

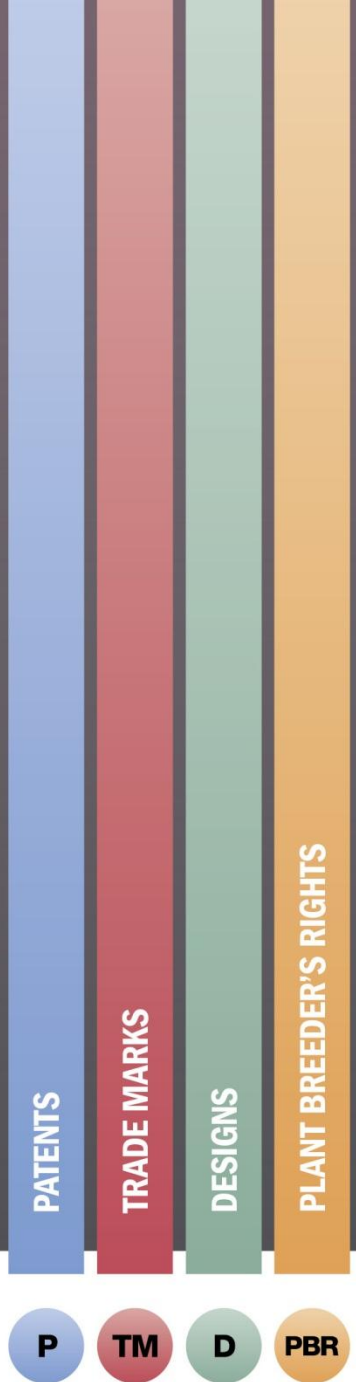


Australian Government
IP Australia

Raising the Bar

Terry Moore
IP Australia

FICPI 2011 Annual Meeting



Robust intellectual property rights delivered efficiently



‘Raising the Bar’ – to help or hinder

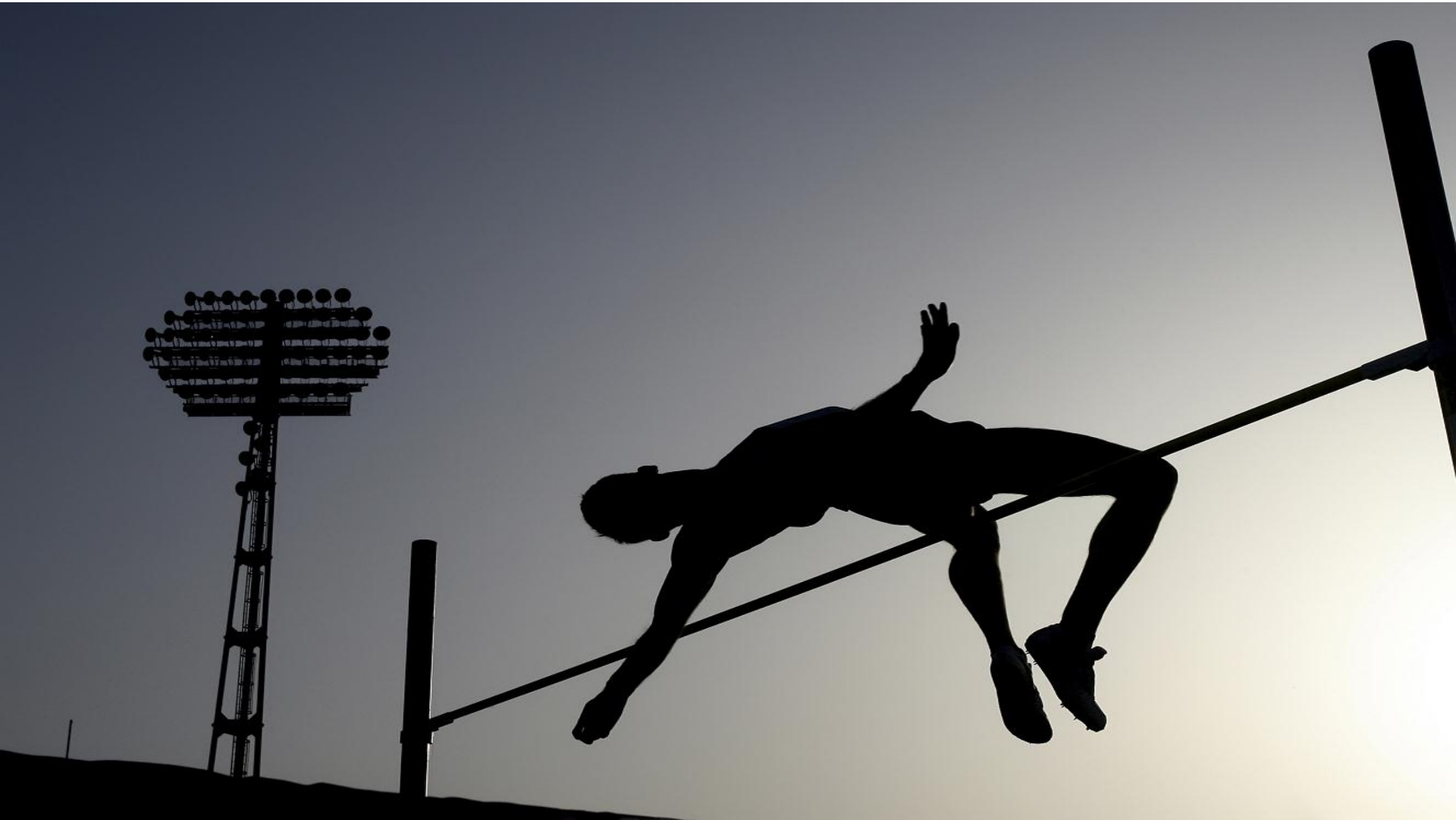
The Australian IP system should help, and not hinder innovation.

