

AUSTRALIA

Trade Marks Regulations 1995

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Notes to the *Trade Marks Regulations 1995* (omitted)

Part 1 Preliminary

1.1 Name of regulations

These Regulations are the *Trade Marks Regulations 1995*.

1.2 Commencement

These Regulations commence on 1 January 1996.

Part 2 Interpretation

2.1 Interpretation

In these Regulations, unless the contrary intention appears:

ACCC means the Australian Competition and Consumer Commission established under the *Trade Practices Act 1974*.

accredited course of study means a course of study that is accredited by the Board under regulation 20.2A of the *Patents Regulations 1991*.

Act means the *Trade Marks Act 1995*.

certificate of verification means a statement:

(a) that a document to which the statement relates:

(i) has been translated by a person who is proficient in both the language from which the document has been translated into English and English; and

(ii) is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and

(b) that is dated and signed.

earlier application, in relation to an application for the registration of a trade mark for which a right of priority is claimed, means an application for the registration of that trade mark in a Convention country:

(a) that was filed, at the trade marks office (or its equivalent) of that Convention country, before the application for which the right of priority is claimed; and

(b) on which the claim for the right of priority is based.

International Register has the meaning given by regulation 17A.2.

international registration has the meaning given by regulation 17A.2.

IRDA has the meaning given by regulation 17A.2.

Madrid Protocol means the Protocol Relating to the Madrid Agreement concerning the International Registration of Marks, as signed at Madrid on 28 June 1989.

month, for a period with a length expressed in months, has the meaning given by regulation 2.2.

priority date, for a trade mark that is the subject of an IRDA or a protected international trade mark, has the meaning given by regulation 17A.3.

protected international trade mark has the meaning given by regulation 17A.2.

Record of International Registrations has the meaning given by regulation 17A.2.

2.2 Period expressed in months

In these Regulations, a period expressed in months and dating from an event, ends:

- (a) on the day, in the relevant subsequent month, which has the same number as the day of the event; or
- (b) if the relevant subsequent month has no day with the same number -- on the last day of the month.

[Note: This provision displaces section 36 of the *Acts Interpretation Act 1901*, and is in accordance with the Madrid Protocol. The difference between the two occurs when the initiating event is on the last day of a calendar month, which has fewer days than the month in which the period ends. For example, a period of 3 months from an event on 30 September ends on 30 December under this rule; it would end on 31 December under the *Acts Interpretation Act 1901* provision.]

Part 3 Trade marks and trade mark rights

3.1 Classification of goods and services

(1) For the purposes of subsection 19(3) of the Act (which deals with the classification of goods and services):

(a) goods are divided into the classes of goods described in column 2 of Part 1 of Schedule 1; and

(b) services are divided into the classes of services described in column 2 of Part 2 of Schedule 1.

(2) Each class of goods or services described in Schedule 1 has:

(a) a class number corresponding to the item number of that class in column 1 of Part 1 or 2 of Schedule 1; and

(b) a class heading corresponding to the description of that class in column 2 of Part 1 or 2 of Schedule 1.

3.2 Period in which action for infringement may be brought

For the purposes of paragraph 26(1) (b) of the Act (which deals with powers of the authorised user of a trade mark), the prescribed period is 2 months from the day on which the authorised user of a trade mark asks the registered owner of the trade mark to bring an action for infringement of the trade mark.

Part 3A Assisted filing service

Division 1 General

3A.1 Purpose of Part

This Part provides for an assisted filing service to enable a person proposing to make an application under Part 4 of the Act to request:

(a) a preliminary assessment from the Registrar concerning the likelihood of the application for the proposed trade mark being successful under Part 4 of the Act; and

(b) information concerning the requirements for registration under Part 4 of the Act.

3A.2 Definitions for Part

In this Part:

AFS request has the meaning given by regulation 3A.3.

requester has the meaning given by regulation 3A.3.

Division 2 Request for filing assistance

3A.3 Request for filing assistance -- form of request

(1) A person proposing to submit an application under Part 4 of the Act (a **requester**) may submit a request for filing assistance (an **AFS request**) under this Part.

(2) An AFS request must:

(a) be supported by such material and attachments as required by the Registrar having regard to the requirements of Part 4 of the Act in relation to an application for registration; and

(b) be accompanied by the fee prescribed for the AFS request.

(3) An AFS request:

(a) must be submitted in a manner required by the Registrar; and

(b) must contain the name of the requester; and

(c) must contain contact details that includes the business or residential address and a telephone number for the requester, and:

(i) the fax number of the requester; or

(ii) the email address of the requester; and

(d) must include a representation of the trade mark that is sufficient to identify the trade mark; and

(e) must specify the goods and/or services in relation to which the request is made; and

(f) must not relate to a matter notified by the Registrar in the *Official Journal* to be a matter for which an AFS request is not available; and

(g) if the AFS request relates to a matter for which the Registrar has notified conditions in the *Official Journal* -- must comply with the conditions.

(4) If the fee mentioned in paragraph (2) (b) remains unpaid 5 working days after an AFS request is submitted, the AFS request is incomplete and is taken not to have been submitted.

(5) A requester may amend an AFS request before it is assessed by the Registrar by advising the Registrar of the details of the amendments and providing:

(a) any material to be added to the AFS request; and

(b) any other document required by the Registrar in relation to the amendment; and

(c) any fee prescribed in relation to the amendment.

(6) For the fee prescribed for an amendment mentioned in paragraph (5) (c), the Registrar may:

- (a) decide to waive the fee; or
- (b) decide not to waive the fee, and require that payment of the fee be made within the period of 5 working days after that decision.

(7) The Registrar must amend the AFS request on receipt of an amendment:

- (a) that complies with subregulation (5); and
- (b) in respect of which the fee, if any, has been paid.

3A.4 AFS request -- assessment by Registrar

(1) After receiving an AFS request the Registrar must, as soon as practicable, assess the AFS request having regard to the requirements of Part 4 of the Act and form an opinion whether or not:

- (a) the AFS request would, if submitted in that form as an application for registration under Part 4 of the Act, be in accordance with that Part; and
- (b) there would be grounds under Division 2 of Part 4 of the Act for rejecting the AFS request.

(2) After forming an opinion the Registrar must, as soon as practicable, inform the requester of:

- (a) the opinion; and
- (b) the procedural requirements of regulation 3A.5 for making an amendment to the AFS request; and
- (c) the procedural requirements for making an application for the registration of a trade mark under Part 4 of the Act.

(3) The Registrar may inform the requester:

- (a) in writing, by mail, fax or email; or
- (b) by telephone; or
- (c) in person.

3A.5 AFS request -- formal requirements for amendment or proceeding to Part 4 application

(1) The requester may, within 5 working days after being informed by the Registrar under subregulation 3A.4(2):

- (a) amend the AFS request under subregulation 3A.5(2); or
- (b) submit the AFS request as an application for registration of a trade mark under Part 4 of the Act by payment of the fee prescribed for that

Part.

(2) If the requester advises the Registrar under paragraph (1) (a) that the AFS request is to be amended:

(a) for the purpose of adding one or more classes of goods or services to the AFS request; or

(b) to significantly change the graphical representation of the trade mark;

the advice must include:

(c) details of the goods and/or services or the graphical representation; and

(d) any material to be attached to the AFS request; and

(e) any other document required by the Registrar; and

(f) any fee prescribed in relation to the amendment.

(3) For the fee prescribed for an amendment mentioned in subregulation (2), the Registrar may:

(a) decide to waive the fee; or

(b) decide not to waive the fee, and require that payment of the fee be made within the period of 5 working days after that decision.

(4) For an amended AFS request to which subregulation (2) applies, and in respect of which the fee mentioned in subregulation (3) has been paid or waived:

(a) the Registrar must amend the AFS request and as soon as practicable:

(i) assess the amended AFS request in accordance with regulation 3A.4; and

(ii) inform the requester under subregulation 3A.4(2); and

(b) the period mentioned in subregulation (1) is extended to 5 working days after the Registrar informs the requester in accordance with subparagraph (a) (ii).

(5) If the requester advises the Registrar that the AFS request is to be amended for a purpose other than that mentioned in subregulation (2), the Registrar:

(a) must amend the AFS request; and

(b) may assess the amended AFS request, insofar as the Registrar considers practicable, having regard to:

(i) the complexity of the amendments requested; and

(ii) the length of time that remains of the period mentioned in subregulation (1); and

(c) insofar as it has been practicable to assess the amended AFS request -- must inform the requester of the assessment.

(6) An AFS request is discontinued if a requester fails to submit an application under Part 4 of the Act after following the procedure mentioned in subregulation (1).

Part 4 Application for registration

4.1 Applications -- approved form

(1) For subsection 27(2) of the Act (which deals with applications for registration), an application for the registration of a trade mark must be:

- (a) in an approved form; or
- (b) an AFS request mentioned in Part 3A, in respect of which all fees were paid within the prescribed time limits.

(2) Any material that is intended by the applicant to form part of the application for registration of a trade mark:

- (a) must be attached to the application; and
- (b) is taken to be part of the application.

4.2 Application in approved form -- requirements for filing

(1) To be taken to be filed, an application for registration of a trade mark that is in an approved form must:

- (a) state that the application is for registration of the trade mark, or contain a clear indication to that effect; and
- (b) include a representation of the trade mark that is sufficient to identify the trade mark; and
- (c) specify the goods and/or services in relation to which the application is made; and
- (d) include sufficient information to enable the Registrar to establish the identity of the applicant; and
- (e) contain sufficient information to enable the Registrar to contact the applicant.

(2) If an application does not meet a requirement set out in paragraph (1) (a), (b), (c) or (d), the Registrar must give to the applicant written notice of the requirement.

(3) If the applicant meets the requirement within a period of 2 months from the date of the notice, the application is taken to be filed on the day on which the requirement is met.

(4) If the applicant does not meet the requirement within that period, the application is taken not to have been filed.

4.2AA Divisional application -- additional requirement for filing

A divisional application must contain the following information:

- (a) a statement that the application is a divisional application;
- (b) a statement identifying the parent application.

4.2A AFS request submitted as application -- requirements for filing

An AFS request that is submitted as an application for registration of a trade mark under this Part may be taken as having been filed only if the Registrar is satisfied that all fees have been paid in respect of the application within the period of 5 working days mentioned in subregulation 3A.5(1).

4.3 Representation of trade marks

(1) If practicable, the representation of a trade mark included in an application for registration of the trade mark must not exceed 8 centimetres by 8 centimetres.

(2) In an application for the registration of 2 or more trade marks as a series, the representation of each trade mark in the series must, if practicable, not exceed 8 centimetres by 8 centimetres.

(3) In an application for the registration of a trade mark that contains, or consists of, a 3 dimensional shape:

(a) if practicable, the representation of the trade mark in the application must be illustrated in a perspective that shows each feature of the trade mark; and

(b) otherwise, the representation of the trade mark in the application must include views of the trade mark that are necessary to show each feature of the trade mark.

(4) If the Registrar reasonably believes that the views of a trade mark to which paragraph (3) (a) or (b) applies are not sufficient to allow all features of the trade mark to be properly examined, the Registrar may, by notice in writing, require the applicant to give to the Registrar up to 6 additional views of the trade mark that show the features sufficiently to permit proper examination of the trade mark.

(5) If the representation of a trade mark in an application for registration of the trade mark includes words of a language other than English, the applicant must file in support of the application a translation of the words into English, if required to do so by the

Registrar at the time of application or later.

(6) If the representation of a trade mark in an application for registration of the trade mark includes characters constituting words, being characters that are not roman letters, the applicant must file in support of the application:

- (a) a transliteration of the characters into roman letters, using the recognised system of romanisation of the characters (if any); and
- (b) a translation of the words into English.

(7) If a trade mark for which registration is sought contains or consists of a sign that is a colour, scent, shape, sound or an aspect of packaging, or any combination of those features, the application for registration of the trade mark must include a concise and accurate description of the trade mark.

(8) If the Registrar reasonably believes that the description or representation of a trade mark in an application for registration of the trade mark does not:

- (a) demonstrate the nature of the trade mark sufficiently; or
 - (b) show each feature of the trade mark sufficiently;
- to permit proper examination of the trade mark, the Registrar may require the applicant to give to the Registrar:
- (c) a description, or further description, of the trade mark; and
 - (d) a specimen of the trade mark.

(9) If a representation of a single trade mark exceeds, or the representations of the trade marks in a series of trade marks together exceed, 8 centimetres by 8 centimetres, the representation or representations:

- (a) must be attached to the application for registration of the trade mark or trade marks; and
- (b) must be taken to be part of the application.

(10) The representation of a trade mark in an application for registration of the trade mark must be of a kind and quality that:

- (a) ensures that the features of the trade mark will be preserved in the course of time; and
- (b) is suitable for reproduction.

4.4 Specification of goods and/or services

(1) For the purposes of paragraph 27(3)(b) of the Act, the following subregulations set out the manner of specifying, in an application for the registration of a trade mark, the goods and/or services in respect of which registration is sought.

(2) The expression 'all goods', 'all services', 'all other goods', or 'all other services' must not be used in an application for registration of a trade mark to specify the goods and/or services in respect of which registration is sought.

(3) The goods and/or services must be grouped according to the appropriate classes described in Schedule 1.

(4) The applicant must nominate the class number that is appropriate to the goods or services in each group.

(5) The groups must be listed in the order of their class numbers.

(6) The goods and/or services must, as far as practicable, be specified in terms appearing in any listing of goods and services that is:

(a) published by the Registrar; and

(b) made available for inspection by the public at the Trade Marks Office and its sub-offices.

(7) If any of the goods and/or services cannot be specified using terms referred to in subregulation (6), the applicant must provide sufficient information to enable the Registrar to decide the classification of the goods and/or services.

4.5 Period for claiming priority for an application

For the purposes of subsection 29(1) of the Act (which deals with claims for priority), the prescribed period in relation to a claim for a right of priority for an application is 2 working days after filing the application.

4.6 How to claim priority

(1) For the purposes of subsection 29(1) of the Act (which deals with claims for priority), an applicant must claim a right of priority for an application by filing notice of the claim.

(2) Any notice under subregulation (1) must specify, in respect of the earlier application or, if there is more than 1 earlier application, in respect of each earlier application:

(a) the Convention country in which the earlier application was filed at the trade marks office (or its equivalent) of that Convention country; and

(b) the date on which the earlier application was filed.

(3) If, as a result of a claim for a right of priority, more than 1 priority date applies in relation to an application, a person who claims a right of priority under subsection 29(1) of the Act must specify the goods and/or services to which each priority date relates.

(4) The applicant must inform the Registrar of the number allocated to each earlier application in the trade marks office, or its equivalent, of the Convention country in which each earlier application was filed.

4.7 Publication of particulars of application

(1) For the purposes of section 30 of the Act (which deals with publishing particulars of applications), the Registrar must publish the following particulars of the application:

(a) if a number has been allocated to the application in the Trade Marks Office -- the number;

(b) the applicant's name;

(c) the date of filing the application;

(d) if the application is a divisional application -- particulars of the parent application;

(e) particulars of any claim for a right of priority for the application;

(f) the class number or numbers for the goods and/or services in respect of which registration of the trade mark is sought.

(2) The particulars must be published in 1, or more than 1, of the following ways:

(a) publication in the *Official Journal*;

(b) listing in a computer database maintained by the Trade Marks Office;

(c) making a record of the application available, in electronic or other form, in each of the sub-offices of the Trade Marks Office.

(3) If, before 1 January 2001, an application by:

(a) the Sydney Organising Committee for the Olympic Games constituted by the Sydney Organising Committee for the Olympic Games Act 1993 of New

South Wales; or

(b) Sydney Paralympic Organising Committee Limited incorporated under the law of New South Wales;

is accompanied by a written request by the applicant to postpone publication of the particulars of the application, the Registrar must publish the particulars of the application as soon as practicable after the expiration of 3 months after the date on which the application was filed.

4.8 Examination of application -- report to applicant

(1) For the purposes of section 31 of the Act (which deals with examination and reporting), if in the course of an examination of an application the Registrar reasonably believes that:

(a) the application has not been made in accordance with the Act or these regulations; or

(b) there are grounds under Division 2 of Part 4 of the Act for rejecting it;

the Registrar must report that belief in writing to the applicant.

(2) A report under subregulation (1) must include notice of the date on which the application will lapse if it is not accepted earlier.

(3) If the Registrar reasonably suspects that the provisions of paragraph 27(1)(b) of the Act do not apply in relation to all of the goods and/or services specified in an application for registration of a trade mark, the Registrar may require the applicant to make a declaration to the Registrar that those provisions apply to all of those goods and/or services.

[Note: Section 37 of the Act and regulation 4.12 deal with the lapsing of an application before acceptance.]

4.9 Examination -- applicant's response to report

(1) An applicant may respond in writing to the Registrar's report under regulation 4.8.

(2) The response may:

(a) contest a belief of the Registrar that is expressed in the report; and

(b) contest another matter that is mentioned in the report; and

(c) provide further documents or evidence in support of the application;

and

(d) request that the application be amended in accordance with the Act.

[Note: Section 65 of the Act relates to the amendment of an application after particulars of the application have been published.]

4.10 Examination -- further report to applicant

(1) On receipt of a response under regulation 4.9, the Registrar must consider the response.

(2) If the Registrar continues to believe that:

(a) the application has not been made in accordance with the Act or these regulations; or

(b) there are grounds under Division 2 of Part 4 of the Act for rejecting it;

the Registrar must report that belief in writing to the applicant.

(3) Unless acceptance of an application is deferred, a report under subregulation (2) in relation to that application must include notice of the date on which the application will lapse if it is not accepted earlier.

(4) Regulation 4.9 and this regulation apply to a report under subregulation (2) as if it were a report under regulation 4.8.

4.11 Examination -- additional requirements

(1) In the course of an examination of an application for which a right of priority is claimed, the Registrar may require in writing the applicant to file:

(a) a copy of any earlier application certified in the trade marks office (or its equivalent) of the Convention country in which it was filed; and

(b) if the earlier application is not in English:

(i) a translation of the earlier application into English; and

(ii) a certificate of verification relating to the translation.

(2) If the applicant is the successor in title to the person who made the earlier application, the Registrar may require in writing the applicant to file documentary evidence that is sufficient to establish the passing of title to the applicant.

4.12 Periods after which applications lapse

(1) For the purposes of subsection 37(1) of the Act (which deals with lapsing), the prescribed period, for an application in respect of which a report is made under regulation 4.8, is:

(a) except as provided by paragraph (b) -- 15 months from the date of that report (whether or not a further report is made under regulation 4.10); or

(b) if a further report raises grounds under Division 2 of Part 4 of the Act for rejecting the application that were not raised in the report made under regulation 4.8 -- 15 months from the date of the further report.

(2) In determining the period of 15 months for the purposes of paragraph (1) (a) or (b) in relation to an application, no account is to be taken of a period in which acceptance of the application is deferred under regulation 4.13.

(3) An applicant may, before the end of a period prescribed in subregulation (1), or that period as extended under section 224 of the Act or as a result of a previous application of subregulation (4), request the Registrar in writing to extend the period.

(4) The Registrar must, in accordance with a request made under subregulation (3), extend a period, unless:

(a) the period; or

(b) that period as extended under section 224 of the Act or as a result of a previous application of this subregulation; would be extended for more than 6 months after the end of the relevant period prescribed in subregulation (1).

[Note 1: If an extension of the time for acceptance of an application is sought after the end of a prescribed period, or of an extended period mentioned in subregulation 4.12(3), application must be made under section 224 of the Act.]

[Note 2: If a period prescribed in subregulation 4.12(1) has been extended by 6 months, any application for a further extension of time must be made under section 224 of the Act.]

4.13 Deferment of acceptance

(1) The Registrar may, at the request of the applicant in writing, defer acceptance of an application for registration of a trade mark, if:

(a) the request is made within a period prescribed in subregulation

4.12(1); and

(b) the Registrar reasonably believes that there are grounds for rejecting the application under subsection 44(1) or (2) of the Act, or subregulation 4.15A(1) or (2), because of another trade mark:

(i) that is registered by another person; or

(ii) that is a protected international trade mark; or

(iii) in respect of which an application for registration, or an IRDA, has been made by another person; and

(c) the applicant:

(i) is awaiting the finalisation of proceedings in respect of the application for registration of the other trade mark or the IRDA; or

(ii) is seeking to satisfy the Registrar as to:

(A) a matter mentioned in paragraph 44(3)(a) or (b) of the Act or 4.15A(3)(a) or (b) of these Regulations; or

(B) the matters mentioned in subsection 44(4) of the Act or subregulation 4.15A(5);

in relation to the applicant's trade mark and the other trade mark; or

(iii) has filed an application under section 92 of the Act or regulation 17A.48 in respect of the other trade mark and is awaiting the finalisation of proceedings in respect of that application; or

(iv) has begun proceedings to have the Register or the Record of International Registrations rectified in respect of the other trade mark and the proceedings have not been determined or otherwise disposed of; or

(v) is awaiting renewal of the registration of the other trade mark in the period of 6 months after registration of the other trade mark has expired, or removal of the other trade mark from the Register; or

(vi) is awaiting renewal of the international registration of the other trade mark in the period of 6 months after the international registration has expired, or removal of the other trade mark from the International Register.

(2) The Registrar may, on his or her own initiative, defer acceptance of the application within a period that is prescribed in subregulation 4.12(1) or that is extended under section 224 of the Act or subregulation 4.12(4), if:

(a) the time within which proceedings mentioned in paragraph (b) may be begun, or an application mentioned in paragraph (c) may be made, has not ended; or

(b) appeal proceedings under a provision of the Act have begun in a prescribed court in relation to the application; or

(c) an application has been made to the Administrative Appeals Tribunal for review of a decision of the Registrar in relation to the first-mentioned application; or

(d) the Registrar is informed in writing that the applicant has died.

(3) The Registrar must defer acceptance of an application for registration of a certification trade mark when a copy of the rules governing the use of the certification trade mark is sent to the Commission in accordance with regulation 16.2.

(4) The Registrar must notify an applicant in writing:

(a) if the applicant requests the Registrar to defer acceptance of an application -- of the Registrar's decision to defer, or not to defer, acceptance of the application; and

(b) if the Registrar otherwise defers acceptance of an application -- of the provision under which acceptance of the application is deferred.

4.14 Period for which acceptance is deferred

(1) The period for which acceptance of an application is deferred (the **deferment period**) begins immediately after:

(a) for deferral under subregulation 4.13(1) -- the date the Trade Marks Office receives the request; or

(b) for deferral under subregulation 4.13(2) or (3) -- the date of the notice of deferment issued under subregulation 4.13(4).

(2) The deferment period ends:

(a) when the application is withdrawn; or

(b) if paragraph (a) does not apply -- when the Registrar is reasonably satisfied that there are no longer grounds for rejecting the application under subsection 44(1) or (2) of the Act or subregulation 4.15A(1) or (2); or

(c) if paragraphs (a) and (b) do not apply -- in accordance with subregulation (3).

