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Canadian Intellectual Property Office

Innovation, Sciences et
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Office de la propriété intellectuelle du Canada



DOING BUSINESS ABROAD

Protecting your IP in Australia



Canada

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DOING BUSINESS ABROAD

Protecting your IP in Australia

Intellectual property (IP) is a valuable asset that can support your business expansion abroad. A Canadian patent, trademark or industrial design does not secure your rights outside Canada. You should consider obtaining IP protection in the countries where you plan on doing business, including selling products online or manufacturing products overseas.

Canada and Australia have a long-standing trading relationship that continues to strengthen. It is therefore important to know how to recognize, register and enforce your IP rights in Australia.

In Australia, you can apply for trademark, patent, design, copyright and plant breeder's rights protection.







Where is IP registered?

IP Australia (Australia's IP office) is the Australian government agency responsible for granting patents, trademarks, designs and plant breeder's rights.

Applications for IP rights can be filed electronically at ipaustralia.gov.au. A good first step is to search existing IP to check whether anticipated IP use may conflict with or infringe on someone's prior rights. A Canadian IP professional may be able to coordinate work with an IP professional in Australia.

Trademarks

- In Australia, a trademark is a sign used, or intended to be used, to distinguish your goods and services from those of others in the marketplace. A sign can be a letter, a word, a symbol, a sound, a scent, a shape, a logo, a picture, a movement or an element of packaging, or a combination of these.
- Australia follows a "first-to-use" system for trademark rights. This means that whoever can prove significant use of a trademark first in the Australian marketplace will own the rights to it even if the mark is not registered.
- However, you should still consider registering your trademark with IP Australia, as registered trademarks with IP Australia are easier to enforce and have a number of other important advantages over trademarks that are not registered.
- In Australia, a trademark is registered for 10 years and may be renewed every 10 years. You can renew your trademark 12 months before your renewal date as well as 6 months after the renewal is due. It should be noted that there will be an extra cost to renewing your trademark past the renewal date.
- If you are not regularly using your trademark in the Australian marketplace, it may be subject to a dispute or challenged for non-use.
- As a member of the Madrid Protocol, Australia can be designated in an international application filed via the Madrid System.
- For **more information** on trademarks and applying for a trademark registration, visit ipaustralia.gov.au/trade-marks.

Patents

- IP Australia grants and publishes patents. There are 2 different types of patents available in Australia:
 - Standard patents are granted to anyone who invents or discovers any new and useful product, process or machine that can be made or used in an industry. The patent must include an inventive element. The term of a standard patent is 20 years from the filing date of its application.
 - Innovation patents are granted to new and useful improvements to existing inventions. Such patents require an innovative element and are best suited to inventions that will remain in the market for a short period due to competition, such as technology-based inventions. Innovation patents are not examined

unless requested. The term of an innovation patent is 8 years from the filing date of its application.

- Australia, like Canada, has a “first-to-file” patent system, where a patent is granted to the first person who files an application for an invention.
- Australia allows for a 1-year grace period for inventors to file their standard or innovation patents. Therefore, if an inventor publicly discloses their invention, there is a 1-year period from the time of disclosure until the invention is considered as part of the public domain. However, unlike in Canadian law, if a third party uses an invention in the grace period before a patent application is made, that party will retain their rights to use the invention even after a patent is granted to the inventor. It is highly recommended that you seek advice from a lawyer licensed to practice in Australia if you wish to rely on the grace period.
- IP Australia provides the option of filing a provisional application for a patent. Similar to the Canadian Intellectual Property Office’s “incomplete application,” IP Australia’s provisional application offers a quicker and cost-effective means for securing an early filing date. However, a provisional application is considered abandoned if it is not converted into a non-provisional application within 1 year.
- Canadian applicants can use the Global Patent Prosecution Highway to speed up the examination process for corresponding patent applications filed in Australia.
- The Patent Cooperation Treaty makes it possible to secure the rights to an invention in a large number of countries by filing a single international application instead of several separate applications. However, the granting of a patent in Australia remains the responsibility of IP Australia.
- For **more information** on patents and applying for patent protection, visit ipaustralia.gov.au/patents.

