

# EXPOSURE DRAFT

2010-2011

The Parliament of the  
Commonwealth of Australia

HOUSE OF REPRESENTATIVES/THE SENATE

## EXPOSURE DRAFT

If you have any comments on this exposure draft, they should be sent by email to [MDB-Reform@ipaaustralia.gov.au](mailto:MDB-Reform@ipaaustralia.gov.au) or by mail to:

Terry Moore  
IP Australia  
PO Box 200  
WODEN ACT 2606  
Australia

The closing date for comments is 4 April 2011.

For further information, please contact Terry Moore on (02) 6283 2632.

## Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

No. , 2011

# EXPOSURE DRAFT

*(Innovation, Industry, Science and Research)*

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

# EXPOSURE DRAFT

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# EXPOSURE DRAFT

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

3     The Parliament of Australia enacts:

4     **1 Short title**

5                     This Act may be cited as the *Intellectual Property Laws*  
6                     *Amendment (Raising the Bar) Act 2011*.

7     **2 Commencement**

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

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**Commencement information**

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<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
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<b>Provision(s)</b>	<b>Commencement</b>	<b>Date/Details</b>
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1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table	The day this Act receives the Royal Assent.	
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2. Schedules 1 to 3	A single day to be fixed by Proclamation. However, if any of the provision(s) 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.	
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3. Schedules 4 and 5	The day after this Act receives the Royal Assent.	
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4. Schedule 6	At the same time as the provision(s) covered by table item 2.	
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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 Schedule(s)**

8 Each Act 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

Raising the quality of granted patents **Schedule 1**  
Amendments **Part 1**

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1  
2 **Schedule 1—Raising the quality of granted**  
3 **patents**

4 **Part 1—Amendments**

5 *Patents Act 1990*

6 **1 Section 3 (in the list of definitions)**

7 Insert “preliminary search and opinion”.

8 **2 Subsection 7(2)**

9 Omit “in the patent area”, substitute “(whether in or out of the patent  
10 area)”.

11 Note: The heading to section 7 is altered by omitting “**and inventive step**” and substituting “,  
12 **inventive step and innovative step**”.

13 **3 Subsection 7(3)**

14 Repeal the subsection, substitute:

15 (3) The information for the purposes of subsection (2) is:

16 (a) any single piece of prior art information; or

17 (b) a combination of any 2 or more pieces of prior art  
18 information that the skilled person mentioned in  
19 subsection (2) could, before the priority date of the relevant  
20 claim, be reasonably expected to have combined.

21 **4 Subsection 7(4)**

22 Omit “in the patent area”, substitute “(whether in or out of the patent  
23 area)”.

24 **5 Section 7 (note 2)**

25 Omit “subsection 98(1)”, substitute “section 98”.

26 **6 After section 7**

27 Insert:

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## Schedule 1 Raising the quality of granted patents

### Part 1 Amendments

---

1     **7A Meaning of useful**

2             (1) For the purposes of this Act, an invention is taken not to be useful  
3                 unless a specific, substantial and credible use for the invention (so  
4                 far as claimed) is disclosed in the complete specification.

5             (2) Subsection (1) does not otherwise affect the meaning of the word  
6                 *useful* in this Act.

7     **7 Subsection 40(1)**

8             Repeal the subsection, substitute:

9                     *Requirements relating to provisional specifications*

10            (1) A provisional specification must disclose the invention in a manner  
11               which is clear enough and complete enough for the invention to be  
12               performed by a person skilled in the relevant art.

13    **8 Paragraph 40(2)(a)**

14            Repeal the paragraph, substitute:

15               (a) disclose the invention in a manner which is clear enough and  
16                 complete enough for the invention to be performed by a  
17                 person skilled in the relevant art; and

18               (aa) disclose the best method known to the applicant of  
19                 performing the invention; and

20    **9 Subsection 40(3)**

21            Omit “fairly based on the matter described”, substitute “supported by  
22               matter disclosed”.

23    **10 Paragraph 43(2)(b)**

24            Repeal the paragraph, substitute:

25               (b) if prescribed circumstances apply in relation to the claim and  
26                 the claim is supported by the matter disclosed in a prescribed  
27                 document—the date determined under the regulations.

28    **11 Before Division 1 of Part 2 of Chapter 3**

29            Insert:



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Raising the quality of granted patents **Schedule 1**  
Amendments **Part 1**

---

1 **Division 1A—Preliminary search and opinion**

2 **43A Preliminary search and opinion**

- 3 (1) If a complete application for a standard patent has been made, the  
4 Commissioner may conduct a preliminary search and opinion in  
5 relation to the patent request and specification relating to the  
6 application.
- 7 (2) The preliminary search and opinion must be conducted in  
8 accordance with the regulations.

9 **12 Paragraphs 45(1)(b) and (c)**

10 Repeal the paragraphs, substitute:

- 11 (b) whether, to the best of his or her knowledge, the invention, so  
12 far as claimed, satisfies the criteria mentioned in paragraphs  
13 18(1)(a), (b) and (c); and
- 14 (c) whether the invention is a patentable invention under  
15 subsection 18(2); and

16 **13 Subsection 45(1A)**

17 Repeal the subsection.

18 **14 Subsection 49(1)**

19 Repeal the subsection, substitute:

- 20 (1) Subject to section 50, the Commissioner must accept a patent  
21 request and complete specification relating to an application for a  
22 standard patent if the Commissioner is reasonably satisfied:
- 23 (a) that the specification complies with section 40; and  
24 (b) that the invention, so far as claimed, satisfies the criteria  
25 mentioned in paragraphs 18(1)(a), (b) and (c); and  
26 (c) that the invention is a patentable invention under subsection  
27 18(2); and  
28 (d) as to the matters (if any) prescribed under paragraph  
29 45(1)(d).

30 **15 After subsection 60(3)**

31 Insert:

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## Schedule 1 Raising the quality of granted patents

### Part 1 Amendments

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1 (3A) If the Commissioner is reasonably satisfied that a ground of  
2 opposition to the grant of the standard patent exists, the  
3 Commissioner may refuse the application.

4 (3B) The Commissioner must not refuse an application under this  
5 section unless the Commissioner has, where appropriate, given the  
6 applicant a reasonable opportunity to amend the relevant  
7 specification for the purpose of removing any ground of opposition  
8 and the applicant has failed to do so.

#### 9 **16 After subsection 97(3)**

10 Insert:

11 (3A) The re-examination must be carried out in accordance with the  
12 regulations.

#### 13 **17 Section 98**

14 Repeal the section, substitute:

#### 15 **98 Report on re-examination**

16 On re-examining a complete specification, the Commissioner must  
17 ascertain and report on:

- 18 (a) whether the specification does not comply with subsection  
19 40(2) or (3); and  
20 (b) whether, to the best of his or her knowledge, the invention, so  
21 far as claimed, does not satisfy the criteria mentioned in  
22 paragraph 18(1)(a), (b) or (c); and  
23 (c) whether the invention is not a patentable invention under  
24 subsection 18(2).

#### 25 **18 Subsection 100A(1)**

26 Repeal the subsection, substitute:

- 27 (1) The Commissioner may refuse to grant a patent if the  
28 Commissioner:  
29 (a) makes an adverse report on a re-examination of the relevant  
30 specification under subsection 97(1); and  
31 (b) is reasonably satisfied that there is a lawful ground of  
32 objection to the specification.

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Raising the quality of granted patents **Schedule 1**  
Amendments **Part 1**

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## 19 Subsection 101(1)

Repeal the subsection, substitute:

- (1) The Commissioner may, by notice in writing, revoke a patent, either wholly or so far as it relates to a particular claim, if the Commissioner:
  - (a) makes an adverse report on a re-examination of the relevant specification under subsection 97(2); and
  - (b) is reasonably satisfied that there is a lawful ground of objection to the relevant specification.

## 20 Section 101B

Repeal the section, substitute:

### 101B Examination of an innovation patent

*What the Commissioner must do in examining a patent*

- (1) If the Commissioner decides, or is asked, to examine an innovation patent under section 101A, the Commissioner must:
  - (a) examine the complete specification relating to the patent to ascertain the matters set out in subsection (2); and
  - (b) report on those matters.

*Matters for examination and report*

- (2) The matters in this subsection are whether:
  - (a) the specification complies with section 40; and
  - (b) the invention, so far as claimed, complies with paragraphs 18(1A)(a), (b) and (c); and
  - (c) the invention is a patentable invention under subsections 18(2) and (3); and
  - (d) the use of the invention would not be contrary to law; and
  - (e) the patent does not claim as an invention a substance that is capable of being used as food or medicine (whether for human beings or animals and whether for internal or external use) and is a mere mixture of known ingredients; and
  - (f) the patent does not claim as an invention a process producing such a substance by mere admixture; and

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## Schedule 1 Raising the quality of granted patents

### Part 1 Amendments

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- 1 (g) the patent does not contain a claim that includes the name of  
2 a person as the name, or part of the name, of the invention so  
3 far as it is claimed in that claim; and  
4 (h) the patent does not claim an invention that is the same as an  
5 invention that is the subject of a patent and is made by the  
6 same inventor, where the relevant claim or claims in respect  
7 of each patent have the same priority date or dates; and  
8 (i) the complete specification complies with such other matters  
9 (if any) as are prescribed for the purpose of this paragraph.

## 10 **21 Section 101E**

11 Repeal the section, substitute:

### 12 **101E Certificate of examination**

- 13 (1) This section applies to an innovation patent if:  
14 (a) after examining the patent under section 101B, the  
15 Commissioner decides in writing that he or she is reasonably  
16 satisfied as to the following:  
17 (i) the specification complies with section 40;  
18 (ii) the invention, so far as claimed, complies with  
19 paragraphs 18(1A)(a), (b) and (c);  
20 (iii) the invention is a patentable invention under subsections  
21 18(2) and (3);  
22 (iv) the use of the invention would not be contrary to law;  
23 (v) the patent does not claim as an invention a substance  
24 that is capable of being used as food or medicine  
25 (whether for human beings or animals and whether for  
26 internal or external use) and is a mere mixture of known  
27 ingredients;  
28 (vi) the patent does not claim as an invention a process  
29 producing such a substance by mere admixture;  
30 (vii) the patent does not contain a claim that includes the  
31 name of a person as the name, or part of the name, of  
32 the invention so far as it is claimed in that claim;  
33 (viii) the patent does not claim an invention that is the same  
34 as an invention that is the subject of a patent and is  
35 made by the same inventor, where the relevant claim or  
36 claims in respect of each patent have the same priority  
37 date or dates;

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Raising the quality of granted patents **Schedule 1**  
**Amendments Part 1**

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- 1 (ix) the complete specification complies with such other  
2 matters (if any) as are prescribed for the purpose of  
3 paragraph 101B(2)(i);  
4 (b) the patent has not ceased under section 143A.
- 5 (2) If this section applies, the Commissioner must:  
6 (a) notify the patentee and the person who requested the  
7 examination (if that person is not the patentee) that the patent  
8 has been examined and that a certificate of examination is to  
9 be issued; and  
10 (b) publish a notice of the examination having occurred in the  
11 *Official Journal*; and  
12 (c) issue a certificate of examination to the patentee in the  
13 approved form; and  
14 (d) register the issue of the certificate.
- 15 (3) A decision under subsection (1) is not a legislative instrument.

## 22 Subsection 101F(1)

16 Repeal the subsection, substitute:  
17

- 18 (1) The Commissioner must revoke a patent if:  
19 (a) the patent has been examined under section 101B; and  
20 (b) section 101E does not apply to the patent; and  
21 (c) the patent has not ceased under section 143A.

## 23 After subsection 101G(1)

22 Insert:  
23

- 24 (1A) The re-examination must be carried out in accordance with the  
25 regulations.

## 24 Subsection 101G(3)

26 Repeal the subsection, substitute:  
27

- 28 (3) The grounds for the revocation of the patent under subsection (2)  
29 are as follows:  
30 (a) that the specification filed in respect of the complete  
31 application does not comply with subsection 40(2) or (3);  
32 (b) that the invention, so far as claimed, does not comply with  
33 paragraph 18(1A)(a), (b) or (c);

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## Schedule 1 Raising the quality of granted patents

### Part 1 Amendments

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1 (c) that the invention is not a patentable invention under  
2 subsection 18(2) or (3).

#### 3 **25 Subsection 101G(5)**

4 Repeal the subsection.

#### 5 **26 Subsection 101J(1)**

6 Repeal the subsection, substitute:

7 (1) The Commissioner may, by notice in writing, revoke a patent,  
8 either wholly or so far as it relates to a particular claim, if the  
9 Commissioner:

10 (a) makes an adverse report on a re-examination of the relevant  
11 specification under section 101G; and

12 (b) is reasonably satisfied that there is a ground of revocation of  
13 the patent.

#### 14 **27 Section 101M**

15 Repeal the section, substitute:

#### 16 **101M Opposition to innovation patent**

17 The Minister, or any other person, may, in accordance with the  
18 regulations, oppose an innovation patent that has been certified and  
19 seek the revocation of it, on one or more of the following grounds  
20 of invalidity, but on no other:

21 (a) that the patentee is either:

22 (i) not entitled to the patent; or

23 (ii) entitled to the patent but only in conjunction with some  
24 other person;

25 (b) that the complete specification does not comply with  
26 subsection 40(2) or (3);

27 (c) that the invention is not a patentable invention because it  
28 does not comply with paragraph 18(1A)(a), (b) or (c);

29 (d) that the invention is not a patentable invention under  
30 subsection 18(2) or (3).

#### 31 **28 Subsection 101N(4)**

32 Before “satisfied”, insert “reasonably”.

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Raising the quality of granted patents **Schedule 1**  
Amendments **Part 1**

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## 29 Subsection 102(1)

Repeal the subsection, substitute:

*Amendment of complete specification not allowable if amended  
specification claims or discloses matter extending beyond that  
disclosed in the specification as filed*

(1) An amendment of a complete specification is not allowable if, as a result of the amendment, the specification would claim or disclose matter that extends beyond that disclosed in the specification as filed.

(1A) For the purposes of subsection (1), a reference to a complete specification includes a reference to any description, claims, drawings and other prescribed documents included in the complete application at its filing date.

## 30 Paragraph 102(2A)(b)

Omit “decisions under paragraphs 101E(a) and (aa)”, substitute “a decision under paragraph 101E(1)(a)”.

## 31 Before subsection 102(3)

Insert:

*Amendments of a kind prescribed by regulations not allowable*

(2D) An amendment of a patent request or a complete specification is not allowable if it is of a kind prescribed by regulations made for the purposes of this section.

## 32 Subsection 102(3)

Repeal the subsection, substitute:

*Section does not apply in certain cases*

(3) This section does not apply to an amendment for the purposes of:  
(a) correcting a clerical error or an obvious mistake made in, or in relation to, a complete specification; or  
(b) complying with paragraph 6(c) (about deposit requirements).

## 33 Section 114

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## Schedule 1 Raising the quality of granted patents

### Part 1 Amendments

---

1 Repeal the section, substitute:

#### 2 **114 Priority date of claims of certain amended specifications**

3 (1) This section applies if:

- 4 (a) a complete specification has been amended; and  
5 (b) the amendments were not allowable under subsection 102(1);  
6 and  
7 (c) as a result of the amendment, a claim of the amended  
8 specification claims matter that:  
9 (i) was not supported by the complete specification as  
10 filed; but  
11 (ii) is supported by the amended specification.

12 (2) If this section applies, the priority date of the claim must be  
13 determined under the regulations.

#### 14 **34 Paragraph 114A(1)(b)**

15 Repeal the paragraph, substitute:

- 16 (b) the amendment was not allowable under subsection 102(1);  
17 and  
18 (ba) as a result of the amendment, a claim of the amended  
19 specification claims matter that was not supported by the  
20 original specification as filed; and

21 Note: The heading to section 114A is altered by omitting “**claims**” and substituting  
22 “**specifications**”.

#### 23 **35 Paragraph 143A(c)**

24 Omit “decisions under paragraphs 101E(a) and (aa)”, substitute “a  
25 decision under paragraph 101E(1)(a)”.

#### 26 **36 Before paragraph 228(2)(a)**

27 Insert:

- 28 (aa) making provision for and in relation to:  
29 (i) the procedures for conducting a preliminary search and  
30 opinion in relation to a patent request and complete  
31 specification; and  
32 (ii) the reports to be made in relation to the preliminary  
33 search and opinion; and



# EXPOSURE DRAFT

Raising the quality of granted patents **Schedule 1**  
Amendments **Part 1**

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1 **37 Schedule 1**

2 Insert:

3 *preliminary search and opinion*, in relation to a patent request and  
4 complete specification relating to an application for a standard  
5 patent, means search and opinion under section 43A.