(3) For the purposes of paragraph (2)(c), the deferment period ends:

(a) if acceptance is deferred because of subparagraph 4.13(1)(c)(i) -- when proceedings relating to the registration of, or the extension of protection to, the other trade mark are finalised; and

(b) if acceptance is deferred because of subparagraph 4.13(1)(c)(ii) -- at the end of 6 months from the date of commencement of deferment; and

(c) if acceptance is deferred because of subparagraph 4.13(1)(c)(iii)

-- when proceedings under Part 9 of the Act or regulation 17A.48 in respect of the other trade mark are finalised; and

(d) if acceptance is deferred because of subparagraph 4.13(1) (c) (iv) -- when the proceedings to have the Register or the Record of International Registrations rectified in respect of the other trade mark are determined or otherwise disposed of; and

(e) if acceptance is deferred because of subparagraph 4.13(1) (c) (v) -- when the registration of the other trade mark is renewed or the other trade mark is removed from the Register; and

(ea) if acceptance is deferred because of subparagraph 4.13(1) (c) (vi) -- when the international registration of the other trade mark is renewed or the other trade mark is removed from the International Register; and

(f) if acceptance is deferred because of paragraph 4.13(2) (a) -- at the end of 2 months after the beginning of the period in which:

(i) proceedings mentioned in paragraph 4.13(2) (b) may be begun; or

(ii) an application mentioned in paragraph 4.13(2) (c) may be made; and

(g) if acceptance is deferred because of paragraph 4.13(2) (b) or (c) -- at the end of:

(i) 3 months after the determination, or other disposal, of the proceedings or review; or

(ii) such time as the court to which any appeal is brought or the Administrative Appeals Tribunal, or a court to which any appeal arising from review by the Tribunal is brought, allows;

(h) if acceptance is deferred because of paragraph 4.13(2) (d) -- at the end of a period after the death of the applicant that the Registrar reasonably regards as sufficient in the circumstances; and

(j) if acceptance is deferred because of subregulation 4.13(3):

(i) if the Commission gives a certificate under subsection 175(2) of the Act in respect of the application -- when the Registrar accepts the certification trade mark for registration; and

(ii) if the Commission does not give a certificate under that subsection -- at the end of 2 months after the date of the notice to the Registrar under subsection 175(4) of the Act.

(4) If acceptance of an application is deferred as a result of the operation of more than 1 of the provisions of paragraph 4.13(1) (c) and subregulation 4.13(2), the deferment period ends in accordance with the relevant provision of subregulation (3) under which the deferment period ends later or last, as the case requires.

(5) The Registrar must notify the applicant in writing of:

- (a) the end of a period of deferment; and
- (b) if acceptance is deferred under subregulation 4.13(1) -- the last day of the relevant period prescribed by paragraph 4.12(1) (a) or (b).

4.15 Trade marks containing etc certain signs

For the purposes of paragraph 39 (2) (a) of the Act (which deals with signs), the following signs are prescribed:

- (a) the words 'Patent', 'Patented', 'By Royal Letters Patent', 'Protected International Trade Mark', 'Registered', 'Registered Design', 'Copyright' 'Plant Breeder's Rights', 'EL rights', or words or symbols to the same effect (including the symbols '©' and '®');
- (b) the words 'To counterfeit this is a forgery', or words to the same effect;
- (c) a representation of the Arms, or of a flag or seal, of the Commonwealth or of a State or Territory;
- (d) a representation of the Arms or emblem of a city or town in Australia or of a public authority or public institution in Australia;
- (e) a representation of a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements;
- (f) a sign specified in Schedule 2.

[Note 1: For the meaning of **EL rights**, see section 5 of the *Circuit Layouts Act 1989*.]

[Note 2: A list of the marks mentioned in paragraph 4.15(e) is available at the Trade Marks Office and sub-offices.]

4.15A Grounds for rejection -- trade mark identical etc to trade mark protected under Madrid Protocol

- (1) For section 189A of the Act, and subject to subregulations (3) and (5), an application for the registration of a trade mark (**applicant's trade mark**) in respect of goods (**applicant's goods**) must be rejected if:
- (a) the applicant's trade mark is substantially identical with, or deceptively similar to:
 - (i) a protected international trade mark; or
 - (ii) a trade mark in respect of which the Registrar has received notification of an IRDA;held by another person in respect of similar goods or closely related services; and
 - (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date

for the other trade mark in respect of the similar goods or closely related services.

[Note: Under subsection 189A(3) of the Act, regulations made for the purposes of section 189A:

(a) may be inconsistent with the Act; and
(b) prevail over the Act (including any other regulations or other instruments made under the Act), to the extent of any inconsistency. Division 2 of Part 4 of the Act includes provisions relating to the grounds on which an application for the registration of a trade mark must be rejected.]

(2) For section 189A of the Act, and subject to subregulations (3) and (5), an application for the registration of a trade mark (**applicant's trade mark**) in respect of services (**applicant's services**) must be rejected if:

(a) the applicant's trade mark is substantially identical with, or deceptively similar to:

(i) a protected international trade mark; or
(ii) a trade mark in respect of which the Registrar has received notification of an IRDA;

held by another person in respect of similar services or closely related goods; and

(b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the other trade mark in respect of the similar services or closely related goods.

[Note: Under subsection 189A(3) of the Act, regulations made for the purposes of section 189A:

(a) may be inconsistent with the Act; and
(b) prevail over the Act (including any other regulations or other instruments made under the Act), to the extent of any inconsistency. Division 2 of Part 4 of the Act includes provisions relating to the grounds on which an application for the registration of a trade mark must be rejected.]

(3) If, in a case mentioned in subregulation (1) or (2), the Registrar is satisfied:

(a) that there has been honest concurrent use of the 2 trade marks; or
(b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose.

(4) If the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

(5) If, in a case mentioned in subregulation (1) or (2), the Registrar is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period:

(a) beginning before the priority date for the other trade mark in respect of:

(i) the similar goods or closely related services; or

(ii) the similar services or closely related goods; and

(b) ending on the priority date for the registration of the applicant's trade mark;

the Registrar must not reject the application because of the existence of the other trade mark.

[Note: Section 44 of the Act provides for rejection of an application on the grounds that the trade mark is substantially identical with, or deceptively similar to, a registered trade mark or a trade mark for which registration is being sought.]

4.18 Request for expedited examination of application

(1) A person who applies, or has applied, for the registration of a trade mark:

(a) may request in writing expedited examination of the application; and

(b) must include with the request a declaration stating the reasons for the request.

(2) As soon as practicable after making a decision in relation to a request, the Registrar must give written notice of the decision to the person who made the request.

4.19 Expedited examinations

(1) The Registrar must, to the extent that is practicable, examine applications for the registration of trade marks in relation to which requests under regulation 4.18 are granted:

(a) in the order in which the requests are filed; and
(b) before examination of an application for registration of a trade mark in relation to which:

- (i) a request under regulation 4.18 is not made; or
- (ii) a request made under that regulation is not granted.

(2) In the absence of a request for expedited examination of an application for registration of a trade mark, the Registrar may expedite examination of the application if he or she reasonably believes that expedited examination is warranted.

(3) The relationship of an application mentioned in subregulation (2) to another application for registration of a trade mark is a relevant circumstance for the purposes of that subregulation.

Part 5 Opposition to registration

5.1 Time for filing notice of opposition

For the purposes of subsection 52(2) of the Act (which deals with notice of opposition), the period for filing a notice of opposition is 3 months from the day on which the acceptance of the application is advertised in the *Official Journal*.

5.2 Extension of time for filing -- grounds

(1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.

(2) An application for an extension of time may be made within the period for filing a notice of opposition referred to in regulation 5.1 on 1, or more than 1, of the following grounds and on no other ground:

- (a) an error or omission by an employee;
- (b) an error or omission by the person applying for the extension of time, or by the person's agent;
- (c) circumstances beyond the control of the person applying for the extension of time;
- (d) the conduct of genuine negotiations between that person and the applicant for registration;
- (e) the undertaking of genuine research to decide:
 - (i) whether opposition is justified; or
 - (ii) on the grounds of opposition.

(3) If the period for filing a notice of opposition has ended, an application for extension of time may be made at any time before the trade mark is registered on 1, or more than 1, of the grounds set out in paragraph (2) (a), (b) or (c) and on no other ground.

5.3 Extension of time for filing -- applications

An application for an extension of time in which to file a notice of opposition must:

- (a) be in an approved form; and
- (b) be accompanied by a declaration stating:
 - (i) the facts on which the grounds specified in the application are based; and
 - (ii) if the period for filing a notice of opposition has ended -- the reason why the application was not made before the end of that period.

[Note: Regulations 21.6 and 21.7 deal with making and filing declarations].

5.4 Extension of time for filing -- grant of extension

(1) Subject to subregulations (2) and (4), if the Registrar is reasonably satisfied as to the grounds set out in an application for an extension of time to file a notice of opposition, the Registrar must grant the extension of time.

(2) The Registrar must not grant the extension of time, unless the Registrar:

- (a) is reasonably satisfied that the person applying for the extension of time has served a copy of the application, and the accompanying declaration, on the applicant for registration of the trade mark; and
- (b) has given to both the person applying for the extension of time and the applicant for registration of the trade mark a reasonable opportunity to make representations concerning the application for extension of time.

(3) For the purposes of paragraph (2) (b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

(4) If an application for extension of time is made after the period for filing a notice of opposition has ended, the Registrar must not grant the extension unless the Registrar is reasonably satisfied that there is sufficient reason for the application not being made before the end of that period.

(5) An extension of time must be for such period:

- (a) in the case of an extension of time that is granted on a ground set out in paragraphs 5.2(2) (a), (b) and (c) -- as the Registrar believes is reasonable; or
- (b) in the case of an extension of time that is granted on a ground set out in paragraphs 5.2(2) (d) and (e) -- not exceeding 3 months as the Registrar believes is reasonable.

5.5 Copy of earlier application to be available to opponent

(1) In opposition proceedings relating to an application in respect of which the applicant claims a right of priority, an opponent may in writing ask the Registrar for a copy of an earlier application to be made available.

(2) On receipt of a request under subregulation (1), the Registrar must require in writing the applicant to file:

- (a) a copy of the earlier application certified in the trade marks office (or its equivalent) of the Convention country in which it was filed; and
- (b) if the earlier application is not in English:
 - (i) a translation of the earlier application into English; and
 - (ii) a certificate of verification relating to the translation.

(3) If the applicant is the successor in title to the person who made the earlier application, the Registrar may require in writing the applicant to provide documentary evidence that is sufficient to establish the passing of title to the applicant.

(4) Subregulation (2) does not apply if the applicant has already filed the documents mentioned in that subregulation.

(5) The Registrar must send a copy of the documents mentioned in subregulation (2) to the opponent.

5.6 Opposition proceedings

For the purposes of subsection 54(2) of the Act (which deals with opposition proceedings), regulations 5.7 to 5.17 set out the procedure to be followed in dealing with an opposition after a notice of opposition is filed.

5.7 Evidence in support

(1) If the opponent intends to rely on evidence in support of the opposition, the opponent must serve a copy of the evidence in support on the applicant within 3 months from the day on which the notice of opposition is filed.

(2) As soon as practicable after the opponent serves a copy of the evidence in support on the applicant, the opponent must file with the Registrar:

- (a) the original evidence; and
- (b) a statement setting out the date, place and manner of service of the copy of the evidence on the applicant.

5.8 Notice that opponent will not rely on evidence in support

(1) If the opponent does not intend to rely on evidence in support of the opposition, the opponent must, within 3 months from the day on which

the notice of opposition is filed, serve on the applicant a copy of a notice stating that the opponent does not intend to rely on evidence in support of the opposition.

(2) As soon as practicable after the opponent serves a copy of the notice on the applicant, the opponent must file with the Registrar:

- (a) the original notice; and
- (b) a statement setting out the date, place and manner of service of the copy of the notice on the applicant.

5.9 Evidence in answer

(1) If the applicant intends to rely on evidence in answer to the opposition, the applicant must serve a copy of the evidence in answer on the opponent within the period for service of a copy of that evidence under regulation 5.10.

(2) As soon as practicable after the applicant serves a copy of the evidence in answer on the opponent, the applicant must file with the Registrar:

- (a) the original evidence; and
- (b) a statement setting out the date, place and manner of service of the copy of the evidence on the opponent.

5.10 Period for service of a copy of the evidence in answer

(1) If the opponent complies with regulation 5.7 or 5.8, the period for service of a copy of the evidence in answer to the opposition is 3 months from the day on which the opponent serves on the applicant:

- (a) the copy of the evidence in support referred to in subregulation 5.7(1); or
- (b) the copy of the notice referred to in subregulation 5.8(1).

(2) If the opponent does not comply with regulation 5.7 or 5.8:

- (a) the period for service of a copy of the evidence in answer to the opposition is the period of 3 months from the day notified by the Registrar under paragraph (b); and
- (b) the Registrar must, after the end of the period of 3 months referred to in subregulations 5.7(1) and 5.8(1), notify the parties in writing of the day on which the period for service of a copy of the evidence in answer to an opposition is to begin.

5.11 Notice that applicants will not rely on evidence in answer

(1) If an applicant does not intend to rely on evidence in answer to the opposition, the applicant must serve on the opponent, within the period for service of a copy of the evidence in answer, a copy of a notice stating that the applicant does not intend to rely on evidence in answer to the opposition.

(2) As soon as practicable after the applicant serves a copy of the notice on the opponent, the applicant must file with the Registrar:

- (a) the original notice; and
- (b) a statement setting out the date, place and manner of service of the copy of the notice on the opponent.

5.12 Evidence in reply to evidence in answer

(1) If an opponent intends to rely on evidence in reply to the evidence in answer to the opposition, the opponent must serve a copy of the evidence in reply on the applicant within 3 months after the service on the opponent of a copy of the evidence in answer.

(2) As soon as practicable after the opponent serves a copy of the evidence in reply on the applicant, the opponent must file with the Registrar:

- (a) the original evidence; and
- (b) a statement setting out the date, place and manner of service of the copy of the evidence on the applicant.

5.13 Notice that opponents will not rely on evidence in reply to evidence in answer

(1) If an opponent does not intend to rely on evidence in reply to the evidence in answer to the opposition, the opponent must serve on the applicant, within 3 months after the service on the opponent of a copy of the evidence in answer, a copy of a notice stating that the opponent does not intend to rely on evidence in reply to the evidence in answer to the opposition.

(2) As soon as practicable after the opponent serves a copy of the notice on the applicant, the opponent must file with the Registrar:

- (a) the original notice; and
- (b) a statement setting out the date, place and manner of service of the copy of the notice on the applicant.

5.14 Hearing of opposition

(1) An applicant may ask the Registrar to hear the parties to opposition proceedings, if:

(a) the opponent serves a copy of a notice under subregulation 5.8(1);
or

(b) at the end of the period for service of:

(i) a copy of the evidence in support under subregulation 5.7(1); or

(ii) a copy of the notice under subregulation 5.8(1);

the opponent has not served a copy of the evidence in support or a copy of the notice.

(2) A party to opposition proceedings may ask the Registrar to hear the parties to the opposition proceedings, if:

(a) the applicant serves a copy of a notice under subregulation 5.11(1);
or

(b) at the end of the period for service of:

(i) a copy of the evidence in answer under subregulation 5.9(1); or

(ii) a copy of the notice under subregulation 5.11(1);

the applicant has not served a copy of the evidence in answer or a copy of the notice; or

(c) the opponent serves a copy of the evidence in reply under subregulation 5.12(1) or a copy of a notice under subregulation 5.13(1); or

(d) at the end of the period for serving:

(i) a copy of the evidence in reply under subregulation 5.12(1); or

(ii) a copy of a notice under subregulation 5.13(1);

the opponent has not served a copy of the evidence in reply or a copy of the notice.

(3) The Registrar must comply with a request made in accordance with subregulation (1) or (2).

(4) If:

(a) an applicant may make a request to the Registrar under subregulation (1); or

(b) a party to opposition proceedings may make a request to the Registrar under subregulation (2);

and a request is not made, the Registrar may, on his or her own initiative, give an opportunity to the parties to the opposition proceedings to be heard in relation to those proceedings.

[Note: Regulations 21.15 and 21.16 deal with hearings.]

5.15 Extension of period to serve evidence and service of further evidence

(1) A party to the opposition proceedings may apply to the Registrar:
(a) for an extension of the period for serving a copy of the evidence under regulation 5.7, 5.10 or 5.12; or
(b) for permission to serve a copy of further evidence on the other party.

(2) The Registrar may grant an application on reasonable terms specified by the Registrar.

(3) The Registrar must not grant an application unless the Registrar:
(a) is reasonably satisfied that the applicant has served a copy of the application, and of any documents accompanying the application, on the other party; and

(b) has given the parties a reasonable opportunity to make representations concerning the application; and

(c) is reasonably satisfied that:

(i) in the case of an application to which paragraph (1) (a) applies -- the extension of the period for serving a copy of the evidence; and

(ii) in the case of an application to which paragraph (1) (b) applies -- permission to serve a copy of further evidence;

is appropriate.

(4) For the purposes of paragraph (3) (b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

(5) If the Registrar grants an application under paragraph (1) (b) on terms that include service of a copy of the further evidence within a specified period, a party to the opposition proceedings may apply to the Registrar for an extension of that period.

(6) Subregulations (2), (3) and (4) apply to an application under subregulation (5).

5.16 Conduct of opposition proceedings generally

(1) The Registrar may, at the request of a party to the opposition proceedings or on the initiative of the Registrar, give a direction in relation to the procedure in the proceedings.

(2) A direction given under subregulation (1) must not be inconsistent with these regulations.

(3) The Registrar must not give a direction unless the Registrar:

- (a) is reasonably satisfied that parties to the proceedings have been notified of the proposed direction; and
- (b) has given the parties a reasonable opportunity to make representations concerning the proposed direction; and
- (c) is reasonably satisfied that the proposed direction is appropriate.

(4) For the purposes of paragraph (3) (b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

5.17 Registrar to give notice of dismissal of proceedings

If opposition proceedings are dismissed under section 222 of the Act (which deals with security for costs) or discontinued, the Registrar must notify the parties in writing that the opposition proceedings have been dismissed or discontinued.

5.18 Grounds for opposition to registration of a trade mark -- trade mark identical etc to trade mark protected under Madrid Protocol

(1) For section 189A of the Act, and in addition to anything in Part 5 of the Act, the registration of a trade mark may be opposed on the grounds for rejection mentioned in regulation 4.15A.

[Note: Under subsection 189A(3) of the Act, regulations made for the purposes of section 189A:

- (a) may be inconsistent with the Act; and
- (b) prevail over the Act (including any other regulations or other instruments made under the Act), to the extent of any inconsistency.]

(2) To avoid doubt, and subject to subsection 52(2) of the Act:

- (a) the registration of a trade mark may be opposed on the grounds mentioned in subregulation (1) even if the application for registration of the trade mark was lodged before the commencement of the *Trade Marks Amendment Regulations 2005 (No. 1)*; and

(b) if:

- (i) a person filed a notice of opposition to the registration of a trade mark before the commencement of the *Trade Marks Amendment Regulations 2005 (No. 1)*; and

- (ii) the notice is stated to have been filed on the grounds mentioned in regulation 4.15A (whether or not the notice states other grounds);

the notice of opposition is taken, on and after the commencement of those Regulations, to have been validly filed on the grounds mentioned in regulation 4.15A; and

(c) if:

(i) a person filed a notice of opposition to the registration of a trade mark before the commencement of the *Trade Marks Amendment Regulations 2005 (No. 1)*; and

(ii) the notice is stated to have been filed on the grounds mentioned in section 44 of the Act (whether or not the notice states other grounds); and

(iii) the person was not entitled to file the notice on those grounds; the notice of opposition is taken, on and after the commencement of those Regulations, to have been validly filed on the grounds mentioned in section 44 of the Act.

5.19 Amendment of notice of opposition

(1) Subject to subregulation (2), the Registrar must, at the request of the person who has filed a notice of opposition to the registration of a trade mark, amend the notice of opposition to add as grounds for opposition the grounds for rejection mentioned in regulation 4.15A.

(2) Subregulation (1) applies only if:

(a) the notice of opposition was filed before the commencement of the *Trade Marks Amendment Regulations 2005 (No. 1)*; and

(b) the request for amendment of the notice of opposition is made not later than 3 months after the commencement of those Regulations.

[Note: Section 66 of the Act also allows, but does not require, the Registrar to amend a notice at the written request of the person who filed it if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.]

Part 6 Amendment of application for registration of a trade mark and other documents

6.1 Amendment of applications by Registrar

(1) For the purposes of subsection 63(2) of the Act (which deals with amendment), if the Registrar proposes to amend an application for the registration of a trade mark, the Registrar must give notice in writing to the applicant:

(a) setting out the proposed amendment and the reason for making the amendment; and

(b) stating that the proposed amendment will be made at the end of a reasonable period stated in the notice, unless the applicant objects to the amendment within that period.

(2) If an applicant objects to an amendment proposed by the Registrar within the period mentioned in paragraph (1) (b), the Registrar must not make the amendment unless the objection is withdrawn.

6.2 Request to amend before publication of details

For the purposes of paragraph 64 (b) of the Act (which deals with amendments before publication), the period for requesting an amendment is 14 days after filing the application for the registration of the trade mark.

6.3 Filing of declarations

If a person requests an amendment under section 64 of the Act (which deals with amendments before publication) or paragraph 66(a) of the Act (which deals with amendment of other documents), the Registrar may require the applicant to file a declaration stating:

(a) that a clerical error or obvious mistake was made in the application; and

(b) the circumstances in which the error or mistake was made.

[Note: Regulations 21.6 and 21.7 deal with making and filing declarations.]

6.4 Notification of amendments

If the Registrar amends an application, notice or document under Part 6 of the Act, the Registrar must give notice in writing of the amendment to:

(a) the person who requested the amendment; and

(b) any other person that the Registrar thinks appropriate.

6.5 Amendment after particulars published -- notice of opposition

(1) For subsection 65A(4) of the Act (which deals with opposition to granting a request for amendment after particulars of the application have been published), a person may oppose a request for amendment by filing a notice of opposition with the Registrar.

(2) A notice of opposition must be:

(a) in an approved form; and

(b) filed within 1 month after the request for amendment is advertised in the *Official Journal*.

(3) The opponent must serve a copy of the notice on the applicant.

6.6 Amendment after particulars published -- opposition proceedings

For subsection 65A(4) of the Act (which deals with opposition to granting a request for amendment after particulars of the application have been published), regulations 5.7 to 5.17 (inclusive) apply to an opposition to a request for amendment.

Part 7 Registration of trade marks

Division 1 Initial registration

7.1 Period in which a trade mark can be registered

(1) For the purposes of subsection 68(1) of the Act (which deals with registration), the period for the registration of a trade mark that has been accepted for registration is:

(a) except if paragraph (b) applies -- the period from the beginning of the day on which the acceptance is advertised in the *Official Journal* to the end of:

(i) the day that is 6 months after that day; or

(ii) if a later day is specified under subregulation (2) or (3) -- the day specified in that subregulation; and

(b) in the case of the death of an applicant for registration of the trade mark -- within 12 months of the date of death or within such further period as the Registrar reasonably allows.

(2) If:

(a) proceedings in relation to the registration of the trade mark before a prescribed court or the Administrative Appeals Tribunal are not determined or otherwise disposed of; and

(b) the prescribed court or the Tribunal is satisfied that the registration of the trade mark cannot take place on or before the first-mentioned day in subparagraph (1) (a) (i);

the prescribed court or the Tribunal may specify for the purposes of subparagraph (1) (a) (ii) a day that is later than the first-mentioned day in subparagraph (1) (a) (i).

(3) If:

(a) proceedings in relation to the registration of the trade mark are before the Registrar; and

(b) the Registrar is reasonably satisfied that:

(i) the registration of the trade mark cannot take place on or before the first-mentioned day in subparagraph (1) (a) (i); and

(ii) it is appropriate to do so;

the Registrar may specify, for the purposes of subparagraph (1) (a) (ii), a day that is later than the first-mentioned day in subparagraph (1) (a) (i).

7.2 Particulars to be entered in the Register

For the purposes of paragraph 69(2)(c) of the Act (which deals with particulars), the following other particulars of a trade mark must be entered in the Register:

- (a) if the trade mark is registered as a certification trade mark, a collective trade mark or a defensive trade mark -- an indication to that effect;
- (b) the date of the registration;
- (c) the date on which the Registrar enters the particulars of the registration in the Register under subsection 69(1) of the Act;
- (d) the particulars of any right of priority claimed under section 29 of the Act;
- (e) the filing date of the parent application on which any divisional application is based;
- (f) any number allocated to the parent application for registration of the trade mark;
- (g) the class numbers of the goods and/or services in respect of which the trade mark is registered;
- (h) the address of the owner of the trade mark;
- (i) any other particulars relating to the trade mark that the Registrar reasonably believes to be appropriate.

