



MEETING BETWEEN OFFICIALS OF IP AUSTRALIA AND FICPI, 14
APRIL 2008

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14 APRIL 2008, 07:00 TO 08:45

THE HERITAGE ROOM, GROUND FLOOR, SHANGRI-LA HOTEL, SYDNEY

FICPI

Danny Huntington	President (US)
Jan Modin	Vice-President (SE)
Julian Crump	Secretary General (GB)
David Bannerman	CET President (GB)
John Dean	CET Reporter General (GB)
Kazuaki Takami	CET Vice-President (JP)
Coleen Morrison	Chair of CET Group 1 (CA)
Ivan Ahlert	Chair of CET Group 3 (BR)
David Griffith	Contact Commission & IPTA President (AU)
Peter Huntsman	President, FICPI Australia & ExCo Delegate (AU)
Greg Chambers	Secretary, FICPI Australia & ExCo Alternate Delegate (AU)
Noel Brett	Immediate Past President, FICPI Australia (AU)

IP AUSTRALIA

Fatima Beattie	Deputy Director General
Victor Portelli	General Manager Patents & Plant Breeders Rights
Philip Spann	Assistant General Manager Patents & Plant Breeders Rights
Michael O'Rourke	Assistant Director Domestic Policy
John Braybrooks	Assistant General Manager Trade Marks & Designs

1. INTRODUCTION

Danny Huntington welcomed people to the meeting, explaining the background to the meeting and the current review of FICPI's strategic plan, which had been established in Broome 10 years ago.



2. QUALITY OF PATENT EXAMINATION, INCLUDING IP AUSTRALIA'S PATENT PROSECUTION HIGHWAY, OTHER RELIANCE ON FOREIGN EXAMINATION REPORTS, FUTURE PLANS SUCH AS THE UNPUBLISHED IDEAL PATENT SYSTEM, DELAYS, AND MODIFIED EXAMINATION, B+ DISCUSSIONS.

Fatima Beattie explained the background to the "Ideal Patent System" project and the aim of the Australian government to internationalise the patentability standards. Danny Huntington asked how IP Australia would handle differences in patentability. Fatima Beattie explained that international standards of novelty and inventive step were the aim however Australia could make changes to better align with our major trading partners.

Philip Spann commented on the progress in the B+ discussions. IP Australia is keen to support the process but is waiting to see what other players would do. Ivan Ahlert mentioned that he had discussed B+ discussions with Anne Jorgensen of the Danish Patent Office and asked about IP Australia's attitude especially with respect to the grace period. Philip Spann explained that IP Australia has always been in favour of a 12 month grace period, without the requirement for a declaration. Ivan Ahlert explained that FICPI was having a workshop relating to the grace period and was keen to find out which countries were for and which were against the grace period. Fatima Beattie explained that they did not really have an understanding of what was behind the concerns of some countries. Danny Huntington explained that "uncertainty" was usually considered to be the issue.

Danny Huntington mentioned that the United States Bill relating to patent reform was about to come to the Senate but was pulled at the last minute over damages. There was unlikely to be progress for some time.

Peter Huntsman emphasised FICPI's concern over patent quality, with the need for good quality examination to result in good quality patents. Victor Portelli emphasised that in all developments to the patent system care was taken not to reduce patent quality. IP Australia shared FICPI's desires to have good quality patents.

Fatima Beattie explained that the practice of Examiners utilising Foreign Examination Reports goes back over 20 years, and that IP Australia is being explicit in acknowledging foreign examination reports in Australian examination reports where the findings within those reports are relevant to the Australian application. The introduction of electronic official files (e dossier) would lead to more transparency of such practices.

Julian Crump underscored the need for partnership, explaining the pressure on patent attorneys and FICPI's quality standards, and invited feedback from the Patent Office. Fatima Beattie responded by referring to IP Australia's customer feedback process in its own quality standards. Greg Chambers reflected on 15 years of practice and suggested that examination reports used to be more thorough, especially in relation to Section 40 (fair basis, internal validity). Victor Portelli had some sympathy for this, but explained that the examination process had had to change to meet changing pressures on the system and



that over the last 10 years or so IP Australia examiners have had to focus on substantive issues during examination.

