

EXPOSURE DRAFT

2016-2017

The Parliament of the
Commonwealth of Australia

HOUSE OF REPRESENTATIVES/THE SENATE

EXPOSURE DRAFT

Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Bill 2017

No. , 2017

(Industry, Innovation and Science)

**A Bill for an Act to amend legislation relating to
intellectual property, and for related purposes**

EXPOSURE DRAFT

EXPOSURE DRAFT

Contents

1	Short title.....	5
2	Commencement.....	5
3	Schedules.....	6
Schedule 1—Responses to the Productivity Commission		7
Part 1—Parallel importation		7
<i>Copyright Act 1968</i>		7
<i>Trade Marks Act 1995</i>		7
Part 2—PBR in essentially derived varieties		10
Division 1—Amendments		10
<i>Plant Breeder’s Rights Act 1994</i>		10
Division 2—Application of amendments		24
Part 3—Period to apply for removal of trade marks from Register for non-use		25
<i>Trade Marks Act 1995</i>		25
Part 4—Innovation patents		26
<i>Patents Act 1990</i>		26
Part 5—Notification of extension of standard patents relating to pharmaceutical substances		28
<i>Patents Act 1990</i>		28
Schedule 2—Other measures		29
Part 1—Amending trade mark applications—non-legal persons		29
<i>Trade Marks Act 1995</i>		29
Part 2—Written requirements		30
Division 1—Amendments		30
<i>Designs Act 2003</i>		30
<i>Patents Act 1990</i>		34
<i>Plant Breeder’s Rights Act 1994</i>		35

EXPOSURE DRAFT

<i>Trade Marks Act 1995</i>	42
Division 2—Application and saving provisions	43
Part 3—Filing requirements	45
Division 1—Amendments	45
<i>Designs Act 2003</i>	45
<i>Patents Act 1990</i>	48
<i>Plant Breeder’s Rights Act 1994</i>	52
<i>Trade Marks Act 1995</i>	54
Division 2—Application, saving and transitional provisions	58
Part 4—Signatures	61
<i>Patents Act 1990</i>	61
Part 5—Computerised decision-making	62
<i>Designs Act 2003</i>	62
<i>Patents Act 1990</i>	63
<i>Plant Breeder’s Rights Act 1994</i>	65
<i>Trade Marks Act 1995</i>	66
Part 6—Addresses and service of documents	69
<i>Plant Breeder’s Rights Act 1994</i>	69
Part 7—Requirements for patent documents	71
<i>Patents Act 1990</i>	71
Part 8—Unjustified threats of infringement	75
Division 1—Amendments	75
<i>Designs Act 2003</i>	75
<i>Olympic Insignia Protection Act 1987</i>	75
<i>Patents Act 1990</i>	76
<i>Plant Breeder’s Rights Act 1994</i>	76
<i>Trade Marks Act 1995</i>	78
Division 2—Application and saving provisions	79
Part 9—Ownership of PBR and entries in the Register	81

EXPOSURE DRAFT

<i>Plant Breeder's Rights Act 1994</i>	81
Part 10—Trade mark oppositions	84
<i>Trade Marks Act 1995</i>	84
Part 11—Further power to award damages under the Plant Breeder's Rights Act	85
<i>Plant Breeder's Rights Act 1994</i>	85
Part 12—Exclusive licensees in the Plant Breeder's Rights Act	87
<i>Plant Breeder's Rights Act 1994</i>	87
Part 13—Publishing personal information of registered patent or trade marks attorneys	90
Division 1—Amendments	90
<i>Patents Act 1990</i>	90
<i>Trade Marks Act 1995</i>	91
Division 2—Application provisions	92
Part 14—Secretary's role in the Plant Breeder's Rights Act	93
<i>Plant Breeder's Rights Act 1994</i>	93
Part 15—Seizure notices	99
Division 1—Amendments	99
<i>Copyright Act 1968</i>	99
<i>Olympic Insignia Protection Act 1987</i>	99
<i>Trade Marks Act 1995</i>	100
Division 2—Application provisions	100
Part 16—Prosecutions	102
Division 1—Amendments	102
<i>Patents Act 1990</i>	102
<i>Trade Marks Act 1995</i>	102
Division 2—Application provision	103
Part 17—Updating references to Designs Act	104
<i>Olympic Insignia Protection Act 1987</i>	104

EXPOSURE DRAFT

Part 18—Removing certain references to New Zealand	106
<i>Patents Act 1990</i>	106
Part 19—International Convention for the Protection of New Varieties of Plants	108
<i>Plant Breeder’s Rights Act 1994</i>	108
Part 20—Other amendments	111
<i>Patents Act 1990</i>	111
<i>Plant Breeder’s Rights Act 1994</i>	111
Part 21—Repeals of Acts	112
<i>Patents Amendment (Patent Cooperation Treaty) Act 1979</i>	112

EXPOSURE DRAFT

1
2 **A Bill for an Act to amend legislation relating to**
3 **intellectual property, and for related purposes**

4 The Parliament of Australia enacts:

5 **1 Short title**

6 This Act is the *Intellectual Property Laws Amendment*
7 *(Productivity Commission Response Part 1 and Other Measures)*
8 *Act 2017.*

9 **2 Commencement**

- 10 (1) Each provision of this Act specified in column 1 of the table
11 commences, or is taken to have commenced, in accordance with
12 column 2 of the table. Any other statement in column 2 has effect
13 according to its terms.
14

Commencement information

Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table	The day this Act receives the Royal Assent.	
2. Schedule 1, Part 1	The day after this Act receives the Royal Assent.	
3. Schedule 1, Parts 2 and 3	A single day to be fixed by Proclamation. However, if the provisions do not commence within the period of 6 months beginning on the day this Act receives the Royal Assent, they commence on the day after the end of that period.	
4. Schedule 1, Part 4	The day after the end of the period of 12 months beginning on the day this Act receives the Royal Assent.	

No. , 2017 *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Bill 2017*

5

EXPOSURE DRAFT

EXPOSURE DRAFT

Commencement information		
Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
5. Schedule 1, Part 5	The day after this Act receives the Royal Assent.	
6. Schedule 2, Part 1	The day after this Act receives the Royal Assent.	
7. Schedule 2, Parts 2 and 3	At the same time as the provisions covered by table item 3.	
8. Schedule 2, Parts 4 and 5	The day after this Act receives the Royal Assent.	
9. Schedule 2, Parts 6 to 12	At the same time as the provisions covered by table item 3.	
10. Schedule 2, Part 13	The day after this Act receives the Royal Assent.	
11. Schedule 2, Part 14	At the same time as the provisions covered by table item 3.	
12. Schedule 2, Parts 15 to 21	The day after this Act receives the Royal Assent.	

1 Note: This table relates only to the provisions of this Act as originally
2 enacted. It will not be amended to deal with any later amendments of
3 this Act.

4 (2) Any information in column 3 of the table is not part of this Act.
5 Information may be inserted in this column, or information in it
6 may be edited, in any published version of this Act.

7 **3 Schedules**

8 Legislation that is specified in a Schedule to this Act is amended or
9 repealed as set out in the applicable items in the Schedule
10 concerned, and any other item in a Schedule to this Act has effect
11 according to its terms.

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
Parallel importation **Part 1**

1 **Schedule 1—Responses to the Productivity**
2 **Commission**

3 **Part 1—Parallel importation**

4 *Copyright Act 1968*

5 **1 Section 198A**

6 Repeal the section.

7 *Trade Marks Act 1995*

8 **2 After section 122**

9 Insert:

10 **122A International exhaustion of registered trade mark in relation**
11 **to goods**

- 12 (1) In spite of section 120, a person who uses a registered trade mark
13 in relation to goods does not infringe the trade mark if:
- 14 (a) the goods are:
 - 15 (i) similar to goods in respect of which the trade mark is
16 registered; or
 - 17 (ii) closely related to services in respect of which the trade
18 mark is registered; and
 - 19 (b) the goods have been put on the market in Australia or a
20 foreign country; and
 - 21 (c) at the time of use, it was reasonable for the person to assume
22 the trade mark had been applied to, or in relation to, the
23 goods by, or with the consent of, a person who was, at the
24 time of the application or consent (as the case may be):
 - 25 (i) the registered owner of the trade mark; or
 - 26 (ii) an authorised user of the trade mark; or
 - 27 (iii) a person authorised to use the trade mark by a person
28 mentioned in subparagraph (i) or (ii), or with significant
-

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 1 Parallel importation

1 influence over the use of the trade mark by such a
2 person; or

3 (iv) an associated entity (within the meaning of the
4 *Corporations Act 2001*) of a person mentioned in
5 subparagraph (i), (ii) or (iii).

6 Note: For goods that are *similar*, see subsection 14(1).

7 (2) A reference in paragraph (1)(c) to consent to the application of a
8 trade mark to, or in relation to, goods includes, without limitation,
9 a reference to:

10 (a) consent subject to a condition (for example, a condition that
11 the goods are to be sold only in a foreign country); and

12 (b) consent that can be reasonably inferred from the conduct of a
13 person mentioned in subparagraph (1)(c)(i), (ii), (iii) or (iv).

14 (3) In determining whether the first-mentioned person in
15 subparagraph (1)(c)(iii) was authorised to use the trade mark or had
16 significant influence over its use, disregard how that authority or
17 influence arose, for example:

18 (a) whether it arose directly or indirectly; or

19 (b) whether it arose by way of proprietary interest, contract,
20 arrangement, understanding, a combination of those things,
21 or otherwise.

22 **3 Section 123 (heading)**

23 Repeal the heading, substitute:

24 **123 Services to which registered trade mark has been applied by or** 25 **with consent of registered owner**

26 **4 Subsection 123(1)**

27 Repeal the subsection.

28 **5 Subsection 123(2)**

29 Omit “(2)”.

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
Parallel importation **Part 1**

1 **6 Application of amendments**

- 2 (1) Despite the repeal of section 198A of the *Copyright Act 1968* by this
3 Part, that section continues to apply in relation to proceedings begun
4 under that Act before the commencement of this item.
- 5 (2) The amendments of the *Trade Marks Act 1995* made by this Part apply
6 in relation to an action for the infringement of a trade mark begun on or
7 after the commencement of this item, even if the infringement of the
8 trade mark is alleged to have occurred before that commencement.

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

1 **Part 2—PBR in essentially derived varieties**

2 **Division 1—Amendments**

3 ***Plant Breeder’s Rights Act 1994***

4 **7 Subsection 3(1)**

5 Insert:

6 *commercial-in-confidence* has the meaning given by
7 subsection 41B(6).

8 *essentially derived*, in relation to a plant variety, has the meaning
9 given by section 4.

10 **8 Subsection 3(1) (at the end of the definition of *grantee*)**

11 Add:

12 Note: For declarations of essential derivation, see sections 40 and 41D.

13 **9 Section 4 (heading)**

14 Repeal the heading, substitute:

15 **4 Definition of *essentially derived***

16 **10 Section 4**

17 Omit “taken to be an essentially derived variety”, substitute “an
18 *essentially derived* variety”.

19 **11 At the end of section 4**

20 Add:

21 Note: For declarations of essential derivation, see sections 40 and 41D.

22 **12 Section 12**

23 Repeal the section, substitute:

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
PBR in essentially derived varieties **Part 2**

1 **12 Extension of PBR to cover essentially derived varieties**

2 Subject to section 23 (exhaustion of PBR), if PBR is granted in a
3 plant variety (the *initial variety*), and a declaration is made that
4 another plant variety is essentially derived from the initial variety,
5 the right granted in the initial variety extends, with effect from the
6 date of declaration, to that other plant variety.

7 Note: For declarations of essential derivation, see sections 40 and 41D.

8 **13 Paragraph 22(5)(b)**

9 Omit “under section 40”.

10 **14 At the end of subsection 22(5)**

11 Add:

12 Note: For declarations of essential derivation, see sections 40 and 41D.

13 **15 At the end of subsection 23(2)**

14 Add:

15 Note: For declarations of essential derivation to which this subsection
16 applies, see section 40.

17 **16 Subparagraph 34(4)(b)(ii)**

18 After “section 41”, insert “or 41E (both of which deal with test growing
19 of essentially derived varieties)”.

20 **17 Section 40 (heading)**

21 Repeal the heading, substitute:

22 **40 Essential derivation for PBR-protected varieties—declaration**

23 **18 At the end of subsection 40(1)**

24 Add:

25 Note 1: If the breeder of the second variety has not applied for, or been
26 granted, PBR in the second variety, the grantee of PBR in the initial
27 variety may apply under section 41A for a declaration that the second
28 variety is essentially derived from the initial variety.

29 Note 2: If an application for PBR in the second variety is made after an
30 application is made under section 41A in relation to that variety, the

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

1 application under section 41A may be treated as if it were an
2 application under this section (see section 41F).

3 **19 Subsection 40(12)**

4 After “a declaration”, insert “under this section”.

5 **20 At the end of section 40 (before the note)**

6 Add:

7 Note 1: Section 19 requires the grantee of PBR in a plant variety to take
8 reasonable steps to ensure reasonable public access to the plant
9 variety.

10 **21 Section 40 (note)**

11 Omit “Note”, substitute “Note 2”.

12 **22 Section 41 (heading)**

13 Repeal the heading, substitute:

14 **41 Essential derivation for PBR-protected varieties—test growing**

15 **23 Paragraph 41(1)(a)**

16 After “applies”, insert “under section 40”.

17 **24 Subsection 41(5)**

18 After “further test growing”, insert “under this section”.

19 **25 At the end of Part 3**

20 Add:

21 **41A Essential derivation for non-PBR-protected second varieties—**
22 **application for declaration**

23 *Circumstances in which application may be made*

24 (1) The grantee of PBR in a plant variety (the *initial variety*) may
25 apply in writing to the Registrar for a declaration under
26 section 41D that another variety (the *second variety*) is essentially
27 derived from the initial variety if:

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
PBR in essentially derived varieties **Part 2**

- 1 (a) PBR has not been applied for, or granted, in the second
2 variety; and
3 (b) the grantee of PBR in the initial variety is satisfied that the
4 second variety is essentially derived from the initial variety;
5 and
6 (c) the initial variety has not itself been declared (under
7 section 40 or 41D) to be essentially derived from another
8 variety in which PBR has been granted.

9 Note: Before making the application, the grantee must give notice of the
10 application to the person reasonably believed to be the breeder of the
11 second variety (see section 41B).

12 *Content of application*

- 13 (2) The application must:
14 (a) be in the approved form; and
15 (b) be accompanied by such fee (if any) as is prescribed by the
16 regulations in respect of the application.
- 17 (3) An application must contain:
18 (a) such information as is required by the form that is relevant to
19 establishing, on the balance of probabilities, that the second
20 variety is:
21 (i) essentially derived from the initial variety; and
22 (ii) a registrable plant variety within the meaning of
23 section 43; and
24 (b) evidence, in an approved form, that the applicant has
25 complied with subsection 41B(1), or that the applicant cannot
26 comply with that subsection despite taking reasonable steps
27 to do so.

28 Note: Subsection 41B(1) requires the applicant to give the breeder of
29 the second variety notice of the application.

30 **41B Essential derivation for non-PBR-protected varieties—notice** 31 **and publication of applications**

32 *Notice by applicant to second variety breeder*

- 33 (1) An applicant under section 41A for a declaration under
34 section 41D that a plant variety (the *second variety*) is essentially
-

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

1 derived from another plant variety must, before applying, give the
2 person the applicant reasonably believes to be the breeder of the
3 second variety written notice of the application including:

- 4 (a) a copy of the application; and
5 (b) any information about the applicant and the application, and
6 any related information, prescribed by regulations made for
7 the purposes of this paragraph.

8 (2) The Registrar must refuse to consider an application under
9 section 41A if satisfied that the applicant has failed to comply with
10 subsection (1) of this section, unless the Registrar is satisfied that
11 the applicant, after taking reasonable steps, cannot comply with
12 that subsection.

13 Note: A decision under this subsection is reviewable by the AAT under
14 section 77.

15 *Publication of notification of application*

16 (3) As soon as practicable after an application under section 41A is
17 made, the Registrar must publish a notification of the application in
18 the *Plant Varieties Journal* including information about the
19 applicant and the application, and any related information,
20 prescribed by regulations made for the purposes of this subsection.

21 (4) At any time or times before making a decision on the application,
22 the Registrar may publish further notification of the application in
23 the *Plant Varieties Journal*, including information (or updated
24 information) about the matters prescribed by regulations made for
25 the purposes of subsection (3).

