection, in the approved form, within the prescribed period. It is intended the regulations will set the period at one month beginning on the date of the publication. This change improves the transparency of short extensions for third parties. From a practical perspective, usually the extension will only need to cover the period from when a relevant act was required to be done and the day it was actually done e.g., the payment of a renewal fee. However, where the extension is required to permit the Commissioner to do an act or make a decision i.e., accept a patent request and complete specification relating to an application for a standard patent, and where the Commissioner can't do that act or decision until the objection period is over, then a longer extension period will need to be sought. If the extension needed to include the objection period is longer than three months, then it is subject to the long extension provisions of section 223C.

— *No objections*

If there are no objections, subsection 223B(4) provides that the Commissioner must grant an extension and specify the period of the extension; or refuse to grant an extension. As noted above, IP Australia intends to automate this process. It is anticipated that the majority of applications for short extensions of time will not be objected to, resulting in a more efficient process.

— *Objections*

If there is an objection to the extension application, subsection 223B(3) requires the Commissioner to give a copy of the notice of objection to the applicant as quickly as reasonably possible.

Subsection 223B(6) sets out the Commissioner's obligations if there are objections to the grant of extension. An objection does not invoke the opposition procedures in Chapter 5 of the Patents Act and Regulations. However, paragraph 223B(6)(a) provides the applicant and each person who objected an opportunity to be heard on the matter.

A person who is a delegate of the Commissioner will assess the application and grant the extension or refuse to grant the extension under paragraph 223B(6)(b). Assessment of the application by a delegate of the Commissioner is warranted where a third party has objected to the grant of the extension.

— *Grounds for extension*

At present, when considering whether to grant an extension, the Commissioner may take into account a number of factors. These include the public interest, whether there had been undue delay in seeking the extension, and whether protection is available to parties that exploited a lapsed application or ceased patent. Amendments to section 223 clarify this situation wherein key discretionary considerations are being made explicit requirements. For example, under 223A(f) by setting a prescribed period for filing the extension request, and under proposed 223A(2)(c) and (d) by requiring grounds and a justifying statement to be filed with the request.

Accordingly, given key discretionary considerations are being made explicit requirements, the amendments remove the Commissioner's discretion on whether to grant extensions by replacing 'the Commissioner may extend the time' with 'the Commissioner must extend the time'.

Where the criteria are met, the Commissioner must extend the time. This simplifies the decision making process for all parties and ensures compliance with Australia's international obligations under the Patent Law Treaty and the Patent Cooperation Treaty regarding extensions of time.

— *Beginning of extension*

Subsection 223B(10) provides that the beginning of the extension period granted under this section is the day after the original day. This ensures that subsequent extensions are calculated from the original due date rather than from the last extended date.

- ***Extension of time – extension sought is more than 3 months***

New section 223C inserts provisions for extensions of more than three months. This type of request will continue to follow the current process, where a person with the Commissioner's delegation will assess the request before advertising it to give third parties an opportunity to oppose it. New subsection 223C(1) provides that the Commissioner must publish the fact and details of the application in the Official Journal.

Examples are provided at the end of this subsection to demonstrate the application of this provision.

As for current subsection 223(6), subsection 223C(2) provides that a person may oppose the grant of an extension within the prescribed period, which is intended to be set in the regulations as within two months of publication, as prescribed by subregulation 5.10(2).

Similar to current subsection 223(6A), subsection 223C(3) provides an exception to the above process. Where the Commissioner considers, on the balance of probabilities, that an extension would not be granted, the Commissioner must not make a publication under subsection (1), and must refuse to grant an extension.

— *No opposition*

If no-one opposes, subsection 223C(4) provides that the Commissioner must grant an extension and specify the period of the extension; or refuse to grant an extension.

Subsection 223C(5) requires the Commissioner to notify the applicant of his or her decision on the application.

— *Opposition*

Subsection 223C(6) sets out the obligations on the Commissioner if one or more persons oppose the grant of an extension. Paragraph (6)(a) provides that the Commissioner must grant, or refuse to grant, an extension; and if an extension is granted, the Commissioner must specify the period of the extension under paragraph (6)(b).

An opposition to the grant of an extension of time of more than three months continues to invoke the opposition procedures in Chapter 5 of the Patents Act and regulations.

Subsection 223C(7) provides that the Commissioner must notify the applicant and each person who opposes the grant of the extension of his or her decision on the application.

— *Grounds for extension*

As for short extensions, the amendments remove the Commissioner's discretion on whether to grant extensions by replacing 'the Commissioner may extend the time' with 'the Commissioner must extend the time'. Where the criteria are met, subsection 223C(8) provides that the Commissioner must extend the

time. If the criteria are not met, subsection 223C(9) provides that the Commissioner must refuse to extend the time for doing an act.

— *Beginning of extension*

As for short extensions, subsection 223C(10) provides that the beginning of the extension period granted under this section is the day after the original day. This ensures that subsequent extensions are calculated from the original due date rather than from the last extended date, so as to prevent repeated short extensions.

- ***Extensions before or after time for doing relevant act expired***

Similar to current subsection 223(3), new section 223D provides that an extension of time may be granted whether before or after the time for doing an act has ended. This is to protect owners from the complete loss of valuable patents due to missed deadlines. However, once the applicant becomes aware of a missed deadline because of an error or omission, or circumstances beyond control, the applicant must file a request for an extension of time within the prescribed period, which is intended to be set at two months in the regulations for paragraph 223A(2)(f). This is to ensure there are no unreasonable delays.

- ***Giving notice of extension***

New section 223E sets out the Commissioner's obligation to give notice of when an extension of time is granted by publishing the details of the extension in the Official Journal as the Commissioner considers appropriate.

- ***Restoration of patent application or patent***

New section 223F provides for the restoration of a lapsed patent application or a ceased patent on the day an extension of time has been granted. The treatment of a provisional patent is dealt with under subsection 223G.

Subsection 223F(2) requires the Commissioner to notify the applicant or patentee, and publish the fact of the restoration in the Official Journal.

Consistent with current subsection 223(10), subsection 223F(3) provides protection for third parties from infringement proceedings for acts done in the period between the patent application lapsing (or the patent ceasing) and it being restored.

- ***Provisional patent application treated as not lapsing***

Similar to current subsection 223(8), new subsection 223G(1) provides that a lapsed provisional patent application must be treated as if it had not lapsed if the period prescribed for section 38 is extended. Subsection 223G(2) sets out the obligation of the Commissioner to notify the applicant of this fact and publish the restoration in the Official Journal.

- ***Protection of third parties***

New section 223H sets out general provisions for the protection of third parties if a patent application or patent is restored under section 223F.

Currently, under subsection 223(9) and subregulation 22.21(2), a person exploiting an invention or who took definite steps to exploit it in the period between the patent application lapsing or patent ceasing and its later restoration must seek a license from the Commissioner to exploit the invention. However, another party may oppose the granting of the licence. This creates uncertainty and an unreasonable burden on the

third party who acted reasonably and made no error. This approach is also inconsistent with that taken in other major jurisdictions.

To address this issue, new section 223H introduces automatic protection for third parties who start to exploit an invention or takes definite steps to do so after the patent lapses, and removes the requirement to seek a licence from the Commissioner to do so. Limiting protection to parties that begin exploiting the invention after lapsing of the patent application ensures that parties who infringe on the patent at other times are not protected.

Consistent with current subsection 223(9), section 223H applies if an application under section 223A is filed and the Commissioner grants an extension of more than three months, or an extension of time for doing a prescribed act in prescribed circumstances. The paying of renewal fees will continue to be prescribed for this purpose.

Current subsection 223(9) provides protection only where the person exploited or took definite steps to exploit the invention *because* the act had not been done in time. In practice this requires the person to have been aware that the particular application or patent in question had lapsed or ceased. This is too limiting because it is reasonable to protect any person who began using an invention when no patent was in force. Also, requiring a person to be aware of the patent can penalise those who conduct due diligence searches but fail to identify the patent in question due to the complexities of the patent system. New subsection 223H(2) addresses this by not requiring the person who started to exploit or took definite steps to exploit to know that the patent had lapsed.

Subsections 223H(2) and (4) provide that a person has the right to exploit the invention or has the right exploit it for a period and then 'dispose' the whole of the right to another person. There is no right to dispose part of the right e.g., for a particular region and continue exploiting otherwise. Subsections 223H(3) and (5) provide that a person that disposes of the invention to another no longer has a right to exploit it. Subsection 223H(6) prohibits the granting of licences to ensure that the right to exploit the invention is contained. Subsection 223H(7) provides protection to third parties defined in subsections (2) or (4), so that these specified actions are not considered infringement of the patent.

The new protection provisions reduce the uncertainty and burden for third parties and better align Australia with other major jurisdictions.

### Item 144: Review of decisions

[s 224]

This item is consequential upon item 143. It amends paragraph 224(1)(a) to provide that a decision to grant or not grant an extension continues to be reviewable by the AAT.

### Item 145: Dictionary

[Schedule 1]

This item inserts definitions of "new day", "original day" and "relevant act" in Schedule 1.

The use of these concepts will clarify that applicants cannot obtain consecutive short extensions for the same act. Whether an extension is short or long is calculated from the initial date the act was due to be done, not from the last extended date.

Only "relevant acts" may be extended. IP Australia proposes that the regulations will prescribe that general extensions will continue to not be available for:

- most opposition periods, which are covered by separate provisions;
- filing an application for an extension of term for a pharmaceutical patent if the term of the patent has expired; and
- periods relating to the registration of patent attorneys.

# Plant Breeder's Rights Act 1994

## Item 146: Definition of new terms

[s 3]

Similar to the other IP rights, this item adds the new terms "new day", "original day" and "relevant act" to the list of definitions in the PBR Act. The use of these concepts will help to clarify that applicants cannot obtain consecutive short extensions for the same act.

## Items 147 to 152: Extension of period to meet certain requirements

[s 34, s 40, s 44]

These items remove the specific extensions in the PBR Act and replace them with the new general extension provisions inserted by item 153.

Currently there are only three specific actions for which an extension of time may be granted by the Secretary of the Department:

- Subsection 34(1) provides that the Secretary may extend the 12 month period in which an applicant must file a detailed description of the variety after acceptance of the application. Such extensions are typically granted because it takes more than 12 months to grow a variety and thereby obtain a detailed description.
- Paragraph 40(8)(b) provides that the Secretary may extend the 30 day period in which a PBR grantee must establish that a second variety is not an essentially derived variety.
- Subsection 44(6) provides that the Secretary may extend the 30 day period in which an applicant has to respond to an objection.

Note that Part 21 of the *Intellectual Property Laws Amendment Bill 2017* devolves the Secretary's powers and obligations under the PBR Act to the Registrar.

The limited number of extensions available under the PBR Act puts PBR stakeholders at a disadvantage compared with other IP rights stakeholders and could lead to loss of rights due to simple errors being made. To align with the other three IP rights, these items replace the specific extensions with references to the new general extension of time process in section 76D introduced by item 153 below. The Registrar's decisions on extensions of time continue to be reviewable by the AAT.

## Item 153: New extension of time provisions

[s 76B, s 76C, s 76D, s 76E, s 76F, s 76G, s 76H]

This item inserts sections 76B to 76H to introduce the new general extensions of time provisions for PBR.

Currently, PBR extensions are available for only a limited number of actions as listed above, unlike patents, trade marks and designs, which have extensions applying to a broad range of statutory actions and circumstances.

To overcome this inconsistency, this item introduces general extension provisions similar to those being introduced for the other IP rights. Similar to the other rights, the new provisions apply to all actions, other than prescribed actions, that are required to be done within a certain time. It is intended that the Regulations prescribe which actions would be excluded.

- ***Extensions of time – errors/omissions by the Registrar or person assisting Registrar***

New section 76B deals with extensions of time sought because of an error or omission by the Registrar or person assisting the Registrar. This extension ensures that applicants and owners are not disadvantaged by errors made by IP Australia.

- ***Extensions of time – errors/omissions by applicant or agent or circumstances beyond control***

- *Application requirement*

Similar to Patents and the other IP rights, new section 76C(2) specifies the requirements of the application for an extension of time, which includes payment of the prescribed fee. However, paragraph 76C(3)(a) provides that the payment of fees is not required for requesting an extension to the 12 month period in which a detailed description must be filed under section 34. It would be unreasonable to impose a fee given the applicant has no influence over the growing time for the variety. Paragraph 76C(3)(b) enables certain relevant acts to be exempt from payment of a fee, where such relevant acts would be prescribed in the regulations in the future. It is intended that for all other acts, a fee would be payable and would be prescribed by the regulations in accordance with subparagraph 80(2)(a)(ii) as inserted by item 156 below.

- *Processing of requests*

Unlike the other IP rights, the PBR Act does not require declarations from applicants, nor provide opposition procedures. Therefore section 76D sets out only one process for extensions of time, regardless of length. However, IP Australia proposes to streamline shorter extensions of three months of less by using a computer to assess them.

Subsection 76D(1) requires the Registrar to give public notice of the fact that an application for an extension has been made. However, if the Registrar considers that an extension would not be granted, under subsection 76D(4), the Registrar must not give public notice , and must refuse to grant an extension.

Under new subsection 76D(2), a person may object to the grant of an extension by giving the Registrar a notice of objection, in the approved form, within the prescribed period, which is intended to be set in the regulations at 1 month beginning on the date of the publication of the application for extension.

Similar to the other IP rights, it is intended that requests for extensions of three months or less would be automatically checked by the computer system under the provisions of section 76J as inserted by Part 9 of the Intellectual Property Laws Amendment Bill 2017. If the application meets the requirements of subsection 76C(2) it will be published without being assessed by a person. If no person objects, the computer system will grant the extension.

For extensions of more than three months, or where a person has objected to the grant of a shorter extension, a person with the Registrar's delegation will assess the application.

- *No objections*

If there are no objections, subsection 76D(5) provides that the Registrar must grant an extension and specify the period of the extension; or refuse to grant an extension.

Subsection 76D(6) requires the Registrar to notify the applicant of his or her decision on the application.

- *Objections*

If there is an objection to the extension application, subsection 76D(3) requires the Registrar to give a copy of the notice of objection to the applicant as quickly as reasonably possible.

Subsection 76D(7) provides that, if a person objects to the grant of the extension, the Registrar must give the applicant and the opponent an opportunity to be heard. The Registrar must grant, or refuse to grant, an extension and must specify the period of the extension if it is granted. Subsection 76D(8) requires the Registrar to notify the applicant of his or her decision on the application.

- *Grounds for extension*

Subsection 76D(9) and (10) provide that the Registrar must extend the time, or refuse to extend the time for doing a relevant act. That is, the Registrar does not have the discretion to refuse an extension if the relevant criteria are met.

- *Beginning of extension*

Subsection 76D(11) provides that the beginning of the extension period granted is the day after the original day. This ensures that subsequent extensions are calculated from the original due date rather than from the last extended date.