Designs

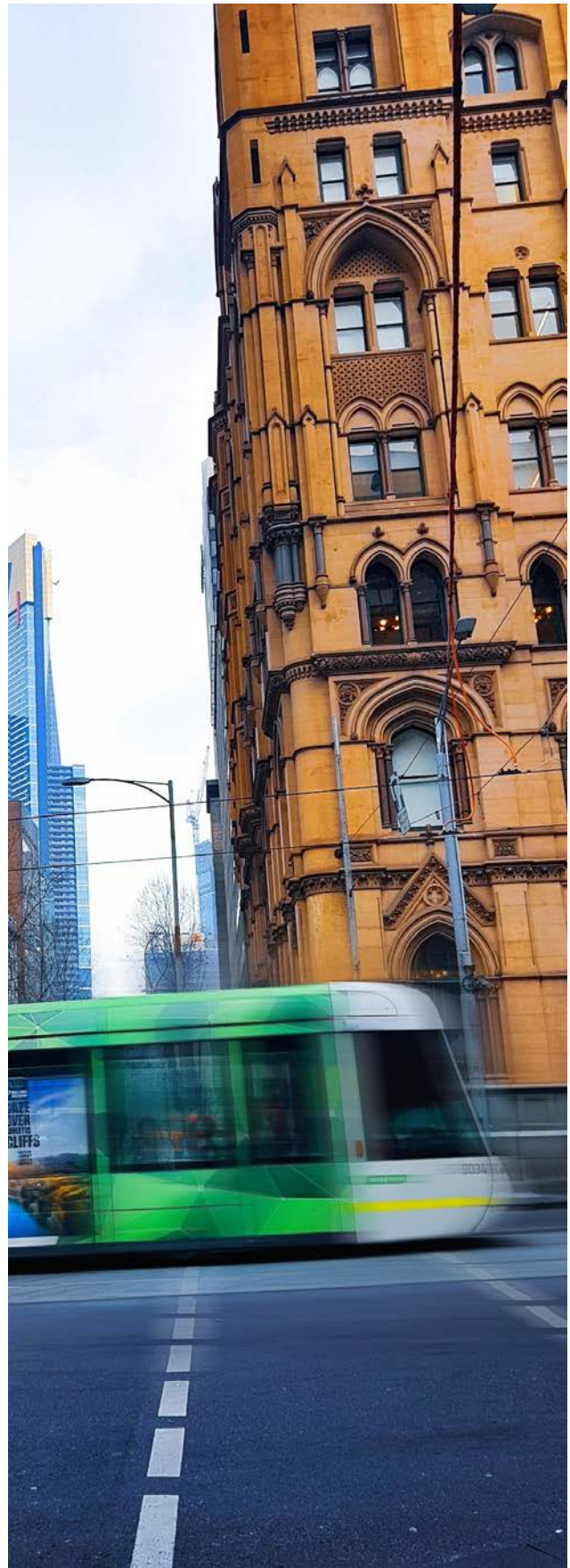
- In Australia, a design is the visual feature of a product that gives it a distinctive appearance: shape, configuration, pattern or ornamentation. Design protection is intended to protect designs that have an industrial or commercial use.
- In Australia, a registration protects your design for 5 years from the filing date and may be renewed for an additional 5 years.
- Some designs, such as medals, Australian currency and disreputable designs, cannot be registered.
- For a design to be registered, it must meet 2 requirements:
 - New – must be original and not identical to any previously disclosed or used design in the world
 - Distinctive – cannot be significantly similar to any previously disclosed or used design in the world
- For **more information** on designs and applying for design protection, visit ipaustralia.gov.au/designs.

Copyright

- In Australia, as in Canada, copyright protects original works such as literary, dramatic, musical and artistic works.
- There is no copyright registration system in Australia, because copyright protection is an automatic right.
- The government agency responsible for the administration of copyright is the Department of Communications and the Arts.
- For **more information** on copyright, visit communications.gov.au/copyright.

Plant breeder's rights

- Plant breeder's rights are exclusive commercial rights for a registered variety of plant.
- These rights give plant breeders a commercial monopoly for a period of time. The purpose of plant breeder's rights is to encourage plant breeding and innovation so that new plant varieties continue to become readily available once the period of protection concludes.
- In Australia, plant breeder's rights protection applies for 20 years for most plant species and 25 years for vines and trees.
- For **more information** on plant breeder's rights and applying for protection, visit ipaaustralia.gov.au/plant-breeders-rights.







IP enforcement

There are several ways to enforce your rights against unauthorized use of your IP in Australia:

- The Australian government Department of Home Affairs helps prevent counterfeit and pirated goods from entering Australia. Owners of IP rights can file a customs notice known as a Notice of Objection, which enables the Department of Home Affairs to seize and detain imported goods that violate Australian IP rights.
- If you believe your IP rights are being infringed upon in Australia, you should consult a lawyer licensed to practise in Australia or an IP professional to discuss the next steps.
- IP owners have many options when they suspect infringement of their IP rights, such as sending a letter of demand, which is often the first step taken.
- In cases where a letter of demand is not sufficient, it may be best to seek legal action.
- Australia also provides the option of ADR, which encompasses mediation, arbitration and expert determination. ADR processes are generally more informal, less adversarial, cheaper and settlement-focused. They can be used before or as an alternative to going to court.
- Before taking any action, you may wish to consult a qualified IP professional who is familiar with Australia's legal system to explore the various enforcement mechanisms available.



Tips: Important notes

- IP rights are important, so take the time to determine what IP can be registered and what rights can be enforced.
- Remember that the protection of IP rights (such as patents, trademarks, industrial designs and copyrights) registered in Canada does not extend to Australia.
- Align your IP strategy with your business strategy. Identify business goals, protectable IP, regional requirements, potential partners and the capacity to expand into your target markets.
- Routinely monitor the marketplace for unauthorized use of your IP.
- Before proceeding with any of the enforcement methods outlined above, consider contacting a qualified legal representative to discuss options, including a “letter of demand.”

For more help

- For information about IP protection in Australia, please see the IP Australia website at ipaustralia.gov.au.
- For material relating to the export of goods to Australia, please see the Canadian Trade Commissioner Service website at tradecommissioner.gc.ca.
- Visit the Global Affairs Canada website at international.gc.ca for more information about doing business in Australia.
- For IP tools, resources and information for businesses, visit Canada.ca/ip-for-business.
- For more information on going global with your IP, visit Canada.ca/export-ip.
- Find more programs and support for Canadian businesses and innovators at innovation.canada.ca.

*The information provided above is meant as an educational resource only and should not be construed as legal advice.

Canada.ca/export-IP

