



# **Intellectual Property Laws Amendment Act 2006**

**No. 106, 2006**

**An Act to amend the law relating to intellectual  
property, and for related purposes**

Note: An electronic version of this Act is available in ComLaw (<http://www.comlaw.gov.au/>)



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# Intellectual Property Laws Amendment Act 2006

No. 106, 2006

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## **An Act to amend the law relating to intellectual property, and for related purposes**

[Assented to 27 September 2006]

The Parliament of Australia enacts:

### **1 Short title**

This Act may be cited as the *Intellectual Property Laws  
Amendment Act 2006*.

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## 2 Commencement

- (1) Each provision of this Act specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.

<b>Commencement information</b>		
<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
<b>Provision(s)</b>	<b>Commencement</b>	<b>Date/Details</b>
1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table	The day on which this Act receives the Royal Assent.	27 September 2006
2. Schedule 1	A single day to be fixed by Proclamation. However, if any of the provision(s) do not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, they commence on the first day after the end of that period.	27 March 2007
3. Schedule 2	A single day to be fixed by Proclamation. However, if any of the provision(s) do not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, they commence on the first day after the end of that period.	27 March 2007
4. Schedule 3, Part 1	The day after this Act receives the Royal Assent.	28 September 2006
5. Schedule 3, Part 2	A single day to be fixed by Proclamation. However, if any of the provision(s) do not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, they commence on the first day after the end of that period.	27 March 2007

<b>Commencement information</b>		
<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
<b>Provision(s)</b>	<b>Commencement</b>	<b>Date/Details</b>
6. Schedule 4	A single day to be fixed by Proclamation. However, if any of the provision(s) do not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, they commence on the first day after the end of that period.	27 March 2007
7. Schedules 5 and 6	The day after this Act receives the Royal Assent.	28 September 2006
8. Schedule 7	The 28th day after the day on which this Act receives the Royal Assent.	25 October 2006
9. Schedules 8 and 9	The day after this Act receives the Royal Assent.	28 September 2006
10. Schedule 10	A single day to be fixed by Proclamation. However, if any of the provision(s) do not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, they commence on the first day after the end of that period.	27 March 2007
11. Schedule 11	The day after this Act receives the Royal Assent.	28 September 2006
12. Schedule 12	A single day to be fixed by Proclamation. However, if any of the provision(s) do not commence within the period of 6 months beginning on the day on which this Act receives the Royal Assent, they commence on the first day after the end of that period.	27 March 2007
13. Schedules 13 to 15	The day after this Act receives the Royal Assent.	28 September 2006
14. Schedule 16, item 1	At the same time as Schedule 1 to the <i>Therapeutic Goods Amendment (Medical Devices) Act 2002</i> commences.	4 October 2002
15. Schedule 16, item 2	Immediately after the commencement of section 84 of the <i>Trade Marks Act 1995</i> .	1 January 1996

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**Commencement information**

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<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
<b>Provision(s)</b>	<b>Commencement</b>	<b>Date/Details</b>
16. Schedule 16, item 3	At the same time as item 943 of Schedule 1 to the <i>Public Employment (Consequential and Transitional) Amendment Act 1999</i> commences.	5 December 1999

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Note: This table relates only to the provisions of this Act as originally passed by the Parliament and assented to. It will not be expanded to deal with provisions inserted in this Act after assent.

- (2) Column 3 of the table contains additional information that is not part of this Act. Information in this column may be added to or edited in any published version of this Act.

### **3 Schedule(s)**

Each Act that is specified in a Schedule to this Act is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this Act has effect according to its terms.



## **Schedule 1—Revoking registration of trade marks etc.**

### ***Trade Marks Act 1995***

#### **1 Subsection 38(1)**

Repeal the subsection, substitute:

- (1) Before a trade mark is registered, the Registrar may revoke the acceptance of the application for registration of the trade mark if he or she is satisfied that:
  - (a) the application should not have been accepted, taking account of all the circumstances that existed when the application was accepted (whether or not the Registrar knew then of their existence); and
  - (b) it is reasonable to revoke the acceptance, taking account of all the circumstances.

#### **2 Application of amendment of section 38**

The amendment of section 38 of the *Trade Marks Act 1995* made by this Schedule applies in relation to the acceptance of an application for registration of the trade mark whether the acceptance occurred before, on or after the commencement of the amendment.

#### **3 At the end of section 73**

Add:

Note: Section 84C explains the effect of revocation of the registration of a trade mark, applying some provisions as if the registration had ceased at a particular time (but for most purposes treating the registration as if it had never occurred).