- ***Extensions before or after time for doing relevant act expired***

Similar to the other IP rights, new section 76E provides that an extension of time may be granted whether before or after the time for doing an act has ended. This is to protect owners from the complete loss of PBR due to missed deadlines.

- ***Giving notice of extension***

New section 76F sets out the obligations on the Registrar when an extension of time is granted. The Registrar must give public notice of the details of the extension as the Registrar considers appropriate.

- ***Consequences of extension and protection from infringement proceedings***

New section 76G sets out the consequences of an extension in relation to a PBR application or a granted PBR.

Subsection 76G(1) provides that where an application is taken to have been withdrawn or PBR in a plant variety ceases due to the failure to do an act, and the time for doing the act is extended, the application or PBR is taken to have been restored on the day an extension is granted.

Subsection 76G(2) requires the Registrar to notify the applicant or grantee of PBR, and give public notice of the restoration.

Subsection 76G(3) provides that infringement proceedings cannot be brought in respect of an infringement committed between the day an application or a PBR is taken to be withdrawn or ceased and the day the application or PBR is restored. This is in alignment with the provisions for patents and other IP rights.

- ***Protection of third parties***

New section 76H sets out protection of third parties, similar to the protections provided under the Patents Act at 223H. This section applies where an application for the grant of PBR is taken to have been withdrawn under subsection 34(2), or a PBR in a plant variety ceases, and is later restored under section 76G because the Registrar grants an extension of time under section 76C.

The amendments introduce automatic protection for third parties who *started* to exploit the plant variety, or took definite steps to do so while the PBR application was withdrawn or when the PBR in the plant variety ceased.

It is not a requirement that the person who started doing these actions did so accordingly because they knew that the PBR in the plant variety was withdrawn or ceased.

The person has the right to exploit the plant variety or to 'dispose' of it to another person. A person that disposes of the right to exploit the plant variety to another person no longer has a right to exploit it. The granting of licences to exploit the plant variety is not permitted.

### Items 154 and 155: Review of extension decisions

[s 77]

Item 154 is consequential upon items 147 to 150. A decision to grant or not grant an extension continues to be reviewable by the AAT.

### Item 156: Application fees for extension of time

[s 80]

This item provides that fees are payable for requests for extensions of time under section 76C, and may be prescribed by the regulations.

## Trade Marks Act 1995

### Items 157 to 160: Definition of new terms

[Readers guide, s 6]

Similar to the other IP rights, these items add new terms "new day", "original day" and "relevant act" to the list of terms used in the Act. This is to provide that applicants cannot obtain consecutive short extensions for the same act.

Extensions of time are available for all "relevant acts", which can be any act or the filing of any document except for those prescribed in the regulations, and any proceedings except for court proceedings.

### Item 161: Lapsing of application

[s 37]

This item is consequential upon items 164 to 167 to include the new extension of time provisions for extending the period within which an application may be accepted.

### Item 162: Protection against infringement for third parties

[s 128]

This item amends section 128 to expand the circumstances in which an infringement action may not be brought.

New subsection 128(4) provides that no action can be taken against an action that infringes a trade mark if that action is done after a trade mark application lapses (if not accepted in time) under subsection 37(1) and before the end of the last day of the extended period.

Similarly, new subsection 128(5) provides the same protection but for trade mark applications that lapse under subsection 54A(1) (where no notice to defend the application is filed).

This reduces the uncertainty and burden for third parties and better aligns the protection provisions across IP rights.

### Item 163: Lapsing of application

[s 222]

This item is consequential upon item 167, which sets out the provision for opposing an extension of time under subsection 224C(2).

### Items 164 and 165: Extensions of time relating to errors or omissions by the Registrar and Trade Mark Office

[s 224]

These items amend the heading and formatting for new section 224 to restructure the extension of time provisions. Section 224 deals with errors or omissions made by the Registrar or a Deputy Registrar, an employee or the Trade Marks office and sets out a similar provision as current subsection 224(1). This extension ensures that applicants and owners are not disadvantaged by errors made by IP Australia. Requests for extensions of time for deadlines missed because of other circumstances are dealt with under new section 224A inserted by item 167.

### Items 166 and 167: New extension of time provisions

[s 224A, s 224B, s 224C, s 224D, s 224E]

Item 166 repeals current subsections 224(2) to (8) and item 167 replaces these with new provisions.

The amendments introduce new general extensions of time provisions for Trade Marks, similar to those for Designs, Patents and PBR, see above.

However, unlike the other IP rights, the trade marks legislation also provides for 'special circumstances' as a ground on which an application for an extension of time can be made. To clarify which circumstances may constitute special circumstances, IP Australia proposes to provide guidance in a notifiable instrument. This will assist applicants in differentiating between special circumstances and circumstances beyond the applicant's control.

New section 224B introduces a streamlined process for short extensions to provide that:

- similar to the other IP rights, where no objections are filed IP Australia intends to use computerised decision making under the provisions of section 222A as inserted by Part 9 of the Intellectual Property Laws Amendment Bill 2017. If the application meets the requirements of subsection 224A(2) it will be published (in accordance with section 230A) without being assessed by a person. Assessment of the application for extension would only occur if the Registrar chose to review a computerised decision under subsection 222A(4) or if there was a notice of objection filed.

- third parties may object to short extensions within one month of publishing the details of the application.

- if there is an objection, the Registrar must give the applicant and the objector an opportunity to be heard. The general hearing process would apply as currently governed by regulations 21.15 and 21.16 with the relevant fees. This would prevent third parties from manipulating the system to introduce unnecessary delays, yet allow the opportunity to be heard where it was warranted.

New section 224C inserts provisions for extensions longer than three months. This type of request will continue to follow the current process, where a person with the Registrar's delegation will assess the request before advertising it to give third parties an opportunity to oppose it. The Registrar must meet the publication requirement and a person may oppose the grant of an extension within one month of publication.

Similar to short extensions, the Registrar must extend the time if the criteria are met, and must refuse to extend the time if the criteria are not met. The Registrar's decision to grant or not grant an extension is to be reviewable by the AAT.

Similar to current subsection 224(4), new section 224D provides that an extension of time may be granted whether before or after the time for doing an act has ended. This will protect owners from the complete loss of valuable trade marks due to missing deadlines. However, the request for an extension of time must be filed within the prescribed period to comply with new paragraph 224A(2)(f). As above for designs, the Registrar must publish the details of a granted extension of time application as the Registrar considers appropriate.

### Item 168: Regulations

[s 231]

This item corrects the references made to oppositions.

## Division 2 – Application, saving and transitional provisions

### Item 169: Designs

The principles underpinning the application provisions are that the proposed changes will only apply to requests for extensions of time filed on or after commencement. The current law continues to apply to requests that are filed before commencement.

Details of the application, saving and transitional provisions are provided by this item under sub-items (1) to (5).

### Item 170: Patents

The proposed changes will only apply to requests for extensions of time filed on or after commencement. The current law continues to apply to requests that are filed prior to commencement. Details are provided by this item under sub-items (1) to (7).

### Item 171: Plant breeder's rights

The proposed changes will only apply to requests for extensions of time filed on or after commencement. The current law continues to apply to requests that are filed prior to commencement. Details are provided by this item under sub-items (1) to (3).

### Item 172: Trade marks

As noted above, the principles underpinning the application provisions are that the proposed changes would only apply to requests for extensions of time filed on or after commencement. The current law would continue to apply to requests that are filed prior to commencement. Details are provided under sub-items (4) to (6).

Sub-items (1) and (2) provide that the protection against infringement for third parties under subsections 128(4) and 128(5) applies to third parties who use a trade mark from a lapsed application that had its status changed to 'lapsed' on or after commencement.

Sub-item (3) provides that section 222 continues in force on and after commencement in relation to a notice of opposition given under subsection 224(6) before, on or after the commencement.

# Part 4 – Written requirements

# Division 1 - Amendments

## Introduction

The IP legislation contains a number of requirements for IP Australia to undertake certain actions in writing, such as notifying parties about events and deciding that an innovation patent meets the requirements for certification. These requirements create unnecessary complexity and inflexibility in how actions are to occur. It also results in different requirements across the four IP rights.

As IP Australia adopts further electronic systems for administering the IP rights and for keeping customers informed, there is increasingly less need to give notices or perform actions in writing. Such requirements may prevent IP Australia from using more efficient and appropriate means of communication and administration into the future.

This Part addresses these issues through a number of amendments to give IP Australia the flexibility to take actions or give information in any means of communication, including by electronic means.

The main changes are:

- replacing the terms 'notice', 'tell', 'advise' and 'inform' with the more general terms 'notification' or 'notify'
- replacing 'send' with 'give', to include making information electronically available; and
- removing unnecessary requirements to give information or do things 'in writing'.

## Designs Act 2003

### Items 173 and 174: Minimum filing requirements for design applications

[s 24]

These items set out the process where an application does not meet the minimum filing requirements, and the consequences if they remain unmet. The requirement for the Registrar to 'give a written notice' that an application does meet the minimum filing requirements is replaced by a 'notification' to the applicant.

### Items 175 to 184, 186: Notification requirement

[ss 41, 42, 43, 66]

These items remove the requirement for the Registrar to give a notice 'in writing' to the applicant or the owner of the design about a deficiency or a refusal. Instead, the Registrar is required to 'notify' the relevant persons by any means of communication (including by electronic means) as provided by item 192.

Consequential amendments are also made to replace 'notice' with 'notification'.

### Items 190 and 191: Other notification provisions

[ss 69, 138]

These items substitute the terms “inform” and “advise” with the term “notify” to provide more consistent language in the legislation.

### Items 185, 187 to 189: Notifying the relevant person of the final outcome of examination

[ss 52, 67, 68]

These items simplify the requirement for the Registrar to notify relevant parties of the revocation and certification of a design. The requirement that the Registrar must ‘give the relevant parties a notice’ is replaced by a requirement to ‘notify the relevant parties’.

### Item 192: Notifications by Registrar under this Act or regulations

[s 144D]

This item inserts a new section to provide that, if the Registrar is required or permitted to notify a person of a matter or of a thing the person is required to do, the Registrar may do so by any means of communication (including by electronic means).

## Patents Act 1990

### Items 193 and 194: Notifying matters affecting validity of standard and innovation patents

[ss 27, 28]

These items change the Commissioner’s obligations when a person notifies the Commissioner under sections 27 and 28 that an invention is not patentable or an innovation patent is invalid. These items also clarify that the copy of a document may be made available to the applicant or patentee electronically.

Currently subsections 27(2) and 28(4) require the Commissioner to inform the applicant or patentee ‘in writing’ of such a notice and to ‘send’ the applicant a copy of any document accompanying the notice. This creates inflexibility in the manner that the Commissioner may give such notice and uses inconsistent terminology.

To address these issues, items 193 and 194 repeal subsections 27(2) and 28(4) and insert new provisions. New subsections 27(2) and 28(4) provide that the Commissioner must ‘notify’ the applicant of any matter under subsections 27(1) and 28(1). New subsections 27(2A) and 28(4A) provide that the Commissioner may ‘give’ the copy of a document by making the copy available electronically and notifying the person, consistent with subregulation 1.3(5) of the Patent Regulations. This regulation provides that the Commissioner may ‘give’ a document to a person by making the document available in electronic form and notifying the person that the document is available.

### Items 195 to 198: Other written notification provision

[ss 49, 74, 76]

These items remove the requirement for the Commissioner to make certain notifications ‘in writing’.

Currently, paragraphs 49(5)(a), subsection 49(7), paragraphs 74(2)(a) and (4)(a), and subsection 76(2) require that the Commissioner notify or inform an applicant/patentee 'in writing' of the outcome of an examination. This creates unnecessary complexity and inflexibility.

These amendments address this problem by removing the requirement for these notifications to be 'in writing'. The Commissioner may notify relevant persons by any means of communication (including by electronic means), as provided by section 220A (item 201). This makes the manner in which the Commissioner may inform or notify the applicant/patentee more flexible, and provides the adaptability to future developments in communications technology.

### Items 199 and 200: Deciding to certify an innovation patent

[s 101E]

Item 199 amends paragraph 101E(1)(a) to remove the requirement that a decision of the Commissioner to certify an innovation patent be made 'in writing'.

Following substantive examination of an innovation patent, the Commissioner must decide whether it meets the relevant criteria. This is similar to the process for the other rights. However, paragraph 101E(1)(a) of the Patents Act requires the Commissioner to 'decide in writing' whether the innovation patent meets the relevant criteria. This is in contrast with standard patents and the other IP rights where the form of a decision to accept, refuse, revoke or certify is not specified.

This amendment addresses this problem by removing the requirement that a decision of the Commissioner to certify an innovation patent be made 'in writing'. The decision itself must still be made, but the Commissioner is not restricted in the form the decision takes.

Item 200 is consequential upon item 199.

### Item 201: Notifications by Commissioner under this Act

[s 220A]

This item inserts a new section to provide that, if required or permitted, the Commissioner may notify a person of a matter or a thing to do, by any means of communication (including by electronic means). This gives the Registrar the required flexibility and adaptability into the future as modern communication technology develops.

## Plant Breeder's Rights Act 1994

### Items 215 to 217: Notifying the relevant person of the final outcome of examination

[s 30]

These items remove the requirement for the Secretary to notify relevant parties of the final outcome of examination 'in writing'. Note that Part 21 of the Bill devolves the powers and obligations of the Secretary of the Department to the Registrar.

Currently, the Secretary is required to 'give written notice to the applicant' of the final outcome of examination of an application. This is either notification of acceptance under paragraph 30(4)(a) or notification of rejection under paragraph 30(5)(a). Specifying that the notice must be a written notice creates unnecessary complexity and rigidity.

These amendments address this problem by changing the provisions from 'give written notice to the applicant' to simply 'notify the applicant'. The means for notifying is provided by item 264 (that is, any

means of communication, including electronic). This increases the flexibility of the manner in which the Registrar may notify the relevant parties of the outcome of an examination.

### Items 202 to 214, 218 to 229, 236, 237 to 239, 254 to 263: Other written notification provisions

[ss 19, 21, 32, 37, 39, 41, 44, 50]

These items remove the requirement for certain notifications given by the Secretary to be in written form. Instead, the Registrar is required to 'notify' the relevant persons (by any means of communication provided by section 72A as inserted by item 264. This increases flexibility in the manner in which the Registrar may inform or notify relevant persons.

Consequent amendments are also made to substitute 'notice' with 'notification'; and 'give notice of' with 'notify' to simplify the language.

### Items 230 to 235, 265: Other notifications

[ss 37, 77]

These items replace the requirement for a 'notice' to be 'sent', 'served' or 'issued' with a 'notification' to be 'given'. This gives IP Australia the required flexibility and adaptability into the future regarding of the means a notification may be given as modern communication technology develops.

### Items 240 to 253: Applications for declarations of essential derivation

[s 40]

These items amend section 40 to remove the requirement for the Secretary to inform the applicant 'in writing' about his or her decision on an application for declarations of essential derivation. Items 242 to 245 substitute 'inform the applicant … in writing' with 'notify the applicant'. Items 246 to 253 replace 'by notice in writing given to' with 'notify'. This simplifies the language and provides flexibility in the manner in which the Registrar may notify the applicant (by any means of communication including electronic means).

