

INDEX

acts not constituting infringement of trade mark,	status of accepted applications, 505
673	substantive examination and test growing
disclaimers, 678	requirements after acceptance, 504–5
exercising right to use trade mark, 677	variation of application after acceptance, 504
good faith use of a name, 675	APRA AMCOS, 111, 706
good faith use of a sign, 675–6	artistic works
good faith use to indicate purpose, 676	artistic craftsmanship, 60–2
in good faith, 674–5	authorship, 77
non-infringement due to condition or limitation,	buildings, 59
678	copyright, 57-62
registration of similar trade mark by defendant,	defence to infringement of copyright, 160-1
677–8	derogatory treatment, 173
use of trade mark for comparative advertising,	drawings, 58
676–7	duration of copyright protection, 101-2
Advisory Council on Intellectual Property (ACIP)	engravings, 59
review of Crown use of patents and designs,	first ownership rights, 86
422	industrial application of corresponding designs,
review of designs system, 198-200, 216	217–18
review of innovation patent system, 293-4, 355	originality, 67–74
review of patentable subject matter, 308, 320,	paintings, 57
322, 381	photographs, 59
Anti-Counterfeiting Trade Agreement (ACTA),	registration of corresponding designs, 216-17
45–6	sculptures, 58
anti-dilution of trade marks, 654-5	artist's resale rights, 185–8
blurring, 655–6	assessment of inventive step, patents, 356
in Europe and USA, 655–6	commercial success, 363
passing off and, 660-2	common general knowledge, 358-60
tarnishment, 656	expectation of success, 363-5
Anton Piller orders, 694–6	expert evidence tainted by hindsight, 361
application for patent, procedure for	information skilled person could ascertain,
acceptance and publication, 276-7	understand and regard as relevant, 360-1
application, 274–5	long-felt want and its successful solution,
examination, 275–6	362-3
grant of patent, 278	objection to reliance on hindsight, 366
innovation patents, 278-9	obviousness, 356
opposition, 277–8	person skilled in relevant art, 356-8
pre-examination, 275	problem and solution, 365-6
re-examination, 278	secondary factors in obviousness assessment,
application for patent, types of	361-6
Convention applications, 271-2, 283	standard required, 361
divisional applications, 273	assignment of trade marks, 681
patents of addition, 273	certification trade marks, 683
PCT applications, 272-3, 283	collective trade marks, 683
application for plant breeder's rights, 501	defensive trade marks, 683
acceptance, 504	process, 681–3
access to application and objections, 505	.au Domain Administration Ltd, 556
deposit of propagating material, 505-6	Audio-Visual Copyright Society, 111
form of application, 502–3	AUSFTA, 43
objections, 505	Australasian Mechanical Copyright Owners'
priority dates, 503	Society (AMCOS), 111
rejection, 504	Australasian Performing Right Association (APRA),
right to apply, 502–3	111



