



# **Intellectual Property Laws Amendment (Raising the Bar) Act 2012**

**No. 35, 2012**

**An Act to amend legislation relating to intellectual  
property, and for related purposes**

Note: An electronic version of this Act is available in ComLaw (<http://www.comlaw.gov.au/>)



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# Intellectual Property Laws Amendment (Raising the Bar) Act 2012

No. 35, 2012

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## **An Act to amend legislation relating to intellectual property, and for related purposes**

[Assented to 15 April 2012]

The Parliament of Australia enacts:

### **1 Short title**

This Act may be cited as the *Intellectual Property Laws  
Amendment (Raising the Bar) Act 2012*.

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## 2 Commencement

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

<b>Commencement information</b>		
<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
<b>Provision(s)</b>	<b>Commencement</b>	<b>Date/Details</b>
1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table	The day this Act receives the Royal Assent.	15 April 2012
2. Schedule 1	The day after the end of the period of 12 months beginning on the day this Act receives the Royal Assent.	15 April 2013
3. Schedule 2	The day after this Act receives the Royal Assent.	16 April 2012
4. Schedules 3 to 5	The day after the end of the period of 12 months beginning on the day this Act receives the Royal Assent.	15 April 2013
5. Schedule 6, items 1 to 86	The day after the end of the period of 12 months beginning on the day this Act receives the Royal Assent.	15 April 2013
6. Schedule 6, item 87	The day after this Act receives the Royal Assent.	16 April 2012
7. Schedule 6, items 88 to 134	The day after the end of the period of 12 months beginning on the day this Act receives the Royal Assent.	15 April 2013

Note: This table relates only to the provisions of this Act as originally enacted.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

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

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### **3 Schedule(s)**

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

## Schedule 1—Raising the quality of granted patents

### Part 1—Main amendments

#### *Patents Act 1990*

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

Insert “preliminary search and opinion”.

##### **2 Subsection 7(2)**

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

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

##### **3 Subsection 7(3)**

Repeal the subsection, substitute:

- (3) The information for the purposes of subsection (2) is:
- (a) any single piece of prior art information; or
  - (b) a combination of any 2 or more pieces of prior art information that the skilled person mentioned in subsection (2) could, before the priority date of the relevant claim, be reasonably expected to have combined.

##### **4 Subsection 7(4)**

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

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

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

##### **6 After section 7**

Insert:



## **7A Meaning of useful**

- (1) For the purposes of this Act, an invention is taken not to be useful unless a specific, substantial and credible use for the invention (so far as claimed) is disclosed in the complete specification.
- (2) The disclosure in the complete specification must be sufficient for that specific, substantial and credible use to be appreciated by a person skilled in the relevant art.
- (3) Subsection (1) does not otherwise affect the meaning of the word *useful* in this Act.

## **7 Subsection 40(1)**

Repeal the subsection, substitute:

### *Requirements relating to provisional specifications*

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

## **8 Paragraph 40(2)(a)**

Repeal the paragraph, substitute:

- (a) disclose the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; and
- (aa) disclose the best method known to the applicant of performing the invention; and

## **9 Subsection 40(3)**

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

## **10 Subsection 43(2)**

Repeal the subsection, substitute:

- (2) The priority date of a claim is:
  - (a) if subsection (2A) applies to the claim—the date determined under the regulations; or
  - (b) otherwise—the date of the filing of the specification.

- (2A) This subsection applies to a claim if:
- (a) prescribed circumstances apply in relation to the invention defined in the claim; and
  - (b) a prescribed document discloses the invention in the claim in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the relevant art.

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

Insert:

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

#### **43A Preliminary search and opinion**

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

## **12 Paragraphs 45(1)(a), (b) and (c)**

Repeal the paragraphs, substitute:

- (a) whether the specification complies with subsections 40(2) to (4); and
- (b) whether, to the best of his or her knowledge, the invention, so far as claimed, satisfies the criteria mentioned in paragraphs 18(1)(a), (b) and (c); and
- (c) whether the invention is a patentable invention under subsection 18(2); and

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

Repeal the subsection.

## **14 Subsection 49(1)**

Repeal the subsection, substitute:

- (1) Subject to section 50, the Commissioner must accept a patent request and complete specification relating to an application for a standard patent if the Commissioner is satisfied, on the balance of probabilities:
- (a) that the specification complies with subsections 40(2) to (4); and
  - (b) that the invention, so far as claimed, satisfies the criteria mentioned in paragraphs 18(1)(a), (b) and (c); and
  - (c) that the invention is a patentable invention under subsection 18(2); and
  - (d) as to the matters (if any) prescribed under paragraph 45(1)(d).

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

Insert:

- (3A) If the Commissioner is satisfied, on the balance of probabilities, that a ground of opposition to the grant of the standard patent exists, the Commissioner may refuse the application.
- (3B) The Commissioner must not refuse an application under this section unless the Commissioner has, where appropriate, given the applicant a reasonable opportunity to amend the relevant specification for the purpose of removing any ground of opposition and the applicant has failed to do so.

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

Insert:

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

### **17 Section 98**

Repeal the section, substitute:

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

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

- (a) whether the specification does not comply with subsection 40(2) or (3); and

- (b) whether, to the best of his or her knowledge, the invention, so far as claimed, does not satisfy the criteria mentioned in paragraph 18(1)(a), (b) or (c); and
- (c) whether the invention is not a patentable invention under subsection 18(2).

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

Repeal the subsection, substitute:

- (1) The Commissioner may refuse to grant a patent if the Commissioner:
  - (a) makes an adverse report on a re-examination of the relevant specification under subsection 97(1); and
  - (b) is satisfied, on the balance of probabilities, that there is a lawful ground of objection to the specification.

### **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 satisfied, on the balance of probabilities, 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 subsections 40(2) to (4); 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
  - (g) the patent does not contain a claim that includes the name of a person as the name, or part of the name, of the invention so far as it is claimed in that claim; and
  - (h) the patent does not claim an invention that is the same as an invention that is the subject of a patent and is made by the same inventor, where the relevant claim or claims in respect of each patent have the same priority date or dates; and
  - (i) the complete specification complies with such other matters (if any) as are prescribed for the purpose of this paragraph.

**21 Section 101E**

Repeal the section, substitute:

**101E Certificate of examination**

- (1) This section applies to an innovation patent if:
- (a) after examining the patent under section 101B, the Commissioner decides in writing that he or she is satisfied, on the balance of probabilities, as to the following:
    - (i) the specification complies with subsections 40(2) to (4);
    - (ii) the invention, so far as claimed, complies with paragraphs 18(1A)(a), (b) and (c);
    - (iii) the invention is a patentable invention under subsections 18(2) and (3);
    - (iv) the use of the invention would not be contrary to law;

- (v) 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;
  - (vi) the patent does not claim as an invention a process producing such a substance by mere admixture;
  - (vii) the patent does not contain a claim that includes the name of a person as the name, or part of the name, of the invention so far as it is claimed in that claim;
  - (viii) the patent does not claim an invention that is the same as an invention that is the subject of a patent and is made by the same inventor, where the relevant claim or claims in respect of each patent have the same priority date or dates;
  - (ix) the complete specification complies with such other matters (if any) as are prescribed for the purpose of paragraph 101B(2)(i);
- (b) the patent has not ceased under section 143A.
- (2) If this section applies, the Commissioner must:
- (a) notify the patentee and the person who requested the examination (if that person is not the patentee) that the patent has been examined and that a certificate of examination is to be issued; and
  - (b) publish a notice of the examination having occurred in the *Official Journal*; and
  - (c) issue a certificate of examination to the patentee in the approved form; and
  - (d) register the issue of the certificate.
- (3) A decision under subsection (1) is not a legislative instrument.

## **22 Subsection 101F(1)**

Repeal the subsection, substitute:

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

### **23 After subsection 101G(1)**

Insert:

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

### **24 Subsection 101G(3)**

Repeal the subsection, substitute:

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

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

Repeal the subsection.

### **26 Subsection 101J(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 section 101G; and
  - (b) is satisfied, on the balance of probabilities, that there is a ground of revocation of the patent.

### **27 Section 101M**

Repeal the section, substitute:

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

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

- (a) that the patentee is either:
  - (i) not entitled to the patent; or
  - (ii) entitled to the patent but only in conjunction with some other person;
- (b) that the complete specification does not comply with subsection 40(2) or (3);
- (c) that the invention is not a patentable invention because it does not comply with paragraph 18(1A)(a), (b) or (c);
- (d) that the invention is not a patentable invention under subsection 18(2) or (3).

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

After “satisfied”, insert “, on the balance of probabilities,”.

### **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 certain documents*

- (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 following documents taken together:
  - (a) the complete specification as filed;
  - (b) other prescribed documents (if any).

### **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**

Repeal the section, substitute:

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

- (1) This section applies if:
- (a) a complete specification has been amended; and
  - (b) the amendment was not allowable under subsection 102(1); and
  - (c) as a result of the amendment, a claim of the amended specification claims an invention that:
    - (i) was not disclosed by the complete specification as filed in a manner that was clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; but
    - (ii) is disclosed in that manner by the amended specification.
- (2) If this section applies, the priority date of the claim must be determined under the regulations.

