Trade Marks Regulations 1995

Statutory Rules No. 341, 1995

made under the

Trade Marks Act 1995

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About this compilation

This compilation

This is a compilation of the *Trade Marks Regulations 1995* that shows the text of the law as amended and in force on 11 April 2024 (the ***compilation date***).

The notes at the end of this compilation (the ***endnotes***) include information about amending laws and the amendment history of provisions of the compiled law.

Uncommenced amendments

The effect of uncommenced amendments is not shown in the text of the compiled law. Any uncommenced amendments affecting the law are accessible on the Register (www.legislation.gov.au). The details of amendments made up to, but not commenced at, the compilation date are underlined in the endnotes. For more information on any uncommenced amendments, see the Register for the compiled law.

Application, saving and transitional provisions for provisions and amendments

If the operation of a provision or amendment of the compiled law is affected by an application, saving or transitional provision that is not included in this compilation, details are included in the endnotes.

Editorial changes

For more information about any editorial changes made in this compilation, see the endnotes.

Modifications

If the compiled law is modified by another law, the compiled law operates as modified but the modification does not amend the text of the law. Accordingly, this compilation does not show the text of the compiled law as modified. For more information on any modifications, see the Register for the compiled law.

Self-repealing provisions

If a provision of the compiled law has been repealed in accordance with a provision of the law, details are included in the endnotes.

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Part 1—Preliminary

1.1 Name of regulations

These Regulations are the *Trade Marks Regulations 1995*.

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Part 2—Interpretation

2.1 Interpretation

Note: A number of expressions used in these Regulations are defined in the Act, including Commission.

In these Regulations, unless the contrary intention appears:

AAT means the Administrative Appeals Tribunal.

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*.

AFS request has the meaning given by subregulation 3A.3(1).

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.

Code of Conduct means the standard of practice titled "Code of Conduct for Patent and Trade Mark Attorneys" that is established by the Board from time to time.

Designated Manager has the same meaning as in the *Patents Act 1990*.

Disciplinary Tribunal means the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 of the *Patents Regulations 1991*.

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.

expedited dispatch means a means of supplying documents that can reasonably be expected usually to be faster than ordinary post.

information system has the same meaning as in the *Electronic Transactions Act 1999*.

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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.

Madrid Regulations has the meaning given by regulation 17A.2.

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

official goods and services pick list: goods or services are specified, in an application to register a trade mark in respect of the goods or services, by using the ***official goods and services pick list*** if:

(a) the application is filed by means of a digital information system that is:
  (i) made available by IP Australia; and
  (ii) a preferred means of filing the application; and
(b) the applicant specifies the goods or services in the application by selecting the goods or services from a pre-populated list of goods or services that is made available by the digital information system for that purpose.

Panel Chair, in relation to a Panel of the Disciplinary Tribunal, means:

(a) the President; or
(b) if the President is unable to perform his or her functions in relation to proceedings of the Panel because of a conflict of interest—the person appointed under subregulation 20.64(2) of the *Patents Regulations 1991* to be the Panel Chair for the proceedings.

Panel of the Disciplinary Tribunal means a Panel constituted under regulation 20A.11.

President means the President of the Disciplinary Tribunal.

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.

Register of Trade Marks Attorneys means the register mentioned in section 228A of the Act.

requester has the meaning given by subregulation 3A.3(1).

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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 expresses a contrary intention to section 2G and subsection 36(1) 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* provisions.

2.3 Giving of documents by Registrar

(1) In these Regulations, the Registrar may give a document to a person by:

(a) making the document available to the person in an electronic form; and

(b) notifying the person that the document is available.

(2) If the Registrar gives a document to a person, the document is taken to have been given to the person on the day the document is dated by the Registrar.

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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.

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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.

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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:

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(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 by item 35 of the table in clause 1 of Schedule 9.

(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.

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(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).

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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 notify the applicant of the requirement.

(3) If the applicant meets the requirement within a period of 2 months from the date of the notification, 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.

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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 notification to the applicant, 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:

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(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, by notification to the applicant, 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 (if any).

(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.

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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;

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

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(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 by notification to the applicant.

(2) A report under subregulation (1) must include notification 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.

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(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 by notification to the applicant.

(3) Unless acceptance of an application is deferred, a report under subregulation (2) in relation to that application must include notification 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 notify the applicant that the applicant is required 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 notify the applicant that the applicant is required 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.

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(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) or that period as extended under regulation 4.12 or section 224 of the Act; 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.48C 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

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(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 AAT 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:

(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 notification 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:

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(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.48C 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 AAT, or a court to which any appeal arising from review by the AAT 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 of:

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(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;

(da) a representation of a flag of a country that is a member of the International Union for the Protection of Industrial Property;

(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 (if any).

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

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(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;

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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 notification 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.

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Part 5—Opposition to registration

Division 1—Preliminary

5.1 What Part 5 is about

This Part sets out requirements for the following:

(a) the filing of notices of opposition and associated documents;
(b) the amending of filed documents;
(c) the dismissal of an opposition;
(d) a cooling-off period for an opposition;
(e) the hearing of an opposition;
(f) associated matters.

5.2 Definitions

In this Part:

notice of intention to defend means a notice filed under regulation 5.13.

notice of opposition means a notice of opposition under section 52 of the Act.

party means an applicant or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

(a) the grounds on which the opponent intends to rely; and
(b) the facts and circumstances forming the basis for the grounds.

trade mark application means an application for registration of a trade mark under section 27 of the Act.

Note: The following terms are defined in section 6 of the Act:

(a) applicant;
(b) approved form;
(c) employee;
(d) file;
(e) month;
(f) opponent;
(g) person.

5.4 Notification and opportunity to make representations

(1) This regulation applies if:

(a) a party makes a request to the Registrar under this Part; or
(b) the Registrar proposes to make a decision on the Registrar's own initiative under this Part.

(2) The Registrar must:

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(a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or

(b) for paragraph (1)(b)—notify the parties of the proposed decision.

(3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:

(a) in writing; or

(b) at a hearing; or

(c) by other means that the Registrar states in the notification.

(4) The Registrar must notify the parties of the decision.

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Division 2—Filing of opposition documents

Subdivision A—Notice of opposition

5.5 Components of notice of opposition

(1) The components of a notice of opposition are:
  (a) a notice of intention to oppose; and
  (b) a statement of grounds and particulars.

(2) A notice of opposition is taken to be filed when both of its components have been filed.

5.6 Filing of notice of intention to oppose

(1) For subsection 52(2) of the Act, the period for filing a notice of intention to oppose is 2 months from the day the acceptance of the trade mark application is advertised in the *Official Journal* under paragraph 34(b) of the Act.

(2) The notice must be in an approved form.

(3) The Registrar must give a copy of the notice to the applicant.

5.7 Filing of statement of grounds and particulars

(1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.

(2) The statement must be in an approved form.

5.8 Statement of grounds and particulars must be adequate

(1) The Registrar must assess the adequacy of a statement of grounds and particulars.

(2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.

(3) If the Registrar decides that the statement is inadequate:
  (a) the Registrar may direct the opponent to rectify the inadequacy by filing more information on the basis for one or more of the grounds; or
  (b) if all the grounds are inadequately particularised, the Registrar may dismiss the opposition; or
  (c) if only some of the grounds are inadequately particularised, the Registrar may:
    (i) delete from the statement some or all of the material that is inadequate; and
    (ii) treat the result as the statement for the purposes of these Regulations; and

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(iii) give a copy of the amended statement to the opponent.

(4) If the Registrar decides that the statement is still inadequate after the information is filed under paragraph (3)(a):

(a) the Registrar may dismiss the opposition; or

(b) the Registrar may:

(i) delete from the statement some or all of the material that is inadequate; and

(ii) treat the result as the statement for the purposes of these Regulations; and

(iii) give a copy of the amended statement to the opponent.

(5) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information filed in relation to paragraph (3)(a) to the applicant.

(6) The opponent may apply to the Administrative Appeals Tribunal for review of a decision under this regulation to dismiss the opposition or delete material from the statement of grounds and particulars.

(7) Regulation 5.4 does not apply to this regulation.

5.9 Extension of time for filing—application

(1) A person who intends to oppose an application under subsection 52(1) of the Act may request the Registrar to extend:

(a) the period for filing a notice of intention to oppose under subregulation 5.6(1); or

(b) the period for filing a statement of grounds and particulars under subregulation 5.7(1).

(2) A request under paragraph (1)(a) or (b) may be made:

(a) within the period for filing the document in question; or

(b) before the trade mark is entered on the Register under section 69 of the Act.

Note: See subparagraph (3)(b)(ii) and subregulation 5.10(2) in relation to the consequences of making the request after the filing period has ended.

(3) The request must:

(a) be in an approved form; and

(b) be accompanied by a declaration stating:

(i) the facts and circumstances forming the basis for the grounds; and

(ii) if the period for filing the notice or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

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

(4) The request may be made only on either or both of the following grounds:

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(a) an error or omission by the person, the person's agent, the Registrar or an employee;
(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

5.10 Extension of time for filing—grant

(1) The Registrar may grant a request under subregulation 5.9(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the request justify the extension.

(2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

5.11 Amendment of notice of intention to oppose

(1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.

(2) If an opposition is proceeding in the name of another person (the ***new opponent***) under section 53 of the Act, the new opponent may request the Registrar to amend the notice of intention to oppose to record the new opponent's name.

(3) The Registrar may grant the request on terms that the Registrar considers appropriate.

(4) If the Registrar grants the request, the Registrar must give a copy of the amended notice of intention to oppose to the applicant.

(5) Regulation 5.4 does not apply to a request under subregulation (1) or (2).

5.12 Amendment of statement of grounds and particulars

(1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
(a) correct an error or omission in the grounds of opposition or the facts and circumstances forming the basis for the grounds; or
(b) amend a ground of opposition; or
(c) add a new ground of opposition; or
(d) to amend the facts and circumstances forming the basis for the grounds.

(2) The Registrar may grant the request on terms that the Registrar considers appropriate.

(3) However, the Registrar may grant a request to:
(a) amend a ground of opposition; or

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(b) add a new ground of opposition;

only if the Registrar is satisfied that the amendment or addition relates to information of which the opponent could not reasonably have been aware at the time of filing the statement.

(4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the applicant.

Subdivision B—Notice of intention to defend

5.13 Filing of notice of intention to defend

(1) For subsection 52A(2) of the Act, a notice of intention to defend must be filed within one month from the day the applicant is given a copy of the statement of grounds and particulars.

(2) The Registrar must give a copy of the notice to the opponent.

5.13A Extension of time for filing—application

(1) A person may apply to the Registrar to extend the period for filing, under subsection 52A(1) of the Act, a notice of intention to defend.

(2) The application must be made before the end of the period of 2 months beginning on the day after the end of the period mentioned in subregulation 5.13(1).

(3) The application must:
(a) be in the approved form; and
(b) be accompanied by a declaration stating the facts and circumstances forming the basis for the grounds for making the application.

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

(4) The application may be made only on either or both of the following grounds:
(a) an error or omission by the person, the person's agent, the Registrar or an employee;
(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

5.13B Extension of time for filing—grant

(1) The Registrar may grant an application under subregulation 5.13A(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the application justify the extension.

(2) However, if the application is made after the period mentioned in subregulation 5.13(1) has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the application.

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(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

Subdivision C—Evidence

5.14 Filing of evidence

(1) The Registrar must notify the parties that:
  (a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
  (b) no evidence was filed for the period.

