

**International Trademark Association  
Comments to  
the Australia IP Exposure Draft of the  
Intellectual Property Laws Amendment Regulation 2017  
February 17, 2017**

The International Trademark Association (INTA) is a global organization of 7000 trademark owners and professionals from over 190 countries, including 123 members in the Australia. INTA is a not-for-profit membership association dedicated to the support and advancement of trademark and related intellectual property as elements of fair and effective commerce. Founded in 1878, INTA supports global trademark research, policy development, education and training. For more information about INTA please visit [www.inta.org](http://www.inta.org).

INTA greatly appreciates submitting comments on the exposure draft, as we have provided comments on earlier drafts in 2015. Many of our views reiterate concerns expressed in these earlier consultations. We commend Australia for taking the lead on innovative solutions to reduce costs and increase efficiency in office operations. Namely, we note that provisions to allow for “computerized decision making” are cutting edge, though do raise a number of interesting questions for consideration.

Additionally, as mentioned in our previous submission, INTA is concerned about provisions that would set Australia’s trademark practice apart from global harmonization trends. In particular, INTA is concerned about new provisions around extensions of time under proposed s224, and revocation of acceptance under s84.

**Comments to Part 2 – Examination, re-examination and reconsideration: Division 1 - Amendments**

*Items 115 and 116: Revocation of acceptance and registration*

This item provides that the Registrar may revoke acceptance of an application. Section 84A provides that the Registrar may revoke registration of a trademark. Items 115 and 116 introduce new subsections to provide that a revocation of acceptance or registration may be initiated by the Registrar or requested by a person.

INTA does not support the existence of this type of unique revocation provision as it is a practice which is different from most trademark systems throughout the world. INTA strongly supports the harmonization of trademark practice around the globe for the benefit of trademark owners who seek clarity and legal certainty while protecting their rights and protecting consumers of their products and services across different jurisdictions. The revocation provisions introduce a system that is unique and goes against the global trend of harmonization of trademark practice and would create tremendous legal uncertainty.

However, as it appears that the revocation provisions will remain, INTA does support the fact that there is a formal and accountable process to be introduced into the existing revocation provisions. Perhaps the provisions can also include more clarity on the circumstances where these provisions will apply.

*Items 166 and 167: New extension of time provisions*

New section 224B introduces a process for short extensions to provide that:

- similar to the other IP rights, where no objections are filed IP Australia intends to use computerized decision making under the provisions of section 222A as inserted by Part 9 of the Intellectual Property Laws Amendment Bill 2017. If the application meets the requirements of subsection 224A(2) it will be published (in accordance with section 230A) without being assessed by a person. Assessment of the application for extension would only occur if the Registrar chose to review a computerized decision under subsection 222A(4) or if there was a notice of objection filed.
- third parties may object to short extensions within one month of publishing the details of the application.
- if there is an objection, the Registrar must give the applicant and the objector an opportunity to be heard. The general hearing process would apply as currently governed by regulations 21.15 and 21.16 with the relevant fees. This would prevent third parties from manipulating the system to introduce unnecessary delays, yet allow the opportunity to be heard where it was warranted.

New section 224C inserts provisions for extensions longer than three months. This type of request will continue to follow the current process, where a person with the Registrar's delegation will assess the request before advertising it to give third parties an opportunity to oppose it. The Registrar must meet the publication requirement and a person may oppose the grant of an extension within one month of publication. Similar to short extensions, the Registrar must extend the time if the criteria are met, and must refuse to extend the time if the criteria are not met. The Registrar's decision to grant or not grant an extension is to be reviewable by the AAT.

Similar to current subsection 224(4), new section 224D provides that an extension of time may be granted whether before or after the time for doing an act has ended. This will protect owners from the complete loss of valuable trademarks due to missing deadlines. However, the request for an extension of time must be filed within the prescribed period to comply with new paragraph 224A(2)(f). As above for designs, the Registrar must publish the details of a granted extension of time application as the Registrar considers appropriate.

#### INTA Comments:

INTA does not support the changes that are introduced in the new sections 224. The extension provisions are restricted to extensions of the original deadline (the "original day") only and do not allow extensions of the previously extended deadline ("new day"). This restriction means that Applicants who are not sure how long they might require to complete an action will need to apply for more time in an extension request than they may originally need. Should an Applicant be granted an extension of more than two months, then discover that they need more time after more than two months from the original deadline has expired, they will be prevented from seeking that additional time as they are now beyond the prescribed period for filing an extension under s224D. Given the deadline is an acceptance deadline and parts of that time are consumed not just by Applicants but also by Examiners, it is an unjust burden on an Applicant not to be permitted to seek additional time as required.

In respect of s224B as the extensions are dealt with by computer it does not appear to place much administrative burden upon the Trade Marks Office to allow a series of consecutive short extensions of time.

INTA also does not support the fact that extensions under s224B are open to challenge for a period of one month. As this section relates specifically to short extensions of time an Applicant would for much of the requested period be in an uncertain position as to what the status of their application is. This seems to contradict the "streamlined" intention of the provisions.