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

Repeal the paragraph, substitute:

- (b) the amendment was not allowable under subsection 102(1); and
- (ba) as a result of the amendment, a claim of the amended specification claims an invention that was not disclosed by the original specification as filed in a manner that was clear enough and complete enough for the invention to be performed by a person skilled in the relevant art; and

## Schedule 1 Raising the quality of granted patents

### Part 1 Main amendments

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

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

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

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

Insert:

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

#### **37 Schedule 1**

Insert:

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

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

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

## **Part 2—Balance of probabilities test**

### *Patents Act 1990*

#### **39 Paragraph 10(1)(c)**

After “is satisfied”, insert “, on the balance of probabilities,”.

#### **40 Paragraph 35(1)(b)**

After “satisfied”, insert “, on the balance of probabilities”.

#### **41 Paragraph 36(1)(c)**

After “is satisfied”, insert “on the balance of probabilities,”.

#### **42 Subsection 52(2)**

After “satisfied”, insert “, on the balance of probabilities,”.

#### **43 Subsection 74(1)**

After “is satisfied”, insert “, on the balance of probabilities,”.

#### **44 Subsection 74(3)**

After “not satisfied”, insert “, on the balance of probabilities,”.

#### **45 Subsection 103(2)**

After “if satisfied”, insert “on the balance of probabilities”.

#### **46 Paragraph 106(1)(b)**

After “is satisfied”, insert “, on the balance of probabilities,”.

#### **47 Subsection 106(4)**

After “is satisfied”, insert “, on the balance of probabilities,”.

#### **48 Paragraph 107(1)(b)**

After “is satisfied”, insert “, on the balance of probabilities,”.

#### **49 Subsection 107(4)**

After “is satisfied”, insert “, on the balance of probabilities,”.

**50 Subsection 150(2)**

After “if satisfied”, insert “, on the balance of probabilities,”.

**51 Subsection 151(2)**

After “if satisfied”, insert “, on the balance of probabilities,”.

**52 Subsection 215(3)**

After “is satisfied”, insert “, on the balance of probabilities,”.

**53 Paragraph 223(2A)(b)**

After “is satisfied”, insert “, on the balance of probabilities,”.

**54 Subsection 223(6A)**

After “is satisfied”, insert “, on the balance of probabilities,”.

## **Part 3—Application, savings and transitional provisions**

### **55 Application of amendments**

- (1) The amendments made by items 2, 3, 4, 6, 8, 9 and 10 of this Schedule apply in relation to:
- (a) patents for which the complete application is made on or after the day this Schedule commences; and
  - (b) standard patents for which the application had been made before the day this Schedule commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day; and
  - (c) innovation patents granted on or after the day this Schedule commences, if the complete application to which the patent relates had been made before that day; and
  - (d) complete patent applications made on or after the day this Schedule commences; and
  - (e) complete applications for standard patents made before the day this Schedule commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day; and
  - (f) complete applications for innovation patents made before the day this Schedule commences, if a patent had not been granted in relation to the application on or before that day; and
  - (g) innovation patents granted before the day this Schedule commences, if:
    - (i) the Commissioner had not decided to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day; and
    - (ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day.

**Schedule 1** Raising the quality of granted patents  
**Part 3** Application, savings and transitional provisions

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- (2) The amendment made by item 7 of this Schedule applies in relation to provisional applications made on or after the day this Schedule commences.
  - (3) The amendments made by items 11 and 37 of this Schedule apply in relation to complete applications for standard patents made on or after the day this Schedule commences.
  - (4) The amendments made by items 12, 13, 14, 15 and 18 of this Schedule apply in relation to:
    - (a) complete applications for standard patents made on or after the day this Schedule commences; and
    - (b) complete applications for standard patents made before the day this Schedule commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day.
  - (5) The amendments made by items 16 and 17 of this Schedule apply in relation to:
    - (a) applications for standard patents, whether the application was made before, on or after the day this Schedule commences; and
    - (b) standard patents, whether granted before, on or after that day.
  - (6) The amendment made by item 19 of this Schedule applies in relation to:
    - (a) standard patents for which the complete application is made on or after the day this Schedule commences; and
    - (b) standard patents for which the complete application had been made before the day this Schedule commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day.
  - (7) The amendments made by items 23, 24 and 25 of this Schedule apply in relation to innovation patents, whether granted before, on or after the day this Schedule commences.
  - (8) The amendments made by items 20, 21, 22, 26, 27, 28, 30, 35 and 38 of this Schedule apply in relation to:
    - (a) complete applications for innovation patents made on or after the day this Schedule commences; and
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- (b) complete applications for innovation patents made before the day this Schedule commences, if a patent had not been granted in relation to the application on or before that day; and
  - (c) innovation patents granted before the day this Schedule commences, if:
    - (i) the Commissioner had not decided to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day; and
    - (ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day; and
  - (d) innovation patents granted on complete applications for innovation patents made on or after the day this Schedule commences; and
  - (e) innovation patents granted on or after the day this Schedule commences, if the complete application to which the patent relates had been made before that day.
- (9) The amendments made by items 29 and 31 to 34 of this Schedule apply in relation to amendments of complete specifications directed or requested to be made on or after the day this Schedule commences if the amendments are in relation to:
- (a) patents for which the complete application is made on or after the day this Schedule commences; or
  - (b) standard patents for which the application had been made before the day this Schedule commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day; or
  - (c) innovation patents granted on or after the day this Schedule commences, if the complete application to which the patent relates had been made before that day; or
  - (d) complete patent applications made on or after the day this Schedule commences; or
  - (e) complete applications for standard patents made before the day this Schedule commences, if the applicant had not asked for an examination of the patent request and specification for

- the application under section 44 of the *Patents Act 1990* before that day; or
- (f) complete applications for innovation patents made before the day this Schedule commences, if a patent had not been granted in relation to the application on or before that day; or
  - (g) innovation patents granted before the day this Schedule commences, if:
    - (i) the Commissioner had not decided to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day; or
    - (ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day.
- (10) The amendments made by items 39, 41, 45, 48, 49 and 50 of this Schedule apply in relation to:
- (a) complete applications for standard patents made on or after the day this Schedule commences; and
  - (b) complete applications for standard patents made before the day this Schedule commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day.
- (11) The amendments made by item 40, 43, 44, 46, 47 and 52 apply in relation to patents granted on or after the day this Schedule commences.
- (12) The amendment made by item 42 of this Schedule applies in relation to:
- (a) complete applications for innovation patents made on or after the day this Schedule commences; and
  - (b) complete applications for innovation patents made before the day this Schedule commences, if a patent had not been granted in relation to the application on or before that day; and
  - (c) innovation patents granted before the day this Schedule commences, if:
    - (i) the Commissioner had not decided to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day; and



- (ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day.
- (13) The amendments made by items 51 and 54 of this Schedule apply in relation to applications made on or after the day this Schedule commences.
- (14) The amendment made by item 53 applies in relation to acts required to be done on or after the day this Schedule commences.

**56 Transitional provision—approved form**

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

## Schedule 2—Free access to patented inventions for regulatory approvals and research

### Part 1—Amendment

#### *Patents Act 1990*

##### **1 After section 119A**

Insert:

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

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

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

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

- (c) improving or modifying the invention;
- (d) determining the validity of the patent or of a claim relating to the invention;
- (e) determining whether the patent for the invention would be, or has been, infringed by the doing of an act.

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

### **2 Application**

The amendment made by item 1 of this Schedule applies in relation to acts done on or after the commencement of this Schedule in relation to patents granted before, on or after that commencement.

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

### **Part 1—Amendments**

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

##### **1 Subsection 26(2)**

After “112”, insert “or 112A”.

##### **2 Subsection 61(1)**

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

##### **3 Section 79B**

Repeal the section, substitute:

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

- (1) If:
  - (a) a complete application (the *first application*) for a patent is made; and
  - (b) the first application is not a divisional application for an innovation patent provided for in section 79C;  
the applicant may make a further complete application for a patent for an invention disclosed in the specification filed in relation to the first application.
- (2) The further complete application:
  - (a) must be made in accordance with the regulations made for the purposes of this subsection; and
  - (b) must include the prescribed particulars.
- (3) The further complete application can only be made during the period:
  - (a) starting on the day the first application is made; and
  - (b) ending when any of the following happens:
    - (i) the first application lapses;
    - (ii) the first application is refused;

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

(4) In this section:

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

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

Omit “, in accordance with the regulations, ”.

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

Insert:

- (1A) The further complete application:
  - (a) must be made in accordance with the regulations made for the purposes of this subsection; and
  - (b) must include the prescribed particulars.

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

Insert:

*Order for amendment during an appeal*

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

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

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

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

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

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

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

## **9 Subsection 105(5)**

Omit “patentee”, substitute “applicant”.

## **10 After section 112**

Insert:

### **112A Decisions on appeal**

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

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

## **11 Subsection 141(1)**

Repeal the subsection, substitute:

- (1) A patent application, other than a PCT application, may be withdrawn if all of the following conditions are met:
  - (a) the applicant lodges a written notice of withdrawal signed by the applicant;
  - (b) if the application has been opposed under section 59—the Commissioner has consented to the withdrawal;
  - (c) if the regulations prescribe a period within which an application must not be withdrawn—the withdrawal will not occur within the prescribed period.

## **12 Sections 179 to 181**

Repeal the sections.

## **13 Section 210**

Before “The”, insert “(1)”.

