

Via Email Onlyconsultation@ipaaustralia.gov.au

21 December 2018

The Commissioner of Patents
PO Box 200
WODEN ACT 2606**Attention:** Sean Applegate**Re: Exposure drafts of the Intellectual Property Laws Amendment
(Productivity Commission Response Part 2 and Other Measures)
Bill 2018 and Explanatory Memorandum to the Amendment Bill**

Dear Sean,

We refer to the Exposure draft of the Intellectual Property Laws Amendment (Productivity Commission Response Part 2 and Other Measures) Regulations 2018 and accompanying Explanatory Statement which were released for public comment on 16 November 2018.

The Institute of Patent and Trade Mark Attorneys of Australia (IPTA) makes the following submissions in connection with the draft Regulations and Explanatory Statement.

About IPTA

IPTA is a voluntary organisation representing registered patent attorneys, registered trade marks attorneys and student members in the process of qualifying for registration as a patent and/or trade marks attorney in Australia. The membership of IPTA includes over 87% of registered patent attorneys located in Australia and it is believed that its members make up more than 90% of registered patent attorneys in active practice in Australia. The membership of IPTA includes registered patent attorneys in private practice as well as patent attorneys working in industry, universities, research institutes and others that practice as barristers. IPTA members represent large local and foreign corporations, SMEs, universities, research institutes and individual inventors. Since 24 February 2017 all Australian patent attorneys have become registered as Trans-Tasman patent attorneys, which also enables them to practice before the Intellectual Property Office of New Zealand. In addition to working with foreign applicants to assist them in obtaining and enforcing their intellectual property rights in Australia and New Zealand, IPTA members also work with clients in Australia and New Zealand to assist them in developing strategies for protecting and enforcing their intellectual property rights in Australia, New Zealand and overseas.

Part 1 - Innovation Patents

IPTA remains of the view that the innovation patent system should not be phased out, but instead should be revised and strengthened to serve the needs of Australian industry. Accordingly, IPTA continues to believe that the provisions relating to the

repeal of the innovation patent system should be removed from the draft Bill, thereby making it unnecessary to amend the Patents Regulations.

Part 2 - Crown Use

IPTA does not have any comments to make in relation to the draft Regulations relating to amendments to the Crown use provisions.

Part 3 - Compulsory Licenses

IPTA notes that the amendments to the Regulations follow on from amendments proposed for the Patents Act 1990 which substitute the current 'reasonable requirements of the public' test with a public interest test. As previously submitted, IPTA believes that the current test is clear and better balances the interest of the Patentee, the public and any party wishing to take advantage of the patented invention. However, IPTA does not have any comments in relation to the draft Regulations which follow from this proposed amendment.

Part 4 - Translations

IPTA agrees that there is currently a lack of clarity in relation the requirements for translations of specifications submitted as part of a request to enter national phase in Australia in respect of a PCT application. IPTA also understands that any requirement to require a verified English translation of the specification at the time of national phase entry would be contrary to Article 27 of the PCT.

While IPTA agrees with the thrust of the proposed amendments to the Regulations, particularly in the way that the Regulations clarify the nature of the translation required for an application to be considered to be a standard patent application in Australian under subsection 29A(1) of the Patents Act, IPTA is concerned about the proposal to remove the requirement for an applicant to submit a verified translation of the specification.

IPTA would prefer IP Australia to introduce a system whereby an Applicant is not required to provide any form of translation at the time of national phase entry, but is provided with a two month period following the filing of the request for national phase entry to provide a verified English translation of the specification. This would bring the practice of IP Australia into conformity with the practices of patent offices of a number of its closest trading partners. If Applicants were still required to provide a verified English translation of the specification then there would be no need for complex Regulation 22.15A. Retaining the requirement for the Applicant to provide a verified English translation of the specification would also remove the need for the proposed amendment to Regulation 13.4(1)(d).

In making these suggestions, IPTA is aware that Applicants filing International applications in languages other than English will be required to submit verified English translations of the specification to the patent offices in the various English language countries in which national phase is to be entered. Accordingly, it will not create an additional burden for the Applicant to provide a verified English translation, or a certificate attesting that a translation previously provided is a true and correct translation. Part of IPTA's concern about removing the need to provide verified English translations of specifications is the wide availability of machine translations of varying quality. Such machine translations should not form the basis of the translation that becomes the formal copy of the specification of the Australian application. We also believe that other documents submitted to IP Australia in languages other than English should be accompanied by a verified English translation.

Part 5 - Delegation

IPTA does not have any concerns in relation to the Commissioner being able to delegate her powers to summon witnesses and require the production of documents to Executive level staff or higher.

Part 6 - Fees

IPTA does not have any comments or concerns in relation to the amendments proposed under this part.

Part 7 – Extension of Time for Acceptance

IPTA does not have any comments to make about the amendments proposed under this part.

Part 8 – Application, Transitional and Savings Provisions

IPTA does not have any comments to make in relation these draft Regulations.

IPTA would be very pleased to provide further information or clarification in relation to any of the submissions discussed above.

Yours faithfully,



Michael J Caine

Vice President and Convenor - Legislation Committee
Institute of Patent and Trade Mark Attorneys of Australia