
**Council for Trade-Related Aspects
of Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY LAWS AND REGULATIONS
NOTIFIED UNDER ARTICLE 63.2 OF THE AGREEMENT**

AUSTRALIA

The present document reproduces the text¹ of the Intellectual Property Laws Amendment Act 1998, amending the Copyright Act 1968 (see document IP/N/1/AUS/C/1), the Designs Act 1906 (see document IP/N/1/AUS/D/1), the Patents Act 1990 (see document IP/N/1/AUS/P/1) and the Trade Marks Act 1995 (see document IP/N/1/AUS/T/1), as notified by Australia under Article 63.2 of the Agreement, by means of a communication from its Permanent Mission, dated 5 March 1999.

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES À LA PROPRIÉTÉ
INTELLECTUELLE NOTIFIÉES AU TITRE DE L'ARTICLE 63:2 DE L'ACCORD**

AUSTRALIE

Le présent document contient le texte¹ de la Loi de 1998 portant modification des Lois relatives à la propriété intellectuelle, qui modifie la Loi de 1968 sur le droit d'auteur (voir le document IP/N/1/AUS/C/1), la Loi de 1906 sur les dessins et modèles (voir le document IP/N/1/AUS/D/1), la Loi de 1990 sur les brevets (voir le document IP/N/1/AUS/P/1) et la Loi de 1995 sur les marques (voir le document IP/N/1/AUS/T/1), notifiée par l'Australie au titre de l'article 63:2 de l'Accord dans une communication de la Mission permanente de ce pays, datée du 5 mars 1999.

**Consejo de los Aspectos de los Derechos de Propiedad
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA PROPIEDAD INTELECTUAL
NOTIFICADOS EN VIRTUD DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

AUSTRALIA

En el presente documento se reproduce el texto¹ de la Ley de Modificación de las Leyes sobre Propiedad Intelectual, por la que se modifica la Ley de Derecho de Autor de 1968 (véase el documento IP/N/1/AUS/C/1), la Ley de Dibujos y Modelos de 1906 (véase el documento IP/N/1/AUS/D/1), la Ley de Patentes de 1990 (véase el documento IP/N/1/AUS/P/1) y la Ley de Marcas de 1995 (véase el documento IP/N/1/AUS/T/1), notificada por Australia en virtud de lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo, mediante una comunicación de su Misión Permanente, de fecha 5 de marzo de 1999.

¹ In English only/En anglais seulement/En inglés solamente.

Intellectual Property Laws Amendment Act 1998

No. 100, 1998

Intellectual Property Laws Amendment Act 1998

No. 100, 1998

**An Act to amend the *Copyright Act 1968*, the
Designs Act 1906, the *Patents Act 1990* and the
Trade Marks Act 1995, and for other purposes**

Contents

1 Short title	1
2 Commencement	1
3 Schedule(s)	2
Schedule 1—Extension of pharmaceutical patents	3
<i>Patents Act 1990</i>	3
Division 1—Petty patents	3
Division 2—Standard patents relating to pharmaceutical substances	3
70 Applications for extension of patent	3
71 Form and timing of an application	4
72 Notification and public inspection of application	5
73 Withdrawal of application	5
74 Acceptance or refusal of application	5
75 Opposition to grant of extension	6
76 Grant of extension	7
76A Notification of extension to the Secretary, Health and Family Services	7
77 Calculation of term of extension	7
78 Exclusive rights of patentee are limited if extension granted	8
79 Rights of patentee if extension granted after patent expires	9
79A Commissioner not to make decision if court proceedings pending	9
83 Term of patent of addition	10
Schedule 2—Patent attorneys and trade marks attorneys	12
<i>Copyright Act 1968</i>	12
<i>Designs Act 1906</i>	13
44A Right of lien of patent attorney and trade marks attorney	13
<i>Patents Act 1990</i>	13
198 Registration of patent attorneys	14
200A Designated Manager	16
202A Documents prepared by a member of a partnership	18
227A Professional Standards Board for Patent and Trade Marks Attorneys	18
<i>Trade Marks Act 1995</i>	21
212 Making and signing applications etc.	22

