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IP Australia
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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 provide submissions on Section A: Proposals 1-3, 6, 8, 9, 13 and Section B: Policy Issues 1-6.

Our submission in respect of Section A: Proposals 4, 5, 7, 10, 11 and 12 was provided on 2 April 2026, and we have not reiterated these here.

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 1: expanding the definition of exclusive licensees for patents

IP Australia proposes to broaden the scope of an exclusive licensee to include:

- licensees who have exclusive rights to exploit some if rights but not all; and
- licensee who has exclusive rights to exploit the patented invention only in parts of Australia.

With regard to expanding the meaning to PBR, NZIPA considers that the meaning of "exclusive licensee" should be consistent across all IP rights, including "authorised users" for trade marks.

While such a development would mean that "partial" exclusive licensees are less disadvantaged, we note that this proposal is inconsistent with provisions in other countries such as the United Kingdom and New Zealand.

The commercial reality is, that it may not only be patents that are licensed, but a license may include other IP rights such as a combination of patent and trade mark rights. There should be consistency across these IP rights to avoid conflicting situations.

Additionally, we point out that licenses are often worldwide licenses. This proposal to expand the definition of "exclusive licensee" may create additional, unnecessary complexity, and confusion for patentees, licensees and their practitioners.

There is also a risk that proposal could result in conflict between the terms of a license and Australia's legislation, including where a patentee is based overseas and a license has been prepared overseas in respect of a product to be launched in Australia.

Proposal 2: shortening oppositions for pharmaceutical patent extensions of term

While NZIPA agrees that any process resulting in long delays is disadvantageous to parties, providing a fair and consistent process is also paramount.

At present, the process is clear. NZIPA are concerned that the levels of flexibility to be afforded may result inconsistencies and result in inconsistent and unclear practice.

Proposal 3: introducing an examination report response system for patents and trade marks

IP Australia proposes to shift from a single long deadline to shorter response-based deadlines, requiring applicants to respond within set timeframes (e.g. 2-months). This proposal would also place a limit on the number of formal responses before rejection procedures commence (e.g. 3 responses).

NZIPA does not support a shift from a single long deadline to response based deadlines, before rejection procedures commence after a set-number of responses (e.g. 3 responses) for both patents and trade marks because this is more consistent with examination processes in overseas jurisdictions such as Europe, Japan, China, and the United States.

We also point out that this proposal is inconsistent with New Zealand. Many applicants have associated businesses and ventures in both Australia and New Zealand and currently enjoy the advantage of examination deadlines being similar in both jurisdictions.

NZIPA is concerned that the proposed example of a set time frame of 2-months to respond to an examination report is far too short and prefers that a single long deadline remain.

We point out that examination reports often involve multiple handling steps and are often communicated from IP Australia to Australian and New Zealand practitioners. This is then communicated by Australian and New Zealand practitioners to an overseas practitioner, before finally being communicated to the applicant.

This process can introduce delays at each handling step meaning the client is already against the deadline by the time the applicant receives the examination report.

Further, the preparation of responses to patent and trade mark examination reports often requires co-ordination of strategy, citations, issues, and examination reports across multiple jurisdictions. In some instances, applicant decisions may require Board approval before proceeding, adding extra hurdles that may disadvantage applicants. Patent applicant could additionally be awaiting scientific results or results from clinical trials to inform decisions and next steps. As such, there are many legitimate reasons for delaying responding to an examination report.

In respect of patents, additional consequences of having too short a timeframe may mean that new prior art may be raised in other jurisdictions, and may need to be addressed after responses to IP Australia are submitted. This could introduce an administrative burden on both the applicant and IP Australia. Further, if new art arises after acceptance of a patent application, applicants may need to request post-acceptance amendments more frequently. Additionally, there be an increase in the number of precautionary divisional patent applications filed to preserve a position.

In respect of trade marks, similar objections are often raised by both IP Australia and the New Zealand Intellectual Property Office due to similarities in law, and the state of each Register.

Further, if the availability and qualifying circumstances of deferment and extensions of time remain unchanged, we consider more use of these will be made with the introduction short examination response deadline. This may result in an increase in the administrative burden for applicants and for IP Australia which we assume is an additional justification for reducing the timeframes.

