

TMDCG - notes from 2 November 2020 meeting (virtual)

Chaired by Bronwen Shelley (Paula Adamson on secondment to Department of the Prime Minister and Cabinet).

1. Introduction and overview

Unexamined TMAs - way higher than planned - stockpile sitting over 17,000

Domestic filings up 31% on last year - grown exponentially over time of pandemic but international filings down 4%

Low trainee attrition, many nearly qualified and anticipate 8 new examiners and an increase in productivity

Design filings tracking to plan

Hearings - last quarter - 34 decisions - average time to decision is 13 weeks - meets Charter service commitments.

New fees introduced on 1 October - new fee structure for hearings depending on how heard

Examination timelines

11.4 weeks for national applications / 19 weeks for international applications

Headstart = 2 days

Designs - 21% compliance

Madrid - continue to prioritise = 30% of stockpile - go to delegated examiners

Additional contact number on examination reports - direct call to group of experienced examiners

Indigenous Knowledge

Subject matter expert group established - new communication materials and review of guidelines

Consult in early 2021 on potential changes - including advisory panel and new ground to refuse application that offensive

Extensions of time

Streamline process continued until 30 November 2020 - decision will be made whether to cont.

3082 COVID extensions sought

2516 for TMs

Receive 450 - 500 per month

COVID helpline

For Small medium AU business - 1-3 contacts per week usually via email

Not advice / information and guidance

2. Action items

2020-1-A2 - Addresses for service - need to be valid - have any examples to share?

2020-1-A3 - Cantarella - Heath Wilson - dealing with matters on case by case basis - keep open

2020-1-A4 - use of "featuring" - no change in official practice - close

2020-1-A5 - see item 3.3 - close

3. Transactional Digital Services (TDS) - Josh

Replacement of e-services - currently in use for renewals

New B2B channel APIs for larger firms - feedback - easy to integrate

Testing new applications for designs with real customers - want to improve whole process not just file upload - expect deliver into beta by 13 November - initial release MVP - limited - no agent functionality as for owners to use - want agents to jump in and have a play around - next 3 - 6 weeks expect much more functionality

By Christmas release MVP for TM filings - if want to get involved in testing contact Josh - testing commencing this month

No threshold for attorney testers but limited spots - see <https://www.ipaustralia.gov.au/beta> and contact the team directly at MDB-TDS@ipaustralia.gov.au to participate in trial.

Running eServices (legacy) until at least July 2021

4. Designs Reform Project - Lana Halperin

What has been done:

Research 80+ interviews

Economic study

Survey of rights holders and broader design industry - recent applicants and also broader industry

- Four reports - <https://www.ipaustralia.gov.au/beta/designs-review/Research>
- IP Report 2020 - chapter 7 - https://www.ipaustralia.gov.au/sites/default/files/reports_publications/2020_ip_report_0.pdf - page 38
- Article in IPSANZ "Intellectual Property Forum" - https://www.ipaustralia.gov.au/sites/default/files/ipsanz_journal_121_september_2020.pdf -
- Information pack on website - <https://www.ipaustralia.gov.au/beta/designs-review/next-steps>
- IPRIA event (11 Nov) and Melbourne Design Week (Mar/Apr 2021)
- Contact email: MDB-DRP@ipaustralia.gov.au

Key findings:

Design activity much larger than what is protected

Value to economy AU\$67.5 billion per year

Awareness is low and system difficult to use

Now what?

Access to design protection

Legislative proposals - e.g. grace period

Protection of virtual and parts of products i.e. partial designs - harmonization with trading partners

Protection for designs in iteration

Certainty in registration and certification hybrid process - remove two-step process? Move to substantive examination

Access to the right information

Education and awareness initiatives - awareness in design community low - publications and working with peak industry bodies

Update IP AU materials resources and webs content related to design rights

Includes covering engaging with IP professionals

Access to the online filing system

Key frustration - uploading images

Poor quality compared with design filings platforms in other countries and other IPAU platforms

Designs filing priority as part of TDS program

5. Update of Policy and Legislative activities - Paul Gardner

Good feedback on design consultation - have made some changes - see consultation hub - <https://consultation.ipaustralia.gov.au/>

Hope bill introduced early in new year:

- Grace period
- Licensees bring infringement
- Streamline application process

High priority policy development - partial and virtual designs

Iterative designs - unregistered designs not first option - ACIP / Productivity Commission. Look at possible models over next few months + consultation

Two stage process - move to mandatory examination? Will look at benefits / costs

Whether AU will join Geneva version of Hague Agreement is not subject of active consideration. May consider in future.

6. Registered Trade Marks and Border Enforcement protection - Rodney Jeffs (AU border force ABF)

If register TM there is something that want to protect but does not seem that message getting across - have only 620 registered notices of objection with ABF and a total 40,000-45,000 registered trade marks on books

If no notice - no authority to seize and hold goods

Assume not much local manufacture of counterfeit goods

Plea to put a notice in place - free service - 2 page form

Have some ex-officio powers but if don't know what looking for hard to exercise

Goods seized - if forfeited to crown - destroyed - but often many small consignments and cost of consignments being destroyed covered by importer's cost of those that get through

If not forfeited then civil matter for brand owner to bring

Infringement notification scheme - if counterfeit - issue infringement notice = fine of \$2,500 - can issue notice per item compared with consignment

Not issue infringement notice (INS) at front end as up to brand owner to take action

7. FTA update - Charlotte Iggulden

EU FTA

8th round in Sept - next in Nov - meeting virtually

Issues - designs / GIs / pharmaceuticals

Designs - Hague / unregistered / longer term of protection (25 yrs)

Well known marks still on the table

UK FTA

Launched in June - 2nd round September

Text based negotiations

UK has strong ambitions on designs - Hague / unregistered designs / increased term of protection

3rd round December 2020

UK signalled that keen to join CPTTP - go beyond existing agreements

RCEP

Concluded late 2019

Signing by end of year

No amendment to IP law necessary

8. GI consultation - Brendan Bourke

June 2018 - FTA with EU

Agree to protect GIs - make changes to GI process - not agreed that will change registration framework - government made no commitment.

If create new right will be within TM Act - make it work in AU context

EU wants to go beyond TRIPs Article 23

Holding virtual round tables - two more this week

Consultation closes 30 November then whole of government consultation lead by IPAU

9. Hearings Update - Heath Wilson

Heath moved from quality assessment to Hearings (as Bronwen covering Paula's absence during her secondment)

Average time to issue decision - pretty good

No drop in oppositions due to COVID - expecting growth further down track as hearings volume usually moves with TM filings

All hearings virtual

No hearings Dec 20 / Jan 21 - deal with stockpile - decisions on written record.

IPAU and hearings officers been involved in GI public objections

COVID extensions

25 appeals before court

General review to identify process improvements - external review

Fee changes - new structure for fees to be heard:

- \$400 initial fee - for written subs or on the papers
- \$600 video / phone
- \$800 in person

If no party requests hearing IPAU still needs to issue decision but is of low priority and suggests parties not interested. IPAU attempt to address this stock pile (around 150 cases) in Dec/Jan

10. Other business

Assessment of certification rules

Andrew Shannon - can be inconsistencies - good to have brought to their attention - not assess content of rules but check that have met requirements under section 173. Must publish rules as soon as can - publish abstract and may ask for further information to accessibility reasons (text to speech).

Andrew Shannon - maybe inappropriate use of the word "assessment" - not making assessment in terms of Consumer Law.

Bronwen to invite ACCC at our next meeting.

11. Next meeting

March 2021 - virtual for now but will be in person if possible