#### **4 Part 8 (heading)**

Repeal the heading, substitute:

## **Part 8—Amendment, cancellation and revocation of registration**

#### **5 Before section 81**

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Insert:

## **Subdivision A—Amending Register**

### **6 Before section 84**

Insert:

## **Subdivision B—Cancelling registration**

### **7 At the end of Division 1 of Part 8**

Add:

## **Subdivision C—Revoking registration**

### **84A Registration may be revoked**

#### *Power to revoke*

- (1) The Registrar may revoke the registration of a trade mark if he or she is satisfied that:
  - (a) the trade mark should not have been registered, taking account of all the circumstances that existed when the trade mark became registered (whether or not the Registrar knew then of their existence); and
  - (b) it is reasonable to revoke the registration, taking account of all the circumstances.
- (2) The circumstances to be taken into account under paragraph (1)(a) include the following:
  - (a) any errors (including errors of judgment) or omissions that led directly or indirectly to the registration;
  - (b) any relevant obligations of Australia under an international agreement;
  - (c) any special circumstances making it appropriate:
    - (i) not to register the trade mark; or
    - (ii) to register the trade mark only if the registration were subject to conditions or limitations to which the registration was not actually subject.
- (3) The circumstances to be taken into account under paragraph (1)(b) include the following:

- (a) any use that has been made of the trade mark;
- (b) any past, current or proposed legal proceedings relating to the trade mark as a registered trade mark or to the registration of the trade mark;
- (c) other action taken in relation to the trade mark as a registered trade mark;
- (d) any special circumstances making it appropriate:
  - (i) to revoke the registration; or
  - (ii) not to revoke the registration.

Note: For *use of a trade mark* see section 6.

*Prerequisites to revocation decision*

- (4) The Registrar may revoke the registration of the trade mark only if the Registrar gives notice of the proposed revocation to each of the following persons in accordance with the regulations within 12 months of registering the trade mark:
  - (a) the registered owner of the trade mark;
  - (b) any person recorded under Part 11 as claiming a right in respect of, or an interest in, the trade mark.

Note: For *registered owner* see section 6.

- (5) The Registrar must not revoke the registration of the trade mark without giving each of the following persons the opportunity to be heard:
  - (a) the registered owner of the trade mark;
  - (b) any person recorded under Part 11 as claiming a right in respect of, or an interest in, the trade mark.

Note: For *registered owner* see section 6.

*No duty to consider whether to revoke*

- (6) The Registrar does not have a duty to consider whether to revoke the registration under this section, whether or not the Registrar is requested to do so.

**84B Registration must be revoked if opposition was ignored in registration process**

The Registrar must revoke the registration of a trade mark if:

- (a) either:
  - (i) a notice of opposition to the registration was filed in accordance with subsection 52(2); or
  - (ii) before the registration, a person applied in accordance with the regulations for an extension of the period for filing a notice of opposition to the registration; and
- (b) the Registrar failed to take account of the opposition or application in deciding to register the trade mark; and
- (c) the Registrar becomes aware of the failure within 1 month after the notice was filed or the application was made.

The revocation must be done within that month.

Note: If the Registrar becomes aware of the failure later, he or she may be able to revoke the registration under section 84A.

### **84C Effect of revocation of registration**

- (1) This section applies if the Registrar revokes the registration of a trade mark under section 84A or 84B.
- (2) This Act generally applies as if the registration had never occurred, but:
  - (a) subsection 129(4) applies as if the trade mark had ceased to be registered at the time of the revocation; and
  - (b) if the Customs CEO, purporting to act under Part 13, seizes goods in respect of which the trade mark was registered before the revocation, the Commonwealth is not liable for any loss or damage suffered because of the seizure, unless:
    - (i) the Registrar gives the Customs CEO written notice of the revocation; and
    - (ii) the seizure occurs after the notice is given to the Customs CEO; and
  - (c) Part 14 applies as if the trade mark had ceased to be registered at the time of the revocation; and
  - (d) subsection 230(2) applies in relation to a defendant who was the registered owner of the trade mark before the revocation as if the trade mark had ceased to be registered at the time of the revocation; and
  - (e) subsection 230(2) applies in relation to a defendant who was an authorised user of the trade mark before the revocation as

if the trade mark had ceased to be registered at the time the defendant became aware of the revocation.

Note: For *registered owner* see section 6.

- (3) To avoid doubt, paragraph (2)(b) does not, by itself, make the Commonwealth liable if the circumstances described in subparagraphs (2)(b)(i) and (ii) exist.
- (4) This Act applies as if, just after the revocation:
  - (a) the application for registration of the trade mark reflected the particulars in the Register for the trade mark just before the revocation; and
  - (b) the applicant for registration of the trade mark were the person in whose name the trade mark was registered just before the revocation.
- (5) This subsection has effect if the Registrar revokes the acceptance of the application for registration of the trade mark after revoking the registration. The Registrar may, but need not, examine the application again under section 31 before rejecting the application. This has effect despite paragraph 38(2)(b).

