



Australian Government

IP Australia

Best Practice Guidelines for Filing

IP Australia is committed to providing the best possible service to you. We aim to process all correspondence accurately and in the most efficient way possible, in order to ensure that your client's IP rights are secure. With this in mind, IP Australia asks that you follow the guidelines below in order to help us file your correspondence as quickly and accurately as possible.

General lodgement of filings

1. If possible, please lodge your filings before 4pm.

This helps staff carry out processing on the day of receipt. If files are lodged early in the day, staff can contact you on the same day to rectify any problems identified.

Problems may include:

- missing documents;
- declined credit card payments; or
- payment of the incorrect amount.

It is important that IP Australia can contact you quickly to resolve these problems, in order to ensure that your customer's IP rights are not adversely affected. We do everything we can to avoid this occurring but after 5pm it becomes more difficult to resolve problems.

2. When lodging any filing, please ensure:

- a filing (lodgement) schedule is included;
- your credit card expiry date is included on the Payment Options forms;
- associated documents are held securely together with a bull-dog clip or foldback clip. Please do not use staples;
- if you have a Corporate Customer ID number (CCID) it is included on your lodgement schedule and in any correspondence with IP Australia.

For multiple (batch) filings - please ensure a separate lodgement schedule is used for each patent, trade mark, and design lodgement to avoid confusion and delays in processing the filing. Please also supply a lodgement schedule for non-fee filings. If several cheques, or credit card authorities are provided for a large batch filing, please ensure that the individual payments are the same as the amounts on the lodgement schedules ie. one payment to cover all of the trade marks filings. This assists with tracking payments if there is a query.

3. IP Australia does not require confirmation copies of faxes relating to filing of documents.

However if for some reason you wish to file a confirmation copy, it is helpful if confirmation copies are clearly marked so. Please include clearly visible stamping on each page of the document. If payment has already been made via fax, a payment or payment option form is not required with the confirmation copy, only a statement that the payment has already been provided with the faxed filing.

4. Original documents,

as opposed to copies, are only required where there is a specific legal requirement for IP Australia to receive originals. In these cases we will inform you that an original document is required, for example, in the case of statutory



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declarations for oppositions.

Patent Filings

1. Please file patent specifications in the following order for ease of electronic processing: description, claims, abstract, drawings and gene sequence.
2. When filing a patent application, IP Australia no longer requires true copies or multiple copies of abstracts or drawings.
3. When categorising filings:
 - Please start the description with the name of the specific transaction rather than referring to a series of related actions culminating in the specific one being requested;
 - Clearly describe the specific transaction. [Refer to Glossary of Terms attached]
4. If WO numbers are provided they should be presented as e.g. WO 02/2135 rather than 02/2135.
5. It is preferable that all documents filed are listed on the lodgement schedule, not just the main transactions. For example, if a response to an examiner's report included a Notice of Entitlement, amendments, as well as submissions, all three transactions should be listed.

Trade Mark Filings

1. Generally, only one copy of a trade mark is required on the application form unless it is an image mark where, in this case, you should also submit a copy on a scanning sheet. For example, it should only be presented sideways if it is intended for the image to be published sideways. The image should be presented exactly how it is intended to be published.
2. If colour is claimed, a total of three representations need to be submitted: one for the certificate, one for the examiner and one to remain on the application form.
3. Ensure the print on the application is dark enough for scanning.
4. State goods and services on the application form itself rather than on a separate sheet with "see attached" on the form.
5. It is not necessary to use italics in describing the goods and services or to put borders

around the description of the goods and services.

6. We only require the Australian Trade Mark Number on correspondence to IP Australia, not the International Number.
7. When sending faxes for extensions of time, attach a completed Payment Options form, as this form is necessary in order to process this request.
8. To assist with the identification of opposition correspondence and its accurate data coding, expeditious data capture and subsequent processing in Trade Mark Opposition and Hearings please ensure that correspondence relating to *exparte*, opposition, removal or court actions is clearly identified as such in the subject heading.

This includes stating the trade mark number and name of the opponent and trade mark applicant or removal applicant (or name of applicant and respondent (plaintiff/defendant) in the court proceedings and the court action number.

For further guidance please refer to the information sheet listing the trade mark correspondence transaction descriptors which by no means is exhaustive.

Design filings

1. Use a designs lodgement schedule for all designs filings. This provides a checking mechanism to ensure that designs filings are not overlooked when they are processed, for example, because they are "tucked behind" a large batch of patents or other filings.
2. Lodge **5 sets** of representations at filing. IP Australia requires 5 copies of representations for processing. Ensure that each set of representations contains one of each of the views of the article rather than providing all 5 copies of each view together.
3. A Form 2 is not required for designs filings.
4. Where the nature or use of the product would not be clear from the product name or the form of the representation, please include a statement of the nature and use of the product. This will facilitate correct classification at filing.