The introduction of a limit on the number of formal responses before rejection procedures commence (e.g. 3 responses), would further increase the demand and need for requesting deferment and extensions of time.

Often the current timeframe allows for these matters to be resolved, or when required sufficient evidence of progress being made to justify further extensions. The end result is a just and fair result for the applicant without adverse impact on the general public/consumer.

Proposal 6: finalising trade mark oppositions that are not progressing

IP Australia proposes to amend the Trade Marks legislation to give the Registrar the power to dismiss or finalise oppositions where both parties have abandoned the matter and are no longer participating.

NZIPA is in support of a proposal to finalise trade mark oppositions to registration and oppositions to removal from the register for non-use where those oppositions are not progressing, and only when neither party has requested a hearing, requested a decision on the written record (including paying the relevant fees), or requested and obtained extra time.

We also acknowledge that oppositions that are not progressing creates uncertainty for the public who may be awaiting an outcome.

However, we support a proposal of **within 4 months** not within 3 months as we consider this gives adequate time for either party to reconsider the situation and take further action or deduce the proceedings can be finalised.

We point out that oppositions often involve multiple handling steps and are often communicated from IP Australia to Australian and New Zealand practitioners. This is then communicated by Australian and New Zealand practitioners to an overseas practitioner, before finally being communicated to the applicant, and vice versa when further instructions are obtained. This always introduces unintended time delays.

Additionally, any negotiations between the parties may take additional time due to registrations in other jurisdictions, which need to be taken into account when considering a proposed settlement. Again, this can introduce unintended time delays, even if each party is genuinely trying their best to be time-efficient.

Proposal 8: removing the requirement for certificates of verification for trade marks and designs

IP Australia proposes to amend the trade marks and designs regulations so certificates of verification are only required on a case-by case basis, where the Registrar reasonably doubts the accuracy of a translation. This proposed change is intended to provide consistency with the patent system and remove unnecessary administrative burden.

NZIPA supports this proposal.

The present process adds unnecessary burden on applicants and creates unnecessary difficulty and cost for those applicants affected by it.

Proposal 9: expressly allowing virtual marking of products protected by patents, PBR and designs

IP Australia proposes to amend the patents, designs and PBR legislation to expressly provide for virtual marking.

NZIPA is in support of the proposal to recognise virtual marking of products protected by patents, designs and PBR. NZIPA agrees that this may reduce costs while simultaneously providing a modern way to provide up-to date, accurate and accessible information to the public, by removing the need for individual product marking.

Marking may be on the product and/or on the product packaging as it is not always simple or appropriate to mark the product itself.

Proposal 13: removing office attendance requirement for patent attorneys

IP Australia proposes to remove the requirement for a registered patent attorney to be in regular physical attendance at their office and in continuous charge of the patents work undertaken there.

NZIPA supports the removal of the requirements for physical office attendance; however, NZIPA still also supports that employment location requirements do not change.

NZIPA agrees that modern workplace practice often includes a combination of working from the office and working remotely, which can impose compliance costs on patent attorneys.

As noted in the proposal document, professional obligations already exist to appropriately supervise juniors' work, and the requirement to be physically in the office seems to no longer be necessary.

Section B: Issues for further investigation

Policy issue 1: removing the declaration requirement for initial short extensions of time and limiting the time patents can be revived with an extension of time

IP Australia considers that parties seeking an extension of time under section 223 are unnecessarily burdened with the provision of a declaration of the reasons for granting the extension. IP Australia proposes to permit one automatic extension of time for short periods (e.g.

up to 3 or 6 months) per action, before the relevant deadline has passed. This would mean that the applicant would not need to submit a declaration but only pay a fee.

NZIPA is in support of this proposal.

Policy issue 2: reforming patent timeframes

IP Australia proposes to provide a mechanism whereby a third party can indicate their interest in a particular patent application.

Under the proposal, if the mechanism is activated, the applicant is intended to be given the time they genuinely need to resolve the issue (e.g. extensions of time with appropriate justifications, and divisional filing to overcome unity objections would continue to be permitted). However, once activated, IP Australia proposes that flexibilities permitting the applicant to delay for commercial or tactical reasons (as opposed to genuinely addressing the issues raised in examination) would not be available.

