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Commonwealth of Australia

HOUSE OF REPRESENTATIVES

Presented and read a first time

Intellectual Property Laws Amendment Bill 2006

No. , 2006

(Industry, Tourism and Resources)

**A Bill for an Act to amend the law relating to
intellectual property, and for related purposes**

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1 **A Bill for an Act to amend the law relating to**
2 **intellectual property, and for related purposes**

3 The Parliament of Australia enacts:

4 **1 Short title**

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

7 **2 Commencement**

8 (1) Each provision of this Act specified in column 1 of the table
9 commences, or is taken to have commenced, in accordance with
10 column 2 of the table. Any other statement in column 2 has effect
11 according to its terms.
12

Commencement information		
Column 1	Column 2	Column 3
Provision(s)	Commencement	Date/Details
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.	
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.	
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.	
4. Schedule 3, Part 1	The day after this Act receives the Royal Assent.	
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.	
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.	
7. Schedules 5 and 6	The day after this Act receives the Royal Assent.	
8. Schedule 7	The 28th day after the day on which this Act receives the Royal Assent.	
9. Schedules 8 and 9	The day after this Act receives the Royal Assent.	

Commencement information		
Column 1	Column 2	Column 3
Provision(s)	Commencement	Date/Details
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.	
11. Schedule 11	The day after this Act receives the Royal Assent.	
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.	
13. Schedules 13 to 15	The day after this Act receives the Royal Assent.	
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
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.

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(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.

7

3 Schedule(s)

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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

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2

concerned, and any other item in a Schedule to this Act has effect according to its terms.

1
2 **Schedule 1—Revoking registration of trade**
3 **marks etc.**
4

5 ***Trade Marks Act 1995***

6 **1 Subsection 38(1)**

7 Repeal the subsection, substitute:

8 (1) Before a trade mark is registered, the Registrar may revoke the
9 acceptance of the application for registration of the trade mark if he
10 or she is satisfied that:

11 (a) the application should not have been accepted, taking account
12 of all the circumstances that existed when the application was
13 accepted (whether or not the Registrar knew then of their
14 existence); and

15 (b) it is reasonable to revoke the acceptance, taking account of
16 all the circumstances.

17 **2 Application of amendment of section 38**

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

22 **3 At the end of section 73**

23 Add:

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

28 **4 Part 8 (heading)**

29 Repeal the heading, substitute:

30 **Part 8—Amendment, cancellation and revocation**
31 **of registration**

32 **5 Before section 81**

1 Insert:

2 **Subdivision A—Amending Register**

3 **6 Before section 84**

4 Insert:

5 **Subdivision B—Cancelling registration**

6 **7 At the end of Division 1 of Part 8**

7 Add:

8 **Subdivision C—Revoking registration**

9 **84A Registration may be revoked**

10 *Power to revoke*

11 (1) The Registrar may revoke the registration of a trade mark if he or
12 she is satisfied that:

13 (a) the trade mark should not have been registered, taking
14 account of all the circumstances that existed when the trade
15 mark became registered (whether or not the Registrar knew
16 then of their existence); and

17 (b) it is reasonable to revoke the registration, taking account of
18 all the circumstances.

19 (2) The circumstances to be taken into account under paragraph (1)(a)
20 include the following:

21 (a) any errors (including errors of judgment) or omissions that
22 led directly or indirectly to the registration;

23 (b) any relevant obligations of Australia under an international
24 agreement;

25 (c) any special circumstances making it appropriate:

26 (i) not to register the trade mark; or

27 (ii) to register the trade mark only if the registration were
28 subject to conditions or limitations to which the
29 registration was not actually subject.

30 (3) The circumstances to be taken into account under paragraph (1)(b)
31 include the following:

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

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

11 *Prerequisites to revocation decision*

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

19 Note: For *registered owner* see section 6.

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

26 Note: For *registered owner* see section 6.

27 *No duty to consider whether to revoke*

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

31 **84B Registration must be revoked if opposition was ignored in**
32 **registration process**

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

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

11 The revocation must be done within that month.

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

14 **84C Effect of revocation of registration**

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

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

3 Note: For *registered owner* see section 6.

4 (3) To avoid doubt, paragraph (2)(b) does not, by itself, make the
5 Commonwealth liable if the circumstances described in
6 subparagraphs (2)(b)(i) and (ii) exist.

7 (4) This Act applies as if, just after the revocation:

8 (a) the application for registration of the trade mark reflected the
9 particulars in the Register for the trade mark just before the
10 revocation; and

11 (b) the applicant for registration of the trade mark were the
12 person in whose name the trade mark was registered just
13 before the revocation.

