



# **Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018**

**No. 77, 2018**

**An Act to amend legislation relating to intellectual  
property, and for related purposes**

Note: An electronic version of this Act is available on the Federal Register of Legislation  
(<https://www.legislation.gov.au/>)



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## Contents

1	Short title.....	1
2	Commencement.....	2
3	Schedules.....	3
<b>Schedule 1—Responses to the Productivity Commission</b>		<b>4</b>
Part 1—Parallel importation		4
Division 1—Amendments		4
<i>Copyright Act 1968</i>		4
<i>Trade Marks Act 1995</i>		4
Division 2—Saving and application provisions		6
Part 2—PBR in essentially derived varieties		7
<i>Plant Breeder’s Rights Act 1994</i>		7
Part 3—Period to apply for removal of trade marks from Register for non-use		25
<i>Trade Marks Act 1995</i>		25
Part 4—Notification of extension of standard patents relating to pharmaceutical substances		26
<i>Patents Act 1990</i>		26
<b>Schedule 2—Other measures</b>		<b>27</b>
Part 1—Amending trade mark applications—non-legal persons		27
<i>Trade Marks Act 1995</i>		27
Part 2—Written requirements		28
Division 1—Amendments		28
<i>Designs Act 2003</i>		28
<i>Patents Act 1990</i>		32
<i>Plant Breeder’s Rights Act 1994</i>		33
<i>Trade Marks Act 1995</i>		39
Division 2—Application and saving provisions		41
Part 3—Filing requirements		43

---

Division 1—Amendments	43
<i>Designs Act 2003</i>	43
<i>Patents Act 1990</i>	46
<i>Plant Breeder’s Rights Act 1994</i>	50
<i>Trade Marks Act 1995</i>	52
Division 2—Application, saving and transitional provisions	56
<b>Part 4—Signatures</b>	59
<i>Patents Act 1990</i>	59
<b>Part 5—Computerised decision-making</b>	60
<i>Designs Act 2003</i>	60
<i>Patents Act 1990</i>	61
<i>Plant Breeder’s Rights Act 1994</i>	63
<i>Trade Marks Act 1995</i>	64
<b>Part 6—Addresses and service of documents</b>	67
<i>Plant Breeder’s Rights Act 1994</i>	67
<b>Part 7—Requirements for patent documents</b>	69
<i>Patents Act 1990</i>	69
<b>Part 8—Unjustified threats of infringement</b>	73
Division 1—Amendments	73
<i>Designs Act 2003</i>	73
<i>Olympic Insignia Protection Act 1987</i>	73
<i>Patents Act 1990</i>	74
<i>Plant Breeder’s Rights Act 1994</i>	74
<i>Trade Marks Act 1995</i>	76
Division 2—Application and saving provisions	77
<b>Part 9—Ownership of PBR and entries in the Register</b>	79
<i>Plant Breeder’s Rights Act 1994</i>	79
<b>Part 10—Trade mark oppositions</b>	82
<i>Trade Marks Act 1995</i>	82

---

---

Part 11—Further power to award damages under the Plant Breeder’s Rights Act	83
<i>Plant Breeder’s Rights Act 1994</i>	83
Part 12—Exclusive licensees in the Plant Breeder’s Rights Act	85
<i>Plant Breeder’s Rights Act 1994</i>	85
Part 13—Publishing personal information of registered patent or trade marks attorneys	88
Division 1—Amendments	88
<i>Patents Act 1990</i>	88
<i>Trade Marks Act 1995</i>	89
Division 2—Application provisions	90
Part 14—Secretary’s role in the Plant Breeder’s Rights Act	91
<i>Plant Breeder’s Rights Act 1994</i>	91
Part 15—Seizure notices	97
Division 1—Amendments	97
<i>Copyright Act 1968</i>	97
<i>Olympic Insignia Protection Act 1987</i>	97
<i>Trade Marks Act 1995</i>	98
Division 2—Application provisions	98
Part 16—Prosecutions	100
Division 1—Amendments	100
<i>Patents Act 1990</i>	100
<i>Trade Marks Act 1995</i>	100
Division 2—Application provision	101
Part 17—Updating references to Designs Act	102
<i>Olympic Insignia Protection Act 1987</i>	102
Part 18—Removing certain references to New Zealand	104
<i>Patents Act 1990</i>	104
Part 19—International Convention for the Protection of New Varieties of Plants	106

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<i>Plant Breeder's Rights Act 1994</i>	106
<b>Part 20—Other amendments</b>	109
<i>Patents Act 1990</i>	109
<i>Plant Breeder's Rights Act 1994</i>	109
<b>Part 21—Repeals of Acts</b>	110
<i>Patents Amendment (Patent Cooperation Treaty) Act 1979</i>	110



# Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018

No. 77, 2018

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## **An Act to amend legislation relating to intellectual property, and for related purposes**

*[Assented to 24 August 2018]*

The Parliament of Australia enacts:

### **1 Short title**

This Act is the *Intellectual Property Laws Amendment  
(Productivity Commission Response Part 1 and Other Measures)  
Act 2018*.

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No. 77, 2018

*Intellectual Property Laws Amendment (Productivity Commission  
Response Part 1 and Other Measures) Act 2018*

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## 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.

<b>Commencement information</b>		
<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
<b>Provisions</b>	<b>Commencement</b>	<b>Date/Details</b>
1. Sections 1 to 3 and anything in this Act not elsewhere covered by this table	The day this Act receives the Royal Assent.	24 August 2018
2. Schedule 1, Part 1	The day after this Act receives the Royal Assent.	25 August 2018
3. Schedule 1, Parts 2 and 3	A single day to be fixed by Proclamation. However, if the provisions 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.	24 February 2019
4. Schedule 1, Part 4	The day after this Act receives the Royal Assent.	25 August 2018
5. Schedule 2, Part 1	The day after this Act receives the Royal Assent.	25 August 2018
6. Schedule 2, Parts 2 and 3	At the same time as the provisions covered by table item 3.	24 February 2019
7. Schedule 2, Parts 4 and 5	The day after this Act receives the Royal Assent.	25 August 2018
8. Schedule 2, Parts 6 to 12	At the same time as the provisions covered by table item 3.	24 February 2019
9. Schedule 2, Part 13	The day after this Act receives the Royal Assent.	25 August 2018
10. Schedule 2, Part 14	At the same time as the provisions covered by table item 3.	24 February 2019



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<b>Commencement information</b>		
<b>Column 1</b>	<b>Column 2</b>	<b>Column 3</b>
<b>Provisions</b>	<b>Commencement</b>	<b>Date/Details</b>
11. Schedule 2, Parts 15 to 21	The day after this Act receives the Royal Assent.	25 August 2018

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 Schedules**

Legislation 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—Responses to the Productivity Commission

### Part 1—Parallel importation

#### Division 1—Amendments

##### *Copyright Act 1968*

###### **1 Section 198A**

Repeal the section.

##### *Trade Marks Act 1995*

###### **2 After section 122**

Insert:

###### **122A Exhaustion of a registered trade mark in relation to goods**

- (1) In spite of section 120, a person who uses a registered trade mark in relation to goods does not infringe the trade mark if:
- (a) the goods are similar to goods in respect of which the trade mark is registered; and
  - (b) before the time of use, the person had made reasonable inquiries in relation to the trade mark; and
  - (c) at the time of use, a reasonable person, after making those inquiries, would have concluded that the trade mark had been applied to, or in relation to, the goods by, or with the consent of, a person (a *relevant person*) who was, at the time of the application or consent (as the case may be):
    - (i) the registered owner of the trade mark; or
    - (ii) an authorised user of the trade mark; or
    - (iii) a person permitted to use the trade mark by the registered owner; or
    - (iv) a person permitted to use the trade mark by an authorised user who has power to give such permission under paragraph 26(1)(f); or

- (v) a person with significant influence over the use of the trade mark by the registered owner or an authorised user; or
- (vi) an associated entity (within the meaning of the *Corporations Act 2001*) of a relevant person mentioned in subparagraph (i), (ii), (iii), (iv) or (v).

Note 1: For goods that are *similar*, see subsection 14(1).

Note 2: For subparagraph (c)(iv), an authorised user may, under paragraph 26(1)(f), subject to any agreement the authorised user has with the registered owner, permit another person to apply the trade mark to, or in relation to, goods in respect of which the trade mark is registered.

- (2) A reference in paragraph (1)(c) to consent to the application of a trade mark to, or in relation to, goods includes, without limitation, a reference to:
  - (a) consent subject to a condition (for example, a condition that the goods are to be sold only in a foreign country); and
  - (b) consent that can be reasonably inferred from the conduct of a relevant person.
- (3) In determining whether a relevant person mentioned in subparagraph (1)(c)(iii) or (iv) was permitted to use the trade mark, disregard how that permission arose, for example:
  - (a) whether it arose directly or indirectly; or
  - (b) whether it arose by way of proprietary interest, contract, arrangement, understanding, a combination of those things, or otherwise.
- (4) In determining whether a relevant person mentioned in subparagraph (1)(c)(v) had significant influence over the use of a trade mark, disregard how that influence arose, for example:
  - (a) whether it arose directly or indirectly; or
  - (b) whether it arose by way of proprietary interest, contract, arrangement, understanding, a combination of those things, or otherwise.

### **3 Section 123 (heading)**

Repeal the heading, substitute:

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**123 Services to which registered trade mark has been applied by or  
with consent of registered owner**

**4 Subsection 123(1)**

Repeal the subsection.

**5 Subsection 123(2)**

Omit “(2)”.

**Division 2—Saving and application provisions**

**6 Saving and application provisions**

*Copyright*

- (1) Despite the repeal of section 198A of the *Copyright Act 1968* by this Part, that section continues to apply in relation to proceedings begun under that Act before the commencement of this item.

*Trade marks*

- (2) The amendments of the *Trade Marks Act 1995* made by this Part apply in relation to an action for the infringement of a trade mark begun on or after the commencement of this item, even if the infringement of the trade mark is alleged to have occurred before that commencement.

## **Part 2—PBR in essentially derived varieties**

### ***Plant Breeder's Rights Act 1994***

#### **7 Subsection 3(1)**

Insert:

*commercial-in-confidence* has the meaning given by subsection 41B(4).

*essentially derived*, in relation to a plant variety, has the meaning given by section 4.

#### **8 Subsection 3(1) (at the end of the definition of *grantee*)**

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

#### **9 Subsection 3(1)**

Insert:

*hearing period* has the meaning given by subsection 41C(3).

#### **10 Section 4 (heading)**

Repeal the heading, substitute:

#### **4 Definition of *essentially derived***

#### **11 Section 4**

Omit “taken to be an essentially derived”, substitute “an *essentially derived*”.

#### **12 At the end of section 4**

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

#### **13 Section 12**

Repeal the section, substitute:

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## 12 Extension of PBR to cover essentially derived varieties

Subject to section 23 (exhaustion of PBR), if PBR is granted in a plant variety (the *initial variety*), and a declaration is made that another plant variety is essentially derived from the initial variety, the right granted in the initial variety extends, with effect from the date of declaration, to that other plant variety.

Note: For declarations of essential derivation, see sections 40 and 41D.

## 14 Paragraph 22(5)(b)

Omit “under section 40”.

## 15 At the end of subsection 22(5)

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

## 16 At the end of subsection 23(2)

Add:

Note: For declarations of essential derivation to which this subsection applies, see section 40.

## 17 Subparagraph 34(4)(b)(ii)

After “section 41”, insert “or 41E (both of which deal with test growing of essentially derived varieties)”.

## 18 Section 40 (heading)

Repeal the heading, substitute:

## 40 Essential derivation for PBR-protected varieties—declaration

### 19 Subsections 40(1) and (2)

Repeal the subsections, substitute:

- (1) A person (an *eligible person*) may make an application under subsection (1A) if the person is:
  - (a) the grantee of PBR in a plant variety; or
  - (b) an exclusive licensee of such a grantee.

(1A) An eligible person in relation to a plant variety (the **initial variety**) may apply in writing to the Registrar for a declaration that another variety (the **second variety**) is essentially derived from the initial variety if:

- (a) another person is the grantee of, or has applied for, PBR in the second variety; and
- (b) the eligible person is satisfied that the second variety is essentially derived from the initial variety; and
- (c) the initial variety has not itself been declared (under section 40 or 41D) to be essentially derived from another variety in which PBR has been granted.

Note 1: If the breeder of the second variety has not applied for, or been granted, PBR in the second variety, an eligible person may apply under section 41A for a declaration that the second variety is essentially derived from the initial variety.

Note 2: If an application for PBR in the second variety is made after an application is made under section 41A in relation to that variety, the application under section 41A may be treated as if it were an application under this section (see section 41F).

(1B) The Registrar must notify the application under subsection (1A) to each eligible person in relation to the initial variety other than the applicant.

(1C) If an eligible person in relation to a plant variety (the **initial variety**) applies for a declaration under subsection (1A) in relation to another plant variety (the **second variety**), that does not prevent another eligible person in relation to the initial variety also applying for a declaration under that subsection in relation to the second variety.

(2) Nothing in this section implies that an eligible person in relation to a plant variety (the **initial variety**) may not, in relation to an application by another person for PBR in another plant variety (the **second variety**) that has been accepted but not finally determined:

- (a) make an objection, under section 35, to the granting of PBR in the second variety; and
- (b) in the alternative, if PBR is granted to another person in the second variety—apply under subsection (1A) for a declaration that the second variety is essentially derived from the initial variety.

**20 Subsection 40(6)**

Repeal the subsection, substitute:

- (6) If the initial variety has itself been declared to be essentially derived from another variety, the Registrar must:
- (a) refuse to declare the second variety essentially derived from the initial variety; and
  - (b) notify each eligible person in relation to the initial variety (including the applicant) of the refusal and the reasons for it.

**21 Subsection 40(9)**

Repeal the subsection, substitute:

- (9) If the Registrar is not satisfied of that prima facie case, the Registrar must notify each eligible person in relation to the initial variety (including the applicant) that the Registrar is not so satisfied, and of the reasons for not being so satisfied.

**22 Paragraph 40(10)(e)**

Repeal the paragraph, substitute:

- (e) notify each eligible person in relation to the initial variety (including the applicant) of the declaration; and

**23 Paragraph 40(11)(a)**

Repeal the paragraph, substitute:

- (a) notify each eligible person in relation to the initial variety (including the applicant) that he or she is so satisfied, and of the reasons for being so satisfied; and

**24 Subsection 40(12)**

After “a declaration”, insert “under this section”.

