

TRADE MARKS AND DESIGNS CONSULTATION GROUP
20 April 2017
MEETING SUMMARY

The Trade Marks and Designs Consultation Group (TMDCG) was held on Thursday 20 April 2017, below is a summary of what was discussed at the meeting.

The Chair updated the group on business performance in the Trade Marks and Designs space.

The Chair formally introduced the new Australian Trade Mark Search, launched on 10 February 2017, and welcomed feedback on the search from the profession.

Trade Marks and Designs Group (TMDG) is now training all its new examiners using Trade Mark Examiner Training (TMET). The innovative online competency based training program offers long-term training and coaching to our trade mark examiner trainees through a blend of online self-paced eLearning modules, facilitated one-on-one mentoring/coaching, and peer/collaborative learning. TMDG has transitioned into a new structure to accommodate the TMET training program.

IP Australia also recently engaged Ernst and Young to investigate potential insurance models targeted at assisting Australian small and medium enterprises to defend and enforce their IP.

The TMDCG endorsed an updated version of their Terms of Reference to include a representative of the New Zealand Institute of Patent Attorneys (NZIPA).

The Director of Performance, Analysis, Planning and Reporting (IP Australia) advised members of the proposed changes to the IP Australia Customer Service Charter which would be introduced on 1 July 2017. Members gave feedback and suggestions for further improvement.

The TMDCG was informed that the most recent draft IP Laws Amendment Bill would be deferred until a Government Response to the Productivity Commission Inquiry Report was finalised, which is expected to occur around mid-2017. Members were thanked for their engagement over the summer.

The Chair led a discussion surrounding pre-publication amendments which can be made in the time between filing a Trade Mark application and it being published on the register. The Rights in One (RIO) system, to be implemented for Trade marks by early 2019, will not allow for this as electronic applications will be filed and published almost simultaneously. IP Australia will not accept pre-publication amendments once RIO for Trade marks is introduced. Members were supportive of this change.

IP Australia facilitated discussion of how the timeframes between the filing of and registration of a Trade Mark or Design could be shortened. Consultation Group members provided valuable insights that would be taken into consideration by IP Australia when further investigating this concept.

Members again discussed the increase in attorneys filing applications with incorrectly classified goods and services specifications (eg. sometimes in a single class). All members were surprised at this unsatisfactory practice and supported firm action from IP Australia including contacting senior partners of attorney firms and other procedural initiatives to ensure the correct IP Australia fees were paid before an application was considered by the office.

The Assistant General Manager of Trade marks and Designs Oppositions and Hearings Section presented an updated snapshot of progress following the raising the bar evaluations.

The proposal to issue a direction to require parties to bookmark and paginate evidence in opposition proceedings and to provide an executive summary of evidence was discussed and accepted by members.

The timing and efficiency of Trade Mark and Design hearing decisions being uploaded on AUSTLII was also discussed. Alternative ways of publishing hearing decisions e.g. on the IP Australia website was discussed and changes can be expected to publication of decisions in the next couple of months.

The next TMDCG meeting will be held in November 2017.