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

Add:

*Exercise of power to summon witnesses*

- (2) The Commissioner must not summon a witness under paragraph (1)(a) unless:
- (a) the Commissioner is satisfied, on the balance of probabilities, of the following matters:
    - (i) the witness has a substantial interest in the proceedings before the Commissioner;
    - (ii) the witness is likely to provide oral evidence of substantial relevance to a matter before the Commissioner;
    - (iii) receiving oral evidence from the witness is necessary or desirable in all the circumstances; and
  - (b) the Commissioner notifies the witness of the actions the Commissioner may take under section 210A if the witness fails or refuses to comply with the summons.
- (3) The Commissioner may summon a witness under paragraph (1)(a) whether the witness is in or out of the patent area.

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

- (4) The Commissioner must not require a person to produce a document or article under paragraph (1)(c) unless:
- (a) the Commissioner is satisfied, on the balance of probabilities, of the following matters:
    - (i) the person has a substantial interest in the proceedings before the Commissioner;
    - (ii) the document or article is likely to be of substantial relevance to a matter before the Commissioner; and
  - (b) the Commissioner notifies the person of the actions the Commissioner may take under section 210A if the person fails or refuses to comply with the requirement.
- (5) The Commissioner may require a person to produce a document or article under paragraph (1)(c) whether the person is in or out of the patent area.

*Exercise of powers in relation to bodies corporate*

- (6) 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.

Note: The following heading to subsection 210(1) is inserted “*Commissioner’s powers*”.

## **15 After section 210**

Insert:

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

- (1) The Commissioner may take one or more of the actions listed in subsection (2) in relation to a person if:
  - (a) the Commissioner summons the person to appear as a witness under paragraph 210(1)(a) or requires the person to produce a document or article under paragraph 210(1)(c); and
  - (b) the person refuses or fails to comply with the summons or requirement; and
  - (c) the Commissioner is satisfied, on the balance of probabilities, that it is appropriate in the circumstances to take the action.
- (2) The actions the Commissioner may take are:
  - (a) if the person is an applicant for a patent—a refusal to grant the patent (see subsection 61(1)); and
  - (b) the drawing of an inference unfavourable to the person’s interest in proceedings before the Commissioner; and
  - (c) actions of a kind that are prescribed by the regulations.
- (3) In deciding whether it is appropriate to take the action, the Commissioner must consider the following:
  - (a) whether the person has a reasonable excuse for refusing or failing to comply with the summons or requirement;
  - (b) whether the person has been offered payment of reasonable expenses associated with complying with the summons or requirement;
  - (c) any other matter the Commissioner considers to be relevant.

## **16 Subsection 224(1)**

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

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

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

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

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

Repeal the subsections, substitute:

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

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

### **19 After section 52**

Insert:

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

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

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

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

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

Add:

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

## **21 After section 54**

Insert:

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

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

## **22 Subsection 55(1)**

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

## **23 At the end of section 55**

Add:

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

## **24 Section 66**

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Before “The”, insert “(1)”.

## **25 At the end of section 66**

Add:

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

Note: Regulations made for the purposes of subsection 231(3) may make provision in relation to amendment of documents filed in relation to an opposition.

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

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

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

Add:

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

## **28 Section 96**

Repeal the section, substitute:

## **96 Notice of opposition**

### *Applications to Registrar*

- (1) Any person may oppose an application under subsection 92(1) by filing a notice of opposition with the Registrar.
- (2) The notice of opposition under subsection (1) must be filed:
  - (a) in the manner and form prescribed by the regulations; and
  - (b) within the prescribed period.
- (3) Regulations made for the purposes of paragraph (2)(a) or (b) may make different provision with respect to different components (if any) of the notice of opposition.

- (4) Subsection (3) does not limit subsection 33(3A) of the *Acts Interpretation Act 1901*.

*Applications to prescribed court*

- (5) Any person may oppose an application under subsection 92(3) by filing a notice of opposition with the court.
- (6) A notice of opposition under subsection (5):
- (a) must be in a form approved by the court; and
  - (b) must be filed in accordance with the rules of court.

**29 Subsection 97(1)**

Repeal the subsection, substitute:

- (1) If:
- (a) there is no opposition to an application to the Registrar under subsection 92(1); or
  - (b) an opposition to an application under that subsection has been dismissed (see section 99A);
- the Registrar must remove the trade mark from the Register in respect of the goods and/or services specified in the application.

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

**30 After section 99**

Insert:

**99A Dismissal of opposition filed with Registrar**

- (1) The Registrar may, in prescribed circumstances, dismiss an opposition filed with the Registrar in accordance with subsection 96(1).
- (2) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Registrar to dismiss an opposition under subsection (1).

**31 At the end of section 231**

Add:

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

## **Part 2—Application and transitional provisions**

### **32 Application of amendments**

- (1) The amendments made by items 1 and 10 of this Schedule apply in relation to:
  - (a) requests for amendments made on or after the day this Schedule commences; and
  - (b) requests for amendments made before that day, if the Commissioner had not dealt with the request on or before that day.
- (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.
- (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.
- (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.
- (5) The amendments made by items 6, 7, 8 and 9 of this Schedule apply in relation to appeals to the Federal Court:
  - (a) made on or after the day this Schedule commences; and
  - (b) made before that day, if the appeal had not been finally determined, withdrawn or otherwise disposed of.
- (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.
- (7) The amendments made by items 17 to 31 of this Schedule apply in relation to opposition proceedings commenced by notices of opposition filed on or after the day this Schedule commences.

### **33 Transitional provision—regulations**

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

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



## **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.

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

Repeal the penalty, substitute:

Penalty: 60 penalty units.

**12 Subsection 178(2) (penalty)**

Repeal the penalty, substitute:

Penalty: 60 penalty units.

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

Repeal the penalty, substitute:

Penalty: 60 penalty units.

**14 Section 183**

Before “The”, insert “(1)”.

**15 At the end of section 183**

Add:

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

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

**16 Subsection 198(4)**

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

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

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

Insert:

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

**18 Subsection 198(4)**

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

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**19 Subsection 198(7)**

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

**20 Subsection 198(7)**

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

**21 At the end of section 198**

Add:

*Registration of companies*

- (9) The Designated Manager must register as a patent attorney a company that:
- (a) has at least one patent attorney director; and
  - (b) has given the Designated Manager written notice in the approved form of its intention to act as a patent attorney; and
  - (c) meets the requirements (if any) prescribed by the regulations.
- The registration is to consist of entering the company’s name in the Register of Patent Attorneys.
- (10) A company registered as a patent attorney is an *incorporated patent attorney*.
- (11) A *patent attorney director* of a company is an individual who is both:
- (a) a registered patent attorney; and
  - (b) a validly appointed director of the company.

**22 Subsection 200(2)**

Repeal the subsection, substitute:

- (2) A communication made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a communication made for the dominant purpose of a legal practitioner providing legal advice to a client.
- (2A) A record or document made for the dominant purpose of a registered patent attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a

record or document made for the dominant purpose of a legal practitioner providing legal advice to a client.

(2B) A reference in subsection (2) or (2A) to a registered patent attorney includes a reference to an individual authorised to do patents work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided.

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

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

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

Repeal the subsection.

### **24 Section 201**

Repeal the section, substitute:

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

#### *Individuals*

- (1) An individual commits an offence if:
- (a) the individual carries on business, practises or acts as a patent attorney; and
  - (b) the individual is not a registered patent attorney or a legal practitioner.

Penalty: 30 penalty units.

- (2) An individual commits an offence if:
- (a) the individual describes himself or herself, or holds himself or herself out, or permits himself or herself to be described or held out, as a patent attorney or agent for obtaining patents; and
  - (b) the individual is not a registered patent attorney.

Penalty: 30 penalty units.

*Partnerships*

- (3) A member of a partnership commits an offence if:
- (a) the member carries on business, practises or acts as a patent attorney; and
  - (b) none of the members of the partnership is a registered patent attorney or a legal practitioner.

Penalty: 30 penalty units.

- (4) A member of a partnership commits an offence if:
- (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
  - (b) none of the members of the partnership is a registered patent attorney.

Penalty: 30 penalty units.

*Companies*

- (5) A company commits an offence if:
- (a) the company carries on business, practises or acts as a patent attorney; and
  - (b) the company is not a registered patent attorney or incorporated legal practice.

Penalty: 150 penalty units.

- (6) A company commits an offence if:
- (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
  - (b) the company is not a registered patent attorney.

Penalty: 150 penalty units.

*Exception—legal representatives*

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

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

*Exception—employees*

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

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

*Exception—related company groups*

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

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

*Whether a company is related to another company*

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

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

- (1) For the purposes of section 201, a person is taken to carry on business, practise or act as a patent attorney if, and only if, the person does, or undertakes to do, patents work in Australia.
- (2) **Patents work** means one or more of the following done, on behalf of someone else, for gain:
  - (a) applying for or obtaining patents in Australia or anywhere else;
  - (b) preparing specifications or other documents for the purposes of this Act or the patent law of another country;
  - (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.

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

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

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

Penalty: 150 penalty units.

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

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

Penalty: 150 penalty units.

*Designated Manager may appoint a registered patent attorney*

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

*Effect of appointment*

- (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.
- (6) However, for the purposes of the *Corporations Act 2001*:
  - (a) the appointed attorney is not a director of the incorporated patent attorney only because:
    - (i) the appointed attorney takes charge of the patents work of the incorporated patent attorney; and
    - (ii) the appointed attorney is taken, for the purposes of this Act, to be a patent attorney director of the incorporated patent attorney; and
  - (b) the Designated Manager is not a director of the incorporated patent attorney only because the Designated Manager appointed the appointed attorney.

*Designated Manager may remove incorporated patent attorney from Register*

- (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.