6 **38 Schedule 1 (definition of *certified*)**

7 Omit “101E(e)”, substitute “101E(2)(c)”.

# EXPOSURE DRAFT

Schedule 1 Raising the quality of granted patents

Part 2 Application, savings and transitional provisions

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1

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## Part 2—Application, savings and transitional provisions

3

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### 39 Application of amendments

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*Amendments applying in relation to certain patents and patent applications*

6

7

(1) The amendments made by items 2, 3, 4, 6, 8, 9, 10, 29, 31, 32, 33 and 34 of this Schedule apply in relation to:

8

9

(a) patents for which the complete application is made on or after the day on which this Schedule commences; and

10

11

(b) standard patents for which the application is made before the day on which this Schedule commences, if the Commissioner has not reported under section 45 of the *Patents Act 1990* on the patent request and complete specification to which the application relates before that day; and

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16

(c) innovation patents granted on or after the day this Schedule commences, if the complete application to which the patent relates is made before that day; and

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19

(d) complete patent applications made on or after the day this Schedule commences; and

20

21

(e) complete applications for standard patents made before the day this Schedule commences, if the Commissioner has not reported under section 45 of the *Patents Act 1990* on the patent request and complete specification to which the application relates on or before that day; and

22

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24

25

(f) complete applications for innovation patents made before the day this Schedule commences, if a patent has not been granted in relation to the application on or before that day; and

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(g) innovation patents granted before the day this Schedule commences, if the Commissioner has not reported under section 101B of the *Patents Act 1990* on the complete specification to which the innovation patent relates on or before that day.

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# EXPOSURE DRAFT

Raising the quality of granted patents **Schedule 1**  
Application, savings and transitional provisions **Part 2**

---

1                    *Amendments applying in relation to provisional applications*

- 2            (2)        The amendment made by item 7 of this Schedule applies in relation to  
3                    provisional applications made on or after the day this Schedule  
4                    commences.

5                    *Amendments applying only in relation to standard patent*  
6                    *applications made after commencement*

- 7            (3)        The amendments made by items 11 and 37 of this Schedule apply in  
8                    relation to complete applications for standard patents made on or after  
9                    the day this Schedule commences.

10                   *Amendments applying only in relation to certain standard patent*  
11                   *applications*

- 12           (4)        The amendments made by items 12, 13, 14, 15 and 18 of this Schedule  
13                   apply in relation to:  
14                        (a) complete applications for standard patents made on or after  
15                                the day this Schedule commences; and  
16                        (b) complete applications for standard patents made before the  
17                                day this Schedule commences, if the Commissioner has not  
18                                reported under section 45 of the *Patents Act 1990* on the  
19                                patent request and complete specification to which the  
20                                application relates on or before that day.

21                   *Amendments applying to all standard patents and standard*  
22                   *patent applications*

- 23           (5)        The amendments made by items 16 and 17 of this Schedule apply in  
24                   relation to:  
25                        (a) applications for standard patents, whether the application was  
26                                made before, on or after the day on which this Schedule  
27                                commences; and  
28                        (b) standard patents, whether granted before, on or after that day.

29                   *Amendments applying only in relation to certain standard patents*

- 30           (6)        The amendment made by item 19 of this Schedule applies in relation to:  
31                        (a) standard patents for which the complete application is made  
32                                on or after the day this Schedule commences; and  
33                        (b) standard patents for which the complete applications is made  
34                                before the day this Schedule commences, if the

# EXPOSURE DRAFT

**Schedule 1** Raising the quality of granted patents

**Part 2** Application, savings and transitional provisions

---

1 Commissioner has not reported under section 45 of the  
2 *Patents Act 1990* on the patent request and complete  
3 specification to which the application relates on or before that  
4 day.

5 *Amendments applying to all innovation patents*

6 (7) The amendments made by items 23, 24 and 25 of this Schedule apply in  
7 relation to innovation patents, whether granted before, on or after the  
8 day on which this Schedule commences.

9 *Amendments applying only in relation to innovation patents and*  
10 *innovation patent applications*

11 (8) The amendments made by items 20, 21, 22, 26, 27 and 28 of this  
12 Schedule apply in relation to:  
13 (a) complete applications for innovation patents made on or after  
14 the day this Schedule commences; and  
15 (b) complete applications for innovation patents made before the  
16 day this Schedule commences, if a patent has not been  
17 granted in relation to the application on or before that day;  
18 and  
19 (c) innovation patents granted before the day this Schedule  
20 commences, if the Commissioner has not reported under  
21 section 101B of the *Patents Act 1990* on the complete  
22 specification to which the innovation patent relates on or  
23 before that day; and  
24 (d) innovation patents granted on complete applications for  
25 innovation patents made on or after the day this Schedule  
26 commences; and  
27 (e) innovation patents granted on or after the day this Schedule  
28 commences, if the complete application to which the patent  
29 relates is made before that day.

30 **40 Transitional provision—approved form**

31 (1) This item applies to an approval of a form given by the Commissioner  
32 under paragraph 101E(e) of the *Patents Act 1990* that was in force  
33 immediately before the commencement of this Schedule.  
34 (2) The approval has effect, after the commencement of this Schedule, as if  
35 it had been given under paragraph 101E(2)(c) as inserted by this  
36 Schedule.

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# EXPOSURE DRAFT

1  
2 **Schedule 2—Free access to patented**  
3 **inventions for regulatory approvals**  
4 **and research**

5 **Part 1—Amendment**

6 *Patents Act 1990*

7 **1 After section 119A**

8 Insert:

9 **119B Infringement exemptions: acts for obtaining regulatory**  
10 **approval (non-pharmaceuticals)**

- 11 (1) A person may, without infringing a patent, do an act that would  
12 infringe the patent apart from this subsection, if the act is done  
13 solely for:
- 14 (a) purposes connected with obtaining an approval required by a  
15 law of the Commonwealth or of a State or Territory to exploit  
16 a product, method or process; or
  - 17 (b) purposes connected with obtaining a similar approval under a  
18 law of another country or region.
- 19 (2) This section does not apply in relation to a pharmaceutical patent  
20 within the meaning of subsection 119A(3).

21 **119C Infringement exemptions: acts for experimental purposes**

- 22 (1) A person may, without infringing a patent for an invention, do an  
23 act that would infringe the patent apart from this subsection, if the  
24 act is done for experimental purposes relating to the subject matter  
25 of the invention.
- 26 (2) For the purposes of this section, *experimental purposes* relating to  
27 the subject matter of the invention include, but are not limited to,  
28 the following:
- 29 (a) determining the properties of the invention;
  - 30 (b) determining the scope of a claim relating to the invention;

# EXPOSURE DRAFT

**Schedule 2** Free access to patented inventions for regulatory approvals and research  
**Part 1** Amendment

---

- 1 (c) improving or modifying the invention;
- 2 (d) determining the validity of the patent or of a claim relating to
- 3 the invention;
- 4 (e) determining whether the patent for the invention has been
- 5 infringed.

# EXPOSURE DRAFT

Free access to patented inventions for regulatory approvals and research **Schedule 2**  
Application of amendment **Part 2**

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1

2

## **Part 2—Application of amendment**

3

### **2 Application**

4

The amendment made by item 1 of this Schedule applies in relation to

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acts done on or after the commencement of this Schedule in relation to

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patents granted before, on or after that commencement.

# EXPOSURE DRAFT

## Schedule 3 Reducing delays in resolution of patent and trade mark applications Part 1 Amendments

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1  
2 **Schedule 3—Reducing delays in resolution of**  
3 **patent and trade mark applications**

4 **Part 1—Amendments**

5 *Patents Act 1990*

6 **1 Subsection 26(2)**

7 After “112”, insert “or 112A”.

8 **2 Subsection 61(1)**

9 After “100A”, insert “and paragraph 210A(2)(a)”.

10 **3 Section 79B**

11 Repeal the section, substitute:

12 **79B Divisional applications prior to grant of patent**

13 (1) If:

14 (a) a complete application (the *first application*) for a patent is  
15 made; and

16 (b) the first application is not a divisional application for an  
17 innovation patent provided for in section 79C;

18 the applicant may make a further complete application for a patent  
19 for an invention disclosed in the specification filed in relation to  
20 the first application.

21 (2) The further complete application:

22 (a) must be made in accordance with the regulations made for  
23 the purposes of this subsection; and

24 (b) must include the prescribed particulars.

25 (3) The further complete application can only be made during the  
26 period:

27 (a) starting on the day the first application is made; and

28 (b) ending when any of the following happens:

29 (i) the first application lapses;

30 (ii) the first application is refused;



# EXPOSURE DRAFT

Reducing delays in resolution of patent and trade mark applications **Schedule 3**  
Amendments **Part 1**

---

- 1 (iii) the first application is withdrawn;  
2 (iv) a period prescribed by the regulations for the purposes  
3 of this subparagraph ends.

4 (4) In this section:

5 *applicant* has the same meaning as in section 38.

## 6 **4 Subsection 79C(1)**

7 Omit “, in accordance with the regulations, ”.

## 8 **5 After subsection 79C(1)**

9 Insert:

10 (1A) The further complete application:

- 11 (a) must be made in accordance with the regulations made for  
12 the purposes of this subsection; and  
13 (b) include the prescribed particulars.

## 14 **6 After subsection 105(1)**

15 Insert:

16 *Order for amendment during an appeal*

17 (1A) If an appeal is made to the Federal Court against a decision or  
18 direction of the Commissioner in relation to a patent application,  
19 the Federal Court may, on the application of the applicant for the  
20 patent, by order direct the amendment of the patent request or the  
21 complete specification in the manner specified in the order.

22 Note: The following heading to subsection 105(1) is inserted “*Order for amendment during*  
23 *relevant proceedings*”.

## 24 **7 Subsection 105(2)**

25 After “order”, insert “under subsection (1) or (1A)”.

26 Note: The following heading to subsection 105(2) is inserted “*Orders for amendment*  
27 *generally*”.

## 28 **8 Subsection 105(3)**

29 Omit “patentee”, substitute “applicant for an order under subsection (1)  
30 or (1A)”.

# EXPOSURE DRAFT

## Schedule 3 Reducing delays in resolution of patent and trade mark applications Part 1 Amendments

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1 **9 Subsection 105(5)**

2 Omit “patentee”, substitute “applicant”.

3 **10 After section 112**

4 Insert:

5 **112A Decisions on appeal**

6 A complete specification relating to a patent application must not  
7 be amended, except under section 105, if:

- 8 (a) an appeal against a decision or direction of the Commissioner  
9 has been made to the Federal Court in relation to the  
10 specification; and  
11 (b) the appeal, and any proceedings resulting from it, have not  
12 been finally determined, withdrawn or otherwise disposed of.

13 **11 Subsection 141(1)**

14 Repeal the subsection, substitute:

- 15 (1) A patent application may be withdrawn:  
16 (a) if subsection (1A) applies to the application—only with the  
17 consent of the Commissioner; and  
18 (b) otherwise—at any time, except during a period prescribed for  
19 the purposes of this section.  
20 (1A) This subsection applies to an application if the grant of a standard  
21 patent in relation to the application has been opposed under  
22 section 59.

23 **12 Sections 179 to 181**

24 Repeal the sections.

25 **13 Section 210**

26 Before “The”, insert “(1)”.

27 **14 At the end of section 210**

28 Add:

# EXPOSURE DRAFT

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## *Exercise of powers generally*

- (2) The Commissioner must not make a requirement of a person in the exercise of a power under subsection (1) unless:
- (a) the person has a substantial interest in the proceedings before the Commissioner; and
  - (b) the Commissioner notifies the person of the actions the Commissioner may take under section 210A if a person fails or refuses to comply with a requirement.
- (3) The Commissioner may make a requirement of a person in the exercise of his or her powers under subsection (1) whether the person is in or out of the patent area.
- (4) The Commissioner's powers in subsection (1) to make a requirement of a person extend, if the person is a body corporate, to making that requirement of any person who is an officer, agent or employee of the body corporate.

## *Exercise of power to summon witnesses*

- (5) The Commissioner must not summon a witness under paragraph (1)(b) unless the Commissioner is satisfied that:
- (a) the witness can provide oral evidence that relates to a matter before the Commissioner; and
  - (b) the evidence is likely to be of substantial relevance to that matter; and
  - (c) receiving oral evidence from the witness is necessary or desirable in all the circumstances.

## *Exercise of power to require production of document or article*

- (6) The Commissioner must not require the production of a document or an article under paragraph (1)(c) unless the Commissioner is satisfied that:
- (a) the document or article relates to a matter before the Commissioner; and
  - (b) the document or article is likely to be of substantial relevance to that matter.

Note: The following heading to subsection 210(1) is inserted "*Commissioner's powers*".

## **15 After section 210**

# EXPOSURE DRAFT

## Schedule 3 Reducing delays in resolution of patent and trade mark applications Part 1 Amendments

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1                   Insert:

2                   **210A Sanctions for non-compliance with Commissioner’s**  
3                   **requirements**

- 4                   (1) The Commissioner may take one or more of the actions listed in  
5                   subsection (2) in relation to a person if:  
6                   (a) the Commissioner makes a requirement of the person under  
7                   subsection 210(1); and  
8                   (b) the person refuses or fails to comply with the requirement;  
9                   and  
10                  (c) the Commissioner is satisfied that it is appropriate in the  
11                  circumstances to take the action.
- 12                  (2) The actions the Commissioner may take are:  
13                  (a) if the person is an applicant for a patent—a refusal to grant  
14                  the patent (see subsection 61(1); and  
15                  (b) the drawing of an inference unfavourable to the person’s  
16                  interest in proceedings before the Commissioner; and  
17                  (c) actions of a kind that are prescribed by the regulations.
- 18                  (3) In deciding whether it is appropriate to take the action, the  
19                  Commissioner must consider the following:  
20                  (a) whether the person has a reasonable excuse for refusing or  
21                  failing to comply with the requirement;  
22                  (b) whether the person has been offered payment of reasonable  
23                  expenses associated with complying with the requirement;  
24                  (c) any other matter the Commissioner considers to be relevant.

25                  **16 Subsection 224(1)**

26                   Before “142(2)(b)”, insert “141(1)(a) or ”.

27                  ***Trade Marks Act 1995***

28                  **17 Paragraph 11(1)(a)**

29                   Omit “section 37”, substitute “sections 37 and 54A”.

30                  **18 Subsections 52(2) and (3)**

31                   Repeal the subsections, substitute:

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# EXPOSURE DRAFT

Reducing delays in resolution of patent and trade mark applications **Schedule 3**  
Amendments **Part 1**

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- 1 (2) The notice of opposition must be filed:  
2 (a) in the manner and form prescribed by the regulations; and  
3 (b) within the prescribed period, or within that period as  
4 extended in accordance with the regulations or in accordance  
5 with subsection (5).
- 6 (3) Regulations made for the purposes of paragraph (2)(a) or (b) may  
7 make different provision with respect to different components (if  
8 any) of the notice of opposition.
- 9 (3A) Subsection (3) does not limit subsection 33(3A) of the *Acts*  
10 *Interpretation Act 1901*.

11 Note: The heading to section 37 is altered by adding at the end “**if not accepted in time**”.

## 12 **19 After section 52**

13 Insert:

### 14 **52A Notice of intention to defend opposition to registration**

- 15 (1) If a notice of opposition is filed in accordance with section 52, the  
16 applicant may file a notice of intention to defend the application  
17 for registration of a trade mark.

18 Note: Failure to file a notice of intention will result in the application  
19 lapsing: see section 54A.

- 20 (2) The notice must be filed in the prescribed manner and within the  
21 prescribed period, or within that period as extended by the  
22 Registrar in accordance with the regulations.

## 23 **20 At the end of section 54**

24 Add:

- 25 (3) Without limiting subsection (2), the regulations may prescribe the  
26 circumstances in which the Registrar may dismiss the opposition.

## 27 **21 After section 54**

28 Insert:

### 29 **54A Lapsing of opposed application if no notice to defend the** 30 **application filed**

- 31 (1) Subject to subsection (2), an application lapses if:
-

# EXPOSURE DRAFT

## Schedule 3 Reducing delays in resolution of patent and trade mark applications Part 1 Amendments

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- 1 (a) a notice of opposition to the registration of the trade mark is  
2 filed (see subsection 52(1)); and  
3 (b) the applicant does not file an intention to defend the  
4 application for registration of the trade mark in the prescribed  
5 manner or within the prescribed period, or that period as  
6 extended (see section 52A).
- 7 (2) If, after the prescribed period has expired, the Registrar extends the  
8 period within which the notice to defend the application may be  
9 filed (see section 52A), the application:  
10 (a) is taken not to have lapsed when the prescribed period  
11 expired; and  
12 (b) lapses if the notice to defend the application is not filed  
13 within the extended period.

