



DATE: 04 April 2008

NAME OF ASSOCIATION/SECTION: FICPI Australia

WEB PAGE OF ASSOCIATION/SECTION: www.ficpi.org.au

MEETING: EXCO Meeting in Sydney, Australia

DRAWN UP BY: Peter Huntsman, President

1 Activities of FICPI Association/Section

1.1 Meetings and Other Internal Activities

The Council of FICPI Australia has met four times since the ExCo meeting in Seville, and has had several phone and email discussions. The principal business at these meetings has been to discuss planning and arrangements for this ExCo meeting in Sydney, preparation for the FICPI Australia Annual General Meeting to be held on Magnetic Island off the coast of Queensland from 25 to 29 July 2008, to discuss internal activities of the Association, such as a benchmarking survey of firms, and to discuss Government and Patent Office reports regarding IP law reform in Australia.

The working sessions currently planned for the Magnetic Island meeting are primarily directed at the option of Patent Attorney firms in Australia being allowed to incorporate, which is expected to be allowed shortly, at electronic opportunities in the office and at the skills shortage that has been anticipated in Australia.

Noel Brett, David Griffith and Peter Huntsman have had numerous meetings and telephone conferences, including with the conference organisers, to progress plans for this ExCo. One such meeting was a weekend visit by Noel Brett, Peter Huntsman and their spouses to Sydney to test the various conference venues. Noel Brett has been fundamental in organising the conference and our sincere thanks are owed to him.

1.2 Meetings with Officials and Other External Activities

There have been several meetings with officials since the last ExCo meeting, particularly:

- a meeting of the Patent Consultation Group (PCG) hosted by IP Australia (IPA) on 22 February 2008, covering a wide variety of subjects (see below);
- a regular update meeting on 5 December 2007 with the Department of Foreign Affairs and Trade to discuss the many Free Trade Agreements that have been and are being put in place by the Federal Government, including with Chile, UAE, the Gulf States, Singapore, USA, Malaysia, Japan and China. The adoption of an ASEAN IP Chapter was also discussed;
- meetings and discussions with other interested parties concerning the issue of privilege in Australia. Interestingly, the Intellectual Property



Research Institute of Australia (IPRIA) issued a research paper on 20 December 2007 supportive of the Association's views that privilege in Australia should be extended. The paper contains a good summary of privilege in a number of countries.

1.3 Submissions Made

(a) Incorporation of Patent & Trade Mark Attorney Firms

On 4 December 2007, the Association filed its response to specific proposals by IP Australia on how to allow for incorporation of IP practice firms. The response was generally supportive of the proposals, with most emphasis being placed on the provisions requiring professional indemnity insurance.

(b) Notices of Entitlement

The Association made submissions on 15 February 2008 arguing for maintaining the requirement to file Notices of Entitlement (NOEs) on patent applications, at least until changes are made to the Patents Act 1990 to relieve the potentially serious consequences of a patent being granted in the name of a party who is not entitled to it. It appears that IP Australia has been persuaded to change its plans to eliminate the need for NOEs.

(c) Divisional Patent Applications

As reported in our last Country Report, IP Australia had been making moves to severely restrict the ability to file divisional patent applications, and the Association made strong submissions against this on 15 February 2008 for presentation to the PCG meeting that month. As a result of this, IP Australia has been persuaded to put its plans on hold.

(d) Opposition Case Management - Amendments

On 15 February 2008, the Association made submissions to IP Australia regarding the options for amending patent applications during oppositions to them.

(e) Patent Attorney Registration and Discipline

IP Australia has very recently released its proposed regulations implementing changes to the registration and disciplinary procedures for Patent Attorneys and Trade Marks Attorneys, which it hopes to bring in to force on 1 July 2008. Comment has been called for by 18 April 2008. The Association hopes to provide comments, but it is not clear that this will be possible given the very short time permitted to do so.

1.4 Changes in membership

There have been no changes in membership since the Seville ExCo, but it is anticipated that some retired members will shortly become Emeritus members and that some Trade Mark Attorneys will shortly apply for membership. The Association currently has 98 members.



1.5 Changes in office bearers

For business and personal reasons, Steve Krouzecky will step down as Treasurer of the Association and be replaced by Charles Berman. The change will take place gradually over the next few months and will be effective until the next round of elections for office bearers due in mid-2009.

1.6 Other activities

(a) Benchmarking Survey

Council is continuing its work on a benchmarking survey of members' firms.

(b) Incorporation of the Association

FICPI Australia has been looking at this requirement for some time and has recently received a draft set of amendments of its Articles of Association. The proposed changes are quite substantial and need careful review as they have to be approved by the membership at a General Meeting

(c) CET Group 2 Resolution

A draft of the resolution on Unregistered Community Designs for presentation to this ExCo was circulated to the Council of the Association and comments were provided.

(d) IP Australia Director General

The Association has welcomed the new Director General, Philip Noonan. It had been anticipated he would attend the Sydney ExCo, but a WIPO meeting has intervened.

1.7 Upcoming events

- (a) 2008 Annual General Meeting, 25 – 29 July 2008 on Magnetic Island, as discussed above.**

2 Changes in Law

2.1 Legislation

There have been no major changes in Law.

2.2 Major Cases



Ajinomoto Co Inc v NutraSweet Australia Pty Ltd [2008] FCA 34

The requirement of section 7(3), as it read prior to the 2001 amendments, that prior art be reasonably expected to be "ascertained, understood and regarded as relevant to work in the relevant art in [Australia]" should be understood as requiring evidence of actual work in that art in this country.

The Polo/Lauren Company L.P. v Ziliani Holdings Pty Ltd [2008] FCA 49

A logo on an article of clothing which conveyed to a person looking at it that it was manufactured by a given entity 'labels' the garment as a product of that entity and is therefore a label within the definition of accessory for the purposes of the Copyright Act. Accordingly, the logo when embroidered on an article of clothing is a "non-infringing accessory" for the purposes of section 44C and copyright is not infringed by the importation or sale of an article bearing that logo.

2.3 Official Practice

On 31 March 2008 IP Australia and the USPTO announced a trial "Patent Prosecution Highway" from 14 April 2008. Under this, an applicant in AU or the US receiving a report from one of the offices identifying at least one allowable claim may request the other office to accelerate the examination of the corresponding application there. The applicant is said to benefit from the other office using work previously conducted by the first office and by obtaining a corresponding patent faster and more efficiently. More information is available at http://www.ipaustralia.gov.au/media/resources/MR_PPH_310308.pdf

3 Proposals for changes

Only those discussed above.