Australia–United States Free Trade Agreement (AUSFTA), 9, 19, 35, 169, 181–3, 372, 381, 418, 430	international dimensions, 262–3 origins of equitable doctrine, 224–6 public interest in disclosure, 254–8
Australian Communications and Media Authority	relationship to copyright, 262
(ACMA), 39	relationship to patents, 261–2
Australian Competition and Consumer Commission	remedies, 258–61
(ACCC), 112, 135, 589, 683	subsistence of obligations alongside
Australian Law Reform Commission (ALRC)	comparable contractual obligations, 223–4
on design law, 197 review of copyright and digital economy, 38,	See also confidential information
	broadcast copyright, 63–4
93, 109, 143, 166 review of designs system, 197, 206	originality, 74 reform, 46
review of gene patenting, 167, 308, 317, 322,	broadcasts
422	initial owners of copyright, 78
Australian Official Journal of Designs, 202, 339	statutory licences, 107
Australian Official Journal of Patents (Official	unauthorised access to encoded broadcasts,
Journal), 275, 277, 279	100–1
Australian Register of Therapeutic Goods, 281–2,	Budapest Treaty, 288–9, 300, 386
471, 479	
Australian Society of Authors (ASA), 133	certification trade marks, 587–8
Australian uniform dispute resolution policy, 556	assignment, 683
authorship	certification by other means, 590
commissioned works, 83–4	requirements for registration, 588–90
Crown copyright, 84–5	character merchandising, 547–50
duration of copyright protection, 101–2	cinematograph films. See films
exceptions to first ownership, 80–5	circuit layouts, 188–9
first ownership rights, 76–80	duration, 191
joint authorship, 78–9	exceptions and defences, 192–3
journalists, 82–3	exclusive rights, 190
literary, dramatic, muscial and artistic works, 77	exploitation, 191
nature of rights, 85–92	infringement, 191
orphan works, 80	innocent commercial exploitation, 192–3
right of commercial rental, 92	overlap with copyright and design protection 194
right of reproduction, 86–8 right to communicate work to public, 89–91	ownership, 191
right to make adaptation of work, 91–2	remedies, 193
right to make adaptation of work, 91–2	subsistence, 190
right to perform work in public, 88–9	claim construction, patents, 444–5
technological protection measures, 92–101	pith and marrow, 445–6
works created by employees, 81–2	purposive construction, 446–9
works created by employees, or 2	competition and intellectual property law, 704
Beijing Treaty, 44–5	abolition of exemptions, 706
Berne Convention, 15–16, 33, 41–3, 65, 134, 136–7,	per se prohibitions, 704–5
159, 169, 186	rule of reason prohibitions, 705–6
bilateral agreements, 17–18	compilations
breach of confidence, 222–3	copyright, 52
after employment, 249–54	compulsory licences, patents
damages, 260–1	application, 425–8
defences, 254–8	court satisfied conditions exist, 426–7
duration of obligation, 244–6	court satisfied of anti-competitive behaviour,
during employment, 248–9	427–8
elements. See elements of breach of confidence	effect on other patents, 428–9
entitlement, 246–8	international requirements, 430–1
equitable obligations, 244	operation of court order, 429
express contractual obligations, 244	other circumstances for, 429–30



> patented pharmaceutical inventions, 431 authorship. See authorship remuneration payable, 429 British legacy, 31-2 revocation, 429 criteria for protection of creations. See computer programs subsistence, copyright digital economy and online piracy, 38-9 copyright, 52-5 defences to infringement of copyright, 161-2 disability access, 40 validity of patents, 302-3 exploitation of copyright work. See exploitation confidential information, 10-11 of copyright business or trade secrets, 234 fair dealing. See fair dealing, copyright circumstances that import an obligation of film directors' rights, 36 confidence, 235-6 first ownership of copyright. See first disclosure by the confidant, 245 ownership, copyright disclosure by the confider, 244 history in Australia, 30 - 41disclosure by third party after confidence is imposed, 245 infringement. See infringement of copyright encrypted information, 236-7 introduction to, 26-7 justifications for, 27-30 entitlement to confidence, 246-8 overlap with circuit layouts protection, 194 ideas, 230-1 illegal eavesdropping, 237 overlap with design law, 216-18 relationship to breach of confidence, 262 inadvertent acquisition of written confidences, reprographic reproduction, 33-4 inadvertent eavesdropping, 237 resale royalty rights, 37-8 information based on public knowledge and ideas, technological protection measures. See technological protection measures, necessary quality of confidence, 229-35 relative secrecy and public domain, 231-4 copyright law reform, 32-41 springboard principle, 259-60 AUSFTA commitments, 35 surreptitious acquisition through theft or use of CLRC reviews, 34 telephoto lens, 239 digital agenda reforms, 34-5, 92 telephone tapping, 237 Franki Committee, 33-4 verbal confidences, 237-8 future reforms, 46-7, 167 confidentiality. See breach of confidence modernisation, 40-1 contracts, patents Productivity Commission review, 39-40 conditions that are not void, 433 reports since 2000, 34 defence to infringement proceedings, 433-4 Spicer Committee, 33 termination after patent ceases to be in force, WIPO commitments, 35 434-6 Copyright Law Review Committee (CLRC), 34, 53, void conditions, 431-3 84, 111, 166 contributory infringement of patents, 464-5 Copyright Tribunal of Australia, 111-12 infringing uses, 468-73 Crown copyright, 84-5, 102 not a staple commercial product, 469-70 statutory licences, 107 product has only one reasonable use, 468-9 Crown use of patents, 417-18 supplier believes person would put product to acquisition of inventions or patents, infringing use, 470-2 421 - 2supply of a product, 465-8 assignment of inventions to Commonwealth, supply of component parts, 473-4 422 use of product in accordance with instructions exploitation of inventions, 418-19 for use, 472-3 exploitation to cease under court order, 421 copyright, 9-10 for services of Commonwealth or a State, 419-20 natural rights arguments for, 29-30 utilitarian arguments for, 28-9 obligations of Crown, 420 Copyright Agency, 107-11, 163, 187 procedures available to patentees, 420 copyright collecting societies, 110-11 remuneration and terms for exploitation, 420 copyright law administration of copyright licences, 41 review of, 422