(2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
  (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
  (b) after the evidentiary period ends.

Evidence in support

(3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend.

Evidence in answer

(4) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the evidence in support within 3 months from the day the Registrar:
  (a) gives the applicant:
    (i) all the evidence in support; or
    (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
  (b) notifies the applicant that all the evidence in support has been filed.

(5) If the opponent does not file any evidence in support of the opposition, the applicant must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Registrar notifies the applicant that no evidence in support was filed.

Evidence in reply

(6) If the applicant files evidence in answer under subregulation (4) or (5), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:
  (a) gives the opponent:
    (i) all the evidence in answer; or
    (ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and
  (b) notifies the opponent that all the evidence in answer has been filed.

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5.15 Extension of time for filing

(1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 5.14.

(2) The Registrar may extend the period only if the Registrar is satisfied that:
  (a) the party:
    (i) has made all reasonable efforts to comply with all relevant filing requirements of this Part; and
    (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
  (b) there are exceptional circumstances that justify the extension.

(3) The Registrar:
  (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
  (b) may do so on terms that the Registrar considers appropriate.

(4) In this regulation:

exceptional circumstances includes the following:
  (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Part;
  (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Part;
  (c) an order of a court or a direction by the Registrar that the opposition be stayed.

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Division 3—Cooling-off period for opposition

5.16 Registrar may allow cooling-off period

(1) This regulation applies to an opposition if:
  (a) the notice of opposition has been filed; and
  (b) the Registrar has not made a decision on the opposition under subsection 55(1) of the Act; and
  (c) the opposition has not been dismissed under section 222 of the Act or regulation 5.8.

(2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.

(3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.

(4) The Registrar must not:
  (a) further extend the cooling-off period; or
  (b) allow more than one cooling-off period for an opposition.

(5) If a party files a notice, in an approved form, requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.

(6) The Registrar may direct the parties on steps the parties must take:
  (a) if the cooling-off period is discontinued; or
  (b) otherwise—when the cooling-off period ends.

(7) The opposition resumes:
  (a) if the cooling-off period is discontinued; or
  (b) otherwise—when the cooling-off period ends.

(8) If:
  (a) the cooling-off period begins during the period mentioned in regulation 5.13 or an evidentiary period mentioned in regulation 5.14; and
  (b) the opposition resumes;

the period mentioned in regulation 5.13 or 5.14 restarts when the opposition resumes.

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Division 4—Hearing of opposition

5.17 Hearing

(1) This regulation applies to an opposition if:
  (a) the opposition has not:
    (i) been dismissed under section 222 of the Act or paragraph 5.8(3)(b) or 5.8(4)(a); or
    (ii) been decided under subsection 55(1) of the Act; and
  (b) the trade mark application to which the opposition relates has not lapsed under section 54A of the Act.

(2) An applicant may request the Registrar to hold a hearing if:
  (a) the evidentiary period mentioned in subregulation 5.14(3) has ended; and
  (b) either:
    (i) all evidence for the opposition proceeding has been filed; or
    (ii) no evidence has been filed in that period.

(3) A party may request the Registrar to hold a hearing if:
  (a) an evidentiary period mentioned in any of subregulations 5.14(4) to (6) has ended; and
  (b) either:
    (i) all evidence for the opposition proceeding has been filed; or
    (ii) no evidence has been filed in that period.

(4) The Registrar:
  (a) must hold a hearing of the opposition if requested by a party; or
  (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(5) The hearing may, at the Registrar's discretion, be:
  (a) an oral hearing; or
  (b) by written submissions.

(6) If the Registrar decides on an oral hearing:
  (a) the Registrar must notify the parties of the date, time and place of the hearing; and
  (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
  (c) the applicant must file a summary of submissions at least 5 business days before the hearing.

(7) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (6) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

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Division 5—Miscellaneous

5.18 Copy of earlier Convention 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 request the Registrar for a copy of an earlier application to be made available.

(2) On receiving the request, the Registrar must require 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) Subregulation (2) does not apply if the applicant has already filed the relevant documents.

(4) The Registrar must give a copy of the documents to the opponent.

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

5.19 Registrar may give direction

(1) The Registrar may give a direction in relation to an opposition to which this Part applies:
  (a) if requested by a party in writing; or
  (b) on the Registrar's own initiative.

(2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

(4) The Registrar must notify the parties of the direction as soon as practicable.

5.20 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under section 222 of the Act or regulation 5.8 or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

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

Division 1—Amendment of application for registration of 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 by notification to the applicant:

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

(b) state that the proposed amendment will be made at the end of a reasonable period stated in the notification, 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 notification of the amendment to:

(a) the person who requested the amendment; and

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

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Division 2—Opposition to amendment after particulars published

6.5 Definitions

In this Division:

notice of opposition means a notice filed under subregulation 6.6(1).

party means an applicant or opponent.

Note: The following terms are defined in section 6 of the Act:
(a) applicant;
(b) approved form;
(c) file;
(d) month;
(e) person.

6.6 Notice of opposition

(1) For subsection 65A(4) of the Act, a person may oppose a request for amendment by filing a notice of opposition, in an approved form, within one month from the advertisement of the request for amendment in the *Official Journal* under subsection 65A(3) of the Act.

(2) The Registrar must give a copy of the notice to the applicant.

6.7 Notification and opportunity to make representations

(1) This regulation applies if:
(a) a party makes a request to the Registrar under this Division; or
(b) the Registrar proposes to make a decision on the Registrar's own initiative under this Division.

(2) The Registrar must:
(a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
(b) for paragraph (1)(b)—notify the parties of the proposed decision.

(3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
(a) in writing; or
(b) at a hearing; or
(c) by other means that the Registrar states in the notification.

(4) The Registrar must notify the parties of the Registrar's decision.

6.8 Practice and procedure

The Registrar may:

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(a) decide the practice and procedure to be followed in an opposition to which this Division applies; and
(b) direct the parties accordingly.

6.9 Hearing

(1) The Registrar:
(a) must hold a hearing of the opposition if requested by a party in writing; or
(b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(2) The hearing may, at the Registrar's discretion, be:
(a) an oral hearing; or
(b) by written submissions.

(3) If the Registrar decides on an oral hearing:
(a) the Registrar must notify the parties of the date, time and place of the hearing; and
(b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
(c) the applicant must file a summary of submissions at least 5 business days before the hearing.

(4) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (3) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

(5) The Registrar must:
(a) decide the opposition; and
(b) notify the parties of the Registrar's decision.

6.10 Registrar may give direction

(1) The Registrar may give a direction in relation to an opposition to which this Division applies:
(a) if requested by a party in writing; or
(b) on the Registrar's own initiative.

(2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

(4) The Registrar must notify the parties of the direction as soon as practicable.

6.11 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

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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 AAT are not determined or otherwise disposed of; and

(b) the prescribed court or the AAT 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 AAT 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;

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(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.

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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 Notification of renewal

For the purposes of subsection 77(2) of the Act (which deals with renewal), a notification 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.

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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 Notification about renewal

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 notification 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 Notification of renewal

For section 80E of the Act (which deals with renewal within the prescribed period), a notification 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.

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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 notification 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 notification.

(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.

8.2 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.

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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 any of the grounds 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.

8.4 Amendment because of inconsistency with international agreements—notice of opposition

(1) For subsection 83A(4) of the Act, 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 Registrar must give a copy of the notice to the registered owner of the registered trade mark.

8.5 Amendment because of inconsistency with international agreements—opposition practice and procedure

The Registrar may:

(a) decide the practice and procedure to be followed in an opposition under subsection 83A(4) of the Act; and

(b) direct the registered owner of the registered trade mark who made the request for amendment, and a person (an ***opponent***) who filed a notice of opposition, accordingly.

8.6 Amendment because of inconsistency with international agreements—hearing

(1) The Registrar:

(a) must hold a hearing of an opposition under subsection 83A(4) of the Act if requested by the registered owner of the registered trade mark, or an opponent, in writing; or

(b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(2) The hearing may, at the Registrar's discretion, be:

(a) an oral hearing; or

(b) by written submissions.

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(3) If the Registrar decides on an oral hearing:
  (a) the Registrar must notify the registered owner of the registered trade mark, and each opponent, of the date, time and place of the hearing; and
  (b) the registered owner of the registered trade mark must file a summary of submissions at least 5 business days before the hearing; and
  (c) each opponent must file a summary of submissions at least 10 business days before the hearing.

(4) If the registered owner of the registered trade mark, or an opponent, fails to file a summary of submissions under subregulation (3), the Registrar may take that failure into account in making an award of costs.

(5) The Registrar must:
  (a) decide the opposition; and
  (b) notify the registered owner of the registered trade mark, and each opponent, of the Registrar's decision.

(6) Regulations 21.15 and 21.16 do not apply in relation to an opposition under subsection 83A(4) of the Act.

8.7 Amendment because of inconsistency with international agreements—opposition directions

(1) The Registrar may give a direction in relation to an opposition under subsection 83A(4) of the Act:
  (a) if requested by the registered owner of the registered trade mark, or an opponent, in writing; or
  (b) on the Registrar's own initiative.

(2) If the Registrar proposes to give a direction, the Registrar must give the registered owner of the registered trade mark, and each opponent, an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

(4) The Registrar must notify the registered owner of the registered trade mark, and each opponent, of the direction as soon as practicable.

8.8 Amendment because of inconsistency with international agreements—notification of dismissal or discontinuance of opposition

If an opposition under subsection 83A(4) of the Act is dismissed under section 222 of the Act or is discontinued, the Registrar must notify the registered owner of the registered trade mark, and each opponent, of the dismissal or discontinuance.

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Part 9—Removal of trade mark from Register for non-use

Division 1—Preliminary

9.1 What Part 9 is about

This Part sets out requirements for the following:

(a) the making and notification of an application for removal;
(b) the filing of notices of opposition and associated documents;
(c) the amending of filed documents;
(d) the dismissal of an opposition;
(e) the hearing of an opposition;
(f) associated matters.

9.2 Definitions

In this Part:

application for removal means an application for removal of a trade mark from the Register.

notice of intention to defend means a notice filed under regulation 9.15.

notice of opposition means a notice of opposition under section 96 of the Act.

opponent means a person who files:

(a) a notice of intention to oppose; and
(b) a statement of grounds and particulars.

party means an applicant or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

(a) the grounds for removal that the opponent intends to rebut; and
(b) the facts and circumstances that form the basis for the opposition to the removal.

Note: The following terms are defined in section 6 of the Act:

(a) applicant;
(b) approved form;
(c) employee;
(d) file;
(e) month;
(f) person.

9.4 Notification and opportunity to make representations

(1) This regulation applies if:

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(a) a party makes a request to the Registrar under this Part; or
(b) the Registrar proposes to make a decision on the Registrar's own initiative under this Part.

(2) The Registrar must:
(a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
(b) for paragraph (1)(b)—notify the parties of the proposed decision.

(3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
(a) in writing; or
(b) at a hearing; or
(c) by other means that the Registrar states in the notification.

(4) The Registrar must notify the parties of the Registrar's decision.

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Division 2—Application for removal

9.5 Application for removal

For paragraph 92(2)(a) of the Act, an application for removal must be in an approved form.

9.6 Notification of application

For subsection 95(1) of the Act, the Registrar must, within one month from the filing of the application, give a copy of the application to each person who, in the Registrar's opinion, should receive one.