#### **84D Appeal from revocation of registration**

An appeal lies to the Federal Court from a decision of the Registrar to revoke the registration of a trade mark under section 84A.

#### **8 After subsection 224(3)**

Insert:

- (3A) If the Registrar has revoked the registration of a trade mark, he or she may extend the time for doing a relevant act that is required by this Act to be done within a certain time in connection with the application for registration of the trade mark.

#### **9 Application of amendments of Part 8 and section 224**

The amendments of Part 8 and section 224 of the *Trade Marks Act 1995* made by this Schedule apply in relation to trade marks that became registered on or after the commencement of this Schedule.

## **Schedule 2—Non-payment of fees relating to trade marks**

### ***Trade Marks Act 1995***

#### **1 Subsections 223(3), (4) and (5)**

Repeal the subsections, substitute:

- (3) The regulations may provide for the consequences (for the purposes of this Act) of failing to pay a fee in accordance with the regulations.
- (4) In particular, the regulations may provide that, for the purposes of this Act:
  - (a) an act is not to be done, or is taken not to have been done, if the fee for doing the act is not paid in accordance with the regulations; or
  - (b) a document is not filed, or is taken not to have been filed, if the fee for filing the document is not paid in accordance with the regulations; or
  - (c) an application for registration of a trade mark lapses, or is taken to have lapsed, if the fee for filing the application is not paid in accordance with the regulations.
- (5) Subsection (4) does not limit subsection (3).

#### **2 Application**

The amendment made by this Schedule applies in relation to fees that become payable after the commencement of this Schedule.

## **Schedule 3—Registration process for certification trade marks**

### **Part 1—Amendments commencing on day after Royal Assent**

#### *Trade Marks Act 1995*

##### **1 Subsection 173(2)**

Repeal the subsection, substitute:

- (2) The rules must specify:
  - (a) the requirements (the *certification requirements*) that goods and/or services must meet for the certification trade mark to be applied to them; and
  - (b) the process for determining whether goods and/or services meet the certification requirements; and
  - (c) the attributes that a person must have to become a person (an *approved certifier*) approved to assess whether goods and/or services meet the certification requirements; and
  - (d) the requirements that a person, who is the owner of the certification trade mark or an approved user, must meet to use the certification trade mark in relation to goods and/or services; and
  - (e) the other requirements about the use of the certification trade mark by a person who is the owner of the certification trade mark or an approved user; and
  - (f) the procedure for resolving a dispute about whether goods and/or services meet the certification requirements; and
  - (g) the procedure for resolving a dispute about any other issue relating to the certification trade mark.
- (3) The rules must also include any other matter the Commission requires to be included.
- (4) The rules may also include any other matter the Commission permits to be included.

##### **2 Application of amendment of section 173**

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The amendment of section 173 of the *Trade Marks Act 1995* made by this Part applies in relation to rules filed on or after the commencement of the amendment.

### **3 Paragraph 175(2)(a)**

Repeal the paragraph, substitute:

- (a) the attributes a person must have to become an approved certifier are sufficient to enable the person to assess competently whether goods and/or services meet the certification requirements; and

### **4 Subsection 175(2) (note 2)**

Repeal the note, substitute:

Note 2: For *approved certifier* see paragraph 173(2)(c).

Note 3: For *certification requirements* see paragraph 173(2)(a).

### **5 Application of amendments of section 175**

The amendments of section 175 of the *Trade Marks Act 1995* made by this Part apply in relation to decisions to give, or refuse to give, a certificate relating to rules filed on or after the commencement of this Part.

### **6 Subsection 177(1) (note 2)**

Omit “173(2)(a)”, substitute “173(2)(c)”.

### **7 Subsection 181(2) (note 2)**

Omit “173(2)(a)”, substitute “173(2)(c)”.



## **Part 2—Amendments commencing on proclaimed day or after 6 months**

### ***Trade Marks Act 1995***

#### **8 Section 174**

Repeal the section, substitute:

#### **174 Registrar to send documents to Commission**

The Registrar must send the prescribed documents relating to the application to the Commission in accordance with the regulations.

#### **9 Application of new section 174**

- (1) Section 174 (the ***new section 174***) of the *Trade Marks Act 1995* as amended by this Part applies to applications filed before, on or after the commencement of this Part.
- (2) However, the new section 174 does not require the Registrar to send to the Commission documents relating to an application if:
  - (a) the Registrar sent documents relating to the application to the Commission before the commencement of this Part under section 174 (the ***old section 174***) of the *Trade Marks Act 1995* as in force before that commencement; or
  - (b) the old section 174 did not require the Registrar to send a copy of the application to the Commission.

#### **10 Subsection 176(1)**

Repeal the subsection, substitute:

- (1) The Registrar must accept the application if:
  - (a) the application is made in accordance with this Act; and
  - (b) there are no grounds for rejecting the application; and
  - (c) the Commission has given a certificate under subsection 175(2).

