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Intellectual Property Laws Amendment (Raising the Bar) Bill

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On 22 June 2011, a Notice of Motion was given by the Minister for Innovation, Industry, Science and Research, Senator Carr to introduce the Intellectual Property Laws Amendment (Raising the Bar) Bill (**Bill**) into the Senate.

The overall purpose of the Bill is to improve Australia's Intellectual Property Rights legislation by, amongst other things, reducing delays in resolving disputes by removing procedural hurdles, improving trade mark and copyright enforcement and simplifying the IP system generally. This will further encourage innovation and investment in Australian research and technology.

If passed, the Bill will amend the *Patents Act* 1990, the *Trade Marks Act* 1995, the *Copyright Act* 1968, the *Designs Act* 2003 and the *Plant Breeder's Rights Act* 1994.

Some of the highlights of the proposed changes are set out below.

Trade Marks

The proposed amendments to the *Trade Marks Act* 1995 mean that:

- the trade mark opposition process will be refined to make it quicker, cheaper and fairer for both the applicant and those opposing the registration of the trade mark;
- trade mark enforcement mechanisms will be implemented to provide stronger penalties and better tailored offence provisions and new provisions for additional damages in civil infringement actions to deter infringers;
- the Federal Magistrates Court will be granted jurisdiction to hear and decide trade mark matters;
- the scope of attorney client privilege will be extended to client communications with overseas attorneys. This is a major development in light of the international nature of intellectual property registration and management; and
- trade mark owners will be allowed to inspect goods seized by Customs. The *Trade Marks Act* 1995 does not currently contain provisions relating to inspection.

Copyright

The amendments to the *Copyright Act 1968* (Cth) are designed to strengthen copyright protection.

Copyright owners will benefit from the amendments because:

- more onerous obligations will be placed on importers because, after receiving a seizure notice from Australian Customs in respect of imported goods that may infringe copyright, the importer must make a claim for the release of the goods;
- if the importer does not make a claim for the release of the goods, the seized goods will be forfeited to the Commonwealth;
- copyright owners will be provided with details of the exporter by Customs which will assist copyright owners to address infringement and identify repeat offenders; and
- the copyright owner will be permitted to inspect multiple samples of seized goods (the current regime limits inspection to a single sample). This will assist copyright owners to determine whether consignments contain infringing and non-infringing goods.

Patents

The proposed amendments to the *Patents Act 1990* will:

- bolster the requirement that a patented invention must be useful such that the specification discloses a 'specific, substantial and credible' use to prevent the grant of patents for speculative inventions;
- grant the Commissioner of Patents broader rights when considering whether to grant or revoke a patent after re-examination and apply a consistent standard of proof across all grounds so that the Commissioner is not obliged to grant patents that would not pass scrutiny in a court challenge;
- expand the existing exemption for pharmaceutical inventions to all technologies, by introducing an exemption for activities undertaken solely for the purpose of gaining regulatory approval to market or manufacture a patented technology;
- clarify that research and experimental activities relating to patented inventions are exempt from infringement, whereas commercial activities are not;
- raise the standards set for disclosure of an invention in a patent specification. The changes will ensure that granted patents are no broader than the invention that has been disclosed;
- raise the Australian standard for inventive step to a level that is more consistent with Australia's major trading partners;

- refine patent opposition proceedings; and
- tighten the timeframes within which divisional applications can be filed, reducing opportunities for abusive use of these types of application.

Designs

- The *Designs Act 2003* will be amended to provide the Federal Magistrates Court with jurisdiction to hear and decide design matters. Small businesses may benefit from being able to prosecute their design matters in a speedy, cost effective and less formal forum.

If you would like further information about the Bill or have any questions about intellectual property generally please contact Alexia Marinos.

This report does not comprise legal advice and neither Gadens Lawyers nor the authors accept any responsibility for it.