3. PRIVILEGE FOR PATENT ATTORNEYS.

Danny Huntington referred to the WIPO meeting on Privilege in May, at which FICPI would provide three speakers. He asked about IP Australia's plans for attending. Michael O'Rourke explained that registered patent attorneys had privilege in Australia but that this did not extend to communications with foreign patent attorneys. A paper produced by IPRIA in 2007 had been in favour of extending privilege to communications with overseas patent attorneys. Progress in this area was held up in view of more general legal privilege issues. It was possible that IP Australia would attend the WIPO meeting. Greg Chambers commented that the issue was not privilege for patent attorneys, but privilege controlled by clients, in respect of communications between clients and their patent attorneys. Greg Chambers noted that the proposal for change being sought by FICPI Australia and other groups such as the Law Council and IPTA should not be affected by broader reviews currently being conducted in relation to privilege. The privilege proposed for communications between clients and local and overseas patent attorneys would remain the same as whatever privilege would exist in communications between a client and a lawyer. Michael O'Rourke stated that this had not been considered and might provide an avenue to progress discussions on the proposal for change. Fatima Beattie reassured Greg Chambers that there was support for progress but that this required all of government approval. Danny Huntington hoped that someone from IP Australia would indeed be present at the WIPO meeting.

4. DIVISIONAL PATENT APPLICATIONS - IP AUSTRALIA'S PLANS?

Danny Huntington asked about the status of divisional application practice in Australia, referring to the Amicus brief filed in the United States by FICPI in relation to the proposed rule changes there. Fatima Beattie confirmed that divisional practice was under consideration in Australia. Danny Huntington explained that limiting the number of divisional applications could cause difficulties for applicants in some technical areas such as biotechnology. Fatima Beattie indicated that if there were to be any further consideration of a change in this area of practice, it would be raised with the Patents Consultation Group.

5. OBLIGATION TO FILE FOREIGN SEARCH RESULTS UNDER S.45(3) - CONCERNS FOR PATENTS GRANTED TO WHICH THE PENALTIES STILL APPLY.

Greg Chambers referred to the issue of cases filed in 2002-7 where amendment may not be allowed because search results were not properly filed. He expressed the view that it would be best to repeal the relevant amendment provision. Danny Huntington asked if there were plans on this matter. Victor Portelli indicated that, after some consideration, there were no plans to change the law. Peter Huntsman argued forcefully that the system which had been introduced was bad, leaving patents which were granted in this period in a worse position



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than other patents. Victor Portelli restated that there were no immediate plans to change, but acknowledged the concerns.

6. IP AUSTRALIA'S VIEWS ON THE FUTURE OF THE MADRID SYSTEM.

Coleen Morrison introduced two trade mark topics. She indicated that FICPI was keen to have an idea of IP Australia's attitude to the Madrid system, explaining FICPI's concerns over developments at recent WIPO meetings. She explained that the interest was in relation to the quality of data which was going to the Madrid system. John Braybrooks indicated that there should be strong and significant movement at the next Madrid system user meeting in May. He explained that IP Australia had made significant representations regarding improving the quality of data. Coleen Morrison asked about improving quality across a variety of offices. John Braybrooks was in agreement and indicated that IP Australia's papers were on the WIPO website.

7. WHAT PRIORITY DOES IP AUSTRALIA PLACE ON ALLOWING PARTIES IN A TRADE MARK OPPOSITION TIME TO SETTLE, AND HOW IS THIS ACHIEVED.

Coleen Morrison referred to changes under Canadian practice relating to trade mark oppositions. She asked about Australian practice. In turn, Fatima Beattie asked about Canadian practice. John Braybrooks thought that the Australian system gave ample time to allow settlement negotiations. The Australian office looked seriously at requests for extensions of time and the possibility of settlement. David Griffith thought that there were no problems under Australian practice. Coleen Morrison explained that the Canadian practice was largely driven by the US situation. David Griffith explained that Australia has always been reasonable. Greg Chambers asked about the new practice note on oppositions, especially the requirement for consent of other parties, which had come as a surprise to FICPI Australia. Fatima Beattie understood that it had not been intentional that FICPI Australia had not been consulted. FICPI Australia had been invited to attend the next user group meeting on 29 April 2008. Coleen Morrison thought that the SCT would be a good forum for establishing best practice on opposition procedures. Victor Portelli referred favourably to UK practice in oppositions.