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Division 3—Filing of opposition documents

Subdivision A—Notice of opposition

9.7 Components of notice of opposition

(1) The components of a notice of opposition are:
  (a) a notice of intention to oppose; and
  (b) a statement of grounds and particulars.

(2) A notice of opposition is taken to be filed when both of its components have been filed.

9.8 Filing of notice of intention to oppose

(1) For subsection 96(2) of the Act, the period for filing a notice of intention to oppose is 2 months from the day the application for removal is advertised in the *Official Journal*.

(2) The notice must be in an approved form.

(3) The Registrar must give a copy of the notice to the applicant.

9.9 Filing of statement of grounds and particulars

(1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.

(2) The statement must be in an approved form.

9.10 Statement of grounds and particulars must be adequate

(1) The Registrar must assess the adequacy of a statement of grounds and particulars filed under regulation 9.9.

(2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.

(3) If the Registrar decides that the statement is inadequate, the Registrar may:
  (a) direct the opponent to rectify the inadequacy by filing more information on the basis for the opposition to the grounds for removal; or
  (b) dismiss the opposition.

(4) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information to the applicant.

(5) For subsection 99A(1) of the Act, the Registrar may dismiss the opposition if:
  (a) the Registrar decides that the statement is inadequate; or

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(b) the Registrar has directed the opponent to file information under paragraph (3)(a) and:

(i) the opponent fails to file the information; or

(ii) the Registrar decides that the information filed does not rectify the inadequacy of the statement.

(6) Regulation 9.4 does not apply to this regulation.

Note: For review rights in relation to a decision by the Registrar to dismiss an opposition, see subsection 99A(2) of the Act.

9.11 Extension of time for filing—application

(1) A person who intends to oppose an application for removal may request the Registrar to extend:

(a) the period for filing a notice of intention to oppose under subregulation 9.8(1); or

(b) the period for filing a statement of grounds and particulars under subregulation 9.9(1).

(2) A request under paragraph (1)(a) or (b) may be made within the period for filing the document in question.

Note: See subparagraph (3)(b)(ii) and subregulation 9.12(2) in relation to the consequences of making the request after the filing period has ended.

(3) The request must:

(a) be in an approved form; and

(b) be accompanied by a declaration stating:

(i) the facts and circumstances forming the basis for the grounds; and

(ii) if the period for filing the notice of intention to oppose or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

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

(4) The request may be made only on either or both of the following grounds:

(a) an error or omission by the person, the person's agent, the Registrar or an employee;

(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

9.12 Extension of time for filing—grant

(1) The Registrar may grant a request under subregulation 9.11(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the request justify the extension.

(2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension

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unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

9.13 Amendment of notice of intention to oppose

(1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.

(2) If an opposition is proceeding in the name of a person other than the opponent under section 96A of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.

(3) The Registrar may grant the request on terms that the Registrar considers appropriate.

(4) If the Registrar grants the request, the Registrar must give a copy of the amended notice of intention to oppose to the applicant.

(5) Regulation 9.4 does not apply to this regulation.

9.14 Amendment of statement of grounds and particulars

(1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
  (a) correct an error or omission; or
  (b) amend or add facts or circumstances that form the basis of the opposition to the removal.

(2) The Registrar may grant the request on terms that the Registrar considers appropriate.

(3) However, the Registrar may grant the request only if the Registrar is satisfied that the amendment should be made.

(4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the applicant.

Subdivision B—Notice of intention to defend

9.15 Filing of notice of intention to defend

(1) A notice of intention to defend must be filed within one month from the day the applicant is given a copy of the statement of grounds and particulars.

(2) The Registrar must give the opponent a copy of the notice.

(3) If the applicant does not file the notice of intention to defend within the period mentioned in subregulation (1) or that period as extended, the Registrar may decide to:

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(a) take the opposition to have succeeded; and
(b) refuse to remove the trade mark from the Register.

(4) The Registrar must notify the parties of the Registrar's decision.

9.15A Extension of time for filing—application

(1) A person may apply to the Registrar to extend the period for filing a notice of intention to defend.

(2) The application must be made before the end of the period of 2 months beginning on the day after the end of the period mentioned in subregulation 9.15(1).

(3) The application must:
(a) be in the approved form; and
(b) be accompanied by a declaration stating the facts and circumstances forming the basis for the grounds for making the application.

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

(4) The application may be made only on either or both of the following grounds:
(a) an error or omission by the person, the person's agent, the Registrar or an employee;
(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

9.15B Extension of time for filing—grant

(1) The Registrar may grant an application under subregulation 9.15A(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the application justify the extension.

(2) However, if the application is made after the period mentioned in subregulation 9.15(1) has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the application.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

Subdivision C—Evidence

9.16 Filing of evidence

(1) The Registrar must notify the parties that:
(a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
(b) no evidence was filed for the period.

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(2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
  (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
  (b) after the evidentiary period ends.

Evidence in support

(3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend the application for removal.

Evidence in answer

(4) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the opponent's evidence within 3 months from the day the Registrar:
  (a) gives the applicant:
    (i) all the evidence in support; or
    (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
  (b) notifies the applicant that all the evidence in support has been filed.

(5) If the opponent does not file any evidence in support of the opposition, regulation 9.17 applies.

Evidence in reply

(6) If the applicant files evidence in answer under subregulation (4), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:
  (a) gives the opponent:
    (i) all the evidence in answer; or
    (ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and
  (b) notifies the opponent that all the evidence in answer has been filed.

9.17 Request for hearing and circumstances in which opposition taken to have ended

(1) If an opponent requests the Registrar, within the period for filing evidence in support mentioned in subregulation 9.16(3), to hear the opposition, the Registrar must do so.

(2) The opposition is taken to have ended, but not to have been discontinued or dismissed, if the opponent does not:
  (a) file evidence in support in accordance with subregulation 9.16(3); or
  (b) ask for a hearing under subregulation (1).

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(3) The application for removal is taken to be unopposed if:
  (a) the opposition is taken to have ended under subregulation (2); and
  (b) the Registrar is satisfied that the application for removal is in order.

Note 1: See section 97 of the Act in relation to what the Registrar must do if the application for removal is unopposed.

Note 2: Regulations 21.15 and 21.16 deal with hearings.

9.18 Extension of time for filing

(1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 9.16.

(2) The Registrar may extend the period only if the Registrar is satisfied that:
  (a) the party:
    (i) has made all reasonable efforts to comply with all relevant filing requirements of this Part; and
    (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
  (b) there are exceptional circumstances that justify the extension.

(3) The Registrar:
  (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
  (b) may do so on terms that the Registrar considers appropriate.

(4) In this regulation:

exceptional circumstances includes the following:
  (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Part;
  (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Part;
  (c) an order of a court or a direction by the Registrar that the opposition be stayed.

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Division 4—Cooling-off period for opposition

9.19 Registrar may allow cooling-off period

(1) This regulation applies to an opposition if:
  (a) the notice of opposition has been filed; and
  (b) the Registrar has not decided to remove the trade mark under subsection 101(1) of the Act; and
  (c) the opposition has not been dismissed under regulation 9.10.

(2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.

(3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.

(4) The Registrar must not:
  (a) further extend the cooling-off period; or
  (b) allow more than one cooling-off period for an opposition.

(5) If a party files a notice, in an approved form, requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.

(6) The Registrar may direct the parties on steps the parties must take:
  (a) if the cooling-off period is discontinued; or
  (b) otherwise—when the cooling-off period ends.

(7) The opposition resumes:
  (a) if the cooling-off period is discontinued; or
  (b) otherwise—when the cooling-off period ends.

(8) If:
  (a) the cooling-off period begins during the period mentioned in regulation 9.15 or an evidentiary period mentioned in regulation 9.16; and
  (b) the opposition resumes;

the period mentioned in regulation 9.15 or 9.16 restarts when the opposition resumes.

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Division 5—Hearing of opposition

9.20 Hearing

(1) This regulation applies to an opposition if the opposition has not been dismissed under regulation 9.10 or discontinued.

(2) A party may request the Registrar to hold a hearing if an evidentiary period mentioned in regulation 9.16 has ended; and either
  (a) all evidence for the opposition proceeding has been filed; or
  (b) no evidence has been filed in that period.

(3) The Registrar:
  (a) must hold a hearing of the opposition if requested by a party in writing; or
  (b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(4) The hearing may, at the Registrar's discretion, be:
  (a) an oral hearing; or
  (b) by written submissions.

(5) If the Registrar decides on an oral hearing:
  (a) the Registrar must notify the parties of the date, time and place of the hearing; and
  (b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
  (c) the applicant must file a summary of submissions at least 5 business days before the hearing.

(6) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (5) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

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Division 6—Miscellaneous

9.21 Registrar may give direction

(1) The Registrar may give a direction in relation to an opposition to which this Division applies:
  (a) if requested by a party in writing; or
  (b) on the Registrar's own initiative.

(2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

(4) The Registrar must notify the parties of the direction as soon as practicable.

9.22 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 9.10 or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

9.23 Removal of trade mark from register

If the Registrar dismisses the opposition under regulation 9.10, the Registrar must remove the trade mark from the Register in respect of the goods, services, or both, specified in the application for removal.

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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.

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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 notification 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 notification;

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

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

(1) For the purposes of section 111 of the Act, the Registrar must notify a person recorded under Part 11 of the Act as claiming an interest in, or a right in respect of, a trade mark 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 notification, 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 notify under this subregulation has already notified the Registrar in writing that the person consents to the assignment or transmission.

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

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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 by a person to amend particulars of a claim to an interest in, or to a right in respect of, a trade mark must be:
  (a) in writing, in an approved form; and
  (b) accompanied by material supporting the person's entitlement to make the request.

(3) The Registrar must amend the particulars in accordance with the request if:
  (a) the request is made in accordance with subregulation (2); and
  (b) the Registrar is reasonably satisfied that the person making the request is entitled to make 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:

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(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 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 notification.

(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.

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Part 13—Importation of goods infringing Australian trade marks

13.1A Definition

In this Part, a reference to the Comptroller-General of Customs includes a reference to:

(b) for Christmas Island—the Comptroller as defined in the *Customs Act 1901* of Christmas Island; and

(c) for the Cocos (Keeling) Islands—the Comptroller as defined in the *Customs Act 1901* of the Cocos (Keeling) Islands.

13.1 Action period

For the definition of ***action period*** in section 6 of the Act, the period is 10 working days.

13.2 Claim period

For the definition of ***claim period*** in section 6 of the Act, the period is 10 working days.

13.3 Notice of objection to importation—prescribed document

For subsection 132(1) of the Act, a document that sets out the particulars of registration of the registered trade mark is prescribed.

13.4 Notice of objection to importation—authorised users

(1) For paragraph 132(3)(b) of the Act, the period is 2 months from the day the request is made by the authorised user under subsection 132(2) of the Act.

(2) For paragraph 132(3)(e) of the Act, the authorised user must give to the Comptroller-General of Customs documents that show:

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

(b) the authorised user has made the request; and

(c) if the authorised user gives to the Comptroller-General of Customs the notice after the period mentioned in subregulation (1) has ended—the period has ended.

Note: Examples of documents for paragraph (2)(a) are:

(a) an agreement between the registered owner of a trade mark, and the authorised user of the trade mark, that the authorised user of the trade mark is able to give notice of objection; and

(b) a declaration by the registered owner that the authorised user of the trade mark is able to give notice of objection.

