

IPAU TMDCG 21 October 2021

Kelly Sims - new General Manager, chaired meeting. Ms Sims has been in this role for 7 weeks.

Attendees:

Amelia Irive, Andrew Shannon, Brett Doyle, Bronwen Shelley, Chris Atichian, Gavin Phillips, Heath Wilson, John Braybrooks, Kim Duong, Meilin Buba, Melissa Delfino, Michael Handler, Nicole Stawski, Richard Hoad, Rohan Wallace, Sidney Gray, Vjekoslav Bradaric, Ian Drew, Alera, Anne Makrigiorgos, Belinda Saunders, Tania Duthie, Edwina Lewis, Sydney Gray, Elena Szentivanyi

There have been a number of other staffing changes including:

Bronwen Shelley is now Chief Legal Counsel for IPAU

Rob Crispe is now General Manager of the Patent Oppositions, Business Improvement and PBR Group.

TM trends

12,000 unexamined TMAs

Average of 11 weeks to first report compared with 2.8 business days for head start application

Aug 21 - hired 10 more examiners

Advertising now for new round of hiring for New Year - we were asked to promote - concerned about "the great resignation" and higher rates of attrition.

100+ TM decisions - average of 10 weeks from hearing to issue of decision

Designs trends

In last year filings 7% higher than planned and examination requests up 29% than planned

Other updates

IPTA and Law Council made submissions on Journal issue - IPAU met with them - IPAU seeking legal opinion and will get back to IPTA and LC

Planning IP Thought Leaders symposium

Dispute Resolution project - contact IPAU if you wish to be involved

EOTs - ongoing impacts of effects of COVID - EOTS considered on case by case status - require declaration - see sample on website

Designs manual to be update early 2022 regarding grace period - see website about new instrument

Minutes

To be circulated within 3 weeks.

There was a request that articulate acronyms at least once.

Action items

Ordinary signification / s 41 examples - have workshop - John Braybrooks at IPAU happy to do this with IPTA / LC / INTA - concentrate people's minds

Jade website - updated more quickly than previously - close issue

International Policy update - Tanya Duthie

Design Law Treaty - impasse since 2014 - issue around disclosure of Traditional Knowledge

Cooperation agreements with EUIPO - AU Designs now included in EUIPO Design View

Pivot focus in ASEAN to consistency in TM examination - TM quality management systems

Working on customer enhancement of Madrid applications - high rate of irregularities plus promote online training modules via WIPO IP Academy.

Designs policy update - Paul Gardner

ACIP Designs Act - received Royal assent 10 September 2021.

Education materials coming especially regarding grace period - only applies to disclosures after 10 March 2022.

More to come - re partial, virtual and iterative designs - public consultation 2022 - see policy register

Hague Agreement - AU to make all reasonable efforts to join if FTA agreement ratified

Confusion around difference between registration and certification - both is the default - help text should describe difference. This will change with new legislation.

Indigenous Knowledge and FTA update - Edwina Lewis

IK - finished 3 month consultation period on 4 topics - will publish report shortly including next steps

- Patent disclosure - support for this
- Indigenous advisory panel - lots of support - panel needs to have authority - need support as won't be expert on everything
- Consultation and consent for use of IK - consent not straightforward
- Certification / labelling - mixed response depending on industry - some support for certification for food

IPAU welcome promotion and awareness raising through our networks

EU FTA - round 12 with EU mid Nov - bridge a number of gaps - continue to discuss GIs - looking at cost implications. If agree to GIs will need new GI Right. Will only agree if agreement in AU's interests. Expect that there will be automatic protection in AU of EU list of GIs. Compare with SG - but not have agricultural market access issues. Look at CA and JP outcome - reflects outcome we can expect to see. After Brexit UK GIs withdrawn from EU FTA. See [DFAT website](#) for more information.

Designs second highest priority in IP chapter - AU already agreed with UK to make all reasonable efforts to join Hague - will meet some of EU's concerns.

UK FTA - in principal agreement on [DFAT website](#) + bespoke GI scheme to come.

TMO practice on trade marks containing references to COVID - John Braybrooks

See paper for (not real life) examples - only 37 applications in total - 2 registrations and 24 pending applications. Members said that they would prefer real examples. Also need to consider device marks.

IPAU asked that members provide feedback.

Other business from members:

Oppositions and hearings

Concern about length of evidence

Response from Heath Wilson - streamlining process - nothing off the table - conscious that lack of extensions might impact on quality of evidence - it is a balancing act.

Also need to look at how SGPs are dealt with

Interpretation and application of case law

Need more training for examiners

Journal

When have response to written concerns? IPAU waiting for advice. Will then have follow up meetings.