Crown use of patents (cont.)	rights of design owners, 209
scope of exploitation right, 419	spare parts, 206
supply of products to foreign countries, 421	visual features of design, 204-5
	design registration, 199-200
damages, 700	certification, 202
breach of confidence, 260-1	duration of protection, 203
copyright infringement, 138	post-registration examination, 203
trade mark infringement, 680-1	priority date, 202
database protection, 7, 14, 43	publication of application, 202
defences to infringement of copyright, 143	request for registration or publication, 201
artistic works, 160–1	requirements of application, 201
commercial research, 167	who can apply, 200
computer programs, 161-2	digital agenda reforms, 34–5, 92
contracting out of copyright defences, 165–7	direct infringement of copyright, 113
educational uses, 159–60	act done on whole or part of copyright work,
exceptions for archives, libraries and key	116–20
cultural institutions, 157–9	activities within owner's control, 113
films, 164	alleged infringing work derived from copyright
format shifting, 155-7	work, 114–16
future reforms, 167	authorisation, 120-31
government uses, 163	liability of internet service providers, 123-31
legal materials, 163	direct infringement of patents, 452–3
organisations assisting persons with a disability,	authorisation, 460–2
160	exclusive right to import invention, 458-9
public interest, 165	exclusive right to keep, 456–8
reading or recitation in public, 163	exclusive right to make patented product, 453-5
sound recordings, 164	exclusive right to use, 455–6
temporary and incidental reproductions, 162-3	liability as joint tortfeasor through common
time shifting, 154–5	design or procurement, 462–4
defences to infringement of design law	parallel importation, 459–60
consent and parallel importation, 214	disability access, 40
Crown use and supply, 214	disclosure without consent, patents, 338-9
overall appearance of a product, 213–14	general grace period, 343–4
'repair' defence, 213	publication before learned society, 340-1
right of repair for spare parts defence, 211-14	showing, use and publication at recognised
defences to infringement of patents, 474–5	exhibition, 339–40
acts for obtaining regulatory approval of	working invention in public for purposes of
pharmaceuticals and non-pharmaceuticals,	reasonable trial, 341-3
479	domain names, 19, 550, 553-6, 561, 618
contracts, 433–4	dramatic works
experimental and research use, 480-3	authorship, 77
prior use of an invention, 475–9	copyright, 55–7
private acts, 479–80	derogatory treatment, 172
use in or on foreign vessels, aircraft or vehicles,	duration of copyright protection, 101-2
475	first ownership rights, 85
design law, 10	originality, 67–74
criteria for protection, 203–9	
definition of design, 203-6	educational lending rights, 194
history, 197–9	elements of breach of confidence, 226-8
new and distinctive designs, 206-9	identification of information with specificity,
overlap with circuit layouts protection, 194	228–9
overlap with copyright, 216–18	information given or received to import an
ownership of designs, 200, 209	obligation of confidence, 235–9
product aspect of designs, 205-6	information with necessary quality of
registration. See design registration	confidence, 229–35
-	