### 22 Subsection 55(1)

14 Omit “Unless the proceedings are discontinued or dismissed”, substitute  
15 “Unless subsection (3) applies to the proceedings”.  
16

### 23 At the end of section 55

17 Add:  
18

- 19 (3) This subsection applies to the proceedings if:  
20 (a) the proceedings are discontinued; or  
21 (b) the proceedings are dismissed; or  
22 (c) the application lapses because of the operation of section 54A  
23 (about lapsing of applications if a notice to defend the  
24 application is not filed).

### 24 Section 66

25 Before “The”, insert “(1)”.  
26

### 25 At the end of section 66

27 Add:  
28

- 29 (2) Subsection (1) does not apply to a notice of opposition filed by an  
30 opponent in relation to:  
31 (a) an opposition to the registration of a trade mark under  
32 section 52; or  
33 (b) an opposition to an application under section 92.

# EXPOSURE DRAFT

Reducing delays in resolution of patent and trade mark applications **Schedule 3**  
Amendments **Part 1**

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1 Note: Regulations made for the purposes of subsection 231(3) may make  
2 provision in relation to amendment of notices of opposition.

## 3 **26 Subparagraph 68(1)(b)(iii)**

4 After “section 222”, insert “or the regulations (if any) made for the  
5 purposes of subsection 54(2)”.

## 6 **27 At the end of subsection 68(1)**

7 Add:

8 Note: Applications may also lapse if an application for registration is  
9 opposed and a notice to defend the application is not filed: see  
10 section 54A.

## 11 **28 Subsection 97(1)**

12 Repeal the subsection, substitute:

13 (1) If:

14 (a) there is no opposition to an application to the Registrar under  
15 subsection 92(1); or

16 (b) an opposition to an application under that subsection has  
17 been dismissed (see section 99A);

18 the Registrar must remove the trade mark from the Register in  
19 respect of the goods and/or services specified in the application.

20 Note: The heading to section 97 is altered by adding at the end “etc.”.

## 21 **29 After section 99**

22 Insert:

### 23 **99A Dismissal of opposition**

24 (1) The Registrar may, in prescribed circumstances, dismiss a notice of  
25 opposition filed with the Registrar in accordance with section 96.

26 (2) An application may be made to the Administrative Appeals  
27 Tribunal for the review of a decision of the Registrar to dismiss a  
28 notice of opposition under subsection (1).

## 29 **30 At the end of section 231**

30 Add:

# EXPOSURE DRAFT

## Schedule 3 Reducing delays in resolution of patent and trade mark applications Part 1 Amendments

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- 1                   (3) Without limiting subsection (1), the regulations may prescribe  
2                   matters relating to oppositions under sections 52 and 92, including  
3                   the following:
- 4                   (a) rules about filing and serving documents in relation to an  
5                   opposition;
  - 6                   (b) rules about the amendment of documents filed in relation to  
7                   an opposition;
  - 8                   (c) the circumstances in which the Registrar may dismiss an  
9                   opposition;
  - 10                  (d) provision for review by the Administrative Appeals Tribunal  
11                  of decisions of the Registrar made under the regulations.



# EXPOSURE DRAFT

Reducing delays in resolution of patent and trade mark applications **Schedule 3**  
Application and transitional provisions **Part 2**

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## Part 2—Application and transitional provisions

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### 31 Application of amendments

4

(1) The amendments made by items 1 and 10 of this Schedule apply in relation to:

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6

(a) requests for amendments made on and after the day this Schedule commences; and

7

8

(b) requests for amendments made before that day, if the Commissioner had not dealt with the request on or before that day.

9

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11

(2) The amendments made by items 2, 13, 14 and 15 of this Schedule apply in relation to powers exercised by the Commissioner under section 210 of the *Patents Act 1990* (as amended by this Schedule) on or after the day this Schedule commences.

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(3) The amendment made by item 3 of this Schedule applies in relation to divisional applications provided for in section 79B of the *Patents Act 1990* made on or after the day this Schedule commences.

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(4) The amendments made by items 4 and 5 of this Schedule apply in relation to divisional applications provided for in section 79C of the *Patents Act 1990* made on or after the day this Schedule commences.

19

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(5) The amendments made by items 6, 7, 8 and 9 of this Schedule apply in relation to appeals to the Federal Court:

22

23

(a) made on or after the day this Schedule commences; and

24

(b) made before that day, if the appeal had not been finally determined, withdrawn or otherwise disposed of.

25

26

(6) The amendments made by items 11 and 16 of this Schedule apply in relation to notices of withdrawal filed on or after the day this Schedule commences in respect of patent applications made before, on or after that day.

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(7) The amendments made by items 17 to 30 of this Schedule apply in relation to opposition proceedings commenced by notices of opposition filed on or after the day this Schedule commences.

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### 32 Transitional provision—regulations

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# EXPOSURE DRAFT

**Schedule 3** Reducing delays in resolution of patent and trade mark applications

**Part 2** Application and transitional provisions

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1           Despite the amendment made by item 11 of this Schedule, regulations  
2           in force for the purposes of section 141 of the *Patents Act 1990*  
3           immediately before the commencement of this Schedule continue in  
4           effect, after that commencement, as if they had been made for the  
5           purposes of that section, as in force after that commencement.

# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

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## **Schedule 4—Assisting the operations of the IP profession**

### ***Patents Act 1990***

#### **1 Section 3 (list of definitions)**

Insert “company”.

#### **2 Section 3 (list of definitions)**

Insert “director”.

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

Insert “incorporated legal practice”.

#### **4 Section 3 (list of definitions)**

Insert “incorporated patent attorney”.

#### **5 Section 3 (list of definitions)**

Insert “intellectual property advice”.

#### **6 Section 3 (list of definitions)**

Insert “patent attorney director”.

#### **7 Section 3 (list of definitions)**

Insert “patents work”.

#### **8 Section 3 (list of definitions)**

Insert “related company group”.

#### **9 Section 132**

Omit “his or her”, substitute “a”.

#### **10 Subsection 177(1) (penalty)**

Repeal the penalty, substitute:

Penalty: 30 penalty units.

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

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1 **11 Subsection 178(1) (penalty)**

2 Repeal the penalty, substitute:

3 Penalty: 60 penalty units.

4 **12 Subsection 181(1) (penalty)**

5 Repeal the penalty, substitute:

6 Penalty: 30 penalty units.

7 **13 Subsection 182(1) (penalty)**

8 Repeal the penalty, substitute:

9 Penalty: 60 penalty units.

10 **14 Section 183**

11 Before “The”, insert “(1)”.

12 **15 At the end of section 183**

13 Add:

14 (2) The Designated Manager may disclose to the Australian Securities  
15 and Investments Commission information (including personal  
16 information within the meaning of the *Privacy Act 1988*) that is:

17 (a) relevant to the functions of the Commission; and

18 (b) obtained by the Designated Manager as a result of the  
19 performance of functions and duties, or the exercise of  
20 powers, in relation to incorporated patent attorneys.

21 **16 Subsection 198(4)**

22 Omit “a person”, substitute “an individual”.

23 Note: The following heading to subsection 198(4) is inserted “*Registration of individuals*”.

24 **17 After paragraph 198(4)(f)**

25 Insert:

26 ; and (g) meets any other requirements prescribed by the regulations.

27 **18 Subsection 198(4)**

28 Omit “person’s”, substitute “individual’s”.

# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

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1 **19 Subsection 198(7)**

2 Omit “a person”, substitute “an individual”.

3 **20 Subsection 198(7)**

4 Omit “the person” (wherever occurring), substitute “the individual”.

5 **21 At the end of section 198**

6 Add:

7 *Registration of companies*

8 (9) The Designated Manager must register as a patent attorney a  
9 company that:

10 (a) has at least one patent attorney director; and

11 (b) has given the Designated Manager written notice in the  
12 approved form of its intention to act as a patent attorney; and

13 (c) meets the requirements (if any) prescribed by the regulations.

14 The registration is to consist of entering the company’s name in the  
15 Register of Patent Attorneys.

16 (10) A company registered as a patent attorney is an *incorporated*  
17 *patent attorney*.

18 (11) A *patent attorney director* of a company is an individual who is  
19 both:

20 (a) a registered patent attorney; and

21 (b) a validly appointed director of the company.

22 **22 Subsection 200(2)**

23 Repeal the subsection, substitute:

24 (2) A communication between a registered patent attorney and another  
25 person made for the sole or dominant purpose of a registered patent  
26 attorney providing intellectual property advice to a client is  
27 privileged in the same way as a communication between a lawyer  
28 and another person made for the sole or dominant purpose of the  
29 lawyer providing legal advice to a client.

30 (2A) A record or document made for the sole or dominant purpose of a  
31 registered patent attorney providing intellectual property advice to  
32 a client is privileged in the same way as a record or document

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

---

1 made for the sole or dominant purpose of a lawyer providing legal  
2 advice to a client.

3 (2B) A reference in subsection (2) or (2A) to a registered patent attorney  
4 includes a reference to an individual authorised to do patents work  
5 under a law of another country or region.

6 (2C) *Intellectual property advice* means advice in relation to:

- 7 (a) patents; or
- 8 (b) trade marks; or
- 9 (c) designs; or
- 10 (d) plant breeder's rights; or
- 11 (e) any related matters.

### 12 **23 Subsection 200(4)**

13 Repeal the subsection.

### 14 **24 Section 201**

15 Repeal the section, substitute:

### 16 **201 Acting or holding out without being registered**

#### 17 *Individuals*

18 (1) An individual commits an offence if:

- 19 (a) the individual carries on business, practises or acts as a patent  
20 attorney; and
- 21 (b) the individual is not a registered patent attorney or a legal  
22 practitioner.

23 Penalty: 30 penalty units.

24 (2) An individual commits an offence if:

- 25 (a) the individual describes himself or herself, or holds himself  
26 or herself out, or permits himself or herself to be described or  
27 held out, as a patent attorney or agent for obtaining patents;  
28 and
- 29 (b) the individual is not a registered patent attorney.

30 Penalty: 30 penalty units.

# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

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1

## *Partnerships*

2

(3) A member of a partnership commits an offence if:

3

(a) the member carries on business, practises or acts as a patent attorney; and

4

5

(b) none of the members of the partnership is a registered patent attorney or a legal practitioner.

6

7

Penalty: 30 penalty units.

8

(4) A member of a partnership commits an offence if:

9

(a) the member describes the partnership, or holds the partnership out, or permits the partnership to be described or held out, as a patent attorney, or agent for obtaining patents; and

10

11

12

13

(b) none of the members of the partnership is a registered patent attorney.

14

15

Penalty: 30 penalty units.

16

## *Companies*

17

(5) A company commits an offence if:

18

(a) the company carries on business, practises or acts as a patent attorney; and

19

20

(b) the company is not a registered patent attorney or incorporated legal practice.

21

22

Penalty: 150 penalty units.

23

(6) A company commits an offence if:

24

(a) the company describes itself, or holds itself out, or permits itself to be described or held out, as a patent attorney, or agent for obtaining patents; and

25

26

27

(b) the company is not a registered patent attorney.

28

Penalty: 150 penalty units.

29

## *Exception—legal representatives*

30

(7) Subsections (1), (3) and (5) do not apply in relation to the business of a registered patent attorney who is deceased if the business:

31

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

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- 1 (a) is carried on, within 3 years of the death of the patent  
2 attorney, or such further time allowed by a prescribed court,  
3 by the legal representative of the deceased registered patent  
4 attorney; and  
5 (b) is managed by a registered patent attorney on behalf of the  
6 legal representative.

7 Note: The defendant bears an evidential burden in relation to the matters in  
8 subsection (7). See subsection 13.3(3) of the *Criminal Code*.

### 9 *Exception—employees*

- 10 (8) Subsections (1) and (2) do not apply in relation to anything done  
11 by a person, as an employee, for:  
12 (a) his or her employer; or  
13 (b) if the person's employer is a member of a related company  
14 group—another member of the group.

15 Note: The defendant bears an evidential burden in relation to the matters in  
16 subsection (8). See subsection 13.3(3) of the *Criminal Code*.

### 17 *Exception—related company groups*

- 18 (9) Subsections (5) and (6) do not apply in relation to anything done  
19 by a member of a related company group for another member of  
20 the group.

21 Note: The defendant bears an evidential burden in relation to the matter in  
22 subsection (9). See subsection 13.3(3) of the *Criminal Code*.

### 23 *Whether a company is related to another company*

- 24 (10) For the purposes of this section, the question of whether a company  
25 is related to another company is to be determined in the same  
26 manner as that question is determined under the *Corporations Act*  
27 *2001*.

## 28 **201A When a person carries on business, practises or acts as a** 29 **patent attorney**

- 30 (1) For the purposes of section 201, a person is taken to carry on  
31 business, practise or act as a patent attorney if, and only if, the  
32 person does, or undertakes to do, patents work in Australia.  
33 (2) *Patents work* means one or more of the following done, on behalf  
34 of someone else, for gain:
-



# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

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- 1 (a) applying for or obtaining patents in Australia or anywhere  
2 else;  
3 (b) preparing specifications or other documents for the purposes  
4 of this Act or the patent law of another country;  
5 (c) giving advice (other than advice of a scientific or technical  
6 nature) about the validity, or infringement, of patents.

7 **201B Incorporated patent attorney must have a patent attorney**  
8 **director**

9 *Offence—failing to notify lack of patent attorney director*

- 10 (1) An incorporated patent attorney commits an offence if the  
11 incorporated patent attorney:  
12 (a) does not have a patent attorney director; and  
13 (b) does not notify the Designated Manager of that within 7 days.

14 Penalty: 150 penalty units.

15 *Offence—acting after 7 days without patent attorney director*

- 16 (2) An incorporated patent attorney commits an offence if the  
17 incorporated patent attorney:  
18 (a) does not have a patent attorney director; and  
19 (b) has not had a patent attorney director during the previous 7  
20 days; and  
21 (c) carries on business, practises or acts as a patent attorney.

22 Penalty: 150 penalty units.

23 *Designated Manager may appoint a registered patent attorney*

- 24 (3) If an incorporated patent attorney does not have a patent attorney  
25 director, the Designated Manager may, by writing, appoint another  
26 registered patent attorney to take charge of the patents work of the  
27 incorporated patent attorney.  
28 (4) The appointment may be made only with the consent of the other  
29 registered patent attorney.

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

---

1

### *Effect of appointment*

2

(5) A registered patent attorney holding an appointment under subsection (3) (the **appointed attorney**) is taken, for the purposes of this Act, to be a patent attorney director of the incorporated patent attorney.

3

4

5

6

(6) However, for the purposes of the *Corporations Act 2001*:

7

(a) the appointed attorney is not a director of the incorporated patent attorney only because:

8

9

10

(i) the appointed attorney takes charge of the patents work of the incorporated patent attorney; and

11

12

13

(ii) the appointed attorney is taken, for the purposes of this Act, to be a patent attorney director of the incorporated patent attorney; and

14

15

16

(b) the Designated Manager is not a director of the incorporated patent attorney only because the Designated Manager appointed the appointed attorney.

17

### *Designated Manager may remove incorporated patent attorney from Register*

18

19

(7) If an incorporated patent attorney does not have a patent attorney director, the Designated Manager may remove the incorporated patent attorney from the Register.

20

21

22

## **25 Section 202 (penalty)**

23

Repeal the penalty, substitute:

24

Penalty: 30 penalty units.

25

## **26 After section 202A**

26

Insert:

27

## **202B Documents prepared by incorporated patent attorneys and incorporated legal practices**

28

29

An incorporated patent attorney or an incorporated legal practice commits an offence if:

30

31

32

33

(a) an employee or member of the incorporated patent attorney or incorporated legal practice prepares a specification, or a document relating to an amendment of a specification; and

# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

---

- 1 (b) the employee or member is not a registered patent attorney;  
2 and  
3 (c) the specification or document is not prepared:  
4 (i) under the instructions or supervision of an individual  
5 who is a registered patent attorney; or  
6 (ii) as directed by an order under section 105.

7 Penalty: 150 penalty units.

## 8 **27 Section 203**

9 Repeal the section, substitute:

### 10 **203 Attendance at patent attorney's office**

11 A registered patent attorney commits an offence if:

- 12 (a) the registered patent attorney practises, acts, or holds himself,  
13 herself or itself out as practising or acting, as a patent  
14 attorney, at an office or place of business where  
15 specifications or other documents are prepared for the  
16 purposes of this Act; and  
17 (b) there is not an individual who is a registered patent attorney:  
18 (i) in regular attendance at that office or place; and  
19 (ii) in continuous charge of the patents work done at that  
20 office or place.