**25 At the end of section 40 (before the note)**

Add:

- Note 1: Section 19 requires the grantee of PBR in a plant variety to take reasonable steps to ensure reasonable public access to the plant variety.



**26 Section 40 (note)**

Omit “Note”, substitute “Note 2”.

**27 Section 41 (heading)**

Repeal the heading, substitute:

**41 Essential derivation for PBR-protected varieties—test growing**

**28 Subsection 41(1)**

Repeal the subsection, substitute:

(1) This section applies if:

- (a) an eligible person applies for a declaration under section 40 in relation to a plant variety (the *initial variety*) that another plant variety (the *second variety*) is essentially derived from the initial variety; and
- (b) in the course of that application the applicant establishes a prima facie case that the second variety is essentially derived from the initial variety.

(1A) On the basis of information supplied by the applicant and the grantee of PBR in the second variety, the Registrar may decide that a test growing or further test growing is required to determine whether the prima facie case has been rebutted.

Note: A decision to require a test growing is reviewable by the AAT under section 77.

(1B) The Registrar must notify the decision to each of the following:

- (a) the applicant;
- (b) the grantee of PBR in the second variety.

**29 Paragraph 41(2)(a)**

Omit “grantee of PBR in the initial variety”, substitute “applicant”.

**30 Subsection 41(5)**

After “further test growing”, insert “under this section”.

**31 At the end of Part 3**

Add:

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**41A Essential derivation for non-PBR-protected second varieties—  
application for declaration**

*Circumstances in which application may be made*

- (1) A person (an **eligible person**) may make an application under subsection (2) if the person is:
  - (a) the grantee of PBR in a plant variety; or
  - (b) an exclusive licensee of such a grantee.
- (2) An eligible person in relation to a plant variety (the **initial variety**) may apply in writing to the Registrar for a declaration under section 41D that another variety (the **second variety**) is essentially derived from the initial variety if:
  - (a) PBR has not been applied for, or granted, in the second variety; and
  - (b) the eligible person is satisfied that the second variety is essentially derived from the initial variety; and
  - (c) the initial variety has not itself been declared (under section 40 or 41D) to be essentially derived from another variety in which PBR has been granted.

*Content of application*

- (3) The application must:
  - (a) be in the approved form; and
  - (b) be accompanied by such fee (if any) as is prescribed by the regulations in respect of the application.
- (4) Without limiting what the approved form may require, the application must contain:
  - (a) such information as is required by the form that is relevant to establishing, on the balance of probabilities, that the second variety is:
    - (i) essentially derived from the initial variety; and
    - (ii) a registrable plant variety within the meaning of section 43; and
  - (b) either:
    - (i) such information as is required by the form that is necessary to enable the Registrar to notify the

application to the person (or persons) the applicant reasonably believes to be the breeder of the second variety; or

- (ii) evidence that the applicant cannot comply with subparagraph (i), despite taking reasonable steps to obtain the information mentioned in that subparagraph.

- (5) The Registrar must refuse to consider the application if satisfied that the applicant has failed to comply with subparagraph (4)(b)(i), unless the Registrar is satisfied that the applicant, after taking reasonable steps to obtain the information mentioned in that subparagraph, cannot do so.

Note: A decision under this subsection is reviewable by the AAT under section 77.

*Notifying other eligible persons and the breeder of the second variety*

- (6) The Registrar must notify an application to:
  - (a) each eligible person in relation to the initial variety other than the applicant; and
  - (b) if the application includes sufficient information for the Registrar to do so—the person (or persons) the applicant reasonably believes to be the breeder of the second variety.
- (7) The notification of the application must include a statement to the effect that the application has been, or will be, published in the *Plant Varieties Journal* under subsection 41B(1).

*Multiple applications*

- (8) If an eligible person in relation to a plant variety (the **initial variety**) applies for a declaration under subsection (2) in relation to another plant variety (the **second variety**), that does not prevent another eligible person in relation to the initial variety also applying for a declaration under that subsection in relation to the second variety.

**41B Essential derivation for non-PBR-protected varieties—  
publication of applications**

- (1) As soon as practicable after an application under section 41A is made, the Registrar must publish a notification of the application in the *Plant Varieties Journal* including information about the applicant and the application, and any related information, prescribed by the regulations.
- (2) At any time or times before making a decision on the application, the Registrar may publish further notification of the application in the *Plant Varieties Journal*, including information (or updated information) about the matters prescribed by regulations made for the purposes of subsection (1).
- (3) However, the Registrar must not publish any information in a notification under subsection (1) or (2) if the Registrar is satisfied that the information is commercial-in-confidence.

Note: A decision not to publish information for this reason is reviewable by the AAT under section 77.

- (4) Information is **commercial-in-confidence** if the applicant demonstrates to the Registrar that:
  - (a) release of the information would cause competitive detriment to the applicant; and
  - (b) the information is not in the public domain; and
  - (c) the information is not required to be disclosed under another Australian law; and
  - (d) the information is not readily discoverable.
- (5) However, this section does not apply if the Registrar refuses to consider an application under subsection 41A(5).

Note: Subsection 41A(5) requires the Registrar to refuse to consider an application if the applicant does not include sufficient information to enable the person (or persons) the applicant reasonably believes to be the breeder of the second variety to be notified, unless the Registrar is satisfied that the applicant took reasonable steps to obtain such information.

#### **41C Essential derivation for non-PBR-protected varieties— opportunity to be heard**

##### *Opportunity to be heard for interested persons*

- (1) Before making a decision in relation to an application under section 41A for a declaration under section 41D that a plant variety (the **second variety**) is essentially derived from another plant variety, the Registrar must give an opportunity to be heard under this section to the following persons (each of whom is an **interested person**):
- (a) a person notified under paragraph 41A(6)(b);
  - (b) another person who claims to have an interest in the second variety.

Note: Paragraph 41A(6)(b) provides for the Registrar to notify a person (or persons) the applicant reasonably believes to be the breeder of the second variety.

- (2) Subsection (1) only applies if the interested person gives the Registrar an address for service in Australia or New Zealand within the hearing period.
- (3) The **hearing period** is the period of 2 months after:
- (a) if the Registrar notifies the application to a person (or persons) under paragraph 41A(6)(b)—the later of the following days:
    - (i) the day the application is notified;
    - (ii) the day notification of the application is last published in the *Plant Varieties Journal*; or
  - (b) if the Registrar does not notify the application to a person (or persons) under paragraph 41A(6)(b)—the day notification of the application is last published in the *Plant Varieties Journal*.

Note: The hearing period is the minimum period for considering the application (see subsection 41D(5)).

##### *Information given in accordance with the opportunity to be heard*

- (4) For the purposes of section 41D, information is given by an interested person in accordance with the person's opportunity to be

heard if the information is given in accordance with regulations prescribed for the purposes of this subsection.

- (5) Regulations made for the purposes of subsection (4) may, without limiting that subsection, include reasonable requirements in relation to the following:
- (a) the giving of written information at the request of the Registrar;
  - (b) the giving of oral information at a hearing convened by the Registrar;
  - (c) when, where and in what circumstances such a hearing may be convened;
  - (d) the practice and procedure for any such hearings, including provision for the Registrar to determine such practice and procedure (whether generally or in relation to a particular hearing);
  - (e) the payment of any fees that are prescribed by the regulations in relation to the opportunity to be heard.

*Interested person declines the opportunity to be heard*

- (6) For the purposes of section 41D, an interested person declines the opportunity to be heard if the person:
- (a) gives the Registrar notice that the person does not want to be heard; or
  - (b) fails to give any information in accordance with the person's opportunity to be heard under subsection (4).

#### **41D Essential derivation for non-PBR-protected varieties— declaration**

*Making the decision*

- (1) On an application under section 41A for a declaration under this section that a plant variety (the *second variety*) is essentially derived from another plant variety (the *initial variety*), the Registrar may:
- (a) declare in writing that the second variety is essentially derived from the initial variety; or
  - (b) refuse to make such a declaration.

- Note 1: A decision under this section is reviewable by the AAT under section 77.
- Note 2: The Registrar must refuse to make a declaration under this section if the applicant fails to comply with a requirement under paragraph 41E(3)(a) in relation to a test growing.
- Note 3: The Registrar must not make a decision under this section if an application for PBR in the second variety is made under section 24 (see section 41F).
- (2) The Registrar must make a declaration under subsection (1) if, and only if:
- (a) he or she is satisfied on the balance of probabilities that the second variety is:
    - (i) essentially derived from the initial variety; and
    - (ii) a registrable plant variety within the meaning of section 43; and
  - (b) the initial variety is not itself declared (under section 40 or this section) to be essentially derived from another plant variety.
- (3) In deciding whether to make a declaration under subsection (1), the Registrar must consider the following:
- (a) the information in the application;
  - (b) any information given by an interested person in accordance with the person's opportunity to be heard under subsection 41C(4);
  - (c) any information obtained in a test growing conducted in accordance with section 41E;
  - (d) any other relevant information.
- (4) For the purposes of making the decision, the Registrar may draw an inference that is unfavourable to the interests of an interested person (within the meaning of section 41C) if the person, within the hearing period:
- (a) does not give the Registrar an address for service for the purposes of subsection 41C(2); or
  - (b) declines the opportunity to be heard under subsection 41C(6).

*Time for making decision*

- (5) The Registrar must not make a decision in relation to the application before the end of the hearing period.

Note: For the hearing period, see subsection 41C(3).

*Notification of decision*

- (6) If the Registrar makes a decision under subsection (1), the Registrar must notify the decision to the following:
- (a) each eligible person within the meaning of section 41A (including the applicant);
  - (b) each interested person who is required to be given an opportunity to be heard under subsection 41C(1).
- (7) A notification under subsection (6) must include:
- (a) a statement of reasons for the decision; and
  - (b) a statement to the effect that, subject to the AAT Act, application may be made to the AAT for review of the decision to which the notice relates by or on behalf of a person or persons whose interests are affected by the decision.

*Effect of declaration—reasonable public access*

- (8) While a declaration under this section that the second variety is essentially derived from the initial variety remains in force, section 19 applies in relation to the second variety as if the reference in subsection 19(4) to 2 years after the grant of PBR were a reference to 2 years after the declaration was made.

Note: Section 19 requires the grantee of PBR in a plant variety to take reasonable steps to ensure reasonable public access to the plant variety.

**41E Essential derivation for non-PBR-protected varieties—test growing**

- (1) For the purposes of considering an application under section 41A for a declaration under section 41D that a plant variety (the *second variety*) is essentially derived from another plant variety (the *initial variety*), the Registrar may conduct a test growing or further test
-



growing to determine whether, on the balance of probabilities, the second variety is:

- (a) essentially derived from the initial variety; and
- (b) a registrable plant variety within the meaning of section 43.

Note: A decision under this section is reviewable by the AAT under section 77.

- (2) The Registrar must notify a decision to conduct a test growing to:
  - (a) the applicant; and
  - (b) each interested person who is required to be given an opportunity to be heard under subsection 41C(1).
- (3) To enable the Registrar to arrange a test growing, the notification must require:
  - (a) the applicant, within a reasonable period specified in the notification, to supply the Registrar with sufficient plants or sufficient propagating material of plants of the initial variety, and with any necessary information; and
  - (b) each interested person notified under paragraph (2)(b), within a reasonable period specified in the notification, to supply the Registrar with sufficient plants or sufficient propagating material of plants of the second variety, and with any necessary information.
- (4) The notification must include a statement of the effect of subsections (5) to (8).
- (5) Despite subsection 41D(2), the Registrar must, under paragraph 41D(1)(b), refuse to make the declaration applied for if the applicant fails to comply with a requirement under paragraph (3)(a) of this section.
- (6) For the purposes of making a decision under subsection 41D(1) in relation to the application, the Registrar may draw an inference that is unfavourable to the interests of a person notified under paragraph (2)(b) of this section if the person fails to comply with a requirement under paragraph (3)(b) of this section.
- (7) After completion of the test growing, the Registrar must ensure that any propagating material of a variety used in, or resulting from, the test growing that is capable of being transported is

delivered to the person by whom propagating material of that variety was supplied for the purpose of the test growing.

- (8) The applicant must pay all costs associated with the test growing.

**41F Essential derivation for non-PBR-protected varieties—  
application lodged for PBR in second variety**

*Decision to treat application under section 41A as an application under section 40*

- (1) The Registrar must decide to treat an application under section 41A for a declaration under section 41D that a plant variety (the **second variety**) is essentially derived from another variety (the **initial variety**) as an application under section 40 in relation to those plant varieties if:
- (a) an application for PBR in a plant variety (the **PBR application**) is made under section 24; and
  - (b) the Registrar is satisfied that the plant variety in relation to which the PBR application is made is the same as the second variety.

Note: Section 40 provides for a declaration that a plant variety (the second variety) is essentially derived from another plant variety (the initial variety) if PBR has been applied for, or granted, in relation to the second variety.

*Effect of decision*

- (2) If the Registrar makes a decision under subsection (1):
- (a) the Registrar must not make a decision under section 41D in relation to the application under section 41A (the **original application**); and
  - (b) the Registrar must treat the application under section 41A as if it were an application (the **converted application**) made under section 40 in relation to the initial variety and the second variety, subject to this section.

*Notification of decision*

- (3) The Registrar must notify the decision to the following persons:

- (a) each eligible person, within the meaning of section 41A, in relation to the initial variety (including the applicant under section 41A);
  - (b) the applicant for PBR in the second variety;
  - (c) each interested person, other than the applicant for PBR in the second variety, who is required to be given an opportunity to be heard under subsection 41C(1).
- (4) A notification under subsection (3) must include:
- (a) a statement of the reasons for the decision, and the effect of this section; and
  - (b) in the case of the notification given under paragraph (3)(a) to the applicant under section 41A—a statement to the effect that the applicant under section 41A may provide additional information under subsection (6) within 2 months after the date of the notification.
- (5) The Registrar must publish notice of the decision in the *Plant Varieties Journal*.