Items 240 and 241 amend subsection 40(6) to better structure the provision.

### Item 264: Notifications by Registrar

[s 72A]

This item inserts a new section to provide that, if required or permitted, the Registrar may notify a person of a matter or a thing to do by any means of communication (including by electronic means). This gives the Registrar the required flexibility and adaptability into the future as modern communication technology develops.

## Trade Marks Act 1995

### Item 267: Notifying of the final outcome of examination

[s 34]

This item removes the requirement for the Registrar to notify the applicant of the final outcome of examination 'in writing'.

Currently, under paragraph 34(a) the Registrar is required to 'notify the applicant in writing' of the final outcome of examination of an application. Specifying that the notice must be in writing creates unnecessary complexity and rigidity.

This amendment addresses this problem by changing the text from 'notify the applicant in writing' to simply 'notify the applicant'. The means of 'notifying' is provided by section 214A as inserted by item 276. This increases flexibility in the manner in which the Registrar may notify the applicant of the outcome of an examination.

### Items 266, 268 to 270, 274: Other notification

[ss 34, 77, 80C, 80E, 111]

These items substitute the term 'notice' with the more general 'notification'. Notifications can be made by any means of communication (including electronic) as provided by section 214A (item 276).

### Items 271 and 272: Revocation of registration

[s 84A]

These items make changes to the Registrar's obligations when revoking registration. Item 271 provides that the Registrar must give 'notification' instead of 'notice' to the registered owner. The notification may be given by any means of communication (including electronic means) as provided by section 214A. This increases flexibility in the manner in which the Registrar may notify the owner of the revocation decision.

The notification must be given within 12 months of registering the trade mark. The period is specified in subsection 84A(4). Item 272 removes an unnecessary reference to the regulations.

### Item 273: Notification of application for removal of trade mark from Register

[s 95]

This item substitutes the requirement for the Registrar to give 'notice' of an application under section 92 with give 'a copy' of the application. This change removes the rigidity of the requirement and provides flexibility in the manner in which the Registrar may notify relevant persons.

### Item 275: Other written notification provisions

[s 176]

This item removes the requirement for certain notifications given by the Registrar to the applicant of a certification trade mark to be in written form.

Currently, paragraph 176(3)(a) requires that the Registrar 'give to the applicant notice in writing' of the decision to accept or reject a certification trade mark. Specifying 'notice in writing' creates unnecessary complexity and inflexibility.

### Item 276: Notifications by Registrar

[s 214A]

This item inserts a new section to provide that, if required or permitted, the Registrar may notify a person of a matter or a thing to do, by any means of communication (including by electronic means). This gives the Registrar the required flexibility into the future as modern communication technology develops.

# Division 2 – Application and saving provisions

### Item 277: Designs

Item 277(1) provides that the amendments to sections 24, 41, 42, 43, 52, 66 to 69 and 138 apply in relation to notifications on or after the commencement.

Item 277(2) provides that the *Designs Act 2003* as in force immediately before the commencement, continues to apply on and after commencement in relation to a notice given under subsection 24(1) or (2), section 41, paragraph 52(3)(a), subsection 66(2) or 67(2) or paragraph 68(2)(a) before that commencement. That is, the current requirements for the Registrar to give notices or perform actions in writing continue to apply to notices given before commencement.

### Item 278: Patents

This item provides that the amendments to sections 27, 28, 49, 74 and 76 of the *Patents Act 1990* apply in relation to notifications on or after the commencement.

### Item 279: Plant breeder's rights

Item 279(1) provides that the amendment to paragraph 19(6)(b) applies in relation to invitations made on or after the commencement. That is, all invitations given by the Secretary or Registrar on or after commencement need not be a written form.

Item 279(2) provides that the amendments of paragraph 19(7)(b), subparagraph 19(9)(b)(i) and sections 21, 30, 32, 37, 39, 40, 41, 44 and 50 apply in relation to notifications on or after the commencement. That is, all notifications given by the Secretary or Registrar on or after the commencement will not need to be in written form.

Item 279(3) provides continuity in relation to a notice given under various sections (as listed). The current requirement for the Registrar or Secretary to issue written notices will continue to apply to notices given before commencement.

### Item 280: Trade marks

Item 280(1) provides that the amendments to sections 34, 77, 80E, 84A and 176 apply in relation to notifications on or after the commencement. This provides the Registrar with the flexibility to notify the applicant or owner by any means of communication on or after commencement.

Item 280(2) provides that the *Trade Marks Act 1995* as in force immediately before the commencement, continues to apply on and after the commencement in relation to a notice given under subsection 77(2), 80E(2) or 84A(4) or paragraph 176(3)(a) before that commencement. That is, the current requirement for the Registrar to issue written notices continues to apply to notices given before commencement.

# Part 5 – Filing requirements

# Division 1 - Amendments

## Introduction

Part 5 contains a number of amendments to streamline how documents are filed with IP Australia including how fees are paid across all IP rights. A key change is empowering the Commissioner and Registrars to determine the preferred means for filing and fee payments.

## Designs Act 2003

### Items 281, 283, 284 to 286: Alignment of filing and fee payment requirements between IP Rights

[ss 5, 130, 130A, 144, 144A, 144B]

These items amend the Designs Act to allow the Registrar to determine, by written instrument, how documents may be filed and fees may be paid, and to allow lower fees to be charged if documents are filed and fees are paid by certain preferred means.

A document can be filed during a process or situation relating to an IP right application.[1] Similarly, fees are required at various times during the life of an IP right. The means, forms and directions approved by the Commissioner or Registrar are currently published in the Official Journals or elsewhere on the IP Australia website.

The various mechanisms for filing documents and paying fees across the IP rights legislation are complex, overlapping and inconsistent. This makes it difficult for the applicant to clearly identify the correct filing requirements for a given situation.

The amendments address these difficulties by making filing requirements consistent and flexible, while allowing lower fees to be charged, if a preferred means is used to file documents.

Item 286 amends section 144 and introduces new section 144A which together allow an instrument published by the Registrar to specify the means (including electronic means) by which documents are to be filed with IP Australia.

Section 144A also empowers the Registrar to declare that certain means are preferred means, for which a lower fee will be payable under the regulations. This is provided for by item 283, which amends section 130 of the Act so that reduced fees can be charged for filing documents through a preferred means, or paying fees by a preferred means.

[1] See section 214, *Patents Act 1990*; section 213, *Trade Marks Act 1995*; section 144, *Designs Act 2003*; section 26, *Plant Breeder's Rights Act 1994*; regulations 3.5B, 3.7, 5.3, 22.10, 22.2AA, 22.16(2) and Schedule 7, Part 2, *Patents Regulations 1991*, regulations 5.3, 9.3, 17A.30, 17A, 48A and 21.21AA, *Trade Marks Regulations 1995*; regulation 11.01A, *Designs Regulations 2004*; and regulation 4A, *Plant Breeder's Rights Regulations 1994*.

Subsection 144A(5) indicates that an instrument published by the Registrar is not a legislative instrument. This provision is included to assist readers, clarifying that the instrument published under this section is not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

Item 286 also introduces new section 144B, which allows a notice published by the Registrar to specify the form in which documents must be filed with IP Australia, where an approved form is not provided for.

Similarly to subsection 144A(5), subsection 144B(4) is included to assist the reader, clarifying that the notice published under this section is not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

Item 285 introduces new section 130A, which together with new subsection 130(2C) introduced by item 283 provides that fees must be paid by a manner determined in an instrument published by the Registrar (which may include electronic means). As with section 144A, section 130A empowers the Registrar to determine that certain means of paying a fee are preferred means, for which a lower fee will be payable under the regulations.

Similarly to subsection 144A(5) and subsection 144B(4), subsection 130A(5) is included to assist the reader, clarifying that the determination published under this section is not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

Item 281 is consequential on the above items, and introduces the definition of 'preferred means' consistent with sections 130A and 144A into the dictionary of the Act in section 5.

In combination, it is intended that these amendments will give IP Australia the flexibility to adopt more efficient communication technologies as required, and charge lower fees where more efficient means are available of filing documents, passing on the cost savings from such efficiencies to applicants for IP rights.

### Item 282: Physical articles

[s 69]

This item amends section 69 of the Designs Act, which provides that evidence may be filed relating to whether a design is new or distinctive. This evidence sometimes takes the form of non-paper physical articles. This is rarely necessary, because if any information about a physical item is needed, a written description, photograph and/or video of the article is usually sufficient. Physical evidence constitutes a Commonwealth record and so creates storage costs for IP Australia. It may not be returned or destroyed, but must be retained in accordance with the relevant Records Disposal Authority issued by the National Archives.

This item amends section 69 so that non-paper physical articles may not be filed without approval from the Registrar. A non-paper physical article which is not accompanied by such approval will be deemed as not filed and IP Australia will be able to return or dispose such articles. This will allow IP Australia the flexibility to allow such filings only if truly necessary, and prevent unnecessary filing and storage costs otherwise.

### Item 286: Filing of evidence

[s 144C]

This item introduces new section 144C to allow the Registrar to determine, by written instrument, how evidence may be filed with IP Australia.

Evidence is filed with IP Australia for a number of processes under the Act, including for oppositions, extensions of time, ownership disputes etc. Such evidence may be in non-documentary form (e.g. physical articles such as an article alleged to have infringed a registered design). As with filing of documents, the provisions for filing evidence across the IP rights are complex and inconsistent.

The amendments address this issue by making filing requirements for evidence consistent and flexible and will allow IP Australia to adopt new and more efficient means for receiving evidence as these become available.

New section 144C therefore allows the Registrar to issue directions in the form of a written notice relating to how evidence must be filed in relation to matters arising under the Act, including the means and form of filing the evidence.

As with item 282 above, new section 144C will allow the directions from the Registrar to include the circumstances under which physical evidence may be filed. Where non-physical evidence such as a photograph will suffice, the Registrar will be able to direct that the evidence take this form. The regulations will provide that non-compliance with the direction of the Registrar will have the consequence that the evidence is treated by IP Australia as not having been filed.

Subsection 144C(5) is included to assist the reader, clarifying that the determination published under this section is not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

### Item 287: Regulations

[s 149]

This item amends the regulation-making power in the Designs Act under section 149. The amendments clarify that the regulation-making power includes the ability to make regulations relating to the filing of documents in accordance with the means and form specified by the Registrar, the consequences of not complying with the requirements issued by the Registrar, and the filing of evidence as specified by the Registrar.

## Patents Act 1990

### Items 288 to 293 and 295: Alignment of IP Rights – Filing and fee payment requirements

[ss 3, 214, 214A, 214B, 227, 227AAA]

These items amend the Patents Act to allow the Commissioner to determine, by written instrument, how documents may be filed and fees may be paid, and to allow lower fees to be charged if documents are filed and fees are paid by certain preferred means.

Similar to the Designs Act amendments above, the various mechanisms for filing documents across the patents legislation are complex, overlapping and inconsistent. This makes it difficult for the applicant to clearly identify the correct filing requirements for a given situation.

The amendments overcome these issues by making filing requirements consistent and flexible, while allowing lower fees to be charged, if a preferred means is used to file documents.

Items 289 and 290 amend section 214 and introduce a new section 214A which together allow an instrument published by the Commissioner to specify the means (including electronic means) by which documents are to be filed with IP Australia, and to declare that certain means are preferred means, for which a lower fee will be payable under the regulations. This is provided for by item 292, which amends section 227 of the Act so that reduced fees can be charged for filing documents through a preferred means, or paying fees by a preferred means.

Item 291 introduces new section 214B, which allows a notice published by the Commissioner to specify the form in which documents must be filed with IP Australia, where an approved form is not provided for.

Item 293 introduces new section 227AAA, which together with new subsection 227(2C) introduced by item 292 provides that fees must be paid by a manner determined in an instrument published by the Commissioner (which may include electronic means), and that certain means of paying fees are preferred means.

Subsections 214A(5), 214(B)(4) and 227AAA(5) indicate that instruments published by the Commissioner under these sections are not legislative instruments. These provisions are included to assist readers, clarifying that the instruments published under these sections are not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

Items 288 and 295 are consequential on the above items, and introduce the definition of 'preferred means' consistent with sections 214A and 227AAA into the dictionary of the Act in section 3 and Schedule 1.

As with the amendments to the Designs Act, it is intended that these amendments will give IP Australia the flexibility to adopt more efficient communication technologies as required, and charge lower fees where more efficient means are available of filing documents, passing on the cost savings from such efficiencies to applicants for IP rights.

### Item 291: Filing of evidence

[s 214C]

This item introduces new section 214C to allow the Commissioner to determine, by written instrument, how evidence may be filed with IP Australia.

As with the Designs Act above, evidence for the Patents Act may be filed with IP Australia for a number of reasons and in a number of forms, including physical non-documentary. The provisions for filing evidence across the IP rights are complex and inconsistent.

The amendments address this issue by making filing requirements for evidence consistent and flexible and will allow IP Australia to adopt new and more efficient means for receiving evidence as these become available.

New section 214C therefore allows the Commissioner to issue directions in the form of a written notice relating to how evidence must be filed in relation to matters arising under the Act, including the means and form of filing the evidence. As with the Designs Act amendments above, this will allow directions from the Commissioner to include the circumstances under which physical evidence may be filed.

Subsection 214C(5) is included to assist the reader, clarifying that the determination published under this section is not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

### Item 294: Regulations

[s 228]

This item amends the regulation-making power in the Patents Act under section 228. The amendments clarify that the regulation-making power includes the ability to make regulations relating to the filing of documents in accordance with the means and form specified by the Commissioner, the consequences of not complying with the requirements issued by the Commissioner, and the filing of evidence as specified by the Commissioner.

## Plant Breeder's Rights Act 1994

### Items 296 to 300, 304 and 305: Alignment of IP Rights – Filing and fee payment requirements

[ss 3, 26, 34, 40, 72B, 72C, 80, 80A]

These items amend the Plant Breeder's Rights Act to allow the Registrar to determine, by written instrument, how documents may be lodged and fees may be paid, and to allow lower fees to be charged if documents are lodged and fees are paid by certain preferred means.

Item 300 introduces new sections 72B and 72C which together allow an instrument published by the Registrar to specify the means (including electronic means) by which documents are to be lodged with IP Australia, and to declare that certain means are preferred means, for which a lower fee will be payable under the regulations.

Item 305 introduces new section 80A, which together with new subsection 80(3) introduced by item 304 provides that fees must be paid by a manner determined in an instrument published by the Registrar (which may include electronic means), and that certain means of paying fees are preferred means.

Subsections 72C(5) and 80A(5) indicate that instruments published by the Registrar under these sections are not legislative instruments. These provisions are included to assist readers, clarifying that the instruments published under these sections are not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

Item 296 is consequential on the above items, and introduces the definition of 'preferred means' consistent with sections 72C and 80A into the dictionary of the Act in section 3.

