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Mr Paul Gardner  
Director Domestic Policy  
IP Australia  
PO Box 200  
Woden, ACT 2606

Dear Paul

**RE: Trade Marks Act and Regulations 1995 - Section 224 and late claim for Convention priority**

We refer to our submission of 30 July 2020.

Following on from that submission, IPTA further requests that consideration be given to amendment of Regulation 21.28 of the Trade Marks Regulations to remove the exclusion relating to late claims for Convention priority.

Under Regulation 21.28 (1)(aa), the filing of a claim to a right of priority under Section 29(1) is a prescribed act and as such is currently outside the application of Section 224. We have reviewed the explanatory memorandum associated with the introduction of this limitations to Section 224 but are unable to discern the policy intent behind this particular exclusion.

Under both the Patents and Designs legislation, it is possible to apply for a late claim to priority and we do not see the rationale for excluding trade mark applications from the same treatment. Removal of this restriction for trade marks would go some way to reducing the differences in the number and types of extensions available between the IP rights, which, according to the information provided on the Policy Register for Policy ID No. 63 "increases complexity and confusion as to which extension is applicable and what evidence is required for supporting the request in a given situation."

Further, as set out in our letter yesterday, in determining whether or not to grant an extension under Section 224 for a late priority claim, the Registrar would be able to exercise his or her discretion in determining where the "balance of convenience" would lie, and whether it is in favour of the public interest or the trade mark applicant in deciding whether or not to grant the extension.

We would be grateful if this issue could be considered together with our earlier submission.

Yours faithfully



**Michael J Caine**  
President  
Institute of Patent and Trade Mark Attorneys of Australia

31 July 2020