

SUMMARY OF 2024 IP AUSTRALIA FEE CHANGES

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The following tables summarises the fee changes in AUD that IP Australia will implement on 1 October 2024.

The changes below concern filing of applications and requests by online electronic means. Filing by alternate means will incur additional costs.

1. Changes to patent fees

a. Increased fees

Description of Fee	Old Amount	New Amount
Changes to patent application fees		
Innovation patent application	\$180	\$200
Standard patent application ('standard application')	\$370	\$400
Entry of PCT application into national phase	\$370	\$400
Changes to patent examination and acceptance fees		
Asking Commissioner to direct patent applicant to request examination of a standard application	\$100	\$150
Request for examination of a standard application – if the Patent Office conducted international preliminary examination on it	\$300	\$350
Request for examination of standard applications in other cases	\$490	\$550
Request for examination of innovation patent – made by patentee	\$500	\$550
Excess claims at first report — if there are more than 20 potential claims in relation to the examined complete specification:		New fee
<ul style="list-style-type: none"> for each of the 21st to the 30th potential claims 	\$0	\$125
<ul style="list-style-type: none"> for each potential claim in excess of 30 potential claims 	\$0	\$250

Acceptance of a standard application: minimum payable in all cases	\$250	\$300
<ul style="list-style-type: none"> adjusting amount for claims added between first report and acceptance 		New fee
- for each of the 21 st to the 30 th potential claims added	\$0	\$125
- for each potential claim in excess of 30 potential claims	\$0	\$250
Change to general fees		
Requesting an international-type search of a provisional application	\$950	\$1,100
Preliminary search and opinion on a standard application	\$950	\$1,100
Search of a standard application during its examination	\$950	\$1,100
Filing notice of opposition	\$600	\$1,200
Requesting a hearing by the Commissioner	\$600	\$1,200
Applying for extension of term of a pharmaceutical patent	\$2,000	\$2,500
Changes to continuation fees for standard applications and renewal fees for standard patents		
Sixth anniversary, fee paid	\$335	\$345
Seventh anniversary, fee paid	\$360	\$380
Eighth anniversary, fee paid	\$390	\$420
Ninth anniversary, fee paid	\$425	\$465
Tenth anniversary, fee paid	\$490	\$540
Eleventh anniversary, fee paid	\$585	\$645
Twelfth anniversary, fee paid	\$710	\$780
Thirteenth anniversary, fee paid	\$865	\$945
Fourteenth anniversary, fee paid	\$1,050	\$1,140
Fifteenth anniversary, fee paid	\$1,280	\$1,385
Sixteenth anniversary, fee paid	\$1,555	\$1,675
Seventeenth anniversary, fee paid	\$1,875	\$2,010
Eighteenth anniversary, fee paid	\$2,240	\$2,390
Nineteenth anniversary, fee paid	\$2,650	\$2,815

b. Decreased fees

Description of Fee	Old Amount	New Amount
Changes to international patents fees		
Fee for transmitting international application under the Patent Cooperation Treaty ('PCT')	\$200	\$0
Changes to patent application fees		
Provisional patent application ('provisional application')	\$110	\$100

c. Commentary

Patent Applications: The application fee for both direct route and national phase entry standard applications will increase as will the fee for filing an innovation application.

Patent Examination: All standard exam request fees have increased as have the fees for innovation exam request.

Excess claim fees: Included in the increase in fees is a change in the procedure and calculation of the excess claims fee for patents. These changes will have a significant impact on the timing of the calculation of the excess claims fees, incurring an excess claims fee where there are more than 20 claims, for any patent application where a request for examination is filed on or after 1 October 2024.

Importantly, the calculation of the excess claims fees will be determined on the total number of claims considered during examination. Since the fee is calculated on the total number of claims at the commencement of examination, an application with over 20 claims **will incur the excess claims fee at the time of examination**. For example, an application with 30 claims will incur an official fee of AUD1,250, and an application with 100 claims will incur an official fee of AUD18,750.

The applicant will have 30 days from the date of the Invitation to Pay by which time the fee must be paid, otherwise, the application will be considered to be in a state of lapse. It will be possible to restore the patent within 12 months if the fee is paid.

What to do to avoid excess claims fees: we recommend taking one of the following actions where the as-filed application has more than 20 claims:

- Submit a request for examination **on or before 30 September 2024;**
- If requesting examination **on or after 1 October 2024,** at the same time as filing the request for examination, file an amendment of the specification to reduce the total number of claims to 20 or less; or
- If requesting examination **on or after 1 October 2024,** file an amendment of the specification to reduce the total number of claims to 20 or less, prior to the commencement of examination, that is, between the time of requesting examination and the issuance of a first examination report.