21 Penalty: 30 penalty units.

## 22 **28 After subparagraph 228(2)(r)(i)**

23 Insert:

- 24 (ia) assessing the professional conduct of registered patent  
25 attorneys by reference to standards of practice  
26 established by the Professional Standards Board from  
27 time to time;

## 28 **29 Schedule 1**

29 Insert:

30 *company* means a company registered under the *Corporations Act*  
31 *2001*.

## 32 **30 Schedule 1**

---

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

---

1                   Insert:

2                                 *director* of a company has the same meaning as in the  
3                                 *Corporations Act 2001*.

### 4           **31 Schedule 1**

5                   Insert:

6                                 *incorporated legal practice* means a body corporate recognised  
7                                 under a law of the Commonwealth, a State or a Territory as an  
8                                 incorporated legal practice (however described).

### 9           **32 Schedule 1**

10                   Insert:

11                                 *incorporated patent attorney* has the meaning given by subsection  
12                                 198(10).

### 13           **33 Schedule 1**

14                   Insert:

15                                 *intellectual property advice* has the meaning given by subsection  
16                                 200(2C).

### 17           **34 Schedule 1**

18                   Insert:

19                                 *patent attorney director* has the meaning given by subsection  
20                                 198(11).

### 21           **35 Schedule 1**

22                   Insert:

23                                 *patents work* has the meaning given by subsection 201A(2).

### 24           **36 Schedule 1**

25                   Insert:

26                                 *related company group* means a group of 2 or more companies,  
27                                 where each member of the group is related to each other member  
28                                 of the group.

# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

---

1 ***Trade Marks Act 1995***

2 **37 Subsection 6(1)**

3 Insert:

4 *company* means a company registered under the *Corporations Act*  
5 *2001*.

6 **38 Subsection 6(1)**

7 Insert:

8 *Designated Manager* has the same meaning as in the *Patents Act*  
9 *1990*.

10 **39 Subsection 6(1)**

11 Insert:

12 *incorporated legal practice* means a body corporate recognised  
13 under a law of the Commonwealth, a State or a Territory as an  
14 incorporated legal practice (however described).

15 **40 Subsection 6(1)**

16 Insert:

17 *incorporated trade marks attorney* has the meaning given by  
18 subsection 228A(6B).

19 **41 Subsection 6(1)**

20 Insert:

21 *intellectual property advice* has the meaning given by subsection  
22 229(3).

23 **42 Subsection 6(1)**

24 Insert:

25 *Professional Standards Board* has the same meaning as in the  
26 *Patents Act 1990*.

27 **43 Subsection 6(1)**

28 Insert:

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

---

1                    *trade marks attorney director* has the meaning given by subsection  
2                    228A(6C).

### 3                    **44 Subsection 6(1)**

4                    Insert:

5                    *trade marks work* has the meaning given by subsection 157A(8).

### 6                    **45 Subsections 156(1) to (3)**

7                    Repeal the subsections, substitute:

#### 8                    *Individuals*

9                    (1) An individual commits an offence if:

- 10                    (a) the individual describes himself or herself, or holds himself  
11                    or herself out, or permits himself or herself to be described or  
12                    held out, as a trade marks attorney; and  
13                    (b) the individual is not a registered trade marks attorney.

14                    Penalty: 30 penalty units.

15                    Note 1:    The Reader's Guide gives information about penalties (see the  
16                    paragraphs under the subheading *Crimes Act 1914*).

17                    Note 2:    For *registered trade marks attorney* see section 6.

18                    (2) An individual commits an offence if:

- 19                    (a) the individual describes himself or herself, or holds himself  
20                    or herself out, or permits himself or herself to be described or  
21                    held out, as a trade marks agent; and  
22                    (b) the individual is not a registered trade marks attorney, a  
23                    patent attorney or a lawyer.

24                    Penalty: 30 penalty units.

25                    Note 1:    The Reader's Guide gives information about penalties (see the  
26                    paragraphs under the subheading *Crimes Act 1914*).

27                    Note 2:    For *registered trade marks attorney, patent attorney* and *lawyer* see  
28                    section 6.

#### 29                    *Companies*

30                    (3) A company commits an offence if:

---

# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

---

- 1 (a) the company describes itself, or holds itself out, or permits  
2 itself to be described or held out, as a trade marks attorney;  
3 and  
4 (b) the company is not a registered trade marks attorney.

5 Penalty: 150 penalty units.

6 Note 1: The Reader's Guide gives information about penalties (see the  
7 paragraphs under the subheading *Crimes Act 1914*).

8 Note 2: For *company* and *registered trade marks attorney* see section 6.

9 (3A) A company commits an offence if the company:

- 10 (a) the company describes itself, or holds itself out, or permits  
11 itself to be described or held out, as a trade marks agent; and  
12 (b) the company is not a registered trade marks attorney, a patent  
13 attorney or an incorporated legal practice.

14 Penalty: 150 penalty units.

15 Note 1: The Reader's Guide gives information about penalties (see the  
16 paragraphs under the subheading *Crimes Act 1914*).

17 Note 2: For *company*, *registered trade marks attorney*, *patent attorney* and  
18 *incorporated legal practice* see section 6.

19 Note: The heading to section 156 is replaced by the heading "**Acting or holding out without**  
20 **being registered**".

## 21 **46 After section 157**

22 Insert:

### 23 **157A Incorporated trade marks attorney must have a trade marks** 24 **attorney director**

25 *Offence—failing to notify lack of trade marks attorney director*

- 26 (1) An incorporated trade marks attorney commits an offence if the  
27 incorporated trade marks attorney:  
28 (a) does not have a trade marks attorney director; and  
29 (b) does not notify the Designated Manager of that within 7 days.

30 Penalty: 150 penalty units.

31 Note 1: The Reader's Guide gives information about penalties (see the  
32 paragraphs under the subheading *Crimes Act 1914*).

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

---

1 Note 2: For *incorporated trade marks attorney, trade marks attorney director*  
2 and *Designated Manager* see section 6.

3 *Offence—acting after 7 days without trade marks attorney director*

- 4 (2) An incorporated trade marks attorney commits an offence if the  
5 incorporated trade marks attorney:  
6 (a) does not have a trade marks attorney director; and  
7 (b) has not had a trade marks attorney director during the  
8 previous 7 days; and  
9 (c) describes itself, or holds itself out, or permits itself to be  
10 described or held out, as a trade marks attorney.

11 Penalty: 150 penalty units.

12 Note 1: The Reader's Guide gives information about penalties (see the  
13 paragraphs under the subheading *Crimes Act 1914*).

14 Note 2: For *incorporated trade marks attorney* and *trade marks attorney*  
15 *director* see section 6.

16 *Designated Manager may appoint a registered trade marks*  
17 *attorney*

- 18 (3) If an incorporated trade marks attorney does not have a trade marks  
19 attorney director, the Designated Manager may, by writing, appoint  
20 another registered trade marks attorney to take charge of the trade  
21 marks work of the incorporated trade marks attorney.
- 22 (4) The appointment may be made only with the consent of the other  
23 registered trade marks attorney.

24 *Effect of appointment*

- 25 (5) A registered trade marks attorney holding an appointment under  
26 subsection (3) (the *appointed attorney*) is taken, for the purposes  
27 of this Act, to be a trade marks attorney director of the  
28 incorporated trade marks attorney.
- 29 (6) For the purposes of the *Corporations Act 2001*:  
30 (a) the appointed attorney is not a director of the incorporated  
31 trade marks attorney only because:  
32 (i) the appointed attorney takes charge of the trade marks  
33 work of the incorporated trade marks attorney; and



# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

---

- 1 (ii) the appointed attorney is taken, for the purposes of this  
2 Act, to be a trade marks attorney director of the  
3 incorporated trade marks attorney; and  
4 (b) the Designated Manager is not a director of the incorporated  
5 trade marks attorney only because the Designated Manager  
6 appointed the appointed attorney.

7 *Designated Manager may remove incorporated trade marks*  
8 *attorney from Register*

- 9 (7) If an incorporated trade marks attorney does not have a trade marks  
10 attorney director, the Designated Manager may remove the  
11 incorporated trade marks attorney from the Register.

12 *Meaning of trade marks work*

- 13 (8) *Trade marks work* means one or more of the following done, on  
14 behalf of someone else, for gain:  
15 (a) applying for or obtaining trade marks in Australia or  
16 anywhere else;  
17 (b) preparing trade marks applications or other documents for the  
18 purposes of this Act or the trade marks law of another  
19 country;  
20 (c) giving advice (other than advice of a scientific or technical  
21 nature) about the validity, or infringement, of trade marks.

## 22 **47 Subsection 228A(1) (note)**

23 Repeal the note, substitute:

24 Note: For *Designated Manager* see section 6.

## 25 **48 Subsection 228A(4)**

26 Omit “a person”, substitute “an individual”.

27 Note: The following heading to subsection 228A(4) is inserted “*Registration of individuals*”.

## 28 **49 After paragraph 228A(4)(d)**

29 Insert:

30 ; and (e) meets any other requirements prescribed by the regulations.

## 31 **50 Subsection 228A(4)**

32 Omit “person’s”, substitute “individual’s”.

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

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1     **51 At the end of subsection 228A(5)**

2             Add:

3                     Note:       For *Professional Standards Board* see section 6.

4     **52 After subsection 228A(6)**

5             Insert:

6                     *Registration of companies*

7             (6A) The Designated Manager must register as a trade marks attorney a  
8                 company that:

9                     (a) has at least one trade marks attorney director; and

10                    (b) has given the Designated Manager written notice in the  
11                       approved form of its intention to act as a trade marks  
12                       attorney; and

13                    (c) meets the requirements (if any) prescribed by the regulations.

14                 The registration is to consist of entering the company's name in the  
15                 Register of Trade Marks Attorneys.

16                     Note:       For *company* and *trade marks attorney director* see section 6.

17             (6B) A company registered as a trade marks attorney is an *incorporated*  
18                 *trade marks attorney*.

19             (6C) A *trade marks attorney director* of a company is an individual  
20                 who is both:

21                     (a) a registered trade marks attorney; and

22                     (b) a validly appointed director of the company.

23     **53 Subsection 228A(9)**

24             Repeal the subsection.

25     **54 Subsection 229(1)**

26             Repeal the subsection, substitute:

27             (1) A communication between a registered trade marks attorney and  
28                 another person made for the sole or dominant purpose of a  
29                 registered trade marks attorney providing intellectual property  
30                 advice to a client is privileged in the same way as a communication  
31                 between a lawyer and another person made for the sole or  
32                 dominant purpose of the lawyer providing legal advice to a client.

# EXPOSURE DRAFT

Assisting the operations of the IP profession **Schedule 4**

---

1 (1A) A record or document made for the sole or dominant purpose of a  
2 registered trade marks attorney providing intellectual property  
3 advice to a client is privileged in the same way as a record or  
4 document made for the sole or dominant purpose of a lawyer  
5 providing legal advice to a client.

6 (1B) A reference in subsection (1) or (2) to a registered trade marks  
7 attorney includes a reference to an individual authorised to do trade  
8 marks work under a law of another country or region:

## 9 **55 Subsection 229(3)**

10 Repeal the subsection, substitute:

11 (3) *Intellectual property advice* means advice in relation to:

- 12 (a) patents; or
- 13 (b) trade marks; or
- 14 (c) designs; or
- 15 (d) plant breeder's rights; or
- 16 (e) any related matters.

17 (4) Nothing in this section authorises a registered trade marks attorney  
18 to prepare a document to be issued from or filed in a court or to  
19 transact business, or conduct proceedings, in a court.

## 20 **56 After section 229**

21 Insert:

### 22 **229A Designated Manager may disclose information to ASIC**

23 The Designated Manager may disclose to the Australian Securities  
24 and Investments Commission, information (including personal  
25 information within the meaning of the *Privacy Act 1988*) that is:

- 26 (a) relevant to the functions of the Commission; and
- 27 (b) obtained by the Designated Manager as a result of the  
28 performance of functions and duties, or the exercise of  
29 powers, in relation to incorporated trade marks attorneys.

### 30 **57 After subparagraph 231(2)(ha)(i)**

31 Insert:

- 32 (ia) assessing the professional conduct of registered trade  
33 marks attorneys by reference to standards of practice

# EXPOSURE DRAFT

## Schedule 4 Assisting the operations of the IP profession

---

1 established by the Professional Standards Board from  
2 time to time;

# EXPOSURE DRAFT

Improving mechanisms for trade mark and copyright enforcement **Schedule 5**  
Customs seizure **Part 1**

---

1  
2 **Schedule 5—Improving mechanisms for trade**  
3 **mark and copyright enforcement**

4 **Part 1—Customs seizure**

5 *Copyright Act 1968*

6 **1 Section 134B**

7 Insert:

8 *action period*, in relation to particular seized copies, means the  
9 period prescribed by the regulations after notice of a claim for  
10 release of the copies is given to the objector under  
11 section 135AED.

12 **2 Section 134B**

13 Insert:

14 *claim period*, in relation to particular seized copies, means the  
15 period prescribed by the regulations after notice of seizure of the  
16 copies is given to the importer under section 135AC.

17 **3 Section 134B**

18 Insert:

19 *personal information* has the same meaning as in the *Privacy Act*  
20 *1988*.

21 **4 Section 134B**

22 Insert:

23 *working day* means a day that is not:  
24 (a) a Saturday; or  
25 (b) a Sunday; or  
26 (c) a public holiday in the Australian Capital Territory.

27 **5 Subsection 135AC(1)**

28 After “notice”, insert “(the *seizure notice*)”.

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement Part 1 Customs seizure

---

### 6 Subsections 135AC(2) to (7)

Repeal the subsections, substitute:

- (2) The seizure notice must state that the copies will be released to the importer if:
- (a) the importer makes a claim for the release of the copies within the claim period; and
  - (b) the objector has not, by the end of the action period:
    - (i) instituted an action for infringement of copyright in relation to the copies; and
    - (ii) given the CEO written notice of that action.
- (3) The seizure notice must also:
- (a) set out the claim period for the copies; and
  - (b) set out the action period for the copies and state that the action period will begin only if the importer makes a claim for the release of the copies; and
  - (c) if the notice is given to the objector—state the name and the address of the place of business or residence of the importer (if known); and
  - (d) if the notice is given to the importer—state the name and the address of the place of business or residence of:
    - (i) the objector; or
    - (ii) if the objector has nominated a person to be the objector’s agent or representative for the purposes of this Division—that person.

### 7 Paragraph 135AC(8)(a)

Repeal the paragraph, substitute:

- (a) the name, and the address of the place of business or residence, of any person or body that made arrangements, on behalf of the importer or the exporter of the copies, for the copies to be brought to Australia or any information that the CEO has, and believes on reasonable grounds may help in identifying and locating such a person or body; and

### 8 Paragraph 135AC(8)(b)

After “information”, insert “(including personal information)”.

### 9 Paragraph 135AC(8)(b)

---

# EXPOSURE DRAFT

Improving mechanisms for trade mark and copyright enforcement **Schedule 5**  
Customs seizure **Part 1**

---

1 After “importer”, insert “or the exporter”.

2 **10 Subsections 135AD(2) and (3)**

3 Omit “sample”, substitute “or more samples”.

4 **11 Subsection 135AD(4)**

5 Omit “copy” (wherever occurring), substitute “copies”.

6 **12 Subsection 135AD(5)**

7 Omit “a sample copy” (wherever occurring), substitute “sample copies”.

8 **13 Subsection 135AE(3)**

9 Omit all the words after “the Commonwealth”.

10 **14 Section 135AF**

11 Repeal the section, substitute:

12 **135AEA Claim for release of seized copies**

13 (1) The importer may make a claim to the CEO for the release of  
14 seized copies.

15 (2) The claim must be made before the end of the claim period for the  
16 copies.

17 (3) The claim must:

18 (a) be in the form (if any) prescribed by the regulations; and

19 (b) include the information prescribed by the regulations.

20 **135AEB Seized copies not claimed are forfeited**

21 (1) Seized copies are forfeited to the Commonwealth if a claim for the  
22 release of the goods is not made within the claim period for the  
23 copies.

24 (2) However, if the CEO allows a late claim for the copies (see  
25 section 135AEC), the copies are taken not to have been forfeited.

