

IPRIA Australian Developments in IP

Update February 2006

Welcome to the IPRIA Australian Developments in IP Bulletin for February 2006. The following is a summary of featured updates on the website. The page can be viewed in full at

http://www.ipria.org/developments_in_ip/domestic/index.html

PATENTS

Review of Crown use provisions for patents and designs

In November 2005, the Advisory Council on Intellectual Property (ACIP) released a report on Crown use provisions for patents and designs. Currently, when such provisions are invoked, the IP rights holder must be notified and compensated, however the Crown, or any organisation or person authorised by the Crown, has statutory immunity from actions for patent or design infringement. The report examines whether the Crown use provisions continue to reflect the needs of government, business and the Australian public. Owing to the increasing commercialisation of many government services, and with court rulings giving a wide interpretation to the range of entities that can access the provisions, ACIP advises that a more transparent and accountable process for utilising Crown use provisions be introduced.

http://www.acip.gov.au/library/review_of_Crown_Use_provisions.pdf

TRADE MARKS

Consultation paper on a new access regime to documents on trade mark files

IP Australia is considering introducing a new system that allows access to documents on trade mark files, replacing the current system of access under the *Freedom of Information Act 1982*. Under the proposed system, all documents on a trade mark file would be made available, on a cost recovery basis, to any person who requests access, however there would be the capacity for certain documents to maintain confidentiality. A person filing a document would be able to request the Registrar of Trade Marks to direct that the document or some part of it be treated as confidential. Comments regarding the proposed system were due to IP Australia by **3 February 2006**.

<http://www.ipaustralia.gov.au/pdfs/news/Access%20to%20trade%20marks%20documents.pdf>

Review of the relationship between trade marks and business names, company names and domain names

In October 2005, ACIP and IP Australia released commissioned market research as part of ACIP's report on the relationship between trade marks and business names, company names and domain names. The research findings conclude that, overall, there appears to be a significant lack of awareness in the business community with

respect to the rights and protections associated with these names. A great majority of respondents (82%) incorrectly believe that registering a business name gives one the 'right' to trade under that name. One half (50%) of respondents incorrectly contend that it is not possible for the same name to be registered to different owners in different states and territories. While many respondents (87%) believe it is important to conduct a trade mark search when applying for a business name, nearly the same amount (83.8%) have not registered their business name as a trade mark. According to ACIP and IP Australia, ignorance and error may create a false sense of security for many businesses.

<http://www.acip.gov.au/library/Eureka%20report%20%20Registered%20business%20names%20survey%20with%20questionnaire.pdf>

Trade mark enforcement

On 7 December 2005, the Commonwealth Government announced its response to the Review of Trade Mark Enforcement conducted by ACIP in 2004. Twelve recommendations were made by ACIP for greater clarity of trade mark rights and greater certainty in their enforcement and protection. Nine of the recommendations have been accepted. IP Australia is progressively implementing six recommendations and will take alternative steps to address the three recommendations that had not been accepted.

http://www.ipaustralia.gov.au/pdfs/news/Enforcement_Gov%20Response_Dec05.pdf

COPYRIGHT

Copyright Amendment (Film Directors' Rights) Act 2005

On 19 December 2005, the substantive provisions of the *Copyright Amendment (Film Directors' Rights) Act 2005* (the Act) came into force by proclamation. The Act amends the *Copyright Act 1968* to give, for the first time, film directors a copyright in the films they direct. The Act provides rights to directors to share, as copyright owners, in remuneration payable by pay-TV services for the retransmission of films included in free-to-air broadcasts. The amendments will apply to films that began production after the commencement of the amendments, but rights arising under contracts entered into before that date are preserved.

http://www.austlii.edu.au/au/legis/cth/num_act/cadra2005n1302005453/

RESEARCH AND DEVELOPMENT ('R & D')

The R&D Tax Concession - impact on the firm

In October 2005, the Department of Industry, Tourism and Resources released a report regarding the Commonwealth Government's R&D Tax Concession and its impact on Australian firms. The report's major findings were that the R&D Tax Concession increases the size of investment in individual R&D projects, brings forward R&D expenditure on projects to enable faster completion with higher commercial results, and encourages investment in projects that otherwise would not

be undertaken. The report found that 80% of participating companies had an “intellectual property strategy”, with most companies using more than one mechanism to protect their IP. Smaller businesses and/or businesses operating in markets with short product cycles and low entry barriers were most likely to cite “industrial secrecy” or “speed to market”. Larger businesses, operating in sectors with slower product cycles or in markets with high entry barriers, were more likely to use patents.

http://www.industry.gov.au/assets/documents/itrinternet/RandD_Tax_Concession_116_Firm_Study_Report20051214092802.pdf

BIOTECHNOLOGY

Protection of human genetic information

On 9 December 2005, the Commonwealth Government released its response to the Australian Law Reform Commission and Australian Health Ethics Committee report *Essentially Yours: The Protection of Human Genetic Information in Australia*. The Government’s response to the report addresses how privacy and discrimination law manage the rapid advances in human genetic technology. The response also discusses clinical practice, ethical standards in medical and scientific research, and the use and collection of genetic databases. The Government is establishing a new principal committee of the National Health and Medical Research Council to advise Australian governments on the complex issues raised by developments in human genetic information and technologies.

<http://www.ag.gov.au/agd/WWW/agdhome.nsf/AllDocs/DFC5F37153385647CA2570CA0076BC77?OpenDocument>

DOMAIN NAMES

Domain name registrations under the ‘close and substantial connection’ rule

On 13 October 2005, au Domain Administration Ltd (auDA) released a statement regarding the ‘close and substantial connection rule’. In the past, auDA has held that it is acceptable under the rule to register domain names for the purpose of providing internet directory services or information portals. According to auDA, some registrants have recently been using this interpretation of the rule to register large numbers of domain names apparently for the primary purpose of capturing web traffic and/or selling click-through advertising. Until auDA issues a policy clarification of the ‘close and substantial connection’ rule, registrants who engage in this practice should be aware that auDA reserves the right to delete the domain names for breach of policy.

<http://www.auda.org.au/news.php?newsid=49>

**HOUSE OF REPRESENTATIVES STANDING COMMITTEE ON SCIENCE
AND INNOVATION****Inquiry into pathways to technological innovation**

On 5 December 2005, the House of Representatives Standing Committee on Science and Innovation had what was expected to be the final public hearing for its inquiry into pathways to technological innovation. Referred in March 2005 by the Minister for Science, the Hon Dr Brendan Nelson MP, the inquiry seeks to examine strategies to overcome potential barriers and factors which determine innovation success. Nine public hearings have been held in various Australian cities. These discussions will help the Committee identify the factors that are critical to commercialisation success, and also ascertain some of the challenges facing research and development organisations attempting to support the commercialisation of innovative technologies.

<http://www.aph.gov.au/house/committee/scin/pathways/index.htm>