Items 297, 298 and 299 are consequential on the above items, and repeal provisions detailing document filing requirements that are now covered by new section 72C.

As with the amendments to the Designs Act, it is intended that these amendments will give IP Australia the flexibility to adopt more efficient communication technologies as required, and charge lower fees where more efficient means are available of lodging documents, passing on the cost savings from such efficiencies to applicants for IP rights.

### Items 301 to 303: Regulations

[s 80]

These items amend the regulation-making power in the PBR Act under section 80. The amendments clarify that the regulation-making power includes the ability to make regulations relating to fees so that reduced fees can be charged for filing documents through a preferred means, or paying fees by a preferred means.

# Trade Marks Act 1995

## Items 306 to 315: Alignment of IP Rights – Filing and fee payment requirements

[ss 6, 52, 52A, 54A, 96, 213, 213A, 213B, 223, 223AA]

These items amend the Trade Marks Act to allow the Registrar to determine, by written instrument, how documents may be filed and fees may be paid, and to allow lower fees to be charged if documents are filed and fees are paid by certain preferred means.

Similar to the Designs Act amendments above, the various mechanisms for filing documents across the trade marks legislation are complex, overlapping and inconsistent. This makes it difficult for the applicant to clearly identify the correct filing requirements for a given situation.

The amendments overcome these issues by making filing requirements consistent and flexible, while allowing lower fees to be charged, if a preferred means is used to file documents.

Items 312 amends section 213 and introduces new section 213A which together allow an instrument published by the Registrar to specify the means (including electronic means) by which documents are to be filed with IP Australia, and to declare that certain means are preferred means, for which a lower fee will be payable under the regulations. This is provided for by item 314, which amends section 223 of the Act so that reduced fees can be charged for filing documents through a preferred means, or paying fees by a preferred means.

Item 313 introduces new section 213B, which allows a notice published by the Registrar to specify the form in which documents must be filed with IP Australia, where an approved form is not provided for.

Item 315 introduces new section 223AA, which together with new subsection 223(2C) introduced by item 314, provide that fees must be paid by a manner determined in an instrument published by the Registrar (which may include electronic means), and that certain means of paying fees are preferred means.

Subsections 213A(5), 213(B)(4) and 223AA(5) indicate that instruments published by the Registrar under these sections are not legislative instruments. These provisions are included to assist readers, clarifying that the instruments published under these sections are not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

Items 306 and 307 are consequential on the above items, and introduce the definition of 'preferred means' consistent with sections 213A and 223AA into the dictionary of the Act in Section 6.

Items 308, 309, 310 and 311 are consequential on the above items, and repeal provisions detailing document filing requirements that are now covered by new section 213A.

As with the amendments to the Designs Act, it is intended that these amendments will give IP Australia the flexibility to adopt more efficient communication technologies as required, and charge lower fees where more efficient means are available of filing documents, passing on the cost savings from such efficiencies to applicants for IP rights.

## Item 313: Filing of evidence

[s 213C]

This item introduces new section 213C to allow the Registrar to determine, by written instrument, how evidence may be filed with IP Australia.

As with the Designs Act above, evidence for the Trade Marks Act may be filed with IP Australia for a number of reasons and in a number of forms, including physical non-documentary. The provisions for filing evidence across the IP rights are complex and inconsistent.

The amendments address this issue by making filing requirements for evidence consistent and flexible and will allow IP Australia to adopt new and more efficient means for receiving evidence as these become available.

New section 213C therefore allows the Registrar to issue directions in the form of a written notice relating to how evidence must be filed in relation to matters arising under the Act, including the means and form of filing the evidence. As with the Designs Act amendments above, this will allow directions from the Registrar to include the circumstances under which physical evidence may be filed.

Subsection 213C(5) is included to assist the reader, clarifying that the determination published under this section is not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003.*

### Item 316: Regulations

[s 231]

This item amends the regulation-making power in the Trade Marks Act under section 231. The amendments clarify that the regulation-making power includes the ability to make regulations relating to the filing of documents in accordance with the means and form specified by the Registrar, the consequences of not complying with the requirements issued by the Registrar, and the filing of evidence as specified by the Registrar.

## Division 2 – Application, saving and transitional provisions

### Item 317: Designs

This item provides that the amendments to the Designs Act above will apply in relation to documents, evidence or material provided or fees paid to the Registrar on or after commencement of the amending items.

### Item 318: Patents

This item provides that the amendments to the Patents Act above will apply in relation to documents, evidence or material provided or fees paid to the Commissioner on or after commencement of the amending items.

### Item 319: PBR

This item provides that the amendments to the PBR Act above will apply in relation to documents, evidence or material provided or fees paid to the Registrar on or after commencement of the amending items.

The item also provides that approved forms that were in effect before commencement of this item continue to be approved after commencement.

### Item 320: Trade Marks

This item provides that the amendments to the Trade Marks Act above will apply in relation to documents, evidence or material provided or fees paid to the Registrar on or after commencement of the amending items.

# Part 6 – Official Journal

# Division 1 - Amendments

## Introduction

The IP legislation requires IP Australia to maintain an Official Journal for each of the four IP rights. The purpose of the Official Journals is to inform the public about an IP application or right. This enables interested parties to take action, such as opposing the right or seeking a licence from the IP owner. The Official Journals are regularly published as searchable PDF documents and in searchable electronic database form on IP Australia's website.

With the development of modern electronic communication systems there is a diminishing need for publishing periodic Journals. Most of the information in the Journals is publicly available through IP Australia's electronic search databases and the online publication of IP Australia's official notices. IP Australia is further improving the functionality and services of its public databases to provide customers with online access to all the information available through the Journals, and more. Information about designs and trade marks such as the acceptance of an application will be available online, and interested parties can be directly notified, promptly after the event occurs. As a result, it is simpler for some time periods to commence or end on the date an event occurs rather than on the advertised date.

Part 6 addresses these issues through a number of amendments to the designs, trade marks and Olympic insignia protection legislation to:

- remove the requirements to publish Official Journals;
- insert new provisions requiring IP Australia to publish or give information via IP Australia's website or by other electronic means;
- replace requirements to publish 'notices' with requirements to publish the facts or details about the event; and
- have some time periods commence or end from the actioned date rather than the advertised date.

The legislation will continue to require the Registrar to notify the applicant or rights owner of changes to their right.

## Designs Act 2003

### Items 321, 322, 329, 330, 334, 335 and 337: Publication requirements

[ss 25, 31, 52, 68, 136A]

These items replace the requirements to publish or advertise certain information in the Official Journal of Designs with a requirement to publish this information in accordance with section 148A (that is, on IP Australia's website or by other electronic means) as provided by item 339 below.

### Items 323 and 328: Publication of information

[ss 32, 50]

These items introduce new requirements to publish certain information in accordance with section 148A. Item 323 requires that, if a design is withdrawn, the Registrar must publish the fact of the withdrawal and

the design number. Item 328 requires that, if the Registrar receives an offer to surrender a registered design, the Registrar must publish that the offer has been made.

### Items 324 to 327, 331 to 333, 336 and 338: Publication requirements

[ss 33, 45, 67, 116, 138]

These items replace requirements to publish a 'notice' in the Official Journals with requirements to publish the facts or details about the event in accordance with section 148A or as prescribed by the regulations.

### Item 339: Electronic publication

[s 148A]

This item inserts a new provision for the publication of information. Section 148A requires IP Australia to publish or give information, or a notice, through IP Australia's website or by other electronic means. This new requirement replaces the requirements to publish Official Journals and gives IP Australia the flexibility in future to make information available in whatever electronic manner that is most appropriate.

## Olympic Insignia Protection Act 1987

### Items 340 to 343: Publication requirements

[ss 10, 11, 11A, 14A]

These items replace the requirements to publish certain information in the Official Journal with a requirement to publish this information in accordance with section 14B (that is, electronically) as provided by item 344 below. The requirements to publish information relating to applications and registrations for Olympic designs in the *Commonwealth of Australia Gazette* remain unchanged because their special public interest warrants wider publication.

### Item 344: Electronic publication

[s 14B]

This item inserts new provisions on the publication of information. Similar to section 148A of the Designs Act, section 14B requires IP Australia to publish or give a notice via IP Australia's website or by other electronic means. This new requirement replaces the requirements to publish Official Journals and gives IP Australia the flexibility in future to make information available in whatever electronic manner that is most appropriate.

## Patents Act 1990

### Item 345

This item removes the requirement for the Commissioner to make arrangements for selling copies of complete specification which are open to public inspection from subsection 222(2). This information is already freely available to the public through IP Australia's electronic search databases for Patents.

# Trade Marks Act 1995

## Item 346 to 349: References to and definition of Official Journal

[Readers guide, s 6]

Items 346 to 348 remove the references to the *Official Journal* in the Readers Guide. This is a consequence of replacing the requirements to publish Official Journals with a requirement to publish information in accordance with section 230A, as provided by item 367. Similarly, item 349 repeals the definition of Official Journal.

## Item 350: Publication of notice of decision

[s 34]

This item removes the requirement to advertise in the *Official Journal* the Registrar's decision on whether to accept or reject an application for a trade mark. This is replaced with a requirement to publish this information in accordance with section 230A (that is, on IP Australia's website or by other electronic means). Where the Registrar's decision is to accept the application, the day of acceptance must also be published.

## Items 351 and 352: Amendment after particulars of application have been published

[ss 65, 65A]

These items provide more appropriate headings for the relevant sections as a result of replacing the requirement to advertise in the *Official Journal* with a requirement to publish in accordance with section 230A.

## Items 353 to 363: Publication requirements

[ss 65A, 71, 83A, 95, 110, 175, 176, 223A]

These items replace the requirements to publish or advertise certain information in the *Official Journal* with requirements to publish these details in accordance with section 230A, as provided by item 367.

## Items 364 to 366: Publication and sale of documents

[s 226]

The amendments remove the requirements to publish the *Official Journal*. The Registrar may continue to prepare, publish (electronically or otherwise) and sell trade marks documents as he or she thinks fit.

## Item 367: Electronic publication

[s 230A]

This item inserts new provisions requiring IP Australia to publish or give information, or a notice, via IP Australia's website or by other electronic means. This requirement replaces the requirement to publish information in the Official Journal and gives IP Australia the flexibility to make information available in whatever electronic manner is most appropriate.

# Division 2 – Application provisions

### Item 368: Designs

Item 368(1) provides that amendments of sections 25, 31, 33, 45, 52, 67, 68, 116, 136A and 138 of the *Designs Act 2003* apply in relation to publications occurring on or after commencement. That is, the requirement to electronically publish information will apply to information that is to be published on or after commencement.

Item 268(2) provides that the amendment of section 32 applies in relation to a withdrawal made on or after commencement and a withdrawal made before the commencement where the design number had not been published in the *Official Journal* before the commencement. That is, the requirement for the Registrar to electronically publish the fact of the withdrawal and the design number will apply to designs withdrawn before commencement if it had not yet been published in the Official Journal. The electronic publication requirement would also apply to designs withdrawn on or after commencement.

Item 368(3) provides that the amendment of section 50 applies in relation to an offer received on or after commencement and an offer received before the commencement where notice of the offer had not been published in the *Official Journal* before the commencement. That is, the requirement to electronically publish the fact that an offer to surrender a register design has been made, applies to offers received on or after commencement. This requirement will also apply to offers received before commencement if the notice of offer was not published in the Official Journal before commencement.

### Item 369: Olympic Designs

This item provides that the amendments of sections 10, 11, 11A and 14A of the *Olympic Insignia Protection Act 1987* apply in relation to publications on or after the commencement. That is, the requirement to electronically publish information related to Olympic designs will apply to information that is to be published on or after commencement.

### Item 370: Trade marks

This item provides that the amendments of section 34, subsection 65A(3), section 71, subsection 83A(3) and sections 95, 110, 175, 176 and 223A of the *Trade Marks Act 1995* apply in relation to publications on or after the commencement. This means that the requirement to electronically publish information will apply to information that is to be published on or after commencement.

# Part 7 – Amendments of applications or other documents

# Division 1 - Amendments

## Introduction

Part 7 makes various amendments to the Designs Act and the Trade Marks Act to make it simpler for applicants of these IP rights, and for IP Australia, to make changes to administrative details of applications.

Under the current legislation, applicants can amend various aspects of their applications, including updating administrative details such as names and addresses.[2] The applicant must submit a form requesting the amendment, which is then considered and actioned by IP Australia.

Requiring customers to request amendments for simple administrative details is an unnecessary burden for them and for IP Australia. The process often involves multiple steps and multiple parties, rather than being performed in a single step by one party. For designs, IP Australia is unable to correct obvious errors in applications like misspellings of names or addresses, unless requested to do so by the applicant, or IP Australia has itself made an error or omission. Where IP Australia identifies an obvious error, it must ask the customer to formally request the amendment, then action it and respond.

The amendments alleviate these problems by allowing applicants to amend certain administrative details of their applications themselves in a single step. The amendments also allow the Registrar to correct obvious errors in these details such as misspellings of names or addresses. These changes will reduce the time and costs for making simple amendments to applications. The processes for amending substantive information that affects the scope of a trade mark or designs application, or the rights of any party, remain unchanged and subject to the Registrar's approval. Trade mark and design owners will not be able to make 'self-amendments' to granted or registered trade mark or designs rights, in order to maintain the integrity of the Registers.

## Designs Act 2003

### Item 371: Amendment of particulars

[s 27A]

This item inserts new section 27A to provide that an applicant may amend the particulars that are prescribed in the regulations, provided this does not change the identity of the applicant. Changes to the name of a person will be allowable, such as to correct spelling or update the surname. However, changes to the actual identity of the person will continue to be handled under other provisions. It is anticipated that the particulars to be prescribed in the regulations will include the applicant's name, contact details and agent details.

Applicants may make self-amendments using an online system approved in a notice by the Registrar, or, where this is not possible, in accordance with a method prescribed in the regulations.

Subsection 27A(5) is included to assist the reader, clarifying that the approval under subsection (3) is not a legislative instrument within the meaning of section 5 of the *Legislation Act 2003*. New subsection (6)

[2] See for example Trade Marks Act, subsection 63(1) and section 83 and Designs Act, sections 28 and 30

enables the Registrar to undo an amendment made by an applicant under subsection (1) if the amendment would result in the application not complying with basic filing requirements or if the amendment would be inappropriate. This is to prevent applicants from circumventing various requirements by making their own amendments after filing. New subsection (7) enables the Registrar to amend the prescribed particulars on his or her own initiative to correct an obvious mistake. This power will be used carefully and the applicant will be notified of the amendment (subsection (8)).

New subsections (9) and (10) limit when such amendments by the applicant or Registrar may be made. For example, such amendments may not be made to a design application after a design disclosed in the application has been registered. Further limitations for specific particulars may be prescribed in the regulations, where appropriate. Where these limits apply, amendments must be made using the existing amendment provisions.