Division 2 Renewal of registration (general)

7.3 Period for request for renewal

For the purposes of subsection 75(1) of the Act (which deals with requests for renewal), the period within which a person may request the Registrar to renew the registration of a trade mark is 12 months ending on the day on which the registration of the trade mark expires.

7.4 Notice of renewal due -- when and how given

(1) For the purposes of section 76 of the Act (which deals with notice of renewal due), the period in relation to notifying a registered owner that renewal of the registration of a trade mark is due is 2 months ending on the day on which the registration of the trade mark expires.

(2) A notice that the renewal is due must include:

- (a) a statement of the date on which the registration of the trade mark will expire; and
- (b) a statement of any fee payable.

7.5 Notice of renewal

For the purposes of subsection 77(2) of the Act (which deals with renewal), a notice of the renewal of the registration of a trade mark must include:

- (a) a statement that the registration is renewed; and
- (b) the period for which it is renewed.

Division 3 Renewal of registration (registration delayed for 10 or more years after filing date)

7.6 Prescribed period (Act s 80A (3))

For subsection 80A(3) of the Act, the prescribed period is 2 months.

[Note: Paragraph 80A(3) (b) of the Act provides that the prescribed period commences on the Register entry day.]

7.7 Notice about renewal (Act s 80C)

For section 80C of the Act (which deals with renewal of registration, where registration has been delayed for 10 or more years after the filing date of the application for registration) the Registrar's notice to the registered owner of the trade mark must state:

- (a) the date on which the prescribed period expires; and
- (b) the fee payable by the registered owner.

7.8 Notice of renewal (Act s 80E)

For section 80E of the Act (which deals with renewal within the prescribed period), a notice of the renewal of the registration of a trade mark must:

- (a) state that the registration is renewed; and
- (b) state the period or periods for which it is renewed.

Part 8 Amendment and cancellation of registration

8.1 Notice of cancellation

(1) The Registrar must, after receiving a request from the owner of a registered trade mark under subsection 84(1) of the Act, cancel registration of the trade mark if the Registrar is not obliged under subsection 84(2) of the Act to notify a person.

(2) If the Registrar must notify a person under that subsection, the notice must state that unless:

- (a) the request from the owner is sooner withdrawn; or
- (b) a prescribed court determines that the Registrar must not cancel registration of the trade mark;

the Registrar will cancel the trade mark at the end of a period of 2 months from the date of the notice.

(3) If:

(a) before the end of the period of 2 months, each person who is notified advises the Registrar in writing that the person does not object to cancellation of registration of the trade mark -- the Registrar must cancel registration of the trade mark; or

(b) paragraph (a) does not apply -- the Registrar must cancel registration of the trade mark after the end of that period;

unless the request from the owner is withdrawn or a prescribed court determines otherwise.

8.1A Notice of revocation

For subsection 84A(4) of the Act, a notice by the Registrar must be:

- (a) in writing; and
- (b) sent, as the case requires, to the address for service of each of the following:
 - (i) the registered owner;
 - (ii) the person recorded under Part 11 of the Act.

8.2 Amendment or cancellation -- matters for the court

For the purposes of paragraph 89(2)(a) of the Act (which deals with amendment or cancellation by a prescribed court), a prescribed court, in making a decision under subsection 89(1) of the Act on an application for rectification of the Register, must take into account the following matters, so far as they are relevant:

- (a) the extent to which the public interest will be affected if

registration of the trade mark is not cancelled;

(b) whether any circumstances that gave rise to the application have ceased to exist;

(c) the extent to which the trade mark distinguished the relevant goods and/or services before the circumstances giving rise to the application arose;

(d) whether there is any order or other remedy, other than an order for rectification, that would be adequate in the circumstances.

8.3 Grounds for application for rectification of Register -- registered trade mark identical etc to trade mark protected under Madrid Protocol

For section 189A of the Act, and in addition to anything in Part 8 of the Act, an application for the rectification of the Register in relation to a trade mark may be made on the grounds mentioned in subregulation 5.18(1).

[Note: Under subsection 189A(3) of the Act, regulations made for the purposes of section 189A:

(a) may be inconsistent with the Act; and

(b) prevail over the Act (including any other regulations or other instruments made under the Act), to the extent of any inconsistency.]

Part 9 Removal of trade mark from register for non-use

9.1 Applications for removal etc

For paragraph 92(2)(a) of the Act (which deals with applications), an application for the removal of a trade mark from the Register must be in an approved form.

9.2 Notification of applications

(1) This regulation applies to an application under section 92 of the Act.

[Note: The application must be in accordance with the Regulations: see Act, para 92(2)(a) and r 9.1.]

(1A) For subsection 95(1) of the Act (which deals with notification), the Registrar must give notice of the application within 1 month after the application is made.

[Note: Subsection 95(1) of the Act applies to an application made to the Registrar under s 92 of the Act.]

(2) The notice must be given by sending a copy of the application to each person who, in the opinion of the Registrar, needs to know that the application has been filed.

9.3 Notice of opposition to removal

(1) For the purposes of subsection 96(2) of the Act (which deals with notice of opposition), a notice of opposition to an application under section 92 of the Act must be filed with the Registrar within 3 months from the day on which the application is advertised in the *Official Journal*.

(2) The opponent must serve a copy of the notice of opposition on the applicant as soon as practicable after the notice is filed.

[Note: For the requirement to notify the Registrar of service, see regulation 21.8.]

9.4 Opposition proceedings before the Registrar

(1) For the purposes of section 99 of the Act (which deals with opposition proceedings), regulations 5.7 to 5.17 (inclusive) apply, subject to

subregulations (2) and (3), to an opposition to an application under section 92 of the Act.

(2) The Registrar must, if asked to do so by the opponent within the period for serving:

- (a) a copy of the evidence in support under subregulation 5.7(1); or
- (b) a copy of the notice under subregulation 5.8(1);

hear the parties to the opposition proceedings.

(3) If the opponent:

(a) does not serve a copy of the evidence in support in accordance with subregulation 5.7(1); or

(b) serves a copy of a notice under subregulation 5.8(1); or

(c) does not serve a copy of that notice within the time allowed in that subregulation;

and the opponent does not request a hearing under subregulation (2), the opposition proceedings are taken to have ended, but are not taken to have been discontinued or dismissed.

[Note: Regulations 21.15 and 21.16 deal with hearings.]

(4) For section 97 of the Act, there is taken to be no opposition to the application if:

(a) under subregulation (3), opposition proceedings are taken to have ended but are not taken to have been discontinued or dismissed; and

(b) the Registrar is satisfied that the application for removal is in order.

[Note: Section 97 provides for the removal of a trade mark from the Register if an application for removal is unopposed.]

Part 10 Assignment and transmission of trade marks

10.1 Applications for assignment etc to be recorded or entered

For the purposes of paragraphs 107(2)(b) and 109(2)(b) of the Act (which deal with assignment and transmission), the following documents are prescribed:

- (a) a document that establishes the title to a trade mark of the assignee, or of the person to whom the trade mark has been transmitted;
- (b) evidence in writing of consent of the Commission to the assignment of a certification trade mark.

10.2 Recording of assignment etc -- trade marks not registered

(1) For the purposes of paragraph 108(1)(a) of the Act (which deals with assignment and transmission), the Registrar must record particulars of the assignment or transmission of a trade mark in accordance with this regulation unless:

- (a) the application to assign or transmit the trade mark is withdrawn;
- or
- (b) a prescribed court determines otherwise.

(2) If there is no record made under Part 11 of the Act of a person claiming an interest in, or a right in respect of, the trade mark, the Registrar must record the particulars after ascertaining that a claim has not been recorded.

(3) If:

- (a) there is a record made under Part 11 of the Act of a person, or persons, claiming an interest in, or a right in respect of, the trade mark; and
- (b) the Registrar has notified that person, or each of those persons, under subregulation 10.5(1); and
- (c) that person or each of those persons has, within the period of 2 months from the date of the notice mentioned in paragraph (b), given written notice to the Registrar consenting to the assignment or transmission; the Registrar must record the particulars after the Registrar has received the last notice consenting to the assignment or transmission.

(4) If:

- (a) paragraphs (3)(a) and (b) apply; and
- (b) the person, or any of the persons, notified by the Registrar under subregulation 10.5(1) has not consented in writing to the assignment or transmission of the trade mark within the period of 2 months from the

date of the notice;

the Registrar must record the particulars as soon as practicable after the end of that period.

10.3 Particulars of recorded assignment or transmission to be published

For the purposes of paragraph 108(1)(b) of the Act (which deals with assignment and transmission):

(a) the following particulars of an assignment or transmission of a trade mark for which registration is sought must be published:

(i) if a number has been allocated in the Trade Marks Office to the application for registration of the trade mark -- the number;

(ii) the name of the person to whom the trade mark is recorded as having been assigned or transmitted;

(iii) the day on which the particulars of the assignment or transmission were recorded; and

(b) if details of an application for registration of the trade mark have been published in a way described in subregulation 4.7(2) -- the particulars of the assignment or transmission mentioned in paragraph (a) must be published in the same way.

10.4 Recording of assignment etc of registered trade marks

(1) For the purposes of paragraph 110(1)(a) of the Act (which deals with assignment and transmission), the Registrar must record particulars of the assignment or transmission of a trade mark in accordance with this regulation, unless:

(a) the application to assign or transmit the trade mark is withdrawn;
or

(b) a prescribed court determines otherwise.

(2) If there is no record made under Part 11 of the Act of a person claiming an interest in, or a right in respect of, the trade mark, the Registrar must record the particulars in the Register after ascertaining that a claim has not been recorded.

(3) If:

(a) there is a record made under Part 11 of the Act of a person, or persons, claiming an interest in, or a right in respect of, the trade mark; and

(b) the Registrar has notified that person, or each of those persons, under subregulation 10.5(1); and

(c) that person or each of those persons has, within the period of 2 months from the date of the notice mentioned in paragraph (b), given written

notice to the Registrar consenting to the assignment or transmission; the Registrar must record the particulars in the Register after the Registrar has received the last notice consenting to the assignment or transmission.

(4) If:

(a) paragraphs (3) (a) and (b) apply; and

(b) the person, or any of the persons, notified by the Registrar under subregulation 10.5(1) has not consented in writing to the assignment or transmission of the trade mark within the period of 2 months from the date of the notice;

the Registrar must record the particulars in the Register as soon as practicable after the end of that period.

10.5 Notice to persons recorded as claiming right or interest in trade marks

(1) For the purposes of section 111 of the Act, the Registrar must give notice in writing to a person recorded under Part 11 of the Act as claiming an interest in, or a right in respect of, a trade mark stating that the Registrar will record the assignment or transmission of the trade mark at the end of a period of 2 months from the date of the notice, unless:

(a) the application to assign or transmit the trade mark is withdrawn; or

(b) a prescribed court determines otherwise; or

(c) each person to whom the Registrar must give notice under this subregulation has already notified the Registrar in writing that the person consents to the assignment or transmission.

(2) Each notice under subregulation (1) in respect of a particular trade mark must be given on the same day.

Part 11 Voluntary recording of claims to interests in and rights in respect of trade marks

11.1 Amendment of particulars -- claimed interests or rights

(1) For the purposes of sections 115 and 119 of the Act (which deal with amendment and cancellation of particulars), particulars of a claim to an interest in, or to a right in respect of, a trade mark (other than the name, address or address for service of a person whose claim is recorded) entered in the Register or recorded under Division 3 of Part 11 of the Act may be amended in accordance with this regulation.

(2) A request to amend particulars of a claim to an interest in, or to a right in respect of, a trade mark must be made in writing:

(a) together by the person whose claim is recorded and the owner of the trade mark; or

(b) if the request has with it the written consent to the amendment of 1 of the persons mentioned in paragraph (a) -- by the other person mentioned in that paragraph.

(3) If a request is made in accordance with subregulation (2), the Registrar must amend the particulars in accordance with the request.

11.2 Amendment of name, address and address for service -- claims not in the Register

If a person:

(a) whose claim to an interest in, or to a right in respect of, a trade mark for which registration is sought is recorded; and

(b) whose name, address or address for service has changed since the claim was recorded;

gives notice of the new name or address to the Registrar, the Registrar must amend the record accordingly.

[Note: In relation to change of a person's name, address or address for service that is recorded in the Register, see sections 215 and 216 of the Act and regulation 21.3.]

11.3 Cancellation of particulars -- claimed interests or rights

(1) For the purposes of sections 115 and 119 of the Act (which deal with amendment and cancellation of particulars), particulars of a claim to an interest in, or to a right in respect of, a trade mark, entered in the Register or recorded under Division 3 of Part 11 of the Act may be

cancelled in accordance with this regulation.

(2) A request to cancel particulars of a claim to an interest in, or to a right in respect of, a trade mark must be made in writing:

- (a) by the person whose claim is recorded; or
- (b) by the owner of the trade mark; or
- (c) together by the person whose claim is recorded and the owner of the trade mark; or
- (d) if the request has with it the written consent to the cancellation of 1 of the persons mentioned in paragraph (c) -- by the other person mentioned in that paragraph.

(3) If a request is made under paragraph (2) (a), (c) or (d), the Registrar must cancel the particulars in accordance with the request.

(4) If a request is made under paragraph (2) (b), the Registrar must notify in writing the person whose claim is recorded that:

- (a) the request has been made; and
- (b) unless the request is withdrawn or a prescribed court orders otherwise, the Registrar will cancel particulars of the claim in accordance with the request as soon as practicable after the end of a period of 2 months from the date of the notice.

(5) Unless a request made under paragraph (2) (b) is withdrawn or a prescribed court determines otherwise, the Registrar must, as soon as practicable:

- (a) if, before the end of the period mentioned in paragraph (4) (b), a person the particulars of whose claim are recorded informs the Registrar in writing that the person does not object to cancellation of the particulars -- cancel the particulars in accordance with the request; or
- (b) if paragraph (a) does not apply -- cancel the particulars after the end of that period in accordance with the request.

Part 13 Importation of goods infringing Australian trade marks

13.1 Notice of objection to importation -- accompanying documents

For the purposes of subsection 132(2) of the Act (which deals with notices of objection), the following documents are prescribed in relation to a notice given under that subsection, namely a document setting out the particulars of registration of the registered trade mark.

13.2 Notice of objection to importation -- authorised users

(1) For the purposes of subsection 132(3) of the Act (which deals with notices of objection), the period in relation to a request by an authorised user under subsection 132(2) of the Act is 2 months from the day on which the request is made.

(2) For the purposes of subsection 132(3) of the Act, the following documents are prescribed, namely documents that establish that:

(a) the authorised user has the power to give a notice of objection under subsection 132(1) of the Act;

(b) the registered owner was asked to give the notice;

(c) since the request mentioned in paragraph (b) was made, the period prescribed by subregulation (1) in relation to the request has ended.

[Note 1: Examples of documents to which paragraph 13.2(2) (a) refers include an agreement between the registered owner of a trade mark and the authorised user of the trade mark and a declaration of the registered owner that the authorised user of the trade mark is able to give notice of objection.]

[Note 2: An authorised user must also give the documents prescribed by r 13.1 to the Customs CEO -- see subs 132(1) of the Act.]

13.3 Period for compliance with Customs CEO's request for information etc

For the purposes of subsection 143(2) of the Act (which deals with giving information to the Customs CEO), the period for complying with a request under subsection 143(1) of the Act is 10 working days from the day on which the request is made.

13.4 Modification of the Act in its application to Norfolk Island

Part 13 of the Act in its application to Norfolk Island is modified as set out in Schedule 3.

13.5 Modification of the Act in its application to Christmas Island

Part 13 of the Act in its application to Christmas Island is modified as set out in Schedule 4.

13.6 Modification of the Act in its application to Cocos (Keeling) Islands

Part 13 of the Act in its application to the Cocos (Keeling) Islands is modified as set out in Schedule 5.

Part 16 Certification trade marks

16.1 Copy of rules to be filed

For the purposes of subsection 173(1) of the Act, (which deals with rules governing use) an applicant for registration of a certification trade mark must file a copy of the rules governing the use of the certification trade mark at, or as soon as practicable after, the time of filing of the application.

16.2 Documents to be sent to Commission

(1) If, after examining an application, the Registrar is satisfied that:

- (a) the application has been made in accordance with this Act; and
- (b) there are no grounds for rejecting it;

the Registrar must send to the Commission copies of the documents mentioned in subregulation (2).

(2) For subregulation (1), the documents are:

- (a) the application for registration; and
- (b) a notification of any amendment made to the application for registration of a certification trade mark; and
- (c) a copy of the rules governing the use of the certification trade mark; and
- (d) any other document that is relevant to the application.

16.3 Initial assessment of applications by Commission

(1) For the purposes of subsection 175(1) of the Act (which deals with consideration of applications), the Commission must make an initial assessment of an application and of any documents received under regulation 16.2 in relation to the application as soon as practicable after receipt.

(2) As soon as practicable after the initial assessment, the Commission must:

- (a) notify the applicant and the Registrar of the initial assessment; and
- (b) state in the notice to the applicant that the initial assessment will be advertised in the *Official Journal*; and
- (c) state in the notice to the applicant that the applicant, or another person, may:
 - (i) respond in writing to the Commission; and
 - (ii) request the Commission in writing to hold a conference;

in relation to the initial assessment not more than 1 month after the date of publication of the *Official Journal* in which the advertisement is published.

(3) After receiving notice from the Commission, the Registrar must:

- (a) advertise the initial assessment in the *Official Journal*; and
- (b) include in the advertisement a statement mentioned in paragraph (2) (c).

(4) If, in the period that ends 1 month after the date of the advertisement in the *Official Journal* of an initial assessment:

- (a) a person responds in writing to the Commission in relation to a notice under subregulation (2) or an advertisement under subregulation (3); and
- (b) no person requests the Commission in writing to hold a conference on a matter included in the initial assessment;

the Commission must, before making a decision on the application:

- (c) give to the applicant and each respondent a copy of each response to which paragraph (a) refers that is received from another person; and
- (d) invite the applicant and each respondent to make a written submission on each response mentioned in paragraph (c).

16.4 Holding of conferences

(1) If, in the period that ends 1 month after the date of the advertisement in the *Official Journal* of an initial assessment:

- (a) a person requests the Commission in writing to hold a conference on a matter included in the initial assessment; and
- (b) no person otherwise responds in writing to the Commission in relation to a notice under subregulation 16.3(2) or an advertisement under subregulation 16.3(3);

the Commission must hold the conference before it makes a decision on the application.

(2) As soon as practicable after the Commission receives a request under subregulation (1) for a conference, the Commission must:

- (a) invite the applicant and any other person mentioned in subregulation (1):

- (i) to attend the conference; and
 - (ii) to make an oral or written submission at the conference on the views expressed by another person that are mentioned in subparagraph (b) (ii);

and

- (b) give to the applicant and any other person mentioned in subregulation

(1):

- (i) reasonable notice of the time, date and place of the conference; and
- (ii) a reasonable opportunity to express views that are relevant to the conference, either orally at, or by written submission before or during, the conference; and
- (iii) a copy of each written submission to which subparagraph (ii) refers that is made by another person.

(3) If, in the period that ends 1 month after the date of the advertisement in the *Official Journal* of an initial assessment:

- (a) a person requests the Commission in writing to hold a conference on a matter included in the initial assessment; and
 - (b) a person otherwise responds in writing to the Commission in relation to a notice under subregulation 16.3(2) or an advertisement under subregulation 16.3(3);
- the Commission must hold the conference before it makes a decision on the application.

(4) As soon as practicable after the Commission receives a request under subregulation (3) for a conference, the Commission must:

- (a) invite the applicant and any person who has responded in writing to the Commission:
 - (i) to attend the conference; and
 - (ii) to make an oral or written submission at the conference on the views expressed by another person that are mentioned in subparagraph (b) (ii);and
- (b) give to the applicant and any person who has responded in writing to the Commission:
 - (i) reasonable notice in writing of the time, date and place of the conference; and
 - (ii) a reasonable opportunity to express views that are relevant to the conference, either orally at, or by written submission before or during, the conference; and
 - (iii) a copy of each response to which paragraph (3) (b) refers, and of each written submission to which subparagraph (ii) refers, that is made by another person.

(5) If a person who is invited to attend a conference:

- (a) informs the Commission that the person does not wish to attend the conference; or
- (b) does not attend the conference;

the conference may proceed in the absence of the person.

16.5 Consideration of applications

(1) In considering an application for registration of a certification trade mark for the purposes of making a decision under subsection 175(2), (3) or (4) of the Act (which deal with consideration of applications), the Commission must have regard to the matters specified in subregulation (2).

(2) The Commission must have regard to:

(a) the initial assessment; and

(b) any response in relation to a notice under subregulation 16.3(2) or an advertisement under subregulation 16.3(3) that is relevant; and

(c) any relevant submission that is made to the Commission in writing about the initial assessment, whether or not the submission is made in relation to a conference; and

(d) any relevant oral submission made during a conference; and

(e) any other relevant matter.

16.6 Criteria for Commission consideration of rules

For the purposes of paragraph 175(2)(b) of the Act (which deals with criteria for rules governing use), the Commission must have regard to the following criteria:

(a) the principles relating to restrictive trade practices set out in Part IV of the *Trade Practices Act 1974*;

(b) the principles relating to unconscionable conduct set out in Part IVA of that Act;

(c) the principles relating to unfair practices, product safety and product information set out in Part V of that Act.

16.7 Matters to be included in advertisement of adverse decision

For the purposes of paragraph 175(4)(b) of the Act (which deals with advertisement of a decision of the Commission not to give a certificate), the advertisement in the *Official Journal* must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for the review of the decision to which the advertisement relates.

16.8 Applications to vary rules

(1) For the purposes of subsection 178(1) of the Act (which deals with the variation of rules), the registered owner of a certification trade

mark may apply to the Commission to approve a variation of the rules governing the use of the certification trade mark.

(2) An application to approve the variation of the rules governing the use of a registered certification trade mark must:

(a) be in writing; and

(b) have with it a copy of the rules governing the use of the registered certification trade mark that incorporate the proposed variation.

16.9 Consideration of applications to vary rules

(1) The Commission must make an initial assessment of an application for approval of the variation of the rules governing the use of a registered certification trade mark as soon as practicable after it receives the application.

(2) Subregulations 16.3(2), (3) and (4) and regulation 16.4 apply to an application to approve the variation of the rules governing the use of a registered certification trade mark as if a reference in those provisions to an application for registration of a certification trade mark were a reference to an application to approve the variation of the rules governing the use of a registered certification trade mark.

(3) Subregulation 16.5(2) applies to a decision whether to approve an application for variation of the rules governing the use of a registered certification trade mark.

[Note: Subsection 178(3) of the Act requires the Commission, in deciding whether to approve a variation, to have regard to prescribed criteria, which are the criteria set out in regulation 16.6.]

16.10 Decision on variation of rules

(1) The Commission may approve a variation of the rules if the Commission is satisfied that the rules, as varied:

(a) would not be to the detriment of the public; and

(b) are satisfactory having regard to the criteria prescribed in regulation 16.6; and

(c) provide that the attributes a person must have to become an approved certifier are sufficient to enable the person to assess competently whether goods or services meet the certification requirements.

(2) If the Commission approves a variation of the rules, the Commission

must:

- (a) notify the registered owner, in writing, of its decision to approve a variation of the rules; and
- (b) certify in writing that it is satisfied of the matters mentioned in subsection 178(3) of the Act and in subregulation (1); and
- (c) send a copy of the certificate to the Registrar; and
- (d) send a certified copy of the rules as varied to the Registrar.

(3) If the Commission decides not to approve a variation of the rules, the Commission must notify the Registrar and the registered owner, in writing, of its decision not to approve a variation of the rules.

(4) The Registrar must publish in the *Official Journal* notice of the Commission's decision to approve or not approve a variation of the rules.

(5) The notice to be published in the *Official Journal* must include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal for review of the decision to which the notice relates.

[Note: **registered owner** is defined in section 6 of the Act.]