**25 Section 202 (penalty)**

Repeal the penalty, substitute:

Penalty: 30 penalty units.

**26 After section 202A**

Insert:

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

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

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

Penalty: 150 penalty units.

**27 Section 203**

Repeal the section, substitute:

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

A registered patent attorney commits an offence if:

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

Penalty: 30 penalty units.

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

Insert:

- (ia) assessing the professional conduct of registered patent attorneys by reference to standards of practice

established by the Professional Standards Board from time to time;

**29 Schedule 1**

Insert:

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

**30 Schedule 1**

Insert:

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

**31 Schedule 1**

Insert:

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

**32 Schedule 1**

Insert:

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

**33 Schedule 1**

Insert:

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

**34 Schedule 1**

Insert:

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

**35 Schedule 1**

Insert:

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

### **36 Schedule 1**

Insert:

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

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

#### **37 Readers guide (list of terms defined in section 6)**

Insert the following terms in their appropriate alphabetical positions:

“company”

“Designated Manager”

“incorporated legal practice”

“incorporated trade marks attorney”

“intellectual property advice”

“Professional Standards Board”

“trade marks attorney director”

“trade marks work”.

#### **38 Subsection 6(1)**

Insert:

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

#### **39 Subsection 6(1)**

Insert:

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

#### **40 Subsection 6(1)**

Insert:

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

**41 Subsection 6(1)**

Insert:

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

**42 Subsection 6(1)**

Insert:

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

**43 Subsection 6(1)**

Insert:

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

**44 Subsection 6(1)**

Insert:

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

**45 Subsection 6(1)**

Insert:

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

**46 Subsections 156(1) to (3)**

Repeal the subsections, substitute:

*Individuals*

- (1) An individual commits an offence if:
  - (a) the individual describes himself or herself, or holds himself or herself out, or permits himself or herself to be described or held out, as a trade marks attorney; and

(b) the individual is not a registered trade marks attorney.

Penalty: 30 penalty units.

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

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

(2) An individual commits an offence if:

(a) the individual describes himself or herself, or holds himself or herself out, or permits himself or herself to be described or held out, as a trade marks agent; and

(b) the individual is not a registered trade marks attorney, a patent attorney or a lawyer.

Penalty: 30 penalty units.

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

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

### *Companies*

(3) A company commits an offence if:

(a) the company describes itself, or holds itself out, or permits itself to be described or held out, as a trade marks attorney; and

(b) the company is not a registered trade marks attorney.

Penalty: 150 penalty units.

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

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

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

(a) the company describes itself, or holds itself out, or permits itself to be described or held out, as a trade marks agent; and

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

Penalty: 150 penalty units.

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

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

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

## **47 After section 157**

Insert:

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

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

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

Penalty: 150 penalty units.

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

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

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

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

Penalty: 150 penalty units.

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

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

*Designated Manager may appoint a registered trade marks attorney*

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

*Effect of appointment*

- (5) A registered trade marks attorney holding an appointment under subsection (3) (the **appointed attorney**) is taken, for the purposes of this Act, to be a trade marks attorney director of the incorporated trade marks attorney.
- (6) For the purposes of the *Corporations Act 2001*:
  - (a) the appointed attorney is not a director of the incorporated trade marks attorney only because:
    - (i) the appointed attorney takes charge of the trade marks work of the incorporated trade marks attorney; and
    - (ii) the appointed attorney is taken, for the purposes of this Act, to be a trade marks attorney director of the incorporated trade marks attorney; and
  - (b) the Designated Manager is not a director of the incorporated trade marks attorney only because the Designated Manager appointed the appointed attorney.

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

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

*Meaning of trade marks work*

- (8) **Trade marks work** means one or more of the following done, on behalf of someone else, for gain:
  - (a) applying for or obtaining trade marks in Australia or anywhere else;

- (b) preparing trade marks applications or other documents for the purposes of this Act or the trade marks law of another country;
- (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of trade marks.

**48 Subsection 228A(1) (note)**

Repeal the note, substitute:

Note: For *Designated Manager* see section 6.

**49 Subsection 228A(4)**

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

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

**50 After paragraph 228A(4)(d)**

Insert:

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

**51 Subsection 228A(4)**

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

**52 At the end of subsection 228A(5)**

Add:

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

**53 After subsection 228A(6)**

Insert:

*Registration of companies*

- (6A) The Designated Manager must register as a trade marks attorney a company that:
- (a) has at least one trade marks attorney director; and
  - (b) has given the Designated Manager written notice in the approved form of its intention to act as a trade marks attorney; and
  - (c) meets the requirements (if any) prescribed by the regulations.
- The registration is to consist of entering the company’s name in the Register of Trade Marks Attorneys.



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

- (6B) A company registered as a trade marks attorney is an *incorporated trade marks attorney*.
- (6C) A *trade marks attorney director* of a company is an individual who is both:
- (a) a registered trade marks attorney; and
  - (b) a validly appointed director of the company.

#### **54 Subsection 228A(9)**

Repeal the subsection.

#### **55 Subsection 229(1)**

Repeal the subsection, substitute:

- (1) A communication made for the dominant purpose of a registered trade marks attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a communication made for the dominant purpose of a lawyer providing legal advice to a client.
- (1A) A record or document made for the dominant purpose of a registered trade marks attorney providing intellectual property advice to a client is privileged in the same way, and to the same extent, as a record or document made for the dominant purpose of a lawyer providing legal advice to a client.
- (1B) A reference in subsection (1) or (1A) to a registered trade marks attorney includes a reference to an individual authorised to do trade marks work under a law of another country or region, to the extent to which the individual is authorised to provide intellectual property advice of the kind provided.

#### **56 Subsection 229(3)**

Repeal the subsection, substitute:

- (3) *Intellectual property advice* means advice in relation to:
- (a) patents; or
  - (b) trade marks; or
  - (c) designs; or
  - (d) plant breeder's rights; or

- (e) any related matters.
- (4) Nothing in this section authorises a registered trade marks attorney to prepare a document to be issued from or filed in a court or to transact business, or conduct proceedings, in a court.

## **57 After section 229**

Insert:

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

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

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

## **58 After subparagraph 231(2)(ha)(i)**

Insert:

- (ia) assessing the professional conduct of registered trade marks attorneys by reference to standards of practice established by the Professional Standards Board from time to time;

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

### **Part 1—Customs seizure**

#### *Copyright Act 1968*

##### **1 Section 134B**

Insert:

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

##### **2 Section 134B**

Insert:

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

##### **3 Section 134B**

Insert:

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

##### **4 Section 134B**

Insert:

*working day* means a day that is not:

- (a) a Saturday; or
- (b) a Sunday; or
- (c) a public holiday in the Australian Capital Territory.

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

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

## 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 (whether in or outside Australia) that made arrangements, on behalf of the importer, 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)

Omit “other information”, substitute “information (including personal information)”.

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

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

**10 Subsection 135AD(4)**

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

**11 Subsection 135AD(5)**

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

**12 Subsection 135AE(3)**

Omit all the words after “the Commonwealth”.

**13 Section 135AF**

Repeal the section, substitute:

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

- (1) The importer may make a claim to the CEO for the release of seized copies.
- (2) The claim must be made before the end of the claim period for the copies.
- (3) The claim must:
  - (a) be in the form (if any) prescribed by the regulations; and
  - (b) include the information prescribed by the regulations.

Note: Sections 137.1 and 137.2 of the *Criminal Code* create offences for providing false or misleading information or documents.

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

- (1) Seized copies are forfeited to the Commonwealth if a claim for the release of the goods is not made within the claim period for the copies.
- (2) However, if the CEO allows a late claim for the copies (see section 135AEC), the copies are taken not to have been forfeited.

**135AEC Late claim for release of seized goods**

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

**135AED Objector to be notified of claim**

- (1) If the importer makes a claim for the release of seized copies, the CEO must, as soon as practicable, give notice of the claim to the objector.
- (2) The notice:
  - (a) must be in writing; and
  - (b) may include any information that the CEO has, and believes on reasonable grounds may be relevant, for the purpose of identifying and locating either or both of the following:
    - (i) the importer of the copies;
    - (ii) any other person or body (whether in or outside Australia) that made arrangements for the copies to be brought to Australia.

**135AF Release of seized copies to importer**

- (1) The CEO must release seized copies to the importer if:
  - (a) the objector gives written notice to the CEO stating that the objector consents to the release of the seized copies; and
  - (b) the copies have not been disposed of under section 135AI.
- (2) The CEO may release seized copies to the importer at any time if:
  - (a) the CEO, having regard to information that has come to his or her knowledge after the copies were seized, is satisfied that there are no reasonable grounds for believing that copyright has been infringed by the importation of the copies; and

- (b) the objector has not brought an action for infringement of copyright in relation to the copies.
- (3) The CEO must release seized copies to the importer if:
  - (a) the importer has made a claim for the release of the copies; 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.
- (4) The CEO must release seized copies to the importer if:
  - (a) the importer has made a claim for the release of the copies; and
  - (b) an action for infringement of copyright has been instituted in relation to the copies; and
  - (c) at the end of a period of 20 working days commencing on the day on which the action was instituted, there is not in force an order of the court in which the action was instituted preventing the release of the copies.
- (5) This section has effect subject to section 135AH.

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

Seized copies are forfeited to the Commonwealth if:

- (a) the copies are released by the CEO to the importer; and
- (b) the importer does not take possession of the copies within 90 days of the release.

