

Dear Jeff,

On behalf of FICPI Australia I add the following comments to those previously made in relation to these issues.

Time to Request Examination

I confirm that FICPI Australia has no objection to the proposal to reduce the currently prescribed period of six months. However, we believe that the proposed period of two months is too short. Often, a direction to request examination goes through many hands before a decision to request examination is made and the request filed. In many cases the direction will come first to an Australian attorney firm. In such a case, it will then be processed within the Australian attorney firm and entered into the appropriate computer systems for reminder.

Communication will then often be referred to an attorney overseas who will in turn refer the direction to the client for instructions. Often the client will be organised to have an IP Manager who will in turn refer the direction to the relevant business unit that will wish to discuss whether to proceed with the examination of the application. The decision is then communicated back through the same chain. In the ordinary course there can be minor delays at each of these points in the communication chain. We consider a more realistic time frame is four months. We submit that the proposed two month time frame would lead to an increased incidence in section 223 applications for extension of time, which would add an unnecessary administrative burden. By and large we consider that this would be avoided if the time frame was in the order of four months.

Revocation of Acceptance

Since the last PCG meeting there have been further discussions within the council of FICPI Australia regarding this issue. FICPI Australia understands the motivation for having the power to revoke acceptance in similar fashion as under the Trade Marks Act. However, there are very real differences in procedure when one is dealing with the registration of a trade mark as opposed to the grant of a patent. Once a trade mark is registered, the Registrar is not generally in a position to re-consider registrability. Once a patent has been granted, the position is not the same. The Commissioner may at any time after acceptance, re-examine the complete specification. Grant of the patent may then be refused under Section 100A or, where a patent has already been granted, the patent may be revoked under Section 101.

The question then arises, if a power is to be given to the Commissioner to withdraw acceptance in circumstances where re-examination would not be the more appropriate course to follow, what are those circumstances? It is our understanding that the Registrar of Trade Marks rarely exercises the power to withdraw acceptance, and, in those cases where she does, it is almost exclusively when a prior mark was not located during examination and is relevant to the registrability of the mark. The corresponding circumstances under the Patents Act are, we believe, adequately addressed through the re-examination provisions.

Whilst there may be other circumstances which would warrant the withdrawal of acceptance, FICPI Australia would like to see these circumstances articulated more clearly. The case described in Discussion paper 4 could be addressed by giving the power to the Commissioner to withdraw acceptance on the request of the applicant.

We would support such a power. We believe that in cases where a concern is expressed by a third party (for example, because of inventorship issues or section 40 issues) it would be more appropriate for the third party to agitate these concerns through an opposition. We also note that the Commissioner has the power to seek the revocation of a patent pursuant to Section 138.

Thus, whilst FICPI Australia is not closed to the idea of the Commissioner having a limited right to withdraw acceptance, we would need to understand better what is proposed in terms of the circumstances where the power would be exercised. In general, FICPI Australia does not support a broad power to withdraw acceptance where other specific procedures are already provided under the current legislation.

We look forward to discussing these issues further at future PCG meetings.

Greg Chambers
Secretary
FICPI Australia
greg.chambers@pof.com.au
T: +613 9614 1944
F: +613 9622 2255

Important Notice

This email transmission may contain confidential information and may be legally privileged. This transmission is intended for use exclusively by the addressee. If you are not the intended recipient please advise us immediately. We agree to reimburse you for any costs involved. It is strictly prohibited to use, copy, disseminate or distribute this transmission other than for the purpose intended.