*Relevant information*

- (6) Within 2 months after a notification of the Registrar's decision is given under subsection (3) to the applicant under section 41A, the applicant under section 41A may give the Registrar any information that would have been required or allowed under subsections 40(4) and (5) had the original application been made under section 40.
- (7) For the purpose of making a decision under section 40 in relation to the converted application, the Registrar may consider the following:
- (a) for the purposes of a decision under subsection 40(7):
    - (i) any information in the original application; and
    - (ii) any additional information given in accordance with subsection (6) of this section;
  - (b) for the purposes of a decision under subsection 40(10) or (11):
    - (i) any information in relation to the original application given by an interested person in accordance with the

- person's opportunity to be heard under subsection 41C(4); and
- (ii) any information in relation to the original application obtained in a test growing conducted in accordance with section 41E; and
  - (iii) any information mentioned in subsection 40(10) in relation to the converted application, including information obtained in a test growing conducted in accordance with section 41.

*Time for making decision*

- (8) The Registrar must not make a decision in relation to the converted application earlier than 2 months after the day the notification is given under paragraph (3)(a) to the applicant under section 41A.

**32 Paragraph 45(3)(c)**

Repeal the paragraph, substitute:

- (c) the other variety is declared to be essentially derived from the initial variety;

**33 At the end of subsection 45(3)**

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

**34 Subsection 46(2)**

Omit "the Secretary makes a declaration that a variety (the *derived variety*) is", substitute "a variety (the *derived variety*) is declared to be".

**35 At the end of subsections 46(2) and 47(2)**

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

**36 Paragraph 48(2)(c)**

Omit "requesting the Secretary to make a declaration under section 40", substitute "applying for a declaration".

**37 At the end of subsections 48(2), 50(3) and 53(2)**

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

**38 At the end of subsection 75(3) (before the penalty)**

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

**39 After subparagraph 77(1)(b)(xiii)**

Insert:

- (xiiia) under subsection 41A(5) to refuse to consider an application for a declaration of essential derivation; or
- (xiiib) under subsection 41B(3) to publish, or not to publish, information in a notification under subsection 41B(1) or (2); or
- (xiiic) under subsection 41D(1) to make, or to refuse to make, a declaration of essential derivation; or
- (xiiid) under section 41E to conduct, or not to conduct, a test growing; or

**40 Subparagraph 80(2)(a)(ii)**

Repeal the subparagraph, substitute:

- (ii) fees payable in respect of the making of applications for declarations of essential derivation, the examination of those applications and the making of those declarations, including giving interested persons the opportunity to be heard in relation to applications for declarations under section 41D; and

**41 At the end of subsection 80(2)**

Add:

Note: For declarations of essential derivation, see sections 40 and 41D.

**42 Application of amendments**

The amendments of the *Plant Breeder's Rights Act 1994* made by this Part apply in relation to an application for a declaration under section 40 or 41D of that Act that a plant variety is essentially derived from

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another plant variety if the application is made on or after the day this item commences, whether the first-mentioned variety was bred or derived before, on or after that commencement.

## **Part 3—Period to apply for removal of trade marks from Register for non-use**

### ***Trade Marks Act 1995***

#### **43 At the end of subsection 92(4)**

Add:

Note 3: For when the registration of a trade mark is taken to have effect, see sections 72 and 239A.

#### **44 Subsection 92(5)**

Omit “an application (under subsection (1) or (3)) to obtain the removal of a trade mark from the Register”, substitute “a non-use application”.

#### **45 Section 93**

Repeal the section, substitute:

#### **93 Time for making application**

- (1) A non-use application on the ground mentioned in paragraph 92(4)(a) may be made at any time after the filing date in respect of the application for the registration of the trade mark.

Note: For *filing date* see section 6.

- (2) A non-use application on the ground mentioned in paragraph 92(4)(b) may only be made after a period of 3 years beginning from the date the particulars of the trade mark were entered into the Register under section 69.

Note: The registration of a trade mark is taken to have effect earlier than the date the particulars of the trade mark are entered into the Register (see sections 72 and 239A).

#### **46 Application of amendments**

Section 93 of the *Trade Marks Act 1995*, as substituted by this Part, applies to a non-use application in relation to a trade mark if the filing date in respect of the application for the registration of the trade mark is on or after the day this item commences.

**Schedule 1** Responses to the Productivity Commission

**Part 4** Notification of extension of standard patents relating to pharmaceutical substances

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**Part 4—Notification of extension of standard patents  
relating to pharmaceutical substances**

*Patents Act 1990*

**47 Section 76A**

Repeal the section.



## **Schedule 2—Other measures**

### **Part 1—Amending trade mark applications— non-legal persons**

#### *Trade Marks Act 1995*

##### **1 At the end of section 65**

Add:

- (8) Without limiting subsection (7), if the application specifies an applicant without legal personality, an amendment may be made under that subsection to change the reference to the specified applicant to a reference to a person with legal personality if that person can be identified as having made the application.

## Part 2—Written requirements

### Division 1—Amendments

#### *Designs Act 2003*

##### **2 Subsection 24(1)**

Omit “give a written notice to the applicant stating”, substitute “, by notification to the applicant, state”.

##### **3 Subsections 24(2) and (3)**

Repeal the subsections, substitute:

- (2) If a purported design application does not meet the minimum filing requirements, the Registrar must notify the applicant to that effect. The notification must:
- (a) identify each minimum filing requirement that has not been met; and
  - (b) require the applicant to file the additional information required within 2 months, or such other period as is prescribed, from the date of the notification.
- (3) If the minimum filing requirements are not met within the period under paragraph (2)(b), the application is taken never to have been filed.

##### **4 Paragraph 33(1)(b)**

Omit “a notice”, substitute “a notification”.

##### **5 Subparagraph 33(1)(b)(ii)**

Omit “the notice”, substitute “the notification”.

##### **6 Section 41**

Omit “give a written notice to the applicant stating”, substitute “notify the applicant”.

**7 Paragraph 41(a)**

Before “the matters”, insert “of”.

**8 Subparagraph 41(c)(ii)**

Omit “notice”, substitute “notification”.

**9 Section 42 (heading)**

Repeal the heading, substitute:

**42 What happens after Registrar’s notification under section 41**

**10 Subsection 42(1)**

Omit “written notice”, substitute “notification”.

**11 Subsection 42(3)**

Omit “notice”, substitute “notification”.

**12 Paragraph 42(5)(b)**

Omit “notice”, substitute “notification”.

**13 Subsection 43(2)**

Omit “a notice”, substitute “a notification”.

**14 Paragraph 43(2)(b)**

Omit “notice”, substitute “notification”.

**15 Subsection 43(3)**

Omit “in writing of a refusal under subsection (1) or (2). The notice must set out”, substitute “of a refusal under subsection (1) or (2) and of”.

**16 Paragraph 52(3)(a)**

Omit “give the relevant parties a notice stating”, substitute “notify the relevant parties”.

**17 Subsection 57(3)**

Omit “give a written notice to the applicant stating”, substitute “notify the applicant”.

**18 Paragraph 57(3)(a)**

Before “the matters”, insert “of”.

**19 Subparagraph 57(3)(c)(ii)**

Omit “notice”, substitute “notification”.

**20 Section 58 (heading)**

Repeal the heading, substitute:

**58 What happens after Registrar’s notification under section 57**

**21 Subsection 58(1)**

Omit “written notice”, substitute “notification”.

**22 Subsection 58(3)**

Omit “notice”, substitute “notification”.

**23 Paragraph 58(5)(b)**

Omit “notice”, substitute “notification”.

**24 Paragraph 59(1)(a)**

Omit “notice”, substitute “a notification”.

**25 Paragraph 59(1)(b)**

Omit “notice”, substitute “notification”.

**26 Subsection 59(2)**

Omit “in writing of a refusal under subsection (1). The notice must set out”, substitute “of a refusal under subsection (1) and of”.

**27 Subsection 66(2)**

Omit “give written notice to that effect to the registered owner of the design”, substitute “notify the registered owner of the design to that effect”.

**28 Subsection 67(2)**

Omit “give the relevant parties a notice stating”, substitute “notify the relevant parties”.

**29 Paragraph 67(2)(b)**

Before “the details”, insert “of”.

**30 Paragraph 68(2)(a)**

Omit “give the relevant parties a notice stating”, substitute “notify the relevant parties”.

**31 Paragraph 69(3)(a)**

Omit “inform”, substitute “notify”.

**32 Paragraph 138(2)(a)**

Omit “advise”, substitute “notify”.

**33 Before section 145**

Insert:

**144D Notifications by Registrar under this Act or regulations**

- (1) If under this Act or the regulations the Registrar is required or permitted:
  - (a) to notify a person of a matter; or
  - (b) to notify a person that the person is required to do a thing;the Registrar may so notify the person by any means of communication (including by electronic means).

Note: Section 145 deals with the service etc. of documents on a person.
- (2) However, the notification must be by a means of communication such that the content of the notification is readily accessible so as to be usable for subsequent reference.

## ***Patents Act 1990***

### **34 Subsection 27(2)**

Repeal the subsection, substitute:

(2) The Commissioner must:

- (a) notify the applicant for the patent of any matter of which the Commissioner is notified under subsection (1); and
- (b) give the applicant for the patent a copy of any document accompanying the notice under subsection (1).

(2A) Without limiting paragraph (2)(b), the Commissioner may give the copy by:

- (a) making the copy available to the applicant for the patent in an electronic form; and
- (b) notifying the applicant for the patent that the copy is available.

### **35 Subsection 28(4)**

Repeal the subsection, substitute:

*Commissioner must notify patentee of notice given*

(4) The Commissioner must:

- (a) notify the patentee of any matter of which the Commissioner is notified under subsection (1); and
- (b) give the patentee a copy of any document accompanying the notice under subsection (1).

(4A) Without limiting paragraph (4)(b), the Commissioner may give the copy by:

- (a) making the copy available to the patentee in an electronic form; and
- (b) notifying the patentee that the copy is available.

### **36 Paragraph 49(5)(a)**

Omit “in writing”.

**37 Subsection 49(7)**

Omit “in writing”.

**38 Paragraphs 74(2)(a) and (4)(a)**

Omit “in writing”.

**39 Subsection 76(2)**

Omit “in writing”.

**40 Paragraph 101E(1)(a)**

Omit “in writing”.

**41 Subsection 101E(3)**

Repeal the subsection.

**42 After section 220**

Insert:

**220A Notifications by Commissioner under this Act**

- (1) If under this Act the Commissioner is required or permitted:
  - (a) to notify a person of a matter; or
  - (b) to notify a person that the person is required to do a thing;  
the Commissioner may so notify the person by any means of communication (including by electronic means).

Note 1: A reference to this Act includes the regulations (see Schedule 1).

Note 2: Section 221 deals with the service etc. of documents on a person.
- (2) However, the notification must be by a means of communication such that the content of the notification is readily accessible so as to be usable for subsequent reference.

***Plant Breeder’s Rights Act 1994***

**43 Subsection 19(6)**

Omit “give the grantee”.

**44 Paragraph 19(6)(a)**

Before “a”, insert “give the grantee”.

**45 Paragraph 19(6)(b)**

Omit “a written invitation”, substitute “by notification to the grantee, invite the grantee”.

**46 Paragraph 19(7)(b)**

Omit “give written notice of the decision to the grantee and to the person making the request”, substitute “notify the grantee, and the person making the request, of the decision”.

**47 Subparagraph 19(9)(b)(i)**

Omit “given written notice to”, substitute “notified”.

**48 Subsection 21(3)**

Omit “give written notice to the claimant and to the person who was the holder before the entry was made, stating that the entry has been made”, substitute “notify the claimant, and the person who was the holder before the entry was made, that the entry has been made”.

**49 Paragraph 21(4)(a)**

Omit “give written notice to”, substitute “notify”.

**50 Subparagraph 21(4)(a)(i)**

Omit “telling the claimant”.

**51 Subparagraph 21(4)(a)(ii)**

Omit “setting out”, substitute “of”.

**52 Paragraph 21(4)(b)**

Omit “give written notice to”, substitute “notify”.

**53 Subparagraph 21(4)(b)(i)**

Omit “setting out”, substitute “of the”.



**54 Subparagraph 21(4)(b)(ii)**

Omit “telling the claimant”.

**55 Subparagraph 21(4)(b)(iii)**

Omit “setting out”, substitute “of”.

**56 Paragraph 30(4)(a)**

Omit “give written notice to the applicant telling the applicant”,  
substitute “notify the applicant”.

**57 Paragraph 30(5)(a)**

Omit “give written notice to the applicant telling the applicant”,  
substitute “notify the applicant”.

**58 Paragraph 30(5)(a)**

Omit “setting out”, substitute “of”.

**59 Subsection 32(1)**

Omit “give written notice to”, substitute “notify”.

**60 Subsection 32(1)**

Omit “telling the person”.

**61 Subsection 32(2)**

Omit “give written notice to”, substitute “notify”.

**62 Paragraph 32(2)(a)**

Omit “telling the person”.

**63 Paragraph 32(2)(b)**

Omit “setting out”, substitute “of”.

**64 Subsection 32(3)**

Omit “give written notice to”, substitute “notify”.

**65 Paragraph 32(3)(a)**

Omit “setting out”, substitute “of the”.

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**66 Paragraph 32(3)(b)**

Omit “telling the applicant”.

**67 Paragraph 32(3)(c)**

Omit “setting out”, substitute “of”.

**68 Subsection 32(4)**

Omit “give written notice of”, substitute “notify”.

**69 Paragraphs 37(1)(d) and (e)**

Omit “give written notice of”, substitute “notify”.

**70 Subsection 37(2)**

Omit “notice”, substitute “notification”.

**71 Subsection 37(2A)**

Omit “a notice is sent”, substitute “a notification is given”.

**72 Subsection 37(2A)**

Omit “the requirements of the notice”, substitute “the requirements of the notification”.

**73 Paragraph 37(2A)(a)**

Omit “of service of the notice”, substitute “the notification is given”.

**74 Subsection 37(2B)**

Omit “notice issued”, substitute “notification given”.

**75 Paragraph 37(2B)(a)**

Omit “notice”, substitute “notification”.

**76 Subsection 37(3)**

Omit “notice”, substitute “notification”.

**77 Paragraph 39(1)(b)**

Omit “notice” (wherever occurring), substitute “notification”.

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**78 Subsection 39(2)**

Omit “, in writing,”.