26 (5) However, the Registrar must not publish any information in a
27 notification under subsection (3) or (4) if the Registrar is satisfied
28 that the information is commercial-in-confidence.

29 Note: A decision not to publish information for this reason is reviewable by
30 the AAT under section 77.

31 (6) Information is ***commercial-in-confidence*** if the applicant
32 demonstrates to the Registrar that:

- 33 (a) release of the information would cause competitive detriment
34 to the applicant; and
35 (b) the information is not in the public domain; and
-

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
PBR in essentially derived varieties **Part 2**

- 1 (c) the information is not required to be disclosed under another
2 Australian law; and
3 (d) the information is not readily discoverable.

4 **41C Essential derivation for non-PBR-protected varieties—** 5 **opportunity to be heard**

6 *Opportunity to be heard for interested persons*

- 7 (1) Before making a decision in relation to an application under
8 section 41A for a declaration under section 41D that a plant variety
9 (the *second variety*) is essentially derived from another plant
10 variety, the Registrar must give an opportunity to be heard under
11 this section to a person (an *interested person*) claiming:
12 (a) to be the breeder of the second variety; or
13 (b) to have another interest in the second variety.
- 14 (2) Subsection (1) only applies if, within 2 months after notification of
15 the application is last published in the *Plant Varieties Journal*, the
16 interested person gives the Registrar an address for service in
17 Australia or New Zealand.

18 *Information given in accordance with the opportunity to be heard*

- 19 (3) For the purposes of section 41D, information is given by an
20 interested person in accordance with the person's opportunity to be
21 heard if the information is given in accordance with regulations
22 prescribed for the purposes of this subsection.
- 23 (4) Regulations made for the purposes of subsection (3) may, without
24 limiting that subsection, include reasonable requirements in
25 relation to the following:
26 (a) the giving of written information at the request of the
27 Registrar;
28 (b) the giving of oral information at a hearing convened by the
29 Registrar;
30 (c) when, where and in what circumstances such a hearing may
31 be convened;
32 (d) the practice and procedure for any such hearings, including
33 provision for the Registrar to determine such practice and

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

- 1 procedure (whether generally or in relation to a particular
2 hearing);
3 (e) the payment of any fees that are prescribed by the regulations
4 in relation to the opportunity to be heard.

5 *Interested person declines the opportunity to be heard*

- 6 (5) For the purposes of section 41D, an interested person declines the
7 opportunity to be heard if the person:
8 (a) gives the Registrar notice that the person does not want to be
9 heard; or
10 (b) fails to give any information in accordance with the person's
11 opportunity to be heard under subsection (3).

12 **41D Essential derivation for non-PBR-protected varieties—** 13 **declaration**

14 *Making the decision*

- 15 (1) On an application under section 41A for a declaration under this
16 section that a plant variety (the *second variety*) is essentially
17 derived from another plant variety (the *initial variety*), the
18 Registrar may:
19 (a) declare in writing that the second variety is essentially
20 derived from the initial variety; or
21 (b) refuse to make such a declaration.

22 Note 1: A decision under this section is reviewable by the AAT under
23 section 77.

24 Note 2: The Registrar must refuse to make a declaration under this section if
25 the applicant fails to comply with a requirement under
26 paragraph 41E(3)(a) in relation to a test growing.

27 Note 3: The Registrar must not make a decision under this section if an
28 application for PBR in the second variety is made under section 24
29 (see section 41F).

- 30 (2) The Registrar must make a declaration under subsection (1) if, and
31 only if:
32 (a) he or she is satisfied on the balance of probabilities that the
33 second variety is:
34 (i) essentially derived from the initial variety; and
-

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
PBR in essentially derived varieties **Part 2**

- 1 (ii) a registrable plant variety within the meaning of
2 section 43; and
3 (b) the initial variety is not itself declared (under section 40 or
4 this section) to be essentially derived from another plant
5 variety.
- 6 (3) In deciding whether to make a declaration under subsection (1), the
7 Registrar must consider the following:
8 (a) the information in the application;
9 (b) any information given by an interested person in accordance
10 with the person's opportunity to be heard under
11 subsection 41C(3);
12 (c) any information obtained in a test growing conducted in
13 accordance with section 41E;
14 (d) any other relevant information.
- 15 Note: The opportunity to be heard under section 41C only extends to persons
16 who give the Registrar an address for service in Australia or New
17 Zealand within 2 months after notification of the application is last
18 published in the *Plant Varieties Journal* (see subsection 41C(2)).
- 19 (4) For the purposes of making the decision, the Registrar may draw
20 an inference that is unfavourable to the interests of an interested
21 person (within the meaning of section 41C) if the person:
22 (a) has not given the Registrar an address for service in
23 accordance with subsection 41C(2); or
24 (b) declines the opportunity to be heard under subsection 41C(5).
- 25 *Time for making decision*
- 26 (5) The Registrar must not make a decision in relation to the
27 application before:
28 (a) the day that is 2 months after the day the latest notice in
29 relation to the application is published under
30 subsection 41B(3) or (4); or
31 (b) if any interested person gives the Registrar an address for
32 service in accordance with subsection 41C(2) within the
33 period mentioned in paragraph (a)—the earlier of:
34 (i) the latest time the person may give the Registrar
35 information in accordance with the person's opportunity
36 to be heard under subsection 41C(3); and
-

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

- 1 (ii) the time (if any) the person declines the opportunity to
2 be heard by giving notice to the Registrar under
3 paragraph 41C(5)(a).

4 *Notification of decision*

- 5 (6) If the Registrar makes a decision under subsection (1), the
6 Registrar must give notification of the decision to:
7 (a) the applicant; and
8 (b) any interested person who has given the Registrar an address
9 for service in accordance with subsection 41C(2).

- 10 (7) A notification under subsection (6) must include:
11 (a) a statement of reasons for the decision; and
12 (b) a statement to the effect that, subject to the AAT Act,
13 application may be made to the AAT for review of the
14 decision to which the notice relates by or on behalf of a
15 person or persons whose interests are affected by the
16 decision.

17 *Effect of declaration—reasonable public access*

- 18 (8) While a declaration under this section that the second variety is
19 essentially derived from the initial variety remains in force,
20 section 19 applies in relation to the second variety as if the
21 reference in subsection 19(4) to 2 years after the grant of PBR were
22 a reference to 2 years after the declaration was made.

23 Note: Section 19 requires the grantee of PBR in a plant variety to take
24 reasonable steps to ensure reasonable public access to the plant
25 variety.

26 **41E Essential derivation for non-PBR-protected varieties—test**
27 **growing**

- 28 (1) For the purposes of considering an application under section 41A
29 for a declaration under section 41D that a plant variety (the *second*
30 *variety*) is essentially derived from another plant variety (the *initial*
31 *variety*), the Registrar may conduct a test growing or further test
32 growing to determine whether, on the balance of probabilities, the
33 second variety is:
34 (a) essentially derived from the initial variety; and
-

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
PBR in essentially derived varieties **Part 2**

- 1 (b) a registrable plant variety within the meaning of section 43.
2
3 Note: A decision under this section is reviewable by the AAT under
section 77.
- 4 (2) The Registrar must give notification of a decision to conduct a test
5 growing to:
6 (a) the grantee of PBR in the initial variety; and
7 (b) each interested person (within the meaning of section 41C)
8 who has given the Registrar an address for service in
9 accordance with subsection 41C(2).
- 10 (3) To enable the Registrar to arrange a test growing, the notification
11 must require:
12 (a) the grantee of PBR in the initial variety, within a reasonable
13 period specified in the notification, to supply the Registrar
14 with sufficient plants or sufficient propagating material of
15 plants of the initial variety, and with any necessary
16 information; and
17 (b) each interested person in relation to the second variety,
18 within a reasonable period specified in the notification, to
19 supply the Registrar with sufficient plants or sufficient
20 propagating material of plants of the second variety, and with
21 any necessary information.
- 22 (4) The notification must include a statement of the effect of
23 subsections (5) to (8).
- 24 (5) Despite subsection 41D(2), the Registrar must, under
25 paragraph 41D(1)(b), refuse to make the declaration applied for if
26 the grantee of PBR in the initial variety fails to comply with a
27 requirement under paragraph (3)(a) of this section.
- 28 (6) For the purposes of making a decision under subsection 41D(1) in
29 relation to the application, the Registrar may draw an inference that
30 is unfavourable to the interests of an interested person (within the
31 meaning of section 41C) if the interested person fails to comply
32 with a requirement under paragraph (3)(b) of this section.
- 33 (7) After completion of the test growing, the Registrar must ensure
34 that any propagating material of a variety used in, or resulting
35 from, the test growing that is capable of being transported is
-

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

1 delivered to the person by whom propagating material of that
2 variety was supplied for the purpose of the test growing.

3 (8) The grantee of the PBR in the first variety must pay all costs
4 associated with the test growing.

5 **41F Essential derivation for non-PBR-protected varieties—** 6 **application lodged for PBR in second variety**

7 *Decision to treat application under section 41A as an application*
8 *under section 40*

9 (1) The Registrar must decide to treat an application under section 41A
10 for a declaration under section 41D that a plant variety (the *second*
11 *variety*) is essentially derived from another variety (the *initial*
12 *variety*) as an application under section 40 in relation to those plant
13 varieties if:

- 14 (a) an application for PBR in a plant variety (the *PBR*
15 *application*) is made under section 24; and
16 (b) the Registrar is satisfied that the plant variety in relation to
17 which the PBR application is made is the same as the second
18 variety.

19 Note: Section 40 provides for a declaration that a plant variety (the second
20 variety) is essentially derived from another plant variety (the initial
21 variety) if PBR has been applied for, or granted, in relation to the
22 second variety.

23 *Effect of decision*

- 24 (2) If the Registrar makes a decision under subsection (1):
25 (a) the Registrar must not make a decision under section 41D in
26 relation to the application under section 41A (the *original*
27 *application*); and
28 (b) the Registrar must treat the application under section 41A as
29 if it were an application (the *converted application*) made
30 under section 40 in relation to the initial variety and the
31 second variety, subject to this section.

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
PBR in essentially derived varieties **Part 2**

1

Notification of decision

2

- (3) The Registrar must give notification of the decision to the following persons:

3

4

(a) the grantee of PBR in the initial variety;

5

(b) the applicant for PBR in the second variety;

6

(c) any other person who is an interested person (within the meaning of section 41C) in relation to the original

7

application, if the interested person has given the Registrar an

8

address for service in accordance with subsection 41C(2).

9

10

- (4) A notification under subsection (3) must include:

11

(a) a statement of the reasons for the decision, and the effect of this section; and

12

13

(b) a statement to the effect that the grantee may provide

14

additional information under subsection (7) within 2 months

15

after the date of the notification.

16

- (5) The Registrar must publish notice of the decision in the *Plant Varieties Journal*.

17

18

Relevant information

19

- (6) Within 2 months after a notification of the Registrar's decision is given under subsection (3) to the grantee of PBR in the initial variety, the grantee may give the Registrar any information that would have been required or allowed under subsections 40(4) and (5) had the original application been made under section 40.

20

21

22

23

24

- (7) For the purpose of making a decision under section 40 in relation to the converted application, the Registrar may consider the following:

25

26

27

(a) for the purposes of a decision under subsection 40(7):

28

(i) any information in the original application; and

29

(ii) any additional information given in accordance with subsection (6) of this section;

30

31

(b) for the purposes of a decision under subsection 40(10) or (11):

32

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

- 1 (i) any information given by an interested person in
2 accordance with the person's opportunity to be heard
3 under subsection 41C(3); and
4 (ii) any information obtained in a test growing conducted in
5 accordance with section 41E in relation to the original
6 application; and
7 (iii) any information mentioned in subsection 40(10) in
8 relation to the converted application, including
9 information obtained in a test growing conducted in
10 accordance with section 41.

11 *Time for making decision*

- 12 (8) The Registrar must not make a decision in relation to the converted
13 application earlier than 2 months after the day the notification is
14 given to the grantee under paragraph (3)(a).

15 **26 Paragraph 45(3)(c)**

16 Repeal the paragraph, substitute:

- 17 (c) the other variety is declared to be essentially derived from the
18 initial variety;

19 **27 At the end of subsection 45(3)**

20 Add:

21 Note: For declarations of essential derivation, see sections 40 and 41D.

22 **28 Subsection 46(2)**

23 Omit "the Secretary makes a declaration that a variety (the *derived*
24 *variety*) is", substitute "a variety (the *derived variety*) is declared to be".

25 **29 At the end of subsections 46(2) and 47(2)**

26 Add:

27 Note: For declarations of essential derivation, see sections 40 and 41D.

28 **30 Paragraph 48(2)(c)**

29 Omit "requesting the Secretary to make a declaration under section 40",
30 substitute "applying for a declaration".

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
PBR in essentially derived varieties **Part 2**

1 **31 At the end of subsections 48(2), 50(3) and 53(2)**

2 Add:

3 Note: For declarations of essential derivation, see sections 40 and 41D.

4 **32 At the end of subsection 75(3) (before the penalty)**

5 Add:

6 Note: For declarations of essential derivation, see sections 40 and 41D.

7 **33 After subparagraph 77(1)(b)(xiii)**

8 Insert:

- 9 (xiiia) under subsection 41B(2) to refuse to consider an
10 application for a declaration of essential derivation; or
11 (xiiib) under subsection 41B(5) to publish, or not to publish,
12 information in a notification under subsection 41B(3) or
13 (4); or
14 (xiiic) under section 41D to make, or to refuse to make, a
15 declaration of essential derivation; or
16 (xiiid) under section 41E to conduct, or not to conduct, a test
17 growing; or

18 **34 Subparagraph 80(2)(a)(ii)**

19 Repeal the subparagraph, substitute:

- 20 (ii) fees payable in respect of the making of applications for
21 declarations of essential derivation, the examination of
22 those applications and the making of those declarations,
23 including giving interested persons the opportunity to be
24 heard in relation to applications for declarations under
25 section 41D; and

26 **35 At the end of subsection 80(2)**

27 Add:

28 Note: For declarations of essential derivation, see sections 40 and 41D.

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 2 PBR in essentially derived varieties

1 **Division 2—Application of amendments**

2 **36 Application**

3 The amendments of the *Plant Breeder's Rights Act 1994* made by
4 Division 1 of this Part apply in relation to an application for a
5 declaration under section 41D of that Act (as inserted by that Division)
6 that a plant variety is essentially derived from another plant variety if
7 the application is made on or after the day this item commences,
8 whether the first-mentioned variety was bred or derived before, on or
9 after that commencement.

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
Period to apply for removal of trade marks from Register for non-use **Part 3**

1 **Part 3—Period to apply for removal of trade marks**
2 **from Register for non-use**

3 *Trade Marks Act 1995*

4 **37 At the end of subsection 92(4)**

5 Add:

6 Note 3: For when the registration of a trade mark is taken to have effect, see
7 sections 72 and 239A.

8 **38 Subsection 92(5)**

9 Omit “an application (under subsection (1) or (3)) to obtain the removal
10 of a trade mark from the Register”, substitute “a non-use application”.

11 **39 Section 93**

12 Repeal the section, substitute:

13 **93 Time for making application**

14 (1) A non-use application on the ground mentioned in
15 paragraph 92(4)(a) may be made at any time after the filing date in
16 respect of the application for the registration of the trade mark.

17 Note: For *filing date* see section 6.

18 (2) A non-use application on the ground mentioned in
19 paragraph 92(4)(b) may only be made after a period of 3 years
20 beginning from the date the particulars of the trade mark were
21 entered into the Register under section 69.

22 Note: The registration of a trade mark is taken to have effect earlier than the
23 date the particulars of the trade mark are entered into the Register (see
24 sections 72 and 239A).

25 **40 Application of amendments**

26 Section 93 of the *Trade Marks Act 1995*, as substituted by this Part,
27 applies to a non-use application in relation to a trade mark if the filing
28 date in respect of the application for the registration of the trade mark is
29 on or after the day this item commences.

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 4 Innovation patents

1 **Part 4—Innovation patents**

2 ***Patents Act 1990***

3 **41 Section 3 (list of definitions)**

4 Insert “priority date”.

5 **42 At the end of section 52**

6 Add:

7 (3) It is a requirement of the formalities check that the date of the
8 patent (if granted) would be a date before the day this subsection
9 commences.

10 Note 1: This subsection was inserted by the *Intellectual Property Laws*
11 *Amendment (Productivity Commission Response Part 1 and Other*
12 *Measures) Act 2017*.

