New Zealand Intellectual Property Attorneys Inc

www.nzipa.org.nz PO Box 5116, Wellington 6140

2 April 2026

IP Australia
Discovery House
47 Bowes Street
Phillip ACT 2606

By email to: consultation@ipaustralia.gov.au

SUBMISSION IN RESPONSE TO IP AUSTRALIA PUBLIC CONSULTATION FOR STREAMLINING AND SIMPLIFYING IP REGULATION

We thank IP Australia for the opportunity to provide feedback on the proposed reforms for streamlining and simplifying IP regulation.

We also thank IP Australia for granting an extension of time to 1 May 2026 to provide a submission on proposals 1-3, 6, 8, 9, and this will follow before 1 May 2026.

Please find below our submissions on proposals 4, 5, 7, 10, 11, and 12.

Introduction

These submissions have been prepared by the New Zealand Intellectual Property Attorneys Inc (NZIPA) and are prepared in response to the proposed reforms for streamlining and simplifying IP regulation.

NZIPA is an incorporated body representing a significant number of trans-Tasman patent attorneys registered and practising in New Zealand and who also practice in Australia; Australian registered Trade Mark Attorneys, and IP lawyers resident and practising in New Zealand.

The current membership of NZIPA comprises 195 Fellows, 3 Honorary, 15 Students, 14 Non-resident, 22 Associates and 3 Retired.

Issue

We understand that IP Australia is contributing to the Australian Government's productivity agenda and is proposing improvements to streamline and simplify IP regulation.

We also understand that IP Australia's proposed reforms are intended to reduce compliance burden and provide greater flexibility for businesses by freeing up time that those businesses

spend attending to regulatory processes, thereby allowing more time delivering better products and services.

Section A: Proposals for reform

Proposal 4: awarding costs above the schedule in trade mark oppositions

IP Australia proposes to amend the trade marks legislation to permit the award of opposition costs above the scheduled amount. The power is intended to be modelled on the similar existing powers for patents and designs powers is intended to be used in exceptional cases.

NZIPA supports the proposal to amend the trade marks legislation to permit the Registrar to award opposition costs above the scheduled amount. We note that this power previously existed under the *Trade Marks Act 1955* and that its restoration is overdue. Our support is subject to the following conditions:

- **Consistency with existing patents and designs powers.** The power should be modelled closely on regulation 22.8(1) of the *Patents Regulations 1991* (Cth) and the equivalent provision under the *Designs Regulations 2004* (Cth). The default position should remain that costs are awarded in accordance with the scheduled scale, with departure reserved for cases where the "justice of the case so requires" or where there is "some special or unusual feature in the case.".

- **Exceptional cases only.** The power should be exercised only in exceptional circumstances, including where the scheduled scale provides manifestly inadequate recompense given the complexity or importance of the case or where a party's conduct, whether during or in the lead-up to proceedings, warrants a greater award. Relevant conduct includes making unfounded allegations, unduly prolonging proceedings through groundless contentions, commencing or continuing proceedings for an improper purpose or withdrawing at a late stage after causing avoidable expense to the other party.

- **Opportunity to be heard.** Consistent with regulation 22.8(1) of the *Patents Regulations 1991* (Cth), the legislation or regulations should expressly provide that the Registrar must not award costs above the scheduled amount unless each party has had a reasonable opportunity to make submissions on the question. Any such award should be accompanied by reasons.

- **Compensation and deterrence.** If implemented with the safeguards above, the reform would provide meaningful, albeit partial, compensation to parties adversely affected by unreasonable conduct and would act as a deterrent to vexatious or disproportionate behaviour in opposition proceedings. NZIPA encourages IP Australia to issue published guidance setting out the circumstances in which the discretion will be considered in order to provide certainty for practitioners and self-represented parties alike.

Proposal 5: updating references to the Madrid Protocol, Madrid Regulations and Nice Agreement

IP Australia proposes to amend the Trade Marks Act and Regulations so that existing references to the Madrid Protocol and Regulations apply to the versions as in force from time to time. IP Australia considers that future-proofing would remove the need for ongoing legislative amendments, ensure alignment with international systems, and provide clearer and more accurate legislative references.

NZIPA is in support of the proposal to:

- amend the Trade Marks Act and Regulations so that existing references to the Madrid Protocol and Regulations apply to the versions as in force, and
- amend the Trade Marks Act and Regulations so that the source of the 'class headings' is the Nice Agreement as in force.

NZIPA considers that this would provide alignment and clarity in the legislation, and notes the following in support.

The current point-in-time definition of the Madrid Protocol and its associated Regulations requires the Trade Marks Regulations to be updated every time there is a change, including minor technical changes, to the Madrid Common Regulations at the international level. This creates a persistent and unnecessary lag between changes made at the WIPO level and their domestic legal effect and is a source of uncertainty for practitioners and applicants.

Ambulatory references of the kind proposed would remove this burden and ensure ongoing alignment with the international system as it operates in practice.