Patent renewals: The patent 4th year and 5th year renewal fees will remain unchanged to assist patent customers who may not at that time be receiving a financial benefit from their patent. The 6th year renewal fee until the 19th year have however increased.

Patent hearings: Patent hearings fees have increased as have the costs that can be awarded.

2. Changes to trade mark fees

a. Increased fees

Description of Fee	Old Amount	New Amount
Filing a statement of grounds and particulars (SGP) in an opposition to registration of a trade mark, or in an opposition to extension of protection to an IRDA:		New fee
<ul style="list-style-type: none"> for each of the fourth and further grounds (if any) 	\$0	\$250
<ul style="list-style-type: none"> for each of the 11th and further registered or protected trade marks that the opposed trade mark is claimed to be substantially identical with, or deceptively similar to (if any) 	\$0	\$250
Requesting amendment of an SGP filed in an opposition to registration of a trade mark, or in an opposition to extension of protection to an IRDA:		New fee
<ul style="list-style-type: none"> for a ground proposed to be added – if that ground would be the fourth or further ground in the SGP 	\$0	\$250
<ul style="list-style-type: none"> for a registered or protected trade mark proposed to be added – if that trade mark would be the 11th or further trade mark that the opposed trade mark is claimed to be substantially identical with, or deceptively similar to 	\$0	\$250
Applying for: <ul style="list-style-type: none"> removal of a trade mark from the Register of Trade Marks for non-use cessation of protection of a protected international trade mark for non-use 	\$250	\$350
Requesting a hearing by the Registrar of Trade Marks	\$400	Repealed
Being heard by written submissions only	\$400	\$500
Oral hearing by remote appearance – for each day or part day (for example, by videoconference)	\$600	\$700
Oral hearing in person – for each day or part day	\$800	\$700
Late filing of evidence in opposition proceedings	\$0	\$500

b. Commentary

Fee increases for TM: There are changes to most fee categories, except for filing fees, which remain unchanged. Further there are fees for trade mark opposition proceedings with the introduction of a new fee structure contingent on the number of grounds of opposition nominated in the Statement of Grounds and Particulars.

3. Changes to design fees

a. Increased fees

Description of Fee	Old Amount	New Amount
Changes to design examination fees		
Request for examination of registered design (by registered owner)	\$420	\$500

b. Decreased Fees

Description of Fee	Old Amount	New Amount
Changes to designs application fees based on filing		
Application for one design	\$250	\$200
Application for several designs – first design (as above) plus each additional design identified in the application	\$200	\$150
Request to amend design application to identify further design	\$250	\$200
Changes to design examination fees		
Request for examination of registered design (by registered owner)	\$420	\$500

c. Commentary

Design applications: Fees for filing a design have decreased. Fees for excess designs will be also reduce.

Design examination: A substantive examination of a design is voluntary and only needs to be pursued if the applicant intends to enforce their Right. The exam request fee will increase.

4. Changes to plant breeder's rights fees

a. Increased fees

Description of Fee	Old Amount	New Amount
Accreditation of a Qualified Person	\$240	\$350
Renewing accreditation of a Qualified Person	\$240	\$350
Lodging an application for grant of plant breeder's rights (PBR application)	\$345	\$400
Examination of PBR application and growing trial		
<ul style="list-style-type: none">examination at a Centralised Testing Centre in Australia (CTC)	\$920	\$1,400
<ul style="list-style-type: none">examination of a plant variety with another variety at the same time and site in Australia (outside a CTC) – amount for each variety	\$1,380	\$1,600
<ul style="list-style-type: none">examination of a test growing in Australia otherwise	\$1,610	\$2,000
<ul style="list-style-type: none">examination based solely on overseas test data	\$1,610	\$2,000
Lodging an application for a declaration of essential derivation	\$800	\$850
Certificate Fee (for grant of PBR)	\$345	\$500
Annual renewal of granted PBR	\$400	\$600

b. Commentary

PBR applications: The PBR application fee will increase.

PBR examinations: The PBR examination fees will also. While these fee increases are substantial, IP Australia notes that they reflect current costs and are reasonable given there have been very few increases over the last 20 years.

PBR renewals: The PBR renewal fees will increase for the annual maintenance of an PBR Right.

About Wrays

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