

IPAU TMDCG meeting 30 March 2021

Chaired by Acting Manager of Trade Marks

Office update

Gavin Phillips - new projects - TM and Designs policy

TM trends

Expected downturn in filings but has been year on year growth. Growth 12.5% compared to Feb 20

Stockpile of 13,460 unexamined TMs - half compared to year ago. First reports within 13 weeks

2021 - Consolidation - 6 new examiners recruited and in training. Plans to on-board 21 new examiners in next financial year

Design trends

6% year on year growth in examination requests. Slightly behind service commitment

Three new examiners and 3 more in next financial year

Hearings

79 decisions, 5 design decisions.

Ongoing Hearings review.

Customer service charter

TMs - 85% examined in 13 weeks - just got there in March / 95% examined in 18 weeks - since Nov 20

Designs - increased demand / staff retirement / recruitment and training slow down process so not meeting service charter but expect to be within coming months

Madrid examination - continue to prioritise - 13% of filings - had been a significant decline but has picked up.

Indigenous Knowledge

Specialist examination group - treated with cultural sensitivity - see manual

Extensions of time

COVID extensions to end at end of March - new process from 1 April 2021.

Approx. 4,900 extensions for TMs and 101 for designs granted since streamline process in place.

Minutes

Updated with names and numbering

Domestic Policy & Legislation update including an update on the Broader Designs Initiatives

Paul Gardner

Designs Bill passed Feb 21 with bipartisan support. Requires Royal Assent and then in force 6 months after Royal Assent. Next sitting in May - also budget sitting. Have new Minister - not sure how that will play out.

Ramila Clugston

Two information packs published on website - working very closely with design community - industry bodies and academic institutions

Comprehensive audit of design content on IPAU website and refreshing designs examination manual

Consultation indicates that design registration does not protect where designers see the value: 1) protection for designs as they iterate, 2) protection for virtual products, and 3) parts of products. A fourth issue relates to inherent confusion and lack of knowledge and certainty in the two-step application process.

IPAU is taking a human centred design approach - possible considerations:

- Preliminary protection period - give designers more time to iterate and suit businesses that are cash poor
- Chain of applications - flexible but more expensive
- Virtual and partial designs - working with Swinburne University - looking at other jurisdictions e.g. CN, JP, CA, US - engaging with businesses

Paul Gardner

Trying to assess size of problems around 1) partial designs and how to search and 2) two-step process - does this require education or legislative amendment?

Feedback from group - two-step process not a problem for sophisticated users - they understand different countries have different processes. If self-filers have a problem look at education. Suggestion that could change nomenclature - confusion that registered but not enforceable - but what change to? FICPI has done some work in this area

T&PP FTA and Indigenous Knowledge update

Edwina Lewis

Indigenous Knowledge

Consultation until 25 May - online survey or written submissions.

Attempting to actively engage with indigenous people around the country - setting up discussion groups around the country and one on one meetings. Had seminar - will release recording

FTA update

With UK and EU

UK - 4th round held March - IP discussing proposals esp. around enforcement - some progress with general provisions for TMs and patents - ongoing discussion around GIs

EU - 9th round in Nov/Dec / 10th round March - some more text agreed - continuing discussions around GIs - possible new GI right - had series of consultations with AU stakeholders - Sean Applegate dealing with possible new GI right

Submissions welcome on either FTA

Discussion - UK has strong interest in GIs - seek AU to protect list of GIs. EU requirements front of mind and UK discussions at early stage.

UK list hived off from EU - UK have large number of GIs protected - taken similar approach to GIs as EU - expect AU to protect much longer list than originally proposed.

Law Council volunteered to provide support on any provisions and asked whether it is possible to see draft text update since July 2018 version. AU government not generally disclose draft text but DFAT (Foreign Affairs and Trade) open to having detailed discussions with stakeholders - happy to share contact details of lead negotiator - open to discussion about progress.

Transactional Digital Services update

Josh Burns

Rebuild front facing transactional channels - nearly there - replace e-Services as of 30 June 2021. 60% uptake of new channel - feedback very strong and positive. E-Services since 2012 - at end of life. Completely delivered new applications across all rights.

Discussion on application of S41

Lead by CG member - important that manual up to date and correct.

Canterella specified a two part test - issue with the first limb - what is ordinary signification - not certain how this is ascertained.

Believe that examination manual takes far too severe line esp. for geographic names. Time to have a review of examination manual

Another member raised issues with section 41(3) and also want to clarify when also objection under s 43 (likely to deceive/cause confusion).

Another member raised that no s41(4) examples

IPAU agreed to look at manual and review - asked for written submissions from members.

Issuance of Draft Minutes

Member complained about late issue of minutes of meetings.

IPAU accepted that minutes been late. Confirmed that they should be issued within 3 weeks of the meeting.

Other Business

Ceasing of PDF Journal and replace with ATMS Journal

IPAU had planned to cease publication of Journal and rely solely on ATMS.

Following submissions from member IPAU will postpone ceasing of Journal - to provide detailed response in coming days.

Feedback from members

New look for examiner's manual - not as easy to search or find things. Also can't download full chapter that was easy to search. IPAU response - big migration project - will look at it - aware bit of work to do there.

Full list of acceptable goods in a particular class has been removed. IPAU response - old tool taken down as security issue. Same issue raised internally. Currently looking at it. Prior tool needed to be decommissioned.

Continuing delay of processing of hearing documents esp. SGP and evidence and what happens if no party pays a decision making fee. IPAU response hearings office recently gone through a review. SGP identified as bottle neck. Hired more staff and looking at improvements. Do have stockpile - getting through it and making improvements.

If no hearing fee paid - won't be given same priority as case when fee paid - will be decided - decision will have to be made. If not request hearing that is an indication to office that not a priority.

Legal advice being given by examiners to self-filers - suggested some changes after looking at applicant's website / suggest non-use action filed. Will provide more detail and make submissions.

Concern about webinar series IPAU ran last year - infringement strategy and dealing with cease & desist letters. IPAU response - understand fine line between advise and advice

TM withdrawn when under opposition when manifestly inadequate examination. IPAU response - if IPAU made mistake then acceptance should be revoked. IPAU is looking at whether should review examination once opposition filed as part of the oppositions and hearings review.