- The elements that matter:
 - Standards
 - Certainty
 - Professionals
 - Enforcement
 - Administrative processes





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- **Background**
- **Raising the Bar**
- **What next?**



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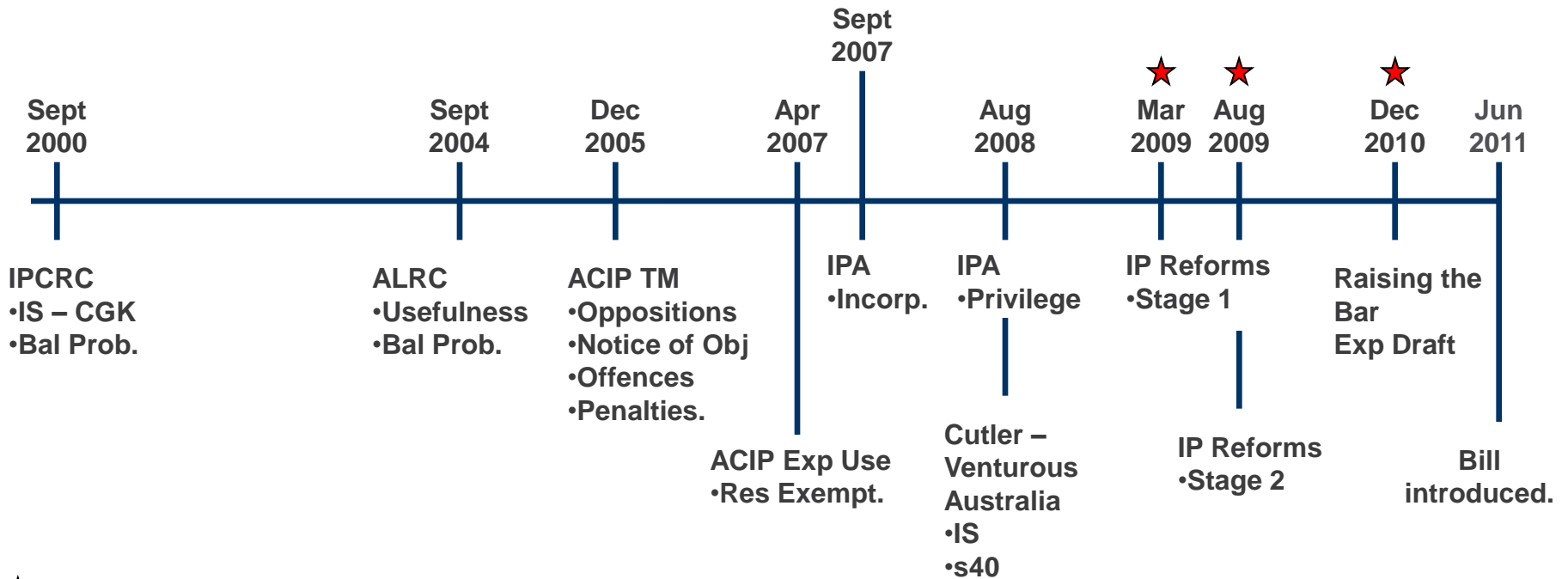