need to show detriment, 242-3 sound recordings, 164 reasonableness of obtaining remedy, 243 exceptions to infringement of design law scope of obligation, 241-2 consent and parallel importation, 214 unauthorised use of disclosure of information, Crown use and supply, 214 239-41 overall appearance of a product, 213-14 See also confidential information 'repair' defence, 213 elements of passing off exploitation of copyright damage or likelihood of damage, 561-2 assignment, 104-5 definition of passing off, 531-2 collective administration, 110-12 compulsory or statutory licences, 106-10 employee inventions, 411-12 duty of good faith, 413-16 educational statutory licences, 107-10 express provisions in employment contract, express licences, 105 412 - 13implied licences, 106 fiduciary duties, 416-17 licences, 105-10 exploitation of patents without infringement employees breach of confidence during employment, exploitation to cease under court order, 421 248-9 remuneration and terms for exploitation, 420 breach of confidence when employment ends, supply of products to foreign countries, 421 exploitation of trade marks copyright over works created by, 81-2 anti-dilution provisions. See anti-dilution of equitable principles of confidence, 252-4 trade marks express terms to control disclosure of indicating connection with owner, 658-60 information, 250–1 owner's interests adversely affected, 660 implied duty of good faith, 251-2 unrelated goods and services, 657-8 enforcement of plant breeder's rights use as a trade mark, 644-5 actions for infringement, 521 use as descriptive term not trade mark, 645-6 jurisdiction, 522 well-known trade marks, 656-7 non-infringement declarations, 521-2 express exclusions from patentability offences and conduct by directors, servants and contrary to law, 381-2 agents, 523 international obligations, 382-3 remedies, 523-4 mere mixtures, 382 unjustified threats of infringement proceedings, plants and animals, 380-1 entitlement to be granted a patent, 401-3 fair dealing, copyright, 143-4 criteria for inventorship. See inventorship access by persons with a disability, 151 criteria for patents criticism or review, 146-8 derives title to invention from inventor, 407-8 dealing must be 'fair', 151-4 patent assigned to a person, 407 parody or satire, 149-51 European Patent Convention, 289-90 permitted purposes, 144 exceptions to first ownership, 80 professional advice and legal proceedings, 149 commissioned works, 83 reporting news, 148-9 Crown copyright, 84-5 research or study, 144-6 works created by employees, 81-2 film directors' rights, 36 films works created by journalists, 82-3 exceptions to infringement of copyright copyright, 62 archives, libraries and key cultural institutions, defences to infringement of copyright, 164 157-9 derogatory treatment, 172 artistic works, 160-1 duration of copyright protection, 102 computer programs, 161-2 first ownership rights, 86 educational uses, 159-60 initial owners of copyright, 77 films, 164 originality, 74 government uses, 163 first ownership, copyright legal materials, 163 authorship and, 76–80 public interest, 165 exceptions to. See exceptions to first ownership reading or recitation in public, 163 Franki Committee, 33-4, 121, 144, 152-3



functions of trade marks, 572

contributory infringement. See contributory
infringement of patents
defences. See defences to infringement of
patents
direct infringement. See direct infringement of
patents
disclosure without consent. See disclosure
without consent, patents
misleading and deceptive conduct, 474
proceedings. See infringement of patents,
proceedings for
infringement of patents, proceedings for, 483-4
non-infringement declarations, 485
relief for infringement, 484–5
unjustified threats of, 485–7
infringement of plant breeder's rights
exemptions from, 520–1
prior use rights, 521
what amounts to infringement, 520
infringement of trade marks
acts not constituting. See acts not constituting
infringement of trade mark
breach of certain restrictions, 671–2
damages, 680–1
groundless threats of legal proceedings, 674–5
internet and, 669–71
no damages for infringement during non-use
period, 680
oral use of trade mark, 662
overview, 644
passing off and, 566
prior continuous use defence, 679
remedies, 680–1
second-hand goods, 668-9
two-dimensional device infringed by three-
dimensional shape, 662
innovative step, patents, 347–8
differences to inventive step, 355–6
level of advance and assessment, 354-5
prior art base and information for comparitive
purposes, 353–4
relationship with novelty, 346–7
statutory requirements, 348-50
time at which innovative step raised, 348
intellectual property
freedom of competition and. See competition
and intellectual property law
nature of, 4
regimes, 11–12
theories of, 4–8
Intellectual Property Competition and Review
Committee, 189, 479
intellectual property law
constitutional issues in Australia, 20–1