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TRADE MARK CORRESPONDENCE TRANSACTION DESCRIPTORS

Descriptors to be used on correspondence and filing schedule

Trade Mark Application
Divisional Application
Amendment to an Application – Pre publication
Amendment to an Application – Post publication
Request for expedited examination
Response to Examiners Report
Response to Examiners Report with Evidence
Deferment of Acceptance
Extension of Time for Acceptance
Opposition
Extension of Time to File a Notice of Opposition
Evidence in Support
Evidence in Reply
Evidence in Answer
Application for Special Leave to Serve further Evidence
Notification of Service
Request for Hearing
Extension of time to serve evidence
Application for an Award of Costs
Bill of Costs
Request for a Decision on the Written Record
Withdrawal of Opposition
Payment of Registration Fee
Renewal of Registration
Renewal of Expired Registrations
Removal of Trade Mark for Non – Use
Amending a Registered Trade Mark
Cancellation of Claimed Interest
Cancellation
Rectification of the Register (Court Orders only)
Claimed Interest
Assignment
Change of Name
Change of Address
Change of Address for Service
Withdrawal of Application

DESIGN CORRESPONDENCE TRANSACTION DESCRIPTORS

Preferred Descriptors to be used on correspondence and filing schedule

Design Application
Amendment of a Registered Design
Amendment of an Application
Convention Application
Additional/ Subsequent Application
Divisional/ Excluded Application
Assignment of an Application
Assignment of a Registered Design
Request for Certified Copies
Request to Register
Request to Publish
Request for Examination
Request for Hearing
Extension of Time request
Licence/ Mortgage
Opposition to First Extension
Opposition – Various
Renewal/ Extension of Registration
Restoration
Request to Withdraw Design application
Request to Withdraw Service Request
Response to Failed Formalies Notice
Offer to Surrender
Request to Exclude
Request to Convert
Duplicate Certificate
Request for Supply of Documents

PATENT CORRESPONDENCE TRANSACTION DESCRIPTORS

Descriptors to be used on correspondence and filing schedule

New Provisional Application
New Standard Application
New Innovation Patent Application
New PCT application
Request to Enter National Phase
Formalities Response
Conversion of Application
Lodgement of Basic Documents or Certified Copies
Lodgement of an International Preliminary Examination Report (IPER)
Lodgement of an International Preliminary Report on Patentability (IPRP)



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PATENT CORRESPONDENCE TRANSACTION DESCRIPTORS (Continued)

Descriptors to be used on correspondence and filing schedule
Withdrawal of Application
Request for early OPI
Notification of Error
Amendment – Change of name and/or address
Amendment – Change of address for service
Amendment – Amending a Specification
Amendment – amending a document other than a Patent, Complete Specification or an entry in the register
Amendment of a patent or an entry in the register
Amendment – section 112 advice
Amendment – Opponent's comments under regulation 10.2 (7)
Amendment – Court Ordered amendments
Request for an International Type Search under Article 15/5
Request for Information
Duplicate Deed
Examination Request
Re-examination Request
Examination Response
Request to defer Examination
Demand for International Preliminary Examination
Notice of Entitlement
Filing of Search results
Continuation/ Renewal Fee Payment
Payment of an Invitation to Pay (ITP)
Acceptance of an application
Postponement of Acceptance
Assignment
Assignment – Death of Applicant/ Patentee
Recording Licence Agreement or Mortgage
Extension of time – Section 223
Extension of Term (Pharmaceutical)
Opposition
Opposition – Innovation Patent
Opposition – Statement of Grounds and Particulars
Opposition – Request to Dismiss Opposition
Opposition – Evidence in Support/ Answer/ Reply

PATENT CORRESPONDENCE TRANSACTION DESCRIPTORS (Continued)

Descriptors to be used on correspondence and filing schedule
Opposition – Request to Serve Further Evidence
Opposition – Request for Directions
Opposition – Request for taxing and costs
Opposition – Extension of time to serve evidence
Opposition – Notification of Service
Opposition – Withdrawal of Opposition
Opposition – Request a hearing
Request for determination of a dispute under section 32.
Application for Declaration of an Eligible Person under section 36
Request for exercise of Commissioner's Powers under section 210
Response to Written Opinion

Thank you for taking the time to read these filing Guidelines.

By following these guidelines, you are helping IP Australia maximise its accuracy and efficiency when processing your client's filings. This in turn helps to ensure their IP rights are protected effectively.