Otherwise the Registrar must reject the application.

- (1A) However, the Registrar must give the applicant an opportunity to be heard before rejecting the application solely because one or both of the conditions in paragraphs (1)(a) and (b) are not met.

Note: The heading to section 176 is replaced by the heading “**Acceptance or rejection of application**”.

### **11 Application of new subsection 176(1)**

- (1) Subsection 176(1) (the *new subsection 176(1)*) of the *Trade Marks Act 1995* as amended by this Part applies to applications filed before, on or after the commencement of this Part.
- (2) However, the new subsection 176(1) does not apply to applications accepted or rejected under Part 16 of the *Trade Marks Act 1995* before the commencement of this Part.

### **12 Subsection 178(4)**

Repeal the subsection, substitute:

- (4) The Commission must notify, in accordance with the regulations, a decision to approve a variation or not to approve a variation.

### **13 Subsection 178(6)**

Repeal the subsection.

### **14 Application of amendments of section 178**

The amendments of section 178 of the *Trade Marks Act 1995* made by this Part apply in relation to decisions made on or after the commencement of this Part to approve or not to approve variations of rules governing the use of certification trade marks.

### **15 Section 179**

Repeal the section, substitute:

### **179 Registrar must publish rules**

The Registrar must publish, in accordance with the regulations, rules governing the use of a certification trade mark.

### **16 Saving of rules made available under old section 179**

The Registrar is not required by section 179 of the *Trade Marks Act 1995* as amended by this Part to publish rules that have before the commencement of this Part been, and continue to be, made available as required by section 179 of that Act as in force before the commencement of this Part, unless the rules are varied.

## **Schedule 4—Availability of documents about trade marks**

### ***Trade Marks Act 1995***

#### **1 At the end of Division 1 of Part 21**

Add:

#### **217A Prescribed documents relating to trade marks to be made available for public inspection**

- (1) The Registrar must make available for public inspection prescribed documents that relate to a trade mark while they are held in the Trade Marks Office at or after the time particulars of the application for registration of the trade mark are published under section 30.
- (2) A document may be prescribed for the purposes of subsection (1) wholly or partly by reference to the fact that it does not contain information covered by a requirement under section 226A. This does not limit the ways in which documents may be prescribed for those purposes.

#### **2 Application of section 217A**

Section 217A of the *Trade Marks Act 1995* applies in relation to applications, made on or after the commencement of that section, for registration of trade marks.

#### **3 After section 226**

Insert:

#### **226A Requirements for confidential treatment of information held in the Trade Marks Office**

- (1) In accordance with the regulations, the Registrar may:
  - (a) require that specified information in a document that has been filed, or is to be filed, in relation to a trade mark be held in the Trade Marks Office confidentially; and

- (b) make such a requirement subject to specified conditions and/or limitations; and
  - (c) vary or revoke such a requirement, condition or limitation.
- (2) The regulations may provide for procedures to be followed in connection with the making, variation or revocation of a requirement under this section or of conditions or limitations on such a requirement.
- (3) If a requirement is made in writing under this section, the requirement is not a legislative instrument.

#### **4 Application of section 226A**

Section 226A of the *Trade Marks Act 1995* applies in relation to information in documents filed on or after the commencement of that section in relation to trade marks. It does not matter whether registration of the trade marks was applied for before, on or after that commencement.

## Schedule 5—Relief for infringement of patents

### *Patents Act 1990*

#### **1 After subsection 122(1)**

Insert:

- (1A) A court may include an additional amount in an assessment of damages for an infringement of a patent, if the court considers it appropriate to do so having regard to:
- (a) the flagrancy of the infringement; and
  - (b) the need to deter similar infringements of patents; and
  - (c) the conduct of the party that infringed the patent that occurred:
    - (i) after the act constituting the infringement; or
    - (ii) after that party was informed that it had allegedly infringed the patent; and
  - (d) any benefit shown to have accrued to that party because of the infringement; and
  - (e) all other relevant matters.

#### **2 Application**

The amendment of section 122 of the *Patents Act 1990* made by this Schedule applies to infringements of patents occurring on or after the commencement of this Schedule.

## **Schedule 6—Exemption of continued prior use from patent infringement**

### *Patents Act 1990*

#### **1 Section 119**

Repeal the section, substitute:

#### **119 Infringement exemptions: prior use**

- (1) A person may, without infringing a patent, do an act that exploits a product, method or process and would infringe the patent apart from this subsection, if immediately before the priority date of the relevant claim the person:

- (a) was exploiting the product, method or process in the patent area; or
- (b) had taken definite steps (contractually or otherwise) to exploit the product, method or process in the patent area.