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13.5 Claim for release of seized goods

For the purposes of subsection 136(3) of the Act, the claim must include the following information:

(a) the designated owner's full name, home or business address and address for service;

(b) a telephone number for the designated owner;

(c) the grounds for seeking the release of the seized goods;

(d) if the designated owner's home or business address is not in Australia:

(i) the full name and the home or business address of a person who is the designated owner's agent in Australia; and

(ii) an address for service for the person who is the designated owner's agent in Australia; and

(iii) a telephone number for the person; and

(iv) information showing that the person agreed to be the designated owner's agent;

(e) if a person or body other than the agent made arrangements on the designated owner's behalf for the seized goods to be brought to Australia:

(i) the full name, home or business address and address for service of the person or body; and

(ii) a telephone number for the person or body.

Note: Examples of grounds for paragraph (c) are:

(a) that the goods do not infringe the notified trade mark; and

(b) that the importation of the goods does not infringe the notified trade mark.

13.6 Period for compliance with request of Comptroller-General of Customs for information etc.

For the purposes of subsection 143(2) of the Act (which deals with giving information to the Comptroller-General of Customs), 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.

13.7 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.

13.8 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.

13.9 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.

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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).

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(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);

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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.

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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 *Competition and Consumer Act 2010*;

(b) the principles relating to unconscionable conduct set out in Part 2-2 of the Australian Consumer Law (within the meaning of that Act);

(c) the principles relating to unfair practices, safety and product information set out in Parts 3-1, 3-3 and 3-4 of the Australian Consumer Law.

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 AAT 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.

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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 AAT 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.

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(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.

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(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.

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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.

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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.

Contracting Party of the holder has the meaning given by Rule 1(xxvi*bis*) of the Madrid 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 3*ter* (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 3*ter* (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 3*ter* (1) or (2) of the Protocol, for extension to Australia of the protection resulting from the international registration of a trade mark.

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Madrid Regulations means the Regulations under the Madrid Protocol, as the Regulations are in force for Australia on 1 October 2020.

Note 1: The Regulations could in 2020 be viewed on the World Intellectual Property Organization website (http://wipo.int/).

Note 2: For ***Madrid Protocol***, see regulation 2.1 of these Regulations.

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 3*ter* (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 3*ter* (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:

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(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.

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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 Madrid 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:

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(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 Madrid 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 3*ter* (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.

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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.

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(3) If the Registrar is reasonably satisfied that a term to be used in an IRDA to specify goods or services in respect of which protection is sought:

(a) is too vague for the purposes of determining the scope of that protection; or

(b) is incomprehensible; or

(c) is linguistically incorrect;

then the term must not be used in the IRDA to specify the goods or services in respect of which protection is sought.

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 Madrid 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 Madrid 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.

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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 Madrid 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 or New Zealand.

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 or New Zealand.

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 report that belief by notification to the holder.

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(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 notify the holder that the holder is required 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 notify the holder that the holder is required 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;

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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) or that period as extended under regulation 17A.20 or section 224 of the Act; 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.48C(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.

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(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 AAT 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 Commission in accordance with regulation 16.2 (as applied by regulation 17A.50).

(4) The Registrar must notify the holder:

(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 ***deferment 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 notification of deferment issued under subregulation 17A.21(4).

(2) The deferment 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 deferment 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 deferment; and

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(c) if acceptance is deferred because of subparagraph 17A.21(1)(c)(iii)—when proceedings under Part 9 of the Act or regulation 17A.48C 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 AAT, or a court to which any appeal arising from review by the AAT 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 Commission 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 Commission 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 notify the holder 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).

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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 as mentioned in subregulation 17A.32(1), 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
  (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 the Madrid Regulations; and
  (b) must notify the holder 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 as mentioned in subregulation 17A.32(1), 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.

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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(3)(b) 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

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(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.

(3) The ground set out in section 177 of the Act is a ground for rejecting an IRDA that is for a certification trade mark.

Subdivision C—Opposition to IRDA

17A.29 Definitions

In this Subdivision:

extension of protection means the extension of protection in Australia to the trade mark that is the subject of the IRDA.

notice of intention to defend means a notice filed under regulation 17A.34H.

notice of intention to oppose means a notice filed under regulation 17A.33.

notice of opposition means:

(a) a notice of intention to oppose; and

(b) a statement of grounds and particulars.

opponent means a person who files:

(a) a notice of intention to oppose; and

(b) a statement of grounds and particulars.

party means an IRDA holder or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

(a) the grounds on which the opponent intends to rely; and

(b) the facts and circumstances forming the basis for the grounds.

Note: The following terms are defined in section 6 of the Act:

(a) applicant;

(b) approved form;

(c) employee;

(d) file;

(e) month;

(f) person.

17A.31 Notification and opportunity to make representations

(1) This regulation applies if:

(a) a party makes a request to the Registrar under this Subdivision; or

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(b) the Registrar proposes to make a decision on the Registrar's own initiative under this Subdivision.

(2) The Registrar must:
(a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
(b) for paragraph (1)(b)—notify the parties of the proposed decision.

(3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
(a) in writing; or
(b) at a hearing; or
(c) by other means that the Registrar states in the notification.

(4) The Registrar must notify the parties of the Registrar's decision.

17A.32 Filing of notice of opposition

(1) A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 17A.33 and 17A.34A.

(2) The Registrar must notify the International Bureau of the filing of the notice of opposition in accordance with rule 17, as applicable, of the Madrid Regulations.

17A.33 Filing of notice of intention to oppose

(1) If the Registrar advertises the acceptance of an IRDA in the *Official Journal*, a person may oppose the extension of protection by filing a notice of intention to oppose within 2 months from the advertisement of the acceptance.

(2) The notice must be in an approved form.

(3) The Registrar must give a copy of the notice to the holder of the IRDA.

17A.34 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 62A of the Act, as affected by subregulation (3).

(3) Sections 58 to 61 and 62A of the Act 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

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(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) of the Act 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 provides for the amendment of documents filed with the Registrar.

17A.34A Filing of statement of grounds and particulars

(1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.

(2) The statement must be in an approved form.

17A.34B Statement of grounds and particulars must be adequate

(1) The Registrar must assess the adequacy of a statement of grounds and particulars.

(2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the holder of the IRDA.

(3) If the Registrar decides that the statement is inadequate:

(a) the Registrar may direct the opponent to rectify the inadequacy by filing more information on the basis for one or more of the grounds; or

(b) if all the grounds are inadequately particularised, the Registrar may dismiss the opposition: or

(c) if only some of the grounds are inadequately particularised, the Registrar may:

(i) delete from the statement some or all of the material that is inadequate; and

(ii) treat the result as the statement for the purposes of these Regulations; and

(iii) give a copy of the amended statement to the opponent.

(4) If the Registrar decides that the statement is still inadequate after the information is filed under paragraph (3)(a):

(a) the Registrar may dismiss the opposition; or

(b) the Registrar may:

(i) delete from the statement some or all of the material that is inadequate; and

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(ii) treat the result as the statement for the purposes of these Regulations; and

(iii) give a copy of the amended statement to the opponent.

(5) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information filed in relation to paragraph (3)(a) to the holder of the IRDA.

(6) The opponent may apply to the Administrative Appeals Tribunal for review of a decision under this regulation to dismiss the opposition or delete material from the statement of grounds and particulars.

(7) Regulation 17A.31 does not apply to this regulation.

17A.34C Extension of time for filing—application

(1) A person who intends to oppose the extension of protection may request the Registrar to extend:

(a) the period for filing a notice of intention to oppose under subregulation 17A.33(1); or

(b) the period for filing a statement of grounds and particulars under subregulation 17A.34A(1).

(2) A request under paragraph (1)(a) or (b) may be made:

(a) within the period for filing the document in question; or

(b) before the extension of protection of the IRDA is entered on the Record of International Registrations under paragraph 17A.37(1)(b).

Note: See subparagraph (3)(b)(ii) and subregulation 17A.34D(2) in relation to the consequences of making the request after the filing period has ended.

(3) The request must:

(a) be in an approved form; and

(b) be accompanied by a declaration stating:

(i) the facts and circumstances forming the basis for the grounds; and

(ii) if the period for filing the notice or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

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

(4) The request must be made only on either or both of the following grounds:

(a) an error or omission by the person, the person's agent, the Registrar or an employee;

(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

(5) Subsection 52(5) of the Act applies to the request.

(6) Regulation 17A.31 does not apply to this regulation.

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17A.34D Extension of time for filing—grant

(1) The Registrar may grant a request under subregulation 17A.34C(1) for an extension of time if the Registrar is satisfied that the grounds set out in the request justify the extension.

(2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.34E Opposition may proceed in name of other person

Section 53 of the Act applies to a notice of intention to oppose filed under this Subdivision.

17A.34F Amendment of notice of intention to oppose

(1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.

(2) If an opposition proceeds in the name of another person under section 53 of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.

(3) The Registrar may grant a request under subregulation (1) or (2) on terms that the Registrar considers appropriate.

(4) If the Registrar grants the request, the Registrar must give a copy of the notice of the amended intention to oppose to the IRDA holder.

(5) Regulation 17A.31 does not apply to this regulation.

17A.34G Amendment of statement of grounds and particulars

(1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
   (a) correct an error or omission in the grounds of opposition or the facts and circumstances forming the basis for the grounds; or
   (b) amend a ground of opposition; or
   (c) add a new ground of opposition; or
   (d) to amend the facts and circumstances forming the basis for the grounds.

(2) The Registrar may grant the request on terms that the Registrar considers appropriate.

(3) However, the Registrar may grant a request to:
   (a) amend a ground of opposition; or

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(b) add a new ground of opposition;

only if the Registrar is satisfied that the amendment or addition relates to information of which the opponent could not reasonably have been aware at the time of filing the statement.

(4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the IRDA holder.

17A.34H Filing of notice of intention to defend

(1) The IRDA holder must file a notice of intention to defend within one month from the day the Registrar notifies the International Bureau under subregulation 17A.32(2).

(2) The holder must file an Australian or New Zealand address for service with the notice.

(3) The Registrar must give a copy of the notice to the opponent.

(4) If the holder does not file the notice within the period mentioned in subregulation (1) or that period as extended, the Registrar may decide to:

(a) take the opposition to have succeeded; and

(b) refuse protection to the holder.

(5) The Registrar is not required to take any action in response to a notice of intention to defend filed under subregulation (1) unless the holder has notified the Registrar, in writing, of the holder's address for service in Australia or New Zealand.

(6) A requirement to:

(a) give a document to a person; or

(b) give a person an opportunity to make written representations or to be heard;

does not apply if no address for service of the person is recorded in the Record of International Registrations.

(7) The Registrar must notify the parties of the Registrar's decision.

17A.34HA Extension of time for filing—application

(1) A person may apply to the Registrar to extend the period for filing a notice of intention to defend.

(2) The application must be made before the end of the period of 2 months beginning on the day after the end of the period mentioned in subregulation 17A.34H(1).

(3) The application must:

(a) be in the approved form; and

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(b) be accompanied by a declaration stating the facts and circumstances forming the basis for the grounds for making the application.

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

(4) The application may be made only on either or both of the following grounds:
(a) an error or omission by the person, the person's agent, the Registrar or an employee;
(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

17A.34HB Extension of time for filing—grant

(1) The Registrar may grant an application under subregulation 17A.34HA(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the application justify the extension.