infringement of patents



> criminal liability and, 702 inventive step, patents, 347-8 customs seizure and, 702 differences to innovative step, 355-6 diversity and complexity, 8 elements of assessment. See assessment of history in Australia, 19-20 inventive step, patents incentive to create or dissemination, 6 prior art base and information for comparitive internationalisation, 15-19 purposes, 350-3 jurisdiction, 703 relationship with novelty, 346-7 natural or personality rights, 5 statutory requirements, 348-50 property aspect, 5 time at which inventive step raised, 348 protection for investment, 7 inventorship criteria for patents, 403-4 remedies. See remedies invention, conception of the invention or rent seeking, 7 inventive concept, 404 technological change and, 13-14 joint inventorship, 406-7 nature of contribution, 404-6 internal requirements for patent specifications application to end with claims defining investor-state dispute settlement, 18 invention, 394 IP Australia, 199, 268-9, 272, 278, 309, 322, 353, best method, 391-3 494, 524 claims supported by matter disclosed in Designs Office, 199 specification, 395-7 on Hague Agreement, 199 claims to relate to one invention only, 399 clarity and succinctness, 394-5 jurisdiction comparison with fair basis assessment, 398-9 intellectual property regimes, 703-4 consistory clause and fair basing, 397-8 plant breeder's rights, 522 construction of specification, 386-7 evolution of specification and function of keyword advertising, 557-8 claims, 383-4 priority date, 398-9 licences, patents, 422-3 provisional specifications, 387-8 compulsory licences. See compulsory licences, relations to other grounds of invalidity, 387 patents requirement to fully describe invention, 388-91 exclusive licences, 424-5 stages for consideration, 387 non-exclusive licences, 425 statutory provisions for, 384-6 sole licences, 425 time for meeting requirement to fully describe licensing of trade marks, 683-4 invention, 393-4 assignment of licences, 687 International Code of Botanical Nomenclature, 503 financial control, 685-6 international influences on copyright law franchising, 686 ACTA, 45-6 other forms of control, 686 quality control, 684-5 AUSFTA, 9, 35, 43 Beijing Treaty, 44-5 limitations on plant breeder's rights, Berne Convention, 15, 33, 41-3 513 harmonisation of procedures, 18 farmer's rights, 514-16 investor-state dispute settlement, 18 harvested material and products from crops grown with farm-saved seed, Marrakesh Treaty, 44 Paris Convention, 15 516 plurilatural and bilateral agreements, 17-18 other restrictions, 516-17 Rome Convention, 42-3 private, experimental or breeding purposes, 513-14 TRIPS Agreement, 42 Universal Copyright Convention, 42 reasonable public access, 517 WIPO internet treaties, 43 literary works, 50-5 World Intellectual Property Organization authorship, 77 (WIPO), 35 copyright, 50-5 International Patent Cooperation Union, 272 derogatory treatment, 172 Internet Corporation for Assigned Names and duration of copyright protection, 101-2 Numbers (ICANN) first ownership rights, 85 uniform dispute resolution policy, 554-6 originality, 67-74



Madrid Protocol, 689	innovative step, relationship with.
manner of manufacture, patents	See innovative step, patents
application of NRDC principles, 300-2	inventive step, relationship with. See inventive
background to meaning of, 295-7	step, patents
computer-implemented methods, 303-7	non-consensual disclosure, 344–5
computer programs, 302–3	prior art base, 327–8
discoveries, ideas, intellectual information and	prior information made publicly available,
other unpatentable subject matter, 318-20	329–30
genes and biological materials, 307–13	prohibition on mosaics, 337–8
methods of medical treatment for humans,	relationship with secret use, 373–4
313–18	skilled addressee, 328
NRDC case, 297–300	statutory requirements, 324–6
reform proposals, 320	test for anticipation. <i>See</i> test for anticipation,
time at which manner of manufacture raised,	patents
295	time at which novelty is raised, 323–4
Marrakesh Treaty, 44	time at which to construe and read
meta-tags, 556–7	documentary disclosures, 326–7
misleading and deceptive conduct	documentary disclosures, 320–7
Competition and Consumer Act 2010 and, 474	ownership of patents, 408
passing off and, 565–6	assignment, 423–4
patent infringement and, 474	directions to co-owners, 409
misrepresentation, passing off, 544	grant of patent, 410
character merchandising, 547–50	notion of co-ownership, 408–9
confusion and deception and, 544–6	proprietary rights in the patent, 410–11
quality of goods, 547	rights of co-owners, 409
target of representation, 546	ownership of trade marks,
trade origin of goods and, 546–7	583–4
moral rights, 169–71	creation or adoption of overseas trade marks,
basis of, 6	586-7
consent, 178–9	distributorship arrangements, 585–6
Indigenous communal moral rights, 38, 180	first use in Australia, 584–5
limits on, 176–9	persons who can own, 587
performers' rights, 183–5	11.1.1
remedies, 179–80	parallel importation, 40
right of attribution, 171–2	passing off and, 667–8
right of integrity, 172–5	parallel importation, copyright
right to object to false attribution, 175-6	books, 132–3
treatment 'reasonable in all the circumstances',	infringement of copyright, 133-5
176–8	non-infringing accessories to the article, 136-7
musical works	sound recordings, 133–5
authorship, 77	parallel importation, designs
copyright, 57	consent and, 214
derogatory treatment, 172	parallel importation, patents
duration of copyright protection, 101-2	patented products, 459-60
first ownership rights, 85	parallel importation, trade marks, 662-6
originality, 67–74	licences and, 666-7
statutory licences, 107	Paris Convention, 15, 262, 271, 287, 339, 430, 475–6, 688
names, 51–2	passing off, 12
natural rights	anti-dilution of trade marks and, 660–2
as argument for copyright, 29–30	common law and, 530–1
intellectual property law and, 5	comparison with misleading or deceptive
Nice Agreement, 689	conduct, 565–6
novelty, patents, 323	comparison with trade mark infringement, 566
by way of selection, 345–6	effect of disclaimers, 558–60
by way or serection, sas-o	chiece of discinificity, 550 00