Note 1: This section applies in relation to a patent granted as a result of an application filed on or after the commencement of Schedule 6 to the *Intellectual Property Laws Amendment Act 2006* (which repealed and substituted this section).

Note 2: Section 119 of this Act as in force before the commencement of that Schedule continues to apply in relation to patents granted as a result of earlier applications.

- (2) Subsection (1) does not apply if, before the priority date, the person:

- (a) had stopped (except temporarily) exploiting the product, method or process in the patent area; or
- (b) had abandoned (except temporarily) the steps to exploit the product, method or process in the patent area.

*Limit for product, method or process derived from patentee*

- (3) Subsection (1) does not apply to a product, method or process the person derived from the patentee or the patentee's predecessor in title in the patented invention unless the person derived the product, method or process from information that was made publicly available:

- (a) by or with the consent of the patentee or the patentee's predecessor in title; and
- (b) through any publication or use of the invention in the prescribed circumstances mentioned in paragraph 24(1)(a).

*Exemption for successors in title*

- (4) A person (the **disposer**) may dispose of the whole of the disposer's entitlement under subsection (1) to do an act without infringing a patent to another person (the **recipient**). If the disposer does so, this section applies in relation to the recipient as if the references in subsections (1), (2) and (3) to the person were references to:
  - (a) the disposer; or
  - (b) if the disposer's entitlement arose because of one or more previous applications of this subsection—the first person:
    - (i) who was entitled under subsection (1) (applying of its own force) to do an act without infringing the patent; and
    - (ii) to whom the disposer's entitlement is directly or indirectly attributable.

*Definition*

- (5) In this section:

**exploit** includes:

- (a) in relation to a product:
  - (i) make, hire, sell or otherwise dispose of the product; and
  - (ii) offer to make, hire, sell or otherwise dispose of the product; and
  - (iii) use or import the product; and
  - (iv) keep the product for the purpose of doing an act described in subparagraph (i), (ii) or (iii); and
- (b) in relation to a method or process:
  - (i) use the method or process; and
  - (ii) do an act described in subparagraph (a)(i), (ii), (iii) or (iv) with a product resulting from the use of the method or process.

## 2 Application

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The amendment of the *Patents Act 1990* made by this Schedule applies in relation to patents granted as a result of applications filed on or after the commencement of this Schedule.

## Schedule 7—Springboarding and patents

### *Patents Act 1990*

#### **1 Subsection 78(1)**

Omit “(1) If”, substitute “If”.

#### **2 Subsection 78(2)**

Repeal the subsection.

#### **3 After section 119**

Insert:

#### **119A Infringement exemptions: acts for obtaining regulatory approval of pharmaceuticals**

- (1) The rights of a patentee of a pharmaceutical patent are not infringed by a person exploiting an invention claimed in the patent if the exploitation is solely for:
  - (a) purposes connected with obtaining the inclusion in the Australian Register of Therapeutic Goods of goods that:
    - (i) are intended for therapeutic use; and
    - (ii) are not medical devices, or therapeutic devices, as defined in the *Therapeutic Goods Act 1989*; or
  - (b) purposes connected with obtaining similar regulatory approval under a law of a foreign country or of a part of a foreign country.
- (2) Subsection (1) does not apply to the export from Australia of goods for purposes described in paragraph (1)(b) unless the term of the patent has been extended under Part 3 of Chapter 6 and the goods consist of or contain:
  - (a) a pharmaceutical substance *per se* that is in substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification; or
  - (b) a pharmaceutical substance when produced by a process that involves the use of recombinant DNA technology, that is in

substance disclosed in the complete specification of the patent and in substance falls within the scope of the claim or claims of that specification.

Note: Part 3 of Chapter 6 provides for the extension of the term of standard patents claiming pharmaceutical substances.

(3) In this section:

***pharmaceutical patent*** means a patent claiming:

- (a) a pharmaceutical substance; or
- (b) a method, use or product relating to a pharmaceutical substance, including any of the following:
  - (i) a method for producing a raw material needed to produce the substance;
  - (ii) a product that is a raw material needed to produce the substance;
  - (iii) a product that is a pro-drug, metabolite or derivative of the substance.

#### **4 Application**

The amendments of the *Patents Act 1990* made by this Schedule apply in relation to the exploitation, at or after the time this Schedule commences, of inventions claimed in patents in force at or after that time.

## Schedule 8—Compulsory licensing of patents

### *Patents Act 1990*

#### **1 Subsection 133(1)**

Omit “a prescribed court”, substitute “the Federal Court”.

#### **2 Paragraphs 133(2)(a) and (b)**

Repeal the paragraphs, substitute:

- (a) all the following conditions exist:
  - (i) the applicant has tried for a reasonable period, but without success, to obtain from the patentee an authorisation to work the invention on reasonable terms and conditions;
  - (ii) the reasonable requirements of the public with respect to the patented invention have not been satisfied;
  - (iii) the patentee has given no satisfactory reason for failing to exploit the patent; or
- (b) the patentee has contravened, or is contravening, Part IV of the *Trade Practices Act 1974* or an application law (as defined in section 150A of that Act) in connection with the patent.