AGENDA ITEM 2.4
MEETING OF: 21 Oct 2021

FOR PRESENTATION

Trade Marks Office practice on trade mark applications containing reference to COVID

PURPOSE: Invite input from TMDCG members in development of examination practice on trade marks containing references to COVID.

BACKGROUND:

In June 2020, the Registrar of Trade Marks developed a practice to address the use of references to COVID in newly filed trade mark applications. This was to reflect the concerns of the Australian community as expressed to Government. The aim of this practice was to prevent inappropriate commercialisation and stop traders trading off the shock, fear and devastation caused by the virus as the pandemic spread.

The Registrar decided to take a conservative approach by erring on the side of caution to ensure that no trade marks that inappropriately referred to COVID proceeded to acceptance. Essentially this practice resulted in taking s42 (scandalous) objections against many marks which contained a reference to COVID. This was in addition to any other objections that were deemed necessary.

It is of course not unusual for the Registrar to step in from time to time and develop a practice to address the filing of marks which are deemed to be of significant concern to the community. Noting that the results of any decisions in exam can be taken to a hearing in the office and then appealed to the courts if necessary.

Recently our COVID practice has started to raise a few questions from customers and members of the profession who believed the Registrar was being a little too conservative. Although this was an appropriate practice to put in place at the time, we believe it is now time to review it.

Proposed Practice


S41 – The word COVID is an abbreviation for Corona Virus Disease. It is a description of a virus. Its appearance in a trade mark will be treated as a descriptive reference and grounds for rejection will be taken accordingly.

S43 – If a trade mark contains a connotation in it that is likely to deceive or cause confusion, s43 grounds for rejection will be taken. This applies to all trade marks including those containing the word COVID. This may be an issue for a range of reasons including if the trade mark contains false information that is likely to be a health risk.

S42 – All trade marks must be examined against the provisions of s42. If a trade mark contains the word COVID in a manner that is likely to be highly offensive, this will generate the need for s42 grounds for rejection.



Examples for discussion purposes only

Trade mark	Specification	TM Approach
COVID Kills Indians	Entertainment services	s42 – This is arguably true - but linking COVID with race in such a way is not acceptable.
COVID=WUHAN	Clothing	s42 - Any reference to the origin of COVID is both extremely sensitive and extremely hard to substantiate. It is not the sort of thing that should be referenced in a trade mark. It is likely to be seen by some as racist and some as factually wrong. It is offensive enough to warrant s42 objections.
ONE SHOT COVID Vaccine 	Information services	s42 - Linking this false and confusing statement to a picture of a handgun is likely to be so offensive as to warrant s42 objections. s41 – An indication that a single COVID jab is all you need to be vaccinated against COVID is not only untrue according to present health advice - but it is also descriptive.
ZYGO Medical – COVID PASSPORTS	Medical Services	s42 – The presumption is that ZYGO is a Medical Centre entitled to own trade marks. However, linking that to the idea of a “passport” is problematic. At present the idea of a passport is in its infancy and is often linked to concepts discrimination coercion and inequity.
COVID - it’s no more than a cold	Information services	s43 – This is an opinion that goes against approved medical advice. Such a comment is essentially a spreading of mis-information. This is serious enough to be considered deceptive and confusing. s41 – A descriptive phrase that is reasonably commonplace – although on the advice of the Chief Medical Officer incorrect.
HOT STUFF - the heat pack that kills COVID 19	Medical products	s43 – Accepted health advice indicates that heat does not kill the virus so this statement is mis-descriptive. s42 – Not required as although this statement is false it is not so shocking as to be deserving of a s42 objection.
COVID ELIMINATION CLEANER – CEC	Cleaning preparations	s41 – Such a claim is one that others may wish to adopt for their cleaning products.
COVID 123 – advice for you and me	Health advice on COVID	s41 – Purely descriptive. Slightly humorous but not scandalous or misdescriptive.



COVIDAVOIDANCE	Information services	S41 - everyone should be able to promote their services as services to help you avoid COVID.
COVID Rules!	Information services	s41 - a phrase which may have a number of different meanings - but one of them is purely descriptive.
RHINOSAURAS REX – COVID GUARD	Masks	No objections – Although COVID GUARD is a description that is not registrable on its own, the combination of the elements comprising the mark is acceptable.
To COVID or not to COVID - that is the question	Board games	No objections - a fairly meaningless reference based on a famous Shakespearian quote

Action required

Please provide comments which will be considered as IP Australia finalises its practice.

ATTACHMENTS: NA

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FOR INFORMATION

Dispute Resolution Streamlining Project Update

PURPOSE: To inform the Trade Marks and Designs Consultative Group on the progress of the Dispute Resolution Streamlining Project (DRSP).

