



## EXCO MEETING ROME, 06-09 NOVEMBER 2011

### COUNTRY REPORT

TITLE: Country report for Australia  
 DRAWN UP BY: Greg Chambers  
 TABLED TO: FICPI delegates  
 PURPOSE: For information

#### SECTION A: ACTIVITIES OF FICPI ASSOCIATION/SECTION

The information supplied in Section A will remain confidential on FICPI's website after the ExCo (will require a password).

##### A1. INTERNAL MEETINGS AND OTHER ACTIVITIES

The Council of FICPI Australia has met five times since the Cape Town ExCo – in April, May, July (twice) and October of this year. In addition, the Association held its Annual General Meeting between 29 July and 1 August. The Annual General Meeting was held in Noosa, Queensland. The working programme associated with the Annual General Meeting was entitled “Clouding Disasters and the Raw Edge”. At the Annual General Meeting there were a number of amendments made to the Articles and Memorandum of Association of FICPI Australia. These principally related to membership and clarified membership categories for members as ordinary members, emeritus members and honorary members. Honorary membership under the revised Articles is available only to those that make a substantial contribution to the advancement of the Association or its objects.

##### A2. EXTERNAL MEETINGS WITH OFFICIALS AND OTHER EXTERNAL ACTIVITIES

There have been two meetings of IP Australia’s Patent Consultation Group (PCG) since the Cape Town ExCo – the first in March and the second in July 2011. Both were attended on behalf of the Association by Greg Chambers. Significant topics discussed during these meetings were:

- the finalization of the “Raising the Bar” legislation;
- cooperation between the Australian and New Zealand Patent Offices;
- gene patenting senate committee enquiries; and
- the Patent Prosecution Highway arrangements between Australia and the United States.

In addition to the Patent Consultation Group meetings, there has been a meeting of the Trade Marks Consultation Group (TCG). This meeting was in April 2011 and a further meeting is scheduled for 25 October 2011. Mr Brett Lewis, a FICPI Australia member, attended the April meeting on behalf of the Association. Topics covered included:

- the Parallel Importation Research Project
- Plain Packaging Legislation for Tobacco Products



- Opposition Case Management

A meeting of the IP Professionals Forum in May 2011 was attended on behalf of the Association by Mark Roberts. Matters discussed at the meeting included

- Gene Patenting Enquiries
- the IP Rights Reform Project
- Indigenous Consultation and Traditional Knowledge
- the proposed joint New Zealand / Australian Professional Standards Board

The Designs Consultation Group (DCG) met in August 2011. Caroline Bommer attended this meeting on behalf of FICPI Australia and topics raised included

- possible Extension of Term
- Customs Seizure
- Resolution of Representations
- Electronic Filing

Further, FICPI Australia co-sponsored the Francis Gurry IP Lecture again this year held on 17 October 2011. The speaker was Mr James Love. Greg Chambers attended the lecture and the following dinner on behalf of FICPI Australia. Greg Chambers also attended on behalf of FICPI Australia an informal meeting of the PCG in Melbourne on 12 October 2011 related to proposed changes in fees foreshadowed in the light of the proposed reforms to the *Australian Patents Act* in the "Raising the Bar" legislation.



### A3. SUBMISSIONS MADE

- IP Australia and IPONZ have proposed a single Trans-Tasman Regulatory Framework for patent attorneys. A discussion paper was issued in April 2011 and FICPI Australia made submissions to both IP Australia and the Ministry of Economic Development in New Zealand with respect to these proposals in May 2011. Mr Steve Krouzecky prepared these submissions on behalf of FICPI Australia.
- Also in May, FICPI Australia was contacted by IP Australia with respect to proposed PCT Rule changes to provide for extensions of time in cases of major natural disasters. FICPI Australia filed a submission with respect to the proposed rule changes in May 2011.
- In June 2011, FICPI Australia filed submissions regarding the proposed Terms of Reference for an ACIP Review of the *Australian Designs Act*.
- In August 2011, FICPI Australia was contacted by IP Australia with respect to Australia joining the Nagoya Protocol relating to access to genetic resources. A detailed submission was prepared and submitted to the Department of Sustainability, Environment and Water Population in Communities in August 2011.
- In addition, FICPI Australia made a number of oral submissions to IP Australia during the course of PCG, TCG, DCG and IP Professionals Forum meetings during the period since the Cape Town ExCo.

The relationship between FICPI Australia and IP Australia is reasonably good. Whilst IP Australia will often pursue its own agenda on matters concerning reform, they will routinely engage FICPI Australia in discussions concerning any changes in practice or law.

FICPI Australia also has a very good relationship with the local Institute of Patent & Trade Mark Attorneys, with many submissions to IP Australia on matters of reform being prepared jointly or at least in consultation one with the other.

### A4. CHANGES IN OFFICE BEARERS

None.