> elements of. See elements of passing off express exclusions from patentability. See equity and, 530-1 express exclusions from patentability history of, 530-1 grant of, 278, 410 holistic perspective, 560-1 infringement of. See infringement of patents internet and. See passing off and the internet innovation patents, 270, 278-9, 370 misrepresentation. See misrepresentation, international treaties and conventions, 286-90 passing off inventorship criteria. See inventorship criteria parallel importation and, 667-8 for patents remedies, 566-8 lapsing of, 286 statutory causes of action. See statutory causes licences for. See licences, patents origins of protection, 266-8 of action, passing off trade marks and, 571-2 ownership. See ownership of patents passing off and the internet, 550-1 patent specifications. See patent specification pharmaceutical substances, term extension, Australian cases, 552-4 Australian uniform dispute resolution policy, 280 - 2556 plant breeder's rights and, 524-5 domain names, 551-2 power of patentees, 438-9 keyword advertising, 557-8 priority dates, requirements, 282-4 meta-tags, 556-7 priority dates, role, 285-6 uniform dispute resolution policy, 554-6 priority documents, 283-5 Patent Law Treaty, 290 rationales for protection, 269-70 patent specification Register. See Register of Patents general principles for construction of, 441-4 revocation. See revocation of patents internal requirements for. See internal selection patents, 271 requirements for patent specifications specification. See patent specification role, 441 standard patents, 270 patentees, exclusive rights term of, 279 implied licence on sale, 450-1 types of patents, 270-1 validity. See validity, patents nature of exclusive rights, 449-50 no grant of positive rights, 451-2 withdrawal of, 286 patents for invention, 11, 265-6 performers' rights, 181-3 application procedure. See application for moral rights, 183-5 patent, procedure for plant breeder's rights, 11-12, 494 application types. See application for patent, applications. See application for plant breeder's types of rights assignments, 423-4 assignment, 518 breach of confidence and, 261-2 certain dependent plant varieties, 510-11 essentially derived varieties, 508-10 ceasing of, 286 claim construction. See claim construction, exhaustion of rights, 512-13 patents exploitation of, 518-19 combination patents, 271 general nature in propogating material, 507-8 complete applications, 283 grant of. See grant of plant breeder's rights contracts. See contracts, patents harvested material, 511-12 co-ownership. See ownership of patents infringement. See infringement of plant Crown use of. See Crown use of patents breeder's rights dealings with inventions, general principles, international conventions or treaties, 525 licences, 518-19 development of patent law in Australia, 268-9 limitations on. See limitations on plant breeder's employee inventions. See employee inventions entitlement to be granted. See entitlement to be ownership and coownership, 517-18 granted a patent products obtained from harvested materials, exclusive rights of patentees. See patentees, Register of Plant Varieties, 523 exclusive rights registrability of plant varieties. See registrability exploitation without infringement. See exploitation of patents without infringement of plant varieties