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement

### Part 1 Customs seizure

---

#### 1 135AEC Late claim for release of seized goods

- 2 (1) The CEO may allow the importer to make a claim (the *late claim*)  
3 to the CEO for the release of seized copies after the end of the  
4 claim period for the copies.
- 5 (2) The CEO may allow the late claim only if:  
6 (a) an action for infringement of copyright in relation to the  
7 copies has not been instituted; and  
8 (b) the CEO considers it reasonable in the circumstances; and  
9 (c) the goods have not been disposed of under section 135AI.

#### 10 135AED Objector to be notified of claim

- 11 (1) If the importer makes a claim for the release of seized copies, the  
12 CEO must, as soon as practicable, give notice of the claim to the  
13 objector.
- 14 (2) The notice:  
15 (a) must be in writing; and  
16 (b) may include any information that the CEO has and believes  
17 on reasonable grounds may be relevant for the purpose of  
18 identifying and locating the importer or the exporter of the  
19 copies.

#### 20 135AF Release of seized copies to importer

- 21 (1) The CEO must release seized copies to the importer if:  
22 (a) the objector gives written notice to the CEO stating that the  
23 objector consents to the release of the seized copies; and  
24 (b) the copies have not been disposed of under section 135AI.
- 25 (2) The CEO may release seized copies to the importer at any time if:  
26 (a) the CEO, having regard to information that has come to his  
27 or her knowledge after the copies were seized, is satisfied  
28 that there are no reasonable grounds for believing that  
29 copyright has been infringed by the importation of the copies;  
30 and  
31 (b) the objector has not brought an action for infringement of  
32 copyright in relation to the copies.
- 33 (3) The CEO must release seized copies to the importer if:



# EXPOSURE DRAFT

- 1 (a) the importer has made a claim for the release of the copies;  
2 and  
3 (b) the objector has not, by the end of the action period:  
4 (i) instituted an action for infringement of copyright in  
5 relation to the copies; and  
6 (ii) given the CEO written notice of that action.
- 7 (4) The CEO must release seized copies to the importer if:  
8 (a) the importer has made a claim for the release of the copies;  
9 and  
10 (b) an action for infringement of copyright has been instituted in  
11 relation to the copies; and  
12 (c) at the end of a period of 20 working days commencing on the  
13 day on which the action was instituted, there is not in force  
14 an order of the court in which the action was instituted  
15 preventing the release of the copies.
- 16 (5) This section has effect subject to section 135AH.

## 17 **135AFA Copies released but not collected are forfeited**

- 18 Seized copies are forfeited to the Commonwealth if:  
19 (a) the copies are released by the CEO to the importer; and  
20 (b) the importer does not take possession of the copies within 90  
21 days of the release.

## 22 **15 Section 135AI**

23 Repeal the section, substitute:

## 24 **135AI Disposal of seized copies forfeited to the Commonwealth**

- 25 (1) Seized copies forfeited to the Commonwealth must be disposed of:  
26 (a) in the manner prescribed by the regulations; or  
27 (b) if no manner of disposal is so prescribed—as the CEO  
28 directs.
- 29 (2) However, copies forfeited under section 135AEB must not be  
30 disposed of until 30 days after their forfeiture.
- 31 (3) Subsection (1) does not require the disposal of copies that are  
32 required in relation to an action for infringement of copyright.

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement

### Part 1 Customs seizure

---

1

#### *Right of compensation in certain circumstances*

2

(4) Despite the forfeiture of seized copies to the Commonwealth, a person may apply to a court of competent jurisdiction under this section for compensation for the disposal of the copies.

3

4

5

(5) A right to compensation exists if:

6

(a) the copies did not infringe the objector's copyright; and

7

(b) the person establishes, to the satisfaction of the court:

8

(i) that he or she was the owner of the copies immediately before they were forfeited; and

9

10

(ii) that there were circumstances providing a reasonable excuse for the failure to make a claim for the release of the copies.

11

12

13

(6) If a right to compensation exists under subsection (4), the court must order the payment by the Commonwealth to the person of an amount equal to the market value of the copies at the time of their disposal.

14

15

16

17

#### **16 Paragraph 195B(1)(c)**

18

Repeal the paragraph, substitute:

19

(c) a decision of the CEO under section 135AA refusing to seize copies under subsection 135(7);

20

21

(ca) a decision of the CEO under section 135AEC refusing to allow a late claim for the release of seized copies;

22

23

(cb) a decision of the CEO under section 135AJ refusing to seize copies under subsection 135(7);

24

25

#### **17 Subsection 195B(3)**

26

Omit "paragraph (1)(ba), (c) or (d)", substitute "paragraphs (1)(ba) to (d)".

27

28

### ***Trade Marks Act 1995***

29

#### **18 Section 6**

30

Insert:

31

***action period***, in relation to particular seized goods, means the period prescribed by the regulations after notice of a claim for release of the goods is given to the objector under section 136C.

32

33

# EXPOSURE DRAFT

1 **19 Section 6**

2 Insert:

3 *claim period*, in relation to particular seized goods, means the  
4 period prescribed by the regulations after notice of seizure of the  
5 goods is given to the designated owner under section 134.

6 **20 Section 6**

7 Insert:

8 *personal information* has the same meaning as in the *Privacy Act*  
9 *1988*.

10 **21 Section 134**

11 Repeal the section, substitute:

12 **134 Notice of seizure**

13 (1) As soon as is practicable after goods are seized under section 133,  
14 the Customs CEO must give to the designated owner and the  
15 objector, either personally or by post, a written notice (the *seizure*  
16 *notice*) identifying the goods and stating that the identified goods  
17 have been seized.

18 Note: For *designated owner* and *objector* see section 6.

19 (2) The seizure notice must state that the goods will be released to the  
20 designated owner if:

21 (a) the designated owner makes a claim for the release of the  
22 goods within the claim period; and

23 (b) the objector has not, by the end of the action period:

24 (i) instituted an action for infringement of the notified trade  
25 mark in respect of the goods; and

26 (ii) given the Customs CEO written notice of that action.

27 Note: For *claim period*, *action period* and *notified trade mark* see section 6.

28 (3) The seizure notice must also:

29 (a) set out the claim period for the goods; and

30 (b) set out the action period for the goods and state that the  
31 action period will begin only if the designated owner makes a  
32 claim for the release of the goods; and

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement

### Part 1 Customs seizure

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- 1 (c) if the notice is given to the objector—state the name and the  
2 address of the place of business or residence of the  
3 designated owner (if known); and  
4 (d) if the notice is given to the designated owner—state the name  
5 and the address of the place of business or residence of:  
6 (i) the objector; or  
7 (ii) if the objector has nominated a person to be the  
8 objector’s agent or representative for the purposes of  
9 this Division—that person.
- 10 (4) The Customs CEO may, at any time after the goods are seized,  
11 give to the objector:  
12 (a) the name and the address of the place of business or  
13 residence of any person or body that made arrangements, on  
14 behalf of the designated owner or the exporter of the goods,  
15 for the goods to be brought to Australia or any information  
16 that the Customs CEO has, and believes on reasonable  
17 grounds may help in identifying and locating such a person  
18 or body; and  
19 (b) any other information (including personal information) that  
20 the Customs CEO has and believes on reasonable grounds  
21 may be relevant for the purpose of identifying and locating  
22 the importer or the exporter.

#### 23 **134A Inspection, release etc. of seized goods**

- 24 (1) The Customs CEO may permit the objector or the designated  
25 owner to inspect the seized goods.  
26 Note: For *designated owner*, *objector* and *seized goods* see section 6.
- 27 (2) If the objector gives the Customs CEO the requisite undertakings,  
28 the Customs CEO may permit the objector to remove one or more  
29 samples of the seized goods from the custody of the Customs CEO  
30 for inspection by the objector.
- 31 (3) If the designated owner gives the Customs CEO the requisite  
32 undertakings, the Customs CEO may permit the designated owner  
33 to remove one or more samples of the seized goods from the  
34 custody of the Customs CEO for inspection by the designated  
35 owner.

# EXPOSURE DRAFT

- 1 (4) The requisite undertakings are undertakings in writing that the  
2 person giving the undertaking will:  
3 (a) return the sample goods to the Customs CEO at a specified  
4 time that is satisfactory to the Customs CEO; and  
5 (b) take reasonable care to prevent damage to the sample goods.
- 6 (5) If the Customs CEO permits inspection of the seized goods, or the  
7 removal of sample goods, by the objector in accordance with this  
8 section, the Commonwealth is not liable to the designated owner  
9 for any loss or damage suffered by the designated owner arising  
10 out of:  
11 (a) damage to any of the seized goods incurred during that  
12 inspection; or  
13 (b) anything done by the objector or any other person to, or in  
14 relation to, sample goods removed from the custody of the  
15 Customs CEO or any use made by the objector of such  
16 sample goods.

17 Note: The heading to section 135 is replaced by the heading “**Consent to forfeiture of seized**  
18 **goods**”.

## 19 **22 Section 136**

20 Repeal the section, substitute:

### 21 **136 Claim for release of seized goods**

- 22 (1) The designated owner may make a claim to the Customs CEO for  
23 the release of seized goods.

24 Note: For *designated owner* and *seized goods* see section 6.

- 25 (2) The claim must be made before the end of the claim period for the  
26 goods.

27 Note: For *claim period* see section 6.

- 28 (3) The claim must:  
29 (a) be in the form (if any) prescribed by the regulations; and  
30 (b) include the information prescribed by the regulations.

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement

### Part 1 Customs seizure

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#### 1 **136A Seized goods not claimed are forfeited**

2 (1) Seized goods are forfeited to the Commonwealth if a claim for the  
3 release of the goods is not made within the claim period for the  
4 goods.

5 Note: For *seized goods* and *claim period* see section 6.

6 (2) However, if the Customs CEO allows a late claim for the goods  
7 (see section 136B), the goods are taken not to have been forfeited.

#### 8 **136B Late claim for release of seized goods**

9 (1) The Customs CEO may allow the designated owner to make a  
10 claim (the *late claim*) to the Customs CEO for the release of seized  
11 goods after the end of the claim period for the goods.

12 Note: For *objector*, *seized goods* and *claim period* see section 6.

13 (2) The Customs CEO may allow the late claim only if:  
14 (a) an action for infringement of the notified trade mark in  
15 respect of the goods has not been instituted; and  
16 (b) the Customs CEO considers it reasonable in the  
17 circumstances; and  
18 (c) the goods have not been disposed of under section 139.

19 (3) An application may be made to the Administrative Appeals  
20 Tribunal for the review of a decision of the Customs CEO under  
21 subsection (1) refusing to allow a late claim for the release of  
22 seized goods.

#### 23 **136C Objector to be notified of claim**

24 (1) If the designated owner makes a claim for the release of seized  
25 goods, the Customs CEO must, as soon as practicable, give notice  
26 of the claim to the objector.

27 Note: For *designated owner*, *objector* and *seized goods* see section 6.

28 (2) The notice:  
29 (a) must be in writing; and  
30 (b) may include any information that the Customs CEO has and  
31 believes on reasonable grounds may be relevant for the  
32 purpose of identifying and locating the importer or the  
33 exporter of the goods.

# EXPOSURE DRAFT

## 136D Release of seized goods

- 1  
2 (1) The Customs CEO must release seized goods to the designated  
3 owner if:  
4 (a) the objector gives written notice to the Customs CEO stating  
5 that the objector consents to the release of the seized goods;  
6 and  
7 (b) the goods have not been disposed of under section 139.

8 Note: For *designated owner*, *objector* and *seized goods* see section 6.

- 9 (2) The Customs CEO may release seized goods to the designated  
10 owner at any time if:  
11 (a) the Customs CEO, having regard to information that has  
12 come to his or her knowledge after the goods were seized, is  
13 satisfied that there are no reasonable grounds for believing  
14 that the notified trade mark has been infringed by the  
15 importation of the goods; and  
16 (b) the objector has not brought an action for infringement of the  
17 notified trade mark in respect of the goods.

- 18 (3) The Customs CEO must release seized goods to the designated  
19 owner if:  
20 (a) the designated owner has made a claim for the release of the  
21 goods; and  
22 (b) the objector has not, by the end of the action period:  
23 (i) instituted an action for infringement of the notified trade  
24 mark in respect of the goods; and  
25 (ii) given the Customs CEO written notice of that action.

26 Note: For *action period* see section 6.

- 27 (4) The CEO must release seized goods to the designated owner if:  
28 (a) the designated owner has made a claim for the release of the  
29 goods; and  
30 (b) action for infringement of the notified trade mark in respect  
31 of the goods has been instituted; and  
32 (c) at the end of a period of 20 working days commencing on the  
33 day on which the action was instituted, there is not in force  
34 an order of the court in which the action was instituted  
35 preventing the release of the goods.

- 36 (5) This section has effect subject to section 140.

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement Part 1 Customs seizure

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1 **136E Goods released but not collected are forfeited**

2 Seized goods are forfeited to the Commonwealth if:

- 3 (a) the goods are released by the Customs CEO to the designated  
4 owner; and  
5 (b) the designated owner does not take possession of the goods  
6 within 90 days of the release.

7 Note: For *designated owner* and *seized goods* see section 6.

8 **23 Subsection 137(1)**

9 Omit all the words after “in respect of seized goods”.

10 **24 Paragraph 137(3)(a)**

11 Omit “their”, substitute “the”.

12 **25 Subsection 137(5)**

13 Repeal the subsection.

14 **26 Section 139**

15 Repeal the section, substitute:

16 **139 Disposal of seized goods forfeited to the Commonwealth**

- 17 (1) Seized goods forfeited to the Commonwealth must be disposed of:  
18 (a) in the manner prescribed by the regulations; or  
19 (b) if no manner of disposal is so prescribed—as the Customs  
20 CEO directs.

21 Note: For *seized goods* see section 6.

- 22 (2) However, goods forfeited under section 136A must not be disposed  
23 of until 30 days after their forfeiture.

24 Note: If the Customs CEO allows a late claim under section 136B for goods  
25 that have been forfeited under section 136A, the goods are taken not to  
26 have been forfeited.

- 27 (3) Subsection (1) does not require the disposal of goods that are  
28 required in relation to an action for infringement of a trade mark.



# EXPOSURE DRAFT

Improving mechanisms for trade mark and copyright enforcement **Schedule 5**  
Customs seizure **Part 1**

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*Right of compensation in certain circumstances*

- (4) Despite the forfeiture of seized goods to the Commonwealth, a person may apply to a court of competent jurisdiction under this section for compensation for the disposal of the goods.
- (5) A right to compensation exists if:
  - (a) the goods did not infringe the objector's notified trade mark; and
  - (b) the person establishes, to the satisfaction of the court:
    - (i) that he or she was the owner of the goods immediately before they were forfeited; and
    - (ii) that there were circumstances providing a reasonable excuse for the failure to make a claim for the release of the goods.
- (6) If a right to compensation exists under subsection (4), the court must order the payment by the Commonwealth to the person of an amount equal to the market value of the goods at the time of their disposal.

# EXPOSURE DRAFT

Schedule 5 Improving mechanisms for trade mark and copyright enforcement

Part 2 Trade Mark offences

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1

## 2 Part 2—Trade Mark offences

### 3 *Trade Marks Act 1995*

#### 4 **27 Sections 145 to 149**

5 Repeal the sections, substitute:

#### 6 **145 Falsifying or removing a registered trade mark**

##### 7 *Indictable offence*

8 (1) A person commits an offence if:

- 9 (a) a registered trade mark has been applied to goods, or in  
10 relation to goods or services; and
- 11 (b) the goods or services are being, or are to be, dealt with or  
12 provided in the course of trade; and
- 13 (c) the person:
- 14 (i) alters or defaces the trade mark; or
- 15 (ii) makes any addition to the trade mark; or
- 16 (iii) wholly or partly removes, erases or obliterates the trade  
17 mark; and
- 18 (d) the person does so without:
- 19 (i) the permission of the registered owner, or an authorised  
20 user, of the trade mark; or
- 21 (ii) being required or authorised to do so by this Act, a  
22 direction of the Registrar or an order of a court.

23 Penalty: Imprisonment for 5 years or 550 penalty units, or both.

24 Note 1: For *registered trade mark* and *registered owner* see section 6.

25 Note 2: For *authorised user* see section 8.

26 Note 3: For *applied to* goods and *applied in relation to* goods or services see  
27 section 9.

28 Note 4: International trade marks may be protected under the regulations: see  
29 Part 17A.

##### 30 *Summary offence*

31 (2) A person commits an offence if:

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# EXPOSURE DRAFT

- 1 (a) a registered trade mark has been applied to goods, or in  
2 relation to goods or services; and  
3 (b) the goods or services are being, or are to be, dealt with or  
4 provided in the course of trade; and  
5 (c) the person:  
6 (i) alters or defaces the trade mark; or  
7 (ii) makes any addition to the trade mark; or  
8 (iii) wholly or partly removes, erases or obliterates the trade  
9 mark; and  
10 (d) the person does so without:  
11 (i) the permission of the registered owner, or an authorised  
12 user, of the trade mark; or  
13 (ii) being required or authorised to do so by this Act, a  
14 direction of the Registrar or an order of a court.