14 (5) This subsection has effect if the Registrar revokes the acceptance
15 of the application for registration of the trade mark after revoking
16 the registration. The Registrar may, but need not, examine the
17 application again under section 31 before rejecting the application.
18 This has effect despite paragraph 38(2)(b).

19 **84D Appeal from revocation of registration**

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

22 **8 After subsection 224(3)**

23 Insert:

24 (3A) If the Registrar has revoked the registration of a trade mark, he or
25 she may extend the time for doing a relevant act that is required by
26 this Act to be done within a certain time in connection with the
27 application for registration of the trade mark.

28 **9 Application of amendments of Part 8 and section 224**

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

1
2 **Schedule 2—Non-payment of fees relating to**
3 **trade marks**
4

5 ***Trade Marks Act 1995***

6 **1 Subsections 223(3), (4) and (5)**

7 Repeal the subsections, substitute:

8 (3) The regulations may provide for the consequences (for the
9 purposes of this Act) of failing to pay a fee in accordance with the
10 regulations.

11 (4) In particular, the regulations may provide that, for the purposes of
12 this Act:

13 (a) an act is not to be done, or is taken not to have been done, if
14 the fee for doing the act is not paid in accordance with the
15 regulations; or

16 (b) a document is not filed, or is taken not to have been filed, if
17 the fee for filing the document is not paid in accordance with
18 the regulations; or

19 (c) an application for registration of a trade mark lapses, or is
20 taken to have lapsed, if the fee for filing the application is not
21 paid in accordance with the regulations.

22 (5) Subsection (4) does not limit subsection (3).

23 **2 Application**

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

1
2 **Schedule 3—Registration process for**
3 **certification trade marks**

4 **Part 1—Amendments commencing on day after**
5 **Royal Assent**

6 *Trade Marks Act 1995*

7 **1 Subsection 173(2)**

8 Repeal the subsection, substitute:

9 (2) The rules must specify:

- 10 (a) the requirements (the *certification requirements*) that goods
11 and/or services must meet for the certification trade mark to
12 be applied to them; and
13 (b) the process for determining whether goods and/or services
14 meet the certification requirements; and
15 (c) the attributes that a person must have to become a person (an
16 *approved certifier*) approved to assess whether goods and/or
17 services meet the certification requirements; and
18 (d) the requirements that a person, who is the owner of the
19 certification trade mark or an approved user, must meet to
20 use the certification trade mark in relation to goods and/or
21 services; and
22 (e) the other requirements about the use of the certification trade
23 mark by a person who is the owner of the certification trade
24 mark or an approved user; and
25 (f) the procedure for resolving a dispute about whether goods
26 and/or services meet the certification requirements; and
27 (g) the procedure for resolving a dispute about any other issue
28 relating to the certification trade mark.

29 (3) The rules must also include any other matter the Commission
30 requires to be included.

31 (4) The rules may also include any other matter the Commission
32 permits to be included.

33 **2 Application of amendment of section 173**

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

4 **3 Paragraph 175(2)(a)**

5 Repeal the paragraph, substitute:

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

10 **4 Subsection 175(2) (note 2)**

11 Repeal the note, substitute:

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

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

14 **5 Application of amendments of section 175**

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

19 **6 Subsection 177(1) (note 2)**

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

21 **7 Subsection 181(2) (note 2)**

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

1

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

4 ***Trade Marks Act 1995***

5 **8 Section 174**

6 Repeal the section, substitute:

7 **174 Registrar to send documents to Commission**

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

10 **9 Application of new section 174**

11 (1) Section 174 (the ***new section 174***) of the *Trade Marks Act 1995* as
12 amended by this Part applies to applications filed before, on or after the
13 commencement of this Part.

14 (2) However, the new section 174 does not require the Registrar to send to
15 the Commission documents relating to an application if:

- 16 (a) the Registrar sent documents relating to the application to the
17 Commission before the commencement of this Part under
18 section 174 (the ***old section 174***) of the *Trade Marks Act*
19 *1995* as in force before that commencement; or
20 (b) the old section 174 did not require the Registrar to send a
21 copy of the application to the Commission.

22 **10 Subsection 176(1)**

23 Repeal the subsection, substitute:

- 24 (1) The Registrar must accept the application if:
25 (a) the application is made in accordance with this Act; and
26 (b) there are no grounds for rejecting the application; and
27 (c) the Commission has given a certificate under subsection
28 175(2).

29 Otherwise the Registrar must reject the application.

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

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

6 **11 Application of new subsection 176(1)**

7 (1) Subsection 176(1) (the *new subsection 176(1)*) of the *Trade Marks Act*
8 *1995* as amended by this Part applies to applications filed before, on or
9 after the commencement of this Part.