228A	Registration of trade marks attorneys.....	23
228B	Deregistration of trade marks attorneys	24
229	Privileges of trade marks attorney and patent attorney	24
Schedule 3—	Miscellaneous amendments of the Patents Act	
	1990	26
185	Commissioner etc. not to prepare documents or search records	26

Intellectual Property Laws Amendment Act 1998

No. 100, 1998

**An Act to amend the *Copyright Act 1968*, the
Designs Act 1906, the *Patents Act 1990* and the
Trade Marks Act 1995, and for other purposes**

[Assented to 27 July 1998]

The Parliament of Australia enacts:

1 Short title

This Act may be cited as the *Intellectual Property Laws
Amendment Act 1998*.

2 Commencement

- (1) Subject to this section, this Act commences on the day on which it receives the Royal Assent.
- (2) Subject to subsection (3), Schedule 1 commences on a day to be fixed by Proclamation.

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- (3) If Schedule 1 does not commence under subsection (2) within the period of 6 months beginning on the day on which this Act receives the Royal Assent, Schedule 1 commences on the first day after the end of that period.
 - (4) Subject to subsection (5), Schedule 2 commences on a day to be fixed by Proclamation.
 - (5) If Schedule 2 does not commence under subsection (4) within the period of 6 months beginning on the day on which this Act receives the Royal Assent, Schedule 2 commences on the first day after the end of that period.

3 Schedule(s)

Subject to section 2, 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—Extension of pharmaceutical patents

Patents Act 1990

1 Section 3 (after the entry relating to “Australian continental shelf”)

Insert:

Australian Register of Therapeutic Goods

2 Before section 69

Insert:

Division 1—Petty patents

3 After section 69

Insert:

Division 2—Standard patents relating to pharmaceutical substances

70 Applications for extension of patent

- (1) The patentee of a standard patent may apply to the Commissioner for an extension of the term of the patent if the requirements set out in subsections (2), (3) and (4) are satisfied.
 - (2) Either or both of the following conditions must be satisfied:
 - (a) one or more pharmaceutical substances *per se* must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification;
 - (b) one or more pharmaceutical substances when produced by a process that involves the use of recombinant DNA technology, must in substance be disclosed in the complete specification of the patent and in substance fall within the scope of the claim or claims of that specification.
-

Schedule 1 Extension of pharmaceutical patents

- (3) Both of the following conditions must be satisfied in relation to at least one of those pharmaceutical substances:
- (a) goods containing, or consisting of, the substance must be included in the Australian Register of Therapeutic Goods;
 - (b) the period beginning on the date of the patent and ending on the first regulatory approval date for the substance must be at least 5 years.

Note: Section 65 sets out the date of a patent.

- (4) The term of the patent must not have been previously extended under this Division.
- (5) For the purposes of this section, the *first regulatory approval date*, in relation to a pharmaceutical substance, is:
- (a) if no pre-TGA marketing approval was given in relation to the substance—the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, the substance; or
 - (b) if pre-TGA marketing approval was given in relation to the substance—the date of the first approval.
- (6) For the purposes of this section, *pre-TGA marketing approval*, in relation to a pharmaceutical substance, is an approval (however described) by a Minister, or a Secretary to a Department, to:
- (a) market the substance, or a product containing the substance, in Australia; or
 - (b) import into Australia, for general marketing, the substance or a product containing the substance.

71 Form and timing of an application

Form of application

- (1) An application for an extension of the term of a standard patent must:
- (a) be in the approved form; and
 - (b) be accompanied by such documents (if any) as are ascertained in accordance with the regulations; and
-

-
- (c) be accompanied by such information (if any) as is ascertained in accordance with the regulations.

For this purpose, *document* includes a copy of a document.

Timing of application

- (2) An application for an extension of the term of a standard patent must be made during the term of the patent and within 6 months after the latest of the following dates:
- (a) the date the patent was granted;
 - (b) the date of commencement of the first inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, any of the pharmaceutical substances referred to in subsection 70(3);
 - (c) the date of commencement of this section.

72 Notification and public inspection of application

If a patentee makes an application for an extension of the term of a standard patent, the Commissioner must publish in the *Official Journal* a notice that the application has been made and is open to public inspection.