15 Penalty: Imprisonment for 12 months or 60 penalty units, or both.

16 (3) The fault element for paragraphs (2)(a), (b) and (d) is negligence.

## 17 **146 Falsely applying a registered trade mark**

### 18 *Indictable offence*

- 19 (1) A person commits an offence if:  
20 (a) the person applies a mark or sign to goods, or in relation to  
21 goods or services; and  
22 (b) the goods or services are being, or are to be, dealt with or  
23 provided in the course of trade; and  
24 (c) the mark or sign is, or is substantially identical to, a  
25 registered trade mark; and  
26 (d) the person applies the mark or sign without:  
27 (i) the permission of the registered owner, or an authorised  
28 user, of the trade mark; or  
29 (ii) being required or authorised to do so by this Act, a  
30 direction of the Registrar or an order of a court.

31 Penalty: Imprisonment for 5 years or 550 penalty units, or both.

32 Note 1: For *registered trade mark* and *registered owner* see section 6.

33 Note 2: For *authorised user* see section 8.

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement

### Part 2 Trade Mark offences

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1 Note 3: International trade marks may be protected under the regulations: see  
2 Part 17A.

#### 3 *Summary offence*

- 4 (2) A person commits an offence if:
- 5 (a) the person applies a mark or sign to goods, or in relation to  
6 goods or services; and
  - 7 (b) the goods or services are being, or are to be, dealt with or  
8 provided in the course of trade; and
  - 9 (c) the mark or sign is, or is substantially identical to, a  
10 registered trade mark; and
  - 11 (d) the person applies the mark or sign without:
    - 12 (i) the permission of the registered owner, or an authorised  
13 user, of the trade mark; or
    - 14 (ii) being required or authorised to do so by this Act, a  
15 direction of the Registrar or an order of a court.

16 Penalty: Imprisonment for 12 months or 60 penalty units, or both.

17 (3) The fault element for paragraphs (2)(b), (c) and (d) is negligence.

### 18 **147 Making a die etc. for use in trade marks offence**

#### 19 *Indictable offence*

- 20 (1) A person commits an offence if:
- 21 (a) the person makes a die, block, machine or instrument; and
  - 22 (b) the die, block, machine or instrument is likely to be used for,  
23 or in the course of, committing an offence; and
  - 24 (c) the offence is an offence against section 145 or 146.

25 Penalty: Imprisonment for 5 years or 550 penalty units, or both.

26 (2) Strict liability applies to paragraph (1)(c).

27 Note: For strict liability, see section 6.1 of the *Criminal Code*.

#### 28 *Summary offence*

- 29 (3) A person commits an offence if:
- 30 (a) the person makes a die, block, machine or instrument; and

# EXPOSURE DRAFT

1 (b) the die, block, machine or instrument is likely to be used for,  
2 or in the course of, committing an offence; and

3 (c) the offence is an offence against section 145 or 146.

4 Penalty: Imprisonment for 12 months or 60 penalty units, or both.

5 (4) The fault element for paragraph (3)(b) is negligence.

6 (5) Strict liability applies to paragraph (3)(c).

7 Note: For strict liability, see section 6.1 of the *Criminal Code*.

## 8 **147A Drawing etc. trade marks for use in offence**

### 9 *Indictable offence*

10 (1) A person commits an offence if:

11 (a) the person draws, or programs a computer or other device to  
12 draw, a registered trade mark or part of a registered trade  
13 mark; and

14 (b) the registered trade mark or part of the registered trade mark  
15 is likely to be used for, or in the course of, an offence; and

16 (c) the offence is an offence against section 145 or 146.

17 Penalty: Imprisonment for 5 years or 550 penalty units, or both.

18 Note: For *registered trade mark* see section 6.

19 (2) Strict liability applies to paragraph (1)(c).

20 Note: For strict liability, see section 6.1 of the *Criminal Code*.

### 21 *Summary offence*

22 (3) A person commits an offence if:

23 (a) the person draws, or programs a computer or other device to  
24 draw, a registered trade mark or part of a registered trade  
25 mark; and

26 (b) the registered trade mark or part of the registered trade mark  
27 is likely to be used for, or in the course of, an offence; and

28 (c) the offence is an offence against section 145 or 146.

29 Penalty: Imprisonment for 12 months or 60 penalty units, or both.

30 (4) The fault element for paragraph (3)(b) is negligence.

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement Part 2 Trade Mark offences

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1 (5) Strict liability applies to paragraph (3)(c).

2 Note: For strict liability, see section 6.1 of the *Criminal Code*.

### 3 **147B Possessing or disposing of things for use in trade marks** 4 **offence**

#### 5 *Indictable offence*

6 (1) A person commits an offence if:

7 (a) the person possesses or disposes of:

8 (i) a die, block, machine or instrument; or

9 (ii) a computer, or other device, programmed to draw a  
10 registered trade mark or part of a registered trade mark;  
11 or

12 (iii) a representation of a registered trade mark or of part of a  
13 registered trade mark; and

14 (b) the die, block, machine, instrument, computer, device or  
15 representation is likely to be used for, or in the course of, an  
16 offence; and

17 (c) the offence is an offence against section 145 or 146.

18 Penalty: Imprisonment for 5 years or 550 penalty units, or both.

19 Note: For *registered trade mark* see section 6.

20 (2) Strict liability applies to paragraph (1)(c).

21 Note: For strict liability, see section 6.1 of the *Criminal Code*.

#### 22 *Summary offence*

23 (3) A person commits an offence if:

24 (a) the possesses or disposes of:

25 (i) a die, block, machine or instrument; or

26 (ii) a computer, or other device, programmed to draw a  
27 registered trade mark or part of a registered trade mark;  
28 or

29 (iii) a representation of a registered trade mark or of part of a  
30 registered trade mark; and

31 (b) the die, block, machine, instrument, computer, device or  
32 representation is likely to be used for, or in the course of, an  
33 offence; and

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# EXPOSURE DRAFT

1 (c) the offence is an offence against section 145 or 146.

2 Penalty: Imprisonment for 12 months or 60 penalty units, or both.

3 (4) The fault element for paragraph (3)(b) is negligence.

4 (5) Strict liability applies to paragraph (3)(c).

5 Note: For strict liability, see section 6.1 of the *Criminal Code*.

## 6 **148 Goods with false trade marks**

### 7 *Indictable offence*

8 (1) A person commits an offence if:

9 (a) the person:

10 (i) sells goods; or

11 (ii) exposes goods for sale; or

12 (iii) possesses goods for the purpose of trade or  
13 manufacture; or

14 (iv) imports goods into Australia for the purpose of trade or  
15 manufacture; and

16 (b) any of the following applies:

17 (i) there is a registered trade mark on the goods;

18 (ii) there is a mark or sign on the goods that is substantially  
19 identical to a registered trade mark;

20 (iii) a registered trade mark on the goods has been altered,  
21 defaced, added to, wholly or partly removed, erased or  
22 obliterated; and

23 (c) the registered trade mark, or mark or sign, was applied,  
24 altered, defaced, added to, wholly or partly removed, erased  
25 or obliterated, as the case requires, without:

26 (i) the permission of the registered owner, or an authorised  
27 user, of the trade mark; or

28 (ii) the application being required or authorised by this Act,  
29 a direction of the Registrar or an order of a court.

30 Penalty: Imprisonment for 5 years or 550 penalty units, or both.

### 31 *Summary offence*

32 (2) A person commits an offence if:

# EXPOSURE DRAFT

## Schedule 5 Improving mechanisms for trade mark and copyright enforcement

### Part 2 Trade Mark offences

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- 1 (a) the person:
- 2 (i) sells goods; or
- 3 (ii) exposes goods for sale; or
- 4 (iii) possesses goods for the purpose of trade or
- 5 manufacture; or
- 6 (iv) imports goods into Australia for the purpose of trade or
- 7 manufacture; and
- 8 (b) any of the following applies:
- 9 (i) there is a registered trade mark applied to the goods;
- 10 (ii) there is a mark or sign applied to the goods that is
- 11 substantially identical to a registered trade mark;
- 12 (iii) a registered trade mark applied to the goods has been
- 13 altered, defaced, added to, wholly or partly removed,
- 14 erased or obliterated; and
- 15 (c) the registered trade mark, or mark or sign, was applied,
- 16 altered, defaced, added to, wholly or partly removed, erased
- 17 or obliterated, as the case requires, without:
- 18 (i) the permission of the registered owner, or an authorised
- 19 user, of the trade mark; or
- 20 (ii) the application being required or authorised by this Act,
- 21 a direction of the Registrar or an order of a court.

22 Penalty: Imprisonment for 12 months or 60 penalty units, or both.

23 (3) The fault element for paragraphs (2)(b) and (c) is negligence.

24 Note 1: For *registered trade mark* see section 6.

25 Note 2: For *applied to* goods see section 9.

26 Note 3: International trade marks may be protected under the regulations: see

27 Part 17A.



# EXPOSURE DRAFT

Improving mechanisms for trade mark and copyright enforcement **Schedule 5**  
Relief for infringement of trade marks **Part 3**

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1

2

## **Part 3—Relief for infringement of trade marks**

3

### ***Trade Marks Act 1995***

4

#### **28 Section 126**

5

Before “The”, insert “(1)”.

6

#### **29 At the end of section 126**

7

Add:

8

(2) A court may include an additional amount in an assessment of damages for an infringement of a registered trade mark, if the court considers it appropriate to do so having regard to:

9

10

11

(a) the flagrancy of the infringement; and

12

(b) the need to deter similar infringements of registered trade marks; and

13

14

(c) the conduct of the party that infringed the registered trade mark that occurred:

15

16

(i) after the act constituting the infringement; or

17

(ii) after that party was informed that it had allegedly infringed the patent; and

18

19

(d) any benefit shown to have accrued to that party because of the infringement; and

20

21

(e) all other relevant matters.

# EXPOSURE DRAFT

Schedule 6 Simplifying the IP system

Part 1 Amendments

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1

## Schedule 6—Simplifying the IP system

2

3

### Part 1—Amendments

4

#### *Designs Act 2003*

5

##### **1 Section 5 (definition of *Convention country*)**

6

Repeal the definition, substitute:

7

*Convention country* has the meaning given by section 5A.

8

##### **2 Section 5 (after paragraph (a) of the definition of *prescribed court*)**

9

Insert:

10

(aa) the Federal Magistrates Court;

11

12

##### **3 After section 5**

13

Insert:

14

##### **5A Meaning of *Convention country***

15

(1) In this Act:

16

*Convention country* means a foreign country or region of a kind prescribed by the regulations.

17

18

(2) Despite subsection 14(2) of the *Legislative Instruments Act 2003*, regulations made for the purposes of this section may make provision in relation to a matter by applying, adopting or incorporating, with or without modification, any matter contained in any other instrument or other writing as in force or existing from time to time.

19

20

21

22

23

24

##### **4 Subsection 28(5)**

25

After “Federal Court”, insert “or the Federal Magistrates Court”.

26

##### **5 Subsection 50(6)**

27

After “Federal Court”, insert “or the Federal Magistrates Court”.

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# EXPOSURE DRAFT

Simplifying the IP system **Schedule 6**  
Amendments **Part 1**

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1 **6 Subsection 52(7)**

2 After “Federal Court”, insert “or the Federal Magistrates Court”.

3 **7 Subsection 54(4)**

4 After “Federal Court”, insert “or the Federal Magistrates Court”.

5 **8 Subsection 67(4)**

6 After “Federal Court”, insert “or the Federal Magistrates Court”.

7 **9 Subsection 68(6)**

8 After “Federal Court”, insert “or the Federal Magistrates Court”.

9 **10 Section 82**

10 Omit “is” (second occurring), substitute “and the Federal Magistrates  
11 Court are”.

12 **11 Subsection 83(2)**

13 Repeal the subsection, substitute:

14 (2) The jurisdiction of the Federal Court to hear and determine appeals  
15 from decisions of the Registrar is exclusive of the jurisdiction of  
16 any other court other than the jurisdiction of:

17 (a) the Federal Magistrates Court under subsection 83A(2); and

18 (b) the High Court under section 75 of the Constitution.

19 **12 After section 83**

20 Insert:

21 **83A Jurisdiction of the Federal Magistrates Court**

22 (1) The Federal Magistrates Court has jurisdiction with respect to  
23 matters arising under this Act.

24 (2) The jurisdiction of the Federal Magistrates Court to hear and  
25 determine appeals from decisions of the Registrar is exclusive of  
26 the jurisdiction of any other court other than the jurisdiction of:

27 (a) the Federal Court under subsection 83(2); and

28 (b) the High Court under section 75 of the Constitution.

# EXPOSURE DRAFT

## Schedule 6 Simplifying the IP system

### Part 1 Amendments

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- 1 (3) A prosecution for an offence against this Act must not be brought  
2 in the Federal Magistrates Court.

#### 3 **13 Subsection 84(1)**

4 After “Federal Court”, insert “or the Federal Magistrates Court”.

#### 5 **14 Section 85**

6 After “83”, insert “, 83A”.

#### 7 **15 At the end of section 86**

8 Add:

- 9 (3) This section does not apply in relation to a transfer of proceedings  
10 between the Federal Court and the Federal Magistrates Court.

11 Note: For transfers of proceedings from the Federal Magistrates Court to the  
12 Federal Court, see section 39 of the *Federal Magistrates Act 1999*. For  
13 transfers of proceedings from the Federal Court to the Federal  
14 Magistrates Court, see section 32AB of the *Federal Court of Australia*  
15 *Act 1976*.

#### 16 **16 Subsection 87(2)**

17 After “single judge of the Federal Court”, insert “or the Federal  
18 Magistrates Court”.

#### 19 **17 Section 88**

20 After “Federal Court”, insert “or Federal Magistrates Court”.

21 Note: The heading to section 88 is altered by inserting “**and Federal Magistrates Court**”  
22 after “**Federal Court**”.

#### 23 **18 Section 89**

24 After “Federal Court”, insert “or Federal Magistrates Court”.

#### 25 **19 Subsection 125(2)**

26 Repeal the subsection, substitute:

27 (2) The Registrar may establish one or more sub-offices of the Designs  
28 Office as the Registrar considers appropriate.

29 (3) The Registrar may abolish any such sub-offices.

#### 30 **20 Subsection 136A**

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# EXPOSURE DRAFT

Simplifying the IP system **Schedule 6**  
Amendments **Part 1**

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1 After “of the Designs Office”, insert “(if any)”.

2 **21 Section 144**

3 Repeal the section, substitute:

4 **144 Filing of documents**

5 A document may be filed with the Designs Office by:

6 (a) delivering the document to the Designs Office, or a  
7 sub-office of the Designs Office (if any), either personally or  
8 by post; or

9 (b) any other prescribed means.

10 ***Patents Act 1990***

11 **22 Section 3 (in the list of definitions)**

12 Omit “foreign patent office”.

13 **23 Section 3 (in the list of definitions)**

14 Omit “modified examination”.

15 **24 Section 3 (in the list of definitions)**

16 Omit “sealed”.

17 **25 Section 4**

18 Repeal the section.

19 **26 Section 8**

20 Repeal the section.

21 **27 Paragraph 9(d)**

22 Omit “Territory.”, substitute “Territory;”.

23 **28 At the end of section 9 (before the note)**

24 Add:

25 (e) any other use of the invention for any purpose, if a complete  
26 application is made for the invention within the prescribed  
27 period.

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1     **29 Section 10 (note)**

2             Omit “: see also Chapter 8”.

3     **30 Before section 22**

4             Insert:

5     **22A Validity not affected by who patent is granted to**

6             A patent is not invalid merely because:

7                 (a) the patent, or a share in the patent, was granted to a person  
8                     who was not entitled to it; or

9                 (b) the patent, or a share in the patent, was not granted to a  
10                     person who was entitled to it.

11     **31 Paragraph 24(1)(a)**

12             Omit “, through any publication or use of the invention”.

13     **32 Subsection 24(1)**

14             Omit “patent application”, substitute “complete application”.

15     **33 After section 29**

16             Insert:

17     **29A Applications for patents—special rules for PCT applications**

18             (1) A PCT application is to be treated as a complete application under  
19                 this Act for a standard patent.

20             (2) The description, drawings and claims contained in a PCT  
21                 application are to be treated as a complete specification filed in  
22                 respect of the application.

