

Intellectual property protection in Australia

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The following information provides a general guide to intellectual property protection in Australia. The regulatory arrangements can change from time to time and potential investors should seek professional advice and consult the website of the relevant government agency before entering any commitment based on this material.

Australia has a modern and effective intellectual property (IP) regime, which is ranked in the top ten in the world ahead of countries such as the UK, Japan, Hong Kong, Sweden and Taiwan.

Because Australia's IP legislation reflects international best practice, firms operating in Australia have the most comprehensive protection possible; they can invest in R&D and transfer technology and develop new products with confidence.

Australia is a member of important IP treaties, such as the Madrid Protocol, Paris Convention and Patent Cooperation Treaty, which provide a streamlined option for applicants seeking international protection of their IP rights.

In Australia, some IP rights are automatic while others are granted after application and examination against the relevant criteria by government agencies:

- IP Australia administers patents, trademarks, designs and plant breeder's rights with an examination and registration process
- The Attorney-General's Department administers the legislation for copyright protection and circuit layout rights where there is no registration process.

Patents

An Australian patent provides a legal right to stop third parties from manufacturing, using and/or selling an invention in Australia. It may be used to license someone else to manufacture an invention on agreed terms.

Patents are regulated under the *Patents Act 1990*. Generally, patents cover any device, substance, method or process which is new, inventive and useful. Artistic creations, mathematical models, or other purely mental processes without a useful application cannot be patented.

Who administers patents?

Australian patents are administered by the Patent Office of IP Australia.

Patents can be complex and IP Australia strongly recommends consulting a qualified patent professional before applying for a patent. A list of qualified patent professionals is available at: www.psb.gov.au

IP Australia is not responsible for maintaining and enforcing patents — this is the responsibility of the patent holder.



Australian Government
Australian Trade Commission



Different kinds of patents:

There are two types of patents in Australia:

- A standard patent gives long-term protection and control over an invention for up to 20 years. There are various stages to gaining a patent and an applicant can normally expect to receive a reply to a request for examination within about 14 months. If an earlier commencement of examination is required, applicants can ask for expedited examination.
- An innovation patent is a relatively fast, inexpensive protection option, lasting a maximum of eight years, and is designed to protect inventions that are not sufficiently inventive to meet the inventive threshold required for standard patents. IP Australia usually issues a report on a granted innovation patent within one month of receiving the request for examination.

International patent protection

An Australian patent provides protection only within Australia.

World Patents do not exist. Australia is party to a number of international agreements which can reduce the complexity of applying overseas. A person interested in applying for a patent in other countries has two options. They can:

- File separate patent applications in each country. This can be cost effective if it only relates to a few countries
- File a single international application with the World Intellectual Property Organization (WIPO), a specialized agency of the United Nations - www.wipo.int - and select the relevant countries (including Australia).

The application will automatically take effect in those countries but the need to meet the national requirements and costs in each case can be deferred for a significant period. This provides extra time to reassess the value of the invention and its export potential before committing to the high costs involved.

In Australia, IP Australia will issue an international search report for a patent application within nine weeks of receiving the search copy of the international application unless the application is for more than one invention.

Trade marks

A trade mark is used to distinguish goods and services of one trader from those of another trader. This means that someone cannot register a word or words that directly describe the goods or services as a trade mark.

A trade mark can be a word, phrase, sound, smell, shape, picture, aspect of packaging or any combination of these.

The *Trade Marks Act 1995* provides the framework for the protection of statutory rights in trade marks. There may be common law rights in unregistered trademarks.

Distinction between a trade mark and a business, company or domain name

Registration of a business, company or domain name does not in itself provide any IP rights. Only a trade mark gives that kind of protection.

It is important to understand that registering a particular business or company name does not mean the same name will be available as either a domain name or a trade mark. Nor does it give more right to a domain name than anyone else. In fact, business, company and domain names are often best protected when they are also registered as trademarks. Since each system is separate, it is necessary to search all relevant databases to ensure the desired combination of name, trade mark and domain name are achieved.

Trade mark registration

Although trade mark rights may exist without registration, registration establishes those rights more clearly. It can be an expensive and time-consuming exercise to take action at common law for trade mark infringement.

A registered trade mark provides the exclusive legal right to use that trade mark in relation to the classes of goods and services for which it is registered. A trade mark owner may also choose to license or sell their trade mark.

