FEE CHANGES FOR TRADE MARKS AND DESIGNS IN AUSTRALIA–EFFECTIVE 1 OCTOBER 2024

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Australia Intellectual Property Alert

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IP Australia has implemented fee changes for trade marks and designs from 1 October 2024.

WHAT DOES IT MEAN FOR INTELLECTUAL PROPERTY (IP) OWNERS?

Trade Marks

For trade marks, the fee changes:

- *Do not* affect the cost to file a trade mark;
- *Do not* affect the cost to renew a trade mark;
- *Do* affect the cost to oppose registration of a trade mark;
- *Do* affect the cost to remove a trade mark for nonuse; and
- *Do* increase the amount of costs recoverable by a successful party in oppositions.

What Effect do the Fee Changes Have for Opposing Registration of a Trade Mark/ Removing a Trade Mark for Nonuse?

The fee changes affect the cost to run an opposition or nonuse cancellation action in the following ways:

- *Grounds:* AU$250 new fee will apply for each ground of opposition above three (including if added later).*
- *Prior mark ground:* AU$250 new fee will apply for each mark above 10 included in an opposition ground based on prior marks.
- *Amending grounds:* AU$250 new fee will apply for amending the grounds of opposition.
- *Late filing of evidence:* AU$500 new fee for late filing of evidence.
- *Removing for nonuse:* AU$350 fee for applying to remove a trade mark for nonuse (increase of AU$100).
- *Decision by submissions:* AU$500 fee for requesting an opposition be decided by written submission only (increase of AU$100).

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- *Decision by hearing:* AU$700 fee for an opposition hearing in person (decrease of AU$100) or via telephone/video conference (increase of AU$100). The previous AU$400 fee for requesting a hearing per se, has been removed.

*The one exception is no additional fee will apply for a ground based on earlier use of a similar trade mark under section 58A of the Trade Marks Act.

IP Australia's summary of the fee changes is here.

Has the Amount of Costs Recoverable Changed?

Pleasingly, the costs recoverable by a successful party in an opposition have substantially increased and in some cases more than tripled. Although they remain less than actual costs likely incurred, the changes are a welcome increase.

IP Australia's new costs structure is here.

What Should IP Owners Do?

- *Current oppositions:* For oppositions on foot, where a statement of grounds and particulars has not yet been filed, IP owners may need to consider if the budget allocated for the opposition requires reviewing. For example, under the new cost regime, oppositions intending to rely on a family of trade marks, that benefit from including multiple prior marks, would attract additional fees.
- *Strategic planning early:* The recent character limit placed on particularising opposition grounds submitted via IP Australia's online services platform, together with these new additional fees for opposing on more than three grounds and when relying on more than 10 prior marks and the new fees for amending grounds or the late filing of evidence, encourages thoughtful, concise and streamlined opposition proceedings. As a result, IP owners need to plan with their IP lawyers early, select the strongest grounds of opposition and be diligent in preparing evidence to meet deadlines.

Designs

Fees for New Design Applications

The changes do positively affect the cost to file a design. The official fees for filing a new design application will change as follows:

- New single design application AU$200 (decrease of AU$50);
- Additional design on filing (within the same Locarno class) AU$150 (decrease of AU$50); and
- Excess design identified during formalities AU$200 (decrease of AU$50).

The aim of reducing fees at filing is to try and incentivise design rights in Australia and to encourage more designers to seek protection of designs.

Fees for Requesting Examination of a Design

The official fees for requesting examination of a design will change as follows:

- Request for examination by the registered owner AU$500 (increase of AU$80); and

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- Request for examination by a third party:
  - Third party fee AU$250 (increase of AU$40); and
  - Registered owner fee AU$250 (increase of AU$40).

What Should IP Owners Do Now About Any Existing Designs or New Designs?

The changes in fees are nominal and do not necessarily warrant any immediate steps unless either of the following are applicable:

- *Requesting examination:* Although the cost of requesting examination has now increased, an IP owner will only be impacted if it wishes to enforce its design and make allegations of infringement. It is only at this stage that an IP owner needs to request examination and incur this fee. Even so, the increased cost of requesting examination will be a factor IP owners need to consider as part of its enforcement budget.
- *New designs:* While the reduction in application fees is nominal, IP owners can now benefit from the reduced fees, particularly if there are a large volume of new applications to file. As a result, now is a good time for IP owners to consider filing multiple design applications in Australia.

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