23             (3) The specification of a PCT application is to be taken to be  
24                 amended in the circumstances, on the day and in the manner as  
25                 prescribed by the regulations.

26             (4) A PCT application is to be taken to comply with the prescribed  
27                 requirements of this Act that relate to applications for standard  
28                 patents, but is not to be taken, merely because of subsection (1) or  
29                 (2), to comply with any other requirements of this Act.

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- 1 (5) An applicant of a PCT application must do the following within the  
2 prescribed period:  
3 (a) if the application was not filed in the receiving Office in  
4 English—file a translation of the application into English;  
5 (b) in any case—file the prescribed documents and pay the  
6 prescribed fees.
- 7 Note: A failure to comply with this subsection may result in the PCT  
8 application lapsing: see paragraph 142(2)(f).

## 9 **29B Applications for patents—special rules for Convention** 10 **applications**

### 11 *Making Convention applications*

- 12 (1) A Convention applicant in relation to a basic application may make  
13 a Convention application, or 2 or more such applicants may make a  
14 joint Convention application.
- 15 (2) If 2 or more basic applications for protection in respect of  
16 inventions have been made in one or more Convention countries,  
17 one Convention application may be made within the prescribed  
18 period by a Convention applicant in relation to those basic  
19 applications, or by 2 or more such entitled applicants jointly, in  
20 respect of the inventions disclosed in the basic applications.
- 21 (3) Subject to subsections (4) and (5), a Convention application must  
22 be made and dealt with in the same way as any other patent  
23 application.
- 24 (4) A patent request relating to a Convention application must:  
25 (a) include the prescribed particulars relating to the relevant  
26 basic application; and  
27 (b) be accompanied by a complete specification.

### 28 *Meaning of Convention country*

- 29 (5) **Convention country** means a foreign country or region of a kind  
30 prescribed by the regulations.
- 31 (6) Despite subsection 14(2) of the *Legislative Instruments Act 2003*,  
32 regulations made for the purposes of subsection (1) may make  
33 provision in relation to a matter by applying, adopting or  
34 incorporating, with or without modification, any matter contained

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1 in any other instrument or other writing as in force or existing from  
2 time to time.

3 Note: The heading to section 29 is altered by adding at the end “—general rules”.

#### 4 **34 Section 30**

5 After “application”, insert “(including a PCT application)”.

#### 6 **35 Section 32**

7 Before “If”, insert “(1)”.

#### 8 **36 Section 32**

9 Omit “interested parties”, substitute “joint applicants”.

#### 10 **37 Section 32**

11 Omit “parties” (second and third occurring), substitute “applicants”.

#### 12 **38 At the end of section 32**

13 Add:

14 (2) The Commissioner may make a determination under subsection (1)  
15 whether or not the application has lapsed.

16 (3) The Commissioner must not make a determination under  
17 subsection (1) without first giving each joint applicant a reasonable  
18 opportunity to be heard.

#### 19 **39 Paragraph 36(1)(a)**

20 Omit “the patent request and complete specification have not been  
21 accepted”, substitute “the patent has not been granted”.

#### 22 **40 After subsection 36(3)**

23 Insert:

24 (3A) The Commissioner may, after making a declaration under  
25 subsection (1), make any determination the Commissioner thinks  
26 fit for enabling the application to proceed in the name of one or  
27 more of the declared persons.

#### 28 **41 After subsection 38(1)**

29 Insert:

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1 (1A) A Convention application must be made within the prescribed  
2 period.

## 3 **42 After subsection 40(3)**

4 Insert:

5 (3A) The claim or claims must not rely on references to descriptions or  
6 drawings unless absolutely necessary to define the invention.

## 7 **43 Subsections 43(5) and (6)**

8 Repeal the subsections, substitute:

9 (5) If, at the time when a Convention application or a PCT application  
10 is made in respect of an invention:

- 11 (a) an application (the *earlier application*) has been made for  
12 protection in respect of the invention in a Convention  
13 country; and  
14 (b) the earlier application was made in the prescribed period; and  
15 (c) the earlier application has been withdrawn, abandoned or  
16 refused without becoming open to public inspection; and  
17 (d) the earlier application has not been used as the basis of  
18 claiming a right of priority in a Convention country under a  
19 law of that country; and  
20 (e) a later application has been made by the same applicant for  
21 protection in respect of the invention in a Convention  
22 country;

23 the earlier application is taken, for the purposes of this Act, to have  
24 never been made.

25 Note: For the purposes of paragraph (e), the later application need not have  
26 been made in the same Convention country as the earlier application.

## 27 **44 After section 43**

28 Insert:

### 29 **43AA Disclosure in basic applications**

30 *Prescribed documents relating to basic applications*

31 (1) The regulations may prescribe documents that relate to a basic  
32 application.

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1                    *Disclosures in prescribed documents may generally be taken into*  
2                    *account*

3                    (2) Without limiting the documents or disclosures that may be taken  
4                    into account for the purposes of this Act in relation to a basic  
5                    application, account may be taken of a disclosure in a prescribed  
6                    document that relates to a basic application.

7                    *Disclosures in prescribed documents must not be taken into*  
8                    *account if Commissioner's requirement not complied with*

9                    (3) However, if the Commissioner makes a requirement under  
10                    subsection (4) in relation to a prescribed document, account must  
11                    not be taken, for the purposes of this Act, of a disclosure in the  
12                    prescribed document unless the document has been made available  
13                    by the prescribed means and within the prescribed period.

14                    *Commissioner may require prescribed documents be made*  
15                    *available*

16                    (4) The Commissioner may require that a prescribed document relating  
17                    to a basic application be made available to the Commissioner by  
18                    the prescribed means and within the prescribed period.

19                    (5) The Commissioner may make a requirement under subsection (4)  
20                    more than once in relation to the same prescribed document.

#### 21                    **45 Subsection 45(1)**

22                    Omit "Where", substitute "Subject to subsection (1A), if".

#### 23                    **46 After subsection 45(1)**

24                    Insert:

25                    (1A) If a PCT application has been made and the prescribed  
26                    requirements have not been met, the Commissioner may decline to  
27                    examine the request and specification under subsection (1) until the  
28                    requirements have been met.

#### 29                    **47 Subsections 45(3) to (5)**

30                    Repeal the subsections.

#### 31                    **48 Section 46**

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1 Repeal the section.

2 **49 Division 2 of Part 2 of Chapter 3**

3 Repeal the Division.

4 **50 Subsections 49(3) and (4)**

5 Repeal the subsections.

6 **51 Subsection 49(6)**

7 Repeal the subsection, substitute:

8 (6) If the patent request and complete specification have not already  
9 become open to public inspection, the notice mentioned in  
10 paragraph (5)(b) must include a statement to the effect that the  
11 patent request and specification are open to public inspection.

12 **52 After section 49**

13 Insert:

14 **49A Postponing acceptance of patent request: standard patent**

15 (1) The Commissioner may postpone acceptance of a patent request  
16 and complete specification:

17 (a) on his or her own initiative; or

18 (b) if requested to do so in writing by the applicant.

19 (2) If the Commissioner postpones acceptance on his or her own  
20 initiative, he or she must specify a day to which acceptance is  
21 postponed.

22 (3) If the Commissioner postpones acceptance following a request by  
23 the applicant, the Commissioner may specify a day to which  
24 acceptance is postponed.

25 (4) The day specified under subsection (2) or (3) cannot be a day that  
26 is after the end of the period prescribed for the purposes of  
27 paragraph 142(2)(e).

28 (5) If:

29 (a) acceptance is postponed under subsection (1) following a  
30 request by the applicant; and

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- 1 (b) the Commissioner has not specified a day to which  
2 acceptance is postponed;  
3 the Commissioner is not required to accept the patent request and  
4 complete specification unless the applicant withdraws the request  
5 in writing.

6 Note: If the applicant does not withdraw the request before the day  
7 prescribed by the regulations, the application lapses: see paragraph  
8 142(2)(e).

### 9 **53 After section 50**

10 Insert:

### 11 **50A Revocation of acceptance**

- 12 (1) The Commissioner may revoke the acceptance of a patent request  
13 and complete specification relating to an application for a standard  
14 patent if the Commissioner is satisfied that:  
15 (a) a patent has not been granted on the application; and  
16 (b) the request and specification should not have been accepted,  
17 taking account of all the circumstances that existed when the  
18 request and specification were accepted (whether or not the  
19 Commissioner knew then of their existence); and  
20 (c) it is reasonable to revoke the acceptance, taking account of  
21 all the circumstances.
- 22 (2) If the Commissioner revokes the acceptance:  
23 (a) the patent request and complete specification are taken to  
24 have never been accepted; and  
25 (b) the Commissioner must continue to examine, and report on,  
26 the application under section 45; and  
27 (c) sections 49 and 50 continue to apply in relation to the request  
28 and specification.

### 29 **54 At the end of section 51**

30 Add “(other than a decision under section 50A)”.

### 31 **55 Section 53**

32 Repeal the section, substitute:

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1 **53 Publication of certain information about applicants etc.**

2 (1) If a patent application (other than a PCT application) is made, the  
3 Commissioner must publish in the *Official Journal* the prescribed  
4 information about the applicant and the application.

5 (2) The regulations may make provision for and in relation to the  
6 publication of information relating to PCT applications.

7 **56 Subsection 55(3)**

8 Omit “section 90”, substitute “section 56A”.

9 **57 After section 56**

10 Insert:

11 **56A Publication and inspection of PCT applications**

12 (1) The regulations may make provision for and in relation to the  
13 public inspection of PCT applications.

14 (2) Without limiting subsection (1), the regulations may make  
15 provision for and in relation to:

16 (a) notices regarding the opening of complete specifications  
17 relating to PCT applications to public inspection; and

18 (b) the circumstances in which PCT applications are taken to  
19 have become open to public inspection.

20 **58 At the end of subsection 57(1)**

21 Add:

22 (5) For the purposes of applying this section to a PCT application,  
23 references to the complete specification becoming open to public  
24 inspection are references to the PCT application becoming open to  
25 public inspection in accordance with regulations made for the  
26 purposes of section 56A.

27 **59 Subsection 61(1)**

28 Omit “by sealing a standard patent in the approved form”, substitute “by  
29 registering prescribed particulars of the patent in the Register”.

30 **60 At the end of section 61**

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1 Add:

2 (3) The Commissioner must notify the patentee that the standard  
3 patent has been granted.

#### 4 **61 Subsection 62(1)**

5 Omit “by sealing an innovation patent in the approved form”, substitute  
6 “by registering prescribed particulars of the patent in the Register”.

#### 7 **62 At the end of section 62**

8 Add:

9 (4) The Commissioner must notify the patentee that the innovation  
10 patent has been granted.

#### 11 **63 Section 66**

12 Repeal the section.

#### 13 **64 Subsection 79C(1)**

14 Omit “sealed”, substitute “granted”.

#### 15 **65 Subsection 81(3)**

16 Omit “sealed” (wherever occurring), substitute “granted”.

#### 17 **66 Chapter 8**

18 Repeal the Chapter.

#### 19 **67 Section 101D**

20 Repeal the section.

#### 21 **68 After section 101E**

22 Insert:

#### 23 **101EA Revocation of certificate of examination**

24 (1) The Commissioner may revoke a certificate of examination issued  
25 in relation to an innovation patent if the Commissioner is satisfied  
26 that:

27 (a) the certificate of examination should not have been issued,  
28 taking account of all the circumstances that existed when the

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- 1 certificate was issued (whether or not the Commissioner  
2 knew then of their existence); and  
3 (b) it is reasonable to revoke the certificate, taking account of all  
4 the circumstances; and  
5 (c) there are no relevant proceedings pending.
- 6 (2) If the Commissioner revokes the certificate:  
7 (a) all of the provisions of section 101E are taken, after  
8 revocation, to have never operated in relation to the patent;  
9 and  
10 (b) the Commissioner must continue to examine and report on  
11 the patent under section 101B; and  
12 (c) sections 101E and 101F continue to apply in relation to the  
13 patent.

## 14 **69 Subsection 102(2C)**

15 Repeal the subsection.

## 16 **70 Subsection 105(1)**

17 Omit “the patent,”.

## 18 **71 Subsection 105(6)**

19 Omit “patent,”.

## 20 **72 Sections 125 to 127**

21 Repeal the sections, substitute:

## 22 **125 Application for non-infringement declaration**

- 23 (1) A person who has done, is doing, or is intending to do an act may  
24 apply to a prescribed court for a declaration that the doing of the  
25 act does not, or would not, infringe a patent.
- 26 (2) An application may be made:  
27 (a) for a declaration in relation to an invention claimed in a  
28 standard patent—at any time after the patent has been  
29 granted; and  
30 (b) for a declaration in relation to an innovation patent—at any  
31 time after the patent has been certified; and

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1 (c) whether or not the patentee has made any assertion to the  
2 effect that the doing of the act has or would infringe the  
3 claim.

4 (3) The patentee must be joined as a respondent in the proceedings.

#### 5 **126 Proceedings for non-infringement declarations**

6 (1) A prescribed court must not make a non-infringement declaration  
7 unless:

8 (a) the applicant for the declaration:

9 (i) has asked the patentee in writing for a written admission  
10 that the doing of the act has not infringed, or would not  
11 infringe, the patent; and

12 (ii) has given the patentee full written particulars of the act  
13 done, or proposed to be done; and

14 (iii) has undertaken to pay a reasonable sum for the  
15 patentee's expenses in obtaining advice about whether  
16 the act has infringed or would infringe the claim; and

17 (b) the patentee has refused or failed to make the admission.

18 (2) The validity of a claim may be questioned in proceedings for a  
19 non-infringement declaration.

20 (3) The court may make orders as to costs as the court thinks fit.

#### 21 **127 Effect of non-infringement declarations**

22 If:

23 (a) a patentee has given a person a written admission that the  
24 doing of an act has not infringed, or would not infringe, a  
25 claim, or a prescribed court has made a non-infringement  
26 declaration in respect of an invention; and

27 (b) the patentee later gets an injunction restraining the person  
28 from doing the act as specified in the admission, or the  
29 declaration is revoked;

30 the person is not liable:

31 (c) to account to the patentee for any profits, made by the person  
32 before the date on which the injunction was granted or the  
33 declaration was revoked, from the doing of the act as  
34 specified in the admission or declaration; or



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1 (d) to pay damages for any loss suffered by the patentee before  
2 that date as a result of the doing of that act.

3 **73 Subsection 135(2)**

4 Omit “sealed”, substitute “granted”.

5 **74 Subsection 141(2)**

6 Omit “A”, substitute “Subject to subsection (3), a”.

7 **75 At the end of section 141**

8 Add:

9 (3) The regulations may prescribe additional circumstances in which  
10 PCT applications may be withdrawn, or are to be taken to be  
11 withdrawn.

12 **76 Paragraph 142(2)(c)**

13 Repeal the paragraph.

14 **77 At the end of subsection 142(2)**

15 Add:

16 ; or (f) if the application is a PCT application—prescribed  
17 circumstances apply to the application.

18 **78 After section 191**

19 Insert:

20 **191A Commissioner’s power to rectify register**

21 (1) The Commissioner may rectify the Register if the Commissioner is  
22 satisfied, whether on application or otherwise, of any of the  
23 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.

28 (2) The Commissioner must, on application, rectify the register if the  
29 Commissioner is satisfied that the Register does not properly  
30 record a person’s entitlement to a patent, or a share in a patent:

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- 1 (a) because the patent, or a share in the patent, was granted to a  
2 person who was not entitled to it; or  
3 (b) the patent, or a share in the patent, was not granted to a  
4 person who was entitled to it; or  
5 (c) for any other reason.
- 6 (3) The Commissioner must not rectify the Register under this section  
7 without first giving the following persons a reasonable opportunity  
8 to be heard:  
9 (a) the person whose entitlement is not properly recorded by the  
10 Register;  
11 (b) any person whose entitlement to the patent, or a share in the  
12 patent, is recorded in the Register.
- 13 (4) The Commissioner must not rectify the Register under this section  
14 while relevant proceedings in relation to the patent are pending.
- 15 (5) An appeal lies to the Federal Court against a decision of the  
16 Commissioner to rectify, or not rectify, the Register under this  
17 section.

### 79 At the end of Chapter 19

18 Add:  
19

#### 20 197AA Evidence of matters arising under PCT

21 A certificate signed by the Commissioner in relation to an  
22 international application, certifying that:

- 23 (a) any matter or thing required or permitted by or under this Act  
24 or the PCT to be made or done has been made or done; or  
25 (b) any matter or thing required by or under this Act or the PCT  
26 not to be made or done has not been made or done;  
27 is prima facie evidence of the matters contained in the certificate.