(2) However, if the application is made after the period mentioned in subregulation 17A.34H(1) has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the application.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.34J Filing of evidence

(1) The Registrar must notify the parties that:
(a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
(b) no evidence was filed for the period.

(2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
(a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
(b) after the evidentiary period ends.

Evidence in support

(3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend.

Evidence in answer

(4) If the opponent files evidence in support of the opposition, the IRDA holder must file any evidence in answer to the evidence in support within 3 months from the day the Registrar:
(a) gives the IRDA holder:
(i) all the evidence in support; or

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(ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and

(b) notifies the IRDA holder that all the evidence in support has been filed.

(5) If the opponent does not file any evidence in support of the opposition, the IRDA holder must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Registrar notifies the IRDA holder that no evidence in support was filed.

Evidence in reply

(6) If the IRDA holder files evidence in answer under subregulation (4) or (5), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:

(a) gives the opponent:

(i) all the evidence in answer; or

(ii) if the IRDA holder files the evidence in answer in instalments—the final instalment of the evidence in answer; and

(b) notifies the opponent that all the evidence in answer has been filed.

17A.34K Extension of time for filing

(1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 17A.34J.

(2) The Registrar may extend the period only if the Registrar is satisfied that:

(a) the party:

(i) has made all reasonable efforts to comply with all relevant filing requirements of this Subdivision; and

(ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or

(b) there are exceptional circumstances that justify the extension.

(3) The Registrar:

(a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and

(b) may do so on terms that the Registrar considers appropriate.

(4) In this regulation:

exceptional circumstances includes the following:

(a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Subdivision;

(b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Subdivision;

(c) an order of a court or a direction by the Registrar that the opposition be stayed.

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17A.34L Registrar may allow cooling-off period

(1) This regulation applies to an opposition if:
  (a) the notice of opposition has been filed; and
  (b) the Registrar has not made a decision on the opposition under regulation 17A.34N; and
  (c) the opposition has not been dismissed under regulation 17A.34B.

(2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.

(3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.

(4) The Registrar must not:
  (a) further extend the cooling-off period; or
  (b) allow more than one cooling-off period for an opposition.

(5) If a party files a notice in an approved form requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.

(6) The Registrar may direct the parties on steps they must take:
  (a) if the cooling-off period is discontinued; or
  (b) otherwise—when the cooling-off period ends.

(7) The opposition resumes:
  (a) if the cooling-off period is discontinued; or
  (b) otherwise—when the cooling-off period ends.

(8) If:
  (a) the cooling-off period begins during the period mentioned in regulation 17A.34H or an evidentiary period mentioned in regulation 17A.34J; and
  (b) the opposition resumes;

the period mentioned in regulation 17A.34H or 17A.34J restarts when the opposition resumes.

17A.34M Hearing

(1) This regulation applies to an opposition if:
  (a) the opposition has not been dismissed under regulation 17A.34B; or
  (b) the opposition has not been decided under regulation 17A.34N; or
  (c) the opposition is not taken to have succeeded under regulation 17A.34H.

(2) The holder of an IRDA may request the Registrar to hold a hearing if:
  (a) the evidentiary period mentioned in subregulation 17A.34J(3) has ended; and
  (b) either:
    (i) all evidence for the opposition proceeding has been filed; or

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(ii) no evidence has been filed in that period.

(3) A party may request the Registrar to hold a hearing if:
(a) an evidentiary period mentioned in any of subregulations 17A.34J(4) to (6) has ended; and
(b) either:
(i) all evidence for the opposition proceeding has been filed; or
(ii) no evidence has been filed in that period.

(4) The Registrar:
(a) must hold a hearing of the opposition if requested by a party in writing; or
(b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(5) The hearing may, at the Registrar's discretion, be:
(a) an oral hearing; or
(b) by written submissions.

(6) If the Registrar decides on an oral hearing:
(a) the Registrar must notify the parties of the date, time and place of the hearing; and
(b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
(c) the holder of the IRDA must file a summary of submissions at least 5 business days before the hearing.

(7) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (6) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

17A.34N 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 the grounds on which the IRDA was opposed have been established.

(2) The Registrar must notify the International Bureau of the Registrar's decision.

17A.34P 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

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

(2) If an appeal is made, the Registrar must tell the International Bureau of the decision on the appeal.

17A.34Q Registrar may give direction

(1) The Registrar may give a direction in relation to an opposition to which this Division applies:
   (a) if requested by a party in writing; or
   (b) on the Registrar's own initiative.

(2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

(4) The Registrar must notify the parties of the direction as soon as practicable.

17A.35 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 17A.34B or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

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 Madrid Regulations.

(3) The Registrar may, within the declaration period declare, under Rule 27(5) of the Madrid Regulations, that the limitation has:
   (a) no effect on the IRDA; or
   (b) partial effect on the IRDA.

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(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 Madrid 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 9^{bis} (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.34P, not including any extension of the period that the court may allow in a particular case.

(2) If:
  (a) the Registrar accepts an IRDA; and
  (b) either:
    (i) no notice of intention to oppose is filed within the period (the ***relevant period***) allowed under subregulation 17A.33(1) or that period as extended; or
    (ii) a notice of intention to oppose is filed within the period allowed under subregulation 17A.33(1) or that period as extended but no statement of grounds and particulars is filed within the period (the ***relevant***

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period) allowed under subregulation 17A.34A(1) or that period as extended;

the trade mark that is the subject of the IRDA becomes a protected international trade mark at the end of the relevant period or that period as extended, as the case requires.

(2A) If:

(a) the Registrar accepts an IRDA; and

(b) a notice of opposition to the IRDA is filed as mentioned in subregulation 17A.32(1); 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) a notice of opposition to the IRDA is filed as mentioned in subregulation 17A.32(1); 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) a notice of opposition to the IRDA is filed as mentioned in subregulation 17A.32(1); 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) a notice of opposition to the IRDA is filed as mentioned in subregulation 17A.32(1); 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.

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(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.32(2); 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) a notice of opposition to the IRDA is filed as mentioned in subregulation 17A.32(1); and

(c) the International Bureau does not receive notification under subregulation 17A.32(2) 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 or New Zealand.

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.

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(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.

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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 of the Act and Parts 12, 13 and 14 of the Act (except section 128 of the Act) and regulations 3.2, 13.1, 13.2 and 13.3 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) of the Act 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.48C(3) for an order directing the Registrar to cease protection; and
  (b) the reference in paragraph 129(1)(b) of the Act 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

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(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.

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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 Madrid Regulations.

(3) The Registrar may, within the declaration period declare, under Rule 27(5) of the Madrid 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 Madrid 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.

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(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.

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(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 on which the extension of protection could have been opposed under regulation 17A.34, 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 is it 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;

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(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 or New Zealand 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

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(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 Comptroller-General of Customs

(1) If the Registrar exercises a power mentioned in subregulation 17A.42A(1) the Registrar must notify the Comptroller-General of Customs in writing.

(2) Despite paragraph 17A.42D(3)(a), if the Comptroller-General of Customs seizes under Part 13 of the Act 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 Comptroller-General of Customs written notice in accordance with subregulation (1); and

(b) the seizure occurs after the notice is given to the Comptroller-General of Customs.

(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 Appeals to Federal Court or Federal Magistrates 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 or Federal Magistrates Court from a decision of the Registrar to exercise, or not exercise, a power mentioned in subregulation 17A.42A(1).

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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.

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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.34;
  (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;

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(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 D—Cessation of protection for non-use

17A.48 Definitions

In this Subdivision:

application for cessation of protection means an application to the Registrar for cessation of protection of a trade mark that is, or may become, a protected international trade mark.

cessation of protection means the cessation of protection of a trade mark that is a protected international trade mark.

notice of intention to defend means a notice filed under regulation 17A.48Q.

notice of intention to oppose means a notice filed under regulation 17A.48G.

notice of opposition means:

(a) a notice of intention to oppose; and

(b) a statement of grounds and particulars.

opponent means a person who files:

(a) a notice of intention to oppose; and

(b) a statement of grounds and particulars.

party means an applicant or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

(a) the grounds for cessation of protection that the opponent intends to rebut; and

(b) the facts and circumstances that form the basis for the opposition to the cessation of protection.

Note: The definitions of the following terms are in section 6 of the Act:

(a) applicant;

(b) approved form;

(c) employee;

(d) file;

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(e) month;
(f) person.

17A.48B Notification and opportunity to make representations

(1) This regulation applies if:
  (a) a party makes a request to the Registrar under this Subdivision; or
  (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Subdivision.

(2) The Registrar must:
  (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
  (b) for paragraph (1)(b)—notify the parties of the proposed decision.

(3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
  (a) in writing; or
  (b) at a hearing; or
  (c) by other means that the Registrar states in the notification.

(4) The Registrar must notify the parties of the Registrar's decision.

17A.48C Application for cessation of protection

(1) A person may make an application for cessation of protection.

(2) However, an application may not be made under subregulation (1) if an action concerning the protected international trade mark is pending in a prescribed court.

(3) If subregulation (2) applies, a person may apply to the court for an order directing the Registrar to cease protecting the protected international trade mark.

17A.48D Cessation of protection

(1) Part 9 of the Act and Part 9 of these Regulations apply in relation to an application for cessation of protection.

(2) 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 trade mark that is, or may become, a protected international trade mark; and
  (b) to removing a trade mark from the Register is taken to be a reference to the cessation of protection of the 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

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(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 for cessation of protection; and

(g) to the date the application for registration of the trade mark was filed, or the filing date in respect of the application for the 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 3*ter* (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 3*ter* (2) of the Protocol—the date of recording of the request; and

(h) to the date the particulars of the trade mark were entered into the Register under section 69 is taken to be a reference to the date the trade mark became a protected international trade mark under regulation 17A.36.

Note: The expressions ***date of international registration*** and ***date of recording*** are defined in regulation 17A.2.

(3) Sections 96 to 101 of the Act apply in relation to the cessation of protection for non-use.

17A.48E Notification of application

For subsection 95(1) of the Act, the Registrar must, within one month from the filing of the application, give a copy of the application to each person who, in the Registrar's opinion, should receive one.

17A.48F Filing of notice of opposition

A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 17A.48G and 17A.48J.

17A.48G Filing of notice of intention to oppose

(1) For subsection 96(2) of the Act, the period for filing a notice of intention to oppose the application for cessation of protection must be filed within 2 months from the day the application for cessation of protection is advertised in the *Official Journal*.

(2) The notice must be in an approved form.

(3) The Registrar must give a copy of the notice to the applicant.

17A.48H Opponent must have address for service

(1) This regulation applies despite any other regulation in this Subdivision.

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(2) The Registrar is not required to take any action in response to a notice of opposition filed under regulation 17A.48F unless the opponent has notified the Registrar, in writing, of the opponent's address for service in Australia or New Zealand.

(3) A requirement to give a document to an opponent, or to give the opponent an opportunity to make written representations or to be heard, does not apply if no address for service of the opponent is recorded in the Record of International Registrations.

17A.48J Filing of statement of grounds and particulars

(1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.

(2) The statement must be in an approved form.

17A.48K Statement of grounds and particulars must be adequate

(1) The Registrar must assess the adequacy of a statement of grounds and particulars filed under regulation 17A.48J.

(2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the applicant.

(3) If the Registrar decides that the statement is inadequate, the Registrar may:
  (a) direct the opponent to rectify the inadequacy by filing more information on the basis for the opposition to the cessation of protection; or
  (b) dismiss the opposition.

