Intellectual Property Laws Amendment Bill 2013

No. , 2013

(Industry, Innovation, Climate Change, Science, Research and Tertiary Education)

A Bill for an Act to amend legislation relating to intellectual property, and for related purposes
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*i*  *Intellectual Property Laws Amendment Bill 2013*  
No.  , 2013
Part 2—Technical amendments

Patents Act 1990

Division 2—Application of amendments
A Bill for an Act to amend legislation relating to intellectual property, and for related purposes

The Parliament of Australia enacts:

1 Short title

This Act may be cited as the Intellectual Property Laws Amendment Act 2013.

2 Commencement

(1) Each provision of this Act specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.
## Commencement information

<table>
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<tr>
<td>Provision(s)</td>
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<tr>
<td>1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table</td>
<td>The day this Act receives the Royal Assent.</td>
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<td>2. Schedule 1</td>
<td>The 28th day after this Act receives the Royal Assent.</td>
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<td>3. Schedule 2</td>
<td>The start of the day after the end of the period of 6 months beginning on the day this Act receives the Royal Assent.</td>
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<td>4. Schedule 3</td>
<td>The later of: (a) immediately after the start of the day after the end of the period of 6 months beginning on the day this Act receives the Royal Assent; and (b) immediately after Article 31bis of the Agreement on Trade-Related Aspects of Intellectual Property Rights set out in Annex 1C to the Marrakesh Agreement establishing the World Trade Organization, done at Marrakesh on 15 April 1994, comes into force for Australia. However, the provision(s) do not commence at all if the event mentioned in paragraph (b) does not occur. The Minister administering the Patents Act 1990 must announce by notice in the Gazette the day the event mentioned in paragraph (b) occurs.</td>
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<td>5. Schedule 4</td>
<td>The day after the end of the period of 6 months beginning on the day this Act receives the Royal Assent.</td>
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</tr>
<tr>
<td>6. Schedule 5</td>
<td>A single day to be fixed by Proclamation. However, if the provision(s) do not commence within the period of 24 months beginning on the day this Act receives the Royal Assent, the provision(s) are repealed</td>
<td></td>
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<tr>
<td>Provision(s)</td>
<td>Commencement</td>
<td>Date/Details</td>
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<td>7. Schedule 6, Part 1</td>
<td>The day after this Act receives the Royal Assent.</td>
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<td>8. Schedule 6, item 6</td>
<td>Immediately after the commencement of item 32 of Schedule 6 to the <em>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</em>.</td>
<td>15 April 2013</td>
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<td>9. Schedule 6, items 7 to 13</td>
<td>A single day to be fixed by Proclamation. However, if the provision(s) do not commence within the period of 6 months beginning on the day this Act receives the Royal Assent, they commence on the day after the end of that period.</td>
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<td>10. Schedule 6, item 14</td>
<td>Immediately after the commencement of item 32 of Schedule 6 to the <em>Intellectual Property Laws Amendment (Raising the Bar) Act 2012</em>.</td>
<td>15 April 2013</td>
</tr>
<tr>
<td>11. Schedule 6, item 15</td>
<td>A single day to be fixed by Proclamation. However, if the provision(s) do not commence within the period of 6 months beginning on the day this Act receives the Royal Assent, they commence on the day after the end of that period.</td>
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<td>12. Schedule 6, item 16</td>
<td>The day this Act receives the Royal Assent.</td>
<td></td>
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</table>

Note: This table relates only to the provisions of this Act as originally enacted. It will not be amended to deal with any later amendments of this Act.

(2) Any information in column 3 of the table is not part of this Act. Information may be inserted in this column, or information in it may be edited, in any published version of this Act.

### 3 Schedule(s)

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—Crown use

Part 1—Amendments

Patents Act 1990

1 Section 3 (list of definitions)
   Insert “Crown exploitation”.

2 Section 3 (list of definitions)
   Insert “relevant Minister”.

3 Section 3 (list of definitions)
   Insert “services”.

4 Before section 161
   Insert:

160A Crown exploitation of inventions

   (1) This Chapter applies, at any time after a patent application for an
       invention has been made, to the exploitation (the Crown
       exploitation) of the invention by a relevant authority, or for a
       relevant authority by an authorised person, for the services of the
       relevant authority concerned.

       Note: A reference in this Chapter to a relevant authority is a reference to the
       Commonwealth or a State (see the Dictionary). See also section 162.

   (2) A relevant authority may, in writing, authorise a person for the
       purposes of subsection (1).

   (3) A person:

       (a) must be authorised before any act covered by the
           authorisation is done; and

       (b) may be authorised:

           (i) before or after a patent has been granted for the
               invention; and

           (ii) even if the person is directly or indirectly authorised by
                the nominated person or patentee to exploit the
                invention.
(4) Subject to section 168, an invention is taken for the purposes of this Chapter to be exploited for the services of a relevant authority if the exploitation of the invention is necessary for the proper provision of those services in Australia.

(5) In this Chapter:

relevant Minister means:

(a) in relation to the exploitation of an invention by or for the Commonwealth—the Minister; and

(b) in relation to the exploitation of an invention by or for a State—the Attorney-General of the State.

services, of a relevant authority, in relation to the exploitation of an invention by or for the relevant authority, includes:

(a) if the relevant authority is the Commonwealth—a service that is:

(i) primarily provided or funded by the Commonwealth; or

(ii) primarily provided or funded by the Commonwealth and one or more of the States; and

(b) if the relevant authority is a State—a service that is:

(i) primarily provided or funded by the State; or

(ii) primarily provided or funded by the State and one or more of the other States or the Commonwealth.

Example: The Commonwealth and the States primarily fund the provision of health services, including genetic tests covered by patents. Under this Chapter, a relevant authority can authorise a third party (an authorised person) to exploit such a patent. Any exploitation of the patent by the third party conducting the test on an individual is not an infringement under this Chapter.

5 Section 163

Repeal the section, substitute:

163 Crown exploitation—general rule

(1) Crown exploitation of an invention is not an infringement of the following if the conditions in subsection (2) are satisfied:

(a) if a patent application for the invention is pending—the nominated person’s rights in the invention;

(b) if a patent has been granted for the invention—the patent.
(2) The conditions are:

(a) the relevant Minister considers that the relevant authority has tried for a reasonable period, but without success, to obtain from the applicant and the nominated person, or the patentee, an authorisation to work the invention on reasonable terms; and

(b) the relevant Minister approves the proposed exploitation by instrument; and

(c) at least 14 days before the exploitation starts, the relevant Minister gives the applicant and the nominated person, or the patentee:

(i) a copy of the instrument of approval; and

(ii) a copy of a statement of reasons for approving the proposed exploitation.

Note: Section 25D of the Acts Interpretation Act 1901 sets out rules about the contents of a statement of reasons.

(3) An approval given under paragraph (2)(b) is not a legislative instrument.

163A Crown exploitation—emergencies

(1) Crown exploitation of an invention is not an infringement of the following if the conditions in subsection (2) are satisfied:

(a) if a patent application for the invention is pending—the nominated person’s rights in the invention;

(b) if a patent has been granted for the invention—the patent.

(2) The conditions are:

(a) the relevant Minister considers that the exploitation is required because of an emergency; and

(b) the relevant Minister approves the proposed exploitation by instrument before the exploitation starts.

(3) As soon as practicable after the relevant Minister approves the proposed exploitation, the relevant Minister must give the applicant and the nominated person, or the patentee:

(a) a copy of the instrument of approval; and

(b) a copy of a statement of reasons for approving the exploitation.
Note: Section 25D of the Acts Interpretation Act 1901 sets out rules about the contents of a statement of reasons.

(4) An approval given under paragraph (2)(b) is not a legislative instrument.

6 Section 164 (heading)
Repeal the heading, substitute:

164 Crown exploitation—information to be given by relevant authority

7 Section 164
Omit “an invention has been exploited under subsection 163(1)”, substitute “the exploitation of an invention to which subsection 163(1) or 163A(1) applies”.