### A5. CHANGES IN MEMBERSHIP

FICPI Australia currently has 96 members of which 4 hold an honorary membership. Since our Country Report to the ExCo in Cape Town there have been 5 new members and one member unfortunately passing away (Mr Peter Fisher).

**A6. RECRUITMENT OF NEW MEMBERS**

FICPI Australia invited a number of eligible non-members from Queensland firms to attend the working programme associated with the AGM in Noosa in July. This resulted in a small number of non-members attending the meeting. It is anticipated that in the future, various non-members will be invited to attend the FICPI AGM in order to get a better idea of the organization, the working programme organized for Annual General Meetings and to speak to other members to understand the benefits of FICPI Australia membership.

**A7. OTHER ACTIVITIES**

None.

**A8. UPCOMING EVENTS**

FICPI Congress – Melbourne 2012 (assisting in preparations)  
FICPI Australia AGM – probably September 2012

**A9. COPYRIGHT**

There is no immediate need for FICPI Australia to become involved in copyright issues. Generally, copyright matters fall outside the scope of work done by patent & trade mark attorneys in Australia, except insofar as those which concern design and design / copyright overlap. FICPI Australia considers that design and design / copyright overlap can be adequately addressed within the current Designs CET Group No. 2.

**A10. OTHER INFORMATION**

None.



## SECTION B: CHANGES IN LAW

Information supplied under Sections B and C will be published on FICPI's website after the ExCo and will be available to the public.

### B1. LEGISLATION

There have been no significant legislative changes in designs, patents or trade mark law in Australia since the Country Report presented to the Cape Town ExCo.

#### ***Therapeutic Goods Legislation Amendment (Copyright) Act 2011***

This legislation commenced on 28 May 2011. Under it, generic pharmaceutical companies are permitted to use product information documentation previously approved by the Therapeutic Goods Administration without that use constituting an infringement of copyright.

#### **Tobacco Plain Packaging Bill 2011**

The purpose of this Bill is to discourage the use of tobacco products. The Bill contains detailed requirements relating to the retail packaging and appearance of tobacco products. If the legislation is passed, all tobacco products will need to be packaged in plain packaging with the proprietor's trade mark appearing in unadorned block letter fashion. Consequent amendments are proposed for the *Trade Marks Act* to protect the registered trade marks of tobacco manufacturers so that removal provisions relating to non-use will be rebuttable with evidence from the registered owner that it would have used the trade mark but for the operation of the Bill. Further, provisions relating to intention to use are modified for applications for registration in relation to tobacco products.

### B2. MAJOR CASES

#### **TRADE MARKS**

#### ***Bodum v DKSH Australia Pty Ltd [2011] FCA FC 98***

A majority of the Full Federal Court found that the shape of a coffee plunger of Peter Bodum A/S had become distinctive. A lookalike product was the subject of an injunction application by Bodum. The Court found that the lookalike product was not adequately labelled to prevent customers being misled or deceived. The case is a continuation of a long line of authority in Australia in which the courts have grappled (sometimes inconsistently) with claimed rights in the shape of a product outside design and trade mark law. In this case, the DKSH coffee plunger was sold in packaging marked with the trade mark "Euroline". However, the coffee plunger itself had no relevant branding. In the circumstances, the Court found that DKSH had not done enough to ensure that the product would not be mistaken for that of Bodum.



## PATENTS

### ***Interpharma Pty Ltd v Aventis Pharma SA* [2011] FCA 32**

This decision reports an interlocutory injunction application filed by Aventis to prevent the sale of two compounds said to infringe an Australian patent. The interlocutory injunction was refused on the basis of delay. Whilst the alleged infringer had not been on the market before the interlocutory injunction application was filed, it was shown that Aventis had been aware of the alleged infringer's listing of the generic products on the Australian Register of Therapeutic Goods and had known of this for almost ten months prior to the injunction application. The judge also did not accept the submissions from Aventis that damages at the conclusion of trial would not adequately compensate Aventis for any lost sales.

### ***SNF (Australia) Pty Ltd v Ciba Speciality Chemicals Water Treatment* [2011] FCA 452**

This case concerned the enforcement of an innovation patent. Kenny J referred to the earlier decision of the Full Court in *Dura-Post (Aust) Pty Ltd v Delnorth Pty Ltd* [2009] FCA FC 81 and confirmed that the innovative step requirement was little more than an expanded novelty test. The Court found that if a difference between the claimed invention in an innovation patent and the prior art was a difference which made a not insubstantial contribution to the working of the invention, then that difference would be sufficient to confer an innovative step. The determination of whether the contribution was not insubstantial was made without reference to the prior art.

