

FICPI

COUNTRY REPORT

AUSTRALIA

October 2005

Meetings

In late July 2005, the Australian Association returned to Broome in the north of Western Australia for another very successful annual meeting. About 30 members of the Australian Association, 1 prospective member and 2 business managers from Australian firms attended, with about 25 accompanying persons. Major topics covered in the business sessions were 1) Human Capital Management, 2) Goodwill or No Goodwill – Pros and Cons for Partnership, 3) Succession Planning, 4) Share Ownership in Clients – What are the Rules?, 5) Recent Changes to Service Trust Rules and 6) Managing Continuing Education. The Association paid for external speakers for all of the sessions. For the first and third sessions, the speaker was a lawyer from a legal practice management research training and consulting organisation. An accountant from a full service business advisory practice spoke at the second, fourth and fifth sessions, supported by several patent attorneys in the second session and by a lawyer specialising in liability insurance and insurance litigation in the fourth session. A human resources specialist with a law firm background delivered the sixth session.

Membership

Membership of the Australian Association has increased to 105, with a couple of prospective members in the wings.

Meetings with Officials

IP Australia continues to call on the Australian Association for input to reviews of, proposals for and changes to Australian IP legislation. Topics on which input has been provided since the Seoul ExCo include evaluation of a test website on Plant Breeders' Rights, proposed Free Trade Agreements with the United Arab Emirates, Malaysia, China and ASEAN, the provisions of the Designs Act 2003 dealing with the exclusion from infringement of spare parts, the extent of privilege provided by the various IP Acts, and the search results' requirements under the Patents Act. On the latter, it looks as though some of the requirements will be eased shortly.

In the last 5 months, government responses have been issues on the Advisory Council on Intellectual Property (ACIP) reports on the patenting of business systems and on the protection of national icons, following replies by the Association to ACIP's original issues papers.

More recently, on 13 October 2005, the government issued its response to a report by the Professional Standards Board for Patent and Trade Mark Attorneys on the Regulatory Regime for attorneys. The Association had supported the report in general terms on the basis that it would have resulted in better qualified patent and trademark attorneys. However, the government has rejected most of the proposals in the report, including one for a provisional form of registration. The government has instead proposed a minimum training period of 2 years prior to registration of a patent attorney, and has accepted ACIP's proposal for a structured continuing education programme.

Website

The development of the Association's website is almost complete. Following approval by the membership, the website should be up and running very shortly.

Legislation

There have been no significant changes to IP legislation in Australia since the report to the Seoul ExCo. However, there have been several interesting decisions of the courts.

Three recent patent decisions emphasise that claims will be given a literal interpretation for both novelty and infringement purposes, with arguments for equivalence failing.

There have been two decisions supporting extensions of term for pharmaceutical patents, and another in relation to the Viagra patent in which one of the independent claims was found to be invalid. That decision is under appeal.

Earlier in the year, the High Court (the highest court in Australia) issued a major decision on fair basis issues in patent specifications, giving much needed clarification.

Following a more European approach, the Patent Office has rejected a patent application for a business method on the basis that the business method did not have "at least some material application of science or technology". A decision on an appeal to a similar, earlier Patent Office decision is expected soon.

The Designs Act 1906 provided that a registered design is infringed by the unauthorised application of "the design or any fraudulent or obvious imitation of it", and the High Court has recently considered what makes a fraudulent imitation. Although the 1906 Act and the definition of an infringing act have been replaced by the Designs Act 2003, the decision will continue to have importance for designs registered under the old Act.

On the trade mark front the Federal Court has ruled that foreign based websites must specifically target Australian customers before the Court will find liability or grant relief for claims of passing off and trade mark infringement.

Peter Huntsman

President

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