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Where it all started



★ IP Reforms public consultation



The 'Raising the Bar' Bill

- Raising the quality of granted patents
- Experimental & regulatory use exemptions
- Reducing delays in resolving applications
- Assisting the operations of the IP profession
- Improving enforcement
- Simplifying the IP system



Schedule 1 – raising the quality of granted patents (1)

- Inventive step
 - CGK is not just CGK in Australia
 - ‘ascertained, understood and regarded as relevant’
- Full description
 - Clear enough and complete enough to be performed by a PSA



Schedule 1 – raising the quality of granted patents (2)

- Replace ‘fair basis’ with ‘support’
 - Basis in description for each claim
 - Scope of each claim must not be broader than is justified by the description



Schedule 1 – raising the quality of granted patents (3)

- Specific, substantial and credible use
 - Retains existing requirement of usefulness – must achieve promise of invention
 - Grounds for examination & re-examination
 - Balance of probabilities



Schedule 2 – greater certainty for researchers

- Experimental use exemption
 - Main/predominant purpose is experimentation
- Regulatory use exemption
 - Pre-market approval



Schedule 3 – reducing delays (1)

- Divisional applications
 - Filed within 3 months of acceptance
 - Can't withdraw opposed applicaiton if have unresolved divisional claiming same invention



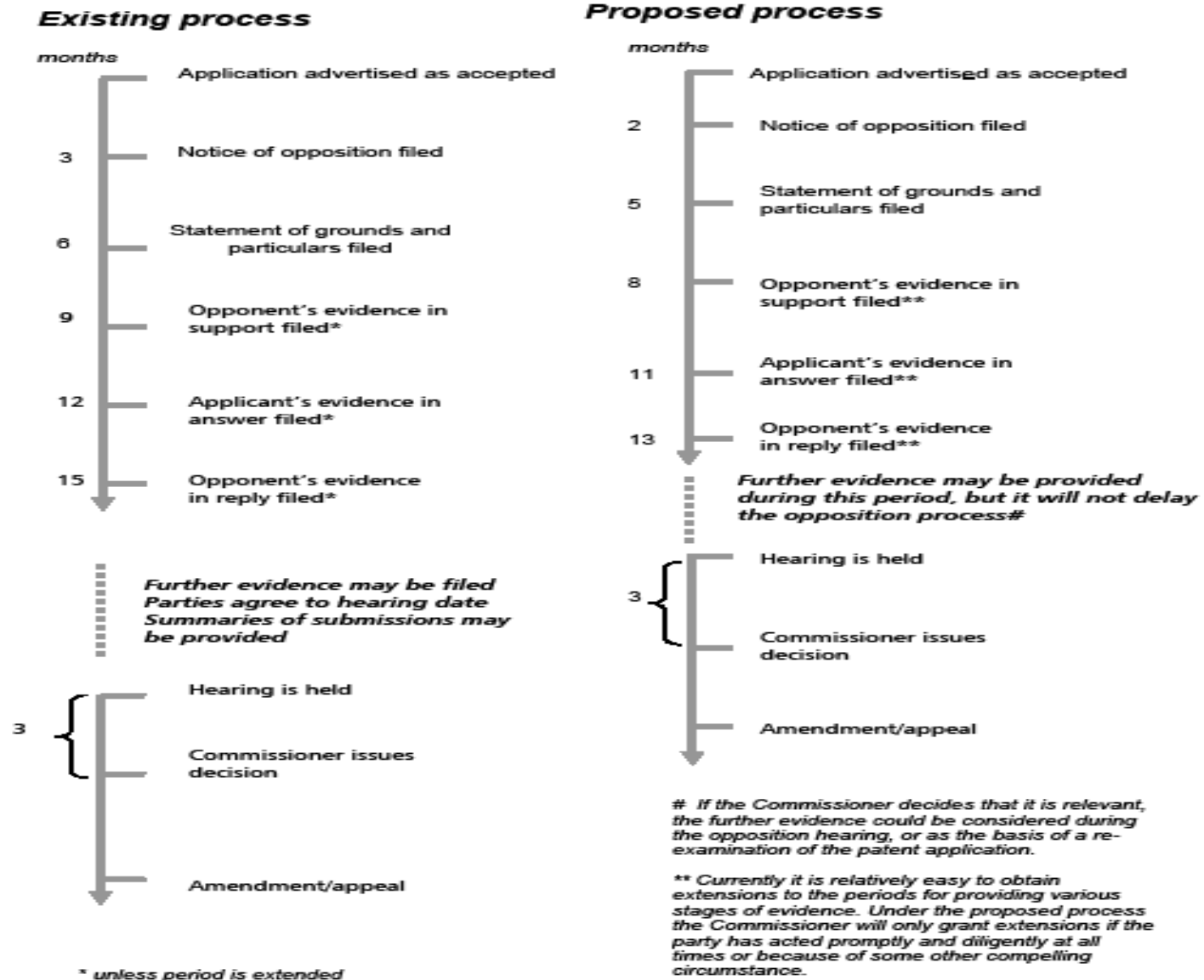
Schedule 3 – reducing delays (2)

- Oppositions
 - extensions of time
 - Further evidence
 - Trade Marks
 - Statement of Grounds and Particulars
 - Notice of intention to defend
 - Cooling off period