### ***Danisco A/S v Novozymes A/S (No. 2)* [2011] FCA 282**

This was a first instance decision of the Federal Court in which the Court found that prior art which incorporated a teaching which, if followed, would inevitably result in the later claimed invention, did not necessarily constitute a novelty-destroying anticipation. It was held by the Court that for an earlier teaching to destroy novelty it was necessary for the teaching to identify the desirability of the result. The decision appears to be at odds with *General Tyre & Rubber Company v Firestone Tyre & Rubber Company Ltd* (1971). It is understood that the decision is under appeal.

## COPYRIGHT

### ***Sanofi-Aventis v Apotex Pty Ltd (No. 3)* [2011] FCA 846**

The Court found that use of the product information of Sanofi-Aventis by the generic company Apotex infringed copyright held by Sanofi-Aventis. The Court confirmed that if the product information had been copied after 28 May 2011 it would not have been an infringement as a result of recent changes to the *Copyright Act*.



### B3. OFFICIAL PRACTICE

#### **Patent Examination – Australia and New Zealand**

On 5 July 2011 the Australian government and the New Zealand government jointly announced the implementation of a plan to streamline the examination of patents in Australia and New Zealand. The aim of the plan is to provide a single application process covering both countries by 2013 and progressing to a single examination process by June in 2014. A work sharing model is currently being developed, and it is expected that this will be implemented in early 2012.

#### **Patent Prosecution Highway**

On 15 July 2011 the Australian Patent Office and the USPTO expanded their bilateral patent prosecution highway arrangements.

Under this expanded program, overseas applicants in Australian cases will be given an opportunity to obtain early patent protection in the United States where a co-pending Australian application has been examined and at least one claim found allowable. If requesting an early PPH examination, it is necessary that the claims be similar and have the same or narrower scope.



#### B4. PROPOSALS FOR CHANGES

IP Australia continues to have on the table an ambitious program of patent law reform. Details of this program were set out in the Country Report for the Cape Town meeting. Since that time the draft Bill has been finalized and has been the subject of a first reading in the Senate. A second reading speech is expected in November this year, or if not then, in the autumn sessions of next year. As indicated in the Report at the Cape Town meeting, the proposed changes include:

##### Patents

- Abolition of “fair basis” to be replaced with a “support requirement”
- An amendment of the full description requirement to require that the description of an invention in a specification enable an invention across the scope of the claims
- Repeal of the provision which requires that documents be considered on inventive step only if it can be shown that they would have been “ascertained, understood and considered to be relevant” by the skilled addressee
- When considering inventive step, the relevant common general knowledge in Australia be amended to common general knowledge without geographical limitation
- Amend the law of utility to provide that an invention will be useful only if the invention so far as claimed in any claim has a “specific, substantial and credible use”
- Amend provisions relating to re-examination so that all grounds available for revocation are also available on re-examination
- Amend all relevant parts of the Act so that “balance of probabilities” is the standard of proof applied whenever a decision is made regarding acceptance, refusal, grant or revocation of a patent or patent application
- Amend the Act to provide that the rights of the patentee are not infringed by acts done predominantly for experiment
- Revamp opposition practice with greater burdens on applicants and opponents to produce and serve evidence in a timely fashion
- Confer power on the Federal Court to direct amendment of an application for a patent - particularly directed to cases where an opposition is on appeal
- Prohibit the withdrawal of a patent application under opposition without leave of the Commissioner
- Abolish omnibus claims except where they are necessary in order to define the invention
- Confer on the Commissioner the right to withdraw acceptance
- Abolish State Offices
- Examination fees to be varied to reflect the amount of original work of the Examiner
- Repeal provisions allowing for modified examination
- Introduce a 12-month grace period with respect to secret use
- Repeal the provisions relating to the submission of overseas search results on corresponding applications
- Introduce experimental user provisions
- Broaden the client/patent attorney privilege provisions to ensure that they extend to overseas practitioners





### Trade Marks

- A review of the rules relating to the presumption of registrability
- Revamp opposition practice with greater burdens on applicants and opponents to produce and serve evidence in a timely fashion
- Increases in penalties for trade mark infringement
- Access to the Federal Magistrate Court for some trade mark enforcement matters
- Discussions have started between the Australian and New Zealand governments with respect to a single trade mark system for registration of trade marks in both Australia and New Zealand with a common application form and common rules relating to registrability and infringement.



## SECTION C: OTHER INFORMATION OF GENERAL INTEREST

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### **Innovation Patent System**

The Advisory Council on Intellectual Property (ACIP) has issued a discussion paper as part of a review of the innovation patent system. The review has been prompted by concerns that the innovation patent system enables patent rights to be granted at an inventive threshold which is too low. The review is ongoing.

### **Senate Committee Report – Gene Patenting**

On 21 September 2011 the Australian Senate Legal and Constitutional Affairs Committee handed down its report in relation to a Private Members Bill seeking to ban the patenting of various biological materials such as genes. The Senate Committee's report rejected the proposal.

### **ACTA**

On 1 October 2011 Australia became a party to the Anti-Counterfeiting Trade Agreement.

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