#### **14 Section 135AI**

Repeal the section, substitute:

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

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

- (2) However, copies forfeited under section 135AEB must not be disposed of until 30 days after their forfeiture.
- (3) Subsection (1) does not require the disposal of copies that are required in relation to an action for infringement of copyright.

*Right of compensation in certain circumstances*

- (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.
- (5) A right to compensation exists if:
  - (a) the copies did not infringe the objector's copyright; and
  - (b) the person establishes, to the satisfaction of the court:
    - (i) that he or she was the owner of the copies 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 copies.
- (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.

**15 Paragraph 195B(1)(c)**

Repeal the paragraph, substitute:

- (c) a decision of the CEO under section 135AA refusing to seize copies under subsection 135(7);
- (ca) a decision of the CEO under section 135AEC refusing to allow a late claim for the release of seized copies;
- (cb) a decision of the CEO under section 135AJ refusing to seize copies under subsection 135(7);

**16 Subsection 195B(3)**

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



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

### **17 Readers guide (list of terms defined in section 6)**

Insert the following terms in their appropriate alphabetical positions:

“action period”

“claim period”

“personal information”.

### **18 Section 6**

Insert:

***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.

### **19 Section 6**

Insert:

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

### **20 Section 6**

Insert:

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

### **21 Section 134**

Repeal the section, substitute:

#### **134 Notice of seizure**

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

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

- (2) The seizure notice must state that the goods will be released to the designated owner if:
- (a) the designated owner makes a claim for the release of the goods within the claim period; and
  - (b) the objector has not, by the end of the action period:
    - (i) instituted an action for infringement of the notified trade mark in respect of the goods; and
    - (ii) given the Customs CEO written notice of that action.

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

- (3) The seizure notice must also:
- (a) set out the claim period for the goods; and
  - (b) set out the action period for the goods and state that the action period will begin only if the designated owner makes a claim for the release of the goods; 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 designated owner (if known); and
  - (d) if the notice is given to the designated owner—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.
- (4) The Customs CEO may, at any time after the goods are seized, give to the objector:
- (a) the name and the address of the place of business or residence of any person or body (whether in or outside Australia) that made arrangements, on behalf of the designated owner of the goods, for the goods to be brought to Australia or any information that the Customs CEO has, and believes on reasonable grounds may help in identifying and locating such a person or body; and
  - (b) any information (including personal information) that the Customs CEO has and believes on reasonable grounds may be relevant for the purpose of identifying and locating the importer of the goods; and
  - (c) any information (including personal information) that the Customs CEO has and believes on reasonable grounds may

be relevant for the purpose of identifying and locating the designated owner of the goods.

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

- (1) The Customs CEO may permit the objector or the designated owner to inspect the seized goods.  
Note: For *designated owner*, *objector* and *seized goods* see section 6.
- (2) If the objector gives the Customs CEO the requisite undertakings, the Customs CEO may permit the objector to remove one or more samples of the seized goods from the custody of the Customs CEO for inspection by the objector.
- (3) If the designated owner gives the Customs CEO the requisite undertakings, the Customs CEO may permit the designated owner to remove one or more samples of the seized goods from the custody of the Customs CEO for inspection by the designated owner.
- (4) The requisite undertakings are undertakings in writing that the person giving the undertaking will:
  - (a) return the sample goods to the Customs CEO at a specified time that is satisfactory to the Customs CEO; and
  - (b) take reasonable care to prevent damage to the sample goods.
- (5) If the Customs CEO permits inspection of the seized goods, or the removal of sample goods, by the objector in accordance with this section, the Commonwealth is not liable to the designated owner for any loss or damage suffered by the designated owner arising out of:
  - (a) damage to any of the seized goods incurred during that inspection; or
  - (b) anything done by the objector or any other person to, or in relation to, sample goods removed from the custody of the Customs CEO or any use made by the objector of such sample goods.

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

## **22 Section 136**

Repeal the section, substitute:

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

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

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

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

Note: For *claim period* see section 6.

- (3) The claim must:

- (a) be in the form (if any) prescribed by the regulations; and
- (b) include the information prescribed by the regulations.

Note: Sections 137.1 and 137.2 of the *Criminal Code* create offences for providing false or misleading information or documents.

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

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

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

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

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

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

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

- (2) The Customs CEO may allow the late claim only if:

- (a) an action for infringement of the notified trade mark in respect of the goods has not been instituted; and
- (b) the Customs CEO considers it reasonable in the circumstances; and
- (c) the goods have not been disposed of under section 139.

- (3) An application may be made to the Administrative Appeals Tribunal for the review of a decision of the Customs CEO under

subsection (1) refusing to allow a late claim for the release of seized goods.

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

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

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

- (2) The notice:
- (a) must be in writing; and
  - (b) may include any information that the Customs CEO has, and believes on reasonable grounds may be relevant, for the purpose of identifying and locating either or both of the following:
    - (i) the importer of the goods;
    - (ii) any other person or body (whether in or outside Australia) that made arrangements for the goods to be brought to Australia.

### **136D Release of seized goods**

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

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

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

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

Note: For *action period* see section 6.

- (4) The CEO must release seized goods to the designated owner if:
- (a) the designated owner has made a claim for the release of the goods; and
  - (b) action for infringement of the notified trade mark in respect of the goods has been instituted; and
  - (c) at the end of a period of 20 working days commencing on the day on which the action was instituted, there is not in force an order of the court in which the action was instituted preventing the release of the goods.
- (5) This section has effect subject to section 140.

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

Seized goods are forfeited to the Commonwealth if:

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

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

### **23 Subsection 137(1)**

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

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

Omit “their”, substitute “the”.

### **25 Subsection 137(5)**

Repeal the subsection.

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## **26 Section 139**

Repeal the section, substitute:

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

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

Note: For *seized goods* see section 6.

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

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

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

#### *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.

## Part 2—Trade Mark offences

### *Trade Marks Act 1995*

#### 27 Sections 145 to 149

Repeal the sections, substitute:

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

##### *Indictable offence*

- (1) A person commits an offence if:
- (a) a registered trade mark has been applied to goods, or in relation to goods or services; and
  - (b) the goods or services are being, or are to be, dealt with or provided in the course of trade; and
  - (c) the person:
    - (i) alters or defaces the trade mark; or
    - (ii) makes any addition to the trade mark; or
    - (iii) wholly or partly removes, erases or obliterates the trade mark; and
  - (d) the person does so without:
    - (i) the permission of the registered owner, or an authorised user, of the trade mark; or
    - (ii) being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

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

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

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

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

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

##### *Summary offence*

- (2) A person commits an offence if:
-



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

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

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

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

##### *Indictable offence*

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

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

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

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

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

*Summary offence*

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

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

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

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

*Indictable offence*

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

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

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

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

*Summary offence*

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

- (b) the die, block, machine or instrument is likely to be used for, or in the course of, committing an offence; and
- (c) the offence is an offence against section 145 or 146.

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

- (4) The fault element for paragraph (3)(b) is negligence.
- (5) Strict liability applies to paragraph (3)(c).

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

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

##### *Indictable offence*

- (1) A person commits an offence if:
  - (a) the person draws, or programs a computer or other device to draw, a registered trade mark or part of a registered trade mark; and
  - (b) the registered trade mark or part of the registered trade mark is likely to be used for, or in the course of, an offence; and
  - (c) the offence is an offence against section 145 or 146.

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

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

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

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

##### *Summary offence*

- (3) A person commits an offence if:
  - (a) the person draws, or programs a computer or other device to draw, a registered trade mark or part of a registered trade mark; and
  - (b) the registered trade mark or part of the registered trade mark is likely to be used for, or in the course of, an offence; and
  - (c) the offence is an offence against section 145 or 146.

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

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

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

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

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

*Indictable offence*

- (1) A person commits an offence if:
- (a) the person possesses or disposes of:
    - (i) a die, block, machine or instrument; or
    - (ii) a computer, or other device, programmed to draw a registered trade mark or part of a registered trade mark; or
    - (iii) a representation of a registered trade mark or of part of a registered trade mark; and
  - (b) the die, block, machine, instrument, computer, device or representation is likely to be used for, or in the course of, an offence; and
  - (c) the offence is an offence against section 145 or 146.

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

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

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

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

*Summary offence*

- (3) A person commits an offence if:
- (a) the possesses or disposes of:
    - (i) a die, block, machine or instrument; or
    - (ii) a computer, or other device, programmed to draw a registered trade mark or part of a registered trade mark; or
    - (iii) a representation of a registered trade mark or of part of a registered trade mark; and
  - (b) the die, block, machine, instrument, computer, device or representation is likely to be used for, or in the course of, an offence; and

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

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

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

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

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

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

### *Indictable offence*

(1) A person commits an offence if:

(a) the person:

- (i) sells goods; or
- (ii) exposes goods for sale; or
- (iii) possesses goods for the purpose of trade or manufacture; or
- (iv) imports goods into Australia for the purpose of trade or manufacture; and

(b) any of the following applies:

- (i) there is a registered trade mark on the goods;
- (ii) there is a mark or sign on the goods that is substantially identical to a registered trade mark;
- (iii) a registered trade mark on the goods has been altered, defaced, added to, wholly or partly removed, erased or obliterated; and

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

- (i) the permission of the registered owner, or an authorised user, of the trade mark; or
- (ii) the application being required or authorised by this Act, a direction of the Registrar or an order of a court.