10 (2) However, the new subsection 176(1) does not apply to applications
11 accepted or rejected under Part 16 of the *Trade Marks Act 1995* before
12 the commencement of this Part.

13 **12 Subsection 178(4)**

14 Repeal the subsection, substitute:

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

17 **13 Subsection 178(6)**

18 Repeal the subsection.

19 **14 Application of amendments of section 178**

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

24 **15 Section 179**

25 Repeal the section, substitute:

26 **179 Registrar must publish rules**

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

29 **16 Saving of rules made available under old section 179**

1 The Registrar is not required by section 179 of the *Trade Marks Act*
2 *1995* as amended by this Part to publish rules that have before the
3 commencement of this Part been, and continue to be, made available as
4 required by section 179 of that Act as in force before the
5 commencement of this Part, unless the rules are varied.

1
2 **Schedule 4—Availability of documents about**
3 **trade marks**
4

5 ***Trade Marks Act 1995***

6 **1 At the end of Division 1 of Part 21**

7 Add:

8 **217A Prescribed documents relating to trade marks to be made**
9 **available for public inspection**

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

20 **2 Application of section 217A**

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

24 **3 After section 226**

25 Insert:

26 **226A Requirements for confidential treatment of information held**
27 **in the Trade Marks Office**

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

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

10 **4 Application of section 226A**

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

1
2 **Schedule 5—Relief for infringement of patents**
3

4 ***Patents Act 1990***

5 **1 After subsection 122(1)**

6 Insert:

7 (1A) A court may include an additional amount in an assessment of
8 damages for an infringement of a patent, if the court considers it
9 appropriate to do so having regard to:

- 10 (a) the flagrancy of the infringement; and
11 (b) the need to deter similar infringements of patents; and
12 (c) the conduct of the party that infringed the patent that
13 occurred:
14 (i) after the act constituting the infringement; or
15 (ii) after that party was informed that it had allegedly
16 infringed the patent; and
17 (d) any benefit shown to have accrued to that party because of
18 the infringement; and
19 (e) all other relevant matters.

20 **2 Application**

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

1
2 **Schedule 6—Exemption of continued prior**
3 **use from patent infringement**
4

5 *Patents Act 1990*

6 **1 Section 119**

7 Repeal the section, substitute:

8 **119 Infringement exemptions: prior use**

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

13 (a) was exploiting the product, method or process in the patent
14 area; or

15 (b) had taken definite steps (contractually or otherwise) to
16 exploit the product, method or process in the patent area.

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

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

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

26 (a) had stopped (except temporarily) exploiting the product,
27 method or process in the patent area; or

28 (b) had abandoned (except temporarily) the steps to exploit the
29 product, method or process in the patent area.

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

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

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

5 *Exemption for successors in title*

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

19 *Definition*

- 20 (5) In this section:

21 *exploit* includes:

- 22 (a) in relation to a product:
23 (i) make, hire, sell or otherwise dispose of the product; and
24 (ii) offer to make, hire, sell or otherwise dispose of the
25 product; and
26 (iii) use or import the product; and
27 (iv) keep the product for the purpose of doing an act
28 described in subparagraph (i), (ii) or (iii); and
29 (b) in relation to a method or process:
30 (i) use the method or process; and
31 (ii) do an act described in subparagraph (a)(i), (ii), (iii) or
32 (iv) with a product resulting from the use of the method
33 or process.

34 **2 Application**

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

1
2
3

Schedule 7—Springboarding and patents

4

Patents Act 1990

5

1 Subsection 78(1)

6 Omit “(1) IF”, substitute “IF”.

7

2 Subsection 78(2)

8 Repeal the subsection.

9

3 After section 119

10 Insert:

11

119A Infringement exemptions: acts for obtaining regulatory

12 **approval of pharmaceuticals**

13 (1) The rights of a patentee of a pharmaceutical patent are not
14 infringed by a person exploiting an invention claimed in the patent
15 if the exploitation is solely for:

16 (a) purposes connected with obtaining the inclusion in the
17 Australian Register of Therapeutic Goods of goods that:

18 (i) are intended for therapeutic use; and

19 (ii) are not medical devices, or therapeutic devices, as
20 defined in the *Therapeutic Goods Act 1989*; or

21 (b) purposes connected with obtaining similar regulatory
22 approval under a law of a foreign country or of a part of a
23 foreign country.