8 Section 165 (heading)
Repeal the heading, substitute:

165 Crown exploitation—terms (including remuneration)

9 Subsection 165(2)
Repeal the subsection, substitute:

(1) The terms for the Crown exploitation (including terms concerning the remuneration payable to the nominated person or the patentee) are such terms:

(a) as are agreed, or determined by a method agreed, between the relevant authority and the nominated person or the patentee; or

(b) in the absence of agreement—as are determined by a prescribed court on the application of the relevant authority, or the nominated person or the patentee.

(2) Without limiting paragraph (1)(b), the prescribed court must determine an amount of remuneration that is just and reasonable, having regard to the economic value of the exploitation of the invention.
10 **Subsection 165(3)**

Omit “subsection (2)”, substitute “this section”.

11 **Section 165A (heading)**

Repeal the heading, substitute:

165A Crown exploitation—court order to cease

12 **Subsection 165A(1)**

Omit “exploitation of the invention by the Commonwealth or the State”, substitute “Crown exploitation of the invention”.

13 **Subsection 165A(1)**

Omit “Commonwealth or of the State”, substitute “relevant authority concerned”.

14 **Subsection 165A(2)**

Omit “Commonwealth or the State”, substitute “relevant authority”.

15 **Subsection 165A(2)**

Omit “Commonwealth or of the State”, substitute “relevant authority”.

16 **Section 166**

Omit “the Commonwealth or a State”, substitute “relevant authority”.

17 **Section 166**

Omit “under subsection 163(1)”, substitute “to which subsection 163(1) or 163A(1) applies”.

18 **Section 166**

Omit all the words after “unless the agreement or licence”, substitute “has been approved by the relevant Minister”.

19 **Subsections 167(1) and (2)**

After “subsection 163(1)”, insert “or 163A(1)”.

20 **Section 169**

Repeal the section.
21 Schedule 1

Insert:

*Crown exploitation* has the meaning given by subsection 160A(1).

*relevant Minister* has the meaning given by subsection 160A(5).

*services*, of a relevant authority, has the meaning given by subsection 160A(5).
Part 2—Application and transitional provisions

22 Definition

In this Part:

amended Act means the Patents Act 1990 as in force after the commencement of this Schedule.

23 Application of amendments

The amendments of the Patents Act 1990 made by Part 1 of this Schedule apply in relation to Crown exploitation that starts, or is proposed to start, on or after the commencement of this Schedule.

24 Transitional—authorised person

An authorisation of a person that is in force for the purposes of section 163 of the Patents Act 1990 immediately before the commencement of this Schedule continues in force as if:

(a) the person had been authorised under subsection 160A(2) of the amended Act; and

(b) subsection 160A(3) of the amended Act were satisfied in relation to the person.

25 Transitional—negotiations

If, before the commencement of this Schedule, a relevant authority has tried, for a period, but without success, to obtain from an applicant and a nominated person, or a patentee, an authorisation to work an invention on reasonable terms, the relevant Minister must take that period into account in considering whether the condition in paragraph 163(2)(a) of the amended Act is satisfied in relation to the exploitation of the invention.

26 Transitional—agreements and determinations

An agreement or determination that is in force for the purposes of subsection 165(2) of the Patents Act 1990 immediately before the commencement of this Schedule continues in force on and after that commencement as if it had been made for the purposes of subsection 165(1) of the amended Act.
Schedule 2—TRIPS Protocol interim waiver

Part 1—Amendments

Patents Act 1990

1 Section 3 (list of definitions)
   Omit “compulsory licence”.

2 Section 3 (list of definitions)
   Insert “eligible importing country”.

3 Section 3 (list of definitions)
   Insert “patented pharmaceutical invention”.

4 Section 3 (list of definitions)
   Insert “pharmaceutical product”.

5 Section 3 (list of definitions)
   Insert “PPI”.

6 Section 3 (list of definitions)
   Insert “PPI ancillary licence”.

7 Section 3 (list of definitions)
   Insert “PPI compulsory licence”.

8 Section 3 (list of definitions)
   Insert “PPI cross-licence”.

9 Section 3 (list of definitions)
   Insert “PPI order”.

10 Section 3 (list of definitions)
    Insert “PPI order applicant”.

11 Section 3 (list of definitions)
    Insert “WTO General Council decision of 30 August 2003”.

12 Before subsection 70(5)

Insert:

Meaning of first regulatory approval date

13 After subsection 70(5)

Insert:

(5A) For the purposes of paragraph (5)(a), disregard an inclusion in the Australian Register of Therapeutic Goods of goods that contain, or consist of, a pharmaceutical substance if the inclusion was sought for the sole purpose of exporting the goods from Australia to address a public health problem in an eligible importing country:

(a) in circumstances of national emergency or other circumstances of extreme urgency; or

(b) by the public non-commercial use of the goods.

Note: This subsection also applies in relation to an application for an extension of the term of a standard patent (see paragraph 71(2)(b)).

Meaning of pre-TGA marketing approval

14 At the end of paragraph 71(2)(b)

Add “, as worked out under subsection 70(5A) (if applicable)”.

15 Before section 133

Insert:

Part 1—Compulsory licences (general)

16 Section 133 (heading)

Repeal the heading, substitute:

133 Compulsory licences—general

17 Section 134 (heading)

Repeal the heading, substitute:
134 Revocation of patent after grant of compulsory licence under section 133

18 Subsection 134(1)
   After “compulsory licence”, insert “under section 133”.

19 After section 136A
   Insert:

Part 2—Compulsory licences (patented pharmaceutical inventions)

Division 1—Scope of Part 2

136B Relationship between Parts 1 and 2
   This Part does not prevent a compulsory licence from being granted under Part 1 in relation to a patented pharmaceutical invention.

Division 2—Patented pharmaceutical invention compulsory licences (grant)

136C Application for order to grant PPI compulsory licence

   Application for order
   
   (1) A person (the **PPI order applicant**) may apply to the Federal Court for an order (the **PPI order** under section 136D requiring the patentee of a patented pharmaceutical invention to grant the PPI order applicant a licence (a **PPI compulsory licence**) to work the invention to the extent necessary for the purposes of manufacturing a pharmaceutical product in Australia for export to an eligible importing country.

   Note 1: A patented pharmaceutical invention may be a patented product or a patented process: see the definition of **patented pharmaceutical invention** in Schedule 1.

   Note 2: For remuneration in respect of a licence, see section 136P.
(2) However, a person cannot apply for an order in respect of an innovation patent unless the patent has been certified.

Statement by or on behalf of eligible importing country

(3) An application must include a copy of a statement made by or on behalf of, and with the authorisation of, the eligible importing country to the effect that it will take reasonable measures within its means, proportionate to its administrative capacities and to the risk of trade diversion, to prevent re-exportation from its territory of a pharmaceutical product imported into its territory in accordance with a PPI compulsory licence.

Statement by or on behalf of importer

(4) If the pharmaceutical product is to be imported on behalf of, and with the authorisation of, the eligible importing country, an application must also include a copy of a statement made by the importer to the effect that it will take reasonable measures within its means to prevent the pharmaceutical product from being used other than in accordance with a PPI compulsory licence.

Parties

(5) The following are parties to proceedings on an application under this section:

(a) the PPI order applicant;

(b) the patentee;

(c) any person claiming an interest in the patent as exclusive licensee or otherwise;

(d) at the option of the eligible importing country—that country.

Note: See also section 136F.