(4) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information to the applicant.

(5) For subsection 99A(1) of the Act, the Registrar may dismiss the opposition if:
  (a) the Registrar decides that the statement is inadequate; or
  (b) the Registrar has directed the opponent to file information under paragraph (3)(a) and:
    (i) the opponent fails to file the information; or
    (ii) the Registrar decides that the information filed does not rectify the inadequacy of the statement.

(6) Regulation 17A.48B does not apply to this regulation.

Note: For review rights in relation to a decision by the Registrar to dismiss an opposition, see subsection 99A(2) of the Act.

17A.48L Extension of time for filing—application

(1) A person who intends to oppose an application for cessation of protection may request the Registrar to extend:

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(a) the period for filing a notice of intention to oppose under subregulation 17A.48G(1); or

(b) the period for filing a statement of grounds and particulars under subregulation 17A.48J(1).

(2) A request under paragraph (1)(a) or (b) may be made within the period for filing the document in question.

Note: See subparagraph (3)(b)(ii) and subregulation 17A.48M(2) in relation to the consequences of making the request after the filing period has ended.

(3) The request must:

(a) be in an approved form; and

(b) be accompanied by a declaration stating:

(i) the facts and circumstances forming the basis for the grounds; and

(ii) if the period for filing the notice of intention to oppose or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

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

(4) The request may be made only on either or both of the following grounds:

(a) an error or omission by the person, the person's agent, the Registrar or an employee;

(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

17A.48M Extension of time for filing—grant

(1) The Registrar may grant a request under subregulation 17A.48L(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the request justify the extension.

(2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.48N Amendment of notice of intention to oppose

(1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.

(2) If an opposition is proceeding in the name of a person other than the opponent under section 96A of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.

(3) The Registrar may grant the request on terms that the Registrar considers appropriate.

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(4) If the Registrar grants the request, the Registrar must give a copy of the amended notice of intention to oppose to the applicant.

(5) Regulation 17A.48B does not apply to a request under subregulation (1) or (2).

(6) Section 96A of the Act applies in relation to the opposition.

17A.48P Amendment of statement of grounds and particulars

(1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
  (a) correct an error or omission; or
  (b) amend or add facts or circumstances that form the basis of the opposition to the cessation of protection.

(2) The Registrar may grant the request on terms that the Registrar considers appropriate.

(3) However, the Registrar may grant the request only if the Registrar is satisfied that the amendment should be made.

(4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the applicant.

17A.48Q Filing of notice of intention to defend

(1) A notice of intention to defend must be filed within one month from the day the applicant is given a copy of the statement of grounds and particulars.

(2) The Registrar must give the opponent a copy of the notice.

(3) If the applicant does not file the notice of intention to defend within the period mentioned in subregulation (1) or that period as extended, the Registrar may decide to:
  (a) take the opposition to have succeeded; and
  (b) refuse to cease protection of the protected international trade mark.

(4) The Registrar must notify the parties of the Registrar's decision.

17A.48QA Extension of time for filing—application

(1) A person may apply to the Registrar to extend the period for filing a notice of intention to defend.

(2) The application must be made before the end of the period of 2 months beginning on the day after the end of the period mentioned in subregulation 17A.48Q(1).

(3) The application must:
  (a) be in the approved form; and

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(b) be accompanied by a declaration stating the facts and circumstances forming the basis for the grounds for making the application.

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

(4) The application may be made only on either or both of the following grounds:
(a) an error or omission by the person, the person's agent, the Registrar or an employee;
(b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

17A.48QB Extension of time for filing—grant

(1) The Registrar may grant an application under subregulation 17A.48QA(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the application justify the extension.

(2) However, if the application is made after the period mentioned in subregulation 17A.48Q(1) has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the application.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.48R Filing of evidence

(1) The Registrar must notify the parties that:
(a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
(b) no evidence was filed for the period.

(2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:
(a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
(b) after the evidentiary period ends.

Evidence in support

(3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend the application for cessation of protection.

Evidence in answer

(4) If the opponent files evidence in support of the opposition, the applicant must file any evidence in answer to the opponent's evidence within 3 months from the day the Registrar:
(a) gives the applicant:

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(i) all the evidence in support; or

(ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and

(b) notifies the applicant that all the evidence in support has been filed.

(5) If the opponent does not file any evidence in support of the opposition, regulation 17A.48S applies.

Evidence in reply

(6) If the applicant files evidence in answer under subregulation (4), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:

(a) gives the opponent:

(i) all the evidence in answer; or

(ii) if the applicant files the evidence in answer in instalments—the final instalment of the evidence in answer; and

(b) notifies the opponent that all the evidence in answer has been filed.

17A.48S Request for hearing and circumstances in which opposition taken to have ended

(1) If an opponent requests the Registrar, within the period for filing evidence in support mentioned in subregulation 17A.48R(3), to hear the opposition, the Registrar must do so.

(2) The opposition is taken to have ended, but not to have been discontinued or dismissed, if the opponent does not:

(a) file evidence in support in accordance with subregulation 17A.48R(3); or

(b) ask for a hearing under subregulation (1).

(3) The application for cessation of protection is taken to be unopposed if:

(a) the opposition is taken to have ended under subregulation (2); and

(b) the Registrar is satisfied that the application for cessation of protection is in order.

Note 1: See section 97 of the Act in relation to what the Registrar must do if the application for cessation of protection is unopposed.

Note 2: Regulations 21.15 and 21.16 deal with hearings.

17A.48T Extension of time for filing

(1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 17A.48R.

(2) The Registrar may extend the period only if the Registrar is satisfied that:

(a) the party:

(i) has made all reasonable efforts to comply with all relevant filing requirements of this Subdivision; and

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(ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or

(b) there are exceptional circumstances that justify the extension.

(3) The Registrar:

(a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and

(b) may do so on terms that the Registrar considers appropriate.

(4) In this regulation:

exceptional circumstances includes the following:

(a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Subdivision;

(b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Subdivision;

(c) an order of a court or a direction by the Registrar that the opposition be stayed.

17A.48U Registrar may allow cooling-off period

(1) This regulation applies to an opposition if:

(a) the notice of opposition has been filed; and

(b) the Registrar has not decided to remove the trade mark under subsection 101(1) of the Act; and

(c) the opposition has not been dismissed under regulation 17A.48K.

(2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.

(3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.

(4) The Registrar must not:

(a) further extend the cooling-off period; or

(b) allow more than one cooling-off period for an opposition.

(5) If a party files a notice, in an approved form, requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.

(6) The Registrar may direct the parties on steps the parties must take:

(a) if the cooling-off period is discontinued; or

(b) otherwise—when the cooling-off period ends.

(7) The opposition resumes:

(a) if the cooling-off period is discontinued; or

(b) otherwise—when the cooling-off period ends.

(8) If:

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(a) the cooling-off period begins during the period mentioned in regulation 17A.48Q or an evidentiary period mentioned in regulation 17A.48R; and
(b) the opposition resumes;

the period mentioned in regulation 17A.48Q or 17A.48R restarts when the opposition resumes.

17A.48V Hearing

(1) This regulation applies to an opposition if the opposition has not been dismissed under regulation 17A.48K or discontinued.

(2) A party may request the Registrar to hold a hearing if an evidentiary period mentioned in regulation 17A.48R has ended; and either:
(a) all evidence for the opposition proceeding has been filed; or
(b) no evidence has been filed in that period.

(3) The Registrar:
(a) must hold a hearing of the opposition if requested by a party in writing; or
(b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(4) The hearing may, at the Registrar's discretion, be:
(a) an oral hearing; or
(b) by written submissions.

(5) If the Registrar decides on an oral hearing:
(a) the Registrar must notify the parties of the date, time and place of the hearing; and
(b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
(c) the applicant must file a summary of submissions at least 5 business days before the hearing.

(6) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (5) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

17A.48W Registrar may give direction

(1) The Registrar may give a direction in relation to an opposition to which this Division applies:
(a) if requested by a party in writing; or
(b) on the Registrar's own initiative.

(2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

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(4) The Registrar must notify the parties of the direction as soon as practicable.

17A.48X Registrar must notify International Bureau

If the result of an action under this Subdivision 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.

17A.48Y Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 17A.48K or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

17A.48Z Cessation of protection of protected international trade mark

If the Registrar dismisses the opposition under regulation 17A.48K, the Registrar must cease protection in respect of the goods, services, or both, specified in the application for cessation of protection.

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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

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(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 Madrid 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 or New Zealand.

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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.

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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 4*bis*.

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 Madrid 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.

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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 Madrid 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 Madrid 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 Commission 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 Commission; 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 Madrid 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 Commission 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 Madrid Regulations that, subject to subregulation (2), the change of ownership has no effect in Australia; and

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(b) notify the person that the change of ownership will have effect at the end of 2 months from the date of the notification 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.

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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) An application by a person under subregulation (1) must:
  (a) be made in an approved form; and
  (b) be accompanied by material supporting the person's interest in, or a right in respect of, the trade mark; and
  (b) 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.

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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 Madrid 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;
  (ba) the address for service 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 Madrid 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.

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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 Madrid Regulations may be adduced by producing a book or pamphlet containing the Protocol or the Madrid 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.

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(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) files a notice of opposition to an IRDA as mentioned in subregulation 17A.32(1); or

(b) applies to the Registrar under regulation 17A.48C 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.

17A.74 Address for service of documents

Application of regulation

(1) This regulation applies in relation to the following persons:

(a) the holder of an IRDA;

(b) the holder of a protected international trade mark;

(c) a person who applies under regulation 17A.61 to have a claim recorded;

(d) a person whose claim is recorded under regulation 17A.62;

(e) a person who opposes the extension of protection in Australia to a trade mark that is the subject of an IRDA by filing a notice of opposition as mentioned in subregulation 17A.32(1);

(f) a person who applies under subregulation 17A.48C(1) for a trade mark that is, or may become, a protected international trade mark to cease to be protected;

(g) a person who opposes an application under subregulation 17A.48C(1).

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Note: The address for service of a person who is not mentioned in subregulation (1) is covered by section 215 of the Act.

Address for service

(2) An address for service for the person must be:
  (a) an address in Australia or New Zealand at which a document under the Act or these Regulations may be given to the person personally or to the person's representative; or
  (b) an address in Australia to which it is practicable and reasonable for Australia Post, or a person acting on behalf of Australia Post, to deliver mail; or
  (c) an address in New Zealand to which it is practicable and reasonable for a person providing mail delivery services to deliver mail.

(3) If the person notifies the Registrar of an address for service, the Registrar must enter the address in the Record of International Registrations as the person's address for service.

(4) If the address changes to another address:
  (a) the person must notify the Registrar of the new address; and
  (b) the Registrar must amend the Record of International Registrations accordingly.

(5) If the person ceases to have an address for service in respect of the IRDA or protected international trade mark:
  (a) the person must notify the Registrar that the person no longer has an address for service; and
  (b) the Registrar must remove the address from the Record of International Registrations.

Note: See subregulation (9).

(6) If the Registrar is satisfied that the address for service notified by the person is no longer an address of the person, the Registrar must remove the address from the Record of International Registrations and notify the person of the removal.

Note: See subregulation (9).

Service

(7) If the Act provides, or these Regulations provide, that a document is to be served on, or given or sent to, the person, the document may be left at, or sent by post to, the address for service of the person.