### Item 372: Headings

[s 28]

This item amends the heading of section 28 to better differentiate this provision from the new section 27A.

### Item 373: Amendments to any other document

[s 28]

This item amends subsection 28(1) of the Designs Act to clarify that amendments requested by the applicant may also be made to any other document accompanying the application.

### Item 374: Limitations to amendments

[s 28]

This item inserts new subsection 28(2A) to provide that, if an applicant can make a self-amendment under the new provisions, they are unable to request that the Registrar makes such an amendment under the existing provisions. That is, applicants will be required to use the means approved by the Registrar to make any changes to the prescribed particulars. This approach will simplify the amendment system by having only one provision to make each type of amendment.

### Item 375: Publication of amendments

[s 31]

This item amends section 31 of the Designs Act to provide that amendments made by the Registrar under the new provisions do not need to be published, as they will merely correct obvious errors.

## Trade Marks Act 1995

### Item 376: Amendment of particulars

[s 62B]

This item inserts new section 62B to provide that an applicant may amend the particulars that are prescribed in the regulations, having regard to the same parameters provided for designs by item 371.

As for designs, applicants may make self-amendments using an online system approved in a notice by the Registrar, or, where this is not possible, in accordance with a method prescribed in the regulations. Similar to designs, this item further enables the Registrar to undo an amendment or correct an obvious mistake. This item also limits the time in which such amendments can be made by the applicant or Registrar, so that such amendments may not be made to a trade mark application after it is accepted.

### Item 377: Headings

[s 63]

This item amends the heading of section 63 to better differentiate this provision from the new section 62B.

### Item 378: Limitations to amendments

[s 63]

This item inserts new subsection 63(1A) to provide that, if an applicant can make a self-amendment under new section 62B, they are unable to request that the Registrar makes such an amendment under the existing sections 63, 64, 65 or 65A. That is, applicants will be required to use the means approved by the Registrar to make any changes to the prescribed particulars. This approach will simplify the amendment system by having only one provision to make each type of amendment.

### Items 379 and 380: Correction of obvious or clerical errors

[s 66]

These items insert new subsection 66(1A) and amends subsection 66(2) to address a gap in the Registrar's powers to correct obvious or clerical errors on his or her own initiative. Corrections to applications for registration may be made under new subsection 62B(7). Corrections to other documents may be made on request under subsection 66(1). Corrections to other documents on the Registrar's own initiative may be made under the new subsection 66(1A) introduced by these items.

## Division 2 – Application and transitional provisions

### Item 381: Designs

This item provides that the amendments apply to all applications for designs, regardless of filing date. Requests for amendment of an application or other document made before commencement will continue to be processed according to the existing provisions. Requests for amendment to the prescribed particulars made on or after commencement must be made by applicants themselves using the new provisions.

### Item 382: Trade Marks

This item provides that the amendments apply to all applications for the registration of a trade mark, regardless of filing date. Requests for amendment of an application or other document made before commencement will continue to be processed according to the existing provisions. Requests for amendment to the prescribed particulars made on or after commencement must be made by applicants themselves using the new provisions. The Registrar may correct obvious or clerical errors on his or her own initiative for an application, notice or other document filed before, on or after commencement.

# Part 8 – Signatures

# Division 1 – Amendments

## Introduction

Part 8 of Schedule 1 removes the unnecessary requirement for an applicant to provide a signature in relation to the Patent Cooperation Treaty (PCT) and international patent requests. This removes an unnecessary administrative burden from customers and IP Australia.

## Patents Act 1990

### Items 383 and 384: Signatures in relation to PCT and international patent requests

[ss 151, 176]

These items remove unnecessary signature requirements in the Patents Act.

The legislation of all four IP rights contains provisions that require certain filed documents to be signed by the applicant. The Patents Act requires signatures in more circumstances than the other IP rights. Some of these signature requirements are considered necessary to authenticate a document or transaction. For example, signatures are required for withdrawing a patent application under paragraph 141(1)(a) of the Patents Act.

However, the current signature requirements of paragraphs 151(4)(c) (request to reinstate an application as an international application) and 176(c) (request to treat a PCT application as a standard application) of the Patents Act are unnecessary because these requests do not involve significant risk of unauthorised actions taking place. The identity and authority of the person in question can be sufficiently confirmed from other information in the documentation.

# Division 2 – Application and transitional provisions

### Item 385: Application provision

The amendments made by this Part will apply in relation to a request referred to in paragraph 151(4)(c) or 176(c) of the Patents Act filed on or after the commencement of this item.

# Part 9 – Computerised decision-making

## Introduction

Part 9 of Schedule 1 makes various amendments to the IP Acts to enable the Commissioner and the Registrar to use a computer to make a decision, exercise any power or comply with any obligation of the Commissioner or Registrar.

The legislation requires delegated staff to make a large number of decisions. These range from simple decisions that are based on whether an event has occurred to complex decisions that require judgement to be exercised.

An example of a more complex decision is when an applicant for a design applies for an extension of time under section 137 in which to do something and provides a reason for needing the extension. The delegate of the Registrar of Designs assesses the reason and decides whether or not the extension may be granted. If the delegate considers that an extension may be granted, the application is advertised and other interested parties may oppose the extension. An example of a simple decision is that, if no opposition to the extension is lodged, then the delegate decides to grant the extension. This requires the delegate to reconsider the case even if no opposition has been lodged.

The problem is that the legislation administered by IP Australia requires staff to double handle IP applications or rights when making a number of simple decisions. This unnecessarily increases IP Australia's administration costs and can prevent the organisation from delivering more efficient services.

The IP legislation does not currently enable the use of automated systems to make decisions or undertake actions relating to the exercise of a delegate's power or fulfilment of a delegate's obligation. These items amend the IP legislation to include a generic provision authorising the use of computerised decision making to undertake decision making, with the decisions limited to those listed in a legislative instrument. This will enable IP Australia to use computer systems to more efficiently perform simple, high volume actions, such as:

- decisions resulting from a straightforward and simple analysis of undisputed facts (for example, granting an extension of time after advertising it if no opposition has been received within the prescribed period); and

- actions relating to the delegate's powers or obligations flowing directly from a separate decision that has already been made (for example, recording the revocation of a design in the Register if the design has been revoked by the Registrar or a court).

Limiting the range of decisions that could be automated by listing them in a legislative instrument provides certainty to stakeholders, while enabling IP Australia to update the affected decisions as necessary. These items also allow IP Australia to remake a decision if the computerised decision was incorrect. Further public consultation will be undertaken prior to the making of the legislative instrument.

## Designs Act 2003

### Item 386: References to computerised decision-making

[s 129]

This item inserts a reference to new Part 3A (introduced in items 387 to 389) that deals with computerised decision-making.

### Items 387 to 389: Computerised decision-making

[ss 135A, 136]

Item 387 introduces new section 135A to enable the Registrar of Designs to use computer programs for any purposes for which the Registrar may, or must, make a decision, exercise a power or comply with an obligation, or do anything else related to these. Where the Registrar uses a computer program for these purposes, the Registrar is taken to have made the decision, exercised the power or complied with the obligation. The action is to be treated in the same way as any similar action performed normally by the Registrar or a delegate of the Registrar.

New subsection 135A(2) provides that these provisions only apply to decisions, powers and obligations determined in a legislative instrument made by the Registrar. This provides certainty to stakeholders around which actions the Registrar may automate.

New subsection 135A(4) provides that the Registrar can substitute a new decision for a decision made by computer if the Registrar is satisfied that it was incorrect. This ensures that the Registrar can address any incorrect operation of a computer system.

Items 388 and 389 amend section 136 to provide that a person may apply to the AAT for review of a substituted decision if the person may apply to the AAT for review of the initial decision. AAT review is not to be available for substituted decisions if it is not available for the initial decision.

## Patents Act 1990

### Items 390 to 392: Computerised decision-making

[ss 223J, 224]

Similar to the amendments to the Designs Act, item 390 introduces new section 223J to enable the Commissioner of Patents to use computer programs for any purposes for which the Commissioner may, or must, make a decision, exercise a power or comply with an obligation, or do anything else related to these. Where the Commissioner uses a computer program for these purposes, the Commissioner is taken to have made the decision, exercised the power or complied with the obligation. The action is to be treated in the same way as any similar action performed normally by the Commissioner or a delegate of the Commissioner.

New subsection 223J(2) provides that these provisions only apply to decisions, powers and obligations determined in a legislative instrument made by the Commissioner.

New subsection 223J(4) provides that the Commissioner can substitute a new decision for a decision made by computer if the Commissioner is satisfied that it was incorrect.

Items 391 and 392 amend section 224 to provide that a person may apply to the AAT for review of a substituted decision if the person may apply to the AAT for review of the initial decision.

# Plant Breeder's Rights Act 1994

### Items 393 to 396: Computerised decision-making

[ss 76J, 77]

Similar to the amendments to the Designs Act, item 393 introduces new section 76J to enable the Registrar of PBR to use computer programs for any purposes for which the Registrar may, or must, make a decision, exercise a power or comply with an obligation, or do anything else related to these. Where the Registrar uses a computer program for these purposes, the Registrar is taken to have made the decision, exercised the power or complied with the obligation. The action is to be treated in the same way as any similar action performed normally by the Registrar or a delegate of the Registrar.

New subsection 76J(2) provides that these provisions only apply to decisions, powers and obligations determined in a legislative instrument made by the Registrar.

New subsection 76J(4) provides that the Registrar can substitute a new decision for a decision made by computer if the Registrar is satisfied that it was incorrect.

Items 394 to 396 amend section 77 to provide that a person may apply to the AAT for review of a substituted decision if the person may apply to the AAT for review of the initial decision.

# Trade Marks Act 1995

### Item 397: Computerised decision-making

[s 222A]

Similar to the amendments to the Designs Act, item 397 introduces new section 222A to enable the Registrar of Trade Marks to use computer programs for any purposes for which the Registrar may, or must, make a decision, exercise a power or comply with an obligation, or do anything else related to these. Where the Registrar uses a computer program for these purposes, the Registrar is taken to have made the decision, exercised the power or complied with the obligation. The action is to be treated in the same way as any similar action performed normally by the Registrar or a delegate of the Registrar.

New subsection 222A(2) provides that these provisions only apply to decisions, powers and obligations determined in a legislative instrument.

New subsection 222A(4) provides that the Registrar can substitute a new decision for a decision made by computer if the Registrar is satisfied that it was incorrect.

New subsection 222A(5) provides that a person may apply to the AAT for review of a substituted decision if the person may apply to the AAT for review of the initial decision.

# Part 10 – Addresses and service of documents

# Division 1 – Amendments

## Introduction

These items amend the PBR Act to clarify and simplify the address requirements by moving some requirements to the approved form for applying for PBR.

Schedule 4 of the *Intellectual Property Laws Amendment Act 2015* amends the PBR Act to provide that an address for service must be an address in Australia or New Zealand. As amended, subsection 26(3) provides that, if an applicant is resident overseas in a country other than New Zealand, the applicant must, unless the applicant has appointed an agent resident in Australia or New Zealand, specify in addition to any overseas address an address in Australia or New Zealand for the service of notices on the applicant.

These items repeal subsection 26(3) and insert new subsection 26(1A) to provide that the approved form must require the inclusion of an address in Australia or New Zealand for service. The items also make a number of consequential amendments.

## Plant Breeder's Rights Act 1994

### Item 398: Electronic address

[s 3]

This item is consequential upon item 403.

Schedule 4, Part 1, item 60 of the *Intellectual Property Laws Amendment Act 2015* inserts new subsections into section 3 of the PBR Act. Subsection 3(2) provides that a reference in the PBR Act to an address includes a reference to an electronic address. Subsection 3(4) provides that section 3 does not apply to certain references to 'address' in subsections 26(2) and (3).

Item 403 below repeals subsection 26(3), thereby requiring an amendment to subsection 3(4) to remove the existing reference to subsection 26(3).

### Items 399 to 401 and 404 to 407: Addresses for notifications and service

[ss 19, 21, 31, 73]

Items 399, 400, 405 and 407 insert notes into subsections 19(5A), 21(5), 31(3) and 73 to clarify that the address referred to in these provisions may be an electronic address. Items 404 and 406 substitute the term "notices" with the term "documents" to allow for service of documents to an electronic address in the future, when specified in the regulations, if considered appropriate.

### Items 402 and 403: Applicant's address for service

[s 26]

These items move the requirement that an address for service must be in Australia or New Zealand to the approved form for applying for PBR. Item 402 also inserts a note to clarify that the address may be an electronic address. These amendments simplify the address requirements in the PBR Act.

# Division 2 – Application and transitional provisions

### Item 408: Application provisions

This item provides that the amendments made to section 26 by this Part apply to applications for PBR made on or after commencement of this item.

# Part 11 – Examination of standard patent requests and specifications

# Division 1 – Amendments

## Introduction

Part 11 of Schedule 1 amends and clarifies the process for examining standard patent requests and specifications. This aligns the terminology used across the Patents Act and the Designs Act and streamlines third party request procedures.

## Patents Act 1990

### Items 409 to 415: Request for examination

[s 44]

These items amend section 44 of the Patents Act to enable third parties to request examination of complete standard patent applications and specifications rather than asking the Commissioner of Patents to direct the applicant to request examination. Associated amendments to the Patent Regulations will require third parties and patent applicants to each pay half of the examination fee to reflect the benefit gained by each party.

Currently, subsection 44(1) of the Act enables a standard patent applicant to request examination of their complete application and specification within the prescribed period after the documents have been filed. Subsection 44(2) also empowers the Commissioner to direct an applicant to request examination of their application and specification within the prescribed period.

Item 410 removes from subsection 44(2) the requirement for the applicant to request examination of their application and specification in response to the Commissioner's direction within the prescribed period. This will be covered in new subsection 44(2A).

Item 411 inserts a new subsection 44(2A) to clarify that, if the Commissioner gives a direction under subsection 44(2), the applicant must request examination and do so within the prescribed period.

Currently, subsection 44(3) of the Act enables any person to require the Commissioner to direct the applicant to ask for examination where the complete application and specification become open to public inspection. This is an unnecessary procedural step that is not consistent with the simpler processes in place for innovation patents (section 101A of the Patents Act) and designs (subsection 63(1) of the Designs Act).

Items 413 and 414 amend subsection 44(3) to provide that a person who is not the applicant may ask the Commissioner to examine a patent request and specification. The amendment will streamline the third party request procedure and align standard patents with innovations patents and designs.

Item 415 amends subsection 44(4) to provide that a third party examination request cannot be made where the applicant has already requested examination under subsection 44(1) or where the Commissioner has already directed this to occur under subsection 44(2). The item also inserts new subsection 44(5) to provide that the applicant must be notified by the Commissioner if a third party request is made.

Items 409 and 412 amend subsections 44(1) and 44(3) to align the terminology used across the Patents Act.

### Item 416: Examination

[s 45]

This item clarifies that the obligations of the Commissioner to examine and report on the patent request and specification under subsection 45(1) apply if an applicant or a third party requests examination under subsections 44(1), 44(2A) (as inserted by item 411) or 44(3).