BACKGROUND: IP Australia conducted a review of the Trade Marks and Designs oppositions and hearings processes in April 2021. The review highlighted opportunities to streamline and simplify these processes for our customers. The IP Australia Executive have agreed to progress this work further to develop and implement solutions that would provide benefits to our customers and improve their experience during their IP journey. The benefits and outcomes realised from this project will contribute to the achievement of a number of our strategic objectives as outlined in the IP Australia Corporate Plan 2021-22.

The DRSP has been created to carry out this work and will consult with our external stakeholders to determine areas of concern with the current processes and to generate ideas and design solutions. This work will take place during the next 6-12 months. The IP Australia Executive are committed to ensuring effective stakeholder consultation is conducted in order that the newly designed oppositions and hearings processes meet the needs of our stakeholders and deliver benefits for our customers. A Human Centred Design approach will be utilised during consultation which will include virtual round table co-design sessions to develop solutions with members of the IP profession. An email seeking nominations to form a Stakeholder Reference Group to attend these co-design sessions has been sent to relevant stakeholders, with sessions expected to be held in November 2021.

The Small and Medium Enterprise (SME) sector forms a large portion of IP Australia's customer base. The project will seek input from the SME sector through targeted communications to ensure that the solutions designed are fit for purpose. Further consultation on draft streamlined dispute models will take place in March 2022.

ATTACHMENT(S): NA

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FOR INFORMATION

IP Australia Corporate Website Modernisation

PURPOSE: To provide an update on the Customer Value Program (CVP) which will be modernising and re-platforming IP Australia's corporate website. The program expects to deliver a public beta by December 2021.

BACKGROUND:

The CVP is working to improve our customers user experience and online satisfaction by modernising IP Australia's corporate website, streamlining internal business processes, and continuously improving our customer facing systems. The program will enable end-to-end efficiencies for IP rights administration as well as further improve user engagement and satisfaction with IP Australia's online service offerings.

IP Australia's corporate website is often the first interaction customers have with the Agency and is the source of important information related to IP within Australia. Unfortunately, the websites outdated content, poorly performing Information Architecture (IA) and fragmented user experience makes it difficult for customers to easily understand or access information in a seamless, timely manner. In addition, the current GovCMS platform is reaching end of life and will be unsupported by November 2022.

To resolve these issues and ensure IP Australia is well placed to continue providing high quality services to our customers, the Program has begun the development of two new corporate and TTIPA websites, both built on top of a modern Digital Experience Platform (DXP).

From December 2021 IP Australia customers will be able to engage with a new corporate beta website, available in parallel to our existing corporate site. Using an iterative and customer centric delivery approach, the Program will continuously develop and improve the beta website using our best practice content optimisation framework as well as customer feedback gained from user testing and research. By July 2022, the beta website is expected to fully replace the current corporate site, with a new website offering for TTIPA customers also being made available at this time.

The Program is committed to putting customers at the centre of its design and build process. We ask anyone interested in helping us shape the development of our new beta website to express their interest in participating in our upcoming user testing rounds. Feedback mechanisms will also be available as customers interact and engage with the new beta experience.

ATTACHMENT(S): NA

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FOR INFORMATION

HEARINGS PRACTICE UPDATE

Particularising an opposition matter on discretionary grounds

PURPOSE: During an opposition proceeding, certain IP law firms have a practice of including a request in the Statement of Grounds and Particulars ('SGP') that the registration of the Trade Mark be refused on discretionary grounds.

This practice has the potential to create confusion, especially amongst self-represented parties and may unnecessarily delay the efficient resolution of disputes.

BACKGROUND: Under section 52(4) of the Act, registration of a Trade Mark may be opposed on any of the grounds specified in the Act and no other grounds. SGPs must only particularise opposition grounds.

Two examples of wording which set out a discretion of the Registrar of Trade Marks are:

- (1) Registration of the Trade Mark ought to be refused in the exercise of the Registrar's discretion, by reason of the conduct of the Applicant and/or the nature of the Trade Mark and/or of its use and/or on such other grounds as the Registrar or the court, on appeal, may see fit to allow.
- (2) Registration of the Trade Mark ought to be refused in the exercise of the Registrar's discretion by reason of the conduct of the Applicant and/or the nature of the Trade Mark and/or its use and/or on other grounds as the Registrar or the court, on appeal, see fit to allow.

Office position

Since it does not amount to a valid ground of opposition, a Hearing Officer will not consider an SGP worded in this fashion. An SGP may also be found invalid if it contains wording that does not constitute a valid ground of opposition.

IP Australia requests that this information paper be distributed to IP law firms and that relevant firms update their practice accordingly.

ATTACHMENT(S): NA

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