

IP Legislative Modifications Released

Recently, the draft *Intellectual Property Laws Amendment (Raising The Bar) Bill 2011* (the Bill) was released for public comment. The reforms proposed in the draft Bill have been made in response to various IP forums held by IP Australia since 2009. A summary of some of the key changes are discussed below.

Patents

Current legislation in relation to patents is contained in the *Patents Act 1990* (Cth). There are numerous amendments proposed to this piece of legislation. The result of the amendments appears to increase the threshold in determining whether or not an invention is patentable.

Inventive Step

The inventive step involves a review of "the prior art base". The prior art base is pre-existing material in the marketplace that may be similar to the proposed patent which is known to a person skilled in the particular industry in which the patent relates. This step will be expanded to allow inspection of all publicly available information in determining whether or not the patent application contains an inventive step.

Prior Use

Patent Examiners will look at the prior use of the invention as a proposed amendment to the Bill. This will mean that prior use of an invention will be considered much sooner in the patent process. Currently prior use is only considered during opposition proceedings and in court proceedings.

Usefulness

It is proposed that the specifications of an invention must disclose "specific, substantial and credible use of the invention". The usefulness requirement will be determined by the Examiner at the examination stage of the patent. The requirement of the usefulness step will minimise the number of patents lodged which require significant work to be undertaken on the invention before the invention can be utilised in any useful way.

Copyright

The current legislation governing copyright protection in Australia is the *Copyright Act 1968* (Cth). The proposed amendments in relation to copyright law all relate to the importation and seizure of goods which infringe copyright.

Once goods are seized the importer of those goods must submit a claim for the release of goods if they still wish to obtain those goods. If a claim is not made within a specified time period then the goods are forfeited to the Commonwealth. Under current copyright laws, goods are released to the importer once a period of time lapses.

Copyright owners will now have the right to obtain the details of the exporter of the infringing goods. This will have the impact of copyright owners being able to identify the source of infringing goods.

Trade Marks

There are numerous amendments proposed to the *Trade Marks Act 1995* (Cth). Some of the key amendments proposed are as follows:

Trade Mark Opposition Proceedings

Presently, opposition proceedings can be a very lengthy process. There are a number of amendments proposed to make this process much faster and more effective for a trade mark Applicant and a trade mark Opponent. Currently the process with trade mark opposition requires an Opponent to lodge a Notice of Opposition. The Opponent must then prepare, file and serve evidence in support of the opposition and the trade mark Applicant will then have the opportunity to respond with their evidence.

The Bill proposes that before any evidence is filed, the trade mark Applicant must file a Notice of Intention to Defend in response to the opposition of a trade mark before any evidence is filed. This will assist in the process as Opponents will not be required to spend time and money preparing and filing evidence if the Applicant has no intention of filing any evidence of their own to support their trade mark application.

A further amendment to the trade mark opposition process is that an Opponent will have to particularise the grounds on which it is opposing the registration of a trade mark. The aim of this amendment is to focus the opposition proceedings earlier on the issues relevant which will reduce time spent on a matter and reduce costs involved in the opposition for both parties.

Penalties for infringement

The Bill has increased maximum penalties for indictable offences under the *Trade Marks Act* so that the penalties are similar to those contained in the *Copyright Act*.

The Bill has introduced summary offences that are for conduct of parties considered from the lower end of the scale as 'reckless' right through to 'negligent' behaviour. The purpose of the introduction of penalties for summary offences is to facilitate an expeditious resolution to disputes involving trade mark offences.

The Bill also introduces the discretion of the court to award exemplary damages in cases where a party has demonstrated a flagrant disregard for the law. It is introduced to deter potential infringers.

Designs

Current legislation protecting designs can be found in the *Designs Act 2003* (Cth).

The Bill allows for proceedings to be commenced in the Federal Magistrates Court. Previously, the Federal and Supreme Courts were the only courts with the jurisdiction to hear matters in relation to Design Law. This will allow for a faster, more cost effective and less formal means of obtaining an outcome for matters involving design protection.

If you think you have intellectual property that needs protection, your IP rights are being breached or you need assistance performing a due diligence for your business, contact our intellectual property experts at info@mslawyers.com.au or visit our website www.mslawyers.com.au. Alternatively, contact our professional team at our Gold Coast or Brisbane office.



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