**79 Subsection 39(2)**

Omit “notice”, substitute “notification”.

**80 Subsection 39(3)**

Omit “notice” (wherever occurring), substitute “notification”.

**81 Paragraphs 40(8)(a) and (b)**

Omit “inform”, substitute “notify”.

**82 Paragraph 40(8)(b)**

Omit “informed”, substitute “notified”.

**83 Paragraph 40(10)(f)**

Omit “by notice in writing given to”, substitute “notify”.

**84 Paragraph 40(10)(f)**

Omit “, tell that grantee of the declaration and set out”, substitute “of the declaration and of”.

**85 Paragraph 40(11)(b)**

Omit “by notice in writing given to”, substitute “notify”.

**86 Paragraph 40(11)(b)**

Omit “, tell that grantee”.

**87 Subsection 41(2)**

Omit “notice”, substitute “notification”.

**88 Subsection 41(5)**

Omit “subsection 40(8) has effect as if the reference in that subsection to 30 days after being so informed were a reference to 30 days after being informed”, substitute “paragraph 40(8)(b) has effect as if the reference in that paragraph to 30 days after being so notified were a reference to 30 days after being notified”.

**89 Subsection 44(12)**

Omit “give written notice to”, substitute “notify”.

**90 Paragraph 44(12)(a)**

Omit “telling the applicant”.

**91 Paragraph 44(12)(b)**

Omit “setting out”, substitute “of”.

**92 Paragraph 50(2)(aa)**

Omit “notice”, substitute “notification”.

**93 Subsection 50(3)**

Omit “by notice given to the grantee of the right that has been revoked or of the right that is affected by the giving of the declaration of essential derivation, tell that grantee of the decision and set out the reasons for the revocation”, substitute “notify the decision, and the reasons for the decision, to the grantee of the right that has been revoked or to the grantee of the right that was affected by the giving of the declaration of essential derivation”.

**94 Subsection 50(10)**

Omit “by notice in writing to”, substitute “notify”.

**95 Subsection 50(10)**

Omit “, tell the person of the decision and set out”, substitute “of the decision and of”.

**96 After section 72**

Insert:

**72A Notifications by Registrar under this Act or regulations**

- (1) If under this Act or the regulations the Registrar is required or permitted:
  - (a) to notify a person of a matter; or
  - (b) to notify a person that the person is required to do a thing;

the Registrar may so notify the person by any means of communication (including by electronic means).

Note: Section 73 deals with the service etc. of documents on a person.

- (2) However, the notification must be by a means of communication such that the content of the notification is readily accessible so as to be usable for subsequent reference.

**97 Subparagraph 77(1)(b)(xi)**

Omit “issue a notice”, substitute “give a notification”.

***Trade Marks Act 1995***

**98 Section 34 (heading)**

Repeal the heading, substitute:

**34 Notification of decision**

**99 Paragraph 34(a)**

Omit “in writing”.

**100 Subsection 77(2)**

Omit “notice”, substitute “notification”.

**101 Section 80C (heading)**

Repeal the heading, substitute:

**80C Notification about renewal**

**102 Subsection 80E(2)**

Omit “notice”, substitute “notification”.

**103 Subsection 84A(4)**

Omit “notice”, substitute “notification”.

**104 Subsection 84A(4)**

Omit “in accordance with the regulations”.

**105 Subsection 95(1)**

Omit “notice”, substitute “a copy”.

**106 Section 111 (heading)**

Repeal the heading, substitute:

**111 Notification of application to be given to person recorded as claiming interest in trade mark etc.**

**107 Paragraph 176(3)(a)**

Repeal the paragraph, substitute:

- (a) notify the applicant of the Registrar’s decision under this section; and

**108 Paragraph 202(e)**

Omit “, as he or she considers fit,”.

**109 After section 214**

Insert:

**214A Notifications by Registrar under this Act**

- (1) If under this Act the Registrar is required or permitted:

- (a) to notify a person of a matter; or  
(b) to notify a person that the person is required to do a thing; the Registrar may so notify the person by any means of communication (including by electronic means).

Note 1: A reference to this Act includes the regulations (see section 6).

Note 2: Section 215 deals with the service etc. of documents on a person.

- (2) However, the notification must be by a means of communication such that the content of the notification is readily accessible so as to be usable for subsequent reference.

## **Division 2—Application and saving provisions**

### **110 Designs**

- (1) The amendments of sections 24, 33, 41, 42, 43, 52, 57, 58, 59, 66, 67, 68, 69 and 138 of the *Designs Act 2003* made by this Part apply in relation to notifications occurring on or after the commencement of this item.
- (2) The *Designs Act 2003*, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to a notice given under subsection 24(1) or (2), section 41, paragraph 52(3)(a), subsection 57(3), 66(2) or 67(2) or paragraph 68(2)(a) of that Act before that commencement.

### **111 Patents**

The amendments of sections 27, 28, 49, 74 and 76 of the *Patents Act 1990* made by this Part apply in relation to notifications occurring on or after the commencement of this item.

### **112 Plant breeder's rights**

- (1) The amendment of paragraph 19(6)(b) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to invitations made on or after the commencement of this item.
- (2) The amendments of paragraph 19(7)(b), subparagraph 19(9)(b)(i) and sections 21, 30, 32, 37, 39, 40, 41, 44 and 50 of the *Plant Breeder's Rights Act 1994* made by this Part apply in relation to notifications occurring on or after the commencement of this item.
- (3) The *Plant Breeder's Rights Act 1994*, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to a notice given under paragraph 19(7)(b), subparagraph 19(9)(b)(i), subsection 21(3), paragraph 21(4)(a) or (b) or 30(4)(a) or (5)(a), subsection 32(1), (2), (3) or (4), section 37, subsection 39(2), paragraph 40(10)(e) or (f) or (11)(a) or (b) or subsection 41(1), 44(12) or 50(3) or (10) of that Act before that commencement.

### **113 Trade marks**

- (1) The amendments of sections 34, 77, 80E, 84A, 176 and 202 of the *Trade Marks Act 1995* made by this Part apply in relation to notifications occurring on or after the commencement of this item.
- (2) The *Trade Marks Act 1995*, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to a notice given under subsection 77(2), 80E(2) or 84A(4) or paragraph 176(3)(a) of that Act before that commencement.



## **Part 3—Filing requirements**

### **Division 1—Amendments**

#### ***Designs Act 2003***

#### **114 Section 5**

Insert:

***preferred means:***

- (a) in relation to filing a document with the Designs Office—means the means specified under subsection 144A(4); or
- (b) in relation to paying a fee—means the means specified under subsection 130A(4).

#### **115 After subsection 69(2)**

Insert:

- (2A) A person must not provide to the Registrar material in the form of a physical article, other than a document, unless the Registrar has given the person an approval to do so.
- (2B) If a person provides material to the Registrar under subsection (1), the material may be accompanied by evidence, in the form of a declaration, of the publication of the material.

Note: The regulations deal with the making of declarations.

#### **116 After subsection 130(2)**

Insert:

- (2A) Without limiting subsection (1), different fees may be prescribed for filing a document with the Designs Office according to the means by which the document is filed.
- (2B) Without limiting subsection (1), different amounts of a fee may be prescribed according to the means by which the fee is paid.

*Means of paying fee*

- (2C) A fee must be paid by a means determined in an instrument under subsection 130A(1).

*Fees payable in accordance with the regulations*

**117 Before subsection 130(4)**

Insert:

*Consequences of failure to pay fee*

**118 At the end of Part 2 of Chapter 11**

Add:

**130A Approved means of paying a fee**

- (1) For the purposes of subsection 130(2C), the Registrar may, by writing, determine one or more means for paying a fee.
- (2) The means may be an electronic means or any other means.
- (3) The Registrar must publish a notice, in accordance with the regulations, setting out the determination.
- (4) The Registrar may, in a determination under subsection (1), specify that one or more means for paying a fee are preferred means.

Note: Under the regulations, the amount of a fee may be reduced for paying the fee by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

**119 Section 144**

Repeal the section, substitute:

**144 Filing of documents**

For the purposes of this Act and the regulations, a document may be filed with the Designs Office by a means determined in an instrument under subsection 144A(1).

#### **144A Approved means of filing documents**

- (1) For the purposes of section 144, the Registrar may, by writing, determine one or more means for filing a document with the Designs Office.
- (2) The means may be an electronic means or any other means.
- (3) The Registrar must publish a notice, in accordance with the regulations, setting out the determination.
- (4) The Registrar may, in a determination under subsection (1), specify that one or more means for filing a document with the Designs Office are preferred means.

Note: Under the regulations, reduced fees may be payable for filing a document by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

#### **144B Directions by Registrar for filing of documents**

- (1) The Registrar may, by writing, give a direction specifying the form in which a document is to be filed under this Act or the regulations.

Note: See also paragraph 149(2)(aa) (about regulations).

- (2) Subsection (1) does not apply in relation to a document that is required, under the regulations, to be in an approved form.
- (3) The Registrar must publish a notice, in accordance with the regulations, setting out the direction.
- (4) A direction under subsection (1) is not a legislative instrument.

#### **144C Directions by Registrar for filing of evidence**

- (1) The Registrar may, by writing, give a direction in relation to the filing of evidence in connection with a matter arising under this Act or the regulations.

Note: See also paragraph 149(2)(ab) (about regulations).

- (2) Without limiting subsection (1), a direction under that subsection may relate to the following:
  - (a) the number of copies of evidence to be filed;
  - (b) the form in which evidence is to be filed (including the circumstances in which physical articles, other than documents, are or are not permitted to be filed);
  - (c) the means by which evidence is to be filed.
- (3) Without limiting paragraph (2)(b), a direction under subsection (1) may require that evidence in writing be in the form of a declaration.
- (4) This section does not apply in relation to the provision of material under section 69 (about material relating to whether a registered design is new or distinctive).
- (5) The Registrar must publish a notice, in accordance with the regulations, setting out a direction under subsection (1).
- (6) A direction under subsection (1) is not a legislative instrument.

## **120 Before paragraph 149(2)(a)**

Insert:

- (aa) making provision for and in relation to the following:
  - (i) the requirements for filing a document under this Act or the regulations (including the requirement that the document must be in the form (if any) specified in a direction under section 144B);
  - (ii) the consequences of a document not being in accordance with an approved form or not complying with the requirements referred to in subparagraph (i); and
- (ab) making provision for and in relation to the consequences of not complying with a direction under section 144C; and

## ***Patents Act 1990***

### **121 Section 3 (list of definitions)**

Insert “preferred means”.

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## **122 Section 214**

Repeal the section, substitute:

### **214 Filing of documents**

For the purposes of this Act, a document may be filed with the Patent Office by a means determined in an instrument under subsection 214A(1).

## **123 After section 214**

Insert:

### **214A Approved means of filing documents**

- (1) For the purposes of section 214, the Commissioner may, by writing, determine one or more means for filing a document with the Patent Office.
- (2) The means may be an electronic means or any other means.
- (3) The Commissioner must publish a notice in the Official Journal setting out the determination.
- (4) The Commissioner may, in a determination under subsection (1), specify that one or more means for filing a document with the Patent Office are preferred means.

Note: Under the regulations, reduced fees may be payable for filing a document by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

## **124 Before section 215**

Insert:

### **214B Directions by Commissioner for filing of documents**

- (1) The Commissioner may, by writing, give a direction specifying the form in which a document is to be filed under this Act.

Note 1: A reference to this Act includes the regulations (see Schedule 1).

Note 2: See also paragraph 228(2)(ba) (about regulations).

- (2) Subsection (1) does not apply in relation to a document that is required to be in an approved form.
- (3) The Commissioner must publish a notice in the Official Journal setting out the direction.
- (4) A direction under subsection (1) is not a legislative instrument.

#### **214C Directions by Commissioner for filing of evidence**

- (1) The Commissioner may, by writing, give a direction in relation to the filing of evidence in connection with a matter arising under this Act.

Note 1: A reference to this Act includes the regulations (see Schedule 1).

Note 2: See also paragraph 228(2)(bb) (about regulations).

- (2) Without limiting subsection (1), a direction under that subsection may relate to the following:
  - (a) the number of copies of evidence to be filed;
  - (b) the form in which evidence is to be filed (including the circumstances in which physical articles, other than documents, are or are not permitted to be filed);
  - (c) the means by which evidence is to be filed.
- (3) Without limiting paragraph (2)(b), a direction under subsection (1) may require that evidence in writing be in the form of a declaration.
- (4) The Commissioner must publish a notice in the Official Journal setting out a direction under subsection (1).
- (5) A direction under subsection (1) is not a legislative instrument.

#### **125 After subsection 227(2)**

Insert:

- (2A) Without limiting subsection (1), different fees may be prescribed for filing a document with the Patent Office according to the means by which the document is filed.

- (2B) Without limiting subsection (1), different amounts of a fee may be prescribed according to the means by which the fee is paid.
- (2C) A fee must be paid by a means determined in an instrument under subsection 227AAA(1).

## **126 After section 227**

Insert:

### **227AAA Approved means of paying a fee**

- (1) For the purposes of subsection 227(2C), the Commissioner may, by writing, determine one or more means for paying a fee.
- (2) The means may be an electronic means or any other means.
- (3) The Commissioner must publish a notice in the Official Journal setting out the determination.
- (4) The Commissioner may, in a determination under subsection (1), specify that one or more means for paying a fee are preferred means.

Note: Under the regulations, the amount of a fee may be reduced for paying the fee by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

## **127 After paragraph 228(2)(b)**

Insert:

- (ba) making provision for and in relation to the following:
  - (i) the requirements for filing a document under this Act (including the requirement that the document must be in the form (if any) specified in a direction under section 214B);
  - (ii) the consequences of a document not being in accordance with an approved form or not complying with the requirements referred to in subparagraph (i);and
- (bb) making provision for and in relation to the consequences of not complying with a direction under section 214C; and

## 128 Schedule 1

Insert:

*preferred means:*

- (a) in relation to filing a document with the Patent Office—means the means specified under subsection 214A(4); or
- (b) in relation to paying a fee—means the means specified under subsection 227AAA(4).

## *Plant Breeder's Rights Act 1994*

### 129 Subsection 3(1)

Insert:

*preferred means:*

- (a) in relation to lodging a document with, or giving a document to, the Registrar—means the means specified under subsection 72C(4); or
- (b) in relation to paying a fee—means the means specified under subsection 80A(4).