Note: Section 29 of the *Acts Interpretation Act 1901* and section 160 of the *Evidence Act 1995* may govern when service on an address in Australia is taken to be effected.

(8) Subregulation (7) does not affect the operation of section 28A of the *Acts Interpretation Act 1901*.

Note: Section 28A of the *Acts Interpretation Act 1901* provides that a document may be served (this term includes given, or sent, to):

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‘(a) on a natural person:

(i) by delivering it to the person personally; or

(ii) by leaving it at, or by sending it by pre-paid post to, the address of the place of residence or business of the person last known to the person serving the document; or

(b) on a body corporate—by leaving it at, or sending it by pre-paid post to, the head office, a registered office or a principal office of the body corporate.’.

No address for service

(9) If no address for service is recorded for the person in the Record of International Registrations:

(a) a requirement in the Act or these Regulations to serve a document on the person is taken to be satisfied by posting the document to, or leaving it at, a foreign address appearing in the Record for the person; and

(b) the requirement is taken to be satisfied on the day in Australia on which the document is posted to, or left at, the foreign address.

Note: If subregulation (9) applies, and a document is required to be served in a prescribed period, it will be sufficient compliance that the document is posted to the foreign address on the final day in Australia of the prescribed period. It is not necessary for the posted document to be received at the foreign address on or before that final day, as reckoned in Australia or at the foreign address.

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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 (if any) 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 (if any) 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.

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Part 20—Registered trade marks attorneys

Division 1—General

20.1A Application of Part

This Part applies to:

(a) a trade marks attorney who is not an incorporated trade marks attorney; and

(b) an individual applying for registration as a trade marks attorney.

20.1 Interpretation

In this Part:

AQF means the Australian Qualifications Framework.

serious offence means an offence that:

(a) involves obtaining property or a financial advantage by deception or fraudulent conduct; and

(b) is either:

(i) an indictable offence against a law of the Commonwealth, a State or a Territory (whether or not the offence may be dealt with summarily); or

(ii) an offence against a law of a foreign country that would be an indictable offence against a law of the Commonwealth, a State or a Territory if committed in Australia (whether or not the offence could be dealt with summarily if committed in Australia).

unsatisfactory professional conduct has the meaning given by regulation 20.32 of the *Patents Regulations 1991*.

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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 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 declaration, by another person, that the applicant is of good fame, integrity and character.

(2) A 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.

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(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) a level 5 or higher AQF qualification; or

(b) a qualification awarded by an overseas institution that the Board is satisfied is equivalent to a level 5 or higher AQF qualification.

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

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(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.

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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:

(a) item 2 in Part 2 of that Schedule provided:

‘2. A course of study must provide for a student to have an appropriate level of understanding of the Australian legal system and how intellectual property rights may be protected.’; and

(b) item 5 in Part 5 of that Schedule 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’.

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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’.

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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’.

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Division 5—Maintaining registration and removing and restoring name to Register of Trade Marks Attorneys

20.14 Maintaining registration and removing and restoring name to Register of Trade Marks Attorneys

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 of Patent Attorneys’ 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

(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’.

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Division 5A—Suspension of registration

20.14A Requirement to notify of serious offence

(1) A registered trade marks attorney who has been charged with a serious offence must, within 14 days after being charged, notify the Designated Manager, in writing, of the charge.

(2) If the registered trade marks attorney:
  (a) fails to comply with subregulation (1); and
  (b) does not have a reasonable excuse for failing to comply;
the failure to comply constitutes unsatisfactory professional conduct.

20.14B Suspension from Register—serious offence

(1) The Designated Manager may, by written notice to a registered trade marks attorney, suspend the registered trade marks attorney's registration if the Designated Manager:
  (a) is notified under subregulation 20.14A(1); or
  (b) becomes aware that the registered trade marks attorney has been charged with a serious offence.

(2) If the Designated Manager suspends the attorney's registration:
  (a) the suspension takes effect when the notice is given to the registered trade marks attorney; and
  (b) the Designated Manager must:
    (i) give written notice to the Board of the suspension; and
    (ii) by written notice, give the registered trade marks attorney 28 days after the date of the notice (a ***show cause notice***) within which to show cause why the suspension should be lifted.

(3) The Designated Manager must consider any information provided by the registered trade marks attorney in response to the show cause notice.

(4) The Designated Manager must immediately end the suspension if:
  (a) the Designated Manager becomes aware that the charge is not proceeded with or the prosecution of the charge is abandoned; or
  (b) the Designated Manager becomes aware that the proceedings have been completed without a conviction being recorded; or
  (c) the proceedings have been completed with a conviction being recorded and the Disciplinary Tribunal decides not to continue the suspension or cancel the registered trade marks attorney's registration; or
  (d) the Designated Manager considers that the suspension is no longer necessary.

(5) If the Designated Manager ends the suspension, the Designated Manager must notify, in writing, each of the following that the suspension has ended:

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(a) the registered trade marks attorney;
(b) the Board;
(c) the Disciplinary Tribunal.

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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'; and

(d) the reference in subparagraph 20.33(2)(b)(i) of the *Patents Regulations 1991* to 'regulation 20.6' were a reference to 'regulation 20.6 of the *Trade Marks Regulations 1995*'; and

(e) the reference in subparagraph 20.33(2)(b)(ii) of the *Patents Regulations 1991* to 'regulation 20.8' were a reference to 'regulation 20.8 of the *Trade Marks Regulations 1995*'; and

(f) subregulation 20.36(4) of the *Patents Regulations 1991* were omitted; and

(g) the words 'or subregulation 20.36E(5)' in subregulation 20.36A(4) of the *Patents Regulation 1991* were omitted; and

(h) the words 'Subject to regulation 20.36E, the Panel' in subregulation 20.36D(2) of the *Patents Regulation 1991* were omitted and the words 'The Panel' substituted; and

(i) regulation 20.36E of the *Patents Regulation 1991* were omitted.

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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.

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Part 20A—Incorporated trade marks attorneys

Division 1—General

20A.1 Application of Part 20A

This Part applies to:

(a) an incorporated trade marks attorney; and

(b) a company applying for registration as an incorporated trade marks attorney.

20A.2 Definitions

In this Part:

professional indemnity insurance means insurance for claims that may be made against the company in relation to its business, practices or acts as an incorporated trade marks attorney.

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Division 2—Obtaining registration for first time

20A.3 Form of application

An application for registration as an incorporated trade marks attorney must:

(a) be in writing, in a form approved by the Designated Manager; and

(b) be accompanied by the following evidence and material:

(i) the name of each trade marks attorney director of the company;

(ii) evidence that the company is a registered company under the *Corporations Act 2001*;

(iii) evidence that the company has adequate and appropriate professional indemnity insurance; and

(c) be accompanied by the fee set out in item 36 of Schedule 9.

20A.4 Certificate of registration

If the Designated Manager registers a company as an incorporated trade marks attorney, the Designated Manager must give the company a certificate of registration as soon as practicable.

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Division 3—Maintaining registration

20A.5 Requirements for remaining on Register of Trade Marks Attorneys

(1) To remain on the Register of Trade Marks Attorneys, a registered incorporated trade marks attorney must, for every year of registration, pay the annual registration fee.

(2) The Designated Manager must, not later than 1 June in each year, give to each registered incorporated trade marks attorney notice of the fee that is payable.

(3) The annual registration fee is payable on 1 July each year by a registered incorporated trade marks attorney:

(a) whose name is on the Register of Trade Marks Attorneys on that day; and

(b) that has not asked the Designated Manager, under regulation 20A.6, to remove its name from the Register of Trade Marks Attorneys.

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Division 4—Removal from Register of Trade Marks Attorneys

20A.6 Voluntary removal of name from Register of Trade Marks Attorneys

If a trade marks attorney director of a registered incorporated trade marks attorney asks the Designated Manager, in writing, to remove the name of the incorporated trade marks attorney from the Register of Trade Marks Attorneys, the Designated Manager must comply with the request.

20A.7 Failure to pay annual registration fee

If a registered incorporated trade marks attorney does not pay the annual registration fee by 31 July in the year the fee is payable, the Designated Manager must:

(a) remove the name of the attorney from the Register of Trade Marks Attorneys; and

(b) notify, in writing, the attorney of the removal.

20A.8 Failure to maintain professional indemnity insurance

(1) If an incorporated trade marks attorney does not maintain adequate and appropriate professional indemnity insurance, the Designated Manager may remove the name of the attorney from the Register of Trade Marks Attorneys.

(2) If the Designated Manager removes the name of the incorporated trade marks attorney from the Register of Trade Marks Attorneys, the Designated Manager must notify, in writing, the attorney of the removal.

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Division 5—Discipline

Subdivision A—General

20A.9 Definitions

In this Part:

former attorney means a person whose registration as an incorporated trade marks attorney has been suspended or cancelled under this Division.

20A.10 Board may apply for cancellation or suspension of incorporated trade marks attorney's registration

(1) The Board may apply to the Disciplinary Tribunal to cancel or suspend an incorporated trade marks attorney's registration if:
  (a) a registered trade marks attorney who is, or was, an employee or officer of the incorporated trade marks attorney has, at any time, been found guilty of professional misconduct in accordance with Division 6 of Part 20; and
  (b) the professional misconduct occurred when the registered trade marks attorney was an employee or officer of the incorporated trade marks attorney; and
  (c) the trade marks attorney's registration was cancelled or suspended in accordance with Division 6 of Part 20 because he or she was found guilty of professional misconduct.

(2) Before applying to the Disciplinary Tribunal, the Board may request the incorporated trade marks attorney to provide the Board with information relating to the professional misconduct.

(3) In deciding whether to apply to the Disciplinary Tribunal, the Board may consider the following:
  (a) the professional misconduct engaged in by the registered trade marks attorney;
  (b) the behaviour of the incorporated trade marks attorney's officers and employees;
  (c) whether officers and employees of the incorporated trade marks attorney have complied with the Code of Conduct;
  (d) any information provided under subregulation (2).

(4) An application by the Board to the Disciplinary Tribunal must:
  (a) be in writing; and
  (b) set out the reasons why the Board considers the incorporated trade marks attorney's registration should be cancelled or suspended; and
  (c) be addressed and sent to the President.

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(5) The Board must give the incorporated trade marks attorney, as soon as practicable after the application is made to the Disciplinary Tribunal, a copy of the application.

Subdivision B—Proceedings in Disciplinary Tribunal

20A.11 Panel of the Disciplinary Tribunal to be constituted

(1) Except as otherwise provided by this Part, the Disciplinary Tribunal's functions and powers in relation to disciplinary proceedings under this Part are to be performed and exercised by a Panel of the Disciplinary Tribunal.

(2) A Panel of the Disciplinary Tribunal is to be constituted by:
  (a) a Panel Chair; and
  (b) 2 other members determined by the Panel Chair under subregulation (3).

(3) The Panel Chair is to determine, in writing, the other members of the Disciplinary Tribunal who are to constitute the Panel that is to conduct the proceedings.

Note: Regulation 20.64 of the *Patents Regulations 1991* sets out requirements relating to the disclosure of conflicts of interest.

20A.11A Meetings of Panel of Disciplinary Tribunal

(1) The Panel Chair of a Panel of the Disciplinary Tribunal must:
  (a) convene such meetings of the Panel as the Panel Chair considers necessary for the purpose of conducting disciplinary proceedings being heard by the Panel; and
  (b) preside at all meetings of the Panel.