73 Withdrawal of application

- (1) A patentee who has applied for an extension of the term of a standard patent may, by notice in writing to the Commissioner, withdraw the application.
- (2) If an application for an extension of the term of a standard patent is withdrawn, the Commissioner must publish in the *Official Journal* a notice stating that the application has been withdrawn.

74 Acceptance or refusal of application

Acceptance

- (1) If a patentee of a standard patent makes an application for an extension of the term of the patent, the Commissioner must accept the application if the Commissioner is satisfied that the

Schedule 1 Extension of pharmaceutical patents

requirements of sections 70 and 71 are satisfied in relation to the application.

- (2) If the Commissioner accepts the application, the Commissioner must:
- (a) notify the applicant in writing of the acceptance; and
 - (b) publish a notice of the acceptance in the *Official Journal*.

Refusal

- (3) The Commissioner must refuse to accept the application if the Commissioner is not satisfied that the requirements of sections 70 and 71 are satisfied in relation to the application.
- (4) If the Commissioner refuses to accept the application, the Commissioner must:
- (a) notify the applicant in writing of the reasons for the refusal; and
 - (b) publish a notice of the refusal in the *Official Journal*.

75 Opposition to grant of extension

- (1) The Minister or any other person may, in accordance with the regulations, oppose the grant of an extension of the term of a standard patent on the ground that one or more of the requirements of sections 70 and 71 are not satisfied in relation to the application for the extension. The Minister or other person may not oppose the grant of the extension on any other ground.
- (2) If the grant of an extension of the term of a standard patent is opposed, the Commissioner must decide the case in accordance with the regulations.
- (3) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before deciding a case.
- (4) The applicant, and any opponent, may appeal to the Federal Court against a decision of the Commissioner under this section.

76 Grant of extension

- (1) The Commissioner must grant an extension of the term of a standard patent if:
 - (a) there is no opposition to the grant; or
 - (b) in spite of opposition, the Commissioner's decision, or the decision on appeal, is that the extension should be granted.
- (2) If the Commissioner grants an extension, the Commissioner must notify the applicant in writing of the grant and publish a notice of the grant in the *Official Journal*.

76A Notification of extension to the Secretary, Health and Family Services

In respect of each application for an extension approved by the Commissioner under section 76 in a financial year, the patent holder must lodge with the Secretary of the Department, before the end of the following financial year, a return setting out the following information:

- (a) details of the amount and origin of any Commonwealth funds spent in the research and development of the drug which was the subject of the application; and
- (b) the name of any body:
 - (i) with which the applicant has a contractual agreement; and
 - (ii) which is in receipt of Commonwealth funds; and
- (c) the total amount spent on each type of research and development, including pre-clinical research and clinical trials, in respect of the drug which was the subject of the application.

77 Calculation of term of extension

- (1) If the Commissioner grants an extension of the term of a standard patent, the term of the extension is equal to:
 - (a) the period beginning on the date of the patent and ending on the earliest first regulatory approval date (as defined by

Schedule 1 Extension of pharmaceutical patents

section 70) in relation to any of the pharmaceutical substances referred to in subsection 70(2);

reduced (but not below zero) by:

(b) 5 years.

Note: Section 65 sets out the date of a patent.

(2) However, the term of the extension cannot be longer than 5 years.

78 Exclusive rights of patentee are limited if extension granted

(1) If the Commissioner grants an extension of the term of a standard patent, the exclusive rights of the patentee during the term of the extension are not infringed:

(a) by a person exploiting:

(i) 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

(ii) 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;

for a purpose other than therapeutic use; or

(b) by a person exploiting any form of the invention other than:

(i) 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

(ii) 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.

(2) If the Commissioner grants an extension of the term of a standard patent, the exclusive rights of the patentee after the grant of the extension are not infringed by a person exploiting:

Extension of pharmaceutical patents Schedule 1

- (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;
- solely for purposes in connection with:
- (c) having goods included in the Australian Register of Therapeutic Goods, where the goods are intended for therapeutic use; or
 - (d) obtaining similar regulatory approval under a law of a foreign country or of a part of a foreign country.