#### **3 Subsection 133(3A)**

Repeal the subsection.

#### **4 Paragraph 133(5)(b)**

Omit “a prescribed court”, substitute “the Federal Court”.

#### **5 At the end of paragraph 133(5)(b)**

Add “and the desirability of discouraging contraventions of Part IV of the *Trade Practices Act 1974* or an application law (as defined in section 150A of that Act)”.

#### **6 Subsections 133(6) and 134(1)**

Omit “a prescribed court”, substitute “the Federal Court”.

#### **7 Paragraphs 134(2)(a) and (b)**

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Repeal the paragraphs, substitute:

(a) both:

- (i) the reasonable requirements of the public with respect to the patented invention have not been satisfied; and
- (ii) the patentee has given no satisfactory reason for failing to exploit the patent; or

(b) the patentee is contravening Part IV of the *Trade Practices Act 1974* or an application law (as defined in section 150A of that Act) in connection with the patent.

## **8 After section 136**

Insert:

### **136A Dealing with allegation of contravention of application law**

Proceedings under section 133 or 134 involving an allegation of contravention of an application law that is a law of a State must be dealt with as if the law were a law of the Commonwealth.

Note: Those proceedings are in the Federal Court, which can only exercise the judicial power of the Commonwealth. This section lets the court deal comprehensively with the proceedings without the need for a court of the State to determine whether the application law has been contravened.

## **9 Application and saving provisions**

- (1) The amendments of the *Patents Act 1990* made by this Schedule apply in relation to conduct (including omissions) that:
  - (a) occurs after the commencement of this Schedule; and
  - (b) is connected with a patent granted before, on or after that commencement.
- (2) To avoid doubt, proceedings started in a prescribed court under section 133 or 134 of the *Patents Act 1990* but not concluded before the commencement of this Schedule may be continued in the court after that commencement as if the amendments of that Act by this Schedule had not been made.

## **Schedule 9—Specifying claims for innovation patents**

### *Patents Act 1990*

#### **1 At the end of paragraph 40(2)(c)**

Add “defining the invention”.

#### **2 Application**

The amendment of paragraph 40(2)(c) of the *Patents Act 1990* made by this Schedule applies to complete specifications relating to applications for innovation patents filed before, on or after the commencement of this Schedule.

## **Schedule 10—Making divisional applications for innovation patents**

### *Patents Act 1990*

#### **1 Subsection 79C(1)**

After “may”, insert “, in accordance with the regulations,”.

#### **2 Subsection 79C(2)**

Repeal the subsection, substitute:

- (2) The patentee may make the further complete application only during the period:
- (a) starting when an examination of the first patent begins; and
  - (b) ending when any of the following happens:
    - (i) the term of the first patent ends;
    - (ii) the first patent is revoked;
    - (iii) the first patent ceases;
    - (iv) a period prescribed by the regulations for the purposes of this subparagraph ends.

#### **3 Application**

The amendments made by this Schedule apply to the making of a complete application on or after the commencement of this Schedule, whether the first patent concerned was granted before, on or after that commencement.

## Schedule 11—Setting dates by regulations

### *Plant Breeder's Rights Act 1994*

#### **1 At the end of subsection 28(2)**

Add “or, if another date is determined under the regulations for the application, the date determined”.

#### **2 Application**

The amendment of the *Plant Breeder's Rights Act 1994* made by this Schedule applies in relation to applications lodged after the commencement of the amendment.

### *Trade Marks Act 1995*

#### **3 Section 6 (at the end of the definition of *filing date*)**

Add:

; or (e) in relation to a prescribed application—the day determined in the prescribed way.

#### **4 Application**

The amendment of the *Trade Marks Act 1995* made by this Schedule applies in relation to applications filed after the commencement of the amendment.



## **Schedule 12—Effect of office not being open for business**

### *Designs Act 2003*

#### **1 Section 129 (after the paragraph relating to Part 4)**

Insert:

Part 4A lets an act be done after the period otherwise provided for doing the act if that period ends on a day when the Designs Office or a sub-office is not open for business.
--

#### **2 After Part 4 of Chapter 11**

Insert:

### **Part 4A—Doing act after end of period otherwise provided for doing it**

#### **136A Doing act when Designs Office reopens after end of period otherwise provided for doing act**

- (1) If the last day of a period provided by this Act (except this section) or the regulations for doing an act is a day when the Designs Office, or a sub-office of the Designs Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.
- (2) For the purposes of this section, the Designs Office, or a sub-office of the Designs Office, is taken not to be open for business on a day:
  - (a) declared by regulations to be a day on which the office or sub-office is not open for business; or
  - (b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office or sub-office is not open for business.

