



# TRADE MARK AND DESIGNS CONSULTATION GROUP

## MEETING SUMMARY

The **Trade Mark and Designs Consultation Group (TMDCG)** met on Tuesday 3 September 2024 via Microsoft Teams. The Chair opened the meeting by providing an update on key trends in trade mark and designs.

### Trade Mark Trends:

- **Stockpile:** Stockpile of trade mark applications sat at just under 7,000 at the time of reporting.
- **Service Level Commitments:** IP Australia maintained a compliance rate of 99%+ across all four commitments over the past year, examining most applications within 6-7 weeks, and responding to TM Headstart requests in about 3.5 business days.
- **Demand:** The 2023-24 FY saw a 5.1% increase in demand with 84,147 applications received in total (breakdown: 64% standard, 19% Madrid, 17% Headstart). 58% of applications received were filed domestically, 42% internationally.
- **Top International Origin:** China became the top country for trade mark filings, surpassing the US.
  - **Applications from China** Totalled 10,203, a 63.6% increase from the previous FY, representing 28.6% of all international applications (up from 18.4%).

### Designs Trends:

- **Stockpile:** Approximately 1,200 new applications and 500 examination requests at time of reporting.
- **Service Level Commitments:** Maintained across all four timeliness measures for the 2023-24 FY.
- **Demand:** Higher demand for new applications in 2023-24 compared to the previous year but saw a drop in examination requests.
- **International Applications:** 67% of new applications are from an international origin, with the US being the top filing route.

### Fee Review

- Previously announced **fee changes** become effective from 1 October 2024. Details and consultation process available [on IP Australia's website](#).

### Indigenous Knowledge (IK) Update

- **Treaty Conclusion:** The Treaty on Intellectual Property, Genetic Resources, and Associated Traditional Knowledge was concluded in May.
- **Parliamentary Consideration:** The Treaty will now go through our domestic signature and ratification processes, including tabling in both Houses of the Australian Parliament for consideration by the Joint Standing Committee on Treaties (JSCOT). The treaty would enter into force after domestic legal and parliamentary processes are completed.
- **Patents Act Review:** IP Australia is reviewing the Patents Act to consider a disclosure requirement. Any changes would be consulted on in due course.

### Free Trade Agreement Policy Update

- Negotiations for a Free Trade Agreement (FTA) with the United Arab Emirates (UAE) are continuing.
- It should be noted since this TMDCG meeting of 3 Sept 2024, conclusion of the FTA negotiations was [announced on 17 September 2024](#).

### Design Law Treaty

- IP Australia has commenced public consultation on the draft Design Law Treaty (DLT) via the [consultation hub](#).
- The DLT is a procedural treaty to harmonise administrative procedures for protecting designs internationally, including setting maximum requirements that IP Offices can request in design applications. The World Intellectual Property Office (WIPO) will host a conference in November 2024 to finalise the Treaty.

### Domestic Design Reforms

- Public consultations on **key proposals** (virtual design, partial designs, incremental designs) were completed in 2023. IP Australia will proceed with reforms, incorporating feedback from consultations. Outcomes of the consultation are available on the [consultation hub](#).

- **Legislative Drafting** will commence as soon as possible, with an exposure draft to be consulted on. All subject to other government priorities and parliamentary processes.
- **Virtual Designs:** Proposed legislative changes will apply only to new applications filed after the commencement of the new legislation. Incrementals linking proposal may be an avenue for protecting already registered designs containing virtual matter. Information paper provides more detail. IP Australia welcomes comments on the proposed approach and is open to separate meetings to discuss the issue.

### Oppositions and Hearings Update

- 221 **Trade Mark Decisions** have been issued up to 31 August 2024, with an average issuance time of 6.2 weeks from the hearing date. Expected to issue 334 decisions by the end of 2024, a 26% increase compared to 2023.
- Two **Design Decisions** have been issued in 2024, averaging 12.86 weeks to complete.
- Maintained low **Processing Times** for extensions of time (EOT) and statements of particular grounds (SGPs) at 1-2 weeks.
- **Hearing Scheduling:**
  - Written submissions: Reduced wait time from 12 months to 6 months.
  - Oral hearings: Reduced wait time from 12 months to 10 months, though this may fluctuate.
- **New Recruitment:** One new hearing officer recruited from the internal examination cohort.

### Oppositions Regulation Changes:

1. **Improvements to Opposition and Hearings Process:**
  - IP Australia aims to enhance the process following a review.
  - Legislative drafting resources are limited, so priority is given to urgent or simple changes.
2. **Proposed Regulation Changes:**
  - **Awarding Costs:** Aligning trade marks with existing patents and designs powers.
  - **Dismissing Oppositions:** Allowing dismissal if parties abandon the opposition.
  - **Prolonging Examination Period:** Allowing the Registrar to extend the period when a hearing is requested, reducing the need for Extensions of Time (EOT).
3. **Extensions of Time (EOT) for Opposition Evidence:**
  - Concerns raised by attorneys led to practice changes aligning with patents.
  - Data shows a mix of reasons for EOT requests, with a majority being granted.
  - No regulation change proposed yet; monitoring outcomes continues.
4. **Next Steps:**
  - A factsheet to help attorneys justify EOTs has been prepared, feedback from members is always welcomed.
  - Members noted some onerous hearing decisions and suggested legislative changes.
  - IP Australia requires evidence and data to support future legislative changes.

Meeting Summaries of our Consultation Groups can be found on our website: [Consultation Groups | IP Australia](#). For further information, please contact [mdb-tmdcg@ipaustalia.gov.au](mailto:mdb-tmdcg@ipaustalia.gov.au).