



New Zealand Institute of Patent Attorneys Inc

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Lisa Bailey
IP Australia

Dear Ms Bailey

NZIPA submissions to IP Australia on Public Consultation: Introducing divisional applications for international trade marks

Introduction

These submissions have been prepared by the New Zealand Institute of Patent Attorneys Inc. (NZIPA).

The NZIPA was established in 1912. It is an incorporated body representing most Patent Attorneys registered under the New Zealand Patents Act, and who are resident and practising in New Zealand.

The current membership of NZIPA comprises 158 Fellows, 1 Honorary, 36 Students, 17 Non-resident, 15 Associates and 6 Retired.



Part 1: Introduction of division of International Registrations, and alignment of the process for domestic divisional applications

TM1.1 Is there anything in the Part 1 proposal that you believe might be unworkable? If so, please suggest improvements.

No.

TM1.2 Can you foresee any scenarios that would be problematic under the Part 1 proposal?

No.

TM1.3 Where do you see benefits and costs for users of the trade mark system as a whole arising in this process?

The ability of trade mark owners to divide an international registration will lead to multi-class applications as a whole not be delayed due to an objection that relates to only one or some of the classes. This obviously means that the owner will enjoy the rights of registration sooner and remove a level of uncertainty for them.

Harmonisation of the domestic divisional process with the proposed international registration divisional process, and alignment with practices of other like-minded trade marks offices, is beneficial to the trade mark owners who are treated equally whether they have filed an international registration or national application.

TM1.4 Do you have any other general observations to add?

The level of fee proposed by WIPO is reasonable.

The public consultation document does not disclose how the divided Australian designation will be numbered. The divided designation should be numbered on the same basis as an application divided from a domestic application.

Alignment of the basis on which IP Australia's fees are calculated with that charged by WIPO would be appropriate.

Part 2: Mergers

IP Australia is interested in receiving feedback on the option of a divisional trade mark being merged back with its parent, as follows:

TM2.1 If there was an option to merge a divisional application back with its parent would you use it? Why or why not?

Yes. The merger of a divisional application would have the effect of re-creating a single multi-class application as filed. This will ensure trade mark owners retains the benefits of multi-class filings such as more stream lined portfolio management.

TM2.2 Do you have any other general observations to add?

We would recommend that IP Australia provide for the merger of a divisional application back with its parent.

Yours faithfully,



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NZIPA Council Member

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