*Declarations*

- (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.
- (4) A declaration mentioned in paragraph (2)(b):
  - (a) may be made before, on or after the day; and
  - (b) is not a legislative instrument.

*Relationship with other law*

- (5) This section has effect despite the rest of this Act.
- (6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

*Exception for prescribed act*

- (7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

***Olympic Insignia Protection Act 1987***

**3 At the end of Part 2.3**

Add:

**14A Doing act when Designs Office reopens after end of period otherwise provided for doing act**

- (1) If the last day of a period provided by this Chapter (except this section), or regulations made for the purposes of this Chapter, for doing an act is a day when the Designs Office is not open for business, the act may be done in prescribed circumstances on the next day when the office is open for business.
- (2) For the purposes of this section, the Designs Office is taken not to be open for business on a day:
  - (a) declared by regulations to be a day on which the office is not open for business; or

- (b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office is not open for business.

*Declarations*

- (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.
- (4) A declaration mentioned in paragraph (2)(b):
- (a) may be made before, on or after the day; and
  - (b) is not a legislative instrument.

*Relationship with other law*

- (5) This section has effect despite the rest of this Chapter.
- (6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

*Exception for prescribed act*

- (7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

## ***Patents Act 1990***

### **4 After section 222**

Insert:

#### **222A Doing act when Patent Office reopens after end of period otherwise provided for doing act**

- (1) If the last day of a period provided by this Act (except this section) for doing an act is a day when the Patent Office, or a sub-office of the Patent Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.

- (2) For the purposes of this section, the Patent Office, or a sub-office of the Patent Office, is taken not to be open for business on a day:
- (a) declared by regulations to be a day on which the office or sub-office is not open for business; or
  - (b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office or sub-office is not open for business.

*Declarations*

- (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.
- (4) A declaration mentioned in paragraph (2)(b):
- (a) may be made before, on or after the day; and
  - (b) is not a legislative instrument.

*Relationship with other law*

- (5) This section has effect despite the rest of this Act.
- (6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

*Exception for prescribed act*

- (7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

## ***Plant Breeder's Rights Act 1994***

### **5 Subsection 3(1)**

Insert:

***PBR office*** means place of work of the Registrar or a person who is engaged under the *Public Service Act 1999* or otherwise for or on behalf of the Commonwealth and whose duties involve providing assistance to the Registrar.

## **6 Subsection 3(1)**

Insert:

*PBR sub-office* means place of work in a single State of the Registrar or a person who is engaged under the *Public Service Act 1999* or otherwise for or on behalf of the Commonwealth and whose duties involve providing assistance to the Registrar.

## **7 After section 76**

Insert:

### **76A Doing act when PBR office reopens after end of period otherwise provided for doing act**

- (1) If the last day of a period provided by this Act (except this section) or the regulations for doing an act is a day when the PBR office or a PBR sub-office is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.
- (2) For the purposes of this section, the PBR office or a PBR sub-office is taken not to be open for business on a day:
  - (a) declared by regulations to be a day on which the office or sub-office is not open for business; or
  - (b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office or sub-office is not open for business.

#### *Declarations*

- (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.
- (4) A declaration mentioned in paragraph (2)(b):
  - (a) may be made before, on or after the day; and
  - (b) is not a legislative instrument.

#### *Relationship with other law*

- (5) This section has effect despite the rest of this Act.

- (6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

*Exception for prescribed act*

- (7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

## ***Trade Marks Act 1995***

### **8 After section 223**

Insert:

#### **223A Doing act when Trade Marks Office reopens after end of period otherwise provided for doing act**

- (1) If the last day of a period provided by this Act (except this section) for doing an act is a day when the Trade Marks Office, or a sub-office of the Trade Marks Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.
- (2) For the purposes of this section, the Trade Marks Office, or a sub-office of the Trade Marks Office, is taken not to be open for business on a day:
- (a) declared by regulations to be a day on which the office or sub-office is not open for business; or
  - (b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office or sub-office is not open for business.

*Declarations*

- (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.
- (4) A declaration mentioned in paragraph (2)(b):
- (a) may be made before, on or after the day; and

(b) is not a legislative instrument.

*Relationship with other law*

- (5) This section has effect despite the rest of this Act.
- (6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

*Exception for prescribed act*

- (7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

## Schedule 13—Extension of time

### *Trade Marks Act 1995*

#### **1 Subsection 224(7)**

Omit “an act”, substitute “a relevant act”.

#### **2 Application**

The amendment of subsection 224(7) of the *Trade Marks Act 1995* made by this Schedule applies in relation to decisions made by the Registrar after the commencement of this Schedule.