24 (2) Subsection (1) does not apply to the export from Australia of goods
25 for purposes described in paragraph (1)(b) unless the term of the
26 patent has been extended under Part 3 of Chapter 6 and the goods
27 consist of or contain:

28 (a) a pharmaceutical substance *per se* that is in substance
29 disclosed in the complete specification of the patent and in
30 substance falls within the scope of the claim or claims of that
31 specification; or

32 (b) a pharmaceutical substance when produced by a process that
33 involves the use of recombinant DNA technology, that is in

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

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

6 (3) In this section:

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

8 (a) a pharmaceutical substance; or

9 (b) a method, use or product relating to a pharmaceutical
10 substance, including any of the following:

11 (i) a method for producing a raw material needed to
12 produce the substance;

13 (ii) a product that is a raw material needed to produce the
14 substance;

15 (iii) a product that is a pro-drug, metabolite or derivative of
16 the substance.

17 **4 Application**

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

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Schedule 8—Compulsory licensing of patents

4

Patents Act 1990

5

1 Subsection 133(1)

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

7

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

8 Repeal the paragraphs, substitute:

9 (a) all the following conditions exist:

10 (i) the applicant has tried for a reasonable period, but
11 without success, to obtain from the patentee an
12 authorisation to work the invention on reasonable terms
13 and conditions;

14 (ii) the reasonable requirements of the public with respect to
15 the patented invention have not been satisfied;

16 (iii) the patentee has given no satisfactory reason for failing
17 to exploit the patent; or

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

22

3 Subsection 133(3A)

23 Repeal the subsection.

24

4 Paragraph 133(5)(b)

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

26

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

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

30

6 Subsections 133(6) and 134(1)

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

32

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

1 Repeal the paragraphs, substitute:

2 (a) both:

3 (i) the reasonable requirements of the public with respect to
4 the patented invention have not been satisfied; and

5 (ii) the patentee has given no satisfactory reason for failing
6 to exploit the patent; or

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

10 **8 After section 136**

11 Insert:

12 **136A Dealing with allegation of contravention of application law**

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

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

21 **9 Application and saving provisions**

22 (1) The amendments of the *Patents Act 1990* made by this Schedule apply
23 in relation to conduct (including omissions) that:

24 (a) occurs after the commencement of this Schedule; and

25 (b) is connected with a patent granted before, on or after that
26 commencement.

27 (2) To avoid doubt, proceedings started in a prescribed court under
28 section 133 or 134 of the *Patents Act 1990* but not concluded before the
29 commencement of this Schedule may be continued in the court after
30 that commencement as if the amendments of that Act by this Schedule
31 had not been made.

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Schedule 9—Specifying claims for innovation patents

5

Patents Act 1990

6

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

7

Add “defining the invention”.

8

2 Application

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12

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.

1
2 **Schedule 10—Making divisional applications**
3 **for innovation patents**
4

5 *Patents Act 1990*

6 **1 Subsection 79C(1)**

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

8 **2 Subsection 79C(2)**

9 Repeal the subsection, substitute:

10 (2) The patentee may make the further complete application only
11 during the period:

12 (a) starting when an examination of the first patent begins; and

13 (b) ending when any of the following happens:

14 (i) the term of the first patent ends;

15 (ii) the first patent is revoked;

16 (iii) the first patent ceases;

17 (iv) a period prescribed by the regulations for the purposes
18 of this subparagraph ends.

19 **3 Application**

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

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Schedule 11—Setting dates by regulations

Plant Breeder’s Rights Act 1994

1 At the end of subsection 28(2)

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

2 Application

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

Trade Marks Act 1995

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

14 Add:
15 ; or (e) in relation to a prescribed application—the day determined in
16 the prescribed way.

4 Application

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

1
2 **Schedule 12—Effect of office not being open**
3 **for business**
4

5 *Designs Act 2003*

6 **1 Section 129 (after the paragraph relating to Part 4)**

7 Insert:

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

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

12 Insert:

13 **Part 4A—Doing act after end of period otherwise**
14 **provided for doing it**
15

16 **136A Doing act when Designs Office reopens after end of period**
17 **otherwise provided for doing act**

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

1 *Declarations*

2 (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the
3 day by reference to its being declared a public holiday by or under
4 a law of a State or Territory. This does not limit the way the
5 declaration may identify the day.

6 (4) A declaration mentioned in paragraph (2)(b):
7 (a) may be made before, on or after the day; and
8 (b) is not a legislative instrument.

9 *Relationship with other law*

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

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

14 *Exception for prescribed act*

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

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

18 ***Olympic Insignia Protection Act 1987***

19 **3 At the end of Part 2.3**

20 Add:

21 **14A Doing act when Designs Office reopens after end of period**
22 **otherwise provided for doing act**

23 (1) If the last day of a period provided by this Chapter (except this
24 section), or regulations made for the purposes of this Chapter, for
25 doing an act is a day when the Designs Office is not open for
26 business, the act may be done in prescribed circumstances on the
27 next day when the office is open for business.