13 Note 2: For the date of the patent, see section 65 and regulations made for the
14 purposes of paragraph 65(b).

15 Note 3: Other requirements of the formalities check are specified in
16 regulations made for the purposes of paragraph 228(2)(ha).

17 **43 Subsection 43(2)**

18 Omit “priority date”, substitute “*priority date*”.

19 **44 After paragraph 101B(2)(h)**

20 Insert:

21 (ha) each claim in the complete specification has a priority date
22 that is before the day this paragraph commences; and

23 **45 At the end of subsection 101B(2)**

24 Add:

25 Note: Paragraph 101B(2)(ha) was inserted by the *Intellectual Property Laws*
26 *Amendment (Productivity Commission Response Part 1 and Other*
27 *Measures) Act 2017*.

28 .

EXPOSURE DRAFT

Responses to the Productivity Commission **Schedule 1**
Innovation patents **Part 4**

1 **46 After subparagraph 101E(1)(a)(viii)**

2 Insert:

3 (viiiia) each claim in the complete specification has a priority
4 date that is before the day paragraph 101B(2)(ha)
5 commences;

6 **47 At the end of subsection 101E(1)**

7 Add:

8 Note: Paragraph 101B(2)(ha) was inserted by the *Intellectual Property Laws*
9 *Amendment (Productivity Commission Response Part 1 and Other*
10 *Measures) Act 2017*.

11 **48 Schedule 1**

12 Insert:

13 *priority date* has the meaning given by subsection 43(2).

EXPOSURE DRAFT

Schedule 1 Responses to the Productivity Commission

Part 5 Notification of extension of standard patents relating to pharmaceutical substances

1 **Part 5—Notification of extension of standard patents**
2 **relating to pharmaceutical substances**

3 *Patents Act 1990*

4 **49 Section 76A**

5 Repeal the section.

EXPOSURE DRAFT

Other measures **Schedule 2**
Amending trade mark applications—non-legal persons **Part 1**

1 **Schedule 2—Other measures**

2 **Part 1—Amending trade mark applications—**
3 **non-legal persons**

4 *Trade Marks Act 1995*

5 **1 At the end of section 65**

6 Add:

- 7 (8) Without limiting subsection (7), if the application specifies an
8 applicant without legal personality, an amendment may be made
9 under that subsection to change the reference to the specified
10 applicant to a reference to a person with legal personality if that
11 person can be identified as having made the application.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

1 **Part 2—Written requirements**

2 **Division 1—Amendments**

3 *Designs Act 2003*

4 **2 Subsection 24(1)**

5 Omit “give a written notice to the applicant stating”, substitute “, by
6 notification to the applicant, state”.

7 **3 Subsections 24(2) and (3)**

8 Repeal the subsections, substitute:

9 (2) If a purported design application does not meet the minimum filing
10 requirements, the Registrar must notify the applicant to that effect.

11 The notification must:

12 (a) identify each minimum filing requirement that has not been
13 met; and

14 (b) require the applicant to file the additional information
15 required within 2 months, or such other period as is
16 prescribed, from the date of the notification.

17 (3) If the minimum filing requirements are not met within the period
18 under paragraph (2)(b), the application is taken never to have been
19 filed.

20 **4 Paragraph 33(1)(b)**

21 Omit “a notice”, substitute “a notification”.

22 **5 Subparagraph 33(1)(b)(ii)**

23 Omit “the notice”, substitute “the notification”.

24 **6 Section 41**

25 Omit “give a written notice to the applicant stating”, substitute “notify
26 the applicant”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Written requirements **Part 2**

1 **7 Paragraph 41(a)**

2 Before “the matters”, insert “of”.

3 **8 Subparagraph 41(c)(ii)**

4 Omit “notice”, substitute “notification”.

5 **9 Section 42 (heading)**

6 Repeal the heading, substitute:

7 **42 What happens after Registrar’s notification under section 41**

8 **10 Subsection 42(1)**

9 Omit “written notice”, substitute “notification”.

10 **11 Subsection 42(3)**

11 Omit “notice”, substitute “notification”.

12 **12 Paragraph 42(5)(b)**

13 Omit “notice”, substitute “notification”.

14 **13 Subsection 43(2)**

15 Omit “a notice”, substitute “a notification”.

16 **14 Paragraph 43(2)(b)**

17 Omit “notice”, substitute “notification”.

18 **15 Subsection 43(3)**

19 Omit “in writing of a refusal under subsection (1) or (2). The notice
20 must set out”, substitute “of a refusal under subsection (1) or (2) and
21 of”.

22 **16 Paragraph 52(3)(a)**

23 Omit “give the relevant parties a notice stating”, substitute “notify the
24 relevant parties”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

- 1 **17 Subsection 57(3)**
2 Omit “give a written notice to the applicant stating”, substitute “notify
3 the applicant”.
- 4 **18 Paragraph 57(3)(a)**
5 Before “the matters”, insert “of”.
- 6 **19 Subparagraph 57(3)(c)(ii)**
7 Omit “notice”, substitute “notification”.
- 8 **20 Section 58 (heading)**
9 Repeal the heading, substitute:
- 10 **58 What happens after Registrar’s notification under section 57**
- 11 **21 Subsection 58(1)**
12 Omit “written notice”, substitute “notification”.
- 13 **22 Subsection 58(3)**
14 Omit “notice”, substitute “notification”.
- 15 **23 Paragraph 58(5)(b)**
16 Omit “notice”, substitute “notification”.
- 17 **24 Paragraph 59(1)(a)**
18 Omit “notice”, substitute “a notification”.
- 19 **25 Paragraph 59(1)(b)**
20 Omit “notice”, substitute “notification”.
- 21 **26 Subsection 59(2)**
22 Omit “in writing of a refusal under subsection (1). The notice must set
23 out”, substitute “of a refusal under subsection (1) and of”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Written requirements **Part 2**

1 **27 Subsection 66(2)**

2 Omit “give written notice to that effect to the registered owner of the
3 design”, substitute “notify the registered owner of the design to that
4 effect”.

5 **28 Subsection 67(2)**

6 Omit “give the relevant parties a notice stating”, substitute “notify the
7 relevant parties”.

8 **29 Paragraph 67(2)(b)**

9 Before “the details”, insert “of”.

10 **30 Paragraph 68(2)(a)**

11 Omit “give the relevant parties a notice stating”, substitute “notify the
12 relevant parties”.

13 **31 Paragraph 69(3)(a)**

14 Omit “inform”, substitute “notify”.

15 **32 Paragraph 138(2)(a)**

16 Omit “advise”, substitute “notify”.

17 **33 Before section 145**

18 Insert:

19 **144D Notifications by Registrar under this Act or regulations**

20 If under this Act or the regulations the Registrar is required or
21 permitted:

22 (a) to notify a person of a matter; or

23 (b) to notify a person that the person is required to do a thing;
24 the Registrar may so notify the person by any means of
25 communication (including by electronic means).

26 Note: Section 145 deals with the service etc. of documents on a person.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

1 ***Patents Act 1990***

2 **34 Subsection 27(2)**

3 Repeal the subsection, substitute:

4 (2) The Commissioner must:

5 (a) notify the applicant for the patent of any matter of which the
6 Commissioner is notified under subsection (1); and

7 (b) give the applicant for the patent a copy of any document
8 accompanying the notice under subsection (1).

9 (2A) Without limiting paragraph (2)(b), the Commissioner may give the
10 copy by:

11 (a) making the copy available to the applicant for the patent in an
12 electronic form; and

13 (b) notifying the applicant for the patent that the copy is
14 available.

15 **35 Subsection 28(4)**

16 Repeal the subsection, substitute:

17 *Commissioner must notify patentee of notice given*

18 (4) The Commissioner must:

19 (a) notify the patentee of any matter of which the Commissioner
20 is notified under subsection (1); and

21 (b) give the patentee a copy of any document accompanying the
22 notice under subsection (1).

23 (4A) Without limiting paragraph (4)(b), the Commissioner may give the
24 copy by:

25 (a) making the copy available to the patentee in an electronic
26 form; and

27 (b) notifying the patentee that the copy is available.

28 **36 Paragraph 49(5)(a)**

29 Omit “in writing”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Written requirements **Part 2**

1 **37 Subsection 49(7)**

2 Omit “in writing”.

3 **38 Paragraphs 74(2)(a) and (4)(a)**

4 Omit “in writing”.

5 **39 Subsection 76(2)**

6 Omit “in writing”.

7 **40 Paragraph 101E(1)(a)**

8 Omit “in writing”.

9 **41 Subsection 101E(3)**

10 Repeal the subsection.

11 **42 After section 220**

12 Insert:

13 **220A Notifications by Commissioner under this Act**

14 If under this Act the Commissioner is required or permitted:

15 (a) to notify a person of a matter; or

16 (b) to notify a person that the person is required to do a thing;
17 the Commissioner may so notify the person by any means of
18 communication (including by electronic means).

19 Note 1: A reference to this Act includes the regulations (see Schedule 1).

20 Note 2: Section 221 deals with the service etc. of documents on a person.

21 ***Plant Breeder’s Rights Act 1994***

22 **43 Subsection 19(6)**

23 Omit “give the grantee”.

24 **44 Paragraph 19(6)(a)**

25 Before “a”, insert “give the grantee”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

1 **45 Paragraph 19(6)(b)**

2 Omit “a written invitation”, substitute “by notification to the grantee,
3 invite the grantee”.

4 **46 Paragraph 19(7)(b)**

5 Omit “give written notice of the decision to the grantee and to the
6 person making the request”, substitute “notify the grantee, and the
7 person making the request, of the decision”.

8 **47 Subparagraph 19(9)(b)(i)**

9 Omit “given written notice to”, substitute “notified”.

10 **48 Subsection 21(3)**

11 Omit “give written notice to the claimant and to the person who was the
12 holder before the entry was made, stating that the entry has been made”,
13 substitute “notify the claimant, and the person who was the holder
14 before the entry was made, that the entry has been made”.

15 **49 Paragraph 21(4)(a)**

16 Omit “give written notice to”, substitute “notify”.

17 **50 Subparagraph 21(4)(a)(i)**

18 Omit “telling the claimant”.

19 **51 Subparagraph 21(4)(a)(ii)**

20 Omit “setting out”, substitute “of”.

21 **52 Paragraph 21(4)(b)**

22 Omit “give written notice to”, substitute “notify”.

23 **53 Subparagraph 21(4)(b)(i)**

24 Omit “setting out”, substitute “of the”.

25 **54 Subparagraph 21(4)(b)(ii)**

26 Omit “telling the claimant”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Written requirements **Part 2**

1 **55 Subparagraph 21(4)(b)(iii)**
2 Omit “setting out”, substitute “of”.

3 **56 Paragraph 30(4)(a)**
4 Omit “give written notice to the applicant telling the applicant”,
5 substitute “notify the applicant”.

6 **57 Paragraph 30(5)(a)**
7 Omit “give written notice to the applicant telling the applicant”,
8 substitute “notify the applicant”.

9 **58 Paragraph 30(5)(a)**
10 Omit “setting out”, substitute “of”.

11 **59 Subsection 32(1)**
12 Omit “give written notice to”, substitute “notify”.

13 **60 Subsection 32(1)**
14 Omit “telling the person”.

15 **61 Subsection 32(2)**
16 Omit “give written notice to”, substitute “notify”.

17 **62 Paragraph 32(2)(a)**
18 Omit “telling the person”.

19 **63 Paragraph 32(2)(b)**
20 Omit “setting out”, substitute “of”.

21 **64 Subsection 32(3)**
22 Omit “give written notice to”, substitute “notify”.

23 **65 Paragraph 32(3)(a)**
24 Omit “setting out”, substitute “of the”.

25 **66 Paragraph 32(3)(b)**
26 Omit “telling the applicant”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

1 **67 Paragraph 32(3)(c)**

2 Omit “setting out”, substitute “of”.

3 **68 Subsection 32(4)**

4 Omit “give written notice of”, substitute “notify”.

5 **69 Paragraphs 37(1)(d) and (e)**

6 Omit “give written notice of”, substitute “notify”.

7 **70 Subsection 37(2)**

8 Omit “notice”, substitute “notification”.

9 **71 Subsection 37(2A)**

10 Omit “a notice is sent”, substitute “a notification is given”.

11 **72 Subsection 37(2A)**

12 Omit “the requirements of the notice”, substitute “the requirements of
13 the notification”.

14 **73 Paragraph 37(2A)(a)**

15 Omit “of service of the notice”, substitute “the notification is given”.

16 **74 Subsection 37(2B)**

17 Omit “notice issued”, substitute “notification given”.

18 **75 Paragraph 37(2B)(a)**

19 Omit “notice”, substitute “notification”.

20 **76 Subsection 37(3)**

21 Omit “notice”, substitute “notification”.

22 **77 Paragraph 39(1)(b)**

23 Omit “notice” (wherever occurring), substitute “notification”.

24 **78 Subsection 39(2)**

25 Omit “, in writing,”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Written requirements **Part 2**

1 **79 Subsection 39(2)**

2 Omit “notice”, substitute “notification”.

3 **80 Subsection 39(3)**

4 Omit “notice” (wherever occurring), substitute “notification”.

5 **81 Subsection 40(6)**

6 Omit “refuse to declare the second variety essentially derived from”.

7 **82 Paragraph 40(6)(a)**

8 Before “the”, insert “refuse to declare the second variety essentially
9 derived from”.

10 **83 Paragraph 40(6)(b)**

11 Omit “inform the applicant for the declaration in writing, to that effect,
12 and give the applicant”, substitute “notify the applicant for the
13 declaration of the decision and of the”.

14 **84 Paragraphs 40(8)(a) and (b)**

15 Omit “inform”, substitute “notify”.

16 **85 Paragraph 40(8)(b)**

17 Omit “informed”, substitute “notified”.

18 **86 Subsection 40(9)**

19 Omit “inform the applicant, in writing, to that effect, and give the
20 applicant”, substitute “notify the applicant of the decision and of the”.

21 **87 Paragraph 40(10)(e)**

22 Omit “by notice in writing given to”, substitute “notify”.

23 **88 Paragraph 40(10)(e)**

24 Omit “, tell that grantee”.

25 **89 Paragraph 40(10)(f)**

26 Omit “by notice in writing given to”, substitute “notify”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

1 **90 Paragraph 40(10)(f)**

2 Omit “, tell that grantee of the declaration and set out”, substitute “of
3 the declaration and of”.

4 **91 Paragraph 40(11)(a)**

5 Omit “by notice in writing given to”, substitute “notify”.

6 **92 Paragraph 40(11)(a)**

7 Omit “, tell that grantee that he or she is so satisfied and set out”,
8 substitute “that he or she is so satisfied and of”.

9 **93 Paragraph 40(11)(b)**

10 Omit “by notice in writing given to”, substitute “notify”.

11 **94 Paragraph 40(11)(b)**

12 Omit “, tell that grantee”.

13 **95 Subsection 41(1)**

14 Omit “give notice of”, substitute “notify”.

15 **96 Subsection 41(2)**

16 Omit “notice”, substitute “notification”.

17 **97 Subsection 41(5)**

18 Omit “subsection 40(8) has effect as if the reference in that subsection
19 to 30 days after being so informed were a reference to 30 days after
20 being informed”, substitute “paragraph 40(8)(b) has effect as if the
21 reference in that paragraph to 30 days after being so notified were a
22 reference to 30 days after being notified”.

23 **98 Subsection 44(12)**

24 Omit “give written notice to”, substitute “notify”.

25 **99 Paragraph 44(12)(a)**

26 Omit “telling the applicant”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Written requirements **Part 2**

1 **100 Paragraph 44(12)(b)**

2 Omit “setting out”, substitute “of”.

3 **101 Paragraph 50(2)(aa)**

4 Omit “notice”, substitute “notification”.

5 **102 Subsection 50(3)**

6 Omit “by notice given to the grantee of the right that has been revoked
7 or of the right that is affected by the giving of the declaration of
8 essential derivation, tell that grantee of the decision and set out the
9 reasons for the revocation”, substitute “notify the decision, and the
10 reasons for the decision, to the grantee of the right that has been
11 revoked or to the grantee of the right that was affected by the giving of
12 the declaration of essential derivation”.