136D Order for PPI compulsory licence

(1) After hearing an application under section 136C, the Federal Court may, subject to this Part, make the PPI order sought if the court is satisfied of all of the following matters:

(a) the application is made in good faith;

(b) the pharmaceutical product is to be imported:

   (i) by the eligible importing country; or
(ii) by a person (the **third party importer**) on behalf of, and with the authorisation of, the eligible importing country;

(c) the proposed use of the pharmaceutical product is to address a public health problem in the eligible importing country:

(i) in circumstances of national emergency or other circumstances of extreme urgency; or

(ii) in other circumstances—by the public non-commercial use of the pharmaceutical product;

(d) working the patented pharmaceutical invention is necessary to enable the import and proposed use of the pharmaceutical product as mentioned in paragraphs (b) and (c);

(e) if subparagraph (c)(ii) applies:

(i) the PPI order applicant has given the patentee a notice in the approved form seeking from the patentee an authorisation to work the patented pharmaceutical invention for public non-commercial use; and

(ii) during the 30 days beginning when the notice was given, the PPI order applicant has tried, without success, to obtain such an authorisation from the patentee on reasonable terms and conditions;

(f) the notification requirements prescribed by the regulations in relation to the importation of the pharmaceutical product have been complied with;

(g) the PPI order applicant, the eligible importing country and, if there is a third party importer, that importer, will take reasonable measures to prevent a pharmaceutical product that is exported from Australia in accordance with a PPI compulsory licence from being used for a purpose other than the purpose of addressing the public health problem mentioned in paragraph (c).

(2) Without limiting the matters that the court may take into account in deciding whether it is satisfied of a matter mentioned in subsection (1), the court must take into account any matters prescribed by the regulations.

**136E Terms of PPI compulsory licence**

(1) A PPI order must direct that the PPI compulsory licence is granted on the following terms:
(a) no more than the quantity of the pharmaceutical product that
is determined by the Federal Court to be necessary to meet
the needs of the eligible importing country is manufactured;
(b) the entirety of the pharmaceutical product manufactured for
that purpose is exported to that country;
(c) the pharmaceutical product is labelled and marked in
accordance with the regulations;
(d) before shipment of the pharmaceutical product begins, the
shipment information prescribed by the regulations is made
available on a website by, or on behalf of, the licensee for a
minimum period prescribed by the regulations;
(e) the duration of the licence is only for the period of time
determined by the Federal Court to be necessary to address
the public health problem concerned;
(f) the licence does not give the licensee, or a person authorised
by the licensee, the exclusive right to work the patented
pharmaceutical invention;
(g) the licence is to be assignable only in connection with an
enterprise or goodwill in connection with which the licence is
used;
(h) the licensee must give the Commissioner the information
prescribed by the regulations in relation to the licence in
accordance with the regulations.

(2) The PPI order may also direct that the licence is to be granted on
any other terms specified in the order, including terms covering:
(a) other requirements relating to the labelling and marking of
the pharmaceutical product; and
(b) other information to be made available by the licensee and
the way in which it is to be made available.

(3) However, a term specified must not be inconsistent with any
regulations prescribed for the purposes of paragraph (1)(c), (d) or
(h).

136F Order for ancillary compulsory licence and cross-licence

Scope

(1) This section applies if:
(a) a PPI order applicant applies for a PPI order in relation to a patented pharmaceutical invention; and
(b) that invention cannot be worked by the applicant without the applicant infringing another patent.

**PPI order**

(2) The Federal Court may make the PPI order only if the court is satisfied that the patented pharmaceutical invention involves an important technical advance of considerable economic significance on the invention (the *other invention*) to which the other patent relates.

(3) If the Federal Court makes the PPI order sought, the court must:
   (a) make a further order that:
      (i) the patentee of the other invention must grant to the PPI order applicant a licence (a *PPI ancillary licence*) to work the other invention to the extent necessary to work the patented pharmaceutical invention; and
      (ii) the patentee of the patented pharmaceutical invention must grant the patentee of the other invention a cross-licence (a *PPI cross-licence*) on reasonable terms and conditions to work the patented pharmaceutical invention, if the patentee of the other invention so requires; and
   (b) direct that the PPI order applicant may assign the PPI ancillary licence:
      (i) only if the PPI compulsory licence is assigned; and
      (ii) only to the assignee of that licence.

**Parties**

(4) In addition to the parties mentioned in subsection 136C(4) (application for order to grant PPI compulsory licence), the following are also parties to any proceedings under that section:
   (a) the patentee of the other invention;
   (b) any person claiming an interest in the other invention as exclusive licensee or otherwise.
Division 3—Patented pharmaceutical invention
compulsory licences (amendment)

136G PPI compulsory licence—amendment

Application for order

(1) A person may apply to the Federal Court for an order to amend any of the following terms of a PPI compulsory licence:
   (a) the quantity of the pharmaceutical product concerned;
   (b) how the pharmaceutical product is labelled and marked;
   (c) the duration of the licence;
   (d) the information that is to be made available by the licensee and the way it is to be made available.

Note: For remuneration in respect of the licence as amended, see section 136P.

Order

(2) The court may grant the order in relation to a term if it is satisfied that:
   (a) it is just to do so in all the circumstances; and
   (b) the legitimate interests of the following are not likely to be adversely affected by the amendment of the term:
       (i) the patentee;
       (ii) any person claiming an interest in the patent as exclusive licensee or otherwise;
       (iii) the licensee;
       (iv) the eligible importing country.

(3) However, an amended term must not be inconsistent with any regulations prescribed for the purposes of paragraph 136E(1)(c), (d) or (h).

Parties

(4) The following are parties to any proceedings under this section:
   (a) the applicant under subsection (1);
   (b) the patentee;
Schedule 2  TRIPS Protocol interim waiver

Part 1 Amendments

(c) any person claiming an interest in the patent as exclusive licensee or otherwise;
(d) the licensee;
(e) at the option of the eligible importing country—that country.

136H  PPI ancillary licence—amendment

Scope

(1) This section applies if:
(a) a PPI compulsory licence is granted in relation to a patented pharmaceutical invention; and
(b) a PPI ancillary licence is granted to work another invention (the ancillary invention) insofar as it is necessary to work the patented invention.

Application for order

(2) A person may apply to the Federal Court for an order to amend the PPI ancillary licence.

Order

(3) The court may grant the order if it is satisfied that:
(a) the PPI ancillary licence as amended by the order would allow the patented pharmaceutical invention to be worked under the terms of the PPI compulsory licence (including such a licence as amended under section 136G); and
(b) it is just to do so in all the circumstances; and
(c) the legitimate interests of the following are not likely to be adversely affected by the amendment:
   (i) the patentee of the ancillary invention;
   (ii) the patentee of the patented pharmaceutical invention;
   (iii) any person claiming an interest, as exclusive licensee or otherwise, in the patent for either invention;
   (iv) the licensee for the PPI compulsory licence;
   (v) the eligible importing country concerned.

Parties

(4) The following are parties to any proceedings under this section:
(a) the applicant under subsection (2);
(b) the licensee for the PPI compulsory licence;
(c) the patentee of the patented pharmaceutical invention;
(d) the patentee of the ancillary invention;
(e) any person claiming an interest, as exclusive licensee or otherwise, in the patent for either invention;
(f) at the option of the eligible importing country concerned—that country.

136J PPI cross-licence—amendment

Scope

(1) This section applies if:
(a) a PPI compulsory licence is granted in relation to a patented pharmaceutical invention; and
(b) a PPI ancillary licence is granted to work another invention (the ancillary invention) insofar as it is necessary to work the patented invention; and
(c) a PPI cross-licence is granted to work the patented pharmaceutical invention.

Application for order

(2) A person may apply to the Federal Court for an order to amend the PPI cross-licence.

Order

(3) The court may grant the order to amend the PPI cross-licence if it is satisfied that:
(a) it is just to do so in all the circumstances; and
(b) the legitimate interests of the following are not likely to be adversely affected by the amendment:
   (i) the patentee of the patented pharmaceutical invention;
   (ii) the patentee of the ancillary invention;
   (iii) any person claiming an interest, as exclusive licensee or otherwise, in the patent for either invention.