### 130 Subsection 26(1)

Repeal the subsection, substitute:

- (1) An application for PBR in a plant variety must be in the approved form.

### 131 Subsection 34(3)

Repeal the subsection, substitute:

- (3) The detailed description must be in the approved form.

### 132 Subsection 40(4)

Repeal the subsection, substitute:

- (4) An application for a declaration of essential derivation must:
  - (a) be in the approved form; and
  - (b) be accompanied by the prescribed fee in respect of the application.



### **133 Before section 73**

Insert:

### **72B Manner in which documents may be lodged with or given to Registrar**

For the purposes of this Act and the regulations, a document may be lodged with, or given to, the Registrar by a means determined in an instrument under subsection 72C(1).

### **72C Approved means of lodging or giving documents**

- (1) For the purposes of section 72B, the Registrar may, by writing, determine one or more means for lodging a document with, or giving a document to, the Registrar.
- (2) The means may be an electronic means or any other means.
- (3) The Registrar must give public notice setting out the determination.
- (4) The Registrar may, in a determination under subsection (1), specify that one or more means for lodging a document with, or giving a document to, the Registrar are preferred means.

Note: Under the regulations, reduced fees may be payable for lodging or giving a document by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

### **134 At the end of subparagraph 80(2)(a)(iv)**

Add “and”.

### **135 After subparagraph 80(2)(a)(iv)**

Insert:

- (v) different fees for lodging a document with, or giving a document to, the Registrar according to the means by which the document is lodged or given; and
- (vi) different amounts of a fee according to the means by which the fee is paid;

**136 Paragraph 80(2)(a)**

Omit “and the manner of payment of such fees”.

**137 At the end of section 80**

Add:

- (3) A fee must be paid by a means determined in an instrument under subsection 80A(1).

**138 At the end of Part 8**

Add:

**80A Approved means of paying a fee**

- (1) For the purposes of subsection 80(3), the Registrar may, by writing, determine one or more means for paying a fee.
- (2) The means may be an electronic means or any other means.
- (3) The Registrar must give public notice setting out the determination.
- (4) The Registrar may, in a determination under subsection (1), specify that one or more means for paying a fee are preferred means.

Note: Under the regulations, the amount of a fee may be reduced for paying the fee by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

***Trade Marks Act 1995***

**139 Readers guide (list of terms defined in section 6)**

Insert “preferred means”.

**140 Subsection 6(1)**

Insert:

***preferred means:***

- (a) in relation to filing a document with the Trade Marks Office—means the means specified under subsection 213A(4); or
- (b) in relation to paying a fee—means the means specified under subsection 223AA(4).

**141 Paragraph 52(2)(a)**

Omit “manner and”.

**142 Subsection 52A(2)**

Omit “in the prescribed manner and”.

**143 Paragraph 54A(1)(b)**

Omit “in the prescribed manner or”.

**144 Paragraph 96(2)(a)**

Omit “manner and”.

**145 Section 213**

Repeal the section, substitute:

**213 Filing of documents**

For the purposes of this Act, a document may be filed with the Trade Marks Office by a means determined in an instrument under subsection 213A(1).

**213A Approved means of filing documents**

- (1) For the purposes of section 213, the Registrar may, by writing, determine one or more means for filing a document with the Trade Marks Office.
- (2) The means may be an electronic means or any other means.
- (3) The Registrar must advertise the determination in the Official Journal.

- (4) The Registrar may, in a determination under subsection (1), specify that one or more means for filing a document with the Trade Marks Office are preferred means.

Note: Under the regulations, reduced fees may be payable for filing a document by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

#### **146 Before section 214**

Insert:

#### **213B Directions by Registrar for filing of documents**

- (1) The Registrar may, by writing, give a direction specifying the form in which a document is to be filed under this Act.

Note 1: A reference to this Act includes the regulations (see section 6).

Note 2: See also paragraph 231(2)(ba) (about regulations).

- (2) Subsection (1) does not apply in relation to a document that is required to be in an approved form.
- (3) The Registrar must advertise the direction in the Official Journal.
- (4) A direction under subsection (1) is not a legislative instrument.

#### **213C Directions by Registrar for filing of evidence**

- (1) The Registrar may, by writing, give a direction in relation to the filing of evidence in connection with a matter arising under this Act.

Note 1: A reference to this Act includes the regulations (see section 6).

Note 2: See also paragraph 231(2)(bb) (about regulations).

- (2) Without limiting subsection (1), a direction under that subsection may relate to the following:
- (a) the number of copies of evidence to be filed;
  - (b) the form in which evidence is to be filed (including the circumstances in which physical articles, other than documents, are or are not permitted to be filed);

- (c) the means by which evidence is to be filed.
- (3) Without limiting paragraph (2)(b), a direction under subsection (1) may require that evidence in writing be in the form of a declaration.
- (4) The Registrar must advertise a direction under subsection (1) in the Official Journal.
- (5) A direction under subsection (1) is not a legislative instrument.

#### **147 After subsection 223(2)**

Insert:

- (2A) Without limiting subsection (1), different fees may be prescribed for filing a document with the Trade Marks Office according to the means by which the document is filed.
- (2B) Without limiting subsection (1), different amounts of a fee may be prescribed according to the means by which the fee is paid.

*Means of paying fee*

- (2C) A fee that must be paid to the Registrar must be paid by a means determined in an instrument under subsection 223AA(1).

*Consequences of failure to pay fee*

#### **148 After section 223**

Insert:

#### **223AA Approved means of paying a fee**

- (1) For the purposes of subsection 223(2C), the Registrar may, by writing, determine one or more means for paying a fee.
- (2) The means may be an electronic means or any other means.
- (3) The Registrar must advertise the determination in the Official Journal.
- (4) The Registrar may, in a determination under subsection (1), specify that one or more means for paying a fee are preferred means.

Note: Under the regulations, the amount of a fee may be reduced for paying the fee by preferred means.

- (5) A determination under subsection (1) is not a legislative instrument.

### **149 Before paragraph 231(2)(c)**

Insert:

- (ba) provide for and in relation to the following:
- (i) the requirements for filing a document under this Act (including the requirement that the document must be in the form (if any) specified in a direction under section 213B);
  - (ii) the consequences of a document not being in accordance with an approved form or not complying with the requirements referred to in subparagraph (i); and
- (bb) provide for and in relation to the consequences of not complying with a direction under section 213C; and

## **Division 2—Application, saving and transitional provisions**

### **150 Designs**

- (1) The amendment of section 69 of the *Designs Act 2003* made by this Part applies in relation to the provision of material to the Registrar on or after the commencement of this item.
- (2) Subsection 130(2C) of the *Designs Act 2003*, as inserted by this Part, applies in relation to fees paid on or after the commencement of this item.
- (3) Section 144 of the *Designs Act 2003*, as substituted by this Part, applies in relation to documents filed on or after the commencement of this item.
- (4) Section 144B of the *Designs Act 2003*, as inserted by this Part, applies in relation to documents filed on or after the commencement of this item.

- (5) Section 144C of the *Designs Act 2003*, as inserted by this Part, applies in relation to evidence filed on or after the commencement of this item.

### **151 Patents**

- (1) The repeal and substitution of section 214 of the *Patents Act 1990* made by this Part applies in relation to documents filed on or after the commencement of this item.
- (2) Section 214B of the *Patents Act 1990*, as inserted by this Part, applies in relation to documents filed on or after the commencement of this item.
- (3) Section 214C of the *Patents Act 1990*, as inserted by this Part, applies in relation to evidence filed on or after the commencement of this item.
- (4) Subsection 227(2C) of the *Patents Act 1990*, as inserted by this Part, applies in relation to fees paid on or after the commencement of this item.

### **152 Plant breeder's rights**

- (1) The repeal and substitution of subsection 26(1) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to applications made on or after the commencement of this item.
- (2) An approved form that was in effect immediately before the commencement of this item for the purposes of paragraph 26(1)(b) of the *Plant Breeder's Rights Act 1994* continues in force on and after that commencement as if it were an approved form in effect for the purposes of subsection 26(1) of that Act.
- (3) The repeal and substitution of subsection 34(3) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to detailed descriptions given on or after the commencement of this item.
- (4) An approved form that was in effect immediately before the commencement of this item for the purposes of paragraph 34(3)(b) of the *Plant Breeder's Rights Act 1994* continues in force on and after that commencement as if it were an approved form in effect for the purposes of subsection 34(3) of that Act.

## Schedule 2 Other measures

### Part 3 Filing requirements

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- (5) The repeal and substitution of subsection 40(4) of the *Plant Breeder's Rights Act 1994* made by this Part applies in relation to applications made on or after the commencement of this item.
- (6) An approved form that was in effect immediately before the commencement of this item for the purposes of paragraph 40(4)(b) of the *Plant Breeder's Rights Act 1994* continues in force on and after that commencement as if it were an approved form in effect for the purposes of paragraph 40(4)(a) of that Act.
- (7) The repeal and substitution of subsection 40(4) of the *Plant Breeder's Rights Act 1994* made by this Part does not affect the validity of any regulations prescribing a fee for an application under subsection 40(1) of that Act that were in force immediately before the commencement of this item.
- (8) Section 72B of the *Plant Breeder's Rights Act 1994*, as inserted by this Part, applies in relation to documents lodged with, or given to, the Registrar on or after the commencement of this item.
- (9) Subsection 80(3) of the *Plant Breeder's Rights Act 1994*, as added by this Part, applies in relation to fees paid on or after the commencement of this item.

### 153 Trade marks

- (1) Section 213 of the *Trade Marks Act 1995*, as substituted by this Part, applies in relation to documents filed on or after the commencement of this item.
- (2) Section 213B of the *Trade Marks Act 1995*, as inserted by this Part, applies in relation to documents filed on or after the commencement of this item.
- (3) Section 213C of the *Trade Marks Act 1995*, as inserted by this Part, applies in relation to evidence filed on or after the commencement of this item.
- (4) Subsection 223(2C) of the *Trade Marks Act 1995*, as inserted by this Part, applies in relation to fees paid on or after the commencement of this item.



## **Part 4—Signatures**

### ***Patents Act 1990***

#### **154 Paragraph 151(4)(c)**

Omit “signed by the applicant”.

#### **155 Paragraph 176(c)**

Omit “signed by the applicant”.

#### **156 Application provision**

The amendments made by this Part apply in relation to a request referred to in paragraph 151(4)(c) or 176(c) of the *Patents Act 1990* filed on or after the commencement of this item.

## Part 5—Computerised decision-making

### *Designs Act 2003*

#### 157 Section 129

After:

Part 3 contains offence provisions.

insert:

Part 3A deals with computerised decision-making.

#### 158 After Part 3 of Chapter 11

Insert:

## Part 3A—Computerised decision-making

### 135A Computerised decision-making

- (1) The Registrar may arrange for the use, under the Registrar's control, of computer programs for any purposes for which the Registrar may, or must, under this Act or the regulations:
  - (a) make a decision; or
  - (b) exercise any power or comply with any obligation; or
  - (c) do anything else related to making a decision to which paragraph (a) applies or related to exercising a power, or complying with an obligation, to which paragraph (b) applies.
- (2) For the purposes of this Act and the regulations, the Registrar is taken to have:
  - (a) made a decision; or
  - (b) exercised a power or complied with an obligation; or

(c) done something else related to the making of a decision or the exercise of a power or the compliance with an obligation; that was made, exercised, complied with or done by the operation of a computer program under an arrangement made under subsection (1).

*Substituted decisions*

(3) The Registrar may substitute a decision for a decision the Registrar is taken to have made under paragraph (2)(a) if the Registrar is satisfied that the decision made by the operation of the computer program is incorrect.

**159 After subsection 136(1)**

Insert:

(1A) If:

- (a) the Registrar is taken to have made a decision (the *initial decision*) under paragraph 135A(2)(a); and
- (b) under subsection (1) of this section, a person may apply to the Administrative Appeals Tribunal for review of the initial decision; and
- (c) the Registrar, under subsection 135A(3), substitutes a decision for the initial decision;

a person may apply to the Administrative Appeals Tribunal for review of the substituted decision.

**160 Subsection 136(2)**

Omit “If a decision mentioned in subsection (1) is made”, substitute “If, under subsection (1) or (1A), a person may apply to the Administrative Appeals Tribunal for review of a decision”.

***Patents Act 1990***

**161 After section 223**

Insert:

### 223A Computerised decision-making

- (1) The Commissioner may arrange for the use, under the Commissioner's control, of computer programs for any purposes for which the Commissioner may, or must, under this Act:
- (a) make a decision; or
  - (b) exercise any power or comply with any obligation; or
  - (c) do anything else related to making a decision to which paragraph (a) applies or related to exercising a power, or complying with an obligation, to which paragraph (b) applies.

Note: A reference to this Act includes the regulations (see Schedule 1).

- (2) For the purposes of this Act, the Commissioner is taken to have:
- (a) made a decision; or
  - (b) exercised a power or complied with an obligation; or
  - (c) done something else related to the making of a decision or the exercise of a power or the compliance with an obligation; that was made, exercised, complied with or done by the operation of a computer program under an arrangement made under subsection (1).

#### *Substituted decisions*

- (3) The Commissioner may substitute a decision for a decision the Commissioner is taken to have made under paragraph (2)(a) if the Commissioner is satisfied that the decision made by the operation of the computer program is incorrect.

### 162 After subsection 224(1)

Insert:

- (1A) If:
- (a) the Commissioner is taken to have made a decision (the **initial decision**) under paragraph 223A(2)(a); and
  - (b) under subsection (1) of this section, application may be made to the Administrative Appeals Tribunal for review of the initial decision; and

- (c) the Commissioner, under subsection 223A(3), substitutes a decision for the initial decision;  
application may be made to the Administrative Appeals Tribunal for review of the substituted decision.

**163 Subsection 224(2)**

Omit “Where a person who makes a decision mentioned in subsection (1) gives the person or persons affected by the decision written notice of the making of the decision”, substitute “If, under subsection (1) or (1A), application may be made to the Administrative Appeals Tribunal for review of a decision and a written notice of the decision is given to a person whose interests are affected by the decision”.