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

### *Summary offence*

(2) A person commits an offence if:

- (a) the person:
  - (i) sells goods; or
  - (ii) exposes goods for sale; or
  - (iii) possesses goods for the purpose of trade or manufacture; or
  - (iv) imports goods into Australia for the purpose of trade or manufacture; and
- (b) any of the following applies:
  - (i) there is a registered trade mark applied to the goods;
  - (ii) there is a mark or sign applied to the goods that is substantially identical to a registered trade mark;
  - (iii) a registered trade mark applied to the goods has been altered, defaced, added to, wholly or partly removed, erased or obliterated; and
- (c) the registered trade mark, or mark or sign, was applied, altered, defaced, added to, wholly or partly removed, erased or obliterated, as the case requires, without:
  - (i) the permission of the registered owner, or an authorised user, of the trade mark; or
  - (ii) the application being required or authorised by this Act, a direction of the Registrar or an order of a court.

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

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

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

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

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

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

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

#### **28 Section 126**

Before “The”, insert “(1)”.

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

Add:

- (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:
- (a) the flagrancy of the infringement; and
  - (b) the need to deter similar infringements of registered trade marks; and
  - (c) the conduct of the party that infringed the registered trade mark that occurred:
    - (i) after the act constituting the infringement; or
    - (ii) after that party was informed that it had allegedly infringed the registered trade mark; and
  - (d) any benefit shown to have accrued to that party because of the infringement; and
  - (e) all other relevant matters.

## Schedule 6—Simplifying the IP system

### Part 1—Amendments

#### *Designs Act 2003*

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

Repeal the definition, substitute:

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

##### **2 Section 5**

Insert:

*Federal Court* means the Federal Court of Australia.

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

Insert:

(aa) the Federal Magistrates Court;

##### **4 After section 5**

Insert:

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

(1) In this Act:

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

(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.

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

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

**6 Subsection 50(6)**

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

**7 Subsection 52(7)**

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

**8 Subsection 54(4)**

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

**9 Subsection 67(4)**

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

**10 Subsection 68(6)**

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

**11 Section 82**

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

**12 Subsection 83(2)**

Repeal the subsection, substitute:

- (2) The jurisdiction of the Federal Court to hear and determine appeals from decisions of the Registrar is exclusive of the jurisdiction of any other court other than the jurisdiction of:
  - (a) the Federal Magistrates Court under subsection 83A(2); and
  - (b) the High Court under section 75 of the Constitution.

**13 After section 83**

Insert:

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

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

- (2) The jurisdiction of the Federal Magistrates Court to hear and determine appeals from decisions of the Registrar is exclusive of the jurisdiction of any other court other than the jurisdiction of:
- (a) the Federal Court under subsection 83(2); and
  - (b) the High Court under section 75 of the Constitution.
- (3) A prosecution for an offence against this Act must not be brought in the Federal Magistrates Court.

**14 Subsection 84(1)**

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

**15 Section 85**

After “83”, insert “, 83A”.

**16 At the end of section 86**

Add:

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

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

**17 Subsection 87(2)**

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

**18 Section 88**

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

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

**19 Section 89**

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

**20 Subsection 125(2)**

Repeal the subsection, substitute:

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

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

**21 Subsection 136A**

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

**22 Section 144**

Repeal the section, substitute:

**144 Filing of documents**

A document may be filed with the Designs Office by:

- (a) delivering the document to the Designs Office, or a sub-office of the Designs Office (if any), either personally or by post; or
- (b) any other prescribed means.

***Patents Act 1990***

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

Omit “foreign patent office”.

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

Omit “modified examination”.

**25 Section 3 (in the list of definitions)**

Omit “sealed”.

**26 Section 4**

Repeal the section.

**27 Section 8**

Repeal the section.

**28 Paragraph 9(d)**

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

**29 At the end of section 9 (before the note)**

Add:

- (e) any use of the invention by or on behalf of, or with the authority of, the patentee or nominated person, or his or her predecessor in title to the invention, for any purpose, if a complete application is made for the invention within the prescribed period.

**30 Section 10 (note)**

Omit “: see also Chapter 8”.

**31 Before section 22**

Insert:

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

A patent is not invalid merely because:

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

**32 Paragraph 24(1)(a)**

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

**33 Subsection 24(1)**

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

**34 After section 29**

Insert:

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

- (1) A PCT application is to be treated as a complete application under this Act for a standard patent.
- (2) The description, drawings and claims contained in a PCT application are to be treated as a complete specification filed in respect of the application.

- (3) The specification of a PCT application is to be taken to be amended in the circumstances, on the day and in the manner as prescribed by the regulations.
- (4) A PCT application is to be taken to comply with the prescribed requirements of this Act that relate to applications for standard patents, but is not to be taken, merely because of subsection (1) or (2), to comply with any other requirements of this Act.
- (5) An applicant of a PCT application must do the following within the prescribed period:
  - (a) if the application was not filed in the receiving Office in English—file a translation of the application into English;
  - (b) in any case—file the prescribed documents and pay the prescribed fees.

Note: A failure to comply with this subsection may result in the PCT application lapsing: see paragraph 142(2)(f).

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

### *Making Convention applications*

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

*Meaning of Convention country*

- (5) **Convention country** means a foreign country or region of a kind prescribed by the regulations.
- (6) Despite subsection 14(2) of the *Legislative Instruments Act 2003*, regulations made for the purposes of subsection (1) 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.

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

**35 Section 30**

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

**36 Section 32**

Before “If”, insert “(1)”.

**37 Section 32**

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

**38 Section 32**

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

**39 At the end of section 32**

Add:

- (2) The Commissioner may make a determination under subsection (1) whether or not the application has lapsed.
- (3) The Commissioner must not make a determination under subsection (1) without first giving each joint applicant a reasonable opportunity to be heard.

**40 Paragraph 36(1)(a)**

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

**41 After subsection 36(3)**

Insert:

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

#### **42 After subsection 38(1)**

Insert:

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

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

Insert:

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

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

Repeal the subsections, substitute:

- (5) If, at the time when a Convention application or a PCT application is made in respect of an invention:
- (a) an application (the *earlier application*) has been made for protection in respect of the invention in a Convention country; and
  - (b) the earlier application was made in the prescribed period; and
  - (c) the earlier application has been withdrawn, abandoned or refused without becoming open to public inspection; and
  - (d) the earlier application has not been used as the basis of claiming a right of priority in a Convention country under a law of that country; and
  - (e) a later application has been made by the same applicant for protection in respect of the invention in a Convention country;

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

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

#### **45 After section 43**

Insert:

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

*Prescribed documents relating to basic applications*

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

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

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

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

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

*Commissioner may require prescribed documents be made available*

- (4) The Commissioner may require that a prescribed document relating to a basic application be made available to the Commissioner by the prescribed means and within the prescribed period.
- (5) The Commissioner may make a requirement under subsection (4) more than once in relation to the same prescribed document.

#### **46 Subsection 45(1)**

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

#### **47 After subsection 45(1)**

Insert:

- (1A) If a PCT application has been made and the prescribed requirements have not been met, the Commissioner may decline to



examine the request and specification under subsection (1) until the requirements have been met.

**48 Subsections 45(3) to (5)**

Repeal the subsections.

**49 Section 46**

Repeal the section.

**50 Division 2 of Part 2 of Chapter 3**

Repeal the Division.

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

Repeal the subsections.

**52 Subsection 49(6)**

Repeal the subsection, substitute:

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

**53 After section 49**

Insert:

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

- (1) The Commissioner may postpone acceptance of a patent request and complete specification:
  - (a) on his or her own initiative; or
  - (b) if requested to do so in writing by the applicant.
- (2) If the Commissioner postpones acceptance on his or her own initiative, he or she must specify a day to which acceptance is postponed.
- (3) If the Commissioner postpones acceptance following a request by the applicant, the Commissioner may specify a day to which acceptance is postponed.

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

(5) If:

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

(b) the Commissioner has not specified a day to which acceptance is postponed;

the Commissioner is not required to accept the patent request and complete specification unless the applicant withdraws the request in writing.

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

## **54 After section 50**

Insert:

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

(1) The Commissioner may revoke the acceptance of a patent request and complete specification relating to an application for a standard patent if the Commissioner is satisfied, on the balance of probabilities, that:

(a) a patent has not been granted on the application; and

(b) the request and specification should not have been accepted, taking account of all the circumstances that existed when the request and specification were accepted (whether or not the Commissioner knew then of their existence); and

(c) it is reasonable to revoke the acceptance, taking account of all the circumstances.

(2) If the Commissioner revokes the acceptance:

(a) the patent request and complete specification are taken to have never been accepted; and

(b) the Commissioner must continue to examine, and report on, the application under section 45; and

(c) sections 49 and 50 continue to apply in relation to the request and specification.

**55 At the end of section 51**

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

**56 Section 53**

Repeal the section, substitute:

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

- (1) If a patent application (other than a PCT application) is made, the Commissioner must publish in the *Official Journal* the prescribed information about the applicant and the application.
- (2) The regulations may make provision for and in relation to the publication of information relating to PCT applications.

**57 Subsection 55(3)**

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

**58 After section 56**

Insert:

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

- (1) The regulations may make provision for and in relation to the public inspection of PCT applications.
- (2) Without limiting subsection (1), the regulations may make provision for and in relation to:
  - (a) notices regarding the opening of complete specifications relating to PCT applications to public inspection; and
  - (b) the circumstances in which PCT applications become open to public inspection.