13 **103 Subsection 50(10)**

14 Omit “by notice in writing to”, substitute “notify”.

15 **104 Subsection 50(10)**

16 Omit “, tell the person of the decision and set out”, substitute “of the
17 decision and of”.

18 **105 After section 72**

19 Insert:

20 **72A Notifications by Registrar under this Act or regulations**

21 If under this Act or the regulations the Registrar is required or
22 permitted:

23 (a) to notify a person of a matter; or

24 (b) to notify a person that the person is required to do a thing;
25 the Registrar may so notify the person by any means of
26 communication (including by electronic means).

27 Note: Section 73 deals with the service etc. of documents on a person.

28 **106 Subparagraph 77(1)(b)(xi)**

29 Omit “issue a notice”, substitute “give a notification”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

1 ***Trade Marks Act 1995***

2 **107 Section 34 (heading)**

3 Repeal the heading, substitute:

4 **34 Notification of decision**

5 **108 Paragraph 34(a)**

6 Omit “in writing”.

7 **109 Subsection 77(2)**

8 Omit “notice”, substitute “notification”.

9 **110 Section 80C (heading)**

10 Repeal the heading, substitute:

11 **80C Notification about renewal**

12 **111 Subsection 80E(2)**

13 Omit “notice”, substitute “notification”.

14 **112 Subsection 84A(4)**

15 Omit “notice”, substitute “notification”.

16 **113 Subsection 84A(4)**

17 Omit “in accordance with the regulations”.

18 **114 Subsection 95(1)**

19 Omit “notice”, substitute “a copy”.

20 **115 Section 111 (heading)**

21 Repeal the heading, substitute:

EXPOSURE DRAFT

Other measures **Schedule 2**
Written requirements **Part 2**

1 **111 Notification of application to be given to person recorded as**
2 **claiming interest in trade mark etc.**

3 **116 Paragraph 176(3)(a)**

4 Repeal the paragraph, substitute:

5 (a) notify the applicant of the Registrar's decision under this
6 section; and

7 **117 Paragraph 202(e)**

8 Omit “, as he or she considers fit,”.

9 **118 After section 214**

10 Insert:

11 **214A Notifications by Registrar under this Act**

12 If under this Act the Registrar is required or permitted:

13 (a) to notify a person of a matter; or

14 (b) to notify a person that the person is required to do a thing;
15 the Registrar may so notify the person by any means of
16 communication (including by electronic means).

17 Note 1: A reference to this Act includes the regulations (see section 6).

18 Note 2: Section 215 deals with the service etc. of documents on a person.

19 **Division 2—Application and saving provisions**

20 **119 Designs**

21 (1) The amendments of sections 24, 33, 41, 42, 43, 52, 57, 58, 59, 66, 67,
22 68, 69 and 138 of the *Designs Act 2003* made by this Part apply in
23 relation to notifications occurring on or after the commencement of this
24 item.

25 (2) The *Designs Act 2003*, as in force immediately before the
26 commencement of this item, continues to apply on and after that
27 commencement in relation to a notice given under subsection 24(1) or
28 (2), section 41, paragraph 52(3)(a), subsection 57(3), 66(2) or 67(2) or
29 paragraph 68(2)(a) of that Act before that commencement.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 2 Written requirements

1 **120 Patents**

2 The amendments of sections 27, 28, 49, 74 and 76 of the *Patents Act*
3 *1990* made by this Part apply in relation to notifications occurring on or
4 after the commencement of this item.

5 **121 Plant breeder's rights**

6 (1) The amendment of paragraph 19(6)(b) of the *Plant Breeder's Rights Act*
7 *1994* made by this Part applies in relation to invitations made on or after
8 the commencement of this item.

9 (2) The amendments of paragraph 19(7)(b), subparagraph 19(9)(b)(i) and
10 sections 21, 30, 32, 37, 39, 40, 41, 44 and 50 of the *Plant Breeder's*
11 *Rights Act 1994* made by this Part apply in relation to notifications
12 occurring on or after the commencement of this item.

13 (3) The *Plant Breeder's Rights Act 1994*, as in force immediately before the
14 commencement of this item, continues to apply on and after that
15 commencement in relation to a notice given under paragraph 19(7)(b),
16 subparagraph 19(9)(b)(i), subsection 21(3), paragraph 21(4)(a) or (b) or
17 30(4)(a) or (5)(a), subsection 32(1), (2), (3) or (4), section 37,
18 subsection 39(2), paragraph 40(10)(e) or (f) or (11)(a) or (b) or
19 subsection 41(1), 44(12) or 50(3) or (10) of that Act before that
20 commencement.

21 **122 Trade marks**

22 (1) The amendments of sections 34, 77, 80E, 84A, 176 and 202 of the
23 *Trade Marks Act 1995* made by this Part apply in relation to
24 notifications occurring on or after the commencement of this item.

25 (2) The *Trade Marks Act 1995*, as in force immediately before the
26 commencement of this item, continues to apply on and after that
27 commencement in relation to a notice given under subsection 77(2),
28 80E(2) or 84A(4) or paragraph 176(3)(a) of that Act before that
29 commencement.

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

1 **Part 3—Filing requirements**

2 **Division 1—Amendments**

3 *Designs Act 2003*

4 **123 Section 5**

5 Insert:

6 *preferred means:*

- 7 (a) in relation to filing a document with the Designs Office—
8 means the means specified under subsection 144A(4); or
9 (b) in relation to paying a fee—means the means specified under
10 subsection 130A(4).

11 **124 After subsection 69(2)**

12 Insert:

13 (2A) A person must not provide to the Registrar material in the form of
14 a physical article, other than a document, unless the Registrar has
15 given the person an approval to do so.

16 (2B) If a person provides material to the Registrar under subsection (1),
17 the material may be accompanied by evidence, in the form of a
18 declaration, of the publication of the material.

19 Note: The regulations deal with the making of declarations.

20 **125 After subsection 130(2)**

21 Insert:

22 (2A) Without limiting subsection (1), different fees may be prescribed
23 for filing a document with the Designs Office according to the
24 means by which the document is filed.

25 (2B) Without limiting subsection (1), different amounts of a fee may be
26 prescribed according to the means by which the fee is paid.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

1 *Means of paying fee*

2 (2C) A fee must be paid by a means determined in an instrument under
3 subsection 130A(1).

4 *Fees payable in accordance with the regulations*

5 **126 Before subsection 130(4)**

6 Insert:

7 *Consequences of failure to pay fee*

8 **127 At the end of Part 2 of Chapter 11**

9 Add:

10 **130A Approved means of paying a fee**

11 (1) For the purposes of subsection 130(2C), the Registrar may, by
12 writing, determine one or more means for paying a fee.

13 (2) The means may be an electronic means or any other means.

14 (3) The Registrar must publish a notice, in accordance with the
15 regulations, setting out the determination.

16 (4) The Registrar may, in a determination under subsection (1), specify
17 that one or more means for paying a fee are preferred means.

18 Note: Under the regulations, the amount of a fee may be reduced for paying
19 the fee by preferred means.

20 (5) A determination under subsection (1) is not a legislative
21 instrument.

22 **128 Section 144**

23 Repeal the section, substitute:

24 **144 Filing of documents**

25 For the purposes of this Act and the regulations, a document may
26 be filed with the Designs Office by a means determined in an
27 instrument under subsection 144A(1).

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

1 **144A Approved means of filing documents**

- 2 (1) For the purposes of section 144, the Registrar may, by writing,
3 determine one or more means for filing a document with the
4 Designs Office.
- 5 (2) The means may be an electronic means or any other means.
- 6 (3) The Registrar must publish a notice, in accordance with the
7 regulations, setting out the determination.
- 8 (4) The Registrar may, in a determination under subsection (1), specify
9 that one or more means for filing a document with the Designs
10 Office are preferred means.
- 11 Note: Under the regulations, reduced fees may be payable for filing a
12 document by preferred means.
- 13 (5) A determination under subsection (1) is not a legislative
14 instrument.

15 **144B Directions by Registrar for filing of documents**

- 16 (1) The Registrar may, by writing, give a direction specifying the form
17 in which a document is to be filed under this Act or the regulations.
- 18 Note: See also paragraph 149(2)(aa) (about regulations).
- 19 (2) Subsection (1) does not apply in relation to a document that is
20 required, under the regulations, to be in an approved form.
- 21 (3) The Registrar must publish a notice, in accordance with the
22 regulations, setting out the direction.
- 23 (4) A direction under subsection (1) is not a legislative instrument.

24 **144C Directions by Registrar for filing of evidence**

- 25 (1) The Registrar may, by writing, give a direction in relation to the
26 filing of evidence in connection with a matter arising under this
27 Act or the regulations.
- 28 Note: See also paragraph 149(2)(ab) (about regulations).

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

- 1 (2) Without limiting subsection (1), a direction under that subsection
2 may relate to the following:
3 (a) the number of copies of evidence to be filed;
4 (b) the form in which evidence is to be filed (including the
5 circumstances in which physical articles, other than
6 documents, are or are not permitted to be filed);
7 (c) the means by which evidence is to be filed.
- 8 (3) Without limiting paragraph (2)(b), a direction under subsection (1)
9 may require that evidence in writing be in the form of a
10 declaration.
- 11 (4) This section does not apply in relation to the provision of material
12 under section 69 (about material relating to whether a registered
13 design is new or distinctive).
- 14 (5) The Registrar must publish a notice, in accordance with the
15 regulations, setting out a direction under subsection (1).
- 16 (6) A direction under subsection (1) is not a legislative instrument.

17 **129 Before paragraph 149(2)(a)**

18 Insert:

- 19 (aa) making provision for and in relation to the following:
20 (i) the requirements for filing a document under this Act or
21 the regulations (including the requirement that the
22 document must be in the form (if any) specified in a
23 direction under section 144B);
24 (ii) the consequences of a document not being in
25 accordance with an approved form or not complying
26 with the requirements referred to in subparagraph (i);
27 and
28 (ab) making provision for and in relation to the consequences of
29 not complying with a direction under section 144C; and

30 ***Patents Act 1990***

31 **130 Section 3 (list of definitions)**

32 Insert “preferred means”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

1 **131 Section 214**

2 Repeal the section, substitute:

3 **214 Filing of documents**

4 For the purposes of this Act, a document may be filed with the
5 Patent Office by a means determined in an instrument under
6 subsection 214A(1).

7 **132 After section 214**

8 Insert:

9 **214A Approved means of filing documents**

10 (1) For the purposes of section 214, the Commissioner may, by
11 writing, determine one or more means for filing a document with
12 the Patent Office.

13 (2) The means may be an electronic means or any other means.

14 (3) The Commissioner must publish a notice in the Official Journal
15 setting out the determination.

16 (4) The Commissioner may, in a determination under subsection (1),
17 specify that one or more means for filing a document with the
18 Patent Office are preferred means.

19 Note: Under the regulations, reduced fees may be payable for filing a
20 document by preferred means.

21 (5) A determination under subsection (1) is not a legislative
22 instrument.

23 **133 Before section 215**

24 Insert:

25 **214B Directions by Commissioner for filing of documents**

26 (1) The Commissioner may, by writing, give a direction specifying the
27 form in which a document is to be filed under this Act.

28 Note 1: A reference to this Act includes the regulations (see Schedule 1).

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

1 Note 2: See also paragraph 228(2)(ba) (about regulations).

2 (2) Subsection (1) does not apply in relation to a document that is
3 required to be in an approved form.

4 (3) The Commissioner must publish a notice in the Official Journal
5 setting out the direction.

6 (4) A direction under subsection (1) is not a legislative instrument.

7 **214C Directions by Commissioner for filing of evidence**

8 (1) The Commissioner may, by writing, give a direction in relation to
9 the filing of evidence in connection with a matter arising under this
10 Act.

11 Note 1: A reference to this Act includes the regulations (see Schedule 1).

12 Note 2: See also paragraph 228(2)(bb) (about regulations).

13 (2) Without limiting subsection (1), a direction under that subsection
14 may relate to the following:

15 (a) the number of copies of evidence to be filed;

16 (b) the form in which evidence is to be filed (including the
17 circumstances in which physical articles, other than
18 documents, are or are not permitted to be filed);

19 (c) the means by which evidence is to be filed.

20 (3) Without limiting paragraph (2)(b), a direction under subsection (1)
21 may require that evidence in writing be in the form of a
22 declaration.

23 (4) The Commissioner must publish a notice in the Official Journal
24 setting out a direction under subsection (1).

25 (5) A direction under subsection (1) is not a legislative instrument.

26 **134 After subsection 227(2)**

27 Insert:

28 (2A) Without limiting subsection (1), different fees may be prescribed
29 for filing a document with the Patent Office according to the means
30 by which the document is filed.

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

1 (2B) Without limiting subsection (1), different amounts of a fee may be
2 prescribed according to the means by which the fee is paid.

3 (2C) A fee must be paid by a means determined in an instrument under
4 subsection 227AAA(1).

5 **135 After section 227**

6 Insert:

7 **227AAA Approved means of paying a fee**

8 (1) For the purposes of subsection 227(2C), the Commissioner may,
9 by writing, determine one or more means for paying a fee.

10 (2) The means may be an electronic means or any other means.

11 (3) The Commissioner must publish a notice in the Official Journal
12 setting out the determination.

13 (4) The Commissioner may, in a determination under subsection (1),
14 specify that one or more means for paying a fee are preferred
15 means.

16 Note: Under the regulations, the amount of a fee may be reduced for paying
17 the fee by preferred means.

18 (5) A determination under subsection (1) is not a legislative
19 instrument.

20 **136 After paragraph 228(2)(b)**

21 Insert:

22 (ba) making provision for and in relation to the following:

23 (i) the requirements for filing a document under this Act
24 (including the requirement that the document must be in
25 the form (if any) specified in a direction under
26 section 214B);

27 (ii) the consequences of a document not being in
28 accordance with an approved form or not complying
29 with the requirements referred to in subparagraph (i);
30 and

31 (bb) making provision for and in relation to the consequences of
32 not complying with a direction under section 214C; and

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

1 **137 Schedule 1**

2 Insert:

3 *preferred means:*

4 (a) in relation to filing a document with the Patent Office—
5 means the means specified under subsection 214A(4); or

6 (b) in relation to paying a fee—means the means specified under
7 subsection 227AAA(4).

8 ***Plant Breeder's Rights Act 1994***

9 **138 Subsection 3(1)**

10 Insert:

11 *preferred means:*

12 (a) in relation to lodging a document with, or giving a document
13 to, the Registrar—means the means specified under
14 subsection 72C(4); or

15 (b) in relation to paying a fee—means the means specified under
16 subsection 80A(4).

17 **139 Subsection 26(1)**

18 Repeal the subsection, substitute:

19 (1) An application for PBR in a plant variety must be in the approved
20 form.

21 **140 Subsection 34(3)**

22 Repeal the subsection, substitute:

23 (3) The detailed description must be in the approved form.

24 **141 Subsection 40(4)**

25 Repeal the subsection, substitute:

26 (4) An application for a declaration of essential derivation must:

27 (a) be in the approved form; and

28 (b) be accompanied by the prescribed fee in respect of the
29 application.

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

1 **142 Before section 73**

2 Insert:

3 **72B Manner in which documents may be lodged with or given to**
4 **Registrar**

5 For the purposes of this Act and the regulations, a document may
6 be lodged with, or given to, the Registrar by a means determined in
7 an instrument under subsection 72C(1).

8 **72C Approved means of lodging or giving documents**

- 9 (1) For the purposes of section 72B, the Registrar may, by writing,
10 determine one or more means for lodging a document with, or
11 giving a document to, the Registrar.
- 12 (2) The means may be an electronic means or any other means.
- 13 (3) The Registrar must give public notice setting out the determination.
- 14 (4) The Registrar may, in a determination under subsection (1), specify
15 that one or more means for lodging a document with, or giving a
16 document to, the Registrar are preferred means.

17 Note: Under the regulations, reduced fees may be payable for lodging or
18 giving a document by preferred means.

- 19 (5) A determination under subsection (1) is not a legislative
20 instrument.

21 **143 At the end of subparagraph 80(2)(a)(iv)**

22 Add “and”.

23 **144 After subparagraph 80(2)(a)(iv)**

24 Insert:

- 25 (v) different fees for lodging a document with, or giving a
26 document to, the Registrar according to the means by
27 which the document is lodged or given; and
28 (vi) different amounts of a fee according to the means by
29 which the fee is paid;

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

1 **145 Paragraph 80(2)(a)**

2 Omit “and the manner of payment of such fees”.

3 **146 At the end of section 80**

4 Add:

5 (3) A fee must be paid by a means determined in an instrument under
6 subsection 80A(1).