16.10A Assignment of unregistered certification trade marks

(1) An application to the Commission for its consent to the assignment of an unregistered certification trade mark must:

- (a) be made by the applicant for registration of the certification trade mark; and
- (b) state the name, address, and address for service of the prospective assignee; and
- (c) state whether the prospective assignee proposes, after assignment, to apply the same rules governing use of the certification trade mark that the applicant for registration applies, or proposes to apply; and
- (d) if the prospective assignee does not propose to apply those rules:
 - (i) state any variation of the rules that the prospective assignee proposes to apply after assignment; and
 - (ii) have with it a copy of the rules incorporating the proposed variation that the prospective assignee proposes to apply after assignment.

(2) If the prospective assignee does not propose, after the assignment, to apply the same rules governing use of the certification trade mark as the applicant for registration of the trade mark applies, or proposes

to apply, the Commission must have regard to the following matters in considering an application:

- (a) whether under the proposed rules the attributes a person must have to become an approved certifier are sufficient, in the opinion of the Commission, to enable a person to competently assess whether or not goods or services meet the certification requirements;
- (b) whether the proposed rules would not be to the detriment of the public;
- (c) whether the proposed rules are satisfactory, having regard to the criteria prescribed in regulation 16.6.

16.11 Assignment of registered certification trade marks

(1) An application to the Commission for its consent to the assignment of a registered certification trade mark must:

- (a) be made by the registered owner of the certification trade mark; and
- (b) state the name, address, and address for service of the prospective assignee; and
- (c) state whether the prospective assignee proposes to continue after assignment to apply the same rules governing use of the registered certification trade mark that the registered owner of the trade mark applies; and
- (d) if the prospective assignee does not propose to continue to apply those rules:
 - (i) state any variation of the rules that the prospective assignee proposes to apply after assignment; and
 - (ii) have with it a copy of the rules incorporating the proposed variation that the prospective assignee proposes to apply after assignment.

(2) If the prospective assignee does not propose after the assignment to continue to apply the same rules governing use of the registered certification trade mark as the registered owner of the trade mark applies, the Commission must have regard to the following matters in considering an application:

- (a) whether under the proposed rules the attributes a person must have to become an approved certifier are sufficient, in the opinion of the Commission, to enable a person to competently assess whether or not goods or services meet the certification requirements;
- (b) whether the proposed rules would not be to the detriment of the public;
- (c) whether the proposed rules are satisfactory, having regard to the criteria prescribed in regulation 16.6.

16.12 Publication of rules

(1) The Registrar must publish the rules governing the use of the certification trade mark as soon as practicable after a copy of the rules is filed in accordance with subsection 173(1) of the Act.

(2) The Registrar must publish the certified copy of the rules, provided to the Registrar by the Commission in accordance with subsection 175(2) of the Act, as soon as practicable after the Registrar advertises acceptance of the application in the *Official Journal* in accordance with paragraph 176(3)(b) of the Act.

(3) The Registrar may publish the rules, or the certified copy of the rules, in any manner the Registrar thinks fit, including (but not limited to):

- (a) a listing in a computer database that is publicly available; or
- (b) making the rules or certified copy of the rules available for public inspection.

Part 17 Defensive trade marks

17.1 Evidence in support of applications

An applicant for registration of a defensive trade mark must file evidence in support of the application at, or as soon as practicable after, the time of filing of the application.

17.2 Defensive trade mark based on protected international trade mark

(1) This regulation applies if, because of the extent to which a protected international trade mark has been used in relation to all or any of the goods or services in respect of which it is protected, it is likely that the use of the trade mark in relation to other goods or services would be taken to indicate that there is a connection between those other goods or services and the holder of the protected international trade mark.

(2) The holder of the protected international trade mark may apply for its registration as a defensive trade mark in respect of any or all of the other goods or services.

(3) Part 17 of the Act applies for the purposes of an application under subregulation (2) as if:

(a) a reference in that Part to a registered trade mark were a reference to the protected international trade mark; and

(b) a reference in that Part to goods or services in respect of which a trade mark is registered were a reference to goods or services protected by the protected international trade mark; and

(c) a reference in that Part to the registered owner of a trade mark were a reference to the holder of the protected international trade mark; and

(d) the reference in paragraph 187(c) of the Act to a trade mark that is not registered as a trade mark in the name of the applicant included a trade mark that is not a protected international trade mark held by the applicant; and

(e) the reference in section 189 of the Act to a trade mark that is not registered in the name of the registered owner included a trade mark that is not a protected international trade mark held by the registered owner.

Part 17A Protected international trade marks under the Madrid Protocol

Division 1 General

17A.1 Purpose of Part

This Part provides for matters that enable the performance of the obligations of Australia, or obtain for Australia an advantage or benefit, under the Madrid Protocol.

17A.2 Definitions for Part

change of ownership includes assignment or transmission.

Common Regulations means the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating to that Agreement, as in force on 1 April 2007.

Contracting Party of the holder has the meaning given by Rule 1(xxvibis) of the Common Regulations.

date of international registration means the date recorded in the International Register as the international registration date for a trade mark in respect of which a request was made under Article 3ter(1) of the Protocol for extension of protection to Australia.

date of recording means the date recorded in the International Register as the recordal date for a request made under Article 3ter(2) of the Protocol for extension of protection to Australia.

holder means:

(a) in relation to an IRDA or a protected international trade mark -- the person or persons in whose name or names the international registration of the trade mark is recorded in the Record of International Registrations; and

(b) in relation to another international registration of a trade mark -- the person or persons in whose name or names the international registration of the trade mark is recorded in the International Register.

International Bureau means the International Bureau of the World Intellectual Property Organisation.

International Register means the register maintained by the International Bureau for the purposes of the Protocol.

international registration of a trade mark means registration of the mark in the International Register.

international registration designating Australia, or **IRDA**, means a request, made under Article 3ter(1) or (2) of the Protocol, for extension to Australia of the protection resulting from the international registration of a trade mark.

Office of origin has the meaning given by Article 2(2) of the Protocol.

priority date, for a trade mark that is the subject of an IRDA or a protected international trade mark, has the meaning given by regulation 17A.3.

protected international trade mark means a trade mark to which protection resulting from international registration of the mark is extended in Australia in accordance with these Regulations.

Protocol means the Madrid Protocol.

Record of International Registrations means the record required to be kept by regulation 17A.66.

17A.3 Meaning of priority date

(1) The priority date for a trade mark that is the subject of an IRDA in respect of particular goods or services is the date that would be the date of effect of the protection of the trade mark in respect of those goods or services if the trade mark became a protected international trade mark.

(2) The priority date for a protected international trade mark in respect of particular goods or services is the date of effect of the protection of the trade mark in respect of those goods or services.

17A.4 Meaning of date of effect

(1) Subject to subregulation (2), the date of effect of the protection of a protected international trade mark is:

(a) if the request for extension of protection to Australia was made under Article 3ter(1) of the Protocol -- the date of international registration of the trade mark; or

(b) if the request for extension of protection to Australia was made under Article 3ter(2) of the Protocol -- the date of recording of the request.

(2) If:

(a) the request for extension of protection to Australia was in respect of a trade mark whose registration had also been sought in 1 or more Convention countries; and

(b) the holder claimed a right of priority under regulation 17A.15 for protection of the trade mark in respect of particular goods or services; and

(c) the trade mark is a protected international trade mark;

the protection of the trade mark is taken to have had effect:

(d) if an application to register the trade mark was made in only 1 Convention country -- from (and including) the day on which the

application was made in that country; or
(e) if applications to register the trade mark were made in more than
1 Convention country -- from (and including) the day on which the earliest
of those applications was made.

Division 2 Application for international registration of a trade mark

17A.5 Purpose of Division

This Division makes provision for dealing with applications for international registration of trade marks that are to be filed with the International Bureau through the intermediary of the Trade Marks Office.

17A.6 Eligibility to apply for international registration

(1) A person who is:

- (a) the registered owner of a registered trade mark; or
- (b) an applicant for registration of a trade mark;

may apply for international registration of the trade mark.

(2) The person must:

- (a) be an Australian citizen; or
- (b) be domiciled in Australia; or
- (c) have a real and effective industrial or commercial establishment in Australia.

[Note: These requirements are stated in Article 2 (1) (ii) of the Protocol.]

(3) Two or more persons may jointly apply for international registration of a trade mark as allowed by rule 8 of the Common Regulations.

17A.7 Application for international registration

(1) Subject to subregulation (2), the application must:

- (a) comply with the requirements of the Protocol; and
- (b) be filed with the International Bureau through the intermediary of the Trade Marks Office.

(2) The applicant must use the official form issued by the International Bureau or another form that requires the same information and uses the same format as the official form.

17A.8 Functions of Registrar

(1) The Registrar must perform the functions, under the Protocol, of the Office of origin in relation to:

- (a) the application; and
- (b) if the application results in an international registration, the international registration.

(2) In particular, the Registrar must:

(a) check the application; and

(b) certify that the information in the application corresponds with the information held by the Registrar in respect of the application for registration of the trade mark (the **basic application**) or the registration of the trade mark (the **basic registration**), as the case requires; and

(c) if the application results in an international registration -- notify the International Bureau if the basic application or the basic registration is withdrawn, restricted or cancelled or lapses, expires or otherwise ceases to have effect in respect of some or all of the goods or services listed in the international registration:

(i) within 5 years after the date of the international registration; or

(ii) after that time, if the action that resulted in the basic application or the basic registration being so affected began before the end of that 5 year period.

[Note: The detailed functions for the Office of origin are set out in the Protocol and the Common Regulations.]

17A.9 Time limit for Registrar to send application to International Bureau

The Registrar must take all reasonable steps to ensure that the application is received by the International Bureau within 2 months after the date on which it is filed.

17A.10 Subsequent designations

(1) The holder of an international registration for which the Trade Marks Office is the Office of the Contracting Party of the holder may make a request for territorial extension in accordance with Article 3ter(2) of the Protocol.

(2) The request may be made to the International Bureau through the intermediary of the Trade Marks Office.

(3) If a request is made through the Trade Marks Office, the Registrar must perform the functions, under the Protocol, of the Office of the Contracting Party of the holder in relation to the request.

Division 3 International registration designating Australia

Subdivision 1 General

17A.11 Purpose of Division

This Division makes provision for dealing with a request to extend to Australia the protection resulting from international registration of a trade mark.

17A.12 Registrar to examine, and report on, IRDA

If the Registrar receives from the International Bureau a notification of an IRDA, the Registrar must examine and report on:

- (a) whether the IRDA is in accordance with this Division; and
- (b) whether there are grounds under Subdivision 2 for rejecting it.

17A.13 Use of trade mark

(1) The holder of an IRDA:

(a) must be using, or must intend to use, the trade mark that is the subject of the IRDA in relation to the goods, services or goods and services listed in the IRDA; or

(b) must have authorised, or intend to authorise, another person to use the trade mark in relation to those goods, services or goods and services; or

(c) must intend to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods, services or goods and services.

(2) If there is reason to suspect that the holder does not meet a requirement of subregulation (1) in relation to any of the goods or services mentioned in the IRDA, the Registrar may require the holder to make a declaration to the Registrar that those provisions apply to all of those goods and services.

17A.14 Specification of goods and services

(1) The expression 'all goods', 'all services', 'all other goods' or 'all other services' must not be used in an IRDA to specify the goods or services in respect of which protection is sought.

(2) If a term has been identified by the International Bureau as being:

- (a) too vague for the purposes of classification; or
- (b) incomprehensible; or

(c) linguistically incorrect;

the term must not be used in an IRDA to specify the goods or services in respect of which protection is sought, unless the Registrar is satisfied that the term is sufficiently clear in the circumstances.

17A.14A Representation of trade marks

If the representation of a trade mark in an IRDA includes words of a language other than English, the holder of the IRDA must file a translation of the words into English, if required to do so by the Registrar.

[Note: Rule 9(4)(a)(xii) of the Common Regulations provides that a transliteration is required if the trade mark consists of or contains matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals.]

17A.15 Claim for priority

(1) If:

(a) a person has made an application for the registration of a trade mark in 1 or more Convention countries; and

(b) within 6 months after the day on which that application, or the first of those applications, was made, that person or another person (**successor in title**) of whom that person is a predecessor in title makes an IRDA in respect of some or all of the goods, services or goods and services in respect of which registration was sought in that country or those countries;

that person or that person's successor in title may claim a right of priority for the protection of the trade mark in respect of any or all of those goods, services or goods and services.

(2) The right of priority must be claimed in the IRDA that is notified to the Registrar in accordance with this Division.

[Note: Rule 9(4)(iv) of the Common Regulations contains requirements relating to claims for priority.]

(3) The priority claimed is for the protection of the trade mark in respect of the goods, services or goods and services:

(a) if an application to register the trade mark was made in only 1 Convention country -- from (and including) the day on which the application was made in that country; or

(b) if applications to register the trade mark were made in more than

1 Convention country -- from (and including) the day on which the earliest of those applications was made.

[Note: For **Convention country** see section 225 of the Act.]

17A.16 Examination of IRDA -- report to holder

(1) If, in the course of an examination of an IRDA, the Registrar reasonably believes that:

- (a) the IRDA is not in accordance with this Division; or
- (b) there are grounds under Subdivision 2 for rejecting it in whole or in part;

the Registrar must send a report in accordance with rule 17 of the Common Regulations to the holder through the intermediary of the International Bureau.

(2) Such a report is a provisional refusal for the purposes of the Protocol.

(3) The report must include:

- (a) notice of the date by which the Registrar must notify his or her final decision on examination to the International Bureau; and
- (b) notice that the Registrar is not required to consider any response by the holder to the report unless the holder has notified the Registrar, in writing, of the holder's address for service in Australia.

[Note: Under the Protocol, protection must be extended in Australia to a trade mark that is the subject of an IRDA at the end of 18 months after the International Bureau notifies the Trade Marks Office of the IRDA unless, before then, the International Bureau receives:

- (a) notification of a provisional or final refusal from the Trade Marks Office; or
- (b) notification of the possibility that oppositions may be filed after the 18-month period.]

17A.17 Examination -- holder's response to report

(1) The holder of the IRDA may respond in writing to the Registrar's report under regulation 17A.16.

(2) The response may do any of the following:

- (a) contest a belief of the Registrar that is expressed in the report;
- (b) contest another matter that is mentioned in the report;

- (c) provide further documents or evidence in support of the IRDA;
- (d) request a hearing from the Registrar.

(3) The holder must notify the Registrar, in writing, of the holder's address for service in Australia.

17A.18 Examination -- further report to holder

(1) If the holder has complied with subregulation 17A.17(3), the Registrar must:

- (a) consider the holder's response; and
- (b) if the holder requests a hearing, give the holder an opportunity to be heard.

(2) If, after considering the response and (if a hearing is requested) the submissions to the hearing, the Registrar continues to believe that:

- (a) the IRDA is not in accordance with this Division; or
- (b) there are grounds under Subdivision 2 for rejecting it in whole or in part;

the Registrar must tell the holder, in writing, of that belief.

(3) Unless the acceptance of an IRDA is deferred under regulation 17A.21, a report under subregulation (2) about the IRDA must specify the date by which the Registrar must notify his or her final decision on examination to the International Bureau.

(4) Regulation 17A.17 and this regulation apply to a report under subregulation (2) as if it were a report under regulation 17A.16.

17A.19 Examination -- additional requirements

(1) In the course of an examination of an IRDA for which a right of priority is claimed, the Registrar may, by writing, require the holder to file:

- (a) a copy of any earlier application certified in the trade marks office (however described) of the Convention country in which it was filed; and
- (b) if the earlier application is not in English:
 - (i) a translation of the earlier application into English; and
 - (ii) a certificate of verification relating to the translation.

(2) If the holder is the successor in title to the person who made the earlier application, the Registrar may, by writing, require the holder to file documentary evidence that is sufficient to establish the passing of title to the holder.

17A.20 Period within which final decision on examination must be notified

(1) For an IRDA in respect of which a report is made under regulation 17A.16, the Registrar must notify his or her decision under regulation 17A.24 (the **final decision on examination**) to the International Bureau: (a) if paragraph (b) does not apply -- within 15 months from the date of that report (whether or not a further report is made under regulation 17A.18); or (b) if a further report raises grounds under Subdivision 2 for rejecting the IRDA that were not raised in the report made under regulation 17A.16 -- within 15 months from the date of the further report.

(2) In determining the period of 15 months for the purposes of paragraph (1) (a) or (b) in relation to an IRDA, no account is to be taken of any period during which acceptance of the IRDA is deferred under regulation 17A.21.

(3) The holder of an IRDA may, before the end of a period mentioned in subregulation (1), or that period as extended under section 224 of the Act or as a result of a previous application of subregulation (4), request the Registrar in writing to extend the period.

(4) The Registrar must, in accordance with a request made under subregulation (3), extend a period, unless:

- (a) the period; or
- (b) that period as extended under section 224 of the Act or as a result of a previous application of this subregulation; would be extended for more than 6 months after the end of the relevant period mentioned in subregulation (1).

[Note 1: If an extension of the time for acceptance of an IRDA is sought after the end of a period mentioned in subregulation (1), or of an extended period mentioned in subregulation (3), application must be made under section 224 of the Act.]

[Note 2: If a period mentioned in subregulation (1) has been extended by 6 months, any application for a further extension of time must be made under section 224 of the Act.]

17A.21 Deferment of acceptance

(1) The Registrar may, at the written request of the holder, defer acceptance of an IRDA if:

(a) the request is made within a period mentioned in subregulation 17A.20(1); and

(b) the Registrar reasonably believes that there are grounds for rejecting the IRDA under subsection 44(1) or (2) of the Act (as applied by regulation 17A.28) because of another trade mark:

(i) that is registered by another person; or

(ii) that is a protected international trade mark; or

(iii) in respect of which an application for registration, or an IRDA, has been made by another person; and

(c) the holder:

(i) is awaiting the finalisation of proceedings in respect of the application for registration of the other trade mark or the IRDA; or

(ii) is seeking to satisfy the Registrar as to:

(A) a matter mentioned in paragraph 44(3) (a) or (b) of the Act (as applied by regulation 17A.28); or

(B) the matters mentioned in subsection 44(4) of the Act (as applied by regulation 17A.28);

in relation to the holder's trade mark and the other trade mark; or

(iii) has filed an application under section 92 of the Act or subregulation 17A.48(1) in respect of the other trade mark and is awaiting the finalisation of proceedings in respect of that application; or

(iv) has begun proceedings to have the Register or the Record of International Registrations rectified in respect of the other trade mark and the proceedings have not been determined or otherwise disposed of; or

(v) is awaiting renewal of the registration of the other trade mark in the period of 6 months after registration of the other trade mark has expired, or removal of the other trade mark from the Register; or

(vi) is awaiting renewal of the international registration of the other trade mark in the period of 6 months after the international registration has expired, or removal of the other trade mark from the International Register.

(2) The Registrar may, on his or her own initiative, defer acceptance of the IRDA within the period mentioned in subregulation 17A.20(1), or (if such a period is extended under section 224 of the Act or subregulation 17A.20(4)) the extended period, if:

(a) the time within which proceedings mentioned in paragraph (b) may be begun, or an application mentioned in paragraph (c) may be made, has not ended; or

(b) appeal proceedings under a provision of the Act have begun in a

prescribed court in relation to the IRDA; or

- (c) an application has been made to the Administrative Appeals Tribunal for review of a decision of the Registrar in relation to the IRDA; or
- (d) the Registrar is informed in writing that the holder has died.

(3) The Registrar must defer acceptance of an IRDA in respect of a certification trade mark when a copy of the rules governing the use of the certification trade mark is sent to the ACCC in accordance with regulation 16.2 (as applied by regulation 17A.50).

(4) The Registrar must inform the holder in writing:

- (a) if the holder requests the Registrar to defer acceptance of an IRDA -- of the Registrar's decision to defer, or not to defer, acceptance of the IRDA; and
- (b) if the Registrar otherwise defers acceptance of an IRDA -- of the provision under which acceptance of the IRDA is deferred.

17A.22 Period for which acceptance is deferred

(1) The period for which acceptance of an IRDA is deferred (the **deferral period**) begins immediately after:

- (a) for deferral under subregulation 17A.21(1) -- the date the Trade Marks Office receives the request; or
- (b) for deferral under subregulation 17A.21(2) or (3) -- the date of the notice of deferral issued under subregulation 17A.21(4).

(2) The deferral period ends:

- (a) when the IRDA is withdrawn; or
- (b) if paragraph (a) does not apply -- when the Registrar is reasonably satisfied that there are no longer grounds for rejecting the IRDA under subsection 44(1) or (2) of the Act (as applied by regulation 17A.28); or
- (c) if paragraphs (a) and (b) do not apply -- in accordance with subregulation (3).

(3) For paragraph (2)(c), the deferral period ends:

- (a) if acceptance is deferred because of subparagraph 17A.21(1)(c)(i) -- when proceedings relating to the registration of, or the extension of protection to, the other trade mark are finalised; and
- (b) if acceptance is deferred because of subparagraph 17A.21(1)(c)(ii) -- at the end of 6 months from the date of commencement of deferral; and

- (c) if acceptance is deferred because of subparagraph 17A.21(1)(c)(iii) -- when proceedings under Part 9 of the Act or regulation 17A.48 relating to the other trade mark are finalised; and
- (d) if acceptance is deferred because of subparagraph 17A.21(1)(c)(iv) -- when the proceedings to have the Register or the Record of International Registrations rectified in respect of the other trade mark are determined or otherwise disposed of; and
- (e) if acceptance is deferred because of subparagraph 17A.21(1)(c)(v) -- when the registration of the other trade mark is renewed or the other trade mark is removed from the Register; and
- (f) if acceptance is deferred because of subparagraph 17A.21(1)(c)(vi) -- when the international registration of the other trade mark is renewed or the other trade mark is removed from the International Register; and
- (g) if acceptance is deferred because of paragraph 17A.21(2)(a) -- at the end of 2 months after the beginning of the period in which:
 - (i) proceedings mentioned in paragraph 17A.21(2)(b) may be begun; or
 - (ii) an application mentioned in paragraph 17A.21(2)(c) may be made; and
- (h) if acceptance is deferred because of paragraph 17A.21(2)(b) or (c) -- at the end of:
 - (i) 3 months after the determination, or other disposal, of the proceedings or review; or
 - (ii) such time as the court to which any appeal is brought, or the Administrative Appeals Tribunal, or a court to which any appeal arising from review by the Tribunal is brought, allows; and
- (i) if acceptance is deferred because of paragraph 17A.21(2)(d) -- at the end of a period after the death of the holder that the Registrar reasonably regards as sufficient in the circumstances; and
- (j) if acceptance is deferred because of subregulation 17A.21(3):
 - (i) if the ACCC gives a certificate under subsection 175(2) of the Act (as applied by regulation 17A.50) in respect of the IRDA -- when the Registrar accepts the IRDA in respect of the certification trade mark; and
 - (ii) if the ACCC does not give such a certificate -- at the end of 2 months after the date of the notice to the Registrar under subsection 175(4) of the Act (as applied by regulation 17A.50).

(4) If acceptance of an IRDA is deferred as a result of the operation of more than 1 of the provisions of paragraph 17A.21(1)(c) and subregulation 17A.21(2), the deferment period ends in accordance with the relevant provision of subregulation (3) under which the deferment period ends later or last, as the case requires.

- (5) The Registrar must inform the holder in writing of:
- (a) the end of a period of deferment; and
 - (b) if acceptance is deferred under subregulation 17A.21(1) -- the last day of the relevant period mentioned in paragraph 17A.20(1) (a) or (b).

17A.23 Expedited examination

Regulations 4.18 and 4.19 apply in relation to an IRDA as if a reference in those regulations to an application for registration of a trade mark were a reference to the IRDA.

17A.24 Final decision on examination

(1) The Registrar must, after the examination, accept the IRDA unless he or she is satisfied that:

- (a) it is not in accordance with this Division; or
- (b) there are grounds for rejecting it.