piant breeder's rights (cont.)	inspection and access to, 45/
relationship to patents,	power of patentee to deal with patent, 438-9
524–5	Register of Plant Varieties, 506, 518, 523
relationship to trade marks, 525	registered trade marks. See trade marks, registered
relationship with other intellectual property	registrability of plant varieties, 496
regimes, 524–5	distinctiveness of variety, 498
revocation, 519	meaning of discovery, 497
rights in, 507-13	meaning of selective propagation, 497
subject matter, 496	stability of variety, 499
surrender of, 519	time at which the variety must meet the DUS
technical background of plant breeding, 494-6	criteria, 501
term of protection, 507	uniformity of variety, 499
Plant Varieties Journal, 504	variety has a breeder, 496-7
plurilateral and bilateral agreements, 17-18	variety not exploited or only recently exploited
presumptive validity, trade marks, 633–4	499–501
contrary to Trade Marks Act 1955 s 28, 634	remedies, 694
fraud, 634	account of profits, 700-2
not distinctive when proceedings commence,	Anton Piller orders, 694–6
634–5	breach of confidence, 260-1
Productivity Commission	damages, 700
on compulsory licensing of patents, 422, 427–8	enforcement of plant breeder's rights,
on Hague Agreement, 199	523–4
review of intellectual property arrangements,	enforcement of trade mark infringement
39–41, 80, 133, 143, 166, 294, 355	remedies, 680-1
review of parallel importation provisions, 132–3	groundless threats of legal proceedings,
public interest defences	699–700
breach of confidence, 254–8	interlocutory injunctions, 697–8
infringement of copyright, 165	passing off, 566–8
public lending rights, 194	permanent injunctions, 698–9
published editions	pre-trial remedies, 694–8
copyright, 64, 74	representative orders, 696–7
first ownership rights, 86	removal of trade mark for non-use, 640–2
original owners of copyright, 78	general discretion not to remove, 642
	under Trade Marks Amendment Act 2006,
rectification of trade marks Register, 627	642
aggrieved person, 629–30	reputation of plaintiff
amendment or cancellation by Registrar, 627–9	abandonment of reputation, 543–4
cancellation, removal or amendment, 633	dual ownership, 537–9
contravention of conditions or limits, 630	elements of passing off, 532–4
court order, 629–30	joint ownership of reputation, 536–7
errors and omissions, 630	location of reputation, 534–6
fraud, false suggestion or misrepresentation,	ownership of reputation, 536
636–7	reputation in descriptive words and insignia,
general discretion not to rectify, 635	539–40
grounds for opposition, 635–6	reputation in packaging and appearance,
presumptive validity. See presumptive validity,	540–2
trade marks	reputation in personality, 542–3
registered owner at fault, 637–40	reputation of marketing image, 542
trade mark becoming generic, 631–2	revocation of patents
	fraud and false suggestion or misrepresentation
use likely to deceive or cause	489–92
misrepresentation, 637	
Register of Patents contents, 436–7	lack of entitlement, 488–9
	parties to litigation proceedings, 492
evidence, 438	statutory provisions, 487–8
false entries, 437	Rome Convention, 42–3