79 Rights of patentee if extension granted after patent expires

If:

- (a) a patentee applies for an extension of the term of a standard patent; and
- (b) the term of the patent expires before the application is determined; and
- (c) the extension is granted;

the patentee has, after the extension is granted, the same rights to start proceedings in respect of the doing of an act during the period:

- (d) commencing on the expiration of the term of the patent; and
 - (e) ending on the day on which the extension was granted;
- as if the extension had been granted at the time when the act was done.

79A Commissioner not to make decision if court proceedings pending

If:

- (a) a patentee of a standard patent applies for an extension of the term of the patent; and

Schedule 1 Extension of pharmaceutical patents

(b) relevant proceedings in relation to the patent are pending;
the Commissioner must not make any decision under this Division
in relation to the patent without the leave of the court.

4 Section 83

Repeal the section, substitute:

83 Term of patent of addition

Usual term

- (1) The general rule is that a patent of addition remains in force for so long as the patent for the main invention remains in force.
However, this rule is subject to the exceptions set out in subsections (3) and (4).
- (2) The term of a patent of addition may be extended under Division 2 of Part 3 of Chapter 6, even though the patent for the main invention is not extended under that Division.

Patent of addition extended

- (3) If the term of a patent of addition is extended under Division 2 of Part 3 of Chapter 6:
 - (a) the extension begins at the end of the unextended term of the patent for the main invention; and
 - (b) when the extension begins, the patent of addition becomes an independent patent.

Patent for main invention extended

- (4) If:
 - (a) the term of the patent for the main invention is extended under Division 2 of Part 3 of Chapter 6; and
 - (b) the term of the patent of addition is not extended under that Division;the term of the patent of addition expires at the end of the unextended term of the patent for the main invention.
-

5 Paragraph 224(1)(a)

Omit "subsection 103(2)," , substitute "subsection 74(3) or 103(2),".

6 Schedule 1

Insert:

Australian Register of Therapeutic Goods means the register
maintained under section 17 of the *Therapeutic Goods Act 1989*.

7 Schedule 1 (definition of *patent of addition*)

Omit "84", substitute "83".

8 Application of amendments

The amendments made by this Schedule apply to:

- (a) standard patents granted on or after the commencement of this item; and
- (b) standard patents granted before the commencement of this item (other than a standard patent granted for a term of 16 years and whose term at the time of the grant was due to end before 1 July 1995).

Schedule 2 Patent attorneys and trade marks attorneys

Schedule 2—Patent attorneys and trade marks attorneys

Copyright Act 1968

1 Subsection 43(2)

Repeal the subsection, substitute:

- (2) A fair dealing with a literary, dramatic, musical or artistic work does not constitute an infringement of the copyright in the work if it is for the purpose of the giving of professional advice by:
- (a) a legal practitioner; or
 - (b) a person registered as a patent attorney under the *Patents Act 1990*; or
 - (c) a person registered as a trade marks attorney under the *Trade Marks Act 1995*.

2 At the end of paragraph 104(a)

Insert “or”.

3 Paragraphs 104(b) and (c)

Repeal the paragraphs, substitute:

- (b) for the purpose of seeking professional advice from:
- (i) a legal practitioner; or
 - (ii) a person registered as a patent attorney under the *Patents Act 1990*; or
 - (iii) a person registered as a trade marks attorney under the *Trade Marks Act 1995*; or
- (c) for the purpose of, or in the course of, the giving of professional advice by:
- (i) a legal practitioner; or
 - (ii) a person registered as a patent attorney under the *Patents Act 1990*; or
 - (iii) a person registered as a trade marks attorney under the *Trade Marks Act 1995*.

Designs Act 1906

4 Subsection 4(1)

Insert:

patent attorney means a person registered as a patent attorney under the *Patents Act 1990*.

5 Subsection 4(1)

Insert:

trade marks attorney means a person registered as a trade marks attorney under the *Trade Marks Act 1995*.

6 Section 32G

Omit "or a patent attorney", substitute ", a patent attorney or a trade marks attorney".

Note: The heading to section 32G is altered by omitting "or patent attorney" and substituting ", patent attorney or trade marks attorney".

7 Section 44

Omit "Subject to the regulations the Registrar may permit any agent to do,", substitute "An agent may,".