(2) The Registrar may accept the IRDA subject to conditions or limitations.

(3) The Registrar must reject an IRDA, in whole or in part, if the Registrar is satisfied that:

- (a) it is not in accordance with this Division; or
- (b) there are grounds for rejecting it, in whole or in part.

17A.25 Notice of final decision on examination

(1) If the Registrar decides to accept the IRDA as notified, the Registrar:

(a) must notify the decision in the *Official Journal*:

(i) specifying the particulars of the IRDA; and

(ii) stating that, unless a notice of opposition is filed within the period allowed under paragraph 17A.29(2) (b), the trade mark that is the subject of the IRDA will be protected in Australia in respect of the goods, services or goods and services in respect of which protection was sought; and

(b) must notify the holder, in writing, of the decision; and

(c) may notify the International Bureau, in writing, of the decision.

(2) If the Registrar made a report under regulation 17A.16 in respect of the IRDA, the Registrar:

(a) must notify the International Bureau of the final decision on examination in accordance with rule 17 of the Common Regulations; and

(b) must notify the holder, in writing, of the final decision on examination; and

(c) if the final decision on examination is to accept the IRDA in whole or in part, must notify the decision in the *Official Journal*:

(i) specifying the particulars of the IRDA; and

(ii) stating that, unless a notice of opposition is filed within the period allowed under paragraph 17A.29(2) (b), the trade mark that is the subject of the IRDA will be protected in Australia, to the extent of the final decision, in respect of the goods, services or goods and services in respect of which protection was sought.

17A.26 Appeal

(1) Section 35 of the Act applies in relation to the Registrar's decision under regulation 17A.24 as if:

(a) the reference in that section to an applicant were a reference to the holder of an IRDA; and

(b) the reference in that section to accepting an application were a reference to accepting an IRDA; and

(c) the reference in that section to rejecting an application were a reference to rejecting an IRDA in whole or in part.

(2) The Registrar:

(a) may inform the International Bureau of an appeal against the Registrar's decision; and

(b) must inform the International Bureau of the decision on the appeal.

17A.27 Revocation of acceptance

(1) If, before the trade mark that is the subject of the IRDA becomes a protected international trade mark, and before the end of 18 months after the International Bureau notified the Registrar of the IRDA, the Registrar becomes satisfied that:

(a) the IRDA should not have been accepted, taking account of all the circumstances that existed when the IRDA was accepted (whether or not the Registrar knew then of their existence); and

(b) it is reasonable to revoke the acceptance, taking account of all the circumstances;

the Registrar may revoke the acceptance of the IRDA.

(2) If the Registrar revokes the acceptance of the IRDA:

(a) the IRDA is taken never to have been accepted; and

(b) this Subdivision again applies in relation to the IRDA.

Subdivision 2 Grounds for rejecting IRDA

17A.28 Grounds for rejecting IRDA

(1) The grounds for rejecting an IRDA are the grounds set out in sections 39 to 44 of the Act, as affected by subregulation (2).

(2) Sections 39 to 44 apply in relation to an IRDA as if:

(a) a reference in those sections:

(i) to an application for the registration of a trade mark were a reference to the IRDA; and

(ii) to an applicant were a reference to the holder of the IRDA; and

(b) the reference in paragraph 41(6)(a) to the filing date in respect of an application were a reference to the date of international registration or the date of recording, as applicable, in respect of the IRDA; and

(c) each reference in subparagraphs 44(1)(a)(i) and (2)(a)(i) to a trade mark registered by another person included a protected international trade mark held by another person; and

(d) each reference in subparagraphs 44(1)(a)(ii) and (2)(a)(ii) to a trade mark whose registration is being sought by another person included a trade mark in respect of which the extension of protection to Australia is being sought by another person.

Subdivision 3 Opposition to IRDA

17A.29 Opposition

(1) If the Registrar has notified in the *Official Journal* the acceptance of an IRDA, a person may oppose the extension of protection in Australia to the trade mark that is the subject of the IRDA by filing a notice of opposition.

(2) The notice of opposition must:

(a) be in an approved form; and

(b) be filed with the Registrar:

(i) within 3 months from the day on which the acceptance of the IRDA is notified in the *Official Journal*; or

(ii) if an extension of time is granted under regulation 17A.30, within the extended time allowed.

(3) The Registrar must notify the International Bureau of the opposition in accordance with rule 16 or 17, as applicable, of the Common Regulations.

17A.30 Extension of time for filing

(1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.

(2) Regulations 5.2, 5.3 and 5.4 (except subregulations 5.4(2) and (3)) apply, with the necessary modifications, to an application for extension of time under subregulation (1).

(3) Subsection 52(5) of the Act applies to an application for extension of time under subregulation (1).

17A.31 Grounds for opposing IRDA

(1) The extension of protection may be opposed on any of the grounds on which an IRDA may be rejected under Subdivision 2, except the ground that the trade mark cannot be represented graphically.

(2) The extension of protection may also be opposed on any of the grounds set out in sections 58 to 61 and section 62A of the Act, as affected by subregulation (3).

(3) Sections 58 to 61 and section 62A apply in relation to an IRDA as if:

(a) a reference in those sections:

(i) to an application for the registration of a trade mark were a reference to the IRDA; and

(ii) to an applicant were a reference to the holder of the IRDA; and

(iii) to the registration of a trade mark were a reference to the extension of protection in Australia to the trade mark that is the subject of the IRDA; and

(b) the reference in paragraph 60(a) to the priority date for the registration of the trade mark were a reference to the priority date for the trade mark that is the subject of the IRDA.

(4) The extension of protection may also be opposed on the grounds that:

(a) a document filed in support of the IRDA was amended contrary to the Act; or

(b) the Registrar accepted the IRDA on the basis of evidence provided, or a representation made, by the holder that was false in a material particular.

[Note: Section 66 of the Act makes provision in relation to amendment of documents filed with the Registrar.]

17A.32 Circumstances in which opposition may proceed in name of a person other than the person who filed the notice

Section 53 of the Act applies in respect of a notice of opposition filed under this Subdivision.

17A.33 Opposition proceedings

(1) The Registrar must give to the opponent and to the holder of the IRDA an opportunity of being heard on the opposition.

(2) Regulations 5.7 to 5.17 apply, with the necessary modifications, for the purposes of the opposition.

(3) Despite subregulations (1) and (2), a requirement to serve a document on the holder, or to give the holder an opportunity to make written representations or to be heard, does not apply until the holder has notified the Registrar, in writing, of the holder's address for service in Australia.

17A.34 Decision on opposition

(1) Unless the opposition proceedings are discontinued or dismissed, the Registrar must decide:

(a) to refuse protection in respect of all of the goods or services listed in the IRDA; or

(b) to extend protection in respect of some or all of the goods or services listed in the IRDA (with or without conditions or limitations); having regard to the extent (if any) to which any ground on which the IRDA was opposed has been established.

(2) The Registrar must tell the International Bureau of his or her decision.

17A.35 Appeal

(1) Section 56 of the Act applies in relation to the Registrar's decision on the opposition as if a reference in that section:

(a) to an applicant were a reference to the holder of an IRDA; and

(b) to a decision under section 55 of the Act were a reference to a decision under regulation 17A.34.

(2) If an appeal is made, the Registrar must tell the International Bureau of the decision on the appeal as soon as practicable after that decision

is made.

Subdivision 3A Cancellation or limitation of an international registration

17A.35A Cancellation

If the International Bureau cancels an international registration in whole or in part the IRDA ceases, to the extent of the cancellation, when the international registration is cancelled.

17A.35B Duties and powers of Registrar -- notification of limitation by International Bureau

(1) This regulation applies if the International Bureau notifies the Registrar that a holder of an international registration in respect of a trade mark that is the subject of an IRDA but has not become protected, has placed a limitation on the registration.

(2) Subject to this regulation, a limitation mentioned in subregulation (1) has effect from the date the limitation was recorded in the International Register in accordance with Rule 27(1) of the Common Regulations.

(3) The Registrar may, within the declaration period declare, under Rule 27(5) of the Common Regulations, that the limitation has:

- (a) no effect on the IRDA; or
- (b) partial effect on the IRDA.

(4) A declaration under subregulation (3):

- (a) has effect from the date the limitation was recorded in the International Register; and
- (b) is not effective unless the Registrar sends a copy of the declaration to the International Bureau during the declaration period.

(5) On appeal from a declaration of the Registrar under subregulation (4), a prescribed court may:

- (a) allow a limitation according to its terms; or
- (b) declare, under Rule 27(5) of the Common Regulations, that the limitation has:
 - (i) no effect in Australia; or
 - (ii) partial effect in Australia.

(6) A decision of a prescribed court under subregulation (5) has effect from the date the limitation was recorded in the International Register.

(7) The Registrar must, after the expiration of the relevant appeal period, make any amendment to the Record of International Registrations that is necessary to give effect to a limitation allowed, or a declaration made, under this regulation.

(8) In this regulation:

declaration period means the period of 18 months after the International Bureau notifies the Registrar that a holder has imposed a limitation on the IRDA.

limitation means a limitation, in respect of Australia, in relation to the goods or services mentioned in an international registration recorded in the International Register under Article 9bis(iii) of the Protocol.

Subdivision 4 Extension of protection

17A.36 When trade mark becomes a protected international trade mark

(1) In this regulation:

appeal period, in relation to an opposition decision, means the period within which an appeal from the decision can be made under regulation 17A.35, not including any extension of the period that the court may allow in a particular case.

opposition period means the period allowed under paragraph 17A.29(2) (b) .

(2) If:

(a) the Registrar accepts an IRDA; and

(b) no opposition to the IRDA is filed within the period allowed under paragraph 17A.29(2) (b) ;

the trade mark that is the subject of the IRDA becomes a protected international trade mark at the end of that period.

(2A) If:

(a) the Registrar accepts an IRDA; and

(b) opposition to the IRDA is filed within the period allowed under paragraph 17A.29(2) (b) ; and

(c) the opposition has been dismissed or withdrawn;

the trade mark that is the subject of the IRDA becomes a protected international trade mark after the opposition has been dismissed or withdrawn.

(3) If:

- (a) the Registrar accepts an IRDA; and
- (b) opposition to the IRDA is filed within the opposition period; and
- (c) the result of the decision on the opposition is that the trade mark that is the subject of the IRDA should be protected in Australia; and
- (d) no appeal from the decision on the opposition is made within the appeal period;

then, subject to subregulation (4), the trade mark becomes a protected international trade mark, to the extent permitted by the decision on the opposition, at the end of the appeal period.

(3A) If:

- (a) the Registrar accepts an IRDA; and
- (b) opposition to the IRDA is filed within the opposition period; and
- (c) an appeal is made from the decision on the opposition within the appeal period, or any extension of that period; and
- (d) the appeal has been dismissed or withdrawn;

the trade mark becomes a protected international trade mark, to the extent permitted by the decision on the opposition, after the appeal has been dismissed or withdrawn.

(4) If:

- (a) the Registrar accepts an IRDA; and
- (b) opposition to the IRDA is filed within the opposition period; and
- (c) an appeal is made from the decision on the opposition within the appeal period, or any extension of that period; and
- (d) the decision on the appeal is that the trade mark that is the subject of the IRDA should be protected in Australia;

the trade mark becomes a protected international trade mark, to the extent permitted by the decision on the appeal, when that decision is made.

(5) If, at the end of 18 months after the Registrar was notified of an IRDA, the International Bureau has not received:

- (a) a notification under subregulation 17A.16(1), 17A.25(2) or 17A.29(3); or
- (b) a notification of the possibility that oppositions may be filed after the 18-month period;

in respect of the IRDA, the trade mark that is the subject of the IRDA becomes a protected international trade mark at the end of the 18-month period.

(6) If:

(a) within 18 months after the Registrar was notified of an IRDA, the International Bureau receives notification of the possibility that oppositions may be filed after the 18-month period; and

(b) opposition to the IRDA is filed within the opposition period; and

(c) the International Bureau does not receive notification under subregulation 17A.29(3) within 7 months after the opposition period begins;

the trade mark that is the subject of the IRDA becomes a protected international trade mark at the end of the 7-month period.

17A.37 Notice that trade mark is a protected international trade mark

(1) If a trade mark becomes a protected international trade mark, the Registrar must:

(a) notify that fact in the *Official Journal*; and

(b) record that fact in the Record of International Registrations.

(2) The notice and record must include particulars of the conditions (if any) and the limitations (if any) to which the protection is subject.

(3) As soon as practicable after receiving notice that a trade mark is a protected international trade mark, the holder must notify the Registrar, in writing, of the holder's address for service in Australia.

17A.38 Disclaimer

(1) The holder of an IRDA or a protected international trade mark may, by notice in writing given to the Registrar, disclaim any exclusive right to use, or authorise the use of, a specified part of the relevant trade mark.

(1A) A notice mentioned in subregulation (1) may be:

(a) given to the Registrar by the holder of the IRDA; or

(b) passed on to the Registrar by the International Bureau as part of an international application.

(2) The disclaimer affects only the rights given under this Part to the holder when protection is extended to the trade mark.

(3) The Registrar must, on extending protection to the trade mark or on receiving notice of the disclaimer (whichever is later), record in the

Record of International Registrations the particulars of the disclaimer.

(4) A disclaimer properly made cannot be revoked.

Division 4 Protected international trade marks -- rights and protection

17A.39 Rights given to, and protection of, protected international trade marks

(1) Subject to this Part, sections 20 to 26, Parts 12, 13 and 14 of the Act (except section 128), and regulations 3.2, 13.1, 13.2, 13.3 and 21.32 apply in relation to a protected international trade mark.

(2) For that application, a reference in those sections, Parts or regulations:

(a) to a registered trade mark or a trade mark that is registered is taken to be a reference to the protected international trade mark or a trade mark that is a protected international trade mark; and

(b) to a registered owner of a trade mark is taken to be a reference to the holder of the protected international trade mark; and

(c) to goods or services in respect of which a trade mark is registered is taken to be a reference to goods or services covered by the protected international trade mark; and

(d) to the date of registration of a trade mark is taken to be a reference to the date of effect of the protection of the trade mark; and

(e) to the Register is taken to be a reference to the Record of International Registrations; and

(f) to a trade mark the registration of which has ceased is taken to be a reference to a protected international trade mark in relation to which the extension of protection in Australia has ceased.

[Note: See regulation 17A.4 for the meaning of ***date of effect***.]

(3) Also for that application:

(a) the reference in paragraph 127(b) to a defendant having applied under subsection 92(3) for an order directing the Registrar to remove a trade mark from the Register is taken to be a reference to the defendant having applied under subregulation 17A.48(2) for an order directing the Registrar to cease protection; and

(b) the reference in paragraph 129(1)(b) to a trade mark alleged to be registered is taken to be a reference to a trade mark alleged to be a protected international trade mark; and

(c) the reference in regulation 13.1 to the particulars of registration of the registered trade mark is taken to be a reference to the particulars of the protected international trade mark recorded in the Record of International Registrations.

17A.40 Circumstances in which action may not be brought

If the international registration of a trade mark is renewed within 6 months after it has expired, an action may not be brought in respect of an act that:

- (a) infringed the trade mark; and
- (b) was done after the international registration had expired and before it was renewed.

[Note: Article 7(4) of the Protocol provides for a 6 month-period of grace for renewal of international registration.]

Division 5 Protected international trade marks -- amendment or cessation of protection

Subdivision 1 Amendment or cessation of protection because of cancellation, limitation or non-renewal of international registration

17A.41 Cancellation of international registration

If the International Bureau cancels, in whole or in part, the international registration of a trade mark that is a protected international trade mark, the trade mark ceases to be a protected international trade mark, to the extent of the cancellation, when the international registration is cancelled.

17A.41A Duties and powers of Registrar -- notification of limitation by International Bureau

(1) This regulation applies if the International Bureau notifies the Registrar that a holder of an international registration in respect of a protected international trade mark has placed a limitation on the registration.

(2) Subject to this regulation, a limitation mentioned in subregulation (1) has effect from the date the limitation was recorded in the International Register in accordance with Rule 27(1) of the Common Regulations.

(3) The Registrar may, within the declaration period declare, under Rule 27(5) of the Common Regulations, that the limitation has:

- (a) no effect on the protected international trade mark; or
- (b) partial effect on the protected international trade mark.

(4) A declaration under subregulation (3):

- (a) has effect from the date the limitation was recorded in the International Register; and
- (b) is not effective unless the Registrar sends a copy of the declaration to the International Bureau during the declaration period.

(5) On appeal from a declaration of the Registrar under subregulation (4), a prescribed court may:

- (a) allow a limitation according to its terms; or
- (b) declare, under Rule 27(5) of the Common Regulations, that the limitation has:

- (i) no effect in Australia; or
- (ii) partial effect in Australia.

(6) A decision of a prescribed court under subregulation (5) has effect from the date the limitation was recorded in the International Register.

(7) The Registrar must, after the expiration of the relevant appeal period, make any amendment to the Record of International Registrations that is necessary to give effect to a limitation allowed, or a declaration made, under this regulation.

(8) In this regulation:

declaration period means the period of 18 months after the International Bureau notifies the Registrar that a holder of an international registration has imposed a limitation on the registration.

limitation means a limitation, in respect of Australia, in relation to the goods or services mentioned in an international registration recorded in the International Register under Article 9bis(iii) of the Protocol.

17A.42 Failure to renew international registration

(1) If the international registration of a trade mark that is a protected international trade mark is not renewed, the trade mark ceases to be a protected international trade mark when the international registration expires.

(2) However, if:

(a) the international registration of a trade mark that is a protected international trade mark (**unrenewed protected international trade mark**) is not renewed; and

(b) an application for the registration of the trade mark, or an IRDA, is made, or has already been made, by a person other than the holder of the unrenewed protected international trade mark;

the unrenewed protected international trade mark is taken to be a protected international trade mark for the purposes of the application or the IRDA, at any time when the registration of the unrenewed protected international trade mark could have been renewed under Article 7 of the Protocol.

Subdivision 2 Amendment or cessation of protection by Registrar

17A.42A Registrar's powers to amend or cease protection

(1) If all the conditions in subregulation (2) are met, the Registrar may do any of the following:

(a) declare that the protection extended to a protected international trade mark is ceased;

(b) impose a condition or limitation on the protection extended to a protected international trade mark;

(c) if a protected international trade mark is already subject to a condition or limitation -- impose or substitute an additional or different condition or limitation on the protection extended to the protected international trade mark;

(d) remove or amend an entry in the Record of International Registrations relating to a protected international trade mark.

(2) For subregulation (1) the conditions are as follows:

(a) within 12 months after the trade mark became a protected international trade mark the Registrar gave notice in writing of the Registrar's intention to exercise a power or powers mentioned in subregulation (1), to:

(i) the holder of the protected international trade mark; and

(ii) any person recorded under regulation 17A.62 as claiming an interest or right in respect of the protected international trade mark;

(b) the Registrar gave the opportunity to be heard to each person mentioned in subparagraph (a) (i) or (ii), in relation to the Registrar's intention to exercise a power mentioned in subregulation (1);

(c) the Registrar is satisfied, having regard to all the circumstances that existed when the trade mark became a protected international trade mark (whether or not the Registrar knew then of their existence), and the grounds for refusing protection mentioned in regulations 17A.31, that:

(i) the trade mark should not have become protected for some or all of the goods or services in respect of which it is protected; or

(ii) the protection of the trade mark should have been subject to a condition or limitation, or an additional or different condition or limitation;

(d) the Registrar is satisfied that it is reasonable to exercise the power or powers mentioned in subregulation (1).

(3) For paragraph (2) (c), the circumstances to which the Registrar must

have regard include the following:

- (a) any error or omission (including an error or omission of judgment) that led directly or indirectly to the trade mark becoming protected for some or all of the goods or services in respect of which it is protected;
- (b) any relevant obligation of Australia under an international agreement;
- (c) any special circumstances making it appropriate, in the opinion of the Registrar, that:
 - (i) the trade mark not be protected for some or all of the goods or services in respect of which it is protected; or
 - (ii) the protection of the trade mark be subject to a condition or limitation, or an additional or different condition or limitation.

(4) For paragraph (2)(d), in deciding whether or not it is reasonable to exercise a power or powers, the matters to which the Registrar must have regard include the following:

- (a) any use that has been made of the trade mark;
- (b) any past, current or proposed legal proceedings relating to the trade mark as a protected international trade mark or seeking amendment or cessation of its protection;
- (c) any other action taken in relation to the trade mark as a protected international trade mark;
- (d) any special circumstances making it appropriate for the Registrar to exercise or not to exercise a power or powers mentioned in subregulation (1).

(5) The Registrar does not have a duty to consider whether or not to exercise a power under this Subdivision, whether or not the Registrar has been requested to do so.

17A.42B Notice to be given

(1) For paragraph 17A.42A(2)(a), the Registrar may give a written notice to the holder by sending it to:

- (a) the address for service in Australia recorded for the holder in the Record of International Registrations; or
- (b) if there is no address for service recorded for the holder in the Record of International Registrations -- the address for the holder.

(2) The Registrar may notify any person if the Registrar is satisfied that it would be reasonable to do so in all the circumstances.

17A.42C Hearings and procedure

(1) The Registrar may conduct the following hearings under this Subdivision:

(a) a hearing at which the Registrar may determine whether or not to exercise a power or powers mentioned in subregulation 17A.42A(1);

(b) a preliminary hearing at which the Registrar may give directions as to the procedure to be adopted in a hearing mentioned in paragraph (a).

(2) The Registrar may determine the procedure to be adopted in a hearing under this subdivision as the Registrar sees fit, according to the circumstances in the particular case.

(3) Regulation 21.14 does not apply to a hearing under this subdivision.

[Note: Regulation 21.14 provides for the conduct of proceedings generally under these Regulations.]

(4) The Registrar may hear any person if the Registrar is satisfied that it would be reasonable to do so in all the circumstances.

17A.42D Effect of amendment or cessation of protection by Registrar

(1) This regulation applies if the Registrar exercises any of the powers mentioned in subregulation 17A.42A(1).

(2) Subject to subregulation (3), the exercise by the Registrar of a power mentioned in subregulation 17A.42A(1) is taken to have had effect from the date of effect of the protection of the protected international trade mark, and in particular:

(a) any reduction in scope of the protection is taken to apply from that date; and

(b) any condition or limitation imposed by the Registrar is taken to have had effect from that date; and

(c) any removal or amendment of an entry in the Record of International Registrations is taken to have had effect from that date.

[Note: See regulation 17A.4 for the meaning of **date of effect**.]

(3) For subregulation (2), the exercise of a power mentioned in subregulation 17A.42A(1) has effect as follows:

(a) for the application of a provision in Part 12, 13 or 14 of the Act as applied by regulation 17A.39, or a provision in Part 13 of these

regulations -- from the date the power is exercised;

(b) for the application of subsection 230(2) of the Act as applied by regulation 17A.71:

(i) in relation to a defendant who was the holder of the protected international trade mark before the exercise of the power -- from the date the power is exercised; or

(ii) in relation to a defendant who was an authorised user of the protected international trade mark before the exercise of the power -- from the date the defendant becomes aware of the exercise of the power.

17A.42E Registrar to notify Customs CEO

(1) If the Registrar exercises a power mentioned in subregulation 17A.42A(1) the Registrar must notify the Customs CEO in writing.

(2) Despite paragraph 17A.42D(3) (a), if the Customs CEO seizes under Part 13 goods in respect of which the protected international trade mark was protected before the exercise of a power mentioned in subregulation 17A.42A(1), the Commonwealth is not liable for any loss or damage suffered because of the seizure unless:

(a) the Registrar gives the Customs CEO written notice in accordance with subregulation (1); and

(b) the seizure occurs after the notice is given to the Customs CEO.

(3) To avoid doubt, subregulation (2) does not, by itself, make the Commonwealth liable if the circumstances described in paragraphs (2) (a) and (b) exist.

