

Alert

INTELLECTUAL PROPERTY

Fee Increases for Trade Marks

By Amy Bishop

IP Australia has undertaken a review of its fees and has advised of several fee increases in relation to trade marks which will take effect on 1 October 2020.

Fee structure

The last change to IP Australia's fee structure, in October 2016, resulted in an overall reduction in fees for registration of a new trade mark. This time, nearly all of the application fees have increased. Therefore, if you were planning to submit a trade mark application in the near future now might be the perfect time so that you can take advantage of the lower rates before the increase on 1 October.

Where a trade mark owner drafts their own specifications via IP Australia's Online Portal, the fee will increase from \$330 to \$400 per class. For applications which are not made through the online portal, the fee will increase from \$350 to \$450. The fee for online applications filed using the picklist¹ will remain the same at \$250.

Evidently, IP Australia's new fee structure has been designed to encourage online applications and use of the picklist. The picklist will increase the efficiency of processing applications because examiners will be able to assess applications knowing the goods and services are in the correct class.

¹ A searchable list which enables you to choose identified goods and services and ensures the selections are in the correct class.

However, applicants with unusual or unique goods and services will be at a disadvantage, since their product is unlikely to be on the picklist. Even some seemingly common items may not appear on the list, such as 'ready-to-eat meals' or 'erosion control services'. These applicants will be required to draft their own description and pay the higher fee, not only for the class in which the item was not available on the picklist but for all the classes listed on the application.

Trade mark hearings

One of the other changes is to the fees payable for trade mark hearings. Most notably, the cost for attending a hearing in person will now be \$800 per day.² The cost of a hearing held by video or teleconference will be \$200 per day less than a hearing in person, while a hearing on the basis of written submissions alone will be half the cost of an in-person hearing. Again, IP Australia appears to be encouraging applicants to move matters online to help streamline processes and improve efficiencies.

Further changes

Other fee changes include an increase to application fees for series trade marks and international registrations designating Australia.³ There are also to be changes to fees where a trade

² Less the \$400 fee paid to request a hearing.

³ Although the changes relating to international registrations are set to take effect on 7 November 2020.

mark requires renewal in circumstances, which only occur occasionally, where registration of the trade mark has been delayed for ten or more years after the filing date.

Additionally, fees for a patent and design applications have, for the most part, generally increased. There are also other fee changes relating to patents and designs to be implemented.

Further assistance

If you have been considering protecting your trade mark, now might be a good time to take action. If you wish to file a trade mark application in Australia prior to the increases, or you have any questions about these fee changes, please contact one of our IP experts.



MORE INFO

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