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**Submission to IP Australia Regarding the Proposals to Streamline IP Processes and Support Small Business Consultation**

These Submissions are lodged on behalf of the Law Institute of Victoria (the LIV) and are informed by contributions from the LIV's Intellectual Property and Information Technology Committee. The below comments are numbered according to the questions raised in the consultation paper.

**Aligning and Simplifying**

**1. Aligning Renewals**

*A. Renewal grace periods: Trade Marks*

The LIV supports a change to the renewals process that provides greater certainty around the application of Trade Mark rights during the grace period.

The LIV submits that Option A2, as proposed by IP Australia, provides the desired outcome with the least amount of significant change, as it clarifies the current position by stating with certainty the operation of rights during the grace period and the effect of a failure to renew by the renewal deadline.

**2. Re-examination / Revocation**

*Trade Marks*

The LIV does not support Option 2 and submits that, currently, no practical need or systemic issue requiring the period for trade mark revocation be extended from its current position (12 months post-registration) to a period ranging between two and five years.

The LIV submits further evidence or research should be obtained or undertaken to demonstrate a need for an extension of the proposed two to five year period with further opportunity for public consultation on this point. We note that applications for revocation under the current provisions appear to be rare.

The LIV does not support Option 4 and submits that allowing re-examination of an accepted application up to 12 months from registration upon applications by third parties is unnecessary in the context of trade mark applications.

Currently, trade mark applications are examined for both relative and non-relative grounds. In addition, the current Office practice of alerting owners of trade marks cited during the application process of acceptance of an application (thereby giving them the opportunity to oppose) provides sufficient opportunity for a thorough and fair examination process.

The LIV acknowledges that, under section 84A (6) of the *Trade Marks Act 1995*, there is no obligation for the Registrar to act on a request for revocation from a third party. The proposal

is to allow applications for revocation by third parties and is to contain the re-examination process by limiting revocation to the grounds that currently apply. On this basis, it seems unlikely it will be used as a de facto opposition forum to deal with, for example, ownership disputes between parties.

The LIV fails to see how effectively introducing another layer of examination will “reduce IP Australia’s administrative costs.”

The LIV submits that the proposed re-examination process appears at odds with the philosophy underpinning the Consultation, as the proposed examination will likely only lead to prolonged periods of uncertainty for trade mark applicants and possible costs due to lost opportunities.

The LIV and the Committee would welcome further opportunities to participate in public consultation on this process, following the provision of more extensive details regarding the underpinning processes behind the implantation of Option 4.

#### **14. Acceptance Time Frames**

The LIV does not support a reduction of the acceptance timeframe from 15 months to six months or abolishing the extension available under regulation 4.12(3).

The LIV has concerns that requiring all extension applications to be made under section 224 of the TMA will result in an increase in the costs payable by all applicants.

The LIV submits that many small business applicants find it difficult to commit the time required to respond to an examination report, even where a report only raises specification objections.

The LIV submits that, where a reduction in the acceptance timeframe is introduced, the period should be greater than the currently proposed six month period identified in Option 2. Similarly, the LIV submits that applicants should be able to obtain at least one three or six month extension without a requirement to provide reasoning forming the basis of their request, which is currently the position under regulation 4.12(3).

The LIV welcomes further detail on the proposal to expand the grounds for deferment under regulations 4.13 and 17A.21 to include overcoming a ground for rejection under section 41. For example, the LIV may have concerns where an applicant would need to demonstrate that it intends to file formal evidence of use (in a Declaration) in order to invoke the deferment.

Please contact Jonathan Lambrianidis on 03 9607 9476 if you wish to discuss the matters raised in this submission.

Sincerely yours,



Katie Miller  
**President**  
Law Institute of Victoria