17A.42F Appeal to Federal Court

A person who made submissions to the Registrar, or was heard by the Registrar, during the course of proceedings mentioned in paragraph 17A.42C(1) (a), may appeal to the Federal Court from a decision of the Registrar to exercise, or not exercise, a power mentioned in subregulation 17A.42A(1).

Subdivision 3 Amendment or cessation of protection by prescribed court

17A.43 Amendment or cessation of protection -- contravention of condition

A prescribed court may, on the application of the Registrar or an aggrieved person, order that:

(a) the protection extended to a protected international trade mark cease;

or

(b) an entry in the Record of International Registrations relating to the protected international trade mark be removed or amended; on the ground that a condition or limitation entered in the Record of International Registrations in relation to the protected international trade mark has been contravened.

17A.44 Amendment or cessation of protection -- loss of exclusive rights to use trade mark

(1) This regulation applies if section 24 or 25 of the Act, as applied by regulation 17A.39, (***applied section 24 or 25***) applies in relation to a particular protected international trade mark.

(2) A prescribed court may, on the application of the Registrar or an aggrieved person, but subject to subregulation (3) and regulation 17A.46, order that:

(a) the protection extended to the protected international trade mark cease; or

(b) an entry in the Record of International Registrations relating to the protected international trade mark be removed or amended; having regard to the effect of applied section 24 or 25 (as the case requires) on the right of the holder of the protected international trade mark to use the trade mark, or any sign that is part of the trade mark, in relation to particular goods or services.

(3) If applied section 24 or 25 applies in relation to the trade mark because the trade mark contains a sign that:

(a) has become generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service; or

(b) describes or is the name of:

(i) an article or substance that was formerly exploited under a patent; or

(ii) a service that was formerly provided as a patented process;

the court may decide not to make an order under subregulation (2).

(4) Instead, the court may allow the trade mark to continue to be protected in respect of:

(a) the article or substance or other goods of the same description; or

(b) the service or other services of the same description;

subject to any condition or limitation that the court imposes.

17A.45 Amendment or cessation of protection -- other specified grounds

(1) Subject to subregulation (2) and regulation 17A.46, a prescribed court may, on the application of the Registrar or an aggrieved person, order that:

- (a) the protection extended to a protected international trade mark cease; or
- (b) an entry wrongly made or remaining in the Record of International Registrations be removed or amended; or
- (c) a condition or limitation affecting the protection of a protected international trade mark be entered in the Record of International Registrations.

(2) An application under this regulation may be made on any of the following grounds:

- (a) any of the grounds on which the extension of protection could have been opposed under regulation 17A.31;
- (b) because of circumstances applying when the application under this regulation is filed, the use of the trade mark is likely to deceive or cause confusion;
- (c) for a certification trade mark -- the ground in section 177 of the Act as applied by regulation 17A.50;
- (d) if the application is in respect of an entry in the Record of International Registrations, the entry was made, or has been amended, as a result of fraud, false suggestion or misrepresentation.
- (e) because the Registrar wrongfully made a declaration under subregulation 17A.35B(3) or 17A.41A(3).

17A.46 Amendment or cessation may not be granted if holder not at fault etc

(1) The court may decide not to grant an application made:

- (a) under regulation 17A.44; or
- (b) on the ground that the trade mark is liable to deceive or confuse (a ground referred to in paragraph 17A.45(2)(a)); or
- (c) on the ground referred to in paragraph 17A.45(2)(c);

if the holder of the protected international trade mark satisfies the court that the ground relied on by the applicant has not arisen through an act or fault of the holder.

(2) In making a decision under subregulation (1), the court:

- (a) must take into account the following matters, so far as they are relevant:

- (i) the extent to which the public interest will be affected if protection of the protected international trade mark is not ceased;
 - (ii) whether any circumstances that gave rise to the application have ceased to exist;
 - (iii) the extent to which the trade mark distinguished the relevant goods and services before the circumstances giving rise to the application arose;
 - (iv) whether there is any order or other remedy, other than an order under regulation 17A.44 or 17A.45, that would be adequate in the circumstances; and
- (b) may take into account any other matter that the court considers relevant.

17A.47 Duties and powers of Registrar

Section 90 of the Act applies, with the necessary modifications, for the purposes of an application under regulation 17A.43, 17A.44 or 17A.45.

[Note: Article 5(6) of the Protocol requires the Registrar to notify the International Bureau of an invalidation of the effect of an international registration.]

Subdivision 4 Cessation of protection for non-use

17A.48 Cessation of protection for non-use

(1) Subject to subregulation (2), a person may apply to the Registrar for a trade mark that is, or may become, a protected international trade mark to cease to be protected.

(2) An application may not be made under subregulation (1) if an action concerning the trade mark is pending in a prescribed court, but the person may apply to the court for an order directing the Registrar to cease the protection.

(3) Part 9 of the Act and Part 9 of these Regulations apply in relation to an application mentioned in subregulation (1) or (2).

(4) For that application, a reference in those Parts:

(a) to a registered trade mark or a trade mark that is registered, or entered on the Register, is taken to be a reference to a protected international trade mark or a trade mark that is a protected international trade mark; and

(b) to removing a trade mark from the Register is taken to be a reference to ceasing protection of a trade mark as a protected international trade mark; and

(c) to an application for registration of a trade mark is taken to be a reference to an international registration designating Australia; and

(d) to an applicant for registration of a trade mark is taken to be a reference to the holder of an international registration designating Australia; and

(e) to a registered owner of a trade mark is taken to be a reference to the holder of a protected international trade mark; and

(f) to an application under section 92 is taken to be a reference to an application under subregulation (1); and

(g) to the date on which the application for registration of the trade mark was filed, or the filing date in respect of the application for registration of the trade mark, is taken to be a reference to:

(i) if the request for extension of protection to Australia was made under Article 3ter(1) of the Protocol -- the date of international registration of the trade mark; or

(ii) if the request for extension of protection to Australia was made under Article 3ter(2) of the Protocol -- the date of recording of the request.

[Note: The expressions ***date of international registration and date of recording*** are defined in regulation 17A.2.]

(5) Also for that application, the reference in subregulation 9.4(1) to regulations 5.7 to 5.17 is taken to be a reference to those regulations modified as necessary for the purposes of an opposition to an application under subregulation (1).

(6) Despite subregulation (3), the Registrar is not required to take any action in response to a notice of opposition to an application under subregulation (1) unless the opponent has notified the Registrar, in writing, of the opponent's address for service in Australia.

(7) If the result of an action mentioned in subregulation (1) or (2) is that the Registrar decides, or is directed by a court:

(a) to cease protection of a protected international trade mark in respect of some or all of the goods or services covered by the protection; or

(b) that the trade mark should be protected subject to conditions or

limitations;

the Registrar must, if no appeal has been made at the end of any relevant appeal period, notify the International Bureau of that decision or order.

Division 6 Collective and certification trade marks

17A.49 Collective trade marks

(1) The provisions of this Part, of the Act as applied by this Part, and sections 164 to 167 of the Act, apply in relation to a collective trade mark that is the subject of an IRDA or that is a protected international trade mark.

[Note: See section 162 of the Act for the meaning of **collective trade mark**.]

(2) For that application:

(a) a reference to a trade mark is taken to include a collective trade mark; and

(b) a reference to an application for the registration of a collective trade mark is taken to be a reference to an IRDA in respect of the collective trade mark; and

(c) a reference to an association in whose name a collective trade mark is registered is taken to be a reference to the association that is the holder of the relevant protected international collective trade mark; and

(d) despite subparagraph 17A.28(2)(a)(ii), a reference in section 41 of the Act to the applicant is taken to be a reference to the members of the association that is the holder of the relevant IRDA; and

(e) the use of a collective trade mark by a member of the association that is the holder of the relevant IRDA or protected international collective trade mark is taken to be a use of the collective trade mark by the holder.

(3) In this regulation:

protected international collective trade mark means a collective trade mark that is a protected international trade mark.

17A.50 Certification trade marks

(1) Part 16 of the Act and Part 16 of these Regulations (except regulation 16.1) apply in relation to a certification trade mark that is the subject of an IRDA or that is a protected international trade mark.

[Note: See section 169 of the Act for the meaning of **certification trade mark**.]

(2) For that application, a reference in those Parts:

(a) to an application for registration of a certification trade mark is taken to be a reference to an IRDA in respect of a certification trade mark; and

(b) to an applicant for registration of a certification trade mark is taken to be a reference to the holder of an IRDA in respect of a certification trade mark; and

(c) to a registered certification trade mark, or a certification trade mark that is registered, is taken to be a reference to a certification trade mark that is a protected international trade mark; and

(d) to the registered owner of a registered trade mark is taken to be a reference to the holder of a protected international trade mark that is a certification trade mark; and

(e) to goods or services in respect of which a certification trade mark is registered is taken to be a reference to goods or services in respect of which a certification trade mark is protected; and

(f) to assignment of a certification trade mark is taken to be a reference to change of ownership of a certification trade mark.

(3) Also for that application:

(a) a reference in section 170 of the Act to another provision of the Act is taken to be a reference to that other provision as it is applied by this Part to a trade mark that is the subject of an IRDA or that is a protected international trade mark; and

(b) each reference in section 170 and 171 of the Act to a certification trade mark is taken to be a reference to a certification trade mark that is the subject of an IRDA or that is a protected international trade mark; and

(c) each reference in Part 16 of these Regulations to the prospective assignee is taken to be a reference to the new holder of the international registration in respect of Australia who is identified in the notification to the Registrar under Rule 27(1) of the Common Regulations.

(4) For subsection 173(1) of the Act, the holder of an IRDA in respect of a certification trade mark must file a copy of the rules governing the use of the certification trade mark with the Registrar as soon as practicable after the Registrar is notified of the IRDA.

(5) When the holder files a copy of the rules in accordance with subregulation (4), the holder must notify the Registrar, in writing, of the holder's address for service in Australia.

Division 7 Transformation of cancelled international registrations

17A.51 Application of Division

This Division applies if:

- (a) the international registration of a trade mark is cancelled, in whole or in part, by the International Bureau at the request of the Office of origin, in accordance with Article 6(4) of the Protocol; and
- (b) the trade mark is the subject of an IRDA or is a protected international trade mark; and
- (c) within 3 months after the date on which the international registration was cancelled, the person who held the international registration files with the Trade Marks Office an application for registration of the trade mark (a **transformation application**); and
- (d) the transformation application is in relation to any of the goods and services to which the cancellation applies that were listed in the IRDA, or covered by the protected international trade mark, immediately before the cancellation.

17A.52 Transformation of IRDA

(1) If the trade mark is the subject of an IRDA, the Act and these Regulations apply for the purposes of the transformation application as if it were an application for registration.

(2) However:

- (a) the filing date for the transformation application is taken to be the date of international registration or the date of recording, as applicable; and
- (b) anything already done under this Part for the purposes of the IRDA is to be treated as having been done for the purposes of the transformation application.

17A.53 Transformation of protected international trade mark

(1) If the trade mark is a protected international trade mark, the Registrar must register the trade mark.

(2) The date of registration of the trade mark is taken to be:

- (a) the date of international registration or the date of recording, as applicable; or
- (b) if the IRDA in respect of the trade mark included a priority claim, the priority date allowed under that claim.

Division 8 Concurrence between registration and international registration

[Note: The Protocol makes provision for this as 'Replacement of a National or Regional Registration by an International Registration': see Article 4bis.]

17A.54 Effect of registration and protection of the same trade mark

(1) This regulation applies if:

- (a) a trade mark that is a registered trade mark becomes a protected international trade mark; and
- (b) the registered owner of the trade mark is the holder of the protected international trade mark; and
- (c) all the goods and services covered by the registered trade mark are covered by the protected international trade mark.

(2) The date of effect of protection of the protected international trade mark in respect of all the goods and services covered by the registered trade mark is taken to be the date of registration of the registered trade mark.

(3) The protected international trade mark has the priority date of the registered trade mark in respect of all the goods and services covered by the registered trade mark.

(4) The holder of the protected international trade mark may file an application in the approved form for particulars of the international registration of the trade mark to be entered in the Register.

(5) If the Registrar receives an application under subregulation (4), the Registrar must:

- (a) enter the particulars in the Register; and
- (b) notify the International Bureau in accordance with rule 21 of the Common Regulations.

(6) This regulation does not affect the rights and protections conferred under the Act in respect of the registered trade mark.

17A.55 Effect of cancellation, removal or expiry of registered trade mark

(1) Subregulations 17A.54(2) and (3) cease to apply if:

- (a) the registration of the trade mark is cancelled (otherwise than at

the request of the registered owner); or
(b) the trade mark is removed from the Register.

(2) However, if the registration of the trade mark expires or is cancelled at the request of the registered owner, those subregulations continue to apply.

Division 9 Change in ownership of international registration

17A.56 Application of Division

This Division applies if the Registrar receives notification from the International Bureau of a change of ownership of the international registration of a trade mark that is the subject of an IRDA or is a protected international trade mark.

[Note: **Change of ownership** is defined in regulation 17A.2 to include assignment or transmission.]

17A.57 Collective trade marks

If the trade mark is a collective trade mark, the Registrar must make a declaration in accordance with rule 27(4) of the Common Regulations that the change of ownership has no effect in Australia.

17A.58 Protected certification trade marks

(1) If the trade mark is a certification trade mark that is a protected international trade mark, the Registrar must make a declaration to the International Bureau in accordance with rule 27(4) of the Common Regulations that, subject to subregulation (2), the change of ownership has no effect in Australia.

(2) If the Registrar receives evidence in writing of the consent of the ACCC to the change of ownership, the Registrar must notify the International Bureau that the change of ownership may be given effect in Australia.

17A.58A Unprotected certification trade marks

(1) If the trade mark is a certification trade mark that is the subject of an IRDA, and:

(a) a copy of the IRDA and the rules governing the use of the certification trade mark has been received by the ACCC; and

(b) the trade mark has not become a protected international trade mark; the Registrar must make a declaration to the International Bureau in accordance with Rule 27(4) of the Common Regulations that, subject to subregulation (2), the change of ownership has no effect in Australia.

(2) If the Registrar receives evidence in writing of the consent of the ACCC to the change of ownership, the Registrar must notify the International Bureau that the change of ownership may be given effect

in Australia.

17A.59 Trade marks affected by claimed interests and rights

(1) If a person is recorded under regulation 17A.62 as claiming an interest in, or a right in respect of, the trade mark, the Registrar must:

(a) make a declaration to the International Bureau in accordance with rule 27(4) of the Common Regulations that, subject to subregulation (2), the change of ownership has no effect in Australia; and

(b) give notice in writing to the person stating that the change of ownership will have effect at the end of 2 months from the date of the notice unless the person serves on the Registrar an order of a prescribed court directing the Registrar not to withdraw the declaration.

(2) At the end of the 2-month period, if a court order has not been served on the Registrar as mentioned in paragraph (1) (b), the Registrar must notify the International Bureau that the change of ownership may be given effect in Australia.

17A.60 Recording change of ownership

If the change of ownership has effect in Australia, the Registrar must record it in the Record of International Registrations.

[Note: If regulation 17A.57, 17A.58 or 17A.59 does not apply to the trade mark, the change of ownership of the international registration has effect in Australia in accordance with the Protocol.]

Division 10 Recording of claimed interests and rights

17A.61 Application to have claims recorded

(1) A person who claims an interest in, or a right in respect of, a trade mark that is the subject of an IRDA or is a protected international trade mark may apply to the Registrar to have particulars of the claim recorded by the Registrar.

(2) The application must:

(a) be made jointly with the holder of the IRDA or protected international trade mark; and

(b) be made in an approved form; and

(c) be filed with the Trade Marks Office.

17A.62 Recording of claims

If the application is made in accordance with regulation 17A.61, the Registrar must record in the Record of International Registrations particulars of the claim.

17A.63 Notification of matters affecting trade mark

The Registrar must notify each person who has a claim recorded in respect of a trade mark of any matter affecting the trade mark that is notified to the Registrar by the International Bureau.

17A.64 Record not proof etc of existence of right etc

The fact that a record has been made by the Registrar under this Division that a person claims an interest in, or a right in respect of, a trade mark is not proof or evidence that the person has the right or interest claimed.

17A.65 Amendment or cancellation of record

(1) Particulars recorded under this Division may be:

(a) amended in accordance with subregulations 11.1(2) and(3); or

(b) cancelled in accordance with subregulations 11.3(2), (3), (4) and

(5).

(2) Those subregulations apply for the purposes of this regulation as if a reference to the owner of the trade mark were a reference to the holder of the relevant IRDA or protected international trade mark.

Division 11 Miscellaneous

17A.66 Record of International Registrations

(1) The Registrar must maintain a Record of International Registrations for the purposes of this Part.

(2) The Record of International Registrations must include the following particulars in respect of each IRDA notified to the Registrar by the International Bureau:

- (a) the name of the holder;
- (b) the address of the holder;
- (c) the goods, services or goods and services in respect of which protection is sought;
- (d) the claims of interest (if any) affecting the trade mark that is the subject of the IRDA;
- (e) any other particulars that are required by the Act, these Regulations, the Protocol or the Common Regulations to be recorded in respect of the IRDA;
- (f) any other particulars relating to the IRDA that the Registrar reasonably believes to be appropriate.

(3) The Record of International Registrations must include the following particulars in respect of each protected international trade mark:

- (a) the name of the holder;
- (b) the address of the holder;
- (c) the goods, services or goods and services in respect of which the trade mark is protected;
- (d) the conditions (if any) and limitations (if any) subject to which the trade mark is protected;
- (e) the claims of interest (if any) and disclaimers (if any) affecting the protected international trade mark;
- (f) any other particulars that are required by the Act, these Regulations, the Protocol or the Common Regulations to be recorded in respect of the protected international trade mark;
- (g) any other particulars relating to the protected international trade mark that the Registrar reasonably believes to be appropriate.

17A.67 Inspection

(1) The Record of International Registrations must be available at the Trade Marks Office for inspection by any person during the hours when the Office is open for business.

(2) Subregulation (1) is satisfied if a person who wants to inspect the Record of International Registrations is given access to a computer terminal from which he or she can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in it.

17A.68 Evidence -- the Record of International Registrations

(1) The Record of International Registrations is evidence of any particular or other matter entered in it.

(2) A copy of, or extract from, the Record of International Registrations that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.

[Note: Section 211 of the Act makes provision in relation to certificates given by the Registrar and certified copies of documents held in the Trade Marks Office.]

17A.69 Evidence -- international instruments

(1) In any proceedings relating to a trade mark that is the subject of an IRDA or is a protected international trade mark, a copy of any of the following documents is admissible in evidence:

(a) the WIPO Gazette of International Marks published by the International Bureau;

(b) an entry in or extract from the International Register, issued by the International Bureau;

(c) any other instrument, or an entry in or extract from any other instrument, issued by the International Bureau.

(2) In any such proceedings:

(a) an instrument that purports to have been issued by the International Bureau is taken to have been issued by the International Bureau unless the contrary is proved; and

(b) an instrument that purports to be the WIPO Gazette of International Marks published by the International Bureau is taken to be that Gazette unless the contrary is proved.

(3) Also in any such proceedings, evidence of the Protocol or the Common Regulations may be adduced by producing a book or pamphlet containing the Protocol or the Common Regulations that purports to have been printed by authority of:

- (a) the World Intellectual Property Organization; or
- (b) another person or body that the court considers to be a reliable source of information.

17A.70 Correction of errors or omissions in Record of International Registrations

(1) The Registrar may, on his or her own initiative, correct any error or omission in the Record of International Registrations.

(2) A prescribed court may, on the application of an aggrieved person, order that the Registrar rectify the Record of International Registrations by:

- (a) entering anything wrongly omitted from it; or
- (b) correcting any error in it.

(3) Section 90 of the Act applies, with the necessary modifications, for the purposes of an application under subregulation (2).

17A.71 Passing off actions

Subsection 230(2) of the Act applies for the purposes of an action for passing off arising out of the use of a protected international trade mark in the same way as it applies for the purposes of an action for passing off arising out of the use of a registered trade mark.

17A.72 Documents to be made available for public inspection

Section 217A of the Act and regulation 21.11A apply in relation to:

- (a) a trade mark that is the subject of an IRDA; or
- (b) a protected international trade mark;

as if the reference in subsection 217A(1) to the time particulars of the application for registration of the trade mark are published under section 30 were a reference to the time of inclusion of the particulars of the IRDA in the Record of International Registrations under subregulation 17A.66(2).

17A.73 Security for costs

If a person who neither resides nor carries on business in Australia:

- (a) gives notice of opposition to an IRDA under regulation 17A.29; or
- (b) applies to the Registrar under regulation 17A.48 for the cessation of the protection extended to a protected international trade mark;

the Registrar may require the person to give security for the costs of the proceeding and may, if security is not given, dismiss the proceeding.

Part 19 Administration

19.1 Trade Marks Office and sub-offices -- business hours

The hours of business of the Trade Marks Office and each sub-office of the Trade Marks Office are from 9 am to 5 pm on each day other than:

- (a) a Saturday or a Sunday; or
- (b) a public holiday:
 - (i) where the Office or sub-office is located; or
 - (ii) for the purposes of the Australian Public Service in that place.

19.2 Persons to whom Registrar may delegate (Act, s 206(1))

For subsection 206(1) of the Act, a person holding, or performing the duties of, an office in the Trade Marks Office stated in Schedule 6 is a person to whom the Registrar may delegate all or any of the Registrar's powers or functions under the Act.

Part 20 Registered trade marks attorneys

Division 1 General

20.1 Interpretation

(1) In this Part:

AQF means the Australian Qualifications Framework.

Board means the Professional Standards Board for Patent and Trade Marks Attorneys.

Register or **Register of Trade Marks Attorneys** means the register kept under section 228A of the Act.

(2) For regulation 20.6, the **higher education sector** comprises:

(a) universities; and

(b) higher education institutions other than universities; and

(c) higher education providers.

Division 2 Obtaining registration for first time

20.2 Form of application

An application for registration as a trade marks attorney must:

- (a) be in writing, in a form approved by the Designated Manager; and
- (b) be accompanied by evidence and material mentioned in regulation 20.3; and
- (c) be accompanied by the fee mentioned in item 28 of Schedule 9.

20.3 Evidence that applicant meets registration requirements

(1) An application for registration as a trade marks attorney must be accompanied by the following:

- (a) evidence that the Board is satisfied that the applicant has, or is entitled to the award of, an academic qualification of a kind mentioned in regulation 20.6;
- (b) evidence that the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a trade marks attorney;
- (c) a statutory declaration, by the applicant, that he or she:
 - (i) has not, in the 5 years preceding the application, committed an offence prescribed by subregulation 20.10 (1); and
 - (ii) is not under sentence of imprisonment for an offence prescribed by subregulation 20.10 (2);
- (d) a statutory declaration, by another person, that the applicant is of good fame, integrity and character.

(2) A statutory declaration under paragraph (1) (d) must contain details of the basis of the opinion that the applicant is of good fame, integrity and character.

20.4 Certificate of registration

If the Designated Manager registers a person as a trade marks attorney, the Designated Manager must give the person a certificate of registration.

20.5 Evidence of academic qualifications

(1) The Board must be satisfied that a person has a qualification mentioned in regulation 20.6 if:

- (a) the person makes an application in the form approved by the Board; and
- (b) the application is accompanied by:
 - (i) evidence that the person has the qualification; and

(ii) the original or a certified copy of an academic record that shows the units that make up the qualification.

(2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the qualification, notify the person, in writing, of its decision.

[Note: A decision that a person does not have a qualification is reviewable under regulation 21.35.]

20.6 Academic qualifications

The Designated Manager must not approve an applicant for registration as a trade marks attorney unless the applicant has or is entitled to:

- (a) an AQF qualification from the higher education sector; or
- (b) a qualification awarded by an overseas institution that the Board is satisfied is equivalent to an AQF qualification from the higher education sector.