7 **147 At the end of Part 8**

8 Add:

9 **80A Approved means of paying a fee**

10 (1) For the purposes of subsection 80(3), the Registrar may, by
11 writing, determine one or more means for paying a fee.

12 (2) The means may be an electronic means or any other means.

13 (3) The Registrar must give public notice setting out the determination.

14 (4) The Registrar may, in a determination under subsection (1), specify
15 that one or more means for paying a fee are preferred means.

16 Note: Under the regulations, the amount of a fee may be reduced for paying
17 the fee by preferred means.

18 (5) A determination under subsection (1) is not a legislative
19 instrument.

20 ***Trade Marks Act 1995***

21 **148 Readers guide (list of terms defined in section 6)**

22 Insert “preferred means”.

23 **149 Subsection 6(1)**

24 Insert:

25 ***preferred means:***

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

- 1 (a) in relation to filing a document with the Trade Marks
2 Office—means the means specified under
3 subsection 213A(4); or
4 (b) in relation to paying a fee—means the means specified under
5 subsection 223AA(4).

6 **150 Paragraph 52(2)(a)**

7 Omit “manner and”.

8 **151 Subsection 52A(2)**

9 Omit “in the prescribed manner and”.

10 **152 Paragraph 54A(1)(b)**

11 Omit “in the prescribed manner or”.

12 **153 Paragraph 96(2)(a)**

13 Omit “manner and”.

14 **154 Section 213**

15 Repeal the section, substitute:

16 **213 Filing of documents**

17 For the purposes of this Act, a document may be filed with the
18 Trade Marks Office by a means determined in an instrument under
19 subsection 213A(1).

20 **213A Approved means of filing documents**

- 21 (1) For the purposes of section 213, the Registrar may, by writing,
22 determine one or more means for filing a document with the Trade
23 Marks Office.
- 24 (2) The means may be an electronic means or any other means.
- 25 (3) The Registrar must advertise the determination in the Official
26 Journal.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

- 1 (4) The Registrar may, in a determination under subsection (1), specify
2 that one or more means for filing a document with the Trade Marks
3 Office are preferred means.

4 Note: Under the regulations, reduced fees may be payable for filing a
5 document by preferred means.

- 6 (5) A determination under subsection (1) is not a legislative
7 instrument.

8 **155 Before section 214**

9 Insert:

10 **213B Directions by Registrar for filing of documents**

- 11 (1) The Registrar may, by writing, give a direction specifying the form
12 in which a document is to be filed under this Act.

13 Note 1: A reference to this Act includes the regulations (see section 6).

14 Note 2: See also paragraph 231(2)(ba) (about regulations).

- 15 (2) Subsection (1) does not apply in relation to a document that is
16 required to be in an approved form.
- 17 (3) The Registrar must advertise the direction in the Official Journal.
- 18 (4) A direction under subsection (1) is not a legislative instrument.

19 **213C Directions by Registrar for filing of evidence**

- 20 (1) The Registrar may, by writing, give a direction in relation to the
21 filing of evidence in connection with a matter arising under this
22 Act.

23 Note 1: A reference to this Act includes the regulations (see section 6).

24 Note 2: See also paragraph 231(2)(bb) (about regulations).

- 25 (2) Without limiting subsection (1), a direction under that subsection
26 may relate to the following:
- 27 (a) the number of copies of evidence to be filed;
- 28 (b) the form in which evidence is to be filed (including the
29 circumstances in which physical articles, other than
30 documents, are or are not permitted to be filed);

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

-
- 1 (c) the means by which evidence is to be filed.
- 2 (3) Without limiting paragraph (2)(b), a direction under subsection (1)
3 may require that evidence in writing be in the form of a
4 declaration.
- 5 (4) The Registrar must advertise a direction under subsection (1) in the
6 Official Journal.
- 7 (5) A direction under subsection (1) is not a legislative instrument.

8 **156 After subsection 223(2)**

9 Insert:

- 10 (2A) Without limiting subsection (1), different fees may be prescribed
11 for filing a document with the Trade Marks Office according to the
12 means by which the document is filed.
- 13 (2B) Without limiting subsection (1), different amounts of a fee may be
14 prescribed according to the means by which the fee is paid.
- 15 *Means of paying fee*
- 16 (2C) A fee that must be paid to the Registrar must be paid by a means
17 determined in an instrument under subsection 223AA(1).

18 *Consequences of failure to pay fee*

19 **157 After section 223**

20 Insert:

21 **223AA Approved means of paying a fee**

- 22 (1) For the purposes of subsection 223(2C), the Registrar may, by
23 writing, determine one or more means for paying a fee.
- 24 (2) The means may be an electronic means or any other means.
- 25 (3) The Registrar must advertise the determination in the Official
26 Journal.
- 27 (4) The Registrar may, in a determination under subsection (1), specify
28 that one or more means for paying a fee are preferred means.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

1 Note: Under the regulations, the amount of a fee may be reduced for paying
2 the fee by preferred means.

3 (5) A determination under subsection (1) is not a legislative
4 instrument.

5 **158 Before paragraph 231(2)(c)**

6 Insert:

7 (ba) provide for and in relation to the following:

8 (i) the requirements for filing a document under this Act
9 (including the requirement that the document must be in
10 the form (if any) specified in a direction under
11 section 213B);

12 (ii) the consequences of a document not being in
13 accordance with an approved form or not complying
14 with the requirements referred to in subparagraph (i);
15 and

16 (bb) provide for and in relation to the consequences of not
17 complying with a direction under section 213C; and

18 **Division 2—Application, saving and transitional** 19 **provisions**

20 **159 Designs**

21 (1) The amendment of section 69 of the *Designs Act 2003* made by this Part
22 applies in relation to the provision of material to the Registrar on or
23 after the commencement of this item.

24 (2) Subsection 130(2C) of the *Designs Act 2003*, as inserted by this Part,
25 applies in relation to fees paid on or after the commencement of this
26 item.

27 (3) Section 144 of the *Designs Act 2003*, as substituted by this Part, applies
28 in relation to documents filed on or after the commencement of this
29 item.

30 (4) Section 144B of the *Designs Act 2003*, as inserted by this Part, applies
31 in relation to documents filed on or after the commencement of this
32 item.

EXPOSURE DRAFT

Other measures **Schedule 2**
Filing requirements **Part 3**

-
- 1 (5) Section 144C of the *Designs Act 2003*, as inserted by this Part, applies
2 in relation to evidence filed on or after the commencement of this item.

3 **160 Patents**

- 4 (1) The repeal and substitution of section 214 of the *Patents Act 1990* made
5 by this Part applies in relation to documents filed on or after the
6 commencement of this item.
- 7 (2) Section 214B of the *Patents Act 1990*, as inserted by this Part, applies in
8 relation to documents filed on or after the commencement of this item.
- 9 (3) Section 214C of the *Patents Act 1990*, as inserted by this Part, applies in
10 relation to evidence filed on or after the commencement of this item.
- 11 (4) Subsection 227(2C) of the *Patents Act 1990*, as inserted by this Part,
12 applies in relation to fees paid on or after the commencement of this
13 item.

14 **161 Plant breeder's rights**

- 15 (1) The repeal and substitution of subsection 26(1) of the *Plant Breeder's*
16 *Rights Act 1994* made by this Part applies in relation to applications
17 made on or after the commencement of this item.
- 18 (2) An approved form that was in effect immediately before the
19 commencement of this item for the purposes of paragraph 26(1)(b) of
20 the *Plant Breeder's Rights Act 1994* continues in force on and after that
21 commencement as if it were an approved form in effect for the purposes
22 of subsection 26(1) of that Act.
- 23 (3) The repeal and substitution of subsection 34(3) of the *Plant Breeder's*
24 *Rights Act 1994* made by this Part applies in relation to detailed
25 descriptions given on or after the commencement of this item.
- 26 (4) An approved form that was in effect immediately before the
27 commencement of this item for the purposes of paragraph 34(3)(b) of
28 the *Plant Breeder's Rights Act 1994* continues in force on and after that
29 commencement as if it were an approved form in effect for the purposes
30 of subsection 34(3) of that Act.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 3 Filing requirements

- 1 (5) The repeal and substitution of subsection 40(4) of the *Plant Breeder's*
2 *Rights Act 1994* made by this Part applies in relation to applications
3 made on or after the commencement of this item.
- 4 (6) An approved form that was in effect immediately before the
5 commencement of this item for the purposes of paragraph 40(4)(b) of
6 the *Plant Breeder's Rights Act 1994* continues in force on and after that
7 commencement as if it were an approved form in effect for the purposes
8 of paragraph 40(4)(a) of that Act.
- 9 (7) The repeal and substitution of subsection 40(4) of the *Plant Breeder's*
10 *Rights Act 1994* made by this Part does not affect the validity of any
11 regulations prescribing a fee for an application under subsection 40(1)
12 of that Act that were in force immediately before the commencement of
13 this item.
- 14 (8) Section 72B of the *Plant Breeder's Rights Act 1994*, as inserted by this
15 Part, applies in relation to documents lodged with, or given to, the
16 Registrar on or after the commencement of this item.
- 17 (9) Subsection 80(3) of the *Plant Breeder's Rights Act 1994*, as added by
18 this Part, applies in relation to fees paid on or after the commencement
19 of this item.

162 Trade marks

- 20
- 21 (1) Section 213 of the *Trade Marks Act 1995*, as substituted by this Part,
22 applies in relation to documents filed on or after the commencement of
23 this item.
- 24 (2) Section 213B of the *Trade Marks Act 1995*, as inserted by this Part,
25 applies in relation to documents filed on or after the commencement of
26 this item.
- 27 (3) Section 213C of the *Trade Marks Act 1995*, as inserted by this Part,
28 applies in relation to evidence filed on or after the commencement of
29 this item.
- 30 (4) Subsection 223(2C) of the *Trade Marks Act 1995*, as inserted by this
31 Part, applies in relation to fees paid on or after the commencement of
32 this item.

EXPOSURE DRAFT

Other measures **Schedule 2**
Signatures **Part 4**

1 **Part 4—Signatures**

2 *Patents Act 1990*

3 **163 Paragraph 151(4)(c)**

4 Omit “signed by the applicant”.

5 **164 Paragraph 176(c)**

6 Omit “signed by the applicant”.

7 **165 Application provision**

8 The amendments made by this Part apply in relation to a request
9 referred to in paragraph 151(4)(c) or 176(c) of the *Patents Act 1990*
10 filed on or after the commencement of this item.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 5 Computerised decision-making

1 **Part 5—Computerised decision-making**

2 *Designs Act 2003*

3 **166 Section 129**

4 After:

5

Part 3 contains offence provisions.

6 insert:

7

Part 3A deals with computerised decision-making.
--

8 **167 After Part 3 of Chapter 11**

9 Insert:

10 **Part 3A—Computerised decision-making**

11

12 **135A Computerised decision-making**

- 13 (1) The Registrar may arrange for the use, under the Registrar's
14 control, of computer programs for any purposes for which the
15 Registrar may, or must, under this Act or the regulations:
- 16 (a) make a decision; or
17 (b) exercise any power or comply with any obligation; or
18 (c) do anything else related to making a decision to which
19 paragraph (a) applies or related to exercising a power, or
20 complying with an obligation, to which paragraph (b)
21 applies.
- 22 (2) For the purposes of this Act and the regulations, the Registrar is
23 taken to have:
- 24 (a) made a decision; or
25 (b) exercised a power or complied with an obligation; or

EXPOSURE DRAFT

Other measures **Schedule 2**
Computerised decision-making **Part 5**

1 (c) done something else related to the making of a decision or
2 the exercise of a power or the compliance with an obligation;
3 that was made, exercised, complied with or done by the operation
4 of a computer program under an arrangement made under
5 subsection (1).

6 *Substituted decisions*

7 (3) The Registrar may substitute a decision for a decision the Registrar
8 is taken to have made under paragraph (2)(a) if the Registrar is
9 satisfied that the decision made by the operation of the computer
10 program is incorrect.

11 **168 After subsection 136(1)**

12 Insert:

13 (1A) If:

- 14 (a) the Registrar is taken to have made a decision (the *initial*
15 *decision*) under paragraph 135A(2)(a); and
16 (b) under subsection (1) of this section, a person may apply to
17 the Administrative Appeals Tribunal for review of the initial
18 decision; and
19 (c) the Registrar, under subsection 135A(3), substitutes a
20 decision for the initial decision;
21 a person may apply to the Administrative Appeals Tribunal for
22 review of the substituted decision.

23 **169 Subsection 136(2)**

24 Omit “If a decision mentioned in subsection (1) is made”, substitute “If,
25 under subsection (1) or (1A), a person may apply to the Administrative
26 Appeals Tribunal for review of a decision”.

27 *Patents Act 1990*

28 **170 After section 223**

29 Insert:

EXPOSURE DRAFT

Schedule 2 Other measures

Part 5 Computerised decision-making

223A Computerised decision-making

(1) The Commissioner may arrange for the use, under the Commissioner's control, of computer programs for any purposes for which the Commissioner may, or must, under this Act:

- (a) make a decision; or
- (b) exercise any power or comply with any obligation; or
- (c) do anything else related to making a decision to which paragraph (a) applies or related to exercising a power, or complying with an obligation, to which paragraph (b) applies.

Note: A reference to this Act includes the regulations (see Schedule 1).

(2) For the purposes of this Act, the Commissioner is taken to have:

- (a) made a decision; or
- (b) exercised a power or complied with an obligation; or
- (c) done something else related to the making of a decision or the exercise of a power or the compliance with an obligation; that was made, exercised, complied with or done by the operation of a computer program under an arrangement made under subsection (1).

Substituted decisions

(3) The Commissioner may substitute a decision for a decision the Commissioner is taken to have made under paragraph (2)(a) if the Commissioner is satisfied that the decision made by the operation of the computer program is incorrect.

171 After subsection 224(1)

Insert:

(1A) If:

- (a) the Commissioner is taken to have made a decision (the *initial decision*) under paragraph 223A(2)(a); and
- (b) under subsection (1) of this section, application may be made to the Administrative Appeals Tribunal for review of the initial decision; and

EXPOSURE DRAFT

Other measures **Schedule 2**
Computerised decision-making **Part 5**

1 (c) the Commissioner, under subsection 223A(3), substitutes a
2 decision for the initial decision;
3 application may be made to the Administrative Appeals Tribunal
4 for review of the substituted decision.

5 **172 Subsection 224(2)**

6 Omit “Where a person who makes a decision mentioned in
7 subsection (1) gives the person or persons affected by the decision
8 written notice of the making of the decision”, substitute “If, under
9 subsection (1) or (1A), application may be made to the Administrative
10 Appeals Tribunal for review of a decision and a written notice of the
11 decision is given to a person whose interests are affected by the
12 decision”.

13 ***Plant Breeder’s Rights Act 1994***

14 **173 After section 76A**

15 Insert:

16 **76B Computerised decision-making**

- 17 (1) The Registrar may arrange for the use, under the Registrar’s
18 control, of computer programs for any purposes for which the
19 Registrar may, or must, under this Act or the regulations:
20 (a) make a decision; or
21 (b) exercise any power or comply with any obligation; or
22 (c) do anything else related to making a decision to which
23 paragraph (a) applies or related to exercising a power, or
24 complying with an obligation, to which paragraph (b)
25 applies.
- 26 (2) For the purposes of this Act and the regulations, the Registrar is
27 taken to have:
28 (a) made a decision; or
29 (b) exercised a power or complied with an obligation; or
30 (c) done something else related to the making of a decision or
31 the exercise of a power or the compliance with an obligation;

EXPOSURE DRAFT

Schedule 2 Other measures

Part 5 Computerised decision-making

1 that was made, exercised, complied with or done by the operation
2 of a computer program under an arrangement made under
3 subsection (1).

4 *Substituted decisions*

5 (3) The Registrar may substitute a decision for a decision the Registrar
6 is taken to have made under paragraph (2)(a) if the Registrar is
7 satisfied that the decision made by the operation of the computer
8 program is incorrect.

9 Note: A substituted decision under subsection (4) may be reviewable by the
10 AAT under section 77.

11 **174 After subsection 77(1)**

12 Insert:

13 (1A) If:

- 14 (a) the Registrar is taken to have made a decision (the *initial*
15 *decision*) under paragraph 76B(2)(a); and
16 (b) under subsection (1) of this section, applications may be
17 made to the AAT for review of the initial decision; and
18 (c) the Registrar, under subsection 76B(3), substitutes a decision
19 for the initial decision;
20 applications may be made to the AAT for review of the substituted
21 decision.