Screenrights, 111	names, 51–2
secret use, patents, 372-3	originality, 67–74
grace period, 379	recorded in material form, 64
meaning of secret, 374	subject matter, 49–50
meaning of use, 374-6	subject matter other than works, 62-4, 74
onus of proof, 378	tables, 52
rationale, 373	titles, 51–2
relationship with novelty, 373-4	works, 50–62
use for purpose other than trade or commerce, 378	Substantive Patent Law Treaty, 290
use for reasonable trial or experiment, 376-7	
use occurring in confidential disclosure, 377-8	tables
use on behalf of government, 378	copyright, 52
signs and exploitation of trade marks	technological change
goods or services for which trade mark	intellectual property law and, 13-15
registered, 652-3	technological protection measures, copyright, 36-7,
likelihood of deception or confusion, 653-4	92–4
relevance of defendant's conduct, 649-50	aiding and abetting in circumvention, 96-7
relevance of plaintiff's trade mark's reputation,	anti-circumvention, 94–9
650–2	circumventing an access control TPM, 94-6
substantially identical or deceptively similar to,	criminal actions, 98
647–9	defences to liability for criminal actions, 99
use to distinguish goods and services, 646-7	providing a circumvention service, 97-8
signs as trade marks	rights management information, 99-100
colour, 578	unauthorised access to encoded broadcasts,
definition, 575-6	100-1
intent to use, 579–81	test for anticipation, patents
objective test of intention, 580	anticipation through prior use, 334-5
packaging and shape, 576-8	general principles, 330-4
scents, 579	implict disclosure and inevitable outcome, 335-7
sounds, 578–9	titles, 51–2
unconditional intention to use, 579-80	trade mark applications, grounds of opposition to
use by others, 580–1	registration, 619–20
sound recordings	application made in bad faith, 625-7
copyright, 62	geographical indications, 623–5
defences to infringement of copyright, 164	prior reputation of another trade mark, 620-2
duration of copyright protection, 102	relationship with honest concurrent and prior
first ownership rights, 86	continuous user, 622
infringement of copyright, 133-5	trade mark applications, identical or similar to
initial owners of copyright, 77	existing trade marks, 607
originality, 74	closely related goods and services, 613
statutory licences, 107	context of comparison, 610–11
Spicer Committee, 33	deceptive similarity, 608–10
statutory causes of action, passing off, 562	global assessment, 613–14
application of legislation, 562-3	honest concurrent user, 614–16
engage in conduct, 563	prior continuous user, 616–17
in trade or commerce, 563	similar goods, 611–12
misleading or deceptive conduct, 563-5	similar services, 612–13
subsistence, copyright, 49	substantially identical with, 607-8
artistic works, 57–62	trade mark applications, requirements at
Australian connection, 65–7	examination of, 592–3
compilations, 52	applications identical or similar to existing trade
computer programs, 52-5	marks. See trade mark applications, identical
dramatic works, 55–7	or similar to existing trade marks
literary works, 50–5	business names, 617–18
musical works, 57	colour trade marks, 603–4



trade mark applications, requirements at voluntary recording of interests and claims, examination of (cont.) 687 - 8deceptive or confusing trade marks, 605-7 traditional knowledge distinctiveness through use, 599-600 intellectual property aspects, 46 TRIPS Agreement, 42, 287-8, 570, 590 functional shapes, 600-3 geographical indications for wine, 618-19 graphical representation, 594 anti-dilution of trade marks, 654 inherent distinctiveness, 595-9 circuit layout protection, 189 national signs prohibition, 593 enforcement of intellectual property partial inherent distinctiveness, 599 agreements, 16-17 prescribed signs, 593-4 express exclusions from patentability, 382-3 protection for particular industries, 619 on compulsory licensing of patents, 430-1 protection of sporting events, 617 protection of confidential information, 262 - 3scandalous matter, 604-5 use contrary to law, 605 trade marks, registered, 12-13 uniform dispute resolution policy acts not constituting infringement. See acts not Australian, 556 ICANN, 554-6 constituting infringement of trade mark assignment. See assignment of trade marks Universal Copyright Convention (UCC), 42 certification trade marks. See certification trade validity, patents collective trade marks, 590, 683 concept of invention, 294-5 defensive trade marks, 590-2, 683 contrary to law or generally inconvenient, definition, 575 distinguishing goods and services. See goods internal requirements for patent specifications. and services, distinguishing by trade marks See internal requirements for patent exploitation of. See exploitation of trade marks specifications functions of. See functions of trade marks manner of manufacture. See manner of grounds of opposition to registration. See trade manufacture, patents mark applications, grounds of opposition to novelty. See novelty, patents registration statutory requirements, 292 history, 570-1 threshold quality of inventiveness, 366-70 infringement. See infringement of trade marks two-tier system, 292-4 international treaty obligations, 688-9 utility, 370-2 licensing of. See licensing of trade marks Viscopy, 111 ownership of. See ownership of trade marks passing off and, 571-2 World Intellectual Property Organization (WIPO), rectification of Register. See rectification of trade 16, 35, 689 marks Register broadcast copyright, 46 registration process, 574-5 intellectual property aspects of traditional relationship to plant breeder's rights, 525 knowledge, 46 removal for non-use. See removal of trade mark internet treaties, 43 moral rights protection for audiovisual requirements at examination of application. See performers, 183 trade mark applications, requirements at proposed Substantive Patent Law Treaty, examination of 290 signs as. See signs as trade marks Washington Treaty, 189 types, 587 World Trade Organization (WTO), 689