INTA also does not support the fact that an extension requested under s224B must be accompanied by reasons required for the extension. If the extension request is to be judged by computer, then the reasons

provided would only be relevant when there is a challenge to the extension request. Given there is likely to be a lower level of challenge to requests, the requirement to provide reasons appears to be an unnecessary burden for the majority of cases.

*Item 172: Trademarks (Division 2 – Application, saving and transitional provisions)*

INTA Comments:

INTA does not support the application of the new s224 provisions to Applications which have an application date prior to the commencement of the new provisions. Applicants that are already in the extension period at the time of the commencement of the provisions will be unjustly disadvantaged by the fact that they are suddenly prevented or inhibited from maintaining their application when they are already set on a particular course of action to progress their application which was allowable prior to the change in the provisions.

*Item 397: Computerized decision-making*

INTA Comments:

INTA accepts that computer software may be utilized to address minor formality issues, it is concerned that the introduction of these provisions will eventually see many more substantive actions and decisions being made by computer software. The prospect of fully automated examination presents many issues for consideration and further research.

*Items 435 and 436: Lapsing of applications*

These items amend section 37 to be consistent with the proposed removal from the regulations of ‘easy’ extensions to the acceptance period of a trademark application.

Subregulations 4.12(3) and (4) and subregulations 17A.20(3) and (4) of the Trade Marks Regulations provide for an ‘easy’ extension of time of up to six months to the prescribed period for acceptance of a trademark application. This type of extension does not require the applicant to justify the extension and is in addition to general extensions available under section 224 and deferment of acceptance under section 36.

INTA Comments:

INTA does not support the changes to s37. When these changes are taken into consideration in conjunction with the reduction of the acceptance period, there is an adverse impact on Applicants that have more difficult prosecution cases and will inhibit unnecessarily their ability to respond appropriately to objections raised during examination. The cases which have complex issues tend to take longer to resolve. These complex cases would be penalized by the combination of the changes to s37 and the acceptance period. By contrast the amendment seems to be of little benefit to the small business owners that these amendments were intended to support.

**Comments to Attachment – Schedule 1: Part 2 Examination, re-examination and reconsideration**

*Item 76: Revocation of acceptance of an International Registration Designating Australia (IRDA)*

INTA Comments:

INTA does not support the existence of revocation provisions as it is a practice which is different from most trademark systems throughout the world. INTA strongly supports the harmonization of trademark practice

around the globe for the benefit of trademark owners who seek clarity and legal certainty while protecting their rights and protecting consumers of their products and services across different jurisdictions. The revocation provisions introduce a system that is unique and goes against the global trend of harmonization of trademark practice and would create tremendous legal uncertainty.

However, as it appears that the revocation provisions will remain INTA does support the fact that there is a formal and accountable process to be introduced into the existing revocation provisions.

*Item 78: Schedule fees*

This item introduces new fees for making a request to: revoke the registration of a national trademark; or to cease a protected international trademark. These fees reflect the service being provided to the person making the request. Requests to revoke acceptance of a national application or of an IRDA do not incur a fee. Revocation at this stage is typically necessary due to errors made during the examination stage and so it is not appropriate to charge interested parties to address these.

INTA Comments:

INTA supports the fact that there is no fee for the filing of revocation of acceptance requests given these are often filed as a result of examination errors. However, INTA is concerned that vexatious parties will essentially be able to file revocation requests against every application accepted by an Applicant and thus cause an unnecessary burden on that Applicant in responding to such requests and/or lead to unnecessary delays of that Applicant's applications.

*Items 124, 126, 129 and 131: Extensions for filing a notice of intention to defend*

INTA Comments:

INTA is concerned that the allowance of an extension application to be filed two months after the expiry of the deadline to file the Notice of Intention to Defend will unnecessarily lead to a great deal of uncertainty and may lead to financial loss by an Opponent that makes commercial decisions following the termination of an opposition at this stage. By the time the Notice of Intention to Defend is due to be filed an Applicant will normally already have had two months' notice that proceedings are on foot. The requirements to file a Notice of Intention to Defend are not particularly onerous and the additional time allowed here seems excessive.

*Item 312: Commencement of the Opposition period after acceptance*

This item provides that an opposition to registration of a trademark must be filed within 2 months of acceptance of the application, not of the advertisement of acceptance.

INTA Comments:

INTA is concerned that issues will arise in respect of cases where early acceptance has been granted to cases. Under the current system these cases are accepted but held back from publication to ensure that there are not later filed applications with earlier convention priority claims. This item creates ambiguity around whether an early acceptance will be discontinued or whether the owners of later filed convention applications will be expected to challenge marks before their convention applications are filed.

These comments were prepared by the Asia-Pacific Subcommittee of the Trademark Office Practice Committee and INTA staff. Should you have any questions or concerns, please contact Seth Hays, INTA Asia-Pacific Chief Representative at [shays@inta.org](mailto:shays@inta.org) or +65 6866 3206.