

Fee Review  
IP Australia  
PO Box 200  
Woden 2606 ACT  
By email: [FeeReview@ipaaustralia.gov.au](mailto:FeeReview@ipaaustralia.gov.au)

**Re: Proposed Review of IP Australia Fees 2019-2020**

We refer to the Official Notice of 14 March 2019 and thank the Fee Review Panel of IP Australia for the opportunity to provide feedback on the current fee structure.

**1. About IPTA**

The Institute of Patent & Trade Mark Attorneys of Australia (IPTA) is a voluntary organization representing registered patent attorneys and registered trade mark attorneys in Australia. The membership of IPTA includes patent attorneys and trade mark attorneys in private practice, as well as patent attorneys and trade mark attorneys in industry, in public sector organisations, such as CSIRO, in universities, and others who practice as barristers. IPTA members represent a multitude of large local and foreign corporations, SMEs, universities, research institutes and individual inventors.

**2. Comments on Fee Structure**

**2.1 Patents**

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

IPTA urges reconsideration of the \$110 excess claim fee payable on acceptance or amendment after acceptance, and preferably removal of this fee altogether. Importantly, some technologies require more than 20 claims for effective protection and the arbitrary setting of 20 claims before the fee becomes applicable is discriminatory to technologies where more claims are appropriate and causes inconvenience and expense. While IPTA recognizes that other jurisdictions also impose excess claim fees, and sometimes at a lower threshold number of claims, this does not negate the issue of effective protection and even-handedness for differing technologies noted above. It simply indicates that the problem also exists, and may be worse, in other jurisdictions.

**2.1.2 Amendments to Correct Clerical Errors and Obvious Mistakes (Patent Regulations 1991, Sch. 7, item 222)**

IPTA urges IP Australia to consider removing the fee for filing a request to amend a complete specification for the purpose of correcting a clerical error or an obvious mistake. Firstly, this type of correction relates to an error or mistake that was inadvertent. Secondly, it is not uncommon

that minor typographical errors are introduced during amendment of a complete specification in the course of the examination procedure and these errors may not be noticed until publication of the accepted (AU-B) specification. By allowing Applicants to correct such clerical errors and obvious mistakes free of any official fee, a significant barrier to making such amendments would be removed, leading to a reduction of patents being sealed while containing clerical errors and obvious mistakes. This would not only benefit Applicants, it would clearly also be in the public interest for sealed patents to contain fewer clerical errors and obvious mistakes.

## 2.2 Trade Marks

### 2.2.1 Multi-Class Fees (Trade Mark Regulations 1995, Sch. 9, items 1, 3, 4, 9-12, and 32-34)

IPTA urges a reduction of fees applicable to multi-class applications and registrations. Unnecessary and inefficient compromises in protection are being made due to Applicants being urged, as a result of the nature of the *Nice Classification*, to file applications in multiple classes even where similar goods and services are concerned. A discount for applications in multiple classes, similar to that offered in other jurisdictions, would be appropriate.

### 2.2.2 Notice of Intention to Defend (Trade Mark Regulations 1995, Reg. 9.15)

IPTA urges IP Australia to consider introducing a nominal official fee to be paid by the Applicant upon filing a notice of intention to defend an opposition. The rationale for imposing a fee on the Applicant in such a case is to reduce the number of undefended oppositions. Considering that opponents must not only pay a fee to oppose the registration of a trade mark, but that they are likely to incur substantial costs (e.g. in preparing the Statement of Grounds and Particulars) by the time a Notice of Intention to Defend is filed (currently without any fee) after which the onus reverts to the opponent to prepare evidence again at substantial cost, the Applicant is at a significant cost advantage in the early stages of an opposition. Also, the Applicant can withdraw the application at the evidence-in-answer stage without having incurred any costs in the opposition proceedings and it is unlikely that the Registrar would issue a costs order in favour of the opponent in such circumstances. By imposing an official fee on the Applicant upon filing its Notice of Intention to Defend, even if nominal (e.g. equivalent to the opposition fee), this would lessen the imbalance and deter such undefended oppositions.

### 2.2.3 Scale of Costs (Trade Mark Regulations 1995, Sch. 8)

IPTA urges a revision of the scale of costs that may be awarded in opposition proceedings, which currently bears little correlation to the actual costs incurred. This cost scale has not been adequately reviewed since the introduction of the Trade Mark Act 1995. The scale was felt by many to be unrealistic at the introduction of the Act and inflation clearly has eroded its relevance to actual costs further.

## 2.3 Other

IPTA urges consideration of a discount on fees for “small entities”, similar to that applied in the United States of America and in Canada. This would improve access to Australian intellectual property protection for individuals and for SMEs. More information can be provided on request.

-----

### 3. Conclusion

IPTA awaits consideration of the above comments and the draft Cost Recovery Implementation Statement (CRIS) for 2019-2020 which we understand will be available for further feedback.

IPTA looks forward to the opportunity to discuss any mooted changes in the fee structure before these are implemented. IPTA again thanks the Fee Review Panel for the opportunity to make comments before the draft CRIS is finalised.

Yours faithfully,



Philip Gehrig  
IPTA Councillor  
Convener of the Patent Practice and IP Australia Business Relations Committee

16 May 2019