***Plant Breeder’s Rights Act 1994***

**164 After section 76A**

Insert:

**76B Computerised decision-making**

- (1) The Registrar may arrange for the use, under the Registrar’s control, of computer programs for any purposes for which the Registrar may, or must, under this Act or the regulations:
- (a) make a decision; or
  - (b) exercise any power or comply with any obligation; or
  - (c) do anything else related to making a decision to which paragraph (a) applies or related to exercising a power, or complying with an obligation, to which paragraph (b) applies.
- (2) For the purposes of this Act and the regulations, the Registrar is taken to have:
- (a) made a decision; or
  - (b) exercised a power or complied with an obligation; or
  - (c) done something else related to the making of a decision or the exercise of a power or the compliance with an obligation;

that was made, exercised, complied with or done by the operation of a computer program under an arrangement made under subsection (1).

*Substituted decisions*

- (3) The Registrar may substitute a decision for a decision the Registrar is taken to have made under paragraph (2)(a) if the Registrar is satisfied that the decision made by the operation of the computer program is incorrect.

Note: A substituted decision under subsection (4) may be reviewable by the AAT under section 77.

**165 After subsection 77(1)**

Insert:

(1A) If:

- (a) the Registrar is taken to have made a decision (the *initial decision*) under paragraph 76B(2)(a); and
- (b) under subsection (1) of this section, applications may be made to the AAT for review of the initial decision; and
- (c) the Registrar, under subsection 76B(3), substitutes a decision for the initial decision;

applications may be made to the AAT for review of the substituted decision.

**166 Subsection 77(2)**

Omit “for a review of a decision referred to in subsection (1)”, substitute “under subsection (1) or (1A) of this section for a review of a decision”.

**167 Paragraph 77(3)(a)**

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

***Trade Marks Act 1995***

**168 After Division 2 of Part 21**

Insert:

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## **Division 2A—Computerised decision-making**

### **222A Computerised decision-making**

- (1) The Registrar may arrange for the use, under the Registrar's control, of computer programs for any purposes for which the Registrar may, or must, under this Act:
- (a) make a decision; or
  - (b) exercise any power or comply with any obligation; or
  - (c) do anything else related to making a decision to which paragraph (a) applies or related to exercising a power, or complying with an obligation, to which paragraph (b) applies.

Note: A reference to this Act includes the regulations (see section 6).

- (2) For the purposes of this Act, the Registrar is taken to have:
- (a) made a decision; or
  - (b) exercised a power or complied with an obligation; or
  - (c) done something else related to the making of a decision or the exercise of a power or the compliance with an obligation; that was made, exercised, complied with or done by the operation of a computer program under an arrangement made under subsection (1).

#### *Substituted decisions*

- (3) The Registrar may substitute a decision for a decision the Registrar is taken to have made under paragraph (2)(a) if the Registrar is satisfied that the decision made by the operation of the computer program is incorrect.

#### *Review*

- (4) If:
- (a) the Registrar is taken to have made a decision (the ***initial decision***) under paragraph (2)(a); and
  - (b) under another provision of this Act, an application may be made to the Administrative Appeals Tribunal for review of the initial decision; and

**Schedule 2** Other measures

**Part 5** Computerised decision-making

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(c) the Registrar, under subsection (3), substitutes a decision for the initial decision;  
an application may be made to the Administrative Appeals Tribunal for review of the substituted decision.



## **Part 6—Addresses and service of documents**

### ***Plant Breeder's Rights Act 1994***

#### **169 Subsection 3(4)**

Repeal the subsection, substitute:

- (4) Subsection (2) of this section does not apply to a reference to an *address* in subsection 26(2).

#### **170 At the end of subsection 19(5A)**

Add:

Note: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

#### **171 Subsection 21(5) (before the note)**

Insert:

Note 1: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

#### **172 Subsection 21(5) (note)**

Omit “Note”, substitute “Note 2”.

#### **173 After subsection 26(1)**

Insert:

- (1A) Without limiting subsection (1), the approved form must require the inclusion of an address in Australia or New Zealand for service, being an address that is in accordance with the requirements of the approved form.

Note: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

**174 Subsection 26(3)**

Repeal the subsection.

**175 Subsection 31(3)**

Omit “notices”, substitute “documents”.

**176 At the end of subsection 31(3)**

Add:

Note: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

**177 Subsection 31(4)**

Omit “notices”, substitute “documents”.

**178 At the end of section 73**

Add:

Note: After the time specified in regulations made for the purposes of subsection 3(2), the address may be an electronic address: see subsections 3(2), (5) and (6).

**179 Application provision**

The amendments of section 26 of the *Plant Breeder’s Rights Act 1994* made by this Part apply in relation to applications for PBR in a plant variety made on or after the commencement of this item.

## **Part 7—Requirements for patent documents**

### ***Patents Act 1990***

#### **180 Subsections 29(3) and (4)**

Repeal the subsections, substitute:

- (3) A patent request in relation to a provisional application must:
  - (a) be in the approved form; and
  - (b) be in English; and
  - (c) be accompanied by a provisional specification.
- (4) The provisional specification referred to in paragraph (3)(c) must:
  - (a) be in the approved form; and
  - (b) be in English.
- (4A) A patent request in relation to a complete application must:
  - (a) be in the approved form; and
  - (b) be in English; and
  - (c) be accompanied by a complete specification; and
  - (d) comply with the formalities requirements determined in an instrument under section 229.
- (4B) The complete specification referred to in paragraph (4A)(c) must:
  - (a) be in the approved form; and
  - (b) be in English; and
  - (c) comply with the formalities requirements determined in an instrument under section 229.

#### **181 Subsection 29A(2)**

After “drawings”, insert “, graphics, photographs”.

#### **182 Subsection 40(3A)**

Omit “or drawings”, substitute “, drawings, graphics or photographs”.

**183 Paragraph 151(4)(f)**

Omit “and drawings”, substitute “, drawings, graphics and photographs”.

**184 Paragraph 176(f)**

Omit “and drawings”, substitute “, drawings, graphics and photographs”.

**185 Subparagraph 228(2)(ha)(i)**

After “subsections 18(2) and (3)”, insert “and 29(4A) and (4B)”.

**186 Subparagraph 228(2)(ha)(ii)**

Omit “the application is in accordance with the requirements of the regulations relating to the preparation of documents for filing”, substitute “those formalities requirements are met”.

**187 Subparagraph 228(2)(i)(i)**

Omit “the requirements of subsection 29A(5) have been met”, substitute “the applicant has complied with subsection 29A(5)”.

**188 Subparagraph 228(2)(i)(ii)**

Omit “the PCT application is in accordance with those requirements”, substitute “those requirements are met”.

**189 After paragraph 228(2)(i)**

Insert:

- (ia) making provision for and in relation to:
  - (i) empowering the Commissioner, in relation to a provisional patent application, to direct the applicant to do such things as are necessary to ensure that the provisional specification complies with the requirements of subsection 29(4); and
  - (ii) the provisional specification being taken not to have been filed if such a direction is not complied with within a time specified in the regulations; and

**190 Paragraph 228(2)(j)**

After “ensure that the”, insert “patent request or”.

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**191 Paragraph 228(2)(j)**

Omit “the requirements of the regulations relating to the preparation of documents for filing”, substitute “the requirements of subsection 29(4A) or (4B)”.

**192 At the end of Chapter 22**

Add:

**229 Instrument determining formalities requirements for patent documents**

- (1) The Commissioner may, by written instrument, determine formalities requirements for the purposes of the following:
  - (a) paragraphs 29(4A)(d) and (4B)(c);
  - (b) a provision of the regulations, if that provision refers to this section.
- (2) The Commissioner must publish a notice in the Official Journal setting out the determination.
- (3) A determination under subsection (1) is not a legislative instrument.

**193 Schedule 1 (definition of *specification*)**

Omit “and drawings”, substitute “, drawings, graphics and photographs”.

**194 Application and transitional provisions**

- (1) The amendments of section 29 of the *Patents Act 1990* made by this Part apply in relation to patent requests filed under subsection 29(1) of that Act on or after the commencement of this item.
- (2) An instrument approving a form and in force for the purposes of subsection 29(3) of the *Patents Act 1990* immediately before the commencement of this item has effect on and after that commencement as if it were an instrument approving that form and in force for the purposes of paragraph 29(3)(a) of that Act.
- (3) An instrument approving a form and in force for the purposes of subsection 29(4) of the *Patents Act 1990* immediately before the

**Schedule 2** Other measures

**Part 7** Requirements for patent documents

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commencement of this item has effect on and after that commencement as if it were an instrument approving that form and in force for the purposes of paragraph 29(4A)(a) of that Act.

- (4) An instrument approving a form and in force for the purposes of paragraph 3.2(1)(a) of the *Patents Regulations 1991* immediately before the commencement of this item has effect on and after that commencement as if it were an instrument approving that form and in force for the purposes of paragraph 29(4)(a) of the *Patents Act 1990*.
- (5) An instrument approving a form and in force for the purposes of paragraph 3.2A(2)(a) of the *Patents Regulations 1991* immediately before the commencement of this item has effect on and after that commencement as if it were an instrument approving that form and in force for the purposes of paragraph 29(4B)(a) of the *Patents Act 1990*.

## **Part 8—Unjustified threats of infringement**

### **Division 1—Amendments**

#### ***Designs Act 2003***

##### **195 After subsection 77(1)**

Insert:

- (1A) The court may include an additional amount in an assessment of damages sustained by the applicant as a result of the unjustified threats, if the court considers it appropriate to do so having regard to:
- (a) the flagrancy of the threats; and
  - (b) the need to deter similar threats; and
  - (c) the conduct of the respondent that occurred after the respondent made the threats; and
  - (d) any benefit shown to have accrued to the respondent because of the threats; and
  - (e) all other relevant matters.

#### ***Olympic Insignia Protection Act 1987***

##### **196 Division 3 of Part 3.4 (heading)**

Repeal the heading, substitute:

### **Division 3—Unjustified threats**

##### **197 Section 64 (heading)**

Repeal the heading, substitute:

#### **64 Unjustified threats of legal proceedings**

##### **198 Paragraph 64(2)(a)**

Omit “AOC or the licensed user had no grounds for making the threat”, substitute “threat is unjustified”.

**199 Section 65 (heading)**

Repeal the heading, substitute:

**65 Counterclaim**

***Patents Act 1990***

**200 After subsection 128(1)**

Insert:

- (1A) The court may include an additional amount in an assessment of damages sustained by the applicant as a result of the unjustifiable threats, if the court considers it appropriate to do so having regard to:
- (a) the flagrancy of the threats; and
  - (b) the need to deter similar threats; and
  - (c) the conduct of the person who made the threats, being conduct that occurred after the person made the threats; and
  - (d) any benefit shown to have accrued to the person who made the threats because of the threats; and
  - (e) all other relevant matters.

***Plant Breeder's Rights Act 1994***

**201 Subsection 3(1)**

Insert:

***legal practitioner*** means a barrister or solicitor of the High Court or of the Supreme Court of a State or Territory.

**202 At the end of Part 5**

Add:

**57A Application for relief from unjustified threats**

- (1) If a person is threatened by another person (the ***respondent***) with proceedings for infringement of PBR in a plant variety, or other



similar proceedings, an aggrieved person (the *applicant*) may apply to the Federal Court or Federal Circuit Court for:

- (a) a declaration that the threats are unjustified; and
  - (b) an injunction against the continuance of the threats; and
  - (c) the recovery of any damages sustained by the applicant as a result of the threats.
- (2) The Federal Court or Federal Circuit Court may include an additional amount in an assessment of damages sustained by the applicant as a result of the unjustified threats, if the Court considers it appropriate to do so having regard to:
- (a) the flagrancy of the threats; and
  - (b) the need to deter similar threats; and
  - (c) the conduct of the respondent that occurred after the respondent made the threats; and
  - (d) any benefit shown to have accrued to the respondent because of the threats; and
  - (e) all other relevant matters.
- (3) A threat mentioned in subsection (1) may be by means of circulars, advertisements or otherwise.
- (4) Subsection (1) applies whether or not the respondent is the grantee of the PBR in the plant variety or an exclusive licensee of the grantee.

### **57B Court's power to grant relief**

The Federal Court or Federal Circuit Court may grant the relief sought by an applicant under section 57A, unless the respondent satisfies the Court that:

- (a) the respondent is the grantee of the PBR in the plant variety or an exclusive licensee of the grantee; and
- (b) the acts about which the threats were made infringe, or would infringe, the PBR in the plant variety.

### **57C Counterclaim for infringement**

- (1) The respondent in proceedings under section 57A may apply, by way of counter-claim, for relief to which the respondent would be

entitled in separate proceedings against the applicant for infringement of the PBR in the plant variety.

- (2) The provisions of this Act relating to proceedings for infringement of PBR in a plant variety apply, with the necessary changes, to a counter-claim under subsection (1).

#### **57D Notification of PBR in a plant variety not a threat**

The mere notification of the existence of PBR in a plant variety does not constitute a threat of proceedings for the purposes of section 57A.

#### **57E Liability of legal practitioner**

A legal practitioner is not liable to proceedings under section 57A in respect of an act done in a professional capacity on behalf of a client.

### ***Trade Marks Act 1995***

#### **203 Section 129 (heading)**

Repeal the heading, substitute:

#### **129 Application for relief from unjustified threats**

#### **204 Paragraph 129(2)(a)**

Omit “defendant has no grounds for making the threat”, substitute “threat is unjustified”.

#### **205 After subsection 129(2)**

Insert:

- (2A) The court may include an additional amount in an assessment of damages the plaintiff has sustained because of the defendant’s conduct, if the court considers it appropriate to do so having regard to:
- (a) the flagrancy of the threat; and
  - (b) the need to deter similar threats; and

- (c) the conduct of the defendant that occurred after the defendant made the threat; and
- (d) any benefit shown to have accrued to the defendant because of the threat; and
- (e) all other relevant matters.

**206 Subsection 129(5)**

Repeal the subsection.

**207 Section 130 (heading)**

Repeal the heading, substitute:

**130 Counterclaim for infringement**

**208 At the end of Part 12**

Add:

**130A Mere notification of registered trade mark not a threat**

The mere notification of the existence of a registered trade mark does not constitute a threat to bring an action for the purposes of section 129.