Part 1 Amendments

Parties

(4) The following are parties to any proceedings under this section:

(a) the applicant under subsection (2);
(b) the licensee for the PPI compulsory licence;
(c) the patentee of the patented pharmaceutical invention;
(d) the patentee of the ancillary invention;
(e) any person claiming an interest, as exclusive licensee or otherwise, in the patent for either invention.

Proceedings for PPI licence amendments may be heard together

Nothing in sections 136G, 136H and 136J prevents the Federal Court from dealing with applications for amendments of terms of PPI compulsory licences, PPI ancillary licences and PPI cross-licences together.

Division 4—Patented pharmaceutical invention compulsory licences (revocation)

PPI compulsory licence or PPI ancillary licence—revocation

Application

(1) A person may apply to the Federal Court to revoke a PPI compulsory licence or a PPI ancillary licence.

Note: For remuneration in respect of the use of a PPI compulsory licence while it is in force, see section 136P.

Federal Court may revoke licence

(2) The Federal Court may revoke the licence if the court is satisfied that:

(a) one or more of the following applies:
   (i) the substantive circumstances that justified the grant of the licence have ceased to exist and are unlikely to recur;
   (ii) the licensee has not complied with the terms of the licence;


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(iii) if an amount has been agreed or determined under section 136P—the amount has not been paid within the time agreed or determined; and
(b) the legitimate interests of the licensee or the eligible importing country are not likely to be adversely affected by the revocation.

Parties

(3) The following are parties to any proceedings under this section:
(a) the applicant for revocation;
(b) the licensee;
(c) at the option of the eligible importing country—that country.

136M  PPI cross-licence—revocation

Application

(1) A person may apply to the Federal Court to revoke a PPI cross-licence.

Federal Court may revoke licence

(2) The Federal Court may revoke the PPI cross-licence if the court is satisfied that:
(a) it is just to do so in all the circumstances; and
(b) the legitimate interests of the following are not likely to be adversely affected by the revocation:
   (i) the patentee of the patented pharmaceutical invention concerned;
   (ii) the patentee of the ancillary invention concerned;
   (iii) any person claiming an interest, as exclusive licensee or otherwise, in the patent for either invention.

Parties

(3) The following are parties to any proceedings under this section:
(a) the applicant for revocation;
(b) the patentee of the patented pharmaceutical invention concerned;
(c) the patentee of the ancillary invention concerned;
(d) any person claiming an interest, as exclusive licensee or otherwise, in the patent for either invention.

136N Proceedings for PPI licence revocation may be heard together

Nothing in section 136L or 136M prevents the Federal Court from dealing with applications for revocations of PPI compulsory licences, PPI ancillary licences and PPI cross-licences together.

Division 5—Patented pharmaceutical invention compulsory licences (remuneration)

136P Remuneration for PPI compulsory licence

Working out amount of remuneration

(1) The patentee is to be paid an amount agreed or determined under subsection (3) in respect of the use authorised by a PPI compulsory licence.

(2) For the purposes of subsection (1), the use authorised by the PPI compulsory licence is:
   (a) while it is in force—the use authorised by the licence as granted and as amended (from time to time) under section 136G; or
   (b) if it has ceased to be in force (whether because it was revoked or otherwise)—the actual use of the patented pharmaceutical invention under the licence while it was in force.

(3) For the purposes of subsection (1), the amount is:
   (a) an amount agreed between the patentee and the PPI order applicant, licensee or former licensee (as the case requires); or
   (b) if paragraph (a) does not apply—an amount determined by the Federal Court to be adequate remuneration taking into account the economic value to the eligible importing country of the use authorised by the PPI compulsory licence.

Application to make or amend a determination

(4) A person may apply to the Federal Court:
(a) to make a determination under paragraph (3)(b); or
(b) to amend a determination made under that paragraph.

Note: Grounds for an application under paragraph (b) may include the fact that the terms of the PPI compulsory licence have been amended, or the licence has been revoked.

Parties

(5) The following are parties to any proceedings under this section:

(a) the applicant for the determination or the amendment of the determination;
(b) the PPI order applicant;
(c) the licensee;
(d) the patentee of the patented pharmaceutical invention;
(e) any person claiming an interest in the patent as exclusive licensee or otherwise.

Exploitation of licence: remuneration

(6) To avoid doubt, if the proposed use of the pharmaceutical product is to address a public health problem in the eligible importing country in circumstances of national emergency or other circumstances of extreme urgency, the licensee may exploit a PPI compulsory licence, as granted or amended (as the case may be), whether or not an amount has been agreed or determined under this section.

(7) However, if the proposed use of the pharmaceutical product is to address a public health problem in the eligible importing country in other circumstances, by the public non-commercial use of the pharmaceutical product, the licensee must not exploit a PPI compulsory licence unless an amount has been agreed or determined under this section.

Exploitation of licence: revocation

(8) To avoid doubt, a PPI compulsory licence may be revoked whether or not an amount has been agreed or determined under this section.
Division 6—Patented pharmaceutical invention
    compulsory licences (general)

136Q Nature of order

Without prejudice to any other method of enforcement, an order under this Part operates as if it were embodied in a deed granting or amending a licence and executed by the patentee and all other necessary parties.

136R Orders to be consistent with international agreements

An order must not be made under this Part that is inconsistent with a treaty between the Commonwealth and a foreign country.

Part 3—Revocation of patents

20 Subsection 137(5)

Omit “compulsory licence”, substitute “licence granted under an order under Part 1”.

21 After section 138

Insert:

Part 4—Other matters

22 After subsection 139(1)

Insert:

Note: See Part 2 for details of parties to proceedings under that Part.

23 Subsection 139(2)

Omit “or 138”, substitute “, Part 2 or section 138”.

24 At the end of subsection 228(1)

Add:

; and (f) for the purpose of carrying out or giving effect to the WTO General Council decision of 30 August 2003.
25 Schedule 1 (definition of compulsory licence)

    Repeal the definition.

26 Schedule 1

    Insert:

    eligible importing country means:
    (a) a foreign country (whether or not a member of the World
        Trade Organization) recognised by the United Nations as a
        least-developed country; or
    (b) a foreign country that has made a notification to the Council
        for TRIPS of its intention to use, as an importer, the system
        set out in the WTO General Council decision of 30 August
        2003; or
    (c) a foreign country (whether or not a member of the World
        Trade Organization) included in a class of foreign countries
        prescribed for the purposes of this paragraph.

27 Schedule 1

    Insert:

    patented pharmaceutical invention, in relation to a pharmaceutical
    product, means:
    (a) if the product is a patented product—the patented product; or
    (b) if the product results from the use of a patented process—the
        patented process.

28 Schedule 1

    Insert:

    pharmaceutical product means any patented product, or product
    manufactured through a patented process, of the pharmaceutical
    sector.

    Example: Examples of a pharmaceutical product include:
    (a) active ingredients necessary for manufacturing the
        pharmaceutical product; and
    (b) diagnostic kits needed for using the pharmaceutical product.

29 Schedule 1

    Insert:
Schedule 2  TRIPS Protocol interim waiver

Part 1  Amendments

PPI is short for patented pharmaceutical invention.

30 Schedule 1
Insert:

PPI ancillary licence has the meaning given by section 136F.

31 Schedule 1
Insert:

PPI compulsory licence has the meaning given by section 136C.

32 Schedule 1
Insert:

PPI cross-licence has the meaning given by section 136F.

33 Schedule 1
Insert:

PPI order has the meaning given by section 136C.

34 Schedule 1
Insert:

PPI order applicant has the meaning given by section 136C.

35 Schedule 1
Insert:

WTO General Council decision of 30 August 2003 means the decision of the World Trade Organization General Council of 30 August 2003 (including the Annex to the decision) on the implementation of paragraph 6 of the Doha Declaration on the TRIPS Agreement and public health.

Note: In 2013, the text of the decision was accessible through the World Trade Organization website (www.wto.org).
Part 2—Application

36 Application of amendments

(1) The amendments of the *Patents Act 1990* made by this Schedule apply in relation to patents granted before, on and after the commencement of this Schedule.