### Items 417 and 418: Lapsing of applications

[s 142]

These items clarify that the lapsing provisions in the Patents Act apply to a complete application for a standard patent where the applicant does not request examination within the relevant period prescribed for subsections 44(1) or 44(2A) (as inserted by item 411).

Item 418 adds a note after subsection 142(3) to clarify that a complete application for a standard patent may also lapse in circumstances where certain fees are not paid within the prescribed period.

## Division 2 – Application and transitional provisions

### Item 419: Application and saving provisions

The amendments made by this Part will apply in relation to requests for examination under section 44 of the Patents Act made on or after the commencement of this item, whether the complete application for a standard patent was made before, on or after that commencement. Sections 44, 45 and 142 of the Patents Act, as in force immediately before the commencement of this item, will continue to apply on and after that commencement to a request under section 44 as a result of a direction given before that commencement under subsection 44(2) or a requirement made of the Commissioner before that commencement under subsection 44(3).

# Part 12 – Requirements for patent documents

# Division 1 – Amendments

## Introduction

Part 12 of Schedule 1 consolidates the requirements for patent applications and specifications and requires complete applications to comply with the formality requirements outlined in an instrument made by the Commissioner.

## Patents Act 1990

### Item 420: Application for patent – general rules

[s 29]

This item repeals subsections 29(3) and (4) and substitutes subsections 29(3) to (4B) to consolidate all the requirements for patent applications and specifications in section 29 and to require complete applications to comply with the formality requirements outlined in an instrument made by the Commissioner under a new section 229 (see item 432 below).

Items 11(1) to 11(18) in Schedule 3 of the Patent Regulations currently set out the formal requirements for drawings in patent specifications. One of these requirements is that the drawings are to be in black and white rather than colour. This was included to comply with filing requirements currently in place under the PCT and due to various problems with using colour.

However, colour drawings and photographs are better able to convey information in certain situations. These include where it is necessary to distinguish components of similar shape that have different physical or chemical properties. Also, the cost and reliability of colour imaging has improved. Recognising this, the PCT Union intends to amend the PCT Rules to allow colour drawings to be filed in international applications. It is not certain when the Rules will be changed and what the exact requirements will be.

The amendment addresses this issue by enabling the Commissioner of Patents to prescribe the formalities requirements for complete patent applications and specifications in an instrument made under new section 229 rather than in Schedule 3 of the Regulations. This will enable the Commissioner to ensure that the formalities requirements are in line with changing technologies and our international obligations. This instrument would be published by IP Australia for applicants to reference.

The availability of colour drawings, graphics and photographs will ensure that IP Australia is consistent with its international obligations and will enable applicants to better describe their inventions.

### Item 421: Application for patents – special rules for PCT applications

[s 29A]

In line with item 420 above, this item allows graphics and photographs included in a PCT application, in addition to drawings, to be treated as a complete specification in respect of the application.

### Item 422: Specifications

[s 40]

In line with item 420 above, this item includes graphics and photographs, in addition to descriptions and drawings, as matters which the claim or claims must not rely on in the patent specification unless absolutely necessary to define the invention.

### Items 423 and 424: International applications treated as standard patent applications under this Act

[ss 151, 176]

These items provide that where an applicant requests a withdrawn international application to be treated as a standard patent application, in addition to the description, claims and drawings, any graphics and photographs that may have been included in the international application must also be treated as part of a complete specification filed in respect of the application. These changes are in line with item 420 above.

### Items 425 and 426 : Regulations on formalities of innovation patents

[s 228]

Item 425 clarifies that the power to make regulations setting out the formalities checking process for innovation patents under paragraph 228(2)(ha) incorporates compliance with new subsections 29(4A) and (4B) (introduced by item 420 above) which consolidate the formalities requirements in respect of patents.

Item 426 provides that the regulation making power for setting innovation patent application formalities includes empowering the Commissioner to direct an innovation patent applicant to do such things as are necessary to ensure that the relevant formalities requirements are met.

### Items 427 and 428: Regulations on formalities of PCT applications

[s 228]

Item 427 clarifies that the regulation-making power to set out a formalities checking process for PCT applications under paragraph 228(2)(i) incorporates compliance with subsection 29A(5).

Item 428 provides that the regulation making power for setting PCT patent application formalities includes empowering the Commissioner to direct a PCT applicant to do such things as are necessary to ensure that the relevant formalities requirements are met.

### Item 429: Regulations on provisional applications

[s 228]

This item provides a new regulation-making power in subsection 288(2) enabling the Commissioner to direct the applicant to do such things as are necessary to ensure that a provisional specification complies with the requirements of subsection 29(4) and allowing for the consequences of the applicant not complying with a direction within a specified timeframe.

### Items 430 and 431: Regulations on standard patents

[s 228]

These items provide that the regulation-making power under paragraph 228(2)(j) enables the Commissioner to direct an applicant for a standard patent to do such things as are necessary to ensure that

the patent request in addition to the complete specification is in accordance with the requirements of new subsections 29(4A) and 4(B) (introduced by item 420 above).

### Item 432: Instrument on formalities requirements

[s 229]

In line with item 420, this item inserts a new section 229 empowering the Commissioner to determine by way of a written instrument the formalities requirements for patent requests, complete specifications, PCT applications that have entered the national phase and other documents as prescribed.

Subsection 229(3) is included to assist readers, as the instrument is not a legislative instrument within the meaning of section 5 of the *Legislative Instruments Act 2003*.

### Item 433: Dictionary

[Schedule 1]

This item expands the dictionary definition of specification to include graphics and photographs.

## Division 2 – Application and transitional provisions

### Item 434: Application and saving provisions

The amendments to section 29 (see item 420 above) in relation to patent requests apply to patent requests filed on or after the commencement date.

An instrument approving a form for current subsections 29(3) and 29(4) of the Patents Act and paragraphs 3.2(1)(a) and 3.2A(2)(a) of the Patents Regulations which is in force prior to the commencement date will have effect on and after commencement as if it were an instrument approving that form and in force for the purposes of new paragraphs 29(3)(a), 29(4A)(a), 29(4)(a) and 29(4B)(a) of the Patents Act respectively.

# Part 13 – Acceptance of trade mark applications

# Division 1 – Amendments

## Introduction

Part 13 of Schedule 1 amends the Trade Marks Act to align the Act with procedural changes to the acceptance of trade mark applications made in the Trade Mark Regulations.

## Trade Marks Act 1995

### Items 435 and 436: Lapsing of applications

[s 37]

These items amend section 37 to be consistent with the proposed removal from the regulations of 'easy' extensions to the acceptance period of a trade mark application.

Subregulations 4.12(3) and (4) and subregulations 17A.20(3) and (4) of the Trade Marks Regulations provide for an 'easy' extension of time of up to six months to the prescribed period for acceptance of a trade mark application. This type of extension does not require the applicant to justify the extension and is in addition to general extensions available under section 224 and deferment of acceptance under section 36.

IP Australia proposes to amend the Trade Marks Regulations to repeal these subregulations, reduce the prescribed period for acceptance and expand the grounds for deferment. These changes will simplify the extension system, ensure that extensions are granted where warranted and speed up the resolution of trade mark applications, thereby increasing certainty in the market. Trade mark applicants will continue to be able to apply for extensions under section 224 (as proposed to be amended under Part 3) and deferment of acceptance.

# Division 2 – Application and transitional provisions

### Item 437: Application provision

This item provides that the amendments to section 37 above will apply in relation to all trade mark applications filed on or after commencement. That is, easy extensions will no longer be available for trade mark applications filed on or after commencement. These amendments will also apply to a trade mark application filed or made before commencement if its acceptance is revoked under subsection 38(1) or subsection 84C(5) on or after commencement.

# Part 14 – Registration of designs

# Division 1 – Amendments

## Introduction

Part 14 makes various amendments to the Designs Act to remove for applicants the option of having a design published rather than registered. These items also amend the Designs Act so that an application will automatically proceed to the formalities check for registration if the applicant does not request registration or withdrawal by the end of the prescribed period.

Upon or after filing a design application, an applicant may currently request either publication or registration of the design.[3] A design application lapses if a request is not made within the prescribed period, which is typically six months from the priority date.[4] The option of publication was provided as a way for applicants to make a design public and thereby prevent others from obtaining certification for the same design. However, to date very few applicants have requested publication.

The option of publication complicates the designs system. Also, requiring applicants to request registration imposes an administrative burden on the great majority of applicants and can result in the unintended lapsing of applications.

The amendments address these problems by removing the option of publication and making registration the default result at the end of the prescribed period, subject to a formalities check.[5] This will simplify the application process and thereby reduce the administrative burden on applicants.

Applicants will still be able to request registration prior to the prescribed period expiring. Applicants who want their application to lapse will instead be required to request withdrawal of the design before the end of the prescribed period. Applicants who would like to strategically publish their design application can continue to do so by registering their design without requesting examination and certification.

## Designs Act 2003

### Items 438 to 441, 443: Design applications

[ss 20, 23, 24, 32]

These items remove references to 'publication' in Chapter 3 of the Act as a consequence of item 441 removing the option for applicants of requesting publication of a design.

### Item 442: Design applications that meet the minimum filing requirements

[s 24]

This amendment extends the current provisions of section 24 to also cover deemed requests for registration under section 35, as amended by item 455.

---

[3] Section 35(1), Designs Act 2003.
[4] Section 33(1), Designs Act 2003; Regulation 3.14, Designs Regulations 2003.
[5] See sections 39 and 40, Designs Act 2003.

### Item 444: Lapsing of design applications

[s 33]

This item substitutes new subsection 33(1) to remove the requirement for an applicant to request to register or publish a design for it to stay live. If no request for registration or withdrawal is received by the end of the prescribed period, the application will automatically proceed to registration under new subsections 35(4) and (5) as inserted by item 455, subject to a formalities check under sections 39 and 40. However, if the applicant fails to respond to the Registrar's notification under section 41 to amend the design within the prescribed period, the application will still lapse.

### Item 445: Lapsing of design applications

[s 33]

This item repeals subsection 33(3) as a consequence of item 444 amending subsection 33(1).

### Items 446 to 451, 453, 461 to 465: Registration of Designs

[ss 34, 35, 60, 61]

These items remove references to 'publication' in Chapter 4 of the Act as a consequence of item 460 removing the option of publication.

### Item 452: Request for registration

[s 35]

This item provides an appropriate heading for subsection 35(1) to set out two types of requests for registration – 'Actual requests' under subsections 35(1) to (3), and 'Deemed requests' under new subsections 35(4) to (5) as added by item 455.

### Item 454: Request for registration

[s 35]

This consequential item removes references to sections 37 and 38 as repealed by item 456.

### Item 455: Request for registration

[s 35]

This item inserts new subsections 35(4) to (6) to provide that at the end of the prescribed period, if an applicant has not made a request for registration, and has not withdrawn the application, the applicant is taken to have requested the registration of the design. Subsection 35(4) covers a single design in a design application, and section 35(5) covers multiple designs in a design application. Subsection 35(6) provides that section 35 is subject to section 37 (as amended by item 456), the latter covers the request for a design application (the ***later application***) in respect of designs excluded from an initial application.

Making registration the default result at the end of the prescribed period, subject to a formalities check, will simplify the application process and thereby reduce the administrative burden and the likelihood of applications unintentionally lapsing.

Applicants who want their application to lapse would need to request withdrawal of the design application under section 32 before the end of the prescribed period.

### Item 456: Request for registration

[ss 36, 37]

This item repeals sections 36 to 38 which refer to publication of a design, and inserts new sections 36 and 37 to cover how requests for partial registration and later application are dealt with. Section 36 provides that if an applicant makes a request for partial registration, the applicant cannot later make a request for registration of a relevant design unless the Registrar determines that the applicant may do so, under certain situations which will be prescribed in an amended regulation. Section 37 provides that default registration extends to a later application in respect of designs excluded from an initial application.

### Items 457 and 458: Formalities check

[ss 39, 40]

The amendments provide that in relation to formalities checks, the current provisions for actual requests for registration also extend to deemed requests for registration under new subsections 35(4) and 35(5) provided by item 455.

### Item 459: Registrar must give applicants an opportunity to correct deficiencies

[s 41]

This is a consequential amendment to provide the correct reference as a result of item 444.

### Item 460: Publication

[Part 4 of Chapter 4]

This item repeals Part 4 of Chapter 4 dealing with requests for publication of a design.

### Items 466 to 472: The Crown and Miscellaneous

[ss 108, 136, 137, 146, 149]

These items remove references to ‘publication’ in Chapters 8 and 11 of the Act.

## Division 2 – Application and transitional provisions

### Item 473: Application and saving provisions

Item 473(1) provides that the amendments/substitution of sections 23 and 37 apply in relation to initial applications filed on or after the commencement.

Item 473(2) provides that the amendments/substitution of sections 24, 32, 33, 35, 36, 38-41, 60, 61, 108, 136 and Part 4 of Chapter 4 apply in relation to design applications filed on or after the commencement.

Item 473(3) provides that sections 136, 137, 146 and 149, as in force immediately before the commencement, continue to apply on and after the commencement in relation to an application for publication of a design that was made before the commencement.

# Part 15 – Unjustified threats of infringement

# Division 1 – Amendments

## Introduction

The patents, trade marks, designs and Olympic insignia protection legislation provides protection for businesses facing an unjustified or groundless threat of infringement proceedings from another party. The aggrieved person may apply to a court for a declaration that the threats are unjustifiable, an injunction against continuance of the threats and the recovery of any damages sustained as a result of the threats.[6] This helps to prevent parties from intimidating other businesses by making threats that have no basis.

The plant breeder's rights legislation does not provide such protection, leaving farmers and other small businesses in that sector more vulnerable to unjustified threats of infringement. Also, while a court is able to award additional damages for the flagrant infringement of a patent, trade mark or design in order to deter such activity,[7] similar additional damages are not available for flagrantly unjustified threats of infringement. Therefore the level of damages provided may be insufficient to deter certain parties from making unjustified threats. For example, to a well-resourced business the benefit gained from hindering a competitor by making unjustified threats may outweigh the cost of ordinary damages. Similarly, threatened parties may be discouraged from taking action because obtaining only ordinary damages provides insufficient incentive.

These items address these problems by introducing protection against unjustified threats in the PBR legislation and by introducing additional damages for patents, trade marks and designs.

## Designs Act 2003

### Item 474: Additional damages

[s 77]

This item inserts new subsection 77(1A) to allow additional damages to be awarded against a person for making unjustified threats of infringing a design. The court may award additional damages if it considers it appropriate to do so, having regard to a number of matters. These matters parallel those considered by the court under subsection 122(1A) of the Patents Act, subsection 126(2) of the Trade Marks Act and subsection 115(4) of the *Copyright Act 1968* when considering whether to award additional damages for infringement.