**59 At the end of subsection 57(1)**

Add:

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

**60 Subsection 61(1)**

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

**61 At the end of section 61**

Add:

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

**62 Subsection 62(1)**

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

**63 At the end of section 62**

Add:

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

**64 Section 66**

Repeal the section.

**65 Subsection 79C(1)**

Omit “sealed”, substitute “granted”.

**66 Subsection 81(3)**

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

**67 Chapter 8**

Repeal the Chapter.

**68 Section 101D**

Repeal the section.

**69 After section 101E**

Insert:

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

- (1) The Commissioner may revoke a certificate of examination issued in relation to an innovation patent if the Commissioner is satisfied, on the balance of probabilities, that:
  - (a) the certificate of examination should not have been issued, taking account of all the circumstances that existed when the certificate was issued (whether or not the Commissioner knew then of their existence); and
  - (b) it is reasonable to revoke the certificate, taking account of all the circumstances; and
  - (c) there are no relevant proceedings pending.
- (2) If the Commissioner revokes the certificate:
  - (a) all of the provisions of section 101E are taken, after revocation, to have never operated in relation to the patent; and
  - (b) the Commissioner must continue to examine and report on the patent under section 101B; and
  - (c) sections 101E and 101F continue to apply in relation to the patent.

### **70 Subsection 102(2C)**

Repeal the subsection.

### **71 Subsection 105(1)**

Omit “the patent,”.

### **72 Subsection 105(6)**

Omit “patent,”.

### **73 Sections 125 to 127**

Repeal the sections, substitute:

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

- (1) A person who has done, is doing, or is intending to do an act may apply to a prescribed court for a declaration that the doing of the act does not, or would not, infringe a patent.
- (2) An application may be made:

- (a) for a declaration in relation to an invention claimed in a standard patent—at any time after the patent has been granted; and
  - (b) for a declaration in relation to an innovation patent—at any time after the patent has been certified; and
  - (c) whether or not the patentee has made any assertion to the effect that the doing of the act has or would infringe the claim.
- (3) The patentee must be joined as a respondent in the proceedings.

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

- (1) A prescribed court must not make a non-infringement declaration unless:
- (a) the applicant for the declaration:
    - (i) has asked the patentee in writing for a written admission that the doing of the act has not infringed, or would not infringe, the patent; and
    - (ii) has given the patentee full written particulars of the act done, or proposed to be done; and
    - (iii) has undertaken to pay a reasonable sum for the patentee's expenses in obtaining advice about whether the act has infringed or would infringe the claim; and
  - (b) the patentee has refused or failed to make the admission.
- (2) The court may make orders as to costs as the court thinks fit.

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

If:

- (a) a patentee has given a person a written admission that the doing of an act has not infringed, or would not infringe, a claim, or a prescribed court has made a non-infringement declaration in respect of an invention; and
  - (b) the patentee later gets an injunction restraining the person from doing the act as specified in the admission, or the declaration is revoked;
- the person is not liable:
- (c) to account to the patentee for any profits, made by the person before the date on which the injunction was granted or the

- declaration was revoked, from the doing of the act as specified in the admission or declaration; or
- (d) to pay damages for any loss suffered by the patentee before that date as a result of the doing of that act.

**74 Subsection 135(2)**

Omit “sealed”, substitute “granted”.

**75 At the end of section 138**

Add:

- (4) A court must not make an order under subsection (3) on the ground that the patentee is not entitled to the patent unless the court is satisfied that, in all the circumstances, it is just and equitable to do so.

**76 Subsection 141(2)**

Repeal the subsection, substitute:

- (2) The regulations may prescribe circumstances in which PCT applications may be withdrawn, or are to be taken to be withdrawn.

**77 Paragraph 142(2)(c)**

Repeal the paragraph.

**78 At the end of subsection 142(2)**

Add:

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

**79 After section 191**

Insert:

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

- (1) The Commissioner may rectify the Register if the Commissioner is satisfied, on the balance of probabilities, whether on application or otherwise, of any of the following:
- (a) the omission of an entry from the Register;
  - (b) an entry made in the Register without sufficient cause;

- (c) an entry wrongly existing in the Register;
  - (d) an error or defect in an entry in the Register.
- (2) The Commissioner must, on application, make a declaration as to a person's entitlement to a patent, or a share in a patent, if the Commissioner is satisfied, on the balance of probabilities, that the Register does not properly record a person's entitlement to a patent, or a share in a patent:
- (a) because the patent, or a share in the patent, was granted to a person who was not entitled to it; or
  - (b) because the patent, or a share in the patent, was not granted to a person who was entitled to it; or
  - (c) for any other reason.
- (3) If the Commissioner makes a declaration under subsection (2), the Commissioner must rectify the Register accordingly.
- (4) The Commissioner must not make a declaration, or rectify the Register, under this section without first giving the following persons a reasonable opportunity to be heard:
- (a) the person whose entitlement is not properly recorded by the Register;
  - (b) any person whose entitlement to the patent, or a share in the patent, is recorded in the Register.
- (5) The Commissioner must not make a declaration or rectify the Register under this section while relevant proceedings in relation to the patent are pending.
- (6) An appeal lies to the Federal Court against a decision of the Commissioner:
- (a) to make, or refuse to make, a declaration; or
  - (b) to rectify, or not rectify, the Register;
- under this section.

## **80 At the end of Chapter 19**

Add:

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

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

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- (a) any matter or thing required or permitted by or under this Act or the PCT to be made or done has been made or done; or
  - (b) any matter or thing required by or under this Act or the PCT not to be made or done has not been made or done;
- is prima facie evidence of the matters contained in the certificate.

### **81 Subsection 205(2)**

Repeal the subsection, substitute:

- (2) The Commissioner may establish one or more sub-offices of the Patent Office as the Commissioner considers appropriate.
- (3) The Commissioner may abolish any such sub-offices.

### **82 Section 214**

Repeal the section, substitute:

#### **214 Filing of documents**

A document may be filed with the Patent Office by:

- (a) delivering the document to the Patent Office or a sub-office of the Patent Office (if any) either personally or by post; or
- (b) any other prescribed means.

### **83 Subsection 215(3)**

Omit “the patent by”, substitute “the Register by”.

### **84 Subsection 222A(1)**

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

### **85 At the end of subsection 223(1)**

Add:

- ; or (d) the receiving Office; or
- (e) the International Bureau of the World Intellectual Property Organization.

### **86 Paragraph 224(1)(a)**

Omit “, 52 or 66, subsection 74(3)”, substitute “or 52, subsection 56(1)(b), 74(3)”.

## 87 Section 226

Repeal the section, substitute:

### 226 Documents open to public inspection do not infringe copyright

- (1) If a document mentioned in subsection (2) is open to public inspection, doing any of the following in relation to the whole or part of the document does not constitute an infringement of any copyright subsisting under the *Copyright Act 1968* in any literary or artistic work:
  - (a) reproducing the document in two-dimensional form;
  - (b) communicating (within the meaning of that Act) the document to the public;
  - (c) translating (within the meaning of that Act) the document.
- (2) The documents are:
  - (a) a provisional specification; and
  - (b) a complete specification; and
  - (c) a prescribed document.
- (3) If a reproduction of an unpublished work is made as a result of a document being open to public inspection, the supply or communication of the reproduction does not constitute the publication of the work for the purposes of the *Copyright Act 1968*.

## 88 Subsection 227(3) (note)

Omit “89(3)”, substitute “29A(5)”.

## 89 Paragraph 228(2)(f)

Repeal the paragraph.

## 90 After paragraph 228(2)(ha)

Insert:

- (i) setting out the checking process for PCT applications including, in particular, the following matters:
  - (i) specifying the requirements that must be met in respect of a PCT application, once the requirements of subsection 29A(5) have been met;

- (ii) empowering the Commissioner to direct an applicant to do such things as are necessary to ensure that the PCT application is in accordance with those requirements;
- (iii) providing for the lapsing of the PCT application if such a direction is not complied with within a time specified in the regulations;

**91 Subsections 228(5) and (6)**

Repeal the subsections.

**92 Schedule 1 (at the end of the definition of *Budapest Treaty*)**

Add:

Note: The text of the Treaty is set out in Australian Treaty Series 1987 No. 9 ([1987] ATS 9). In 2011, the text of a Treaty in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).

**93 Schedule 1 (definition of *Convention application*)**

Omit “Part 2 of Chapter 8”, substitute “Part 1 of Chapter 3”.

**94 Schedule 1 (definition of *Convention country*)**

Repeal the definition, substitute:

*Convention country* has the meaning given by section 29B.

**95 Schedule 1 (paragraph (a) of the definition of *examination*)**

Omit “, or a modified examination of the request and specification under section 48”.

**96 Schedule 1 (definition of *foreign patent office*)**

Repeal the definition.

**97 Schedule 1 (definition of *international filing date*)**

Repeal the definition, substitute:

*international filing date*, in relation to an international application, means the date given to the international application as its international filing date under the PCT.

**98 Schedule 1 (definition of *modified examination*)**

Repeal the definition.

**99 Schedule 1 (at the end of the definition of *PCT*)**

Add:

Note: The text of the Treaty is set out in Australian Treaty Series 1980 No. 6 ([1980] ATS 6). In 2011, the text of a Treaty in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).

**100 Schedule 1 (definition of *PCT application*)**

Repeal the definition, substitute:

*PCT application* means an international application in which Australia is specified as a designated State under Article 4(1)(ii) of the PCT.

**101 Schedule 1 (sub-subparagraph (b)(ii)(B) of the definition of *prior art base*)**

After “published”, insert “on or”.