#### 28 80 Subsection 205(2)

29 Repeal the subsection, substitute:

- 30 (2) The Commissioner may establish one or more sub-offices of the  
31 Patent Office as the Commissioner considers appropriate.
- 32 (3) The Commissioner may abolish any such sub-offices.

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1 **81 Section 214**

2 Repeal the section, substitute:

3 **214 Filing of documents**

4 A document may be filed with the Patent Office by:

- 5 (a) delivering the document to the Patent Office or a sub-office  
6 of the Patent Office (if any) either personally or by post; or  
7 (b) any other prescribed means.

8 **82 Subsection 215(3)**

9 Omit “the patent by”, substitute “the Register by”.

10 **83 Subsection 222A(1)**

11 After “of the Patent Office”, insert “(if any)”.

12 **84 At the end of subsection 223(1)**

13 Add:

- 14 ; or (d) the receiving Office; or  
15 (e) the International Bureau of the World Intellectual Property  
16 Organization.

17 **85 Paragraph 224(1)(a)**

18 Omit “, 52 or 66, subsection 74(3)”, substitute “or 52, subsection  
19 56(1)(b), 74(3)”.

20 **86 Section 226**

21 Repeal the section, substitute:

22 **226 Documents open to public inspection do not infringe copyright**

23 (1) If a document mentioned in subsection (2) is open to public  
24 inspection, doing any of the following in relation to the whole or  
25 part of the document does not constitute an infringement of any  
26 copyright subsisting under the *Copyright Act 1968* in any literary  
27 or artistic work:

- 28 (a) reproducing the document in a material form;  
29 (b) publishing the document;

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- 1 (c) communicating (within the meaning of that Act) the  
2 document to the public;  
3 (d) making an adaptation (within the meaning of that Act) of the  
4 document.

- 5 (2) The documents are:  
6 (a) a provisional specification; and  
7 (b) a complete specification; and  
8 (c) a prescribed document.

#### 87 Subsection 227(3) (note)

9 Omit “89(3)”, substitute “29A(3)”.

#### 88 Paragraph 228(2)(f)

11 Repeal the paragraph.

#### 89 After paragraph 228(2)(ha)

13 Insert:

- 14 (i) setting out the checking process for PCT applications  
15 including, in particular, the following matters:  
16 (i) specifying the requirements that must be met in respect  
17 of a PCT application, once the requirements of  
18 subsection 29A(5) have been met;  
19 (ii) empowering the Commissioner to direct an applicant to  
20 do such things as are necessary to ensure that the PCT  
21 application is in accordance with those requirements;  
22 (iii) providing for the lapsing of the PCT application if such  
23 a direction is not complied with within a time specified  
24 in the regulations;  
25

#### 90 Subsections 228(5) and (6)

26 Repeal the subsections.

#### 91 Schedule 1 (at the end of the definition of *Budapest Treaty*)

28 Add:

29 Note: The text of the Treaty is set out in Australian Treaty Series 1987 No. 9  
30 ([1987] ATS 9). In 2011, the text of a Treaty in the Australian Treaty  
31 Series was accessible through the Australian Treaties Library on the  
32 AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).  
33  
34

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1 **92 Schedule 1 (definition of *Convention application*)**

2 Omit “Part 2 of Chapter 8”, substitute “Part 1 of Chapter 3”.

3 **93 Schedule 1 (definition of *Convention country*)**

4 Repeal the definition, substitute:

5 *Convention country* has the meaning given by section 29B.

6 **94 Schedule 1 (paragraph (a) of the definition of *examination*)**

7 Omit “, or a modified examination of the request and specification  
8 under section 48”.

9 **95 Schedule 1 (definition of *foreign patent office*)**

10 Repeal the definition.

11 **96 Schedule 1 (definition of *international filing date*)**

12 Repeal the definition, substitute:

13 *international filing date*, in relation to an international application,  
14 means the date given to the international application as its  
15 international filing date under the PCT.

16 **97 Schedule 1 (definition of *modified examination*)**

17 Repeal the definition.

18 **98 Schedule 1 (at the end of the definition of *PCT*)**

19 Add:

20 Note: The text of the Treaty is set out in Australian Treaty Series 1980 No. 6  
21 ([1980] ATS 6). In 2011, the text of a Treaty in the Australian Treaty  
22 Series was accessible through the Australian Treaties Library on the  
23 AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).

24 **99 Schedule 1 (definition of *PCT application*)**

25 Repeal the definition, substitute:

26 *PCT application* means an international application in which  
27 Australia is specified as a designated State under Article 4(1)(ii) of  
28 the PCT.

29 **100 Schedule 1 (sub-subparagraph (b)(ii)(B) of the definition  
30 of *prior art base*)**

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1 After “published”, insert “on or”.

2 **101 Schedule 1 (sub subparagraph (b)(ii)(C) of the definition**  
3 **of *prior art base*)**

4 Omit “and when it was published”.

5 **102 Schedule 1 (definition of *sealed*)**

6 Repeal the definition.

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

8 **103 Subsection 3(1) (definition of *Convention*)**

9 Repeal the definition, substitute:

10 *Convention* means the International Convention for the Protection  
11 of New Varieties of Plants, done at Geneva on 23 October 1978, as  
12 that treaty is in force for Australia from time to time.

13 Note: The text of the Convention is set out in Australian Treaty Series 1989  
14 No. 2 ([1989] ATS 2). In 2011, the text of a Convention in the  
15 Australian Treaty Series was accessible through the Australian  
16 Treaties Library on the AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).

17 **104 Subsection 43(10)**

18 Insert:

19 *authority* has the same meaning as in the Convention.

20 **105 Subsection 43(10)**

21 Insert:

22 *territory* has the same meaning as in the Convention.

23 **106 Subsection 43(10)**

24 Insert:

25 *variety* has the same meaning as in the Convention.

26 **107 Schedule**

27 Repeal the schedule.

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1 ***Trade Marks Act 1995***

2 **108 Subsection 6(1) (definition of *Convention country*)**

3 Repeal the definition, substitute:

4 *Convention country* means a foreign country or region of a kind  
5 prescribed by the regulations.

6 **109 At the end of section 6**

7 Add:

8 (3) Despite subsection 14(2) of the *Legislative Instruments Act 2003*,  
9 regulations made for the purposes of the definition of *Convention*  
10 *country* in subsection (1) may make provision in relation to a  
11 matter by applying, adopting or incorporating, with or without  
12 modification, any matter contained in any other instrument or other  
13 writing as in force or existing from time to time.

14 **110 Subsection 27(4)**

15 After “sub-offices”, insert “(if any)”.

16 **111 Section 35**

17 After “Federal Court”, insert “or the Federal Magistrates Court”.

18 **112 Section 41**

19 Repeal the section, substitute:

20 **41 Trade mark not distinguishing applicant’s goods or services**

21 (1) An application for the registration of a trade mark must be rejected  
22 if the trade mark is not capable of distinguishing the applicant’s  
23 goods or services in respect of which the trade mark is sought to be  
24 registered from the goods or services of other persons.

25 Note: For *goods of a person* and *services of a person* see section 6.

26 (2) A trade mark is capable of distinguishing the applicant’s goods or  
27 services from the goods or services of other persons if:

28 (a) the trade mark is inherently adapted to distinguish the goods  
29 or services from the goods or services of other persons; or

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## Schedule 6 Simplifying the IP system

### Part 1 Amendments

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- 1 (b) the trade mark does or will distinguish the designated goods  
2 or services as being those of the applicant because of the  
3 combined effect of the following:  
4 (i) the extent to which the trade mark is inherently adapted  
5 to distinguish the goods or services from the goods or  
6 services of other persons;  
7 (ii) the use, or intended use, of the trade mark by the  
8 applicant;  
9 (iii) any other circumstances; or  
10 (c) the applicant has used the trade mark before the filing date in  
11 respect of the application to such an extent that the trade  
12 mark does distinguish the designated goods or services as  
13 being those of the applicant.

- 14 Note 1: Trade marks that are not inherently adapted to distinguish goods or  
15 services are mostly trade marks that consist wholly of a sign that is  
16 ordinarily used to indicate:  
17 (a) the kind, quality, quantity, intended purpose, value, geographical  
18 origin, or some other characteristic, of goods or services; or  
19 (b) the time of production of goods or of the rendering of services.  
20 Note 2: For *goods of a person* and *services of a person* see section 6.  
21 Note 3: Use of a trade mark by a predecessor in title of an applicant and an  
22 authorised use of a trade mark by another person are each taken to be  
23 use of the trade mark by the applicant (see subsections (3) and 7(3)  
24 and section 8).

- 25 (3) For the purposes of this section, the use of a trade mark by a  
26 predecessor in title of an applicant for the registration of the trade  
27 mark is taken to be a use of the trade mark by the applicant.

- 28 Note 1: For *applicant* and *predecessor in title* see section 6.  
29 Note 2: If a predecessor in title had authorised another person to use the trade  
30 mark, any authorised use of the trade mark by the other person is  
31 taken to be a use of the trade mark by the predecessor in title (see  
32 subsection 7(3) and section 8).

### 33 **113 Section 56**

34 After “Federal Court”, insert “or the Federal Magistrates Court”.

### 35 **114 Section 67**

36 After “Federal Court”, insert “or the Federal Magistrates Court”.

### 37 **115 Subsection 83(2)**



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Simplifying the IP system **Schedule 6**  
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1 After “Federal Court”, insert “or the Federal Magistrates Court”.

2 **116 Subsection 83A(8)**

3 After “Federal Court”, insert “or the Federal Magistrates Court”.

4 **117 Section 84D**

5 After “Federal Court”, insert “or the Federal Magistrates Court”.

6 **118 Section 104**

7 After “Federal Court”, insert “or the Federal Magistrates Court”.

8 **119 After paragraph 190(a)**

9 Insert:

10 (aa) the Federal Magistrates Court;

11 **120 Subsection 191(2)**

12 Repeal the subsection, substitute:

13 (2) The jurisdiction of the Federal Court to hear and determine appeals  
14 against decisions, directions or orders of the Registrar is exclusive  
15 of the jurisdiction of any other court except the jurisdiction of:

16 (a) the Federal Magistrates Court under subsection 191A(2) of  
17 this Act; and

18 (b) the High Court under section 75 of the Constitution.

19 **121 After section 191**

20 Insert:

21 **191A Jurisdiction of the Federal Magistrates Court**

22 (1) The Federal Magistrates Court has jurisdiction with respect to  
23 matters arising under this Act.

24 (2) The jurisdiction of the Federal Magistrates Court to hear and  
25 determine appeals against decisions, directions or orders of the  
26 Registrar is exclusive of the jurisdiction of any other court except  
27 the jurisdiction of:

28 (a) the Federal Court under subsection 191(2) of this Act; and

29 (b) the High Court under section 75 of the Constitution.

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### Part 1 Amendments

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- 1 (3) A prosecution for an offence against this Act may not be started in  
2 the Federal Magistrates Court.

#### 3 **122 Subsection 192(1)**

4 After “Federal Court”, insert “and the Federal Magistrates Court”.

#### 5 **123 Section 193**

6 After “191”, insert “, 191A”.

#### 7 **124 At the end of section 194**

8 Add:

- 9 (3) This section does not apply in relation to a transfer of proceedings  
10 between the Federal Court and the Federal Magistrates Court.

11 Note: For transfers of proceedings from the Federal Magistrates Court to the  
12 Federal Court, see section 39 of the *Federal Magistrates Act 1999*. For  
13 transfers of proceedings from the Federal Court to the Federal  
14 Magistrates Court, see section 32AB of the *Federal Court of Australia*  
15 *Act 1976*.

#### 16 **125 Subsection 195(2)**

17 After “single judge of the Federal Court”, insert “or the Federal  
18 Magistrates Court”.

#### 19 **126 Section 196**

20 After “Federal Court”, insert “or the Federal Magistrates Court”.

#### 21 **127 Section 197**

22 After “Federal Court”, insert “or the Federal Magistrates Court”.

23 Note: The heading to section 197 is altered by inserting “**and Federal Magistrates Court**”  
24 after “**Federal Court**”.

#### 25 **128 Subsection 199(2)**

26 Repeal the subsection, substitute:

27 (2) The Registrar may establish one or more sub-offices of the Trade  
28 Marks Office as the Registrar considers appropriate.

29 (3) The Registrar may abolish any such sub-offices.

#### 30 **129 Subsections 213(1) and (2)**

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Amendments **Part 1**

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1 Repeal the subsections, substitute:

2 A document may be filed with the Trade Marks Office by:

3 (a) delivering the document to any sub-office of the Trade Marks  
4 Office (if any) either personally or by post; or

5 (b) any other prescribed means.

6 **130 Subsection 223A(1)**

7 After “Trade Marks Office” (second occurring), insert “(if any)”.

8 **131 Subsection 225(1)**

9 Repeal the subsection.

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Schedule 6 Simplifying the IP system

Part 2 Application and savings provisions

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## Part 2—Application and savings provisions

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### 132 Application provisions

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(1) The amendment made by item 28 of this Schedule applies in relation to a use of an invention on or after the day on which this Schedule commences.

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(2) The amendments made by items 29, 33, 34, 41, 45, 46, 55, 56, 57, 58, 66, 74, 75, 77, 79, 84, 87, 89, 92, 96 and 99 of this Schedule apply in relation to applications made on or after the day this Schedule commences.

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(3) The amendments made by items 30 and 78 of this Schedule apply after the commencement of this Schedule in relation to patents granted before, on or after that commencement.

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(4) The amendments made by items 31 and 32 of this Schedule apply in relation to information that is made publicly available on or after the day on which this Schedule commences.

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(5) The amendments made by items 35, 36, 37 and 38 of this Schedule apply in relation to disputes arising on or after the commencement of this Schedule.

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(6) The amendments made by items 39 and 40 of this Schedule apply in relation to declarations made on or after the commencement of this Schedule.

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(7) The amendments made by items 42 and 101 of this Schedule apply in relation to:

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(a) patents for which the complete application is made on or after the day on which this Schedule commences; and

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(b) standard patents for which the application is made before the day on which this Schedule commences, if the Commissioner has not reported under section 45 of the *Patents Act 1990* on the patent request and complete specification to which the application relates on or before that day; and

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(c) innovation patents granted on or after the day this Schedule commences, if the complete application to which the patent relates is made before that day; and

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Simplifying the IP system **Schedule 6**  
Application and savings provisions **Part 2**

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- 1 (d) complete patent applications made on or after the day this  
2 Schedule commences; and
- 3 (e) complete applications for standard patents made before the  
4 day this Schedule commences, if the Commissioner has not  
5 reported under section 45 of the *Patents Act 1990* on the  
6 patent request and complete specification to which the  
7 application relates on or before that day; and
- 8 (f) complete applications for innovation patents made before the  
9 day this Schedule commences, if a patent has not been  
10 granted in relation to the application on or before that day;  
11 and
- 12 (g) innovation patents granted before the day this Schedule  
13 commences, if the Commissioner has not reported under  
14 section 101B of the *Patents Act 1990* on the complete  
15 specification to which the innovation patent relates on or  
16 before that day.
- 17 (8) The amendment made by item 43 of this Schedule applies in relation to  
18 applications filed, and patents granted, before, on or after the day this  
19 Schedule commences.
- 20 (9) The amendments made by items 59, 60, 61, 62 and 63 of this Schedule  
21 apply in relation to patents granted on or after the day this Schedule  
22 commences.
- 23 (10) The amendments made by items 53 and 54 of this Schedule apply in  
24 relation to applications accepted on or after the day this Schedule  
25 commences.
- 26 (11) The amendment made by item 68 of this Schedule applies in relation to  
27 patents certified on or after the day this Schedule commences.
- 28 (12) The amendment made by item 72 of this Schedule applies in relation to  
29 applications for non-infringement declarations made on or after the day  
30 this Schedule commences.

## 31 **133 Savings provision—modified examinations**

- 32 (1) This item applies if:
- 33 (a) a request for a modified examination had been made under  
34 section 47 of the *Patents Act 1990* (as in force immediately  
35 before the commencement of this Schedule) in relation to an  
36 application; and

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Schedule 6 Simplifying the IP system

Part 2 Application and savings provisions

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- 1 (b) the modified examination:
- 2 (i) had not yet commenced at the time of that
- 3 commencement; or
- 4 (ii) had commenced but the application had not been
- 5 accepted at the time of that commencement.
- 6 (2) Despite the amendment made by item 49 of this Schedule, Division 2 of
- 7 Part 2 of Chapter 3 of the *Patents Act 1990* (as in force immediately
- 8 before the commencement of this Schedule) continues to apply in
- 9 relation to the application as if that amendment had not been made.