(2) The amendments of sections 70 and 71 of the *Patents Act 1990* made by this Schedule apply in relation to an application that is made on or after the commencement of this Schedule to include a pharmaceutical substance in the Australian Register of Therapeutic Goods.
Schedule 3—TRIPS Protocol: later commencing amendments

Patents Act 1990

1 Section 3 (list of definitions)
   Insert “TRIPS Agreement”.

2 Section 3 (list of definitions)
   Omit “WTO General Council decision of 30 August 2003”.

3 Paragraph 228(1)(f)
   Omit “WTO General Council decision of 30 August 2003”, substitute “TRIPS Agreement”.

4 Schedule 1 (paragraph (b) of the definition of eligible importing country)
   Repeal the paragraph, substitute:
   (b) a foreign country that has made a notification to the Council for TRIPS of its intention to use, as an importer, the system as set out in Article 31bis of the TRIPS Agreement, the Annex to the TRIPS Agreement and the Appendix to that Annex; or

5 Schedule 1
   Insert:

   TRIPS Agreement means the Agreement on Trade-Related Aspects of Intellectual Property Rights set out in Annex 1C to the Marrakesh Agreement establishing the World Trade Organization, done at Marrakesh on 15 April 1994, as Annex 1C is in force for Australia from time to time.

Note: The text of the WTO Agreement is set out in Australian Treaty Series 1995 No. 8 ([1995] ATS 8). In 2013, the text of an Agreement in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website (www.austlii.edu.au).
6 Schedule 1 (definition of WTO General Council decision of 30 August 2003)

Repeal the definition.

**Plant Breeder’s Rights Act 1994**

1 **Subsection 3(1) (definition of Court)**
   
   Repeal the definition.

2 **Subsection 3(1)**
   
   Insert:

   
   **Federal Circuit Court** means the Federal Circuit Court of Australia.

3 **Subsection 3(1)**
   
   Insert:

   
   **Federal Court** means the Federal Court of Australia.

4 **Subsection 39(5)**
   
   Repeal the subsection, substitute:

   
   (5) Nothing in this section affects the power of:

   a) the Federal Court, or a Judge of that Court, under subsection 44A(2) of the AAT Act; or

   b) the Federal Circuit Court, or a Judge of that Court, under subsection 44A(2A) of that Act;

   where an appeal is begun in that court from a decision of the AAT.

5 **Subsection 50(7)**
   
   Repeal the subsection, substitute:

   
   (7) Nothing in this section affects the power of:

   a) the Federal Court, or a Judge of that Court, under subsection 44A(2) of the AAT Act; or

   b) the Federal Circuit Court, or a Judge of that Court, under subsection 44A(2A) of that Act.
6 Subsection 54(1)
Omit “Court”, substitute “Federal Court or the Federal Circuit Court”.

7 Subsections 54(3) and (4)
Omit “Court” (wherever occurring), substitute “court”.

8 Subsection 55(1)
Omit “Court”, substitute “Federal Court or the Federal Circuit Court”.

9 Subsections 55(3) and (4)
Omit “Court”, substitute “court”.

10 Section 56 (heading)
Repeal the heading, substitute:

56 Jurisdiction of the Federal Court

11 Subsection 56(1)
Omit “Court” (wherever occurring), substitute “Federal Court”.

12 After subsection 56(1)
Insert:

Note: A matter may also be transferred to the Federal Court from the Federal Circuit Court: see section 39 of the Federal Circuit Court of Australia Act 1999.

13 Subsection 56(2)
Repeal the subsection, substitute:

(2) That jurisdiction is exclusive of the jurisdiction of all other courts other than the jurisdiction of:
(a) the Federal Circuit Court under subsection 56A(2); and
(b) the High Court under section 75 of the Constitution.

14 Subsection 56(3)
Omit “Court” (wherever occurring), substitute “Federal Court”.

15 Subsection 56(4)
Omit “Court”, substitute “Federal Court”.

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Intellectual Property Laws Amendment Bill 2013  No. , 2013  33
16 Subsection 56(5)

Omit “the Court”, substitute “the Federal Court”.

17 Subsection 56(5)

Omit “rules”, substitute “Rules”.

Note: This item fixes a typographical error.

18 After section 56

Insert:

56A Jurisdiction of Federal Circuit Court

(1) The Federal Circuit Court has jurisdiction with respect to matters in which actions may, under this Part, be begun in the Federal Circuit Court.

Note: A matter may also be transferred to the Federal Circuit Court from the Federal Court: see section 32AB of the Federal Court of Australia Act 1976.

(2) That jurisdiction is exclusive of the jurisdiction of all other courts, other than the jurisdiction of:

(a) the Federal Court under subsection 56(2); and

(b) the High Court under section 75 of the Constitution.

(3) The relief that the Federal Circuit Court may grant in an action or proceeding for infringement of PBR includes an injunction (subject to such terms, if any, as the Federal Circuit Court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

(4) The regulations may make provision in relation to the practice and procedure of the Federal Circuit Court in actions under this Act, including provision prescribing the time within which any action may be begun, or any other act or thing may be done, and providing for the extension of any such time.

(5) Subsection (4) does not limit the power of the Judges of the Federal Circuit Court, or a majority of them, to make Rules of Court under section 81 of the Federal Circuit Court of Australia Act 1999 that are consistent with the regulations referred to in that subsection.
19 Subsection 57(1)
Omit “The Court”, substitute “A court”.

20 Subsection 57(1)
Omit “the Court”, substitute “the court”.

21 Section 72
Omit “the High Court Rules and the Federal Court Rules”, substitute “Rules of Court of the High Court, the Federal Court or the Federal Circuit Court”.
Schedule 5—Australia New Zealand Single Economic Market

Part 1—Amendments

Designs Act 2003

1 Section 145

Before “Where”, insert “(1)”.

2 Section 145

After “Australia”, insert “or New Zealand”.

3 Section 145

Omit “post”, substitute “a prescribed means”.

4 At the end of section 145

Add:

(2) After the time specified in the regulations, a reference in this section to an address includes a reference to an electronic address.

(3) The time specified under subsection (2) must be later than the day on which the regulations are registered under the Legislative Instruments Act 2003.

(4) For the purposes of this section, the question of whether an electronic address is in Australia is to be determined in accordance with the regulations.

(5) For the purposes of this section, the question of whether an electronic address is in New Zealand is to be determined in accordance with the regulations.

Patents Act 1990

5 Section 3 (list of definitions)

Insert “Board”.

6 Section 3 (list of definitions)
   Insert “Director-General of IP Australia”.

7 Section 3 (list of definitions)
   Insert “New Zealand Assistant Commissioner of Patents”.

8 Section 3 (list of definitions)
   Insert “New Zealand Commissioner of Patents”.

9 Section 3 (list of definitions)
   Insert “New Zealand delegate”.

10 Section 3 (list of definitions)
    Insert “New Zealand Patents Minister”.

11 Section 3 (list of definitions)
    Insert “New Zealand patents official”.

12 Section 3 (list of definitions)
    Omit “Professional Standards Board”.

13 Section 3 (list of definitions)
    Insert “Registrar of Companies of New Zealand”.

14 Subsection 20(2)
    Omit “or an employee,”, substitute “an employee, or a New Zealand
delegate,”.

15 At the end of section 20
    Add:
        (3) For the purposes of this section, it is immaterial whether an act was
done in New Zealand.

16 At the end of section 183
    Add:
(3) The Designated Manager may disclose to the Registrar of Companies of New Zealand information (including personal information within the meaning of the Privacy Act 1988) that is:
   (a) relevant to the functions conferred on the Registrar of Companies of New Zealand by or under the Companies Act 1993 of New Zealand; and
   (b) obtained by the Designated Manager as a result of the performance of functions and duties, or the exercise of powers, in relation to incorporated patent attorneys.