22 **175 Subsection 77(2)**

23 Omit “for a review of a decision referred to in subsection (1)”,
24 substitute “under subsection (1) or (1A) of this section for a review of a
25 decision”.

26 **176 Paragraph 77(3)(a)**

27 After “subsection (1)”, insert “or (1A)”.

28 *Trade Marks Act 1995*

29 **177 After Division 2 of Part 21**

30 Insert:

EXPOSURE DRAFT

Other measures **Schedule 2**
Computerised decision-making **Part 5**

1 **Division 2A—Computerised decision-making**

2 **222A Computerised decision-making**

3 (1) The Registrar may arrange for the use, under the Registrar's
4 control, of computer programs for any purposes for which the
5 Registrar may, or must, under this Act:

- 6 (a) make a decision; or
7 (b) exercise any power or comply with any obligation; or
8 (c) do anything else related to making a decision to which
9 paragraph (a) applies or related to exercising a power, or
10 complying with an obligation, to which paragraph (b)
11 applies.

12 Note: A reference to this Act includes the regulations (see section 6).

13 (2) For the purposes of this Act, the Registrar is taken to have:

- 14 (a) made a decision; or
15 (b) exercised a power or complied with an obligation; or
16 (c) done something else related to the making of a decision or
17 the exercise of a power or the compliance with an obligation;
18 that was made, exercised, complied with or done by the operation
19 of a computer program under an arrangement made under
20 subsection (1).

21 *Substituted decisions*

22 (3) The Registrar may substitute a decision for a decision the Registrar
23 is taken to have made under paragraph (2)(a) if the Registrar is
24 satisfied that the decision made by the operation of the computer
25 program is incorrect.

26 *Review*

27 (4) If:

- 28 (a) the Registrar is taken to have made a decision (the *initial*
29 *decision*) under paragraph (2)(a); and
30 (b) under another provision of this Act, an application may be
31 made to the Administrative Appeals Tribunal for review of
32 the initial decision; and

EXPOSURE DRAFT

Schedule 2 Other measures

Part 5 Computerised decision-making

- 1 (c) the Registrar, under subsection (3), substitutes a decision for
2 the initial decision;
3 an application may be made to the Administrative Appeals
4 Tribunal for review of the substituted decision.

EXPOSURE DRAFT

Other measures **Schedule 2**
Addresses and service of documents **Part 6**

1 **Part 6—Addresses and service of documents**
2

3 *Plant Breeder's Rights Act 1994*

4 **178 Subsection 3(4)**

5 Repeal the subsection, substitute:

6 (4) Subsection (2) of this section does not apply to a reference to an
7 *address* in subsection 26(2).

8 **179 At the end of subsection 19(5A)**

9 Add:

10 Note: After the time specified in regulations made for the purposes of
11 subsection 3(2), the address may be an electronic address: see
12 subsections 3(2), (5) and (6).

13 **180 Subsection 21(5) (before the note)**

14 Insert:

15 Note 1: After the time specified in regulations made for the purposes of
16 subsection 3(2), the address may be an electronic address: see
17 subsections 3(2), (5) and (6).

18 **181 Subsection 21(5) (note)**

19 Omit “Note”, substitute “Note 2”.

20 **182 After subsection 26(1)**

21 Insert:

22 (1A) Without limiting subsection (1), the approved form must require
23 the inclusion of an address in Australia or New Zealand for service,
24 being an address that is in accordance with the requirements of the
25 approved form.

26 Note: After the time specified in regulations made for the purposes of
27 subsection 3(2), the address may be an electronic address: see
28 subsections 3(2), (5) and (6).

EXPOSURE DRAFT

Schedule 2 Other measures

Part 6 Addresses and service of documents

1 **183 Subsection 26(3)**

2 Repeal the subsection.

3 **184 Subsection 31(3)**

4 Omit “notices”, substitute “documents”.

5 **185 At the end of subsection 31(3)**

6 Add:

7 Note: After the time specified in regulations made for the purposes of
8 subsection 3(2), the address may be an electronic address: see
9 subsections 3(2), (5) and (6).

10 **186 Subsection 31(4)**

11 Omit “notices”, substitute “documents”.

12 **187 At the end of section 73**

13 Add:

14 Note: After the time specified in regulations made for the purposes of
15 subsection 3(2), the address may be an electronic address: see
16 subsections 3(2), (5) and (6).

17 **188 Application provision**

18 The amendments of section 26 of the *Plant Breeder’s Rights Act 1994*
19 made by this Part apply in relation to applications for PBR in a plant
20 variety made on or after the commencement of this item.

EXPOSURE DRAFT

Other measures **Schedule 2**
Requirements for patent documents **Part 7**

1 **Part 7—Requirements for patent documents**

2 ***Patents Act 1990***

3 **189 Subsections 29(3) and (4)**

4 Repeal the subsections, substitute:

5 (3) A patent request in relation to a provisional application must:

- 6 (a) be in the approved form; and
7 (b) be in English; and
8 (c) be accompanied by a provisional specification.

9 (4) The provisional specification referred to in paragraph (3)(c) must:

- 10 (a) be in the approved form; and
11 (b) be in English.

12 (4A) A patent request in relation to a complete application must:

- 13 (a) be in the approved form; and
14 (b) be in English; and
15 (c) be accompanied by a complete specification; and
16 (d) comply with the formalities requirements determined in an
17 instrument under section 229.

18 (4B) The complete specification referred to in paragraph (4A)(c) must:

- 19 (a) be in the approved form; and
20 (b) be in English; and
21 (c) comply with the formalities requirements determined in an
22 instrument under section 229.

23 **190 Subsection 29A(2)**

24 After “drawings”, insert “, graphics, photographs”.

25 **191 Subsection 40(3A)**

26 Omit “or drawings”, substitute “, drawings, graphics or photographs”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 7 Requirements for patent documents

1 **192 Paragraph 151(4)(f)**

2 Omit “and drawings”, substitute “, drawings, graphics and
3 photographs”.

4 **193 Paragraph 176(f)**

5 Omit “and drawings”, substitute “, drawings, graphics and
6 photographs”.

7 **194 Subparagraph 228(2)(ha)(i)**

8 After “subsections 18(2) and (3)”, insert “and 29(4A) and (4B)”.

9 **195 Subparagraph 228(2)(ha)(ii)**

10 Omit “the application is in accordance with the requirements of the
11 regulations relating to the preparation of documents for filing”,
12 substitute “those formalities requirements are met”.

13 **196 Subparagraph 228(2)(i)(i)**

14 Omit “the requirements of subsection 29A(5) have been met”, substitute
15 “the applicant has complied with subsection 29A(5)”.

16 **197 Subparagraph 228(2)(i)(ii)**

17 Omit “the PCT application is in accordance with those requirements”,
18 substitute “those requirements are met”.

19 **198 After paragraph 228(2)(i)**

20 Insert:

21 (ia) making provision for and in relation to:

22 (i) empowering the Commissioner, in relation to a
23 provisional patent application, to direct the applicant to
24 do such things as are necessary to ensure that the
25 provisional specification complies with the
26 requirements of subsection 29(4); and

27 (ii) the provisional specification being taken not to have
28 been filed if such a direction is not complied with within
29 a time specified in the regulations; and

30 **199 Paragraph 228(2)(j)**

31 After “ensure that the”, insert “patent request or”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Requirements for patent documents **Part 7**

1 **200 Paragraph 228(2)(j)**

2 Omit “the requirements of the regulations relating to the preparation of
3 documents for filing”, substitute “the requirements of
4 subsection 29(4A) or (4B)”.

5 **201 At the end of Chapter 22**

6 Add:

7 **229 Instrument determining formalities requirements for patent**
8 **documents**

- 9 (1) The Commissioner may, by written instrument, determine
10 formalities requirements for the purposes of the following:
11 (a) paragraphs 29(4A)(d) and (4B)(c);
12 (b) a provision of the regulations, if that provision refers to this
13 section.
- 14 (2) The Commissioner must publish a notice in the Official Journal
15 setting out the determination.
- 16 (3) A determination under subsection (1) is not a legislative
17 instrument.

18 **202 Schedule 1 (definition of *specification*)**

19 Omit “and drawings”, substitute “, drawings, graphics and
20 photographs”.

21 **203 Application and transitional provisions**

- 22 (1) The amendments of section 29 of the *Patents Act 1990* made by this
23 Part apply in relation to patent requests filed under subsection 29(1) of
24 that Act on or after the commencement of this item.
- 25 (2) An instrument approving a form and in force for the purposes of
26 subsection 29(3) of the *Patents Act 1990* immediately before the
27 commencement of this item has effect on and after that commencement
28 as if it were an instrument approving that form and in force for the
29 purposes of paragraph 29(3)(a) of that Act.
- 30 (3) An instrument approving a form and in force for the purposes of
31 subsection 29(4) of the *Patents Act 1990* immediately before the
-

EXPOSURE DRAFT

Schedule 2 Other measures

Part 7 Requirements for patent documents

1 commencement of this item has effect on and after that commencement
2 as if it were an instrument approving that form and in force for the
3 purposes of paragraph 29(4A)(a) of that Act.

4 (4) An instrument approving a form and in force for the purposes of
5 paragraph 3.2(1)(a) of the *Patents Regulations 1991* immediately before
6 the commencement of this item has effect on and after that
7 commencement as if it were an instrument approving that form and in
8 force for the purposes of paragraph 29(4)(a) of the *Patents Act 1990*.

9 (5) An instrument approving a form and in force for the purposes of
10 paragraph 3.2A(2)(a) of the *Patents Regulations 1991* immediately
11 before the commencement of this item has effect on and after that
12 commencement as if it were an instrument approving that form and in
13 force for the purposes of paragraph 29(4B)(a) of the *Patents Act 1990*.

EXPOSURE DRAFT

Other measures **Schedule 2**
Unjustified threats of infringement **Part 8**

1 **Part 8—Unjustified threats of infringement**

2 **Division 1—Amendments**

3 *Designs Act 2003*

4 **204 After subsection 77(1)**

5 Insert:

6 (1A) The court may include an additional amount in an assessment of
7 damages sustained by the applicant as a result of the unjustified
8 threats, if the court considers it appropriate to do so having regard
9 to:

- 10 (a) the flagrancy of the threats; and
11 (b) the need to deter similar threats; and
12 (c) the conduct of the respondent that occurred after the
13 respondent made the threats; and
14 (d) any benefit shown to have accrued to the respondent because
15 of the threats; and
16 (e) all other relevant matters.

17 *Olympic Insignia Protection Act 1987*

18 **205 Division 3 of Part 3.4 (heading)**

19 Repeal the heading, substitute:

20 **Division 3—Unjustified threats**

21 **206 Section 64 (heading)**

22 Repeal the heading, substitute:

23 **64 Unjustified threats of legal proceedings**

24 **207 Paragraph 64(2)(a)**

25 Omit “AOC or the licensed user had no grounds for making the threat”,
26 substitute “threat is unjustified”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 8 Unjustified threats of infringement

1 **208 Section 65 (heading)**

2 Repeal the heading, substitute:

3 **65 Counterclaim**

4 ***Patents Act 1990***

5 **209 After subsection 128(1)**

6 Insert:

7 (1A) The court may include an additional amount in an assessment of
8 damages sustained by the applicant as a result of the unjustifiable
9 threats, if the court considers it appropriate to do so having regard
10 to:

- 11 (a) the flagrancy of the threats; and
12 (b) the need to deter similar threats; and
13 (c) the conduct of the person who made the threats, being
14 conduct that occurred after the person made the threats; and
15 (d) any benefit shown to have accrued to the person who made
16 the threats because of the threats; and
17 (e) all other relevant matters.

18 ***Plant Breeder's Rights Act 1994***

19 **210 Subsection 3(1)**

20 Insert:

21 *legal practitioner* means a barrister or solicitor of the High Court
22 or of the Supreme Court of a State or Territory.

23 **211 At the end of Part 5**

24 Add:

25 **57A Application for relief from unjustified threats**

26 (1) If a person is threatened by another person (the *respondent*) with
27 proceedings for infringement of PBR in a plant variety, or other

EXPOSURE DRAFT

Other measures **Schedule 2**
Unjustified threats of infringement **Part 8**

- 1 similar proceedings, an aggrieved person (the *applicant*) may
2 apply to the Federal Court or Federal Circuit Court for:
- 3 (a) a declaration that the threats are unjustified; and
4 (b) an injunction against the continuance of the threats; and
5 (c) the recovery of any damages sustained by the applicant as a
6 result of the threats.
- 7 (2) The Federal Court or Federal Circuit Court may include an
8 additional amount in an assessment of damages sustained by the
9 applicant as a result of the unjustified threats, if the Court considers
10 it appropriate to do so having regard to:
- 11 (a) the flagrancy of the threats; and
12 (b) the need to deter similar threats; and
13 (c) the conduct of the respondent that occurred after the
14 respondent made the threats; and
15 (d) any benefit shown to have accrued to the respondent because
16 of the threats; and
17 (e) all other relevant matters.
- 18 (3) A threat mentioned in subsection (1) may be by means of circulars,
19 advertisements or otherwise.
- 20 (4) Subsection (1) applies whether or not the respondent is the grantee
21 of the PBR in the plant variety or an exclusive licensee of the
22 grantee.

57B Court's power to grant relief

- 24 The Federal Court or Federal Circuit Court may grant the relief
25 sought by an applicant under section 57A, unless the respondent
26 satisfies the Court that:
- 27 (a) the respondent is the grantee of the PBR in the plant variety
28 or an exclusive licensee of the grantee; and
29 (b) the acts about which the threats were made infringe, or would
30 infringe, the PBR in the plant variety.

57C Counterclaim for infringement

- 32 (1) The respondent in proceedings under section 57A may apply, by
33 way of counter-claim, for relief to which the respondent would be
-

EXPOSURE DRAFT

Schedule 2 Other measures

Part 8 Unjustified threats of infringement

1 entitled in separate proceedings against the applicant for
2 infringement of the PBR in the plant variety.

3 (2) The provisions of this Act relating to proceedings for infringement
4 of PBR in a plant variety apply, with the necessary changes, to a
5 counter-claim under subsection (1).

6 **57D Notification of PBR in a plant variety not a threat**

7 The mere notification of the existence of PBR in a plant variety
8 does not constitute a threat of proceedings for the purposes of
9 section 57A.

10 **57E Liability of legal practitioner**

11 A legal practitioner is not liable to proceedings under section 57A
12 in respect of an act done in a professional capacity on behalf of a
13 client.

14 *Trade Marks Act 1995*

15 **212 Section 129 (heading)**

16 Repeal the heading, substitute:

17 **129 Application for relief from unjustified threats**

18 **213 Paragraph 129(2)(a)**

19 Omit “defendant has no grounds for making the threat”, substitute
20 “threat is unjustified”.

21 **214 After subsection 129(2)**

22 Insert:

23 (2A) The court may include an additional amount in an assessment of
24 damages the plaintiff has sustained because of the defendant’s
25 conduct, if the court considers it appropriate to do so having regard
26 to:

- 27 (a) the flagrancy of the threat; and
28 (b) the need to deter similar threats; and

EXPOSURE DRAFT

Other measures **Schedule 2**
Unjustified threats of infringement **Part 8**

- 1 (c) the conduct of the defendant that occurred after the defendant
2 made the threat; and
3 (d) any benefit shown to have accrued to the defendant because
4 of the threat; and
5 (e) all other relevant matters.

6 **215 Subsection 129(5)**

7 Repeal the subsection.

8 **216 Section 130 (heading)**

9 Repeal the heading, substitute:

10 **130 Counterclaim for infringement**

11 **217 At the end of Part 12**

12 Add:

13 **130A Mere notification of registered trade mark not a threat**

14 The mere notification of the existence of a registered trade mark
15 does not constitute a threat to bring an action for the purposes of
16 section 129.

17 **Division 2—Application and saving provisions**

18 **218 Application and saving provisions**

19 *Designs*

20 (1) The amendment of section 77 of the *Designs Act 2003* made by this Part
21 applies in relation to threats of the kind referred to in subsection 77(1)
22 of that Act that are made on or after the commencement of this item.

23 *Olympic expressions*

24 (2) The amendments of section 64 of the *Olympic Insignia Protection Act*
25 *1987* made by this Part apply in relation to threats of the kind referred to
26 in subsection 64(1) of that Act that are made on or after the
27 commencement of this item.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 8 Unjustified threats of infringement

1

Patents

2

- (3) The amendment of section 128 of the *Patents Act 1990* made by this Part applies in relation to threats of the kind referred to in subsection 128(1) of that Act that are made on or after the commencement of this item.

