



Managing IP in the Australian Government

AUGUST 2022



What is intellectual property (IP)?








The Australian Government is a major investor in the creation and development of intellectual property (IP) through its many activities in science, health, education, public infrastructure, information technology, defence, and arts and culture.

- intellectual property, very broadly, means the legal rights which result from intangible activity in the industrial, scientific and artistic fields
- intellectual property is the property of your mind or proprietary knowledge
- this can be an invention (new and novel, distinct method, mechanism, device, chemical, drug) trade mark, design, copyright, brand or description of your idea
- copyright results from expressing your idea (not the idea itself). Copyright provides the owner with the exclusive and assignable legal right for a fixed number of years, to print, publish, perform, film, or record literary, artistic, or musical material
- applying for an IP right to protect your ideas can be critical if you want to protect these assets, defend against infringers, assign, license, sell the IP, and build a business presence.



What are the **types** of intellectual property?

TYPE	PURPOSE
 <p>Trade mark</p>	<p>Protects the name, letters, signature, logo, device, colour, shape, and sign.</p>
 <p>Copyright</p>	<p>Protects a literacy, computer program, databases, plays, films, scripts, website content, performance, architectural plans, schematics, music, sound records, publications, novels, choreography, and photos.</p>
 <p>Patents</p>	<p>Protect new and novel inventions (i.e., pharmaceuticals, mechanical inventions or processes, and medical devices).</p>
 <p>Designs</p>	<p>Protects the way products look (i.e., new chair design, pattern, fashion garment).</p>
 <p>Others</p>	<p>Trade secrets, confidential information, domain names, circuit layouts, plant breeders rights, geographical indications, privacy.</p>



How is intellectual property managed in Australia?



The Intellectual Property Principles for Australian Government Entities (**the Statement of IP Principles**) provides a policy for the management of IP by Commonwealth non-corporate entities covered by the Public Governance, Performance and Accountability Act 2013.

WHAT ARE THE IP PRINCIPLES THAT AGENCIES MUST ADHERE TO?

Efficient management	An agency's IP assets should be managed efficiently, effectively and transparently to ensure the maximum benefit and usage of these assets for the benefit of the people.
Compliance	Agencies should have in place internal procedures to ensure that all relevant agency personnel are made aware of and comply with IP laws, and respect the legal rights of IP creators, owners and licensors and all other people who have legal interests in IP, including moral rights under the Copyright Act.
Determining ownership and existing licences	Before using IP material, agencies should check if they own IP, and if not, check whether their proposed use of the IP is permitted under an existing licence with a supplier, IP owner/licensor or collecting society.
Whole of government agreements	Before procuring or acquiring a licence to use IP, agencies should check if whole of government IP licences or other arrangements are in place for that class of IP.
Defining ownership and rights	Agencies should ensure that IP ownership and rights are clearly addressed where relevant in their agreements and other commercial arrangements.
Deciding on ownership	Where an agency procures, commissions or funds the creation of new IP, the agency should consider whether the agency should own the IP, or alternatively, obtain sufficient licences for that IP to enable the agency to achieve its objectives, having regard to all relevant factors.



Sharing and disseminating IP	Agencies are encouraged to share and publicly disseminate IP material which they own where it is appropriate to do so.
Restrictions that may apply	Agencies wishing to share or publicly disseminate IP material should first consider whether any third party IP rights, personal information, confidentiality, security or sensitive classification or other restrictions apply.
Commercialisation	Agencies may commercialise their IP material on terms which are consistent with the agency's legal powers, purpose and strategic priorities and in accordance with all relevant policies on dealing with State assets.
Identification and recording	Agencies should maintain appropriate internal processes and systems to identify, record and manage any business-critical or strategically valuable IP (including any IP that has high public value) that they own, control, or use.
Protection of IP	Agencies should take appropriate steps to protect the agency's business critical or strategically valuable IP (including any IP that has high public value) where there is a net benefit in doing so.
Branding	Agency branding and marketing materials must comply with Government policies on use of State insignia, government-owned logos, publication style guides and business and domain names.