(4) For the purposes of subsection (3), it is immaterial whether the disclosure takes place in New Zealand.

(5) The Commissioner may disclose to a New Zealand delegate information (including personal information within the meaning of the Privacy Act 1988) that is relevant to the exercise of the powers, or the performance of the functions, delegated to the New Zealand delegate under subsection 209(1A).

(6) For the purposes of subsection (5), it is immaterial whether the disclosure takes place in New Zealand.

17 Section 185

Repeal the section.

18 Paragraph 198(4)(a)

Repeal the paragraph.

19 Subsection 198(5)

Omit “Professional Standards Board”, substitute “Board”.

20 Subsections 198(7) and (8)

Repeal the subsections, substitute:

(7) A reference in this section to conviction of an offence includes a reference to:
   (a) the making of an order under section 19B of the Crimes Act 1914 in relation to the offence; or
   (b) the making of an order under a corresponding provision of a law of:
       (i) a State; or
21 At the end of section 198

Add:

New Zealand

(12) It is immaterial whether a matter mentioned in:

(a) paragraph (4)(b), (c), (d), (e), (f) or (g); or
(b) subsection (5); or
(c) paragraph (9)(a), (b) or (c); or
(d) paragraph (11)(b);

concerns something that happened in New Zealand.

22 Section 199
Before “The name”, insert “(1)”.

23 At the end of section 199

Add:

(2) It is immaterial whether the prescribed grounds concern something

that happened in New Zealand.

24 Before subsection 209(1)

Insert:

Delegation to employees

25 After subsection 209(1)

Insert:

Delegation to New Zealand patents officials

(1A) The Commissioner may, by instrument, signed by him or her,
delegate all or any of the Commissioner’s powers or functions
under this Act to a New Zealand patents official.

(1B) A function or power delegated under subsection (1A) may be
performed or exercised by the delegate in New Zealand.
26 Before subsection 209(2)

Insert:

Direction or supervision

27 Section 214

Before “A document”, insert “(1)”.

28 At the end of section 214

Add:

(2) For the purposes of this Act, a prescribed document is taken to have been filed with the Patent Office if the document is delivered or given to:

(a) the New Zealand Commissioner of Patents; or
(b) a New Zealand Assistant Commissioner of Patents; or
(c) a person who, under a law of New Zealand, is a delegate of the New Zealand Commissioner of Patents;

in a prescribed manner.

(3) The regulations may provide that a document filed with the Patent Office because of subsection (2) is taken to have been so filed at the time ascertained in accordance with the regulations.

29 Section 221

Before “Where”, insert “(1)”.

30 Section 221

After “Australia”, insert “or New Zealand”.

31 Section 221

Omit “post”, substitute “a prescribed means”.

32 At the end of section 221

Add:

(2) After the time specified in the regulations, a reference in this section to an address includes a reference to an electronic address.
(3) The time specified under subsection (2) must be later than the day on which the regulations are registered under the Legislative Instruments Act 2003.

(4) For the purposes of this section, the question of whether an electronic address is in Australia is to be determined in accordance with the regulations.

(5) For the purposes of this section, the question of whether an electronic address is in New Zealand is to be determined in accordance with the regulations.

33 After paragraph 223(1)(b)

Insert:

(ba) a New Zealand delegate; or

34 After subsection 223(1)

Insert:

(1A) For the purposes of subsection (1), it is immaterial whether a relevant act took place, or is to take place, in New Zealand.

(1B) For the purposes of subsection (1), it is immaterial whether an error or omission took place in New Zealand.

35 After subsection 224(3)

Insert:

(3A) For the purposes of this section, it is immaterial whether a decision was made in New Zealand.

36 Section 227 (heading)

Repeal the heading, substitute:

227 Fees payable under this Act

37 At the end of section 227

Add:

(6) For the purposes of this Act, if:

(a) a fee is declared by the regulations to be a fee to which this subsection applies; and
(b) the fee is paid to:
   (i) the New Zealand Commissioner of Patents; or
   (ii) a New Zealand Assistant Commissioner of Patents; or
   (iii) a person who, under a law of New Zealand, is a delegate
        of the New Zealand Commissioner of Patents; and
   (c) the New Zealand Commissioner of Patents, the New Zealand
        Assistant Commissioner of Patents, or the delegate, as the
        case may be, is authorised to receive the fee on behalf of the
        Commonwealth; and
   (d) the fee is paid in New Zealand currency;
then:
   (e) the liability to pay the fee is discharged; and
   (f) this Act has effect as if the fee had been paid in accordance
        with the regulations.

(7) For the purposes of subsection (6), the amount of the fee in New
Zealand currency is to be ascertained in accordance with the
regulations.

38 After section 227

   Insert:

227AA Receipt of fees payable under New Zealand law

   The regulations may make provision for and in relation to
   authorising:
   (a) the Commissioner; or
   (b) a Deputy Commissioner; or
   (c) an employee;
   to receive, on behalf of New Zealand, a specified fee payable under
   a specified law of New Zealand that relates to patents for
   inventions, so long as:
   (d) the fee is paid in Australian currency; and
   (e) the amount of the fee in Australian currency is ascertained in
       accordance with the regulations.
227AB Application of administrative law regime to decisions made in New Zealand

Judicial review

(1) For the purposes of the application of the Administrative Decisions (Judicial Review) Act 1977 to a decision under this Act, it is immaterial whether the decision was made in New Zealand.

Note: See also the Trans-Tasman Proceedings Act 2010.

(2) For the purposes of subsection (1), decision has the same meaning as in the Administrative Decisions (Judicial Review) Act 1977.

Merits review

(3) For the purposes of the application of the Administrative Appeals Tribunal Act 1975 to a decision under this Act, it is immaterial whether the decision was made in New Zealand.

Note: See also the Trans-Tasman Proceedings Act 2010.

(4) For the purposes of subsection (3), decision has the same meaning as in the Administrative Appeals Tribunal Act 1975.

39 Section 227A (heading)

Repeal the heading, substitute:

227A Trans-Tasman IP Attorneys Board

40 Subsection 227A(1)

Repeal the subsection, substitute:

(1) The body known immediately before the commencement of this subsection as the Professional Standards Board for Patent and Trade Marks Attorneys is continued in existence as the Trans-Tasman IP Attorneys Board.

Note 1: In this Act, Board means the Trans-Tasman IP Attorneys Board—see Schedule 1.

Note 2: See also section 25B of the Acts Interpretation Act 1901.
41 Subsection 227A(2)

Omit “Professional Standards Board” (wherever occurring), substitute “Board”.

42 After subsection 227A(2)

Insert:

**Membership of the Board**

(2A) The Board consists of the following members:

(a) a Chair;
(b) the Director-General of IP Australia;
(c) the New Zealand Commissioner of Patents;
(d) at least 2 members nominated by the New Zealand Patents Minister to represent the New Zealand patent attorney profession;
(e) at least 2 other members.

(2B) The total number of members of the Board must not exceed 10.

**Appointment of members of the Board**

(2C) Each member of the Board mentioned in paragraph (2A)(a), (d) or (e) is to be appointed by the Minister by written instrument.

Note: For reappointment, see the Acts Interpretation Act 1901.

(2D) A person is not eligible for appointment as a member of the Board mentioned in paragraph (2A)(a), (d) or (e) unless the Minister is satisfied that the person has:

(a) substantial experience or knowledge; and
(b) significant standing;
in at least one of the following fields:
(c) Australian patent attorney practice;
(d) New Zealand patent attorney practice;
(e) Australian trade mark attorney practice;
(f) the regulation of persons engaged in a prescribed occupation;
(g) public administration;
(h) academia.

(2E) A member of the Board holds office on a part-time basis.
Period of appointment for members of the Board

(2F) A member of the Board mentioned in paragraph (2A)(a), (d) or (e) holds office for the period specified in the instrument of appointment. The period must not exceed:

(a) in the case of the member mentioned in paragraph (2A)(a)—3 years; or

(b) otherwise—5 years.

