



THE AUSTRALIAN FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS
FICPI AUSTRALIA

4 July 2016

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By email: consultation@ipaaustralia.gov.au

Director
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Attention: Lisa Bailey

Dear Lisa

**Exposure Draft of the Intellectual Property Legislation Amendment
(Single Economic Market) Regulation 2016**

Thank you for extending the time for us to make a written submission in relation to the above, which is greatly appreciated.

FICPI Australia is the National Association of the International Federation of Intellectual Property Attorneys (FICPI). FICPI takes its membership exclusively from IP attorneys in private practice from more than 86 countries, including USA, Japan, Europe, India and China, as well as Australia and New Zealand. The organisation was founded in 1906. Further details regarding FICPI can be found at www.ficpi.org.

We have now had an opportunity to consider the Exposure Draft Explanatory Statement and Regulations, and make the following comments:

Schedule 1

- Items 7, 163 to 167 – **Paragraph 3.2C(2)(a) and Reg 22.10 Address for service:**

We note the attempt which has been made to try and ensure that an address for service is a physical address as opposed to an electronic address. However, with respect to the services now provided by Australia Post, which we understand provide forwarding of mail electronically, and the uncertainty of the mail delivering authority in New Zealand and the manner in which they operate, we suggest that appropriate qualification be made directly to the word "address" where it appears in the context of

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an address for service, to describe this as a “physical” address, or other wording to achieve the same effect, in order to avoid any uncertainty in the matter.

- **Item 113 – Reg 20.63 Eligibility for appointment as tribunal member:**

*We note that the criteria for President is that the person needs to be enrolled as a legal practitioner for at least **seven** years, however, there is no similar experiential criteria for Other Tribunal members.*

*Given that the experiential criteria for becoming a member of FICPI Australia includes being a registered patent attorney or trade marks attorney for at least **five** years, and similar experiential criteria applies to being a Fellow of the Institute of Patent and Trade Mark Attorneys of Australia, we consider it appropriate that a similar period of **five** years be also required in order to be an Other Tribunal member.*

Schedule 2

- **Item 10 – Reg 17A.48H Opponent address for service:**

We note that the requirement for an address for service in Australia for an opponent in respect of a notice of opposition filed under regulation 17A.48F applies different criteria to that which applies to a holder of an IRDA under regulation 17A.74. As the same problems which are attempted to be overcome by the provisions of regulation 17A.74, apply in relation to opponents under regulation 17A.48F, we consider that similar provisions for the address for service of documents provided under proposed new sub-regulation 17A.74(2), subject to our further proposed amendment under Item 12, be introduced as a new sub-regulation 17A.48H(4).

- **Item 12 – Sub-regulation 17A.74(2) IRDA holder address for service:**

We refer to our comments under Schedule 1 with respect to Items 7 and 163 to 167 and consider that the same rationale applies to Sub-regulation 17A.74(2). Therefore, we suggest that appropriate qualification be made directly to the word “address” where it appears in the context of an address for service to describe this as a “physical” address, or other wording to achieve the same effect, in order to avoid any uncertainty in the matter.

Also with respect to the Explanatory Statement, there is a minor typographical error that you have probably already picked up at Schedule 1, Item 172. In the third last line, the first occurrence of ‘have’ should be deleted, so that the last sentence reads:

“The new provision will provide that a course of study must provide for a student...”

By way of general comment, which may be beyond the scope of the Exposure Draft Regulations at this time, is the equitable consideration of the attendance of a person appearing before a sitting of the Tribunal to be heard in a matter concerning them before the Tribunal, if the Tribunal is

sitting in one country, either Australia or New Zealand, and the person appearing is resident in the other country. Clearly, there would be an inequity compared to a situation where the Tribunal sitting and the residence of the person appearing, was in the same country.

The above aside, we have no further comment to make at this time.

If you have any queries concerning any of the above, we would be more than pleased to discuss the matter with you further.

Yours sincerely

A handwritten signature in blue ink, consisting of a series of loops and a long horizontal stroke.

President – FICPI Australia