8 Section 44

Before "any act", insert "do".

9 After section 44

Insert:

44A Right of lien of patent attorney and trade marks attorney

The regulations may provide that a patent attorney or a trade marks attorney has, in relation to documents and property of a client in a matter relating to designs, the same right of lien that a solicitor has in relation to the documents and property of a client.

Patents Act 1990

Schedule 2 Patent attorneys and trade marks attorneys

10 Section 3 (after the entry relating to “Deputy Commissioner”)

Insert:

Designated Manager

11 Section 3 (after the entry relating to “prior art information”)

Insert:

Professional Standards Board

12 Section 3 (after the entry relating to “registered”)

Insert:

registered patent attorney

13 Section 198

Repeal the section, substitute:

198 Registration of patent attorneys

- (1) A Register of Patent Attorneys is to be kept by the Designated Manager.

Note: *Designated Manager* is defined by section 200A.

- (2) The Register of Patent Attorneys may be kept wholly or partly by use of a computer.
- (3) If the Register of Patent Attorneys is kept wholly or partly by use of a computer, references in this Act to an entry in the Register of Patent Attorneys are to be read as including references to a record of particulars kept by use of the computer and comprising the Register of Patent Attorneys or part of the Register of Patent Attorneys.
- (4) The Designated Manager must register as a patent attorney a person who:
- (a) is ordinarily resident in Australia; and
 - (b) holds such qualifications as are specified in, or ascertained in accordance with, the regulations; and
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- (c) has been employed as prescribed for not less than the prescribed period; and
 - (d) is of good fame, integrity and character; and
 - (e) has not been convicted of a prescribed offence during the previous 5 years; and
 - (f) is not under sentence of imprisonment for a prescribed offence.

The registration is to consist of entering the person's name in the Register of Patent Attorneys.

- (5) A qualification specified in, or ascertained in accordance with, regulations made for the purposes of paragraph (4)(b) may consist of passing an examination conducted by the Professional Standards Board. This subsection does not limit paragraph (4)(b).
- (6) Paragraphs (4)(e) and (f) do not limit paragraph (4)(d).
- (7) For the purposes of this section, a person is taken to be *ordinarily resident* in Australia if:
 - (a) the person has his or her home in Australia; or
 - (b) Australia is the country of his or her permanent abode even though he or she is temporarily absent from Australia;but the person is taken not to be ordinarily resident in Australia if he or she resides in Australia for a special or temporary purpose only.
- (8) A reference in this section to conviction of an offence includes a reference to the making of an order under section 19B of the *Crimes Act 1914*, or a corresponding provision of a law of a State or a Territory, in relation to the offence.

14 Section 200

Omit "patent attorney" (wherever occurring), substitute "registered patent attorney".

15 Subsection 200(2)

Omit "his or her client," (first occurring), substitute "the attorney's client in intellectual property matters,".

Schedule 2 Patent attorneys and trade marks attorneys

16 At the end of section 200

Add:

(4) In this section:

intellectual property matters means:

- (a) matters relating to patents; or
- (b) matters relating to trade marks; or
- (c) matters relating to designs; or
- (d) any related matters.

17 After section 200

Insert:

200A Designated Manager

For the purposes of this Act, a person is the *Designated Manager* if:

- (a) the Secretary to the Department has, in writing, declared that the holder or occupier of a specified Senior Executive Service office or position is the Designated Manager; and
- (b) the person holds or occupies, or is performing the duties of, that office or position.

18 Subsection 201(2)

Omit "each member", substitute "at least one member".

19 Subsection 201(4)

Repeal the subsection, substitute:

- (4) The members of a partnership must not describe the partnership, or hold the partnership out, or permit the partnership to be described or held out, as patent attorneys, or agents for obtaining patents, unless at least one member is a registered patent attorney.

Penalty: 30 penalty units.