3

4

5

6

Plant breeder's rights

7

- (4) Section 57A of the *Plant Breeder's Rights Act 1994*, as added by this Schedule, applies in relation to threats of the kind referred to in subsection 57A(1) of that Act that are made on or after the commencement of this item.

8

9

10

11

Trade marks

12

- (5) The amendments of section 129 of the *Trade Marks Act 1995* made by this Part (except the repeal of subsection 129(5) of that Act) apply in relation to threats of the kind referred to in subsection 129(1) of that Act that are made on or after the commencement of this item.

13

14

15

16

- (6) Despite the repeal of subsection 129(5) of the *Trade Marks Act 1995* made by this Part, that subsection, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to an action for infringement of a trade mark begun before that commencement.

17

18

19

20

EXPOSURE DRAFT

Other measures **Schedule 2**
Ownership of PBR and entries in the Register **Part 9**

1 **Part 9—Ownership of PBR and entries in the**
2 **Register**

3 ***Plant Breeder’s Rights Act 1994***

4 **219 Subsection 3(1)**

5 Insert:

6 *relevant proceedings*, in relation to PBR in a plant variety, means
7 proceedings in a court or in the AAT relating to:

- 8 (a) the grant of the PBR; or
9 (b) the infringement of the PBR; or
10 (c) a decision to revoke, or not to revoke, the PBR.

11 **220 Subsection 45(1)**

12 Omit “subsections (2) and (3)”, substitute “subsection (3)”.

13 **221 At the end of subsection 45(1)**

14 Add:

15 Note: If PBR is granted to persons who make a joint application, the PBR is
16 granted to those persons jointly: see subsection 44(11).

17 **222 Subsection 45(2)**

18 Repeal the subsection.

19 **223 At the end of Part 6**

20 Add:

21 **62A Registrar’s power to rectify Register**

22 (1) The Registrar may rectify the Register if the Registrar is satisfied,
23 whether on application or otherwise, of any of the following:

- 24 (a) the omission of an entry from the Register;
25 (b) an entry made in the Register without sufficient cause;
26 (c) an entry wrongly existing in the Register;
27 (d) an error or defect in an entry in the Register.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 9 Ownership of PBR and entries in the Register

1

Form of application

2

- (2) An application under subsection (1) must be in the approved form.

3

Further information

4

- (3) The Registrar:

5

- (a) may seek further information from any person for the purpose of considering an application under subsection (1); and

6

7

8

- (b) is not required to consider the application while seeking the further information.

9

10

Persons to be heard

11

- (4) The Registrar must not rectify the Register under this section in relation to PBR in a plant variety without first giving the following persons a reasonable opportunity to be heard:

12

13

14

- (a) in the case of an application to rectify the Register—the applicant;

15

16

- (b) the grantee of the PBR as recorded in the Register;

17

- (c) any other person the Registrar considers appropriate.

18

Relevant proceedings pending

19

- (5) The Registrar must not rectify the Register under this section in relation to PBR in a plant variety while:

20

21

- (a) relevant proceedings in relation to the PBR are pending; or

22

23

- (b) proceedings in a court or in the AAT, relating to a decision under section 21 to amend, or refuse to amend, the Register in relation to the PBR, are pending.

24

25

Note: A decision under this section to rectify, or refuse to rectify, the Register is reviewable by the AAT under section 77.

26

27

224 At the end of paragraph 77(1)(b)

28

Add:

29

- (xvii) under section 62A to rectify, or refuse to rectify, the Register.

30

82

EXPOSURE DRAFT

Other measures **Schedule 2**
Ownership of PBR and entries in the Register **Part 9**

1 **225 Paragraph 80(2)(d)**

2 After “mistake”, insert “, or for any other purpose”.

3 **226 Application provision**

4 Section 62A of the *Plant Breeder’s Rights Act 1994*, as added by this
5 Part, applies in relation to:

- 6 (a) PBR in a plant variety granted before, on or after the
7 commencement of this item; and
8 (b) entries made in the Register before, on or after that
9 commencement.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 10 Trade mark oppositions

1 **Part 10—Trade mark oppositions**

2 ***Trade Marks Act 1995***

3 **227 Paragraph 222(a)**

4 After “subsection”, insert “65A(4), 83A(4) or”.

5 **228 Subsection 231(3)**

6 Omit “and 92”, substitute “, 65A, 83A and 96”.

7 **229 Application provision**

8 The amendment of paragraph 222(a) of the *Trade Marks Act 1995* made
9 by this Part applies in relation to a request referred to in
10 subsection 65A(4) or 83A(4) of that Act that is made on or after the
11 commencement of this item.

EXPOSURE DRAFT

Other measures **Schedule 2**
Further power to award damages under the Plant Breeder's Rights Act **Part 11**

1 **Part 11—Further power to award damages under the**
2 **Plant Breeder's Rights Act**

3 *Plant Breeder's Rights Act 1994*

4 **230 After subsection 56(3)**

5 Insert:

- 6 (3A) The Federal Court may include an additional amount in an
7 assessment of damages for an infringement of PBR, if the Court
8 considers it appropriate to do so having regard to:
- 9 (a) the flagrancy of the infringement; and
 - 10 (b) the need to deter similar infringements of PBR; and
 - 11 (c) the conduct of the party that infringed the PBR that occurred:
 - 12 (i) after the act constituting the infringement; or
 - 13 (ii) after that party was informed that it had allegedly
14 infringed the PBR; and
 - 15 (d) any benefit shown to have accrued to that party because of
16 the infringement; and
 - 17 (e) all other relevant matters.

18 **231 After subsection 56A(3)**

19 Insert:

- 20 (3A) The Federal Circuit Court may include an additional amount in an
21 assessment of damages for an infringement of PBR, if the Court
22 considers it appropriate to do so having regard to:
- 23 (a) the flagrancy of the infringement; and
 - 24 (b) the need to deter similar infringements of PBR; and
 - 25 (c) the conduct of the party that infringed the PBR that occurred:
 - 26 (i) after the act constituting the infringement; or
 - 27 (ii) after that party was informed that it had allegedly
28 infringed the PBR; and
 - 29 (d) any benefit shown to have accrued to that party because of
30 the infringement; and
 - 31 (e) all other relevant matters.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 11 Further power to award damages under the Plant Breeder's Rights Act

1 **232 Application and transitional provisions**

2 (1) The amendments of sections 56 and 56A of the *Plant Breeder's Rights*
3 *Act 1994* made by this Part apply in relation to infringements of PBR
4 that occur on or after the commencement of that Part.

5 (2) If, on or after the commencement of this Part, an action for infringement
6 of PBR is begun in relation to conduct engaged in before and on or after
7 that commencement, the Federal Court or the Federal Circuit Court may
8 include an additional amount in an assessment of damages under
9 subsection 56(3A) or 56A(3A) of the *Plant Breeder's Rights Act 1994*
10 only in relation to the conduct that was engaged in on or after
11 commencement.

EXPOSURE DRAFT

Other measures **Schedule 2**
Exclusive licensees in the Plant Breeder's Rights Act **Part 12**

1 **Part 12—Exclusive licensees in the Plant Breeder's**
2 **Rights Act**

3 *Plant Breeder's Rights Act 1994*

4 **233 Section 3**

5 Insert:

6 *exclusive licensee* of the grantee of PBR in a plant variety means a
7 licensee under a licence granted by the grantee that confers on the
8 licensee, or on the licensee and persons authorised by the licensee,
9 PBR in the plant variety to the exclusion of the grantee and all
10 other persons.

11 **234 Paragraph 51(1)(b)**

12 Omit “54(3)”, substitute “54A(2)”.

13 **235 At the end of section 53**

14 Add:

15 (4) In this section, if a grantee of a PBR in a plant variety has granted
16 an exclusive licence in relation to that right, a reference to the
17 grantee is taken to be a reference to the exclusive licensee.

18 **236 At the end of subsection 54(1)**

19 Add “or an exclusive licensee of the grantee”.

20 **237 Subsections 54(2) to (4)**

21 Repeal the subsections, substitute:

22 (2) If an exclusive licensee of a grantee of PBR in a plant variety
23 begins an action for infringement of that right, the licensee must
24 make the grantee a defendant in the action, unless the grantee is
25 joined as a plaintiff.

26 (3) A grantee who is made a defendant in an action is not liable for
27 costs if the grantee does not take part in the proceedings.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 12 Exclusive licensees in the Plant Breeder's Rights Act

1 **238 After section 54**

2 Insert:

3 **54A Counterclaims to actions for infringement**

4 (1) A defendant in an action for infringement of PBR in a plant variety
5 may apply, by way of counterclaim, for revocation of that right on
6 the ground that:

7 (a) the variety was not a new plant variety; or

8 (b) facts exist that would have resulted in the refusal of the grant
9 of that right if they had been known to the Registrar before
10 the grant of that right.

11 (2) If, in an action for infringement of PBR in a plant variety:

12 (a) the defendant applies, by way of counterclaim, for the
13 revocation of that right; and

14 (b) the court is satisfied that a ground for revocation of that right
15 exists;

16 the court may make an order revoking that right.

17 (3) If the court revoked PBR in a plant variety on the counterclaim of a
18 defendant, the court may order the defendant to serve on the
19 Registrar a copy of the order revoking that right.

20 **239 At the end of section 55**

21 Add:

22 (7) The grantee must be joined as a respondent in the proceedings.

23 (8) In this section:

24 *grantee* includes an exclusive licensee of the grantee.

25 **240 Application and transitional provisions**

26 (1) The amendments made by this Part apply in relation to conduct engaged
27 in on or after the commencement of this Part.

28 (2) If, on or after the commencement of this Part, an exclusive licensee of
29 PBR in a plant variety begins an action for infringement of PBR in
30 relation to conduct engaged in before and on or after that

EXPOSURE DRAFT

Other measures **Schedule 2**
Exclusive licensees in the Plant Breeder's Rights Act **Part 12**

1 commencement, the Federal Court or the Federal Circuit Court may
2 only grant relief under section 56 or 56A of the *Plant Breeder's Rights*
3 *Act 1994* in relation to the conduct that was engaged in on or after
4 commencement.

EXPOSURE DRAFT

EXPOSURE DRAFT

Schedule 2 Other measures

Part 13 Publishing personal information of registered patent or trade marks attorneys

1 **Part 13—Publishing personal information of**
2 **registered patent or trade marks attorneys**

3 **Division 1—Amendments**

4 ***Patents Act 1990***

5 **241 After subsection 183(1)**

6 Insert:

- 7 (1A) The Designated Manager may disclose to the Board personal
8 information (within the meaning of the *Privacy Act 1988*):
9 (a) that is about a registered patent attorney; and
10 (b) that the Designated Manager considers to be relevant to the
11 Board's functions.

12 **242 After section 227A**

13 Insert:

14 **227B Publishing personal information of registered patent attorneys**

- 15 (1) The Board may publish on its website any or all of the following
16 personal information (within the meaning of the *Privacy Act 1988*)
17 that is about a registered patent attorney:
18 (a) the name of the attorney;
19 (b) the country in which the attorney's work address is located;
20 (c) if the attorney's work address is located in Australia—the
21 State or Territory in which the attorney's work address is
22 located;
23 (d) if the attorney's work address is located in a foreign
24 country—the state, territory, province, region or other
25 political subdivision (however described) of that country in
26 which the attorney's work address is located;
27 (e) the attorney's work email address.
- 28 (2) Subsection (1) does not prevent the Board from publishing on its
29 website other personal information (within the meaning of the

EXPOSURE DRAFT

Schedule 2 Other measures

Part 13 Publishing personal information of registered patent or trade marks attorneys

1 **Division 2—Application provisions**

2 **245 Application provisions**

3 *Patents*

- 4 (1) The amendments of the *Patents Act 1990* made by this Part apply in
5 relation to information about a registered patent attorney obtained
6 before, on or after the commencement of this item (whether the attorney
7 was registered under that Act before, on or after that commencement).

8 *Trade marks*

- 9 (2) The amendments of the *Trade Marks Act 1995* made by this Part apply
10 in relation to information about a registered trade marks attorney
11 obtained before, on or after the commencement of this item (whether
12 the attorney was registered under that Act before, on or after that
13 commencement).

EXPOSURE DRAFT

Other measures **Schedule 2**
Secretary's role in the Plant Breeder's Rights Act **Part 14**

1 **Part 14—Secretary's role in the Plant Breeder's**
2 **Rights Act**

3 *Plant Breeder's Rights Act 1994*

4 **246 Subsection 3(1) (definition of *approved form*)**

5 Repeal the definition, substitute:

6 *approved form*, in relation to a provision of this Act, means a form
7 approved in an instrument under subsection (1B) for the purposes
8 of that provision.

9 **247 Subsection 3(1) (definition of *genetic resource centre*)**

10 Omit "Secretary", substitute "Registrar".

11 **248 Subsection 3(1) (definition of *herbarium*)**

12 Omit "Secretary", substitute "Registrar".

13 **249 Subsection 3(1) (definition of *Secretary*)**

14 Repeal the definition.

15 **250 After subsection 3(1A)**

16 Insert:

17 (1B) The Registrar may, by writing, approve a form for the purposes of
18 a provision of this Act.

19 **251 Subsection 8(1)**

20 Omit "Secretary", substitute "Registrar".

21 **252 Subsections 19(3) and (4) and (6) to (11)**

22 Omit "Secretary" (wherever occurring), substitute "Registrar".

23 **253 Subsection 24(1)**

24 Omit "Secretary", substitute "Registrar".

EXPOSURE DRAFT

Schedule 2 Other measures

Part 14 Secretary's role in the Plant Breeder's Rights Act

1 **254 Subparagraph 26(2)(i)(iii)**

2 Omit "Secretary", substitute "Registrar".

3 **255 Subsections 28(1), (2) and (3)**

4 Omit "Secretary", substitute "Registrar".

5 **256 Subsections 29(3) and (4)**

6 Omit "Secretary", substitute "Registrar".

7 **257 Subsections 30(1) to (5)**

8 Omit "Secretary" (wherever occurring), substitute "Registrar".

9 **258 Subsections 31(1), (2), (4), (5) and (6)**

10 Omit "Secretary" (wherever occurring), substitute "Registrar".

11 **259 Subsections 32(1) to (5)**

12 Omit "Secretary" (wherever occurring), substitute "Registrar".

13 **260 Subsection 33(2)**

14 Omit "Secretary", substitute "Registrar".

15 **261 Section 34 (heading)**

16 Repeal the heading, substitute:

17 **34 Detailed description in support of application to be given to**
18 **Registrar**

19 **262 Subsections 34(1), (2), (5) and (6)**

20 Omit "Secretary" (wherever occurring), substitute "Registrar".

21 **263 Subsections 35(1) and (2)**

22 Omit "Secretary" (wherever occurring), substitute "Registrar".

23 **264 Paragraph 36(3)(d)**

24 Omit "Secretary", substitute "Registrar".

EXPOSURE DRAFT

Other measures **Schedule 2**
Secretary's role in the Plant Breeder's Rights Act **Part 14**

1 **265 Subsection 37(1)**

2 Omit "Secretary" (wherever occurring), substitute "Registrar".

3 **266 Subsection 37(2)**

4 Omit "Secretary's", substitute "Registrar's".

5 **267 Paragraph 37(2)(b)**

6 Omit "Secretary" (wherever occurring), substitute "Registrar".

7 **268 Subsections 37(2B), (3), (4), (6) and (7)**

8 Omit "Secretary" (wherever occurring), substitute "Registrar".

9 **269 Subsections 38(4) and (5)**

10 Omit "Secretary", substitute "Registrar".

11 **270 Subsection 38(5) (note)**

12 Omit "Secretary", substitute "Registrar".

13 **271 Subsections 39(1), (2) and (4)**

14 Omit "Secretary" (wherever occurring), substitute "Registrar".

15 **272 Subsections 40(1), (3), (6), (7), (8), (9), (10) and (11)**

16 Omit "Secretary" (wherever occurring), substitute "Registrar".

17 **273 Subsections 41(1), (2) and (5)**

18 Omit "Secretary" (wherever occurring), substitute "Registrar".

19 **274 Subsections 44(1), (2), (3), (4), (5), (6) and (9)**

20 Omit "Secretary" (wherever occurring), substitute "Registrar".

21 **275 Subsection 44(10)**

22 Omit "issue to that person by the Secretary", substitute "issue to that
23 person by the Registrar".

24 **276 Subsection 44(10)**

25 Omit "the Secretary or".

EXPOSURE DRAFT

Schedule 2 Other measures

Part 14 Secretary's role in the Plant Breeder's Rights Act

1 **277 Subsection 44(10)**

2 Omit "as the Secretary", substitute "as the Registrar".

3 **278 Subsection 44(12)**

4 Omit "Secretary" (wherever occurring), substitute "Registrar".

5 **279 Subsection 46(1)**

6 Omit "Secretary", substitute "Registrar".

7 **280 Subsections 47(1) and (2)**

8 Omit "Secretary", substitute "Registrar".

9 **281 Paragraph 49(3)(a)**

10 Omit "Secretary", substitute "Registrar".

11 **282 Subsections 50(1), (2), (3), (4), (5), (8), (9) and (10)**

12 Omit "Secretary" (wherever occurring), substitute "Registrar".

13 **283 Subsections 51(1) and (3)**

14 Omit "Secretary" (wherever occurring), substitute "Registrar".

15 **284 Section 52**

16 Omit "Secretary", substitute "Registrar".

17 **285 Subsection 58(3)**

18 Repeal the subsection, substitute:

19 (3) The Registrar has the functions and powers that are conferred on
20 the Registrar by this Act or by the regulations.

