Streamlining IP Protection in Australia and New Zealand

Posted on 03/06/2011 by Ben Halberg

Separated only by the Tasman Sea and isolated from major trading partners in Europe and the Americas, Australia and New Zealand have a long history of economic cooperation.

In August 2009, the Prime Ministers of both countries agreed upon a number of outcomes for removing regulatory barriers to trans-Tasman trade, contributing towards establishing a "seamless business environment" between the two countries - dubbed the "single economic market" (SEM).[1]

Several of those outcomes are of particular interest to owners of intellectual property in either or both of Australia and New Zealand.[2]

Trans-Tasman Trade Mark Regime

One of the proposed outcomes is the establishment of a single trans-Tasman trade mark regime.

This will involve an alignment of trade mark registration procedures in both Australia and New Zealand to eventually lead to a single trans-Tasman trade mark register. Initially, this is likely to be in addition to the existing national registers of Australia and New Zealand, but may eventually replace both national registers.

The trans-Tasman trade mark regime is intended to result in cost savings for applicants who would otherwise file applications in both Australia and New Zealand.

Single Patent Application Process

The second major IP-related outcome involves establishing a single patent application process by aligning the patent filing requirements in both countries to enable a single "portal" for filing applications. This presumably will involve filing a single application "electing" both Australia and New Zealand, before examination is carried independently in each country.

A "medium term" timeframe of five years was laid down for implementing both the Trans-Tasman trade mark regime and the single patent application process.

In a further announcement in February 2011, however, the Prime Ministers announced an agreement to extend the single patent application process to a single patent *examination* process, to achieve economies of scale and avoid duplication of effort in performing a separate examination in each country.[3] The intention of this change is to reduce prosecution fees for patent applicants, in addition to any potential savings on official filing fees from the single patent application process.

Under the single examination process, corresponding applications filed in both Australia and New Zealand will be examined in only one country. The law of both countries will be considered by the examiner where differences exist, and the examiner will thus allow or reject applications for patents in each country as appropriate.[4]

It is unclear at this stage precisely how the single examination process will be implemented, but it is likely that applicants will be permitted to amend their application independently for each country to overcome differences in law. These differences are likely to be substantial, such as

the looming exclusion of computer programs from patentability in New Zealand and the significant changes proposed by the Australian government under the Intellectual Property Laws Amendment (Raising The Bar) Bill 2011.

The first stage towards implementation of the single examination process will involve merely the sharing of resources between IP Australia and the Intellectual Property Office of New Zealand (IPONZ). This will presumably include search results and examination reports, the latter of which are not currently open to public inspection at any stage under the current law in New Zealand.

Examination by a single patent office will be implemented as the second stage, giving the patent offices of each country the authority to allow a patent application for the other country.

It remains to be seen from what point the Trans-Tasman application will proceed as separate applications in each country. Ordinarily, an accepted patent application in either country would remain open to pre-grant opposition for a period of three months before proceeding to grant. However, no mention has yet been made of a centralised pre-grant opposition procedure.

At this stage, no plans for a single “Trans-Tasman” patent covering both Australia and New Zealand have been announced, but this would appear to be a natural progression from the single examination process and is consistent with the “single economic market” concept. The prospect of a trans-Tasman patent system thus remains a distinct possibility in the longer term.

Extending IP Across the Tasman

Australia is often seen by international clients as the more important market due to having the larger population, but the close relations between Australia and New Zealand make it relatively straightforward to introduce new products or services to both countries.

In particular, trade agreements between the two countries mean that many goods certified or approved for sale in one country can also be sold in the other, and service providers can generally provide services in both countries.[5]

A number of other factors also make New Zealand an attractive manufacturing base, test market, or entry point to the wider Australasian market, including a more favourable exchange rate, lower wages, skill availability, favourable time zone, “clean-green” image, ease of doing business,[6] and duty-free access to the Australian market, among others.

Obtaining formal IP protection across both Australia and New Zealand is, therefore, often a wise investment. The proposed outcomes will provide a more cost-effective means for doing so, but the logistics of implementing such a regime will require considerable development in view of the not insignificant differences between the patent laws of each country.

Baldwins Intellectual Property

Established in 1896, Baldwins has a long and proud history in the IP field in New Zealand.

All of Baldwins’ patent attorneys are registered to practice in both New Zealand and Australia, and regularly assist both local and international clients with prosecution of patent, trade mark, and registered design applications in both countries.

For further information, or to take advantage of our expertise and competitive fees in either country, please contact us.

[1]“Joint Statement of Intent: Single Economic Market Outcomes Framework” (2010) Ministry of Economic Development <www.med.govt.nz>.

[2]“Single Economic Market Outcomes Framework as Identified in Prime Ministers Rudd and Key’s Joint Statement of Intent, 20 August 2009” (2009) Ministry of Economic Development <www.med.govt.nz>.

[3]“Joint Statement by Prime Ministers Key and Gillard: February 2011 Report on Trans-Tasman Cooperation” (2011) The official website of the New Zealand Government <www.beehive.govt.nz>.

[4]“Integration of Patent Examination between Australia and New Zealand” (2011) IP Australia <www.ipaustralia.govt.nz>.

[5]“Exporter Guide - Australia - Country Brief” (2011) New Zealand Trade & Enterprise <www.nzte.govt.nz>.

[6]New Zealand placed third for 2011 in The World Bank’s rankings of economies for “ease of doing business,” ahead of the United Kingdom, United States, and Australia among others. See “Economy Rankings” (2011) Doing Business - World Bank Group <www.doingbusiness.org/rankings>.