20 Subsection 201(7)

Repeal the subsection, substitute:

- (7) For the purposes of this section, a person or company is taken to carry on business, practise or act as a patent attorney if, and only if, the person or company does, or undertakes to do, on behalf of someone else, any of the following in Australia for gain:
 - (a) applying for or obtaining patents in Australia or anywhere else;
 - (b) preparing specifications or other documents for the purposes of this Act or the patent law of another country;
 - (c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.
- (8) A person does not commit an offence against subsection (1) in respect of anything done, or undertaken to be done, by the person in the capacity of employee for:
 - (a) in any case—the person's employer; or
 - (b) if the person's employer is a member of a related company group—another member of the group.
- (9) A company that is a member of a related company group does not commit an offence against subsection (5) in respect of anything done, or undertaken to be done, by the company for another member of the group.
- (10) In this section:

related company group means a group of 2 or more companies, where each member of the group is related to each other member of the group.
- (11) For the purposes of this section, the question of whether a company is related to another company is to be determined in the same manner as that question is determined under the Corporations Law.

21 After section 202

Insert:

Schedule 2 Patent attorneys and trade marks attorneys

202A Documents prepared by a member of a partnership

A person who is:

- (a) a member of a partnership; and
- (b) not a registered patent attorney;

must not prepare a specification, or a document relating to an amendment of a specification, unless:

- (c) the person is acting under the instructions or supervision of a registered patent attorney; or
- (d) the amendment has been directed by an order under section 105.

Penalty: 30 penalty units.

22 Section 204

After “202”, insert “, 202A”.

23 Section 213

Omit “person entitled under this Act to practise as a patent attorney”, substitute “registered patent attorney”.

24 Section 220

Omit “patent attorney”, substitute “registered patent attorney”.

25 Paragraph 224(1)(b)

Repeal the paragraph, substitute:

- (b) a decision of the Designated Manager under section 198 not to register a person as a patent attorney; or

26 After section 227

Insert:

227A Professional Standards Board for Patent and Trade Marks Attorneys

- (1) The Professional Standards Board for Patent and Trade Marks Attorneys is established.
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- (2) The Professional Standards Board has the following functions:
- (a) such functions as are conferred on the Professional Standards Board by this Act or the *Trade Marks Act 1995*;
 - (b) such functions as are conferred on the Professional Standards Board by regulations made for the purposes of any of the following provisions:
 - (i) paragraph 198(4)(b) of this Act (which deals with the qualifications of patent attorneys);
 - (ii) section 199 of this Act (which deals with the deregistration of patent attorneys);
 - (iii) paragraph 228(2)(r) of this Act (which deals with the professional conduct of patent attorneys);
 - (iv) paragraph 228A(4)(a) of the *Trade Marks Act 1995* (which deals with the qualifications of trade marks attorneys);
 - (v) section 228B of the *Trade Marks Act 1995* (which deals with the deregistration of trade marks attorneys);
 - (vi) paragraph 231(2)(ha) of the *Trade Marks Act 1995* (which deals with the professional conduct of trade marks attorneys);
 - (c) to do anything incidental to or conducive to the performance of any of the above functions.
- (3) The regulations may make provision for and in relation to:
- (a) the constitution and membership of the Professional Standards Board; and
 - (b) the manner in which the Professional Standards Board is to perform its functions; and
 - (c) the procedure to be followed at or in relation to meetings of the Professional Standards Board, including (but not limited to) matters with respect to:
 - (i) the convening of meetings of the Board; and
 - (ii) the number of members of the Board who are to constitute a quorum; and
 - (iii) the selection of a member of the Board to preside at a meeting of the Board; and
-

Schedule 2 Patent attorneys and trade marks attorneys

- (iv) the manner in which questions arising at a meeting of the Board are to be decided.
- (4) A member of the Professional Standards Board is to be paid such remuneration as is determined by the Remuneration Tribunal. If no determination of that remuneration by the Tribunal is in operation, the member is to be paid such remuneration as is prescribed.
- (5) A member of the Professional Standards Board is to be paid such allowances as are prescribed.
- (6) Subsections (4) and (5) have effect subject to the *Remuneration Tribunal Act 1973*.

27 Schedule 1

Insert:

Designated Manager has the meaning given by section 200A.

28 Schedule 1

Insert:

Professional Standards Board means the Professional Standards Board for Patent and Trade Marks Attorneys established by section 227A.

29 Schedule 1 (definition of *registered*)

Repeal the definition, substitute:

registered, in relation to a patent, means entered in the Register of Patents.