10 ways Holding Redlich can help:



- 1.** Protect each agency's IP assets including trade marks, copyright, patents and designs.
- 2.** Advise on confidentiality, trade secrets, privacy, and data protection.
- 3.** Manage and record each agency's portfolio of IP assets including assignment or sale of IP rights.
- 4.** Prepare documentation to ensure agencies are complying with relevant IP legislation.
- 5.** Advise in relation to legal issues such as clearance of third party rights for use in agency materials, licences and other aspects of IP compliance.
- 6.** Oppose infringing IP assets in opposition to each agency's IP.
- 7.** Obtain permission to use other's IP for agency projects.
- 8.** Identify potential risks in proposed commercialisation projects.
- 9.** Advise on Crown copyright and Creative Commons.
- 10.** Enforce IP rights when a breach has occurred.



About Holding Redlich

Holding Redlich's reputation for delivering excellent results for our clients has developed over 40 years.

Our consistent growth has seen us become one of Australia's top 20 law firms.

We are committed to providing innovative commercial legal advice utilising our resources and expertise of more than 500 staff, including over 160 lawyers and 74 partners, across offices in Melbourne, Canberra, Sydney, Brisbane and Cairns.

We act for a number of Australia's largest public and private companies, addressing some of their most complex and important business issues.

We provide our clients with legal, commercial and strategic solutions founded on our legal and industry experience.

Holding Redlich's industry focus means that our people are connected to their clients and the communities in which they live and work, with strong political, commercial and cultural networks.



We maintain our reputation as one of Australia's leading law firms across various key areas of practice, including:

- Administrative Law
- Competition & Consumer Law
- Construction, Infrastructure & Projects
- Corporate & Commercial Law
- Dispute Resolution & Litigation
- Finance
- Immigration Law
- Intellectual Property
- Leasing
- Mergers & Acquisitions
- Planning, Environment & Sustainability
- Privacy & Data Protection
- Private Client Practice
- Pro Bono
- Property, Planning & Development
- Tax Risk, Dispute Management & Litigation
- Technology, Media & Telecommunications
- Regulatory
- Royal Commissions & Commissions of Inquiry
- Workplace Relations & Safety.

Above all else, we understand that our job is to look after our clients and their best interests. Integrity and trust are at the core of our relationships with them.

This singular focus on our clients is a hallmark of the firm.



Key contacts



Blair Beven
Partner *Sydney*
T +61 2 8083 0386
blair.beven
@holdingredlich.com



Elizabeth Carroll
Partner *Canberra*
T +61 2 5115 1601
elizabeth.carroll
@holdingredlich.com



Blair Beven

PARTNER SYDNEY

T +61 2 8083 0386 / blair.beven@holdingredlich.com

Corporate & Commercial Law, Intellectual Property

EXPERTISE

Blair has over 18 years' experience in the area of Intellectual Property (IP) in Australia and New Zealand. He is widely regarded as a preeminent expert in trade mark and patent law.

Blair was named as a highly recommended lawyer for Intellectual Property in The Legal 500 Asia Pacific, 2019.

In 2013, he founded the Australian office of New Zealand's largest IP firm and managed a team of over 20 IP professionals.

Blair regularly advises a diverse client base including food and beverage, skincare and cosmetics, entertainment, media, IT, fashion, finance, and celebrity endorsements.

His clients include start-up ventures, individuals, celebrities, and small to medium companies. More recently, Blair has worked with the commonwealth government to devise a global branding strategy and filed trade mark applications in over 120 countries.

Blair currently manages over 2000 trade marks in Australia and overseas and represents the IP interests of over 250 clients.

Blair's expertise includes:

- trade mark creation, availability and registrability
- global trade mark protection strategies
- enforcing IP rights (trade marks, designs, copyright, patents)
- licensing of trade marks
- copyright matters
- patent enforcement strategies

- breach of confidence matters (including data theft and breach of confidential information)
- IP litigation, including appearing in the Supreme Court of NSW, the Federal Court of Australia and before IP Australia.

EXPERIENCE

Blair has significant experience in trade marks, copyright, design, and patent strategies. While his specialisation is mainly trade marks, he also has experience in all forms of IP litigation including trade mark infringement, patent litigation and breach of confidence matters.