Resolving Patent Opposition Proceedings Faster



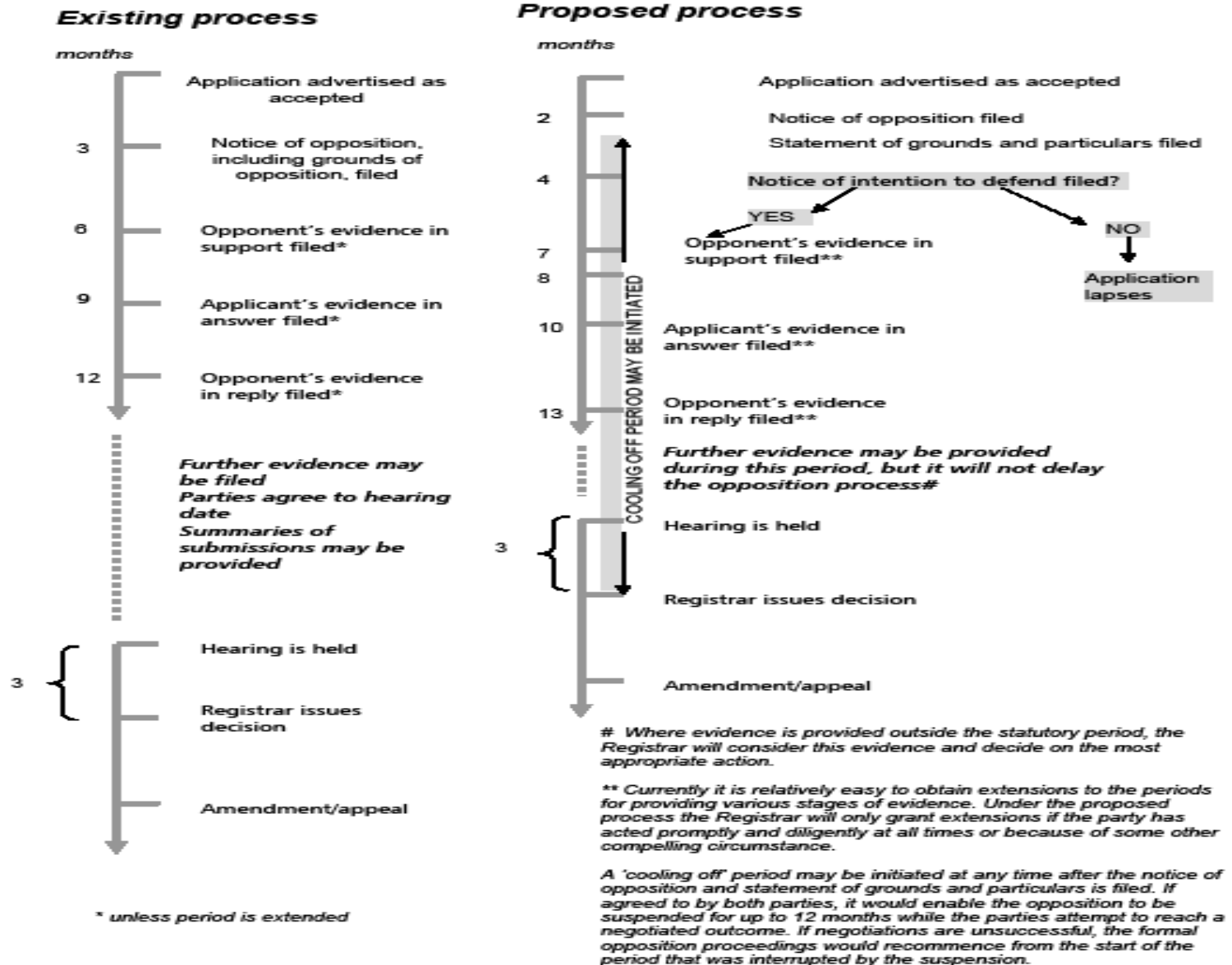
Figure 1: Typical steps in substantive opposition to grant of a patent



Resolving Trade Mark Opposition Proceedings Faster



Figure 1: Typical steps in substantive opposition to registration of a trade mark





Schedule 4 – the attorney profession (1)

- Privilege – attorney-client communications
 - Communications with foreign attorney
 - Documents prepared by third party
 - Applies to those permitted to practice as patent or trade mark attorneys in country where communication occurs



Schedule 4 – the attorney profession (2)

- Incorporation
 - Patent and Trade Mark attorneys can incorporate.
 - Must have patent or trade mark attorney director
 - Can do patents work if lawyer, but can't describe company as patent attorney



Schedule 5 - enforcement

- Notice of objection scheme
 - Confiscated goods only returned if notice for return lodged w/in specified time
 - Valid address required
 - Customs can give information about size and content of seizure and release samples



Schedule 5 – enforcement (2)

- Offences and penalties
 - Increase penalties for indictable offences
 - Introduce summary offences
 - Fault element – recklessness -> negligence
 - Lower penalty than for indictable offences
 - Strict liability for jurisdictional offences



Schedule 6 – Reducing complexity

- Federal Magistrates Court – Designs & TM
- Omnibus claims
- Entitlement
 - Not invalid solely because not correctly entitled
 - Commissioner can rectify Register



Schedule 6 – improving the operations of the Patents Act (2)

- Grace period
 - Novelty and inventive step
 - Complete application filed in prescribed period
- Secret use



Application and transitional provisions

- Amendments to raise standards will apply to all applications where examination not requested at commencement
 - Balance public interest with applicant interests
 - Applicant can request early exam or amend
- Changes commence 12 months after Royal Assent
 - Extra time to decide what to do and consult on Regulations



What next?

- Debated in Spring Sittings – mid-August to November 2011
- If passed in Spring – commence in Aug-Sept 2012
- Consultation on Regulations end 2011-early 2012



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And then what?





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Thank you

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