The principles by which additional damages may be awarded under these provisions are well established in Australian law. They correspond to those which govern awards of aggravated or exemplary damages at common law.[8] More than copying needs to be shown to warrant additional damages. [9] An additional

[6] Section 128 of the *Patents Act 1990*, section 77 of the *Designs Act 2003*, section 129 of the *Trade Marks Act 1995* and section 64 of the *Olympic Insignia Protection Act 1987* .
[7] See subsection 75(3) of the *Designs Act 2003*, subsection 122(1A) of the *Patents Act 1990* and subsection 126(2) of the *Trade Marks Act 1995*.
[8] *Gray v Motor Accident Commission* [1998] HCA 70; 196 CLR 1; 158 ALR 485; 73 ALJR 45, at 8.
[9] *Zetco Pty Ltd v Austworld Commodities Pty Ltd (No 2)* [2011] FCA 848, at 261 to 269.

element such as flagrancy, deliberate disregard for the IP owner's rights or cynical pursuit of benefits is required.[10]

Additional damages for unjustified threats of infringement are to be awarded under subsection 77(1A) of the Designs Act according to the same principles. For example, additional damages may be warranted where the person making the threat knew they did not have rights over the design in question and there was no prospect of infringement being proven. The objectives of additional damages are that they are felt as a sanction by the person on whom it is imposed and that they act as a deterrent to others. Therefore the appropriate amount to be awarded depends on the specific situation and factors such as the financial means of the party making the unjustified threats and the benefit gained by doing so.

# Olympic Insignia Protection Act 1987

The Olympic Insignia protection provisions relate to 'groundless' rather than 'unjustified' threats as provided in the designs and patents legislation. The term 'groundless' is also used in trade marks legislation however the provisions are interpreted similarly to the provisions in the designs and patents legislation (see items 482 and 483 relating to the Trade Marks Act below). This difference creates unnecessary complexity and confusion in the IP legislation.

### Items 475 to 478: Replace groundless threats with unjustified threats

[Division 3, ss 64, 65]

Items 475, 476 and 478 amend the headings of Division 3, section 64 and section 65 to replace references to a groundless threat with references to an unjustified threat. Item 477 replaces the reference to no grounds for making a threat in paragraph 64(2)(a) with a reference to a threat that is unjustified.

These amendments provide clarity and align the provisions for unjustified threats in the Olympic Insignia Protection Act with the legislation for designs and patents.

# Patents Act 1990

### Item 479: Additional damages

[s 128]

This item inserts new subsection 128(1A) to allow additional damages to be awarded against a person for making flagrant unjustified threats of infringing a patent. The court may award additional damages if it considers it appropriate to do so, having regard to the same matters provided for designs by item 474.

[10] For example, *Pacific Enterprises (Aust) Pty Ltd v Bernen Pty Ltd* [2014] FCA 1372 at 13 to 15; *Halal Certification Authority Pty Limited v Scadilone Pty Limited* [2014] FCA 614, at 95 to 113; *Sullivan v FNH Investments Pty Ltd t/as Palm Bay Hideaway* [2003] FCA 323, at 91 to 111.

# Plant Breeder's Rights Act 1994

## Item 480: Definition of legal practitioner

[s 3]

This item inserts a new definition under subsection 3(1) for 'legal practitioner' as a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory. This term is used is new section 57E introduced by item 481.

## Item 481: Relief from Unjustified threats

[ss 57A, 57B, 57C, 57D, 57E]

This item amends Part 5 of the PBR Act by inserting new sections 57A to 57E to enable a person to apply to a court for relief from unjustified threats of infringement proceedings.

The new provisions are aligned with those provided by the Patents Act[11] and will deter parties from making unjustified threats of infringement of PBR. *The Intellectual Property Laws Amendment Act 2015* enabled PBR infringement proceedings and applications for declaration of non-infringement to be brought in the Federal Circuit Court as well as in the Federal Court. This includes applications for relief from unjustified threats brought under new section 57A.

New section 57A will allow an aggrieved person to apply to the court for relief from unjustified threats of PBR infringement or similar proceedings. Section 57A sets out the remedies available to a threatened party. These remedies apply regardless of whether the person making the threats is entitled to the PBR.

Section 57B provides that the court may grant the relief sought unless the court is satisfied that the person making the threats is the grantee of the PBR in the plant variety and the acts in question infringe or would infringe the PBR. This provision parallels section 129 of the Patents Act.

Subsection 57C(1) allows the respondent of an unjustified threats claim to apply for relief for an infringement of PBR, similar to section 130 of the Patents Act. If the respondent does make such a counter-claim, subsection 57C(2) allows the applicant (the threatened party) to apply for revocation of the PBR without having to make a separate application under section 50 of the PBR Act.

Section 57D provides that merely notifying of the existence of PBR in a plant variety does not constitute a threat of infringement proceedings, similar to section 131 of the Patents Act. This is to ensure that a PBR owner is able to inform another party about the existence of PBR in a plant variety without this being construed as alleging that the other party is infringing the PBR and that the PBR owner may commence infringement proceedings. This is to avoid the perverse situation of it being in a PBR owner's best interest to not inform other parties about its PBR rights in order to avoid possible actions for unjustified threats.

Whether a threat is 'unjustified' is well established in Australian law. Once it has been established that a threat was made, it is prima facie unjustifiable unless the person making the threat establishes that is was justified, such as by the IP right being infringed.[12]

---

[11] Sections 128-132 of the *Patents Act 1990.*

[12] *BLH Engineering and Construction Pty Ltd v Pro 3 Products Pty Ltd* [2015] FCA 833, at [83], [106]-[112]; *B. Braun Melsungen AG v Multigate Medical Devices Pty Ltd* [2014] FCA 1110, at [129]; *Telstra Corporation Limited v Phone Directories Company Pty Ltd* [2014] FCA 568, at [665]; *JMVB Enterprises Pty Ltd v Camoflag Pty Ltd* [2005] FCA 1474 at

Section 57E protects a legal practitioner professionally acting on behalf of a client, from liability to proceedings against an unjustified threat of infringing a PBR. For example, a legal practitioner would be protected if they have issued a notification of infringement following a client's direction to do so.

# Trade Marks Act 1995

Unlike the patent and design legislation, the trade mark provisions relate to 'groundless' rather than 'unjustified' threats, despite the provisions being interpreted similarly.[13] This difference creates unnecessary complexity and confusion in the IP legislation.

Subsection 129(5) currently allows a trade mark owner to stop a groundless threat action by simply bringing infringement proceedings against the person. This can disadvantage the alleged infringer as the infringement proceedings do not have to be successful to stop a groundless threats proceeding.[14]

## Items 482 and 483: Replace groundless threats with unjustified threats

[s 129]

These items amend the heading of section 129 and paragraph 129(2)(a) to replace references to a groundless threat with references to an unjustified threat. This provides clarity and consistency in the provisions for unjustified threats.

## Item 484: Additional damages

[s 129]

This item inserts subsection 129(2A) to allow additional damages to be awarded against a person for making unjustified threats of infringing a trade mark. The award of additional damages will be considered by the court having regard to the same parameters as those introduced by item 474 for designs.

## Item 485: Repeal of provisions preventing an unjustified threats action

[s 129]

This item repeals subsection 129(5) to prevent a trade mark owner from using the commencement of infringement proceedings to avoid an unjustified threats action.

---

[208]-[211]; *Occupational and Medical Innovations Limited (ACN 091 192 871) v Retractable Technologies Inc* [2007] FCA 1364, at [5].

[13] Sections 129-130 of the *Trade Marks Act 1995* and see Edwards v Liquid Engineering 2003 Pty Ltd [2008] FCA 970 at [34].

[14] Davison and Horak, *Shanahan's Australian Law of Trade Marks and Passing Off* (5th ed, 2012), p915 and see also Transport Tyre Sales Pty Ltd v Montana Tyres Rims & Tubes Pty Ltd [1999] FCA 329, where the trade mark owner failed in infringement, but was still able to stop the groundless threats proceeding.

### Item 486: Heading

[s 130]

This item replaces the current heading for section 130 with a new heading 'Counterclaim for infringement' to remove the reference to groundless threats.

## Division 2 – Application and transitional provisions

### Item 487: Application and savings provisions

*Designs*
Item 487(1) provides that the amendments in item 474 to the Designs Act applies to threats referred to in subsection 77(1) that are made on or after commencement.

*Olympic expressions*
Item 487(2) provides that the amendments in items 476 and 477 to the Olympic Insignia Protection Act applies to unjustified threats referred to in subsection 64(1) that are made on or after commencement.

*Patents*
Item 487(3) provides that the amendments in item 479 to the Patents Act applies to threats referred to in subsection 128(1) that are made on or after commencement.

*Plant breeder's rights*
Item 487(4) provides that the amendments in item 481 to the Plant Breeder's Rights Act applies to threats referred to in subsection 57A(1) that are made on or after commencement.

*Trade marks*
Item 487(5) provides that the amendments in items 483, 484 and 486 to the Trade marks Act applies to threats referred to in subsection 129(1) that are made on or after commencement.

Item 487(6) also provides that subsection 129(5) of the Trade marks Act (item 485), continues to apply on and after commencement of this item to an action for infringement of a trade mark begun before that commencement.

# Part 16 – Ownership of PBR and entries in the Register

# Division 1 – Amendments

## Introduction

The amendments introduced by Part 16 clarify and provide certainty about PBR ownership.

## Plant Breeder's Rights Act 1994

### Items 488 to 490: Grant of PBR to multiple breeders

[s 45]

These items amend subsection 45(1) and repeal subsection 45(2) to clarify that PBR may be granted to two or more breeders jointly.

Multiple breeders commonly collaborate to develop a new variety. Subsection 44(11) provides that if PBR is granted to persons who make a joint application, the right is granted to those persons jointly. However, subsection 45(2) of the PBR Act provides that, if two breeders lodge a joint application for PBR, PBR may be granted to them jointly. This implies that no more than two breeders may have a PBR granted to them jointly. This is redundant in light of subsection 44(11) and inconsistent with the definition of 'breeder' in section 3 and with subsections 24(3) and (4).

These items remedy this uncertainty by repealing subsection 45(2) and inserting a clarifying note at the end of subsection 45(1) that makes reference to subsection 44(11).

### Item 491: Registrar's power to rectify the Register

[s 62A]

This item introduces a new section (section 62A) at the end of Part 6 of the PBR Act to provide the Registrar with the power to rectify the Register of a number of errors.

In certain circumstances, the Registrar can amend the Register to ensure that the details are correctly recorded in it. These include where a PBR has been assigned to another party, when conditions have been placed on the grant of a PBR, or when a PBR has been revoked.[15] However, unlike the other IP rights,[16] the PBR Act currently does not enable the Registrar to correct the PBR register where there is an omission, incorrect entry or for various other reasons. This can create uncertainty over the ownership of PBR.

The amendments address this deficiency by inserting a new subsection 62A(1) providing power to the Registrar to rectify the Register in certain circumstances. The circumstances include where an entry is omitted, made without sufficient cause, wrongly existing or has an error or defect.

---

[15] Sections 21, 49 and 51 of the *Plant Breeder's Rights Act 1994*

[16] Section 191A, 192 and paragraph 228(2)(e) of the *Patents Act 1990*, subregulation 10.7(3), *Patents Regulations 1991*, section 216 of the *Trade Marks Act 1995*, regulation 11.2 of the *Trade Marks Regulations 1995*, section 114 and 120 of the *Designs Act 2003* and regulation 9.05 of the *Designs Regulations 2004*.

New subsection 62A(2) requires an application under subsection 62A(1) to amend the Register to be in the approved form. This item also inserts subsection 62A(3) to allow the Registrar to seek further information for the purpose of considering the application.

New subsections 62A(4) and (5) prevent the Registrar from rectifying the Register in certain situations. To ensure procedural fairness, subsection 62(4) requires an applicant, grantee or any other appropriate person to be given a reasonable opportunity to be heard before the Register is rectified. Subsection 62A(5) prevents the Registrar from rectifying the Register under section 62A while relevant proceedings are pending, to ensure the result of the proceedings are not pre-empted. Section 77 of the PBR Act allows a number of decisions relating to the grant, infringement and revocation of PBR to be reviewed by the AAT, so these are included as relevant for the purposes of subsection (5).

### Item 492: Review of the Registrar's decision

[s 77]

This item inserts paragraph 77(1)(d) to provide that the Registrar's decision to rectify or refuse to rectify the Register under new section 62A (inserted by item 491) is reviewable by the AAT.

### Item 493: Power to make regulations

[s 80]

This item amends paragraph 80(2)(d) to allow regulations to be made for amending the Register for any other purpose. This is consistent with the scope provided by paragraph 228(2)(e) of the Patents Act.

## Division 2 – Application and transitional provisions

### Item 494: Application Provision

This item provides that the amendments in item 491 will apply to PBR in a plant variety granted before, on or after commencement and to entries made in the Register before, on or after commencement. This enables corrections to be made in respect of all PBR on the Register, regardless of when they were granted.

# Part 17 – Trade mark oppositions

# Division 1 – Amendments

## Introduction

The amendments made under this part ensure consistency with international obligations and correct references made to opposition proceedings.

## Trade Marks Act 1995

### Item 495: Security for costs

[s 222]

This item corrects references in section 222 to provide that the Registrar may require a person to give security for the costs of a wider range of opposition proceedings.

Currently, section 222 provides that, if a person who neither resides nor carries on business in Australia gives notice of an opposition under section 52 or subsection 224(6), the Registrar may require the person to give security for the costs of the proceeding. This fails to refer to all relevant proceedings.

This item inserts references to opposition proceedings under subsections 65A(4) and 83A(4). This enables the Registrar to impose such requirements in relation to oppositions to amendments after particulars of the application have been advertised and oppositions to amendments proposed to ensure consistency with international obligations.

### Item 496: Regulations

[s 231]

This item amends section 231 to provide the necessary power to make regulations for the purposes of opposition proceedings under sections 65A and 83A.

Currently, the Trade Mark Regulations do not set out in the regulations the procedures to be followed for oppositions under section 83A. The amendment to section 231 enables such regulations to be made to correct this oversight.

# Division 2 – Application and transitional provisions

### Item 497: Application provision

This item provides that the amendments in item 495 will apply in relation to requests made on or after commencement.

# Part 18 – Seizure notices

# Division 1 – Amendments

## Introduction

The amendments introduced by part 18 provide the Comptroller-General with flexibility on how seizure notices are provided and whether personal information is excluded for confidentiality reasons.

## Copyright Act 1968

### Items 498 and 499: Customs notices of seizure

[s 135AC]

These items amend section 135AC of the Copyright Act to provide the Australian Border Force with flexibility on how seizure notices are issued and what information is to be included on those notices.

The Copyright Act enables the Comptroller-General of Customs (the Comptroller-General) to seize and deal with goods imported into Australia which infringe or appear to infringe copyrighted material.[17] Upon seizure, the Comptroller-General is required to issue a written notice to the importer of the goods and to the objector (copyright owner) identifying seizure of the goods. While the *Electronic Transactions Act 1999*[18] and the *Customs Act 1901*[19] enable such notices to be delivered electronically, subsection 135AC(1) requires that the Comptroller-General provide seizure notices 'either personally or by post'. Additionally, paragraphs 135AC(3)(c) and 135AC(3)(d) require the name and address of the importer and objector to be included in the notices.