Blair's experience includes:

- protecting the trade mark of a well-known Australian skincare brand in over 120 countries involving over 400 individual trade mark applications
- protecting the trade mark of an Australian IT company in 45 countries in multiple classes of goods and services
- protecting the name of a high profile fashion retailer from inception
- protecting the celebrity name of a well-known Australian supermodel
- negotiating publishing rights for an Australian celebrity chef
- negotiating the joint venture and protection of IP rights with a large US television network
- opposing and defending multiple trade mark applications at IP Australia
- appearing before the Federal Court in 2018 a patent infringement suit involving two innovation patents (involving Bluetooth technology)



- appearing before the Supreme Court of NSW in a breach of confidence matter involving the sale of an accountancy business
- appearing before the Federal Court in a breach of confidence matter involving the employee theft of over 300,000 customer names
- protecting the new First Nations trade mark in Australia and globally for the Australian Federal Government
- appearing before the Federal Court in a patent suit involving the appeal from a patent office decision
- currently appearing in the Federal Circuit Court against the International Olympic Committee on an appeal of a trade mark hearing decision
- currently appearing before the Supreme Court of NSW on a complex confidentiality breach and trust issues
- currently appearing before the Federal Circuit Court on an appeal of a trade mark hearing decision
- currently appearing before the Federal Court on three major trade mark infringement matters against three respondents.

QUALIFICATIONS

Master of Laws (Hons) (Intellectual Property and International Law) – Victoria University of Wellington

Bachelor of Laws – Victoria University of Wellington

Bachelor of Arts (Psychology, Sociology) – Otago University

Legal Practice Management Course – College of Law

Admitted as a Barrister and Solicitor of the High Court of Australia

MEMBERSHIPS

Law Society of New South Wales

New Zealand Law Society

Intellectual Property Society of Australia and New Zealand (**IPSANZ**)

International Trade Mark Association (**INTA**)
Committee member for INTA Enforcement and Oppositions





Elizabeth Carroll

PARTNER CANBERRA

T +61 2 5115 1601 / elizabeth.carroll@holdingredlich.com

Administrative Law, Data & Privacy, Government, Regulatory

EXPERTISE

Elizabeth is an award-winning lawyer with over 20 years' experience, specialising in public and administrative law. She regularly advises on statutory interpretation, privacy, freedom of information, litigation, legislative drafting, compliance and regulatory issues. She has an in-depth understanding of the needs of government clients, having successfully led the legal teams at three Commonwealth agencies, most recently as Chief Legal Counsel at IP Australia. She enjoys giving back to the community through her current role as President of the ACT Law Society and brings particular expertise relating to professional standards and probity matters. Elizabeth has a strong track record of client service and delivery on innovative legal projects, supporting clients to harness the benefits of technology while addressing privacy and accountability issues.

Elizabeth received the ACT Law Society's Government Law Award in 2016. In 2020 she was named General Counsel of the Year in the Lawyers Weekly Women in Law Awards, and Government Lawyer (as well, her team was Government Team of the Year) in the Lawyers Weekly Corporate Counsel Awards 2020.

Elizabeth was also included in Australasian Lawyer's In-house Leaders List 2020, and was listed in Managing Intellectual Property Magazine's 50 Most Influential People in IP in 2019.

EXPERIENCE

Elizabeth's experience includes:

- advising on IP rights legislation and managing litigation in the Federal Court and High Court regarding cutting-edge issues, such as the capacity to patent ideas created by AI
- acting as Deputy Registrar of Trade Marks and managing litigation within the Trade Marks Tribunal and Design Tribunal
- advising on the Outcomes Based Directions Project which involved the first application of amendments to the IP legislation allowing use of AI in decision making, including implementing a governance framework, drafting supporting legal instruments and assessment against the legislative requirements
- advising on Smart Trade Mark, a blockchain initiative which creates a digital fingerprint for trade mark owners to prove the authenticity of products exported around the world. The Project won three Innovation Awards and is the basis for the National Rugby League's "Trust Badge" used on its official merchandise
- providing legal support to TM Link, an internationally-linked trade mark database used by IP offices and researchers around the globe. This database is a world-first data product instigated and hosted by IP Australia, working with international partners
- advising on open data projects such as IPGOD (Intellectual Property Government Open Data), IPGOLD (Intellectual Property Government Open Live Data) and IPNOVA (Intellectual Property Neural Open-data Visualisation and Analysis)