**Division 2—Application and saving provisions**

**209 Application and saving provisions**

*Designs*

- (1) The amendment of section 77 of the *Designs Act 2003* made by this Part applies in relation to threats of the kind referred to in subsection 77(1) of that Act that are made on or after the commencement of this item.

*Olympic expressions*

- (2) The amendments of section 64 of the *Olympic Insignia Protection Act 1987* made by this Part apply in relation to threats of the kind referred to in subsection 64(1) of that Act that are made on or after the commencement of this item.

*Patents*

- (3) The amendment of section 128 of the *Patents Act 1990* made by this Part applies in relation to threats of the kind referred to in subsection 128(1) of that Act that are made on or after the commencement of this item.

*Plant breeder's rights*

- (4) Section 57A of the *Plant Breeder's Rights Act 1994*, as added by this Schedule, applies in relation to threats of the kind referred to in subsection 57A(1) of that Act that are made on or after the commencement of this item.

*Trade marks*

- (5) The amendments of section 129 of the *Trade Marks Act 1995* made by this Part (except the repeal of subsection 129(5) of that Act) apply in relation to threats of the kind referred to in subsection 129(1) of that Act that are made on or after the commencement of this item.
- (6) Despite the repeal of subsection 129(5) of the *Trade Marks Act 1995* made by this Part, that subsection, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to an action for infringement of a trade mark begun before that commencement.

## **Part 9—Ownership of PBR and entries in the Register**

### ***Plant Breeder’s Rights Act 1994***

#### **210 Subsection 3(1)**

Insert:

*relevant proceedings*, in relation to PBR in a plant variety, means proceedings in a court or in the AAT relating to:

- (a) the grant of the PBR; or
- (b) the infringement of the PBR; or
- (c) a decision to revoke, or not to revoke, the PBR.

#### **211 Subsection 45(1)**

Omit “subsections (2) and (3)”, substitute “subsection (3)”.

#### **212 At the end of subsection 45(1)**

Add:

Note: If PBR is granted to persons who make a joint application, the PBR is granted to those persons jointly: see subsection 44(11).

#### **213 Subsection 45(2)**

Repeal the subsection.

#### **214 At the end of Part 6**

Add:

#### **62A Registrar’s power to rectify Register**

- (1) The Registrar may rectify the Register if the Registrar is satisfied, whether on application or otherwise, of any of the following:
  - (a) the omission of an entry from the Register;
  - (b) an entry made in the Register without sufficient cause;
  - (c) an entry wrongly existing in the Register;
  - (d) an error or defect in an entry in the Register.

*Form of application*

- (2) An application under subsection (1) must be in the approved form.

*Further information*

- (3) The Registrar:
- (a) may seek further information from any person for the purpose of considering an application under subsection (1); and
  - (b) is not required to consider the application while seeking the further information.

*Persons to be heard*

- (4) The Registrar must not rectify the Register under this section in relation to PBR in a plant variety without first giving the following persons a reasonable opportunity to be heard:
- (a) in the case of an application to rectify the Register—the applicant;
  - (b) the grantee of the PBR as recorded in the Register;
  - (c) any other person the Registrar considers appropriate.

*Relevant proceedings pending*

- (5) The Registrar must not rectify the Register under this section in relation to PBR in a plant variety while:
- (a) relevant proceedings in relation to the PBR are pending; or
  - (b) proceedings in a court or in the AAT, relating to a decision under section 21 to amend, or refuse to amend, the Register in relation to the PBR, are pending.

Note: A decision under this section to rectify, or refuse to rectify, the Register is reviewable by the AAT under section 77.

**215 At the end of paragraph 77(1)(b)**

Add:

- (xvii) under section 62A to rectify, or refuse to rectify, the Register.

**216 Paragraph 80(2)(d)**

After “mistake”, insert “, or for any other purpose”.

**217 Application provision**

Section 62A of the *Plant Breeder’s Rights Act 1994*, as added by this Part, applies in relation to:

- (a) PBR in a plant variety granted before, on or after the commencement of this item; and
- (b) entries made in the Register before, on or after that commencement.

## Part 10—Trade mark oppositions

### *Trade Marks Act 1995*

#### **218 Paragraph 222(a)**

After “subsection”, insert “65A(4), 83A(4) or”.

#### **219 Subsection 231(3)**

Omit “and 92”, substitute “, 65A, 83A and 96”.

#### **220 Application provision**

The amendment of paragraph 222(a) of the *Trade Marks Act 1995* made by this Part applies in relation to a request referred to in subsection 65A(4) or 83A(4) of that Act that is made on or after the commencement of this item.



## **Part 11—Further power to award damages under the Plant Breeder's Rights Act**

### ***Plant Breeder's Rights Act 1994***

#### **221 After subsection 56(3)**

Insert:

- (3A) The Federal Court may include an additional amount in an assessment of damages for an infringement of PBR, if the Court considers it appropriate to do so having regard to:
- (a) the flagrancy of the infringement; and
  - (b) the need to deter similar infringements of PBR; and
  - (c) the conduct of the party that infringed the PBR that occurred:
    - (i) after the act constituting the infringement; or
    - (ii) after that party was informed that it had allegedly infringed the PBR; and
  - (d) any benefit shown to have accrued to that party because of the infringement; and
  - (e) all other relevant matters.

#### **222 After subsection 56A(3)**

Insert:

- (3A) The Federal Circuit Court may include an additional amount in an assessment of damages for an infringement of PBR, if the Court considers it appropriate to do so having regard to:
- (a) the flagrancy of the infringement; and
  - (b) the need to deter similar infringements of PBR; and
  - (c) the conduct of the party that infringed the PBR that occurred:
    - (i) after the act constituting the infringement; or
    - (ii) after that party was informed that it had allegedly infringed the PBR; and
  - (d) any benefit shown to have accrued to that party because of the infringement; and
  - (e) all other relevant matters.

### **223 Application and transitional provisions**

- (1) The amendments of sections 56 and 56A of the *Plant Breeder's Rights Act 1994* made by this Part apply in relation to infringements of PBR that occur on or after the commencement of that Part.
- (2) If, on or after the commencement of this Part, an action for infringement of PBR is begun in relation to conduct engaged in before and on or after that commencement, the Federal Court or the Federal Circuit Court may include an additional amount in an assessment of damages under subsection 56(3A) or 56A(3A) of the *Plant Breeder's Rights Act 1994* only in relation to the conduct that was engaged in on or after commencement.

## **Part 12—Exclusive licensees in the Plant Breeder's Rights Act**

### ***Plant Breeder's Rights Act 1994***

#### **224 Subsection 3(1)**

Insert:

*exclusive licensee* of the grantee of PBR in a plant variety means a licensee under a licence granted by the grantee that confers on the licensee, or on the licensee and persons authorised by the licensee, PBR in the plant variety to the exclusion of the grantee and all other persons.

#### **225 Section 18 (heading)**

Repeal the heading, substitute:

### **18 Restrictions on exercise of PBR in certain circumstances**

#### **226 Paragraph 18(1)(b)**

Omit “variety;”, substitute “variety, or an exclusive licensee of the grantee;”.

#### **227 Paragraph 18(1)(c)**

After “grantee”, insert “, or an exclusive licensee of the grantee,”.

#### **228 Subsection 18(1)**

Omit “the grantee is not entitled”, substitute “neither the grantee, nor any exclusive licensee of the grantee, nor any other person authorised by the grantee or exclusive licensee, is entitled”.

#### **229 Subsection 18(3) (paragraph (a) of the definition of *equitable remuneration*)**

Omit “variety;”, substitute “variety, or an exclusive licensee of the grantee;”.

**230 Subsection 23(3)**

After “grantee of PBR”, insert “, or an exclusive licensee of the grantee,”.

**231 Paragraph 51(1)(b)**

Omit “54(3)”, substitute “54A(2)”.

**232 At the end of section 53**

Add:

- (4) In this section, if a grantee of a PBR in a plant variety has granted an exclusive licence in relation to that right, a reference to the grantee is taken to be a reference to the exclusive licensee.

**233 At the end of subsection 54(1)**

Add “or an exclusive licensee of the grantee”.

**234 Subsections 54(2) to (4)**

Repeal the subsections, substitute:

- (2) If an exclusive licensee of a grantee of PBR in a plant variety begins an action for infringement of that right, the licensee must make the grantee a defendant in the action, unless the grantee is joined as a plaintiff.
- (3) A grantee who is made a defendant in an action is not liable for costs if the grantee does not take part in the proceedings.

**235 After section 54**

Insert:

**54A Counterclaims to actions for infringement**

- (1) A defendant in an action for infringement of PBR in a plant variety may apply, by way of counterclaim, for revocation of that right on the ground that:
  - (a) the variety was not a new plant variety; or

- (b) facts exist that would have resulted in the refusal of the grant of that right if they had been known to the Registrar before the grant of that right.
- (2) If, in an action for infringement of PBR in a plant variety:
  - (a) the defendant applies, by way of counterclaim, for the revocation of that right; and
  - (b) the court is satisfied that a ground for revocation of that right exists;the court may make an order revoking that right.
- (3) If the court revoked PBR in a plant variety on the counterclaim of a defendant, the court may order the defendant to serve on the Registrar a copy of the order revoking that right.

### **236 At the end of section 55**

Add:

- (7) The grantee must be joined as a respondent in the proceedings.
- (8) In this section:

*grantee* includes an exclusive licensee of the grantee.

### **237 Application and transitional provisions**

- (1) The amendments made by this Part apply in relation to conduct engaged in on or after the commencement of this Part.
- (2) If, on or after the commencement of this Part, an exclusive licensee of PBR in a plant variety begins an action for infringement of PBR in relation to conduct engaged in before and on or after that commencement, the Federal Court or the Federal Circuit Court may only grant relief under section 56 or 56A of the *Plant Breeder's Rights Act 1994* in relation to the conduct that was engaged in on or after commencement.

## **Part 13—Publishing personal information of registered patent or trade marks attorneys**

### **Division 1—Amendments**

#### ***Patents Act 1990***

#### **238 After subsection 183(1)**

Insert:

- (1A) The Designated Manager may disclose to the Board personal information (within the meaning of the *Privacy Act 1988*):
- (a) that is about a registered patent attorney; and
  - (b) that the Designated Manager considers to be relevant to the Board's functions.

#### **239 After section 227A**

Insert:

#### **227B Publishing personal information of registered patent attorneys**

- (1) The Board may publish on its website any or all of the following personal information (within the meaning of the *Privacy Act 1988*) that is about a registered patent attorney:
- (a) the name of the attorney;
  - (b) the country in which the attorney's work address is located;
  - (c) if the attorney's work address is located in Australia—the State or Territory in which the attorney's work address is located;
  - (d) if the attorney's work address is located in a foreign country—the state, territory, province, region or other political subdivision (however described) of that country in which the attorney's work address is located;
  - (e) the attorney's work email address.
- (2) Subsection (1) does not prevent the Board from publishing on its website other personal information (within the meaning of the

*Privacy Act 1988*) that is about a registered patent attorney with the attorney's written consent.

### ***Trade Marks Act 1995***

#### **240 After section 229**

Insert:

#### **229AA Designated Manager may disclose information to Board**

The Designated Manager may disclose to the Board personal information:

- (a) that is about a registered trade marks attorney; and
- (b) that the Designated Manager considers to be relevant to the Board's functions.

#### **241 After section 229A**

Insert:

#### **229B Publishing personal information of registered trade marks attorneys**

- (1) The Board may publish on its website any or all of the following personal information that is about a registered trade marks attorney:
  - (a) the name of the attorney;
  - (b) the country in which the attorney's work address is located;
  - (c) if the attorney's work address is located in Australia—the State or Territory in which the attorney's work address is located;
  - (d) if the attorney's work address is located in a foreign country—the state, territory, province, region or other political subdivision (however described) of that country in which the attorney's work address is located;
  - (e) the attorney's work email address.
- (2) Subsection (1) does not prevent the Board from publishing on its website other personal information that is about a registered trade marks attorney with the attorney's written consent.

## Division 2—Application provisions

### 242 Application provisions

#### *Patents*

- (1) The amendments of the *Patents Act 1990* made by this Part apply in relation to information about a registered patent attorney obtained before, on or after the commencement of this item (whether the attorney was registered under that Act before, on or after that commencement).

#### *Trade marks*

- (2) The amendments of the *Trade Marks Act 1995* made by this Part apply in relation to information about a registered trade marks attorney obtained before, on or after the commencement of this item (whether the attorney was registered under that Act before, on or after that commencement).



## **Part 14—Secretary's role in the Plant Breeder's Rights Act**

### ***Plant Breeder's Rights Act 1994***

#### **243 Subsection 3(1) (definition of *approved form*)**

Repeal the definition, substitute:

*approved form*, in relation to a provision of this Act, means a form approved in an instrument under subsection (1B) for the purposes of that provision.

#### **244 Subsection 3(1) (definition of *genetic resource centre*)**

Omit "Secretary", substitute "Registrar".

#### **245 Subsection 3(1) (definition of *herbarium*)**

Omit "Secretary", substitute "Registrar".

#### **246 Subsection 3(1) (definition of *Secretary*)**

Repeal the definition.

#### **247 After subsection 3(1A)**

Insert:

(1B) The Registrar may, by writing, approve a form for the purposes of a provision of this Act.

#### **248 Subsection 8(1)**

Omit "Secretary", substitute "Registrar".

#### **249 Subsections 19(3) and (4) and (6) to (11)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

#### **250 Subsection 24(1)**

Omit "Secretary", substitute "Registrar".

**251 Subparagraph 26(2)(i)(iii)**

Omit "Secretary", substitute "Registrar".

**252 Subsections 28(1), (2) and (3)**

Omit "Secretary", substitute "Registrar".

**253 Subsections 29(3) and (4)**

Omit "Secretary", substitute "Registrar".

**254 Subsections 30(1) to (5)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**255 Subsections 31(1), (2), (4), (5) and (6)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**256 Subsections 32(1) to (5)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**257 Subsection 33(2)**

Omit "Secretary", substitute "Registrar".

**258 Section 34 (heading)**

Repeal the heading, substitute:

**34 Detailed description in support of application to be given to Registrar**

**259 Subsections 34(1), (2), (5) and (6)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**260 Subsections 35(1) and (2)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**261 Paragraph 36(3)(d)**

Omit "Secretary", substitute "Registrar".