21 **286 Subsection 59(2)**

22 Repeal the subsection.

23 **287 Subsection 59(4)**

24 Omit "the Minister or the Secretary under subsection (1) or (2)",
25 substitute "the Minister under subsection (1)".

EXPOSURE DRAFT

Other measures **Schedule 2**
Secretary's role in the Plant Breeder's Rights Act **Part 14**

1 **288 Subsection 59(5)**

2 Omit "person who originally delegated the corresponding power or
3 function under subsection (1) or (2)", substitute "Minister".

4 **289 Paragraph 60(1)(a)**

5 Repeal the paragraph.

6 **290 Subsection 61(1)**

7 Omit "Secretary", substitute "Registrar".

8 **291 Subsections 68(1), (2), (3) and (4)**

9 Omit "Secretary" (wherever occurring), substitute "Registrar".

10 **292 Subsection 70(1)**

11 Omit "Secretary" (wherever occurring), substitute "Registrar".

12 **293 Section 71**

13 Omit "Secretary" (wherever occurring), substitute "Registrar".

14 **294 Paragraph 73(b)**

15 Omit "the Secretary or".

16 **295 Subsection 75(1)**

17 Omit "the Secretary or".

18 **296 Paragraph 77(1)(b)**

19 Omit "by the Secretary", substitute "by the Registrar".

20 **297 After subparagraph 77(1)(b)(iv)**

21 Insert:

22 (iva) under section 21 to amend, or refuse to amend, the
23 Register; or

24 **298 Subparagraphs 77(1)(b)(ix) and (x)**

25 Omit "Secretary", substitute "Registrar".

EXPOSURE DRAFT

Schedule 2 Other measures

Part 14 Secretary's role in the Plant Breeder's Rights Act

1 **299 Paragraph 77(1)(c)**

2 Repeal the paragraph.

3 **300 Subsection 77(3)**

4 Omit "Secretary", substitute "Registrar".

5 **301 Subparagraph 80(2)(a)(iv)**

6 Omit "Secretary", substitute "Registrar".

7 **302 Saving and transitional provisions**

- 8 (1) A thing done by, or in relation to, the Secretary under the *Plant*
9 *Breeder's Rights Act 1994* before the commencement of this item has
10 effect on and after that commencement as if it had been done by, or in
11 relation to, the Registrar.
- 12 (2) A form approved by the Secretary and in force immediately before the
13 commencement of this item for the purposes of a provision of the *Plant*
14 *Breeder's Rights Act 1994* has effect on and after that commencement
15 as if it were a form approved by the Registrar in an instrument under
16 subsection 3(1B) of that Act for the purposes of that provision.
- 17 (3) Despite the repeal of paragraph 60(1)(a) of the *Plant Breeder's Rights*
18 *Act 1994* made by this Part, that paragraph, as in force immediately
19 before the commencement of this item, continues in force on and after
20 that commencement for the period of 12 months beginning on the day
21 this item commences.
- 22 (4) Paragraph 77(1)(c) of the *Plant Breeder's Rights Act 1994*, as in force
23 immediately before the commencement of this item, continues to apply
24 on and after that commencement in relation to a decision of the
25 Registrar, before that commencement, under section 21 of that Act to
26 amend, or refuse to amend, the Register.

EXPOSURE DRAFT

Other measures **Schedule 2**
Seizure notices **Part 15**

1 **Part 15—Seizure notices**

2 **Division 1—Amendments**

3 ***Copyright Act 1968***

4 **303 Subsection 135AC(1)**

5 Omit “either personally or by post, a written notice”, substitute “by any
6 means of communication (including by electronic means), a notice”.

7 **304 Paragraphs 135AC(3)(c) and (d)**

8 Repeal the paragraphs, substitute:

- 9 (c) if the notice is given to the objector—state the name and the
10 address of the place of business or residence of the importer
11 (if known), unless the Comptroller-General of Customs is
12 satisfied, for reasons of confidentiality, that it is not desirable
13 to do so; and
14 (d) if the notice is given to the importer—state the name and the
15 address of the place of business or residence of:
16 (i) the objector; or
17 (ii) if the objector has nominated a person to be the
18 objector’s agent or representative for the purposes of
19 this Division—that person;
20 unless the Comptroller-General of Customs is satisfied, for
21 reasons of confidentiality, that it is not desirable to do so.

22 ***Olympic Insignia Protection Act 1987***

23 **305 Subsection 55(1)**

24 Omit “either personally or by post, a written notice”, substitute “by any
25 means of communication (including by electronic means), a notice”.

26 **306 Paragraph 55(2)(a)**

27 Repeal the paragraph, substitute:

- 28 (a) state the name and the address of the place of business or
29 residence of the designated owner (if known), unless the
-

EXPOSURE DRAFT

Schedule 2 Other measures

Part 15 Seizure notices

1 Comptroller-General of Customs is satisfied, for reasons of
2 confidentiality, that it is not desirable to do so; and

3 *Trade Marks Act 1995*

4 **307 Subsection 134(1)**

5 Omit “either personally or by post, a written notice”, substitute “by any
6 means of communication (including by electronic means), a notice”.

7 **308 Paragraphs 134(3)(c) and (d)**

8 Repeal the paragraphs, substitute:

- 9 (c) if the notice is given to the objector—state the name and the
10 address of the place of business or residence of the
11 designated owner (if known), unless the Comptroller-General
12 of Customs is satisfied, for reasons of confidentiality, that it
13 is not desirable to do so; and
- 14 (d) if the notice is given to the designated owner—state the name
15 and the address of the place of business or residence of:
- 16 (i) the objector; or
17 (ii) if the objector has nominated a person to be the
18 objector’s agent or representative for the purposes of
19 this Division—that person;
20 unless the Comptroller-General of Customs is satisfied, for
21 reasons of confidentiality, that it is not desirable to do so.

22 **Division 2—Application provisions**

23 **309 Application provisions**

24 *Copyright*

- 25 (1) The amendments of section 135AC of the *Copyright Act 1968* made by
26 this Part apply in relation to notices given under subsection 135AC(1)
27 of that Act on or after the commencement of this item.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 16 Prosecutions

1 **Part 16—Prosecutions**

2 **Division 1—Amendments**

3 *Patents Act 1990*

4 **310 Section 204**

5 Omit “or (5)”, substitute “, (5) or (6) or 201B(1) or (2)”.

6 **311 Section 204**

7 After “202A”, insert “, 202B”.

8 *Trade Marks Act 1995*

9 **312 Subsection 156(3A)**

10 Omit “the company” (first occurring).

11 **313 Before subsection 156(4)**

12 Insert:

13 *Common rules*

14 **314 At the end of section 157A**

15 Add:

16 *Time for starting prosecutions*

17 (9) Despite section 15B of the *Crimes Act 1914*, a prosecution for an
18 offence against this section may be started at any time within 5
19 years after the offence was committed.

EXPOSURE DRAFT

Other measures **Schedule 2**
Prosecutions **Part 16**

1 **Division 2—Application provision**

2 **315 Application provision**

3 The amendments of section 204 of the *Patents Act 1990* and of
4 section 157A of the *Trade Marks Act 1995* made by this Part apply in
5 relation to offences committed on or after the commencement of this
6 item.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 17 Updating references to Designs Act

1 **Part 17—Updating references to Designs Act**

2 ***Olympic Insignia Protection Act 1987***

3 **316 Subsection 2(1) (definition of *Registrar*)**

4 Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

5 **317 Subsection 2(2)**

6 Repeal the subsection.

7 **318 Subsection 2(3)**

8 Omit “*Designs Act 1906*” (wherever occurring), substitute “*Designs Act*
9 *2003*”.

10 **319 Paragraph 10(7)(e)**

11 Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

12 **320 Subsection 10(12) (paragraph (a) of the definition of**
13 ***published design*)**

14 Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

15 **321 Subsection 12(5)**

16 Omit “Section 36 of the *Designs Act 1906*”, substitute “Section 131 of
17 the *Designs Act 2003*”.

18 **322 Section 13**

19 Omit “Section 8A of the *Designs Act 1906*”, substitute “Section 124 of
20 the *Designs Act 2003*”.

21 **323 Section 18 (heading)**

22 Repeal the heading, substitute:

23 **18 Protected designs not to be registered under the *Designs Act 2003***

24 **324 Section 18**

25 Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

EXPOSURE DRAFT

Other measures **Schedule 2**
Updating references to Designs Act **Part 17**

- 1 **325 Paragraphs 20(1)(b) and (3)(d)**
2 Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 18 Removing certain references to New Zealand

1 **Part 18—Removing certain references to New**
2 **Zealand**

3 *Patents Act 1990*

4 **326 Section 3 (list of definitions)**

5 Omit “New Zealand Assistant Commissioner of Patents”.

6 **327 Section 3 (list of definitions)**

7 Omit “New Zealand delegate”.

8 **328 Subsection 20(2)**

9 Omit “an employee, or a New Zealand delegate,”, substitute “or an
10 employee,”.

11 **329 Subsection 20(3)**

12 Repeal the subsection.

13 **330 Subsections 183(5) and (6)**

14 Repeal the subsections.

15 **331 Subsections 209(1A) and (1B)**

16 Repeal the subsections.

17 **332 Subsection 214(1)**

18 Omit “(1)”.

19 **333 Subsections 214(2) and (3)**

20 Repeal the subsections.

21 **334 Paragraph 223(1)(ba)**

22 Repeal the paragraph.

23 **335 Subsections 223(1A) and (1B)**

24 Repeal the subsections.

EXPOSURE DRAFT

Other measures **Schedule 2**
Removing certain references to New Zealand **Part 18**

1 **336 Subsection 224(3A)**

2 Repeal the subsection.

3 **337 Subsections 227(6) and (7)**

4 Repeal the subsections.

5 **338 Section 227AA**

6 Repeal the section.

7 **339 Schedule 1 (definitions of *New Zealand Assistant***
8 ***Commissioner of Patents* and *New Zealand delegate*)**

9 Repeal the definitions.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 19 International Convention for the Protection of New Varieties of Plants

1 **Part 19—International Convention for the Protection**
2 **of New Varieties of Plants**

3 ***Plant Breeder’s Rights Act 1994***

4 **340 Subsection 3(1)**

5 Insert:

6 ***1991 Act of the Convention*** means the Act of the International
7 Convention for the Protection of New Varieties of Plants, done at
8 Geneva on 19 March 1991, as that Act is in force for Australia
9 from time to time.

10 Note: The text of the 1991 Act of the Convention is set out in Australian
11 Treaty Series 2000 No. 6 ([2000] ATS 6). In 2017, the text of a
12 Convention in the Australian Treaty Series was accessible through the
13 Australian Treaties Library on the AustLII website
14 (www.austlii.edu.au).

15 ***Act of the Convention*** means:

- 16 (a) the Act of the International Convention for the Protection of
17 New Varieties of Plants, done at Geneva on 23 October 1978,
18 as that Act is in force for Australia from time to time; or
19 (b) the 1991 Act of the Convention; or
20 (c) any other Act of that Convention determined by the Minister
21 under subsection (1A), as that Act is in force for Australia
22 from time to time.

23 Note: The text of the Act mentioned in paragraph (a) is set out in Australian
24 Treaty Series 1989 No. 2 ([1989] ATS 2). In 2017, the text of a
25 Convention in the Australian Treaty Series was accessible through the
26 Australian Treaties Library on the AustLII website
27 (www.austlii.edu.au).

28 **341 Subsection 3(1) (definition of *Convention*)**

29 Repeal the definition.

30 **342 Subsection 3(1) (definition of *contracting party*)**

31 Omit “that is a party to the Convention”, substitute “in relation to which
32 Australia has obligations under an Act of the Convention”.

EXPOSURE DRAFT

Other measures **Schedule 2**
International Convention for the Protection of New Varieties of Plants **Part 19**

1 **343 Subsection 3(1) (definition of *PBR*, twice occurring)**

2 Repeal the definitions, substitute:

3 ***PBR*** means:

- 4 (a) in relation to a plant variety registered (or to be registered) in
5 Australia under this Act—the plant breeder’s right specified
6 in section 11; or
7 (b) in relation to a plant variety registered (or to be registered) in
8 another contracting party—a plant breeder’s right,
9 corresponding to the right specified in section 11, conferred
10 under the law of that contracting party; or
11 (c) in relation to a plant variety registered (or to be registered) in
12 a foreign country that is not a contracting party—a plant
13 breeder’s right corresponding to the right specified in
14 section 11 conferred under the law of that foreign country.

15 Note: The *Plant Breeder’s Rights Act 1994*, as in force before the commencement of this item,
16 contained 2 definitions of ***PBR***.

17 **344 Subsection 3(1) (definition of *Union*)**

18 Omit “Convention”, substitute “1991 Act of the Convention”.

19 **345 After subsection 3(1)**

20 Insert:

21 *Act of the Convention*

- 22 (1A) The Minister may, by legislative instrument, make a determination
23 for the purposes of paragraph (c) of the definition of ***Act of the***
24 ***Convention*** in subsection (1).

25 **346 Paragraph 10(a)**

26 Omit “the Convention” (first occurring), substitute “an Act of the
27 Convention”.

28 **347 Paragraph 10(a)**

29 Omit “the Convention” (second occurring), substitute “that Act”.

30 **348 Subsection 29(4)**

31 Omit “3 years”, substitute “5 years”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 19 International Convention for the Protection of New Varieties of Plants

1 **349 Paragraph 43(6)(b)**

2 Omit “in the territory of another contracting party”, substitute “outside
3 of Australia”.

4 **350 Subsection 43(8)**

5 After “contracting party”, insert “, or in a foreign country that is not a
6 contracting party”.

7 **351 Subsection 43(10) (definitions of *authority* and *territory*)**

8 Repeal the definitions.

9 **352 Subsection 43(10) (definition of *variety*)**

10 Omit “Convention”, substitute “1991 Act of the Convention”.

11 **353 Application provision**

12 The amendments made by this Part apply in relation to a grant of PBR
13 in a plant variety on or after the commencement of this item, whether
14 the application for that right is made before, on or after that
15 commencement.

EXPOSURE DRAFT

Other measures **Schedule 2**
Other amendments **Part 20**

1 **Part 20—Other amendments**

2 *Patents Act 1990*

3 **354 Subsection 222(2)**

4 Omit “, and of complete specifications which are open to public
5 inspection”.

6 *Plant Breeder’s Rights Act 1994*

7 **355 Section 42**

8 Repeal the section.

9 **356 Subsection 49(2)**

10 Omit “appropriate”, substitute “to be necessary in the public interest”.

11 **357 Subsection 69(1)**

12 Omit “, 22(3) or 42(1)”, substitute “or 22(3)”.

EXPOSURE DRAFT

Schedule 2 Other measures

Part 21 Repeals of Acts

1 **Part 21—Repeals of Acts**

2 *Patents Amendment (Patent Cooperation Treaty) Act 1979*

3 **358 The whole of the Act**

4 Repeal the Act.

112 *Intellectual Property Laws Amendment (Productivity Commission
Response Part 1 and Other Measures) Bill 2017* No. , 2017

EXPOSURE DRAFT