20.7 Evidence of knowledge requirements

(1) The Board must be satisfied that a person has a knowledge requirement mentioned in regulation 20.8 if:

- (a) the person makes an application in the form approved by the Board; and
- (b) the application is accompanied by:
 - (i) evidence that the applicant has the relevant knowledge; and
 - (ii) the original or a certified copy of any academic record that shows the study that contributes to the knowledge.

(2) The Board must, within 42 days of deciding whether or not it is satisfied that the person has the knowledge requirement, notify the person, in writing, of its decision.

[Note: A decision that a person does not have a knowledge requirement is reviewable under regulation 21.35.]

20.8 Knowledge requirements

(1) The Designated Manager must not approve an applicant for registration as a trade marks attorney unless the Board is satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a trade marks attorney.

(2) Subject to subregulations (3), (4) and (5), the Board must, in

satisfying itself whether or not an applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a trade marks attorney, take into account whether the applicant has qualifications that meet the minimum requirements set out in Schedule 5 to the *Patents Regulations 1991*.

[Note: Schedule 5 to the *Patents Regulations 1991* applies to a trade marks attorney as modified by regulation 20.11 of these Regulations.

(3)The Board may publish guidelines setting out criteria for deciding whether or not areas of study:

(a)are likely to meet the minimum requirements set out in Schedule 5 to the *Patents Regulations 1991*; and

(b)are likely to provide a person with the appropriate level of understanding to practise as a trade marks attorney.

(4)The Board may be satisfied that an applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a trade marks attorney, despite the fact that the applicant does not meet every requirement set out in Schedule 5 to the *Patents Regulations 1991*.

(5)The Board is not able to be satisfied that the applicant has the knowledge of intellectual property law and practice that is required for a person to practise as a trade marks attorney if the knowledge requirements on which the applicant relies were obtained more than 10 years prior to the application.

(6)If an applicant has been granted an exemption under regulation 20.9, the applicant is taken to meet the requirement in Schedule 5 to the *Patents Regulations 1991* for which the exemption is granted.

[Note: Subsection 228A (4) of the Act provides that the Designated Manager must register as a trade marks attorney a person who satisfies certain conditions. Paragraph 228A (4) (a) requires that a person hold such qualifications as are specified in, or ascertained in accordance with, the Regulations.

20.9 Exemption from a requirement in Schedule 5 to Patents Regulations

(1)The Board may exempt an applicant from having to satisfy all or some of the requirements mentioned in Schedule 5 to the *Patents Regulations*

1991.

(2) The Board must not give an exemption to an applicant unless:

(a) the applicant makes an application in the form approved by the Board;
and

(b) the applicant gives the Board enough information for the Board to be satisfied under paragraph (c); and

(c) the Board is satisfied that:

(i) the applicant has passed a course of study at a satisfactory level;
and

(ii) the course of study has outcomes that are the same as, or similar to, those of a knowledge requirement for which the exemption is sought.

(3) The Board may give an exemption under subregulation (1) if it is satisfied that the applicant has successfully completed a relevant course of study within the 5 years preceding the application or within a longer period specified in writing by the Board.

(4) An exemption under subregulation (1) is valid for 5 years from the date that the exemption was granted or for a longer period specified in writing by the Board.

20.10 Prescribed offences

(1) For paragraph 228A (4) (c) of the Act, an offence against the Act, the *Designs Act 2003* or the *Patents Act 1990* is a prescribed offence.

(2) For paragraph 228A (4) (d) of the Act, an offence of dishonesty for which the maximum penalty is imprisonment for at least 2 years is a prescribed offence.

20.11 Application of Schedule 5 to Patents Regulations

Schedule 5 to the *Patents Regulations 1991* applies to obtaining registration as a trade marks attorney for the first time as if item 5 in Part 5 provided:

'5. A course of study must provide for a student to have an appropriate level of understanding of the system of protecting and exploiting trade marks, both in Australia and other countries.'

Division 3 Accreditation of courses of study

20.12 Accreditation of courses of study

Part 3 of Chapter 20 of the *Patents Regulations 1991* applies to the accreditation of a course of study for the purposes of Schedule 5 to the *Patents Regulations 1991* in its application to the registration of a trade marks attorney under this Part as if references to 'patent attorney' were references to 'trade marks attorney'.

Division 4 Board examinations

20.13 Board examinations

Part 4 of Chapter 20 of the *Patents Regulations 1991* applies to a requirement referred to in Schedule 5 to the *Patents Regulations 1991* in its application to the registration of a trade marks attorney under this Part as if references to 'patent attorney' were references to 'trade marks attorney'.

Division 5 Maintaining registration, removal from Register and returning to Register

20.14 Maintaining registration, removal from Register and returning to Register

Parts 5, 6 and 7 of Chapter 20 of the *Patents Regulations 1991* apply to a trade marks attorney in its application to the registration of a trade marks attorney under this Part as if:

- (a) references to 'patent attorney' were references to 'trade marks attorney'; and
- (b) references to the 'Register' were references to the 'Register of Trade Marks Attorneys'; and
- (c) references to 'trade marks attorney' were references to 'patent attorney'; and
- (d) the reference in paragraph 20.22 (1) (a) of the *Patents Regulations 1991* to 'item 105 or 106 of Schedule 7' were a reference to 'item 29 or 30 of Schedule 9'; and
- (e) the reference in regulations 20.26 and 20.27 of the *Patents Regulations 1991* to the 'Register of Patent Attorneys' were a reference to the 'Register of Trade Marks Attorneys'; and
- (f) the reference in regulations 20.29, 20.30 and 20.31 of the *Patents Regulations 1991* to 'item 107 of Schedule 7' were a reference to 'item 31 of Schedule 9'.

Division 6 Discipline

20.15 Discipline

Part 8 of Chapter 20 of the *Patents Regulations 1991* applies to a registered trade marks attorney as if:

- (a) references to a 'registered patent attorney' were references to a 'registered trade marks attorney'; and
- (b) references to a 'registered trade marks attorney' were references to a 'registered patent attorney'; and
- (c) the reference in regulation 20.49 of the *Patents Regulations 1991* to 'the Register of Patent Attorneys' were a reference to 'the Register of Trade Marks Attorneys'.

Division 7 Rights of registered trade marks attorneys

20.16 Lien

A registered trade marks attorney has the same right of lien over documents and property of a client as a solicitor.

Part 21 Miscellaneous

Division 1 Applications and other documents

21.1 Compliance with instructions on approved forms

If:

(a) an application, notice or request under the Act or these regulations is required to be in an approved form; and

(b) a blank form that may be used in making an application or request or giving notice:

(i) is supplied by the Registrar; and

(ii) contains directions about completing that form;

the person who completes the form must comply with those directions.

21.2 Filing of documents -- requirements as to form

(1) A document to be filed at the Trade Marks Office must comply with the requirements set out in Schedule 7.

(2) If the document does not comply with the requirements in Schedule 7, the Registrar may return the document to the person from whom it was received with a statement setting out the requirements that have not been complied with.

(4) If a person files a copy of a document, the Registrar may require the person to file the original document.

21.3 Filing of documents -- common requirements

(1) A person who files an application, notice or request must include in the application, notice or request the business or residential address of:

(a) the person making the application or request or giving the notice; or

(b) the person on whose behalf the application, notice or request is made.

(2) If an address recorded in the Register or included in an application, notice or request that is filed changes, the person whose address changes, or a person acting on behalf of that person, must notify the Registrar of the new address.

(3) If the Registrar is notified of a new address, the Registrar must amend the Register, application, notice or request accordingly.

[Note: Section 212 of the Act also deals with the making and signing of applications, notices and requests.]

21.4 Filing of documents -- treatment of non complying documents

If a document received for filing at the Trade Marks Office fails to comply with the Act or these regulations, the Registrar may:

- (a) treat the document as not having been filed at the Trade Marks Office;
- or
- (b) treat the document as having been filed, but require the person who filed the document to make, or cause to be made, any alterations to the document that are necessary to enable the document to so comply.

[Note: Regulations 4.2 and 4.2A set out requirements with which applications for the registration of trade marks must comply to be taken as having been filed.]

21.5 Filing of documents -- date of receipt to be marked

(1) A document that is received for filing must be marked by the Registrar with the date on which it is received.

(2) If the Trade Marks Office or a sub-office provides a facility for the receipt of documents (other than documents filed electronically or by facsimile transmission), when the Trade Marks Office or sub-office is not open to the public for business, a document received by means of that facility is taken to have been received on the day on which the Trade Marks Office or sub-office was last open to the public for business before the document was received.

(3) Except as otherwise provided by the Act or these regulations, a document is taken to be filed at the Trade Marks Office on the date on which it is received by the Trade Marks Office.

21.6 Declarations

(1) In this regulation:

diplomatic or consular officer means a person who holds any of the following offices of the Commonwealth in a country other than Australia:

- (a) ambassador;
- (b) high commissioner;
- (c) minister;
- (d) chargé d'affaires;
- (e) counsellor or second or third secretary at an embassy, high commission

or other post;

(f) consul-general;

(g) consul;

(h) vice-consul.

(2) A declaration required by the Act or these regulations to be given to the Registrar must:

(a) be headed with the title of the matter for which the declaration is made; and

(b) be expressed in the first person; and

(c) state the name and address of the person making the declaration; and

(d) state the name and title of the person before whom the declaration is made; and

(e) state the date on which, and the place at which the declaration is made; and

(f) be divided into paragraphs, each of which must be:

(i) numbered consecutively; and

(ii) as far as practicable, confined to 1 subject.

(2A) If the declaration is made on behalf of another person, it must also state the other person's name and address.

(2B) If the declaration is made for the purposes of a business whose details are set out in the declaration, it must also state:

(a) the office or position in the business held by the person who makes the declaration; and

(b) the address of the place at which the business is conducted or principally conducted.

(3) A declaration may be made before:

(a) a magistrate; or

(b) a justice of the peace; or

(c) a commissioner for affidavits; or

(d) a commissioner for declarations; or

(e) a notary public; or

(f) a registered patent attorney; or

(g) a person before whom a statutory declaration may be made under the *Statutory Declarations Act 1959* or the law of the State, Territory or foreign country where the declaration is made; or

(h) a diplomatic or consular officer.

(4) The name and title of the person before whom the declaration is made and the date when, and the place where, it was made must be stated in

the declaration.

21.7 Declarations -- additional material

(1) If:

(a) a person is required by the Act or these regulations to file a declaration or serve a copy of the declaration; and

(b) it is not practicable to include in, or attach to, the declaration or copy any material to which the declaration refers;

the person must file or serve the material to which the declaration refers, or a copy of the material, at the same time as the declaration or as soon as practicable after that time.

(2) A declaration is not taken to have been filed or served until any material to which the declaration refers, or any copy of the material, is filed or served.

21.8 Notification of service

A person who is required by the Act or these regulations to serve a document on another person must, as soon as practicable after the document is served, notify the Registrar in writing of the date, place and manner of service.

21.9 Notice of withdrawal of applications etc

(1) For the purposes of section 214 of the Act (which deals with withdrawal of applications, notices and requests):

(a) a person who has filed an application, notice or request; or

(b) another person in whom the right or interest in reliance on which the application, notice or request was filed has become vested;

may withdraw the application, notice or request by giving notice in writing of the withdrawal to the Registrar.

(2) If:

(a) the application, notice or request was filed by, or on behalf of, more than 1 person; or

(b) the right or interest mentioned in paragraph (1) (b) has become vested in more than 1 person;

the notice of withdrawal must be signed by, or on behalf of, each of those persons.

(3) If a person mentioned in paragraph (1) (b) withdraws an application, notice or request, the Registrar may require in writing that person to file documentary evidence that is sufficient to establish that the right

or interest mentioned in that paragraph is vested in the person.

21.10 Withdrawal of application etc -- Registrar's notice to applicants

If an application, notice or request is withdrawn in accordance with regulation 21.9, the Registrar must notify in writing each person by, or on behalf of whom, the application, notice or request was filed of the withdrawal.

21.11 Change of address for service -- notice to interested persons

A person:

(a) who has filed an application, notice or request stating an address for service; and

(b) who notifies the Registrar of another address for service for the purposes of paragraph 215(1)(b) of the Act (which deals with address for service);

must give a copy of the notification to:

(c) any party to proceedings relating to the application, notice or request; and

(d) to any other person as directed by the Registrar.

21.11A Documents to be made available for public inspection

(1) For subsection 217A(1) of the Act each document held by the Registrar that relates to a trade mark is prescribed, other than a document mentioned in subregulation (2).

(2) For subregulation (1), the documents are:

(a) a document that would be privileged from production in legal proceedings on the ground of legal professional privilege; and

(b) a document that is subject to an order of a court or tribunal that prohibits disclosure of the document or information in the document; and

(c) a document:

(i) whose production the Registrar has required under paragraph 202(c) of the Act; and

(ii) that the Registrar is satisfied should not be made available for public inspection; and

(d) a document that solely contains evidence of the use or proposed use of a trade mark; and

(e) a declaration stating the reasons for a request for expedited examination under regulation 4.18; and

(f) a document filed by an applicant for an extension of time under subsection 224(2) or (3) of the Act in relation to an application under

those provisions, other than the application for an extension of time;
and

(g) a document filed in the course of opposition proceedings under the Act and Regulations, other than the notice of opposition; and

(h) a document containing any information that the Registrar requires to be held confidentially under paragraph 226A(1) (a) of the Act; and

(i) a document prepared by the Registrar, a Deputy Registrar or an employee in the Trade Marks Office that contains information obtained from a document to which any of paragraphs (a) to (h) applies, being information that is the reason, or contributes to the reason, why that paragraph applies to the document.

Division 2 Proceedings before the Registrar

21.12 Applications for costs

(1) For the purposes of section 221 of the Act (which deals with costs), a party to proceedings before the Registrar may apply to the Registrar, in an approved form, for an award of costs in relation to the proceedings.

(2) An application must be made:

(a) during the proceedings; or

(b) within 3 months from:

(i) the day on which the Registrar makes a decision in the proceedings that ends those proceedings; or

(ii) the date of the Registrar's notice to the party that the proceedings have been discontinued or dismissed;

as the case requires.

(3) Before awarding costs in respect of the proceedings, the Registrar must give each party to the proceedings a reasonable opportunity to be heard in relation to the award of costs.

(4) If a bill of costs is filed in relation to the proceedings, the bill of costs must be filed within 3 months from the day on which the costs are awarded.

21.13 Determination of costs

(1) In this regulation, **costs** does not include the costs referred to in paragraph 105(2)(b) of the Act.

(2) For the purposes of section 221 of the Act (which deals with costs), costs may only be awarded in respect of a matter set out in Schedule 8.

(3) The amount of costs must be taxed, allowed and certified by an employee appointed by the Registrar for that purpose, in accordance with:

(a) in the case of an item in Part 1 of Schedule 8 -- the amount specified in that item; or

(b) in the case of a matter set out in a clause in Part 2 of Schedule 8 -- that clause.

(4) The Registrar may review the taxation of costs by an employee.

21.14 Conduct of proceedings generally

(1) The Registrar may, at the request of a party to proceedings before the Registrar, other than opposition proceedings, give directions in relation to the procedure in the proceedings.

(2) Directions given under subregulation (1) must not be inconsistent with these regulations.

(3) The Registrar must not give directions under subregulation (1) unless the Registrar:

(a) is reasonably satisfied that any person affected by the proposed directions has been notified of the proposed directions; and

(b) has given any person affected a reasonable opportunity to make representations concerning the proposed directions; and

(c) is reasonably satisfied that the proposed directions are appropriate.

(4) For the purposes of paragraph (3) (b), representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

(5) Subject to these regulations, the Registrar may determine the procedure to be followed in proceedings before the Registrar.

[Note: Regulation 5.16 deals with directions as to procedure in opposition proceedings.]

21.15 Hearings by Registrar

(1) This regulation applies if the Act or these regulations provide for a person to be heard by the Registrar.

(2) A request for a hearing by the Registrar must be in an approved form.

(3) On request, or on his or her own initiative, the Registrar may:

(a) fix a time, date and place for the hearing; and

(b) give the parties to the hearing at least 10 days' notice in writing of the hearing and of the time, date and place fixed for the hearing.

(4) A party must, as soon as practicable after being notified of a hearing, inform the Registrar in writing whether the party wants to be heard.

(5) A party may attend a hearing in person or by such means as the Registrar

reasonably allows.

(6) A party may make representations in writing before or during a hearing.

(7) A hearing must be conducted with as little formality and technicality, and with as much expedition, as the requirements of the Act and these regulations and a proper consideration of the matters before the Registrar, allow.

(8) The Registrar is not bound by the rules of evidence but may inform himself or herself on any matter that is before him or her in any way that the Registrar reasonably believes to be appropriate.

(9) The Registrar may adjourn a hearing by notifying each party to the hearing accordingly.

(10) Subject to these regulations, the Registrar may give a direction that is reasonably necessary for the conduct of the hearing.

21.16 Registrar not required to hold hearings

(1) The Registrar is not required to proceed to hear a matter if:

(a) the Registrar reasonably believes that no party wishes to be heard in the matter; or

(b) at least 1 of the following circumstances applies in relation to each party notified of the hearing under subregulation 21.15(3):

(i) the party has not indicated to the Registrar that the party wishes to be heard; or

(ii) the party has informed the Registrar that the party does not wish to be heard; or

(iii) the party does not attend the hearing.

(2) The Registrar may decide a matter to which subregulation (1) refers:

(a) without a hearing; and

(b) by reference to relevant information about the matter that is held in the Trade Marks Office.

21.17 Evidence in proceedings

(1) Evidence that is given in writing in any proceedings before the Registrar must be in the form of a declaration.

(2) The Registrar may require a person who has made a declaration that

is filed in the proceedings to attend before the Registrar to give evidence orally on oath or affirmation instead of, or in addition to, the evidence contained in the declaration.

(3) The Registrar may permit a party to cross-examine a person who attends under subregulation (2).

[Note: Regulations 21.6 and 21.7 deal with making and filing declarations.]

21.18 Documents not in English

If a document that is filed as evidence in proceedings before the Registrar is not in English, the party who files the document must file with it:

- (a) a translation of the document into English; and
- (b) a certificate of verification in relation to the translation.

21.19 Registrar may use information available

(1) If:

- (a) information that is available to the Registrar is relevant to proceedings before the Registrar; and
- (b) the Registrar has reason to believe that the information is not known to a party to the proceedings; and
- (c) the Registrar proposes to take the information into account in making a decision in the proceedings;

before making the decision the Registrar must:

- (d) provide the information to the party; and
- (e) give the party a reasonable opportunity to make representations about the information.

(2) For the purposes of paragraph (1) (e), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

21.20 Statements of reasons for decision

If:

- (a) the Registrar notifies a party to proceedings before the Registrar of a decision of the Registrar in the proceedings; and
- (b) the party requests the Registrar in writing for the reasons for the decision;

the Registrar must comply with the request.

Division 3 General

21.21 What fees are payable

(1) For subsection 223(1) of the Act (which deals with fees), the fees specified in an item in Schedule 9 are payable in respect of a matter specified in that item.

(2) If a person asks the Registrar, under subsection 75(1) of the Act, to renew the registration of a trade mark before it expires, the fee payable for the renewal is the fee that would be payable if the person had asked for renewal of the registration on the day when it would otherwise expire.

(3) Subregulation (4) applies if a person asks the Registrar, under section 79 of the Act, to renew the registration of a trade mark after it expires.

(4) The fees payable for the renewal are:

(a) the fee that would have been payable if the person had asked for renewal of the registration on the day when it expired; and

(b) the additional fee stated in item 10 of Schedule 9 for the period:
(i) beginning on the day after the day when the registration expires; and

(ii) ending on the day when the request for renewal is filed.

(5) If a person asks the Registrar, under section 80D of the Act, to renew the registration of a trade mark for one or more potential renewal periods, the fee payable is the sum of the fees payable for the potential renewal period or periods requested by the person, as those fees were at the Register entry day.

(6) Subregulation (7) applies if a person asks the Registrar, under paragraph 80G(1) (b) of the Act (which deals with renewal within 10 months after the end of the prescribed period) to renew the registration of a trade mark for one or more potential renewal periods.

(7) The fee payable for the renewal is:

(a) the sum of the fees payable for the potential renewal period or periods requested by the person, as those fees were at the Register entry day; and

(b) the additional fee stated in item 12 of Schedule 9 for the period:

- (i) beginning on the day after the day when the prescribed period expires;
and
- (ii) ending on the day when the request for renewal is filed.

21.21A No action permitted until fee paid

(1) If a fee is payable in respect of the doing of an act by the Registrar or the Customs CEO, the Registrar or Customs CEO must not do the act until the fee has been paid.

(2) Subject to subregulation (3), if:

- (a) a fee is payable in respect of the doing of an act by a person other than the Registrar or the Customs CEO; or
 - (b) a fee is payable in respect of the filing of a document;
- the act is taken to have been done, or the document is taken to have been filed, despite of the failure to pay the fee.

[Note: **File** has the meaning given by section 6 of the Act.]

(3) If the Registrar or the Customs CEO notifies under regulation 21.23 the person concerned or his or her agent, that the fee has not been paid, the act is not taken to have been done, or the document is not taken to have been filed, before the day on which the fee is paid.

21.22 How fees are to be paid

(1) For the purposes of subsection 223(2) of the Act (which deals with payment of fees), a fee, other than a fee payable under Part 13 of the Act, must be paid to the Registrar.

(2) A fee payable under Part 13 of the Act must be paid to the Customs CEO.

(3) A fee must be paid in accordance with a direction given:

(a) in the case of a fee that is paid to the Registrar -- by the Registrar;
and

(b) in the case of a fee that is paid to the Customs CEO -- by the Customs CEO;

as to the way in which it is to be paid.

21.23 Notice of non-payment of fee

For subregulation 21.21A(3), the Registrar or the Customs CEO must, in writing or by telephone:

(a) if a fee mentioned in Part 3A has not been paid or waived within the period prescribed in that Part for the payment of the fee -- advise the

requester that the fee has not been paid and that the AFS request has been discontinued; or

(b) in any other case -- notify the person concerned, or his or her agent, that the fee has not been paid, within 14 working days after the doing of the act, or the filing of the document, for which the fee is payable.

21.24 Refunds etc of fees

(1) If, because of an error or omission by an employee, a person becomes liable to pay a fee for which the person would not otherwise have been liable, the Registrar may:

(a) remit the whole or part of the fee; or

(b) if the fee has been paid -- refund the whole or part of the fee to that person.

(2) If:

(a) the acceptance of an application for registration of a trade mark; or

(b) the registration of a trade mark;

is delayed because of an error or omission by an employee, the period that the Registrar reasonably believes to be equal to the period of the delay resulting from the error or omission is not to be taken into account for the purposes of calculating the amount of the fee for the matter in relation to which the error or omission was made.

21.24A Period for doing certain acts -- office not open for business

For subsection 223A(1) of the Act, the circumstance is that the act is done at:

(a) the Trade Marks Office; or

(b) a sub-office of the Trade Marks Office;

that was not open for business.

[Note: Subsection 223A(1) provides as follows:

'(1) If the last day of a period provided by this Act (except this section) for doing an act is a day when the Trade Marks Office, or a sub-office of the Trade Marks Office, is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.'.]

21.24B Days when office not open for business

(1) For paragraph 223A(2) (a) of the Act, the days on which the Trade Marks Office, or a sub-office of the Trade Marks Office, is not open for business

are:

- (a) Saturday; and
- (b) Sunday; and
- (c) Australia Day; and
- (d) Anzac Day.

(2) For paragraph 223A(2) (b) of the Act, the Director General of IP Australia is a prescribed person.

(3) For paragraph 223A(2) (b) of the Act, the prescribed way of publishing a declaration is in the Official Journal of Trade Marks.

21.24C Period for doing certain acts -- acts to which section 223A does not apply

For subsection 223A(7) of the Act, the following acts are prescribed:

(a) an act done in opposition proceedings, other than the filing of a notice or request with the Trade Marks Office, under the following provisions:

- (i) Part 5, 9 or 21 of the Act;
- (ii) Part 5, 9, 17A or 21 of these Regulations;

(b) an act done in relation to proceedings in a court or a tribunal;

(c) the filing of a notice of opposition with a court under section 96 of the Act;

(d) an act done under Part 13 or 16 of the Act;

(e) an act done under Part 13, 16 or 20 of these Regulations.