**102 Schedule 1 (sub subparagraph (b)(ii)(C) of the definition of *prior art base*)**

Omit “and when it was published”.

**103 Schedule 1 (definition of *sealed*)**

Repeal the definition.

***Plant Breeder’s Rights Act 1994***

**104 Subsection 3(1) (definition of *Convention*)**

Repeal the definition, substitute:

*Convention* means the International Convention for the Protection of New Varieties of Plants, done at Geneva on 23 October 1978, as that treaty is in force for Australia from time to time.

Note: The text of the Convention is set out in Australian Treaty Series 1989 No. 2 ([1989] ATS 2). In 2011, the text of a Convention in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).

**105 Subsection 43(10)**

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Insert:

*authority* has the same meaning as in the Convention.

**106 Subsection 43(10)**

Insert:

*territory* has the same meaning as in the Convention.

**107 Subsection 43(10)**

Insert:

*variety* has the same meaning as in the Convention.

**108 Schedule**

Repeal the schedule.

***Trade Marks Act 1995***

**109 Subsection 6(1) (definition of *Convention country*)**

Repeal the definition, substitute:

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

**110 At the end of section 6**

Add:

- (3) Despite subsection 14(2) of the *Legislative Instruments Act 2003*, regulations made for the purposes of the definition of *Convention country* in subsection (1) 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.

**111 Subsection 27(4)**

After “sub-offices”, insert “(if any)”.

**112 Section 35**

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

## 113 Section 41

Repeal the section, substitute:

### 41 Trade mark not distinguishing applicant's goods or services

- (1) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (the *designated goods or services*) from the goods or services of other persons.

Note: For *goods of a person* and *services of a person* see section 6.

- (2) A trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons only if either subsection (3) or (4) applies to the trade mark.
- (3) This subsection applies to a trade mark if:
- (a) the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and
  - (b) the applicant has not used the trade mark before the filing date in respect of the application to such an extent that the trade mark does in fact distinguish the designated goods or services as being those of the applicant.
- (4) This subsection applies to a trade mark if:
- (a) the trade mark is, to some extent, but not sufficiently, inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and
  - (b) the trade mark does not and will not distinguish the designated goods or services as being those of the applicant having regard to the combined effect of the following:
    - (i) the extent to which the trade mark is inherently adapted to distinguish the goods or services from the goods or services of other persons;
    - (ii) the use, or intended use, of the trade mark by the applicant;

(iii) any other circumstances.

- Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:
- (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
  - (b) the time of production of goods or of the rendering of services.
- Note 2: For *goods of a person* and *services of a person* see section 6.
- Note 3: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (5) and 7(3) and section 8).

(5) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

- Note 1: For *applicant* and *predecessor in title* see section 6.
- Note 2: If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

#### **114 Section 56**

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

#### **115 Section 67**

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

#### **116 Subsection 83(2)**

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

#### **117 Subsection 83A(8)**

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

#### **118 Section 84D**

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

#### **119 Section 104**

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

#### **120 After paragraph 190(a)**

Insert:

- (aa) the Federal Magistrates Court;

### **121 Subsection 191(2)**

Repeal the subsection, substitute:

- (2) The jurisdiction of the Federal Court to hear and determine appeals against decisions, directions or orders of the Registrar is exclusive of the jurisdiction of any other court except the jurisdiction of:
  - (a) the Federal Magistrates Court under subsection 191A(2) of this Act; and
  - (b) the High Court under section 75 of the Constitution.

### **122 After section 191**

Insert:

#### **191A Jurisdiction of the Federal Magistrates Court**

- (1) The Federal Magistrates Court has jurisdiction with respect to matters arising under this Act.
- (2) The jurisdiction of the Federal Magistrates Court to hear and determine appeals against decisions, directions or orders of the Registrar is exclusive of the jurisdiction of any other court except the jurisdiction of:
  - (a) the Federal Court under subsection 191(2) of this Act; and
  - (b) the High Court under section 75 of the Constitution.
- (3) A prosecution for an offence against this Act may not be started in the Federal Magistrates Court.

### **123 Subsection 192(1)**

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

### **124 Section 193**

After “191”, insert “, 191A”.

### **125 At the end of section 194**

Add:



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

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

**126 Subsection 195(2)**

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

**127 Section 196**

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

**128 Section 197**

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

Note: The heading to section 197 is altered by inserting “**and Federal Magistrates Court**” after “**Federal Court**”.

**129 Subsection 199(2)**

Repeal the subsection, substitute:

- (2) The Registrar may establish one or more sub-offices of the Trade Marks Office as the Registrar considers appropriate.
- (3) The Registrar may abolish any such sub-offices.

**130 Subsections 213(1) and (2)**

Repeal the subsections, substitute:

A document may be filed with the Trade Marks Office by:

- (a) delivering the document to the Trade Marks Office or any sub-office of the Trade Marks Office (if any) either personally or by post; or
- (b) any other prescribed means.

**131 Subsection 223A(1)**

After “Trade Marks Office” (second occurring), insert “(if any)”.

**132 Subsection 225(1)**

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

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Repeal the subsection.

## **Part 2—Application and savings provisions**

### **133 Application provisions**

- (1) The amendment made by item 29 of this Schedule applies in relation to a use of an invention on or after the day that item commences.
- (2) The amendments made by items 30, 34, 35, 42, 46, 47, 56, 57, 58, 59, 67, 76, 78, 80, 85, 88, 90, 93, 97 and 100 of this Schedule apply in relation to applications made on or after the day those items commence.
- (3) The amendments made by items 31 and 79 of this Schedule apply on and after the day those items commence in relation to patents granted before, on or after that commencement.
- (4) The amendments made by items 32 and 33 of this Schedule apply in relation to information that is made publicly available on or after the day those items commence.
- (5) The amendments made by items 36, 37, 38 and 39 of this Schedule apply in relation to disputes arising on or after the day those items commence.
- (6) The amendments made by items 40 and 41 of this Schedule apply in relation to declarations made on or after the day those items commence.
- (7) The amendments made by items 43 and 102 of this Schedule apply in relation to:
  - (a) patents for which the complete application is made on or after the day those items commence; and
  - (b) standard patents for which the application was made before the day those items commence, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day; and
  - (c) innovation patents granted on or after the day those items commence, if the complete application to which the patent relates was made before that day; and
  - (d) complete patent applications made on or after the day those items commence; and

- (e) complete applications for standard patents made before the day those items commence, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day; and
  - (f) complete applications for innovation patents made before the day those items commence, if a patent had not been granted in relation to the application on or before that day; and
  - (g) innovation patents granted before the day those items commence, if:
    - (i) the Commissioner had not decided to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day; and
    - (ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day.
- (8) The amendment made by item 44 of this Schedule applies in relation to applications filed, and patents granted, before, on or after the day that item commences.
- (9) The amendments made by items 60, 61, 62, 63 and 64 of this Schedule apply in relation to patents granted on or after the day those items commence.
- (10) The amendments made by items 71 and 72 of this Schedule apply in relation to proceedings commenced on or after the day those items commence.
- (11) The amendments made by items 54 and 55 of this Schedule apply in relation to applications accepted on or after the day those items commence.
- (12) The amendment made by item 69 of this Schedule applies in relation to patents certified on or after the day that item commences.
- (13) The amendment made by item 73 of this Schedule applies in relation to applications for non-infringement declarations made on or after the day that item commences.
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- (14) The amendment made by item 75 of this Schedule applies in relation to applications for orders made on or after the day that item commences, whether the patent was granted before, on or after that day.
- (15) The amendment made by item 77 of this Schedule does not apply in relation to an application if:
- (a) the examination of the patent request and complete specification for the application had been deferred under section 46 of the *Patents Act 1990* (as in force immediately before the commencement of that item); and
  - (b) the applicant had not asked for an examination of the patent request and complete specification on or before that commencement.
- (16) The amendment made by item 101 of this Schedule applies in relation to:
- (a) patents for which the complete application is made on or after the day that item commences; and
  - (b) standard patents for which the application was made before the day that item commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day; and
  - (c) innovation patents granted on or after the day that item commences, if the complete application to which the patent relates was made before that day; and
  - (d) complete patent applications made on or after the day that item commences; and
  - (e) complete applications for standard patents made before the day that item commences, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the *Patents Act 1990* before that day; and
  - (f) complete applications for innovation patents made before the day that item commences, if a patent had not been granted in relation to the application on or before that day; and
  - (g) innovation patents granted before the day that item commences, if:
    - (i) the Commissioner had not decided to examine the complete specification relating to the patent under

section 101A of the *Patents Act 1990* before that day;  
and

- (ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the *Patents Act 1990* before that day.

### **134 Savings provision—modified examinations**

- (1) This item applies if:
    - (a) a request for a modified examination had been made under section 47 of the *Patents Act 1990* (as in force immediately before the commencement of this item) in relation to an application; and
    - (b) the modified examination:
      - (i) had not yet commenced at the time of that commencement; or
      - (ii) had commenced but the application had not been accepted at the time of that commencement.
  - (2) Despite the amendments made by items 50 and 52 of this Schedule, Division 2 of Part 2 of Chapter 3 and subsection 49(6) of the *Patents Act 1990* (as in force immediately before the commencement of this item) continue to apply in relation to the application as if those amendments had not been made.
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[*Minister's second reading speech made in—  
Senate on 22 June 2011  
House of Representatives on 19 March 2012*]