Note: For reappointment, see the Acts Interpretation Act 1901.

Appointment of deputy of Director-General of IP Australia

(2G) The Director-General of IP Australia may appoint an APS employee to be his or her deputy for the purpose of attendance at one or more specified meetings of the Board.

(2H) If:

(a) a person is the deputy of the Director-General of IP Australia for the purpose of attendance at a particular meeting of the Board; and

(b) the Director-General of IP Australia is absent from the meeting;

the person is entitled to attend the meeting and, when so attending, is taken to be a member of the Board.

(2J) A deputy of the Director-General of IP Australia is not entitled to any remuneration or allowances for attending a meeting of the Board (other than remuneration or allowances payable to the deputy in his or her capacity as an APS employee).

Appointment of deputy of New Zealand Commissioner of Patents

(2K) The New Zealand Commissioner of Patents may appoint a New Zealand patents official to be his or her deputy for the purpose of attendance at one or more specified meetings of the Board.

(2L) If:

(a) a person is the deputy of the New Zealand Commissioner of Patents for the purpose of attendance at a particular meeting of the Board; and

(b) the New Zealand Commissioner of Patents is absent from the meeting;
the person is entitled to attend the meeting and, when so attending, is taken to be a member of the Board.

(2M) A deputy of the New Zealand Commissioner of Patents is not entitled to any remuneration or allowances for attending a meeting of the Board (other than remuneration or allowances payable to the deputy in his or her capacity as a New Zealand patents official).

### Paragraph 227A(3)(a)

Repeal the paragraph, substitute:

(a) the terms and conditions on which members of the Board mentioned in paragraph (2A)(a), (d) or (e) hold office; and

(aa) the manner in which members of the Board mentioned in paragraph (2A)(a), (d) or (e) may resign their appointments; and

(ab) the termination of the appointment of members of the Board mentioned in paragraph (2A)(a), (d) or (e); and

### Paragraphs 227A(3)(b) and (c)

Omit “Professional Standards Board”, substitute “Board”.

### Subsections 227A(4) and (5)

Omit “Professional Standards Board”, substitute “Board”.

### At the end of section 227A

Add:

(7) The Board may perform its functions in Australia or New Zealand.

### Subparagraph 228(2)(r)(ia)

Omit “Professional Standards Board”, substitute “Board”.

### After subsection 228(4)

Insert:

(4A) If the regulations confer a function on a person or body, the regulations may provide that the function may be performed in Australia or New Zealand.
(4B) If the regulations confer a power on a person or body, the regulations may provide that the power may be exercised in Australia or New Zealand.

(4C) If the regulations provide that application may be made to the Administrative Appeals Tribunal for review of a decision, the regulations may provide that it is immaterial whether the decision was made in New Zealand.

(4D) The regulations may provide that it is immaterial whether an act or omission mentioned in the regulations took place in New Zealand.

(4E) The regulations may provide that it is immaterial whether a matter mentioned in the regulations concerns something that took place in New Zealand.

49 Schedule 1

Insert:

Board means the Trans-Tasman IP Attorneys Board continued in existence by section 227A.

50 Schedule 1 (definition of company)

Repeal the definition, substitute:

company means:

(a) a company registered under the Corporations Act 2001; or
(b) a company registered under the Companies Act 1993 of New Zealand.

51 Schedule 1

Insert:

Director-General of IP Australia means the SES employee who holds or performs the duties of the position of Director-General of IP Australia.

52 Schedule 1 (at the end of the definition of file)

Add:

Note: See also section 214.
53 Schedule 1

Insert:

*New Zealand Assistant Commissioner of Patents* means a person who holds or performs the duties of an office or position of Assistant Commissioner of Patents under or in accordance with a law of New Zealand.

54 Schedule 1

Insert:

*New Zealand Commissioner of Patents* means the person who holds or performs the duties of the office or position of Commissioner of Patents under or in accordance with a law of New Zealand.

55 Schedule 1

Insert:

*New Zealand delegate* means a New Zealand patents official who is a delegate under subsection 209(1A).

56 Schedule 1

Insert:

*New Zealand Patents Minister* means the Minister of New Zealand who:

(a) under the authority of a warrant; or

(b) with the authority of the Prime Minister of New Zealand; is responsible for the administration of a law of New Zealand relating to the regulation of patent attorneys.

57 Schedule 1

Insert:

*New Zealand patents official* means a person:

(a) who is an employee in any part of the State services of New Zealand; and

(b) whose functions or duties relate to the administration of a law of New Zealand relating to patents for inventions.
58 Schedule 1 (definition of Professional Standards Board)

Repeal the definition.

59 Schedule 1

Insert:

Registrar of Companies of New Zealand means the person who holds or performs the duties of the office or position of Registrar of Companies under or in accordance with the Companies Act 1993 of New Zealand.

Plant Breeder’s Rights Act 1994

60 Subsection 3(1)

Insert:

address has a meaning affected by subsection (2).

61 Subsection 3(2)

Repeal the subsection, substitute:

Electronic address

(2) After the time specified in the regulations, a reference in this Act to an address includes a reference to an electronic address.

(3) The time specified under subsection (2) must be later than the day on which the regulations are registered under the Legislative Instruments Act 2003.

(4) Subsection (2) of this section does not apply to the following references to an address:

(a) a reference in subsection 26(2);
(b) the first reference in subsection 26(3).

(5) For the purposes of this Act, the question of whether an electronic address is in Australia is to be determined in accordance with the regulations.

(6) For the purposes of this Act, the question of whether an electronic address is in New Zealand is to be determined in accordance with the regulations.
62 After subsection 19(5)
Insert:

(5A) An address given under paragraph (5)(c) must be an address in
Australia or New Zealand.

63 Subsection 21(5)
After “Australia”, insert “or New Zealand”.

64 Subsection 26(3)
After “overseas”, insert “in a country other than New Zealand”.

65 Subsection 26(3)
After “Australia” (first occurring), insert “or New Zealand”.

66 Subsection 26(3)
Omit “a postal address in Australia”, substitute “an address in Australia
or New Zealand”.

67 Subsection 31(3)
After “Australia”, insert “or New Zealand”.

68 Section 73
Repeal the section, substitute:

73 Service of documents
If:

(a) this Act provides for a document to be served on, or given or
sent to, a person; and
(b) the person has given the Secretary or the Registrar an address
in Australia or New Zealand for service;
the document may be served on, or given or sent to, the person by a
prescribed means to that address.

Trade Marks Act 1995

69 Readers guide (list of terms defined in section 6)
Insert the following term in its appropriate alphabetical position:
70 **Readers guide (list of terms defined in section 6)**

Omit “Professional Standards Board”.

71 **Subsection 6(1)**

Insert:

> **Board** has the same meaning as in the *[Patents Act 1990]*.

72 **Subsection 6(1) (definition of Professional Standards Board)**

Repeal the definition.

73 **At the end of subsection 215(5)**

Add “or New Zealand”.

74 **Paragraph 215(6)(a)**

Repeal the paragraph, substitute:

(a) if the person has an address for service—the document may be served on, or given or sent to, the person by a prescribed means to that address; or

75 **Paragraph 215(6)(b)**

After “Australia” (first occurring), insert “or New Zealand”.

76 **Paragraph 215(6)(b)**

Omit “post”, substitute “a prescribed means”.

77 **Paragraph 215(6)(b)**

After “Australia” (second occurring), insert “or New Zealand”.

78 **At the end of section 215**

Add:

(8) After the time specified in the regulations, a reference in this section to an *address* includes a reference to an electronic address.
(9) The time specified under subsection (8) must be later than the day
on which the regulations are registered under the *Legislative
Instruments Act 2003*.

(10) For the purposes of this section, the question of whether an
electronic address is in Australia is to be determined in accordance
with the regulations.