30 Schedule 1

Insert:

registered patent attorney means a person registered as a patent attorney under this Act.

31 Transitional—Register of Patent Attorneys

After the commencement of this item, the Register of Patent Attorneys kept under section 198 of the *Patents Act 1990* (as in force immediately before that commencement) is taken to form part of the Register of Patent Attorneys kept under section 198 of that Act as amended by this Schedule.

32 Transitional—registered patent attorneys

- (1) This item applies to a person who was, immediately before the commencement of this item, a registered patent attorney within the meaning of the *Patents Act 1990*.
- (2) The *Patents Act 1990* has effect, after the commencement of this item, in relation to the person, as if the person had been registered as a patent attorney under section 198 of the *Patents Act 1990* as amended by this Schedule.

Trade Marks Act 1995

33 Section 6

Insert:

registered trade marks attorney means a person registered as a trade marks attorney under this Act.

34 Subsection 129(6)

After “a lawyer”, insert “, registered trade marks attorney”.

35 Subsection 129(6) (note)

After “*lawyer*”, insert “, *registered trade marks attorney*”.

36 Section 155 (except note 4)

Repeal the section.

37 Section 155 (note 4)

Relocate the note to the end of subsection 156(2).

38 Subsection 156(1)

Schedule 2 Patent attorneys and trade marks attorneys

Repeal the subsection, substitute:

- (1) A person must not describe himself or herself, or hold himself or herself out, or permit himself or herself to be described or held out, as a trade marks attorney unless the person is a registered trade marks attorney.

Penalty: 30 penalty units.

Note 1: The Reader's Guide gives information about penalties (see the paragraphs under the subheading *Crimes Act 1914*).

Note 2: For *registered trade marks attorney*, see section 6.

39 Subsection 156(2)

Omit all the words from and including "held out," to and including "unless the person is", substitute "held out, as a trade marks agent unless the person is a registered trade marks attorney or".

40 Subsection 156(2) (note 2)

After "*lawyer*", insert ", *registered trade marks attorney*".

41 Subsection 156(2) (note 3)

Repeal the note.

42 Subsection 156(5)

Repeal the subsection.

43 Section 212

Repeal the section, substitute:

212 Making and signing applications etc.

An application, notice or request required or permitted under this Act to be made or signed by a person may be made or signed, on behalf of that person, by any other person.

44 After section 228

Insert:

228A Registration of trade marks attorneys

- (1) A Register of Trade Marks Attorneys is to be kept by the Designated Manager.

Note: *Designated Manager* is defined by subsection (9).

- (2) The Register of Trade Marks Attorneys may be kept wholly or partly by use of a computer.
- (3) If the Register of Trade Marks Attorneys is kept wholly or partly by use of a computer, references in this Act to an entry in the Register of Trade Marks Attorneys are to be read as including references to a record of particulars kept by use of the computer and comprising the Register of Trade Marks Attorneys or part of the Register of Trade Marks Attorneys.
- (4) The Designated Manager must register as a trade marks attorney a person who:
- (a) holds such qualifications as are specified in, or ascertained in accordance with, the regulations; and
 - (b) is of good fame, integrity and character; and
 - (c) has not been convicted of a prescribed offence during the previous 5 years; and
 - (d) is not under sentence of imprisonment for a prescribed offence.

The registration is to consist of entering the person's name in the Register of Trade Marks Attorneys.

- (5) A qualification specified in, or ascertained in accordance with, regulations made for the purposes of paragraph (4)(a) may consist of passing an examination conducted by the Professional Standards Board. This subsection does not limit paragraph (4)(a).
- (6) Paragraphs (4)(c) and (d) do not limit paragraph (4)(b).
- (7) A person may apply to the Administrative Appeals Tribunal for review of a decision of the Designated Manager not to register the person as a trade marks attorney.
- (8) A reference in this section to conviction of an offence includes a reference to the making of an order under section 19B of the
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Schedule 2 Patent attorneys and trade marks attorneys

Crimes Act 1914, or a corresponding provision of a law of a State or a Territory, in relation to the offence.

(9) In this section:

Designated Manager has the same meaning as in the *Patents Act 1990*.