21.25 Extension of time -- application

For the purposes of subsections 224(2) and (3) of the Act (which deal with extensions of time), an application for an extension of time for doing a relevant act:

(a) must be in an approved form; and

(b) must be accompanied by a declaration stating:

(i) the facts on which the grounds specified in the application are based; and

(ii) if the period for doing the relevant act has ended -- the reason why the application was not made before the period ended.

[Note: Regulations 21.6 and 21.7 deal with making and filing declarations.]

21.26 Extension of time -- notice of opposition

(1) For the purposes of subsection 224(6) of the Act (which deals with opposition to an extension), a person may oppose an application for an extension of time for more than 3 months by filing a notice of opposition with the Registrar.

(2) A notice of opposition:

(a) must be in an approved form; and

(b) must be filed within 1 month after the application for an extension of time is advertised in the *Official Journal*.

(3) The opponent must serve a copy of the notice on the applicant.

21.27 Extension of time -- opposition proceedings

For the purposes of subsection 224(6) of the Act (which deals with opposition to an extension), regulations 5.7 to 5.17 (inclusive) apply to an opposition to an application for an extension of time.

21.28 Extension of time -- prescribed acts and documents

(1) For the purposes of paragraph (a) of the definition of **relevant act** in subsection 224(8) of the Act, the following acts are prescribed:

(a) complying with the requirements of subregulation 4.2(1);

(aa) filing notice of a claim to a right of priority under subsection 29(1) of the Act;

(b) applying for the registration of a trade mark in the circumstances described in paragraph 29(1)(b) of the Act;

(c) making a divisional application for the registration of a trade mark under subsection 45(1) of the Act;

(f) serving a copy of the evidence under regulation 5.7, 5.9 or 5.12;

(g) serving a copy of a notice under regulation 5.8, 5.11 or 5.13;

(h) serving a copy of further evidence under regulation 5.15;

(ha) requesting an amendment of a notice of opposition under subregulation 5.19(1);

(j) requesting that an application for the registration of a trade mark be amended under paragraph 64(b) of the Act;

(k) requesting renewal of the registration of a trade mark under sections 79, 80D or 80G of the Act;

(n) complying with the authorised user's request referred to in regulation 13.2;

(o) complying with a request for information referred to in regulation 13.3;

- (p) responding to a notice under subregulation 16.3(2);
- (q) responding to an advertisement under subregulation 16.3(3);
- (r) making a claim for priority under section 29 of the Act for an application for the registration of a trade mark in the circumstances mentioned in section 244 of the Act;
- (s) the filing of a document or the giving of advice to the Registrar under Part 3A.
- (t) an action or step prescribed in Part 20.

(2) For the purposes of paragraph (b) of the definition of **relevant act** in subsection 224(8) of the Act, the following documents are prescribed:

- (a) a notice of opposition to the registration of a trade mark under section 52 of the Act;
- (b) a notice of opposition to which subregulation 21.26(1) applies;
- (c) any of the following documents required or permitted to be submitted under Part 3A:
 - (i) an AFS request;
 - (ii) a submission;
 - (iii) an attachment;
 - (iv) accompanying material;
 - (v) a written advice.

21.29 Convention countries

(1) For the purposes of section 225 of the Act (which deals with Convention countries), each of the countries specified in Schedule 10 is a Convention country for the purposes of the Act.

(2) For the purposes of subsection 225(2) of the Act, an application for the registration of a trade mark, being an application that is made under the treaty done at Bangui in the Central African Republic on 2 March 1977 entitled the *Agreement Relating to the Creation of an African Intellectual Property Organisation, Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property* (a treaty subsisting between 2 or more Convention countries), is, in accordance with the terms of that treaty, declared to be equivalent to an application made in each of those Convention countries.

(3) For the purposes of subsection 225(2) of the Act, an application for the registration of a trade mark, being an application that is made under the *Benelux Convention Concerning Trademarks* done at Brussels on 19 March 1962 (being a treaty subsisting between 2 or more Convention countries),

is, in accordance with the terms of that treaty, declared to be equivalent to an application made in each Convention country that is a High Contracting party within the meaning of that treaty.

(4) For subsection 225(2) of the Act, an application, under the terms of the *Treaty Establishing the European Community* done at Rome on 25 March 1957, for registration of a European Community trade mark is equivalent to an application made in each Convention country party to the treaty.

21.30 Rights of registered patent attorneys

A registered patent attorney has the same right of lien over documents and property of a client as a solicitor.

21.31 Incapacity of certain persons

(1) If a person is incapable of doing anything required or permitted by the Act or these regulations to be done because of infancy or physical or mental disability, a court may, on the application of a person acting on behalf of the incapable person or of another person interested in the thing being done:

(a) do the thing; or

(b) appoint a person to do the thing;

in the name, and on behalf, of the incapable person.

(2) A thing done in the name of, and on behalf of, an incapable person is taken to have been done by that person as if the person had not been incapable when the thing was done.

21.32 Destruction of documents

(1) The Registrar may order the destruction of documents relating to trade marks the registration of which ceased not less than 25 years before the date of the order.

(2) Subregulation (1) does not authorise the destruction of:

(a) the Register; or

(b) documents that are considered by the Registrar or the Director-General of the Australian Archives to be of legal or historical interest.

21.33 Directions not otherwise prescribed

If the Registrar reasonably believes that it is necessary for the proper conduct of proceedings for a person to perform an act, file a document or produce evidence that the person is not required by the Act or these

regulations to perform, file or produce, the Registrar may give notice in writing to the person requiring him or her:

- (a) to perform the act; or
- (b) file the document; or
- (c) to produce the evidence;

that is specified in the notice.

21.34 Requirements cannot be complied with for reasonable cause

If:

(a) under these regulations, a person is required to do an act or thing, sign a document, make a declaration or file or give to the Registrar a document or evidence; and

(b) the Registrar is reasonably satisfied that the person cannot comply with the requirement;

subject to any condition that the Registrar may reasonably impose, the Registrar may dispense with the requirement.

21.35 Review of decisions

(1) In this regulation:

decision has the same meaning as in the *Administrative Appeals Tribunal Act 1975*.

(2) Application may be made to the Tribunal for review of a decision of:

(a) the Board under the following provisions:

(i) regulation 20.5 ('evidence of academic qualifications');

(ii) regulation 20.7 ('evidence of knowledge requirements'); or

(b) the Designated Manager under the following provisions of the *Patents Regulations 1991* in their application to trade marks attorneys:

(i) regulation 20.28 ('failure to comply with continuing professional education requirements');

(ii) regulation 20.29 ('restoring attorney's name to Register');

(iii) regulation 20.30 ('restoring attorney's name to Register following payment of unpaid fee');

(iv) regulation 20.31 ('returning to the Register in other circumstances'); or

(c) the Disciplinary Tribunal under the following provisions of the *Patents Regulations 1991* in their application to trade marks attorneys:

(i) regulation 20.43 ('decision of Disciplinary Tribunal');

(ii) regulation 20.44 ('penalties – professional misconduct');

(iii) regulation 20.45 ('penalties – unsatisfactory professional conduct');

(iv) regulation 20.46 ('finding that attorney was unqualified at time of registration');

(v) regulation 20.47 ('finding that registration obtained by fraud').

Part 22 Transitional provisions

22.1 Application of the Act

(1) If:

(a) an application for the registration of a trade mark is lodged under the *Trade Marks Act 1955*; and

(b) the Registrar has issued a report on the application under the *Trade Marks Act 1955*; and

(c) immediately before the commencement of these regulations, the application is pending and has not been accepted;

the report is taken to have been issued by the Registrar under the Act on the date on which it was issued under the *Trade Marks Act 1955*.

(2) If:

(a) an application under the *Trade Marks Act 1955* for the registration of a trade mark is amended under the *Trade Marks Act 1955*; and

(b) immediately before the commencement of these regulations, the application is pending and has not been accepted;

the amendment is taken to have been made under the Act on the date on which it was made under the *Trade Marks Act 1955*.

(3) If the particulars of an application for the registration of a trade mark have been published before the commencement of these regulations:

(a) in the *Official Journal*; or

(b) by listing in a computer database maintained by the Trade Marks Office;
or

(c) by making a record of the application available, in electronic or other form, in each of the sub-offices of the Trade Marks Office;

then, for the purposes of subsection 45(2), paragraph 64(a), subsection 65(1) and paragraph 83(1)(a) of the Act, those particulars are taken to have been published under section 30 of the Act.

22.2 Fees payable in relation to certain matters

(1) Subject to subregulation (2), a fee payable in relation to proceedings:

(a) relating to an application for the registration of a trade mark of a kind mentioned in subsection 241(2) of the Act (which deals with pending applications for registration of trade marks); or

(b) of a kind mentioned to which section 251 of the Act (which deals with action for removal of trade marks from the Register for non-use) applies; is the fee that would have been payable if these regulations had applied

to the proceedings.

(2) The fee payable for the registration of a trade mark of a kind mentioned in subsection 241(2) of the Act is the fee that was payable under regulations made under the *Trade Marks Act 1955*, being the regulations as in force when the application was accepted.

(5) If:

(a) under the repealed Act the registration of a trade mark expires in 1995; and

(b) a request is made to renew the registration of the trade mark within the period of 12 months following the expiry;

the fee payable in relation to the request is the fee that would have been payable for lodgment of an application for restoration of the trade mark under subsection 71(1) of the repealed Act.

22.3 Certain delegations continue

If, immediately before the commencement of these regulations, a person:

(a) was a delegate of the Registrar of Trade Marks under the repealed Act; and

(b) was exercising the powers of the Registrar in relation to a matter to which, under Division 3 of Part 22 of the Act, the repealed Act continues to apply;

the delegation of that person continues in relation to the matter.

22.4 Certain deferments continue

(1) If:

(a) the Registrar has deferred acceptance of an application for registration of a trade mark under subsection 33(3) of the *Trade Marks Act 1955*; and

(b) the deferment was in force immediately before the commencement of these regulations;

the deferment is in force under subregulation 4.13(1) after the commencement of these regulations as if the Registrar had deferred acceptance of the application on the day on which it was deferred under the *Trade Marks Act 1955*.

(2) Subject to paragraph 4.14(2)(a), the deferment period for an application referred to in subregulation (1) ends:

(a) when the Registrar is reasonably satisfied that there are no longer grounds for rejecting the application under subsection 44(1) or (2) of

the Act because of another trade mark in respect of which an application for registration has been made by another person; or

(b) if the period does not end in accordance with paragraph (a) -- when proceedings in respect of the application for registration of the other trade mark are finalised.

(3) If acceptance of the application is deferred as a result of the operation of more than 1 provision of these regulations, the deferment period ends in accordance with whichever of the provisions of:

(a) paragraph (2) (b); and

(b) subregulation 4.14(3), other than paragraph 4.14(3) (a);

under which the deferment period ends later or last, as the case requires.

22.5 Certain extensions of time continue

If:

(a) the Registrar has extended a period of time under section 130 or 131 of the *Trade Marks Act 1955*; and

(b) the extended period of time had not ended before the commencement of these regulations;

the period ends when it would have ended if that section had continued to be in force.

22.6 Deferment of acceptance -- certain applications

If:

(a) an applicant requests the Registrar to defer acceptance of an application for registration of a trade mark because of another trade mark that is registered by another person; and

(b) the applicant has lodged an application under section 23 of the *Trade Marks Act 1955* in respect of the other trade mark;

then:

(c) regulation 4.13 applies in relation to the first-mentioned application as if the reference in subparagraph 4.13(1) (c) (iii) to an application under section 92 were a reference to an application under section 23 of the *Trade Marks Act 1955*; and

(d) regulation 4.14 applies in relation to that application as if the reference in paragraph 4.14(3) (c) to Part 9 of the *Trade Marks Act 1995* were a reference to section 23 of the *Trade Marks Act 1955*.

22.7 Trade marks attorneys

For registration as a trade marks attorney, a person is taken to meet the requirements of subregulation 20.1(1) until 27 January 2001 if the

person:

(a) was, on 28 February 1998, registered as a patent attorney under section 198 of the *Patents Act 1990*; or

(b) met the requirements of paragraphs 198(2) (c) and (d) of the *Patents Act 1990* as in force on 26 January 1999; or

(c) is a legal practitioner who acted for a client in trade mark matters before 27 January 1999, and makes a statutory declaration to that effect; or

(d) is a person to whom note 4 to subsection 156(2) of the *Trade Marks Act 1995* applies.

22.8 Trade marks attorney examination requirements

(1) For a person who passed an examination, or was exempted from having to pass the examination, for at least 1 subject under Schedule 5 of the *Patents Regulations 1991* as in force on 26 January 1999, the period of 5 years for paragraph 20.3A(1) (b) of the *Patents Regulations 1991* is taken to commence on 27 January 1999.

(2) Subregulation (3) applies to a person who has passed an examination, or been exempted from having to pass the examination, for at least 1 subject mentioned in Schedule 5 as in force on 26 January 1999.

(3) A pass in an examination for a subject mentioned in column 1 of the following table is taken to be a pass for paragraph 20.1(1) (a) in a topic group mentioned in column 2 of the table:

Column 1 Subject	Column 2 Topic group
Legal Process	Group A -- Legal process and overview of intellectual property
Patent Attorneys' Practice, Part 2	Group B -- Professional conduct
Trade Marks law of Australia and the Practice of the Trade Marks Office	Group C -- Trade mark law
Patent Attorneys' Practice, Part 1 and Patent Attorneys' Practice, Part 2	Group D -- Trade mark practice

(4) For registration as a trade marks attorney, a person is taken to have passed an examination for Patent Attorney's Practice 1 and Patent Attorney's Practice 2 if the person:

(a) before 27 January 1999, passed an examination for a subject that the Board considers is equivalent to topic groups A and C mentioned in Schedule 5 to the *Patents Regulations 1991*; and

(b) applies for registration as a trade marks attorney before 27 January 2001; and

(c) provides a statutory declaration by an employer or the employer's representative that the person's principal field of practice for 2 continuous years has been in trade marks matters.

Schedule 1 Classification of goods and services

(regulation 3.1)

Part 1 Classes of goods

Item number (Class number)	Class of goods (Class heading)
1	Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry
2	Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists
3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices
4	Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks
5	Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides
6	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores
7	Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements, other than hand operated; incubators for eggs
8	Hand tools and implements (hand operated); cutlery; side arms; razors
9	Scientific, nautical, surveying, electric, photographic,

	cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus
10	Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials
11	Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes
12	Vehicles; apparatus for locomotion by land, air or water
13	Firearms, ammunition and projectiles; explosives; fireworks
14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments
15	Musical instruments
16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks
17	Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal
18	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery
19	Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal
20	Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes

	for all these materials, or of plastics
21	Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes
22	Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials
23	Yarns and threads, for textile use
24	Textiles and textile goods, not included in other classes; bed and table covers
25	Clothing, footwear, headgear
26	Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers
27	Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile)
28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees
29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats
30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice
31	Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt
32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages
33	Alcoholic beverages (except beers)
34	Tobacco; smokers' articles; matches

Part 2 Classes of services

Item number (Class number)	Class of services (Class heading)
35	Advertising; business management; business administration; office functions
36	Insurance; financial affairs; monetary affairs; real estate affairs
37	Building construction; repair; installation services
38	Telecommunications
39	Transport; packaging and storage of goods; travel arrangement
40	Treatment of materials
41	Education; providing of training; entertainment, sporting and cultural activities
42	Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software
43	Services for providing food and drink; temporary accommodation
44	Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services
45	Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals

Schedule 2 Signs that may not be registered as trade marks

(paragraph 4.15(f))

Austrade

C.E.S.

Olympic Champion

Repatriation

Returned Airman

Returned Sailor

Returned Soldier

Schedule 3 Modifications of Part 13 of the Act -- Norfolk Island (omitted)

(regulation 13.4)

**Schedule 4 Modifications of Part 13 of the Act -- Christmas Island
(omitted)**

(regulation 13.5)

**Schedule 5 Modifications of Part 13 of the Act -- Cocos (Keeling) Islands
(omitted)**

(regulation 13.6)

Schedule 6 Offices of persons to whom registrar may delegate (omitted)

(regulation 19.2)

Schedule 7 Requirements for documents

(regulation 21.2)

1. Documents, except documents mentioned in regulations 4.11, 5.5 and 21.18, must be written in English.
2. Documents must be durable.
4. The contents of a document must be legible.

Schedule 8 Costs, expenses and allowances

(subregulation 21.13(3))

Part 1 Costs

Item	Matter	Amount
1	Notice of opposition	\$200
2	Evidence in support	\$700
3	Receiving and perusing notice of opposition	\$130
4	Receiving and perusing evidence in support	\$300
5	Evidence in answer	\$700
6	Receiving and perusing evidence in answer	\$210
7	Evidence in reply	\$350
8	Receiving and perusing evidence in reply	\$130
9	Preparation of cases for hearing	\$525
10	Attendance at hearing by registered patent attorney, registered trade marks attorney or solicitor without counsel	\$260 an hour, but not more than \$1 170 a day
11	Attendance at hearing by registered patent attorney, registered trade marks attorney or solicitor instructing counsel	\$200 an hour, but not more than \$900 a day
12	Counsel fees for attendance at a hearing	\$300 an hour, but not more than \$1 350 a day

Part 2 Expenses and allowances

Division 1 Expenses

1. A person who has paid a fee prescribed in these regulations in relation to proceedings before the Registrar may be paid the amount of the fee.

2. A person attending proceedings before the Registrar must be paid:

(a) a reasonable amount for allowances for transport between the usual place of residence of the person and the place that he or she attends for that purpose; and

(b) if the person is required to be absent overnight from his or her usual place of residence -- a reasonable amount for allowances up to a daily maximum of \$700 for meals and accommodation.

Division 2 Allowances

3. A person who, because of his or her professional, scientific or other special skill or knowledge, is summoned to appear as a witness before the Registrar must be paid:

(a) if the person is remunerated in his or her occupation by wages, salary or fees -- an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and

(b) in any other case -- an amount of not less than \$140, or more than \$700, for each day on which he or she so attends.

4. A person summoned to appear as a witness, other than a witness referred to in clause 3, before the Registrar must be paid:

(a) if the person is remunerated in his or her occupation by wages, salary or fees -- an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and

(b) in any other case -- an amount of not less than \$80, or more than \$130, for each day on which he or she so attends.

Schedule 9 Fees

(regulation 21.21)

Item	Matter	Fee
1	Filing an application to register a trade mark under subsection 27(5) or 45(1) of the Act in respect of goods or services in 1 or more of the prescribed classes:	
	(a) by an electronic means approved by the Registrar for this paragraph	\$120 for each class
	and, in addition, if the goods and services are specified in the application otherwise than by using the official Goods and Services pick list	\$40 for each class
	(b) by AFS request mentioned in regulation 4.2A	\$90 for each class
	(c) by another means	\$180 for each class
3	Filing an application to register 2 or more trade marks as a series under section 51 of the Act:	
	(a) by an electronic means approved by the Registrar for this paragraph:	\$270 for each class
	and, in addition, if the goods and services are specified in the application otherwise than by using the official Goods and Services pick list	\$40 for each class
	(b) by other means	\$330 for each class
4	Requesting an amendment under section 64, 65 or 65A of the Act to include an additional prescribed class of goods or services in an application:	
	(a) application under section 51 for a series of trade marks	\$330 for each class
	(b) any other case	\$180 for each class
5	Filing an application for an extension of: (a) a period under subregulation 4.12(3) or regulation 17A.20; or (b) time under regulation 21.25	\$100 for each month or part of a month for which the extension is sought
6	Filing an application for an extension of: (a) a period under regulation 5.15 (including regulation 5.15 as applied by regulation 17A.33); or	\$150 for each month or part of a month for which the extension is sought

	(b) time under regulation 5.2 or 17A.30	
7	Filing a notice of opposition under:	
	(a) section 52 of the Act; or	\$250
	(b) section 96 of the Act (including section 96 as applied by regulation 17A.48); or	\$150
	(c) subsection 224(6) of the Act; or	\$250
	(d) regulation 17A.29	\$250
8	Filing an application for permission to serve a copy of further evidence in opposition proceedings under paragraph 5.15(1) (b) (including paragraph 5.15(1) (b) as applied by regulation 17A.33)	\$100
9	Single registration of a trade mark under section 68 of the Act in respect of goods or services in 1 or more of the prescribed classes	\$250 for each class
10	Renewal of a single registration of a trade mark under section 75 of the Act in respect of goods or services in 1 or more of the prescribed classes	\$300 for each class
	and, in addition, if the request for renewal is made within 6 months after the expiry date to which section 79 of the Act refers	\$100 for each class for each month, or part of a month, after the expiry date
11	Each potential renewal period requested by a person under section 80D of the Act in respect of goods or services in 1 or more of the prescribed classes	\$300 for each class
12	Each potential renewal period requested by a person under paragraph 80G(1) (b) of the Act in respect of goods and services in 1 or more of the prescribed classes	\$300 for each class
	and, in addition, if the request for renewal is made within 10 months after the end of the prescribed period, regardless of the number of potential renewal periods requested	\$100 for each class for each month, or part of a month, after the end of the prescribed period
13	Filing an application for removal of a trade mark from the Register: (a) for non-use under section 92 of the Act; or (b) for cessation of protection for non-use under subregulation 17A.48(1)	\$250
14	Request for a hearing under: (a) regulation 5.14 (including regulation 5.14 as applied by regulation 17A.33); or	\$500

	(b) regulation 9.4, (including regulation 9.4 as applied by regulation 17A.48)	
15	Request for a hearing in relation to any other matter	\$300
16	Attendance at a hearing under: (a) regulation 5.14 (including regulation 5.14 as applied by regulation 17A.33); or (b) regulation 9.4 (including regulation 9.4 as applied by regulation 17A.48)	\$500 for each day, or part of a day, less any amount paid under item 14 in relation to the hearing
17	Attendance at a hearing in relation to any other matter	\$300 less any amount paid under item 15 in relation to the hearing
18	Handling an application for the international registration of a trade mark under regulation 17A.7	\$100
19	Transmitting a renewal fee for the international registration of a trade mark under Article 7 of the Madrid Protocol	\$100
20	Requesting a decision under subregulation 21.16(2)	\$300
21	Supply of a certificate signed by the Registrar under section 211 of the Act	\$50
21A	Supply of a duplicate of a certificate signed by the Registrar under section 211 of the Act	\$250
22	Supply of a copy of an extract from the Register or the Record of International Registrations	\$50
23	Supply of a copy of a document for which a search is required	\$100
25	Applying for admission to sit for an examination conducted by the Board	\$400
26	Applying for a grant of a supplementary examination conducted by the Board	\$200
27	A report of reasons for failure of an examination conducted by the Board	\$200
28	Applying for registration as a trade marks attorney	\$150
29	Annual registration of a trade marks attorney	\$250
30	Annual registration fee payable for combined registration as a trade marks attorney and patent attorney	\$450
31	Applying to be restored to the Register, as authorised by regulation 20.14	\$160
32	AFS request under regulation 3A.3	\$90 for

		each class
33	Inclusion of an additional class of goods or services in an AFS request under paragraph 3A.3(5) (c) or 3A.5(2) (f)	\$90 for each class
34	Inclusion of an amendment in an AFS request that significantly changes the graphical representation of a trade mark under paragraph 3A.5(2) (f)	\$90 for each class
35	(a) request for a copy of a file or part of a file under regulation 21.11A	\$30 for each file that is the subject of a request
	(b) for each request of 20 pages or less	no additional charge
	(c) for each request involving more than 20 pages from a single file	\$1 for each additional page over 20 from the file

Schedule 10 Convention countries (omitted)

(regulation 21.29)

Notes to the *Trade Marks Regulations 1995* (omitted)