(11) For the purposes of this section, the question of whether an
electronic address is in New Zealand is to be determined in
accordance with the regulations.

**79 Subsection 228A(5)**

Omit “the Professional Standards Board”, substitute “the Board”.

**80 Subsection 228A(5) (note)**

Omit “*Professional Standards Board*”, substitute “*Board*”.

**81 Subparagraph 231(2)(ha)(ia)**

Omit “Professional Standards Board”, substitute “Board”.

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52 *Intellectual Property Laws Amendment Bill 2013 No.* 2013
Part 2—Transitional provisions

82 Transitional—registration as a patent attorney

(1) The Designated Manager must:
   (a) register as a patent attorney an individual who, immediately
       before the commencement of this item:
       (i) was registered as a patent attorney under a law of New
           Zealand; and
       (ii) was not a registered patent attorney (within the meaning
           of the Patents Act 1990); and
   (b) do so as soon as practicable after the commencement of this
       item.

(2) The registration is to consist of entering the individual’s name in the
    Register of Patent Attorneys.

(3) For the purposes of the Patents Act 1990, the registration is taken to be
    under that Act.

83 Transitional—qualification for registration as a patent
attorney

(1) A qualification specified in, or ascertained in accordance with,
    regulations made for the purposes of paragraph 198(4)(b) of the Patents
    Act 1990 may consist of passing examinations conducted in New
    Zealand, so long as:
    (a) the examinations are specified in those regulations; and
    (b) at least one of those examinations was passed before the
        commencement of this item; and
    (c) the remaining examinations are passed before the end of the
        4-year period beginning at the commencement of this item.

(2) Regulations authorised by subitem (1) do not apply to examinations
    passed by an individual unless the individual applies for registration as
    a patent attorney under section 198 of the Patents Act 1990 within 6
    months after the completion of the last of those examinations.

(3) Subitem (1) does not limit paragraph 198(4)(b) of the Patents Act 1990.
84 Transitional—conduct of patent attorneys

(1) Grounds prescribed for the purposes of section 199 of the *Patents Act 1990* may relate to conduct that took place in New Zealand before the commencement of this item.

(2) Subitem (1) does not limit section 199 of the *Patents Act 1990*.

85 Transitional—registration as a trade marks attorney

(1) If:

(a) immediately before the commencement of this item, an individual:

(i) was registered as a patent attorney under a law of New Zealand; and

(ii) was not a registered trade marks attorney (within the meaning of the *Trade Marks Act 1995*); and

(b) within 12 months after the commencement of this item, the individual applies to the Designated Manager to be registered as a trade marks attorney; and

(c) the application is in accordance with the regulations; and

(d) the individual satisfies the Designated Manager, in accordance with the regulations, that the individual’s level of competency in trade marks law and practice is sufficient to warrant the individual becoming a registered trade marks attorney; and

(e) the individual has not been convicted of a prescribed offence during the 5-year period ending when the application was made; and

(f) the individual is not under sentence of imprisonment for a prescribed offence;

the Designated Manager must register the individual as a trade marks attorney.

(2) The registration is to consist of entering the individual’s name in the Register of Trade Marks Attorneys.

(3) For the purposes of the *Trade Marks Act 1995*, the registration is taken to be under that Act.

(4) The Governor-General may make regulations for the purposes of this item.
(5) It is immaterial whether a matter mentioned in paragraph (1)(d), (e) or (f) concerns something that happened in New Zealand.

(6) A reference in this item to conviction of an offence includes a reference to:

(a) the making of an order under section 19B of the Crimes Act 1914 in relation to the offence; or

(b) the making of an order under a corresponding provision of a law of:

(i) a State; or

(ii) a Territory; or

(iii) New Zealand;

in relation to the offence.
Schedule 6—Other amendments

Part 1—Document retention

Division 1—Amendments

*Designs Act 2003*

1 Paragraph 69(3)(b)

Omit “design; and”, substitute “design.”.

2 Paragraph 69(3)(c)

Repeal the paragraph.

*Patents Act 1990*

3 Paragraph 228(2)(u)

Repeal the paragraph.

*Trade Marks Act 1995*

4 Paragraph 231(2)(h)

Repeal the paragraph.

Division 2—Application of amendments

5 Application of amendments

The amendments made by this Part apply in relation to material and documents provided or filed before, on or after the commencement of this Part.
Part 2—Technical amendments

Division 1—Amendments

Patents Act 1990

6 Section 24 (heading)

Repeal the heading, substitute:

24 Validity not affected by making information available in certain circumstances

7 Section 29A (note)

Repeal the note, substitute:

(6) An applicant is not entitled to ask that any action be taken, or that he or she be allowed to take any action, under this Act in relation to a PCT application unless the following requirements of subsection (5) have been met (if applicable):

(a) a translation of the application into English has been filed;
(b) the prescribed documents have been filed;
(c) the prescribed fees have been paid.

Note: A failure to comply with subsection (5) may also result in the PCT application lapsing: see paragraph 142(2)(f).

8 Subsection 29B(2)

Omit “within the prescribed period”.

9 Before subsection 40(2)

Insert:

Requirements relating to complete specifications

10 Before subsection 41(1)

Insert:


**Provisional specifications**

(1A) A specification is taken to comply with subsection 40(1), so far as it requires a description of a micro-organism, if:

(a) the micro-organism is deposited with a prescribed depository institution in accordance with such provisions of the Budapest Treaty as are applicable; and

(b) the prescribed circumstances apply.

**Complete specifications**

11 **Paragraph 43(2A)(b)**

After “discloses”, insert “, or a prescribed set of prescribed documents considered together disclose,“.

12 **After subsection 43(2A)**

Insert:

(2B) A prescribed document, or a prescribed set of prescribed documents considered together, is taken to disclose the invention in a claim as mentioned in paragraph (2A)(b) so far as such disclosure requires a description of a micro-organism, if:

(a) the micro-organism is deposited with a prescribed depository institution in accordance with such provisions of the Budapest Treaty as are applicable; and

(b) the prescribed circumstances apply.

13 **At the end of subparagraph 101E(1)(a)(ix)**

Add “and”.

14 **Paragraph 119(3)(b)**

Omit “through any publication or use of the invention”.

15 **Subsection 191A(4)**

Omit “a declaration, or rectify the Register, under this section”, substitute “a declaration under subsection (2), or rectify the Register under subsection (3),“.

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58 **Intellectual Property Laws Amendment Bill 2013** No. , 2013
Division 2—Application of amendments

16 Application of amendments

(1) The amendments made by items 6 and 14 apply in relation to information that is made publicly available at or after the time those items commence.

(2) The amendments made by items 7 and 8 apply in relation to applications made at or after the time those items commence.

(3) The amendment made by item 10 applies in relation to provisional applications made at or after the time that item commences.

(4) The amendments made by items 11 and 12 apply in relation to:
   
   (a) patents for which the complete application is made at or after the time those items commence; and
   
   (b) standard patents for which the application had been made before the time those items commence, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the Patents Act 1990 before that time; and
   
   (c) innovation patents granted at or after the time those items commence, if the complete application to which the patent relates had been made before that time; and
   
   (d) complete patent applications made at or after the time those items commence; and
   
   (e) complete applications for standard patents made before the time those items commence, if the applicant had not asked for an examination of the patent request and specification for the application under section 44 of the Patents Act 1990 before that time; and
   
   (f) complete applications for innovation patents made before the time those items commence, if a patent had not been granted in relation to the application on or before that time; and
   
   (g) innovation patents granted before the time those items commence, if:
      
      (i) the Commissioner had not decided to examine the complete specification relating to the patent under section 101A of the Patents Act 1990 before that time; and
(ii) the patentee or any other person had not asked the Commissioner to examine the complete specification relating to the patent under section 101A of the Patents Act 1990 before that time.

(5) The amendment made by item 15 applies on and after the day that item commences in relation to patents granted before, on or after that commencement.