8. NOTICES OF ENTITLEMENT - S.15(1) TO BE AMENDED TO AVOID PROBLEMS ARISING FROM GRANT TO A PARTY NOT ENTITLED?

Peter Huntsman emphasised that there were problems in Australia if the party entitled to be granted a patent were not correctly identified. Victor Portelli confirmed that there were now no plans to abandon the "Notice of Entitlement" practice. Specific problems should be raised. He noted that S15(1) was under review.



9. COMPARISON OF PROVISIONS AROUND THE WORLD FOR FURTHER PROCESSING/RESTORATION OF A PATENT/APPLICATION WHERE A DEADLINE HAS BEEN MISSED.

David Bannerman explained that FICPI has always supported liberal provisions for correcting mistakes during patent prosecution. He referred to the changes in Europe as a result of the EPC 2000 revisions and that errors which had formerly required an application for restitution could now be corrected by the much simpler further processing route. He asked how liberal was the situation in Australia. Noel Brett indicated that the Australian system of extensions was possibly the most liberal in the world. David Bannerman asked if there had been any problems with the liberal approach. Ivan Ahlert referred to the more conservative approach in Brazil to the correction of errors and the stringent requirements for obtaining restoration. Practice in Brazil was very severe. Philip Spann indicated that IP Australia had not experienced problems with the more liberal approach. Noel Brett thought that the Australian system was excellent. Victor Portelli explained the background to Australian practice and the checks and balances which were built into the system. Fatima Beattie indicated that that extensions of time do cause concern in opposition cases.

10. ADVISORY SERVICES PROVIDED BY IP OFFICES (PATENTS, TRADE MARKS, DESIGNS).

Danny Huntington explained the background to this topic, indicating that the intellectual property system worked well and FICPI's concern at patent offices moving into giving advice to users. Peter Huntsman sought IP Australia's views and Greg Chambers gave the "assisted filing service" as an example. Fatima Beattie commented that generally the system did not work well because there was still significant lack of understanding of the IP System. The question IP Australia was addressing was how far into providing information to users about intellectual property does IP Australia need to be. Fatima Beattie thought that much more needed to be done to provide education for potential users of the system. Danny Huntington explained that this was not FICPI's concern. John Braybrooks explained that it was within IP Australia's remit to provide information about the intellectual property system, but would not provide advice. David Griffith reflected on the origins of the "Headstart" programme to help people to get into the intellectual property system and explained that this caused problems with respect to international strategy and some users having to adopt new trade marks. He thought the system worked well for users who only wanted to get into the Australian market, but was not good for other users. He had had experience of sorting out problems which had been created by the system. John Braybrooks emphasised that the desire was not to move into providing advice. Victor Portelli noted that he was responsible for the assisted filing program and explained that IP Australia did encourage users to get professional advice. Coleen Morrison mentioned that Australian private applicants had approached her to file trade mark applications in Canada without wishing to engage her professionally.



11. AUSTRALIAN INNOVATION PATENTS - PROS AND CONS.

Fatima Beattie explained that innovation patents were a second tier system. About 1000 applications a year were received, with such patents being granted without examination. They had to be examined before an infringement action could be taken. "Innovation divisionals" were being filed by sophisticated users wishing to tackle infringement quickly. David Bannerman asked how IP Australia handled the two different levels of inventive step for normal and innovation patents respectively, especially since the CET had initiated a study on how inventive step/non-obviousness was dealt with in different jurisdictions. Danny Huntington asked if innovation patents had been a success. Michael O'Rourke indicated that IP Australia would continue to consider whether these patents were meeting policy objectives. David Griffith explained the problem of early publication of innovation patents which could be an advantage for sophisticated users but could cause problems for unsophisticated users. Kasuaki Takami asked whether examination was conducted by IP Australia or by the court. Michael O'Rourke indicated that IP Australia examined such cases.

Danny Huntington thanked Fatima Beattie for bringing her team to the meeting. Fatima Beattie welcomed the exchange of different perspectives. She also noted that IP Australia as a government agency needed to balance the interests of applicants and the public more generally in its advice to Government. Also she noted that IP Australia is not the sole provider of IP advice to Government.

Meeting closed 9 a.m.