

Fee Review
IP Australia
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Re Proposed Review of IP Australia Fees 2016/17

We refer to the Official Notice of 3 August 2015 and thank the Fee Review Panel of IP Australia for the opportunity to provide initial feedback on the current fee structure.

1. About IPTA

The Institute of Patent and Trade Mark Attorneys of Australia (“IPTA”) is a voluntary organisation representing registered patent attorneys and registered trade marks attorneys in Australia. The membership of IPTA includes registered patent and trade marks attorneys in private practice along with patent attorneys working in industry, public sector organisations including CSIRO; and universities as well as others that practice as barristers. IPTA members represent many large local and foreign corporations, SMEs, universities, research institutes and individual inventors.

2. Comments on Fee Structure

2.1 Patents

2.1.1 Fees for International-type Search and Preliminary Search and Opinion (Patent Regulations 1991, Sch. 7, items 236 and 236A)

IPTA urges re-consideration of the \$2200 fee which remains excessive for some applicants. The fee, which attracted a number of comments from members in the 2012 review, is more expensive than available from search providers, yet the IP Australia search remains valued for its quality and indication of likely novelty and inventive step objections to patentability.

IPTA understands that other comparable patent offices, for example KIPO and UKIPO at least, have search fees several hundred dollars lower than this. Such services are being used by some IPTA members where IP Australia would presumably prefer that its service be used.

IPTA considers that IP Australia could provide a greater incentive for use of its search services if this fee was reduced.

2.1.2 Excess Claim Fees (Patent Regulations 1991, Sch. 7, items 213 and 222A)

IPTA urges reconsideration of the \$110 per excess claim fee payable at acceptance or on amendment. Some technologies do require more than 20 claims for effective protection and an arbitrary setting of 20 claims before the fee is applicable causes inconvenience and expense. IPTA recognises that other jurisdictions impose the excess claim fees at a lower threshold number of claims but that does not remove the issue of effective protection. It simply indicates that the problem is worse in other jurisdictions.

2.1.3 Amendments to Correct Clerical Errors and Obvious Mistakes between Acceptance and Grant (Patent Regulations 1991, Sch. 7, item 222)

IPTA urges IP Australia to remove the fee for filing a request to amend for purposes of correcting a clerical error or obvious mistake where the request is filed between acceptance and grant. It is common enough that minor typographical errors are introduced in final amendments leading to acceptance. Such inadvertent errors may not be identified until review of the AU-B specification. Allowing a short (3 months or so) window to make corrections, free of official fee, would benefit applicants and be in the public interest because sealing of patents free of errors is a desirable policy objective.

2.2 Trade Marks (Trade Marks Regulations 2004, Sch 9, Items 1, 3, 4, 9-12 and 32-34)

IPTA also urges a reduction of fees applicable to multi-class trade mark applications and registrations. Unnecessary and inefficient compromises in protection are being made through applicants being urged, by the revenue driven nature of the *Nice Classification*, to file in multiple classes even where similar goods and services are concerned. A discount for multiple classes, similar to that offered by trade mark service providers, is appropriate.

2.3 Other

IPTA urges consideration of a discount on fees for “small entities” similarly to that applied in the United States and Canada. More information can be provided on request. This will improve access to Australia’s IP system and it is a question raised by some applicants. IPTA also notes that a concern with innovation patents is that cost is disproportionately borne by small to medium size enterprises. If IP Australia holds that view, presumably extending it to other IP rights as well, a “small entity” fee regime would go some way to addressing that issue.

3. Conclusion

IPTA awaits consideration of the above feedback and the draft Cost Recovery Impact Statement (“CRIS”) for 2016/17. IPTA also seeks the opportunity to discuss any mooted changes in fee structure before these are implemented. IPTA once again thanks the Fee Review Panel for the opportunity to comment before the draft CRIS is finalised.

Yours Faithfully,



Richard Baddeley
Vice President, Convenor of Finance and Secretariat Committee, IPTA