Time limit

Initial registration of a trade mark lasts for ten years. After that time registration can be renewed for successive periods of ten years on payment of the appropriate fee. If a trade mark has not been used by the applicant, or on behalf of the applicant, for a period of three years, another party can make an application for removal of it from the Trade Marks Register.

Who administers trademarks?

Applications should be filed with the Trade Marks Office of IP Australia. This office will examine the application to see if it meets legislative requirements.

Trade mark applications are usually examined within four months or less, however the period of time taken between filing and examination of applications can vary considerably due to significant fluctuations in the number of applications lodged at any given time. Expedited examination can be requested. Note: IP Australia is not responsible for maintaining and enforcing trademarks. This is the responsibility of the trade mark owner.

International trade marks

Australia is a signatory to the Madrid Protocol relating to the international registration of trademarks. The advantages of using the Madrid Protocol system include:

- Only a single international application is required.
- It is in one language: English or French.
- It is filed through the Trade Marks Office of the home country.
- Protection can be sought in up to 81 countries and more countries are planning to come on board.

The Madrid Protocol is not the only way to apply for a trade mark overseas, however, as it is still possible to file an application directly within each country.

Domain Name

The protection of a business's domain name – their internet address – is extremely important for companies.

Domain name registrations are valid globally and cannot be used by any other person or company; however, they do not provide trade mark rights.

Australia's domain names finish with the au prefix, and are registered for renewable two year periods. There are many registration companies to apply to register an internet domain name in Australia. For a complete listing, go to: www.auda.org.au

Designs

Design refers to the features of shape, configuration, pattern or ornamentation which can be judged by the eye in finished products. A registered design provides a legally enforceable right to use, license or sell your design.

Registration of designs is regulated under the *Designs Act 2003*. A design application can be filed containing one design, a single design in relation to many products, or multiple designs provided all the designs fall within the same classification class.

The applicant has six months from the priority date of the application (this is the date which the application was first lodged with IP Australia) in which to decide to register or publish any of the designs in an application.

Registration requirements

To be registrable, a design must be new and distinctive. 'New' means the identical design (or one very similar) has not been publicly used in Australia nor has it been published in a document within or outside Australia.

For example, a design would not be considered new if it had been 'published' on the Internet before the date it was filed (or its priority date, whichever is earlier).

A design is 'distinctive' unless it is substantially similar in overall appearance to other designs already in the public domain.

Design registration is used to protect the visual appearance of manufactured products and is intended to protect designs which are applied industrially rather than a single artistic work (in the latter case, copyright protection would apply). Design registration only covers the appearance of the article and not how it works.

Time limit

The initial period of registration for a design lasts for five years from the date of filing; however, it can be renewed for a further five years. If it is not renewed the registration will cease.

Who administers designs?

Applications should be filed with the Designs Office of IP Australia. They will assess whether the design meets the legislative requirements. Examination normally is completed within four months after lodgement of the application.

IP Australia is not responsible for maintaining and enforcing designs. This is the responsibility of the design right holder.

International registration of designs

Australian design registration provides protection only within Australia. Australia is party to the Paris Convention which can reduce the complexity of applying for design registration overseas. It is possible to apply for a design in a foreign country by following one of two strategies. They are:

- Make a new application in each foreign country as if making an application for the design for the first time — i.e., a normal national application.
- Make a new application in each foreign country within six months of the Australian application and specify the date on which the Australian application was lodged as the priority date of the application — i.e., an application under the Paris Convention.

Plant Breeder's Rights

Plant Breeder's Rights (PBR) are exclusive commercial rights to a registered variety. The rights are administered under the *Plant Breeder's Rights Act 1994*.

In certain circumstances, principally if the breeder has not had a reasonable opportunity to exercise the right on the propagating material, PBR extends to harvested material and, subject to a similar set of qualifications, to products obtained from harvested material.

Exceptions to the breeder's right are the use of the variety privately and for non-commercial purposes, for experimental purposes, and for breeding other plant varieties. A variety can be used for these purposes irrespective of the existence of Plant Breeder's Rights.

Registration requirements

Only new or recently exploited varieties can be registered. A new variety is one which has not been sold with the breeder's consent. A recently exploited variety is one which has been sold with the breeder's consent for up to 12 months in Australia, and for

overseas varieties this limit is up to four years (with the exception of trees and vines in which a six year overseas prior sale limit is permitted).