The requirement to provide seizure notices 'either personally or by post' prevents the use of quicker and lower cost electronic means. The requirement that personal information be included in the seizure notices means that this information must be provided even where there are concerns about the confidentiality of the parties involved.

The amendments remedy these problems by providing the Comptroller-General with flexibility on how seizure notices are provided and whether to include the name and address of the importer and objector in the notice. This information will not be included if the Comptroller-General is satisfied, for reasons of confidentiality, that it is not desirable to do so.

## Olympic Insignia Protection Act 1987

### Items 500 and 501: Customs notices of seizure

[s 55]

These items amend section 55 of the Olympic Insignia Protection Act to provide the Australian Border Force with flexibility on how seizure notices are issued and what information is to be included on those notices.

---

[17] Part V, Division 7, Copyright Act.
[18] Section 9 *Electronic Transactions Act 1999* (Cth).
[19] As an example, section 77EB, *Customs Act 1901* (Cth).

Similar to section 134 of the Copyright Act as detailed above, section 55 of the Olympic Insignia Protection Act requires the Comptroller-General provide seizure notices 'either personally or by post' and does not enable personal information to be omitted from such notices where there are concerns about the confidentiality of the parties involved. These items address these problems by providing the Comptroller-General with flexibility on how seizure notices are provided and whether to include the name and address of the designated owner in the notice.

## Trade Marks Act 1995

### Items 502 and 503: Customs notices of seizure

[s 134]

These items amend section 134 of the Trade Marks Act to provide the Australian Border Force with flexibility on how seizure notices are issued and what information is to be included on those notices.

Similar to the provisions in the Copyright Act as detailed above, the Trade Marks Act requires the Comptroller-General provide seizure notices 'either personally or by post' and does not enable personal information to be omitted from such notices where there are concerns about the confidentiality of the parties involved. These items address these problems by providing the Comptroller-General with flexibility on how seizure notices are provided and whether to include the name and address of the designated owner and objector in the notice.

# Division 2 – Application and transitional provisions

### Item 504: Application Provisions

*Copyright*
Item 504(1) provides that the amendments to section 135AC of the Copyright Act apply to seizure notices given under subsection 135AC(1) of that Act on or after commencement.

*Olympic expressions*
Item 504(2) provides that the amendments to section 55 of the Olympic Insignia Protection Act apply to seizure notices given under subsection 55(1) of that Act on or after commencement.

*Trade marks*
Item 504(3) provides that the amendments to section 134 of the Trade Marks Act apply to seizure notices given under subsection 134(1) of that Act on or after commencement.

# Part 19 – Publishing personal information of registered patent or trade marks attorneys

# Division 1 – Amendments

## Introduction

This part introduces new provisions to ensure that the Professional Standards Board for Patent and Trade Marks Attorneys (the Board) can publish certain personal information of registered patent and/or trade marks attorneys. Upon effect of Schedule 4 to the *Intellectual Property Laws Amendment Act 2015,* the Board will be renamed the Trans-Tasman IP Attorneys Board to reflect the new trans-Tasman patent attorney regime due to commence in February 2017. These amendments provide transparency so that members of the public can easily access information to verify whether an attorney is registered to practice in Australia (or New Zealand). They also ensure Australia complies with its obligation under the Bilateral Arrangement with New Zealand to make the name and address details of registered patent attorneys publically available.

## Patents Act 1990

### Items 505 and 506: Disclosure and publication of personal information of patent attorneys

[ss 183, 227B]

These items insert new subsections 183(1A) and section 227B in the Patents Act to enable the Board to publish specified personal information of an individual or company registered as a patent attorney.

The Designated Manager (the Director General of IP Australia) registers IP attorneys in Australia.[20] The Board administers the regulatory and disciplinary regime for IP attorneys in Australia (and soon to be expanded to include New Zealand).[21] It is illegal for an IP attorney to practice without being registered.[22]

Currently, the Board publishes the name and contact address of registered IP attorneys on its website. This enables the public to identify whether an individual or company is registered as an IP attorney. IP attorneys can use a business address, PO Box or their place of residence as their contact address on the Board's website. The privacy notices on the Board's website and on the registration and renewal notices inform IP attorneys that their personal information will be published by the Board. The Australian Privacy Principles in the *Privacy Act 1988*[23] allow the Board to disclose the personal information of registered attorneys in line with the privacy notices published by the Board.

In 2013, Australia and New Zealand signed a Bilateral Arrangement for the trans-Tasman regulation of patent attorneys. This arrangement is being implemented by Schedule 4 to the *Intellectual Property Laws*

[20] Section 198, *Patents Act 1990*; section 228A *Trade Marks Act 1995*.
[21] Chapter 20, Patents Act 1990; sections 228A-229, Trade Marks Act 1995.
[22] Section 201, Patents Act 1990; section 156, Trade Marks Act 1995.
[23] Part III Division 2 and Schedule 1, *Privacy Act 1988*, in particular Australian Privacy Principle 6.

*Amendment Act 2015*. The Arrangement provides that the name and address details of registered patent attorneys will be made publicly available.[24]

The amendments under items 505 and 506 are intended to ensure that, upon enactment of the new trans-Tasman patent attorney regime, the Designated Manager can share relevant personal information about attorneys or prospective attorneys with the Board. This information would have been provided to the Designated Manager by the attorney or prospective attorney for example, through the registration or renewal process.

The amendments will also ensure that the Board can publish specified information about registered attorneys. Therefore, where a patent attorney does not provide consent for his or her personal details to be published and does not provide legitimate reasons to support this, the Board may wish to publish the information anyway, in the interest of the public. This information includes the name of the patent attorney, the State or Territory in which the attorney's work address is located, and the attorney's work email address.

The amendments also provide the Designated Manager and the Board with the discretion to not provide or publish some or all of this information where this is warranted for confidentiality reasons. The amendments also provide that the Board may publish other personal information about a registered patent attorney with the attorney's written consent.

The intention of the amendments is to enable the public to readily verify that an attorney is registered to practice in Australia or New Zealand. The amendments reduce the risk of businesses using unqualified people to prosecute their IP rights who are not registered to practice as IP attorneys in Australia or New Zealand, while complying with the Australian Privacy Principles. They would also ensure compliance with the Bilateral Arrangement with New Zealand.

# Trade Marks Act 1995

## Items 507 and 508: Disclosure and publication of personal information of trade mark attorneys

[ss 229AA, 229B]

This item inserts new subsections 229AA(1) and section 229B in the Trade Marks Act to enable the Board to publish specified personal information of an individual or company that is a registered trade mark attorney.

These amendments are in line with amendments made applying to patent attorneys detailed in items 505 and 506 above. While there will not be a trans-Tasman trade mark attorney regime, it is still important that the public can easily verify that a trade mark attorney is registered to practice in Australia.

[24] *Arrangement between the Government of Australia and the Government of New Zealand relating to trans-Tasman regulation of patent attorneys*, March 2013, paragraph 4.9.

# Division 2 – Application and transitional provisions

### Item 509: Application Provisions

This item provides that the amendments made by this Part will apply to personal information obtained about a registered patent attorney or a registered trade marks attorney regardless of when that attorney was registered.

# Part 20 – Prosecutions

# Division 1 – Amendments

## Introduction

Section 201 of the Patents Act and section 156 of the Trade Marks Act provide for a number of criminal offences relating to unauthorised and fraudulent conduct by members of the attorney professions. A prosecution for some of these offences must be brought within five years of the offence being committed, instead of the one year limit provided under the *Crimes Act 1914*.[25] A longer time frame for prosecuting attorney offences is necessary as the process to apply for an IP right is often lengthy and it can take a number of years before offences are identified.

The reforms made by the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* included allowing attorney firms to be incorporated and added offences to cover such firms. The intention was that the new offences for incorporated attorney firms would also have a five year prosecution period. Due to a drafting oversight, the five year prosecution period was not applied to these offences.

## Patents Act 1990

### Items 510 and 511: Time for starting prosecutions

[s 204]

These items amend section 204 of the Patents Act to include references to subsections 201(6), 201B(1) and 201B(2) and to section 202B. These amendments align the time frame to prosecute offences committed by incorporated attorneys with the five year time frame to prosecute offences committed by individual attorneys.

## Trade Marks Act 1995

### Item 512: Subsection heading

[s 156]

This item introduces a new heading for subsection 156(4) to more accurately reflect the content of this provision.

### Item 513: Time for starting prosecutions

[s 157A]

This item inserts new subsection 157A(9) into the Trade Marks Act to provide that offences committed by incorporated trade mark attorney firms will have a five year prosecution period, in line with the prosecution period for individual trade mark attorneys.

---

[25] Paragraph 15B(1A)(b) of the *Crimes Act 1914*.

# Division 2 – Application provision

### Item 514: Application Provision

This item provides that the amendments in items 510 to 513 apply to offences committed on or after the commencement of this Act.

# Part 21 – Secretary's role in the Plant Breeder's Rights Act

# Division 1 – Amendments

## Introduction

The amendments introduced by part 21 transfer the powers and obligations of the Secretary of the Department of Industry, Innovation and Science to the Registrar of PBR to reflect existing practice and ensure alignment with the other IP rights legislation.

## Plant Breeder's Rights Act 1994

### Items 515 to 574: Devolution of Secretary's powers and obligations to the Registrar

[ss 3,8, 12, 19, 24, 26, 28 to 41, 44 to 51, 54, 58 to 61, 68, 70, 71, 73, 75, 77, 80]

These items amend the Plant Breeder's Rights Act to devolve the powers and obligations of the Secretary of the Department of Industry, Innovation and Science to the Registrar of PBR.

Currently under the PBR legislation, the Secretary of the Department of Industry, Innovation and Science has the powers, functions and obligations to administer the PBR system. This includes receiving applications, approving forms and granting rights. The Registrar of PBR is responsible for maintaining the Register of PBR and some other functions. However, in practice the powers, functions and duties of the Secretary are delegated to the IP Australia senior executive. This division of functions is different to the other IP rights, where the Commissioner of Patents, the Registrar of Trade Marks and the Registrar of Designs have responsibility to administer those systems. The reason for the difference is mostly historical; the PBR legislation was drafted when it was within the responsibilities of the Department of Agriculture and is therefore not aligned with the other IP rights legislation.

It is not appropriate for the Secretary to have administrative powers at such an operational level. The PBR legislation is also less transparent because it does not reflect actual practice. The Registrar of PBR is the most appropriate person to have statutory responsibility for the PBR system as the Registrar has the most relevant experience, resources and knowledge of the system.

These items omit and repeal references to the 'Secretary' and, where appropriate, substitute and insert provisions regarding the 'Registrar' in order to devolve the Secretary's powers and obligations to the Registrar. These amendments better align the PBR Act with the other IP rights legislation, better reflect actual practice and improve transparency.

Items 515 and 519 repeal the definition of 'approved form' in subsection 3(1) and substitute a new definition, wherein the Registrar may, by writing, approve a form for the purposes of a provision of this Act.

Items 569 and 572 move the provision that the AAT may review the Registrar's decision under section 21 to subparagraph 77(1)(b)(iva).

# Division 2 – Application and transitional provisions

### Item 575: Saving and transitional provisions

This item inserts transitional provisions into the Plant Breeder's Rights Act to ensure that things done by, or in relation to, the Secretary before the commencement of this item are considered as though they had been done by, or in relation to, the Registrar.

Sub-item (3) provides for continuity to ensure that if a person held or performed the duties of the office of Secretary before commencement of this item that person cannot apply for PBR in a plant variety within 12 months of holding that position despite repeal of paragraph 60(1) of the Act.

Sub-item (4) provides for continuity in that a decision of the Registrar under section 21 to amend, or refuse to amend, the Register that is made before commencement of this item continues to be reviewable by the AAT, despite repeal of paragraph 77(1)(c) of the Act.

# Part 22 – Updating references to the Designs Act

## Olympic Insignia Protection Act 1987

### Items 576 to 585: References to the Designs Act

[ss 2, 10, 12, 13, 18, 20]

These items amend the Olympic Insignia Protection Act to update references to the correct provisions in the *Designs Act 2003*. Currently, references are to the *Designs Act 1906*.

# Part 23 – Other amendments

# Division 1 – Amendments

## Introduction

This part removes the Plant Breeder's Rights Advisory Committee (PBRAC) from the PBR Act, and repeals a redundant provision.

## Plant Breeder's Act 1994

### Items 586 to 595: Plant Breeder's Rights Advisory Committee

[ss 3, 42, 49, 63 to 67, 69, 85]

These items remove all references to the Plant Breeder's Rights Advisory Committee (PBRAC) from the PBR Act.

The PBRAC is a statutory body established and administered under Part 7 of the PBR Act. Its functions are to advise the government on matters related to the PBR Act.[26] In March 2014, the National Commission of Audit (the Commission) released recommendations for rationalising agencies, boards and committees as part of streamlining the structure and operation of the Australian Public Service. The Commission recommended that the functions of the PBRAC be considered for consolidation into the portfolio department. Having a statutory body provide PBR advice to the government increases costs and complexity and does not provide sufficient flexibility regarding the operation and membership of such a body.

The amendments remedy this problem by removing the PBRAC from the PBR Act. A more flexible, non-statutory mechanism will provide specialised advice on PBR matters.

Item 590 amends subsection 49(2) to enable the Minister to impose conditions on the grant of PBR as the Minister considers to be necessary in the public interest, rather than as appropriate. This is to ensure consistency with Article 17 of the 1991 International Convention for the Protection of New Varieties of

[26] See the Explanatory Memorandum to the *Plant Breeder's Rights Bill 1994* and subsection 63(2).

Plants (1991 UPOV Convention). This article provides that, except where expressly provided in the Convention, no Contracting Party may restrict the free exercise of a breeder's right for reasons other than of public interest.

### Item 587: Redundant bridging provision

[s 42]

This item repeals section 42 of the PBR Act to remove a redundant provision.

Section 42 of the PBR Act provides a regulation-making power to exclude application of the PBR Act to a specified taxon. The *Plant Variety Rights Act 1987* conformed to the 1978 International Convention for the Protection of New Varieties of Plants and only applied to plant varieties declared by regulation. The Plant Variety Rights Act was replaced by the PBR Act 1994, which applies to all plant varieties except where excluded by regulation under section 42. Section 42 was a bridging measure covering the period between commencement of the PBR Act and commencement of Australia's obligations under the 1991 UPOV Convention. The 1991 UPOV Convention entered into force in Australia on 20 January 2000, rendering section 42 redundant.

## Division 2 – Application and transitional provisions

### Item 596: Transitional provisions

Item 596 ensures that any views given by PBRAC to the Minister, and any documents in the possession of the PBRAC, are dealt with appropriately.