This approach is consistent with overseas legislative practice. Singapore, for example, expressly defines the Madrid Common Regulations in its Trade Marks (International Registration) Rules as the regulations adopted under the Madrid Protocol **as replaced, revised or amended from time to time**, precisely the drafting approach now proposed for Australia.

NZIPA recommends that the following additional matters be addressed in implementing the proposal:

- **Notification mechanism**: Even where parliamentary amendment is no longer required, IP Australia should commit to notifying practitioners whenever WIPO amends the Madrid Common Regulations or a new edition of the Nice Classification comes into force to maintain transparency and accessibility.

- **Transitional provisions**: The amending legislation should make clear how the ambulatory references interact with applications pending and registrations made under earlier versions of the relevant instruments.

- **Nice Classification**: NZIPA notes that new editions of the Nice Classification can involve substantive changes to class headings and the allocation of goods and services. A notification mechanism is particularly important in this context given the practical significance of classification decisions for applicants and practitioners.

Proposal 7: correcting trade mark ownership errors

IP Australia proposes to amend the trade mark legislation to allow the Registrar to correct ownership errors before and after registration in defined circumstances (e.g. where entities are closely connected or act in concert) and with safeguards such as advertising changes and allowing affected parties to be heard.

In principle, NZIPA supports the proposal to correct ownership errors made, under prescribed circumstances, when filing a trade mark application.

We understand there are some circumstances where a genuine error is made in identifying the applicant when filing a trade mark application, such as mistakenly filing it the in name of the trade mark agent, failing to file in the relevant group legal entity for a group of related companies (closely connected entities or entities that act in concert), or filing in an individual's name instead of a company.

However, we do not consider this should be used as a mechanism to transfer an application filed in an individual's name to a corporate legal entity that has been created after the application was filed. We consider this should still require an assignment of the application to occur and recorded at IP Australia.

NZIPA consider that evidence or an explanation needs to exist to demonstrate that a genuine error has occurred. Such evidence or explanation(s) should be presented in a Declaration which accompanies the request to correct the error.

NZIPA also considers that provision needs to be made for the request to correct an ownership error to be rejected if there is uncertainty around whether a genuine error has occurred or if the request does not meet the prescribed circumstances noted above. In which case, the application should proceed in the original applicant's name. If that is problematic, then provision maintained for the application to be withdrawn or to become abandoned through failure to progress it.

Additionally, NZIPA consider that the Court should maintain its right to cancel a trade mark registration especially if the Court determines that the error was not genuine when assessed against the provided criteria on the balance of probabilities. This should apply even if IP Australia has made a different determination and allowed for the error to be corrected. Additional facts may come to light in Court proceedings that are not available to IP Australia at the time the request to correct such an error is made.

We also support the safeguards of advertising the change and allowing affected parties to be heard, and mechanisms for the request to be rejected if affected parties have sufficient grounds to prove the error was not genuine.

Proposal 10: introducing a grace period for PBR renewals fees

IP Australia proposes to amend the PBR Act to introduce a 6-month, non-extendable grace period for payment of renewal fees, modelled on patent legislation.

NZIPA supports the proposal to provide for a grace period for PBR, and this aligns and provides consistency between PBR renewals with renewals on other IP rights.

The current rules have harsh consequences for both international applicants that do not fully understand Australian time zones, and smaller rights owners that manage their own renewals and do not have sophisticated reminder systems.

Introducing a grace period for PBRs modelled on the patent renewal grace period, would be a welcome change for those users.

The proposed late fee of $100 per month is reasonable, is not overly onerous for owners that need to rely on the extension but is also high enough to encourage owners to renew the PBR before the deadline, where possible.

Proposal 11: removing herbarium deposit requirements for PBR

IP Australia proposes to repeal the mandatory herbarium deposit requirement for native plant varieties as this is considered to cause delays, add extra costs and provides little practical benefit to breeders working with native species.

We support the proposal for the reasons given in the consultation document, i.e. it would reduce cost and administrative delay and streamline applications.

Proposal 12: closing the attorney re-registration loophole

IP Australia proposes to close the loophole allowing a registered patent or trade mark attorney, to circumvent the disciplinary process by requesting voluntary deregistration, and then later re-registering, without having addressed the complaint.

NZIPA is in support the proposal to close the loophole to prevent a registered patent or trade mark attorney from de-registering themselves.

Patent or trade mark attorneys who de-register themselves and then re-register risk causing harm to clients and damaging the reputation of the profession.

Regarding safeguards, if an attorney attempts to re-register, then the disciplinary process could re-commence. This may be a sufficient enough deterrent for this conduct.

Additional safeguards that may also be appropriate may be similar to those applied to lawyers. For example, and depending on the number and seriousness of offences, safeguards could

perhaps include periods of supervision, prohibition from the patent or trade mark attorney practicing as a sole practitioner.

Yours faithfully

New Zealand Intellectual Property Attorneys (NZIPA)
Nzipa1@gmail.com
Secretary@nzipa.org.nz