

TRADE MARKS AND DESIGNS CONSULTATION GROUP
10 November 2016
MEETING SUMMARY

The Trade Marks and Designs Consultation Group (TMDCG) was held on Thursday 10 November 2016, below is a summary of what was discussed at the meeting.

The Chair provided an update on Trade Marks and Designs, advising members of recent trends. Members were informed that the July intake of trainee examiners were the first group to use the new Trade Mark Examiner Training (TMET) system. The Chair also advised that IP Australia is on track to release the new search system, “Australian Trade Mark Search”, from January 2017 with an official launch event to be scheduled for February 2017. Our examiners are already using the new system internally and a subscriber list of 250 stakeholders has been established. Feedback on the search system has been positive so far.

TMDCG members were informed that the 11th edition of the NICE classification will come into effect 1 January 2017. Members were also alerted to a recent increase in agents and attorneys incorrectly filing applications. The Chair encouraged TMDCG members to liaise with their representative organisations regarding the number and correct selection of classes on Trade Marks (TM) applications and provide feedback on this issue to the TMDCG at the next meeting.

Corrections made to the Trade Marks register under Section 81 were discussed. Currently these amendments are advertised as corrigenda in the Official Journal with a short description of the amendment. In future, the planned e-dossier for trade marks will expose these service requests more broadly online. Members supported the idea of more information regarding Section 81 amendments being made available for stakeholders via the future TM e-dossier potentially in 2018, and accepted that the corrigenda is sufficient in the interim.

Members also discussed the emerging issue of excessive, irrelevant and/or disorganised material being submitted as evidence for TM oppositions and hearings, and the potential remedies. Members agreed to provide IP Australia with suggestions regarding improving efficient management of evidence for oppositions and hearings by March 2017.

The TMDCG were informed that interstate hearings including hearings at MPEC will be charged the same fee, \$1,200 to cover the hearing officer’s interstate travel. An upgrade to IP Australia’s video conferencing facilities is expected in February 2017 to further reduce the need for interstate travel to attend hearings. Members were provided a snapshot of the experience following the implementation of the Raising the Bar changes.

TMDCG Members discussed issues with Section 19 of the Designs Act 2003 such as uncertainty surrounding the informed user, the interaction of factors at 19(2) and the requirement at 19(1), and considering Newness and Distinctiveness. Members discussed the need for flexibility in the legislation in this developing area. IP Australia would continue to monitor further court decisions and future developments in this area to assess the need for any future changes.

The TMDCG were advised that the IP Laws Amendment Bill would be tabled in parliament soon. Public consultation on this Bill will occur before it is introduced in Autumn 2017. Members were also advised the Single Economic Market work with New Zealand has been successful and implementation of the single trans-Tasman patent attorney regime will commence in February 2017. The Productivity Commission Inquiry Report should be released to the public by February 2017 after which it will be available via the IP Australia website.

The next TMDCG meeting will be held in April 2017.