Professional Standards Board has the same meaning as in the *Patents Act 1990*.

228B Deregistration of trade marks attorneys

The name of the person registered as a trade marks attorney may be removed from the Register of Trade Marks Attorneys in the prescribed manner and on the prescribed grounds.

45 Section 229

Repeal the section, substitute:

229 Privileges of trade marks attorney and patent attorney

- (1) A communication between a registered trade marks attorney and the attorney's client in intellectual property matters, and any record or document made for the purposes of such a communication, are privileged to the same extent as a communication between a solicitor and his or her client.
- (2) The regulations may provide that a registered trade marks attorney or a patent attorney has, in relation to documents and property of a client in a matter relating to trade marks, the same right of lien that a solicitor has in relation to the documents and property of a client.
- (3) In this section:
intellectual property matters means:
 - (a) matters relating to patents; or
 - (b) matters relating to trade marks; or
 - (c) matters relating to designs; or
 - (d) any related matters.

46 After paragraph 231(2)(h)

Insert:

- (ha) provide for the control of the professional conduct of registered trade marks attorneys and the practice of the profession and, for that purpose, make provision for and in relation to all or any of the following:
 - (i) making complaints, and hearing charges, against registered trade marks attorneys about their professional conduct;
 - (ii) imposing penalties on registered trade marks attorneys (including issuing a reprimand and suspending or cancelling registration);
 - (iii) summoning witnesses;
 - (iv) requiring persons to give evidence on oath (whether orally or otherwise);
 - (v) administering oaths to persons giving evidence (whether orally or otherwise);
 - (vi) requiring persons to produce documents or articles; and

Schedule 3 Miscellaneous amendments of the Patents Act 1990

**Schedule 3—Miscellaneous amendments of
the Patents Act 1990**

1 Subparagraph 6(c)(ii)

Repeal the subparagraph.

2 Section 185

Repeal the section, substitute:

185 Commissioner etc. not to prepare documents or search records

The Commissioner, a Deputy Commissioner or an employee must not:

- (a) prepare, or help to prepare:
 - (i) a specification; or
 - (ii) any other document relating to a specification (other than a document which is in an approved form);unless the Commissioner, Deputy Commissioner or the employee is the inventor in respect of the specification; or
- (b) search the records of the Patent Office otherwise than in his or her official capacity.

Penalty: 10 penalty units.

3 Subsection 227(5)

Repeal the subsection, substitute:

(5) If:

- (a) a fee (other than a renewal fee or a continuation fee) is payable under this Act by a person in respect of:
 - (i) the doing of an act by someone other than the Commissioner; or
 - (ii) the filing of a document; and
- (b) the Commissioner has, in accordance with the regulations, given the person a written notice under this paragraph in relation to the payment of that fee; and

Miscellaneous amendments of the Patents Act 1990 Schedule 3

- (c) the person fails to pay the fee within a prescribed period after the notice has been given to the person;
- then, for the purposes of this Act:
- (d) if paragraph (e) does not apply—the act is taken never to have been done, or the document is taken never to have been filed (as the case requires); or
 - (e) in the case of a fee that is payable in respect of the filing of a patent request and the accompanied specification—the patent request and the specification are taken to have been filed but the application under section 29 to which the patent request relates lapses.

Note: The consequence of failing to pay a continuation fee is provided for in paragraph 142(2)(d). The consequence of failing to pay a renewal fee is provided for in paragraph 143(a).

- (6) If, in accordance with subsection (5):
 - (a) an act is taken never to have been done; or
 - (b) a document is taken never to have been filed; or
 - (c) a patent request and its accompanied specification are taken to have been filed but the application to which the patent request relates lapses;the Commissioner must, as soon as practicable, give written notice about that fact to:
 - (d) the person referred to in paragraph (5)(a); and
 - (e) any other persons considered by the Commissioner to be interested in the matter.

4 Application

Section 227 of the *Patents Act 1990* as amended by item 3 of this Schedule applies only in relation to a fee payable under that Act in respect of the doing of an act or the filing of a document that is to occur on or after the commencement of that item.

*[Minister's second reading speech made in
House of Representatives on 26 November 1997
Senate on 26 March 1998]*

(216/97)