Assuming that the proposal relates to examination timelines and based on the mention of unity objections, NZIPA is concerned that applicants may be unjustifiably disadvantaged with the proposal as presented.

We refer to our comments under Proposal 3, above in this regard, and point out that there any many different legitimate reasons for an applicant to delay responding to an examination report.

We also refer to Section 44(3) of the Patents Act, and Regulation 3.17 (1):

Division 1—Examination

44 Request for examination

(1) Where a complete application for a standard patent has been made, the applicant may, within the prescribed period and in accordance with the regulations, ask for an examination of the patent request and specification relating to the application.

(2) Where a complete application has been made for a standard patent, the Commissioner may, on one or more of the prescribed grounds and in accordance with the regulations, direct the applicant to ask, within the prescribed period, for an examination of the patent request and complete specification relating to the application.

(3) Where the patent request and specification relating to a complete application for a standard patent are open to public inspection, a person may, in accordance with the regulations, require the Commissioner to direct the applicant to ask, within the prescribed period, for an examination of the request and specification.

(4) Where required under subsection (3), the Commissioner must give a direction accordingly, unless the applicant has already asked, or been directed to ask, for an examination of the patent request and specification.

3.17 Requirement for Commissioner to direct or expedite examination

(1) For the purposes of subsection 44(3) of the Act, a person may, in the approved form, request the Commissioner to direct an applicant for a standard patent to ask for an examination of the patent request and complete specification under subsection 44(2) of the Act.

(2) If an applicant has asked for an examination of the patent request and complete specification to be expedited, the Commissioner may do so if he or she is reasonably satisfied that:

(a) it is in the public interest; or

(b) there are special circumstances that make it desirable.

We point out that Section 44(3) and Regulation 3.17(1) already provide an opportunity for a person to ask the Commissioner to direct the applicant to request examination. We point out that "a person" also includes interested third parties.

It seems that Section 44(3) already provides sufficient opportunity for a third party to progress an application it may have an interest in, if a third party wishes to do so. Third parties also have additional opportunities to challenge under opposition and re-examination procedures.

The proposed change appears to prioritise the needs of a third party over the patent applicant. The proposed change would be unfair to applicants who may legitimately need such flexibility, particularly when other opportunities are also available to third parties as noted above.

Policy issue 3: streamlining the treatment of applications in respect of more than one design

IP Australia proposes to amend the Designs legislation to streamline and reduce complexity in how applications for more than one design are handled after filing.

In relation to filing multiple designs in a single design application, many New Zealand based practitioners prefer not to use this option as the administrative burden outweighs the benefit of the very small fee reduction.

Specifically, filing an application that then results in multiple application numbers being issued later requires practitioners to match each design with each application number and copy documents across files, etc.

This must be done carefully to reduce the risk that the wrong application number is associated with a design. It is generally easier and less time-intensive for practitioners (and cheaper for applicants) to file separate design applications at the outset.

Furthermore, if formality objections are raised to some of the designs in a multi-design application and not to others, then this is burdensome for practitioners and applicants too. The ability to file multiple designs in a single application does not, in our experience, streamline the application process, or reduce costs.

NZIPA's preference is to file a single design with a single design application.

Policy issue 4: increasing flexibility for filing excluded designs

Section 23 of the Designs Act requires an applicant to amend their initial application before filing an excluded design application and to do so within a prescribed regulatory period. IP Australia proposes to amend the Designs Act to clarify that the order of filing an amendment request and an excluded design application does not matter, provided both occur before the initial application lapses or is withdrawn.

NZIPA support the proposal to amend the Designs Act to clarify that the order of filing the amendment request and the excluded design application does not matter, provided both occur before the initial application lapses or is withdrawn.

Policy issue 5: clarifying exhaustion in the PBR Act

NZIPA is in support of clarifying exhaustion under the PBR Act.

Policy issue 6: clarifying how rights apply where harvested material is also propagating material

NZIPA is in support of clarifying how rights apply where harvested material is also propagating material.

Yours faithfully

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