## **Schedule 14—Approving forms**

### ***Plant Breeder's Rights Act 1994***

#### **1 Subsection 3(1)**

Insert:

*approved form* means a form approved by the Secretary for the purposes of the provision in which the expression appears.

#### **2 Section 7**

Repeal the section.

#### **3 Transitional provision**

- (1) A form that, just before the commencement of this Schedule, was approved under section 7 of the *Plant Breeder's Rights Act 1994* has effect as if it had been approved, on that commencement, for the purposes of each provision of that Act to which the form is relevant, by the Secretary of the Department administering that Act.
- (2) This item does not prevent the Secretary from approving another form for the purposes of a provision of that Act.

## Schedule 15—Delegation

### *Designs Act 2003*

#### **1 Subsection 124(1)**

After “this Act”, insert “, the regulations”.

### *Plant Breeder’s Rights Act 1994*

#### **2 Section 59**

Repeal the section, substitute:

#### **59 Delegation**

##### *Delegation of Minister’s statutory powers and functions*

- (1) The Minister may, by signed instrument, delegate to the Registrar, or to an SES employee, or acting SES employee, in the Department, any of the powers or functions of the Minister under this Act or the regulations.

##### *Delegation of Secretary’s statutory powers and functions*

- (2) The Secretary may, by signed instrument, delegate to the Registrar, or to an SES employee, or acting SES employee, in the Department, any of the powers or functions of the Secretary under this Act or the regulations.

##### *Delegation of Registrar’s statutory powers and functions*

- (3) The Registrar may, by signed instrument, delegate to a prescribed employee, or employees in a prescribed class, any of the powers or functions of the Registrar under this Act or the regulations.

##### *Subdelegation of delegated powers and functions*

- (4) A person to whom a power or function under this Act or the regulations has been delegated by the Minister or the Secretary under subsection (1) or (2) may, by signed instrument, delegate the

power or function to a prescribed employee, or employees in a prescribed class.

- (5) A power or function that is exercised or performed by an employee under a delegation under subsection (4) is taken, for the purposes of this Act and the regulations, to have been exercised or performed by the person who originally delegated the corresponding power or function under subsection (1) or (2).

*Requirement to act under direction or supervision*

- (6) If required by an instrument under subsection (3) or (4) delegating a power or function to an employee, the employee must exercise the power or perform the function under the direction or supervision of:
- (a) the person who delegated the power or function to the employee; or
  - (b) another employee specified in the instrument.

This subsection applies whether the instrument identifies the employee specifically or by reference to a class.

*Definition*

- (7) In subsections (3), (4), (5) and (6):

**employee** means a person who is engaged under the *Public Service Act 1999* or otherwise for or on behalf of the Commonwealth and whose duties involve providing assistance to the Registrar.

### **3 Saving**

- (1) A delegation in force under section 59 of the *Plant Breeder's Rights Act 1994* immediately before the commencement of this Schedule has effect on and after that commencement as if it had been made on that commencement.
- (2) This item does not prevent the revocation or variation of the delegation after that commencement.

## Schedule 16—Statute law revision amendments

### *Patents Act 1990*

#### **1 Schedule 1 (definition of *Australian Register of Therapeutic Goods*)**

Omit “17”, substitute “9A”.

Note: This item corrects a cross-reference consequentially on the *Therapeutic Goods Amendment (Medical Devices) Act 2002* repealing section 17 of the *Therapeutic Goods Act 1989*, which provided for the Australian Register of Therapeutic Goods, and inserting section 9A in that Act to provide for that register.

### *Trade Marks Act 1995*

#### **2 Subsection 84(2)**

Repeal the subsection, substitute:

- (2) Before cancelling the registration of the trade mark, the Registrar must notify in accordance with the regulations:
  - (a) any person recorded under Part 11 as claiming a right in respect of, or an interest in, the trade mark; and
  - (b) if:
    - (i) an application has been made to the Registrar for a record of the assignment or transmission of the trade mark to a person to be entered in the Register (see section 109); and
    - (ii) the assignment has not yet been recorded;  
the person to whom the trade mark has been assigned or transmitted.

Note: The text of the new and repealed subsections is identical but the indentation differs to fix a formatting error in the repealed subsection. The different indentation clarifies that the words after subparagraph 84(2)(b)(ii) relate only to paragraph 84(2)(b) and not to the whole of subsection 84(2).

#### **3 Paragraph 206(2)(b)**

Omit “paragraph (1)(a) or (b)”, substitute “subsection (1)”.

Note: This item corrects a cross-reference consequentially on the removal of paragraphs 206(1)(a) and (b) by item 943 of Schedule 1 to the *Public Employment (Consequential and Transitional) Amendment Act 1999*.

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*[Minister's second reading speech made in—  
House of Representatives on 30 March 2006  
Senate on 9 August 2006]*

(27/06)

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