To be eligible for protection, the applicant must show that the new variety is distinct, uniform and stable. To obtain acceptance of an application and provisional protection it must be established that there is a prima facie case that the variety is distinct from all other varieties of common knowledge. To obtain a grant of PBR the applicant must verify these claims, normally by conducting a comparative growing test which includes the new variety and the most similar varieties of common knowledge.

Time limit

The PBR is yours for a period of 25 years for trees and vines or 20 years for all other plants provided you pay the maintenance fee and obey any conditions that may be placed on the variety. For grants made under the previous *Plant Variety Rights Act 1987* all varieties were protected for 20 years.

Who administers Plant Breeder's Rights?

Applications should be filed with the Plant Breeder's Rights Office of IP Australia. They will assess whether the PBR meets the legislative requirements. IP Australia is not responsible for maintaining and enforcing PBR. This is the responsibility of the PBR holder.

International registration of Plant Breeder's Rights

Plant breeder's rights may be called plant variety rights (PVR) or plant variety protection (PVP) in other countries – however, they are effectively the same.

Australia belongs to the International Convention for the Protection of New Varieties of Plants. There are some 68 member countries of this Convention, including all major industrial countries and our key trading partners.

Generally you have to apply for PBR in each foreign country in the same way as you have to in Australia. Currently, there are two exceptions. For example it is possible to apply for protection in the European Community (EC); this single application provides potential PBR protection in all EC countries (currently 27). Regional protection is also available in 16 African countries that are affiliated under the African Intellectual Property Organisation (OAPI).

Copyright

Copyright protects the original expression of ideas, not the ideas themselves. At the time of creation, copyright protection automatically applies to original works of art, literature, music, films, broadcasts and computer programs. Material is automatically protected from the time it is first written down, painted or drawn, filmed or recorded.

Copyright protection is provided under the *Copyright Act 1968*. Copyright owners are granted exclusive rights to do certain acts with an original work or other subject matter including: communicating online, licensing others in regard to copying the work, performing it in public, broadcasting it, publishing it and making an adaptation of the work. Rights vary according to the nature of the work.

There are a number of 'fair dealing' provisions in the *Copyright Act* which except certain uses of material from infringing copyright. This covers uses of material relating to research or study, criticism or review, and judicial proceedings or professional advice.

Using a copyright notice

Although a copyright notice – © – with the owner's name and date of publication is not necessary in Australia it reminds people that the work is protected, lets people know who owns the copyright and, in certain cases, may be necessary to establish copyright in other countries.

Moral rights

Individual creators have rights called ‘moral rights’, whether or not they own copyright. These are the rights to:

- Be attributed as the creator of their work.
- Take action if their work is falsely attributed as being someone else’s work or is altered by someone else but attributed as if it were unaltered.
- Take action if their work is distorted or treated in a way that is prejudicial to their honour or reputation.

Time limit

Depending on the material and the author of the work, copyright in works generally lasts 70 years from the year of the author’s death or from the year of first publication. Copyright in films and sound recordings lasts 70 years from the date of publication, and copyright in broadcasts lasts 70 years from the year in which the broadcast was made.

International protection of copyright

Australia is a signatory to various international conventions that deal with copyright. Most of the treaties allow for automatic protection, without formalities such as registration. Member states agree to extend the same copyright protection to works first published or created by nationals of other member states as they do to works first published in their own country or created by their own nationals.

Useful websites

For more information about intellectual property protection in Australia, go to:

IP Australia www.ipaustralia.gov.au

World Intellectual Property Organization (WIPO) www.wipo.int

Attorney-General’s Department www.ag.gov.au

Australian Copyright Council www.copyright.org.au

About Austrade

The Australian Trade Commission – Austrade – is the Australian Government’s trade and investment development agency.

Through Austrade’s global network, we assist Australian companies to succeed in international business and attract productive foreign direct investment into Australia.

Austrade is the first national point-of-contact for all investment inquiries. Working in partnership with business and government, Austrade can provide your company with the information needed to establish or expand a business in Australia.

Austrade can also help by connecting you with the right industry and government contacts as well as providing information on investment regulations and government assistance programs.

For more information email info@austrade.gov.au or visit austrade.gov.au

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