28 (2) For the purposes of this section, the Designs Office is taken not to
29 be open for business on a day:

30 (a) declared by regulations to be a day on which the office is not
31 open for business; or

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

4 *Declarations*

5 (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the
6 day by reference to its being declared a public holiday by or under
7 a law of a State or Territory. This does not limit the way the
8 declaration may identify the day.

9 (4) A declaration mentioned in paragraph (2)(b):
10 (a) may be made before, on or after the day; and
11 (b) is not a legislative instrument.

12 *Relationship with other law*

13 (5) This section has effect despite the rest of this Chapter.

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

17 *Exception for prescribed act*

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

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

21 ***Patents Act 1990***

22 **4 After section 222**

23 Insert:

24 **222A Doing act when Patent Office reopens after end of period**
25 **otherwise provided for doing act**

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

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

8 *Declarations*

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

16 *Relationship with other law*

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

21 *Exception for prescribed act*

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

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

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

26 **5 Subsection 3(1)**

27 Insert:

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

1 **6 Subsection 3(1)**

2 Insert:

3 *PBR sub-office* means place of work in a single State of the
4 Registrar or a person who is engaged under the *Public Service Act*
5 *1999* or otherwise for or on behalf of the Commonwealth and
6 whose duties involve providing assistance to the Registrar.

7 **7 After section 76**

8 Insert:

9 **76A Doing act when PBR office reopens after end of period**
10 **otherwise provided for doing act**

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

23 *Declarations*

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

31 *Relationship with other law*

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

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

4 *Exception for prescribed act*

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

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

8 ***Trade Marks Act 1995***

9 **8 After section 223**

10 Insert:

11 **223A Doing act when Trade Marks Office reopens after end of**
12 **period otherwise provided for doing act**

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

18 (2) For the purposes of this section, the Trade Marks Office, or a
19 sub-office of the Trade Marks Office, is taken not to be open for
20 business on a day:

21 (a) declared by regulations to be a day on which the office or
22 sub-office is not open for business; or

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

26 *Declarations*

27 (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the
28 day by reference to its being declared a public holiday by or under
29 a law of a State or Territory. This does not limit the way the
30 declaration may identify the day.

31 (4) A declaration mentioned in paragraph (2)(b):

32 (a) may be made before, on or after the day; and

1 (b) is not a legislative instrument.

2 *Relationship with other law*

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

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

7 *Exception for prescribed act*

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

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

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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.

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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.

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Schedule 15—Delegation

4

Designs Act 2003

5

1 Subsection 124(1)

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

7

Plant Breeder’s Rights Act 1994

8

2 Section 59

9 Repeal the section, substitute:

10

59 Delegation

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

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

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

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

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

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

25 *Subdelegation of delegated powers and functions*

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

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

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

8 *Requirement to act under direction or supervision*

9 (6) If required by an instrument under subsection (3) or (4) delegating
10 a power or function to an employee, the employee must exercise
11 the power or perform the function under the direction or
12 supervision of:

13 (a) the person who delegated the power or function to the
14 employee; or

15 (b) another employee specified in the instrument.

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

18 *Definition*

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

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

23 **3 Saving**

24 (1) A delegation in force under section 59 of the *Plant Breeder's Rights Act*
25 *1994* immediately before the commencement of this Schedule has effect
26 on and after that commencement as if it had been made on that
27 commencement.

28 (2) This item does not prevent the revocation or variation of the delegation
29 after that commencement.

1
2 **Schedule 16—Statute law revision**
3 **amendments**
4

5 ***Patents Act 1990***

6 **1 Schedule 1 (definition of *Australian Register of Therapeutic***
7 ***Goods*)**

8 Omit “17”, substitute “9A”.

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

13 ***Trade Marks Act 1995***

14 **2 Subsection 84(2)**

15 Repeal the subsection, substitute:

16 (2) Before cancelling the registration of the trade mark, the Registrar
17 must notify in accordance with the regulations:

18 (a) any person recorded under Part 11 as claiming a right in
19 respect of, or an interest in, the trade mark; and

20 (b) if:

21 (i) an application has been made to the Registrar for a
22 record of the assignment or transmission of the trade
23 mark to a person to be entered in the Register (see
24 section 109); and

25 (ii) the assignment has not yet been recorded;
26 the person to whom the trade mark has been assigned or
27 transmitted.

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

32 **3 Paragraph 206(2)(b)**

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

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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*.