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**262 Subsection 37(1)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**263 Subsection 37(2)**

Omit "Secretary's", substitute "Registrar's".

**264 Paragraph 37(2)(b)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**265 Subsections 37(2B), (3), (4), (6) and (7)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**266 Subsections 38(4) and (5)**

Omit "Secretary", substitute "Registrar".

**267 Subsection 38(5) (note)**

Omit "Secretary", substitute "Registrar".

**268 Subsections 39(1), (2) and (4)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**269 Subsections 40(3), (7), (8), (10) and (11)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**270 Subsections 41(2) and (5)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**271 Subsections 44(1), (2), (3), (4), (5), (6) and (9)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**272 Subsection 44(10)**

Omit "issue to that person by the Secretary", substitute "issue to that person by the Registrar".

**273 Subsection 44(10)**

Omit "the Secretary or".

**274 Subsection 44(10)**

Omit "as the Secretary", substitute "as the Registrar".

**275 Subsection 44(12)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**276 Subsection 46(1)**

Omit "Secretary", substitute "Registrar".

**277 Subsections 47(1) and (2)**

Omit "Secretary", substitute "Registrar".

**278 Paragraph 49(3)(a)**

Omit "Secretary", substitute "Registrar".

**279 Subsections 50(1), (2), (3), (4), (5), (8), (9) and (10)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**280 Subsections 51(1) and (3)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**281 Section 52**

Omit "Secretary", substitute "Registrar".

**282 Subsection 58(3)**

Repeal the subsection, substitute:

- (3) The Registrar has the functions and powers that are conferred on the Registrar by this Act or by the regulations.

**283 Subsection 59(2)**

Repeal the subsection.

**284 Subsection 59(4)**

Omit "the Minister or the Secretary under subsection (1) or (2)", substitute "the Minister under subsection (1)".

**285 Subsection 59(5)**

Omit "person who originally delegated the corresponding power or function under subsection (1) or (2)", substitute "Minister".

**286 Paragraph 60(1)(a)**

Repeal the paragraph.

**287 Subsection 61(1)**

Omit "Secretary", substitute "Registrar".

**288 Subsections 68(1), (2), (3) and (4)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**289 Subsection 70(1)**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**290 Section 71**

Omit "Secretary" (wherever occurring), substitute "Registrar".

**291 Paragraph 73(b)**

Omit "the Secretary or".

**292 Subsection 75(1)**

Omit "the Secretary or".

**293 Paragraph 77(1)(b)**

Omit "by the Secretary", substitute "by the Registrar".

**294 After subparagraph 77(1)(b)(iv)**

Insert:

(iva) under section 21 to amend, or refuse to amend, the Register; or

**295 Subparagraphs 77(1)(b)(ix) and (x)**

Omit "Secretary", substitute "Registrar".

**296 Paragraph 77(1)(c)**

Repeal the paragraph.

**297 Subsection 77(3)**

Omit "Secretary", substitute "Registrar".

**298 Subparagraph 80(2)(a)(iv)**

Omit "Secretary", substitute "Registrar".

**299 Saving and transitional provisions**

- (1) A thing done by, or in relation to, the Secretary under the *Plant Breeder's Rights Act 1994* before the commencement of this item has effect on and after that commencement as if it had been done by, or in relation to, the Registrar.
- (2) A form approved by the Secretary and in force immediately before the commencement of this item for the purposes of a provision of the *Plant Breeder's Rights Act 1994* has effect on and after that commencement as if it were a form approved by the Registrar in an instrument under subsection 3(1B) of that Act for the purposes of that provision.
- (3) Despite the repeal of paragraph 60(1)(a) of the *Plant Breeder's Rights Act 1994* made by this Part, that paragraph, as in force immediately before the commencement of this item, continues in force on and after that commencement for the period of 12 months beginning on the day this item commences.
- (4) Paragraph 77(1)(c) of the *Plant Breeder's Rights Act 1994*, as in force immediately before the commencement of this item, continues to apply on and after that commencement in relation to a decision of the Registrar, before that commencement, under section 21 of that Act to amend, or refuse to amend, the Register.

## **Part 15—Seizure notices**

### **Division 1—Amendments**

#### ***Copyright Act 1968***

##### **300 Subsection 135AC(1)**

Omit “either personally or by post, a written notice”, substitute “by any means of communication (including by electronic means), a notice”.

##### **301 Paragraphs 135AC(3)(c) and (d)**

Repeal the paragraphs, substitute:

- (c) if the notice is given to the objector—state the name and the address of the place of business or residence of the importer (if known), unless the Comptroller-General of Customs is satisfied, for reasons of confidentiality, that it is not desirable to do so; and
- (d) if the notice is given to the importer—state the name and the address of the place of business or residence of:
  - (i) the objector; or
  - (ii) if the objector has nominated a person to be the objector’s agent or representative for the purposes of this Division—that person;unless the Comptroller-General of Customs is satisfied, for reasons of confidentiality, that it is not desirable to do so.

#### ***Olympic Insignia Protection Act 1987***

##### **302 Subsection 55(1)**

Omit “either personally or by post, a written notice”, substitute “by any means of communication (including by electronic means), a notice”.

##### **303 Paragraph 55(2)(a)**

Repeal the paragraph, substitute:

- (a) state the name and the address of the place of business or residence of the designated owner (if known), unless the

Comptroller-General of Customs is satisfied, for reasons of confidentiality, that it is not desirable to do so; and

### ***Trade Marks Act 1995***

#### **304 Subsection 134(1)**

Omit “either personally or by post, a written notice”, substitute “by any means of communication (including by electronic means), a notice”.

#### **305 Paragraphs 134(3)(c) and (d)**

Repeal the paragraphs, substitute:

- (c) if the notice is given to the objector—state the name and the address of the place of business or residence of the designated owner (if known), unless the Comptroller-General of Customs is satisfied, for reasons of confidentiality, that it is not desirable to do so; and
- (d) if the notice is given to the designated owner—state the name and the address of the place of business or residence of:
  - (i) the objector; or
  - (ii) if the objector has nominated a person to be the objector’s agent or representative for the purposes of this Division—that person;unless the Comptroller-General of Customs is satisfied, for reasons of confidentiality, that it is not desirable to do so.

## **Division 2—Application provisions**

### **306 Application provisions**

#### *Copyright*

- (1) The amendments of section 135AC of the *Copyright Act 1968* made by this Part apply in relation to notices given under subsection 135AC(1) of that Act on or after the commencement of this item.

#### *Olympic expressions*

- (2) The amendments of section 55 of the *Olympic Insignia Protection Act 1987* made by this Part apply in relation to notices given under subsection 55(1) of that Act on or after the commencement of this item.



*Trade marks*

- (3) The amendments of section 134 of the *Trade Marks Act 1995* made by this Part apply in relation to notices given under subsection 134(1) of that Act on or after the commencement of this item.

## Part 16—Prosecutions

### Division 1—Amendments

#### *Patents Act 1990*

##### **307 Section 204**

Omit “or (5)”, substitute “, (5) or (6) or 201B(1) or (2)”.

##### **308 Section 204**

After “202A”, insert “, 202B”.

#### *Trade Marks Act 1995*

##### **309 Subsection 156(3A)**

Omit “the company” (first occurring).

##### **310 Before subsection 156(4)**

Insert:

*Common rules*

##### **311 At the end of section 157A**

Add:

*Time for starting prosecutions*

- (9) Despite section 15B of the *Crimes Act 1914*, a prosecution for an offence against this section may be started at any time within 5 years after the offence was committed.

## **Division 2—Application provision**

### **312 Application provision**

The amendments of section 204 of the *Patents Act 1990* and of section 157A of the *Trade Marks Act 1995* made by this Part apply in relation to offences committed on or after the commencement of this item.

## Part 17—Updating references to Designs Act

### *Olympic Insignia Protection Act 1987*

#### **313 Subsection 2(1) (definition of Registrar)**

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

#### **314 Subsection 2(2)**

Repeal the subsection.

#### **315 Subsection 2(3)**

Omit “*Designs Act 1906*” (wherever occurring), substitute “*Designs Act 2003*”.

#### **316 Paragraph 10(7)(e)**

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

#### **317 Subsection 10(12) (paragraph (a) of the definition of published design)**

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

#### **318 Subsection 12(5)**

Omit “Section 36 of the *Designs Act 1906*”, substitute “Section 131 of the *Designs Act 2003*”.

#### **319 Section 13**

Omit “Section 8A of the *Designs Act 1906*”, substitute “Section 124 of the *Designs Act 2003*”.

#### **320 Section 18 (heading)**

Repeal the heading, substitute:

### **18 Protected designs not to be registered under the *Designs Act 2003***

#### **321 Section 18**

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

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**322 Paragraphs 20(1)(b) and (3)(d)**

Omit “*Designs Act 1906*”, substitute “*Designs Act 2003*”.

## **Part 18—Removing certain references to New Zealand**

### ***Patents Act 1990***

#### **323 Section 3 (list of definitions)**

Omit “New Zealand Assistant Commissioner of Patents”.

#### **324 Section 3 (list of definitions)**

Omit “New Zealand delegate”.

#### **325 Subsection 20(2)**

Omit “an employee, or a New Zealand delegate,”, substitute “or an employee,”.

#### **326 Subsection 20(3)**

Repeal the subsection.

#### **327 Subsections 183(5) and (6)**

Repeal the subsections.

#### **328 Subsections 209(1A) and (1B)**

Repeal the subsections.

#### **329 Subsection 214(1)**

Omit “(1)”.

#### **330 Subsections 214(2) and (3)**

Repeal the subsections.

#### **331 Paragraph 223(1)(ba)**

Repeal the paragraph.

#### **332 Subsections 223(1A) and (1B)**

Repeal the subsections.

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**333 Subsection 224(3A)**

Repeal the subsection.

**334 Subsections 227(6) and (7)**

Repeal the subsections.

**335 Section 227AA**

Repeal the section.

**336 Schedule 1 (definitions of *New Zealand Assistant Commissioner of Patents* and *New Zealand delegate*)**

Repeal the definitions.

## Part 19—International Convention for the Protection of New Varieties of Plants

### *Plant Breeder's Rights Act 1994*

#### **337 Subsection 3(1)**

Insert:

*1991 Act of the Convention* means the Act of the International Convention for the Protection of New Varieties of Plants, done at Geneva on 19 March 1991, as that Act is in force for Australia from time to time.

Note: The text of the 1991 Act of the Convention is set out in Australian Treaty Series 2000 No. 6 ([2000] ATS 6). In 2018, the text of a Convention in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).

*Act of the Convention* means:

- (a) the Act of the International Convention for the Protection of New Varieties of Plants, done at Geneva on 23 October 1978, as that Act is in force for Australia from time to time; or
- (b) the 1991 Act of the Convention; or
- (c) any other Act of that Convention determined by the Minister under subsection (1A), as that Act is in force for Australia from time to time.

Note: The text of the Act mentioned in paragraph (a) is set out in Australian Treaty Series 1989 No. 2 ([1989] ATS 2). In 2018, the text of a Convention in the Australian Treaty Series was accessible through the Australian Treaties Library on the AustLII website ([www.austlii.edu.au](http://www.austlii.edu.au)).

#### **338 Subsection 3(1) (definition of *contracting party*)**

Omit “that is a party to the Convention”, substitute “in relation to which Australia has obligations under an Act of the Convention”.

#### **339 Subsection 3(1) (definition of *Convention*)**

Repeal the definition.

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**340 Subsection 3(1) (definition of *PBR*, twice occurring)**

Repeal the definitions, substitute:

***PBR*** means:

- (a) in relation to a plant variety registered (or to be registered) in Australia under this Act—the plant breeder’s right specified in section 11; or
- (b) in relation to a plant variety registered (or to be registered) in another contracting party—a plant breeder’s right, corresponding to the right specified in section 11, conferred under the law of that contracting party; or
- (c) in relation to a plant variety registered (or to be registered) in a foreign country that is not a contracting party—a plant breeder’s right, corresponding to the right specified in section 11, conferred under the law of that foreign country.

Note: The *Plant Breeder’s Rights Act 1994*, as in force before the commencement of this item, contained 2 definitions of ***PBR***.

**341 Subsection 3(1) (definition of *Union*)**

Omit “Convention”, substitute “1991 Act of the Convention”.

**342 After subsection 3(1)**

Insert:

*Act of the Convention*

- (1A) The Minister may, by legislative instrument, make a determination for the purposes of paragraph (c) of the definition of ***Act of the Convention*** in subsection (1).

**343 Paragraph 10(a)**

Omit “the Convention” (first occurring), substitute “an Act of the Convention”.

**344 Paragraph 10(a)**

Omit “the Convention” (second occurring), substitute “that Act”.

**345 Subsection 29(4)**

Omit “3 years”, substitute “5 years”.

**346 Paragraph 43(6)(b)**

Omit “in the territory of another contracting party”, substitute “outside of Australia”.

**347 Subsection 43(8)**

After “contracting party”, insert “, or in a foreign country that is not a contracting party”.

**348 Subsection 43(10) (definitions of *authority* and *territory*)**

Repeal the definitions.

**349 Subsection 43(10) (definition of *variety*)**

Omit “Convention”, substitute “1991 Act of the Convention”.

**350 Application provision**

The amendments made by this Part apply in relation to a grant of PBR in a plant variety on or after the commencement of this item, whether the application for that right is made before, on or after that commencement.

## **Part 20—Other amendments**

### ***Patents Act 1990***

#### **351 Subsection 222(2)**

Omit “, and of complete specifications which are open to public inspection”.

### ***Plant Breeder’s Rights Act 1994***

#### **352 Section 42**

Repeal the section.

#### **353 Subsection 49(2)**

Omit “appropriate”, substitute “to be necessary in the public interest”.

#### **354 Subsection 69(1)**

Omit “, 22(3) or 42(1)”, substitute “or 22(3)”.

## Part 21—Repeals of Acts

### *Patents Amendment (Patent Cooperation Treaty) Act 1979*

#### **355 The whole of the Act**

Repeal the Act.

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*[Minister's second reading speech made in—  
House of Representatives on 28 March 2018  
Senate on 27 June 2018]*

(56/18)

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110      *Intellectual Property Laws Amendment (Productivity Commission  
Response Part 1 and Other Measures) Act 2018*      No. 77, 2018