- advising the Trans-Tasman IP Attorneys Board and Disciplinary Tribunal on professional standards, Code of Conduct and privacy issues including a review of the Trans-Tasman Attorneys Regime
- conducting reviews of decisions in relation to the National Competitive Grants Program for the Australian Research Council
- providing advice on the Agricultural and Veterinary Chemicals Code Act 1994 (Cth) and the Agricultural and Veterinary Chemicals (Administration) Act 1992 (Cth)
- managing AAT and Federal Court litigation regarding registration of agricultural and veterinary chemicals
- developing and implementing the Australian Pesticides and Veterinary Medicines Authority's Compliance and Enforcement Strategy and chairing the agency's Enforcement Committee
- advising on the Water Act 2007 (Cth) and the Murray-Darling Basin Agreement
- coordinating the preparation of the Basin Plan 2012 (Cth)
- managing the Murray-Darling Basin Authority's (MDBA) defence of the *Lee and Gropler v Commonwealth and MDBA* High Court constitutional challenge to the Water Act 2007 (Cth)
- advising the MDBA on procurement, contracts and grants relating to scientific and economic research
- acting for the Department of Finance and Department of Defence on various Federal Court litigation and probity matters
- providing specialist advice on the Northern Territory Emergency Response during its initial implementation
- acting on over 15 complex AAT and Federal Court social security appeals
- representing News Limited/Michael McKinnon of The Australian newspaper in High Court of Australia proceedings relating to the Freedom of Information Act 1982 (Cth) including acting as instructing solicitor during the proceedings
- acting for Airservices Australia on over 25 native title proceedings and advising on interpretation of the Native Title Act 1993 (Cth).

QUALIFICATIONS

Master of Laws – University of Sydney

Bachelor of Laws/Bachelor of Arts – Australian National University

Graduate Diploma of Legal Practice – Australian National University

Interpersonal Dynamics Program – Stanford Graduate School of Business

Company Directors Course – Australian Institute of Company Directors

APPOINTMENTS

Executive Member, Law Council of Australia, 2022–present

President, ACT Law Society, 2020–present

Director, Law Council of Australia, 2020–2021

Vice President, ACT Law Society, 2018–2020

Government Law Committee, ACT Law Society, 2018–2021

Councillor, ACT Law Society, 2017–present

Australian Pro Bono Centre Inhouse Steering Committee, 2020–2021

Australian Research Council Appeals Committee, 2019–2020

Chair, Australian Government Legal Network (AGLN), 2015–2019

Board member, AGLN, 2012–2019

MEMBERSHIPS

Australian Institute of Administrative Law





CONTACT US	MELBOURNE Level 8 555 Bourke St Melbourne VIC 3000 GPO Box 2154 Melbourne VIC 3001 T +61 3 9321 9999	CANBERRA Level 7 Canberra House 40 Marcus Clarke St Canberra ACT 2601 PO Box 1568 Canberra ACT 2601 T +61 2 5115 1600	SYDNEY Level 65 25 Martin Place (formerly MLC Centre) Sydney NSW 2000 GPO Box 4118 Sydney NSW 2001 T +61 2 8083 0388	BRISBANE Level 1 300 Queen St Brisbane QLD 4000 GPO Box 490 Brisbane QLD 4001 T +61 7 3135 0500	CAIRNS Level 1 Cairns Corporate Tower 15 Lake St Cairns QLD 4870 PO Box 4766 Cairns QLD 4870 T +61 7 4230 0400
-------------------	---------------------------------------------------------------------------------------------------------------------------------------------	--------------------------------------------------------------------------------------------------------------------------------------------------------------	-------------------------------------------------------------------------------------------------------------------------------------------------------------	----------------------------------------------------------------------------------------------------------------------------------------	-------------------------------------------------------------------------------------------------------------------------------------------------------