(2) Subject to paragraph 20A.11D(2)(a), all members of a Panel of the Disciplinary Tribunal must be present at a meeting of the Panel.

(3) A question arising at a meeting of a Panel of the Disciplinary Tribunal must be determined by a majority of the votes of the members of the Panel present and voting.

(4) However, if, in accordance with paragraph 20A.11D(2)(a), a hearing of proceedings is continued with 2 members of the Panel, questions arising at the hearing must be determined by a unanimous vote of the 2 members.

20A.11B Procedure of Panel of Disciplinary Tribunal

(1) Subject to this Part, the procedures for convening meetings of a Panel of the Disciplinary Tribunal and for the conduct of business by a Panel of the Disciplinary Tribunal are as the Panel Chair determines.

(2) Proceedings before the Panel are to be conducted quickly and informally, while allowing for proper consideration of the matter before the Panel.

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(3) The Panel is not bound by the rules of evidence but may be informed on any matter in the manner it chooses.

(4) The Panel may take evidence on oath or on affirmation and, for that purpose, the Panel Chair may administer an oath or affirmation.

20A.11C Panel Chair unavailable to complete hearing

(1) This regulation applies if:
  (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  (b) before the matter has been determined, the Panel Chair has:
    (i) ceased to be a member; or
    (ii) for any reason, ceased to be available as a member of the Panel.

(2) The matter is to be reheard by a new Panel constituted in accordance with regulation 20A.11.

(3) The new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

20A.11D Members other than the Panel Chair unavailable to complete hearing

(1) This regulation applies if:
  (a) a hearing of proceedings in relation to a particular matter has been commenced or completed by a Panel of the Disciplinary Tribunal; and
  (b) before the matter has been determined, one of the members (other than the Panel Chair) constituting the Panel has:
    (i) ceased to be a member; or
    (ii) for any reason, ceased to be available as a member of the Panel.

(2) The Panel Chair may determine that:
  (a) the hearing and determination, or the determination, of the matter is to be completed by the Panel constituted by the remaining members of the Panel; or
  (b) the matter is to be reheard by a new Panel constituted in accordance with regulation 20A.11.

(3) If a matter is reheard under paragraph (2)(b), the new Panel may, for the purposes of performing or exercising the Disciplinary Tribunal's functions or powers in relation to that matter, have regard to any record of the proceedings before the Panel as previously constituted for the purposes of hearing that matter.

20A.12 Notification of hearing

(1) As soon as practicable after receiving an application under regulation 20A.10, the Panel Chair of a Panel of the Disciplinary Tribunal must:

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(a) fix a day, time and place to hear the application; and
(b) notify the incorporated trade marks attorney and the Board of that day, time and place.

(3) The day of hearing must not be less than 21 days after the day the incorporated trade marks attorney is notified of the hearing.

20A.13 Hearings to be public except in special circumstances

(1) A hearing before a Panel of the Disciplinary Tribunal must be in public.

(2) However, if the Panel Chair is reasonably satisfied that it is desirable to do so, in the public interest or because of the confidential nature of any evidence or matter, the Panel Chair may:
(a) direct that a hearing, or a part of a hearing, is to take place in private and give directions as to the persons who may be present; and
(b) give directions restricting or prohibiting the publication or disclosure of:
(i) evidence given before the Panel, whether in public or in private; or
(ii) matters contained in documents lodged with the Panel or received in evidence by the Panel.

(3) A person commits an offence if the person:
(a) is given a direction under paragraph (2)(a) or (b); and
(b) does not comply with the direction.

Penalty: 5 penalty units.

20A.14 Representation before Panel of Disciplinary Tribunal

(1) At a hearing before a Panel of the Disciplinary Tribunal, the incorporated trade marks attorney must be represented by a trade marks attorney director of the incorporated trade marks attorney or a legal practitioner.

(2) A party to proceedings before the Panel, or a representative of the party, may request the Panel Chair to summon witnesses.

20A.15 Summoning of witnesses

(1) For the purpose of a hearing before a Panel of the Disciplinary Tribunal, the Panel Chair may, by written instrument signed by the Panel Chair:
(a) summon a person to appear before the Panel to give evidence and to produce any documents or articles mentioned in the summons; or
(b) summon a trade marks attorney director of the incorporated trade marks attorney to appear before the Panel:
(i) to produce any documents or articles mentioned in the summons; and
(ii) to give evidence to identify the documents or articles.

(2) A trade marks attorney director who is summoned must appear in person.

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20A.16 Offences by persons appearing before a Panel of Disciplinary Tribunal

(1) A person commits an offence if the person:
  (a) is summoned to appear before a Panel of the Disciplinary Tribunal; and
  (b) does not comply with the summons by:
    (i) appearing as required by the summons; and
    (ii) producing documents or articles as required by the summons; and
    (iii) appearing and reporting to the Panel, as required.

Penalty: 10 penalty units.

(2) It is a defence to a prosecution for an offence against subregulation (1) if:
  (a) the defendant is prevented or hindered from complying with the summons by:
    (i) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or
    (ii) any other circumstance that the Panel Chair reasonably considers is an impediment to the defendant complying with the summons; or
  (b) in relation to subparagraph (1)(b)(iii)—the defendant is excused by the Panel Chair.

Note: A defendant bears an evidential burden in relation to the matters mentioned in subparagraph (2)(a)(i) (see section 13.3 of the *Criminal Code*).

(3) A person commits an offence if:
  (a) the person:
    (i) is not a trade marks attorney director to whom subregulation (5) applies; and
    (ii) appears as a witness before a Panel of the Disciplinary Tribunal; and
    (iii) has been paid expenses and allowances in accordance with Part 2 of Schedule 8 to the *Patents Regulations 1991*; and
  (c) the person refuses:
    (i) to be sworn or make an affirmation; or
    (ii) to answer a question relevant to the evidence that the person was summoned to give.

Penalty: 10 penalty units.

(4) Strict liability applies to the physical element of an offence against subregulation (3) that is constituted by:
  (a) the circumstance mentioned in subparagraph (3)(a)(i); and
  (b) the circumstance mentioned in subparagraph (3)(a)(iii).

Note: For ***strict liability***, see section 6.1 of the *Criminal Code*.

(5) A person commits an offence if the person:
  (a) is a trade marks attorney director who has been summoned to appear at a hearing before a Panel of the Disciplinary Tribunal; and
  (b) refuses:
    (i) to be sworn or to make an affirmation; or

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(ii) to answer a question relevant to the evidence that the person was summoned to give.

Penalty: 10 penalty units.

(6) It is a defence to a prosecution for an offence against subregulation (3) or (5) if a person mentioned in the subregulation refused to answer a question or to produce a document or article because the answer to the question, or the document or article, may tend to prove that the person has committed an offence against a law of the Commonwealth or of a State or Territory.

20A.17 Protection of certain persons

(1) A person who is a member of a Panel of the Disciplinary Tribunal conducting a hearing of disciplinary proceedings under this Part has, in the performance of his or her duties as a member of the Panel, the same protection and immunity as a Justice of the High Court.

(2) A member of the Board has, in exercising a power under this Part, the same protection and immunity as a Justice of the High Court.

(3) A legal practitioner or other person appearing before a Panel of the Disciplinary Tribunal has the same protection and immunity as a barrister has in appearing for a party in proceedings in the High Court.

(4) A person summoned to attend or appearing before a Panel of the Disciplinary Tribunal as a witness:

(a) has the same protection; and

(b) is, in addition to the penalties provided by this Part, subject to the same liabilities;

as a witness in proceedings in the High Court.

20A.18 Decision of Panel of Disciplinary Tribunal

(1) After hearing an application for the cancellation or suspension of the incorporated trade marks attorney's registration, a Panel of the Disciplinary Tribunal may:

(a) cancel the attorney's registration as an incorporated trade marks attorney; or

(b) suspend the attorney's registration as an incorporated trade marks attorney.

(2) The Panel may also impose conditions on the attorney's return to the Register of Trade Marks Attorneys after the cancellation has been lifted or the period of suspension has elapsed.

(3) In making a decision under this regulation, the Panel may consider the following:

(a) the professional misconduct engaged in;

(b) the behaviour of the incorporated trade marks attorney's officers and employees;

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(c) whether officers and employees of the incorporated trade marks attorney had complied with the Code of Conduct;

(d) findings made (regardless of when the findings were made) about the conduct of the incorporated attorney in any other proceedings brought before a relevant disciplinary tribunal;

(e) findings made (regardless of when the findings were made) about the conduct of the incorporated attorney's employees and officers in any other proceedings brought before a relevant disciplinary tribunal;

(f) if the incorporated trade marks attorney failed, without reasonable excuse, to provide information requested by the Board under subregulation 20A.10(2)—the incorporated trade marks attorney's failure to provide requested information.

(4) In this regulation:

relevant disciplinary tribunal means any of the following:

(a) the Patents and Trade Marks Attorneys Disciplinary Tribunal established by regulation 20.61 of the *Patents Regulations 1991* as in force before the commencement of this subregulation;

(b) the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 of the *Patents Regulations 1991* as in force on the commencement of this subregulation;

(c) the Patents and Trade Marks Attorneys Disciplinary Tribunal as continued in force by subregulation 23.42(1) or 23.43(1) of the *Patents Regulations 1991* or subregulation 22.16(1) or 22.17(1) of these Regulations.

20A.19 Notification and publication of decisions of Panel of Disciplinary Tribunal

(1) Within 14 days after a Panel of the Disciplinary Tribunal makes a decision under regulation 20A.18, the Panel must:

(a) prepare a written statement that states:

(i) the decision of the Panel; and

(ii) the reasons for the decision; and

(iii) the findings on any material questions of fact; and

(iv) evidence or other material on which the findings of fact are based; and

(b) give a copy of the statement to:

(i) the incorporated trade marks attorney who is the subject of the decision; and

(ii) the Board; and

(iii) the Designated Manager; and

(c) publish, in the *Official Journal*, a written statement that sets out the decision of the Panel.

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(2) If the registration of an incorporated trade marks attorney is suspended, the Designated Manager must note the suspension and its duration in the Register of Trade Marks Attorneys.

(3) If the registration of an incorporated trade marks attorney is cancelled, the Designated Manager must remove the name of the incorporated trade marks attorney from the Register of Trade Marks Attorneys.

20A.20 Completion of outstanding business

(1) If a Panel of the Disciplinary Tribunal cancels the registration of an incorporated trade marks attorney, the Panel Chair may appoint a registered trade marks attorney to complete the unfinished trade marks work of the former attorney.

(2) If a Panel of the Disciplinary Tribunal suspends the registration of an incorporated trade marks attorney, the Panel Chair may appoint a registered trade marks attorney to carry on the former attorney's trade marks work for:
  (a) the period of the suspension; or
  (b) a specified period, not longer than the period of suspension.

(3) The Panel Chair of a Panel of the Disciplinary Tribunal must not appoint a registered trade marks attorney under subregulation (1) or (2) unless the registered trade marks attorney consents to the appointment.

(4) A registered trade marks attorney appointed under subregulation (1) or (2) may only act as a registered trade marks attorney for a client of the former attorney if the client has given consent for the appointed attorney to act.

20A.21 Former attorney may be required to provide assistance

(1) A registered trade marks attorney appointed under subregulation 20A.20(1) or (2) may, by written notice, request the former attorney to make available:
  (a) information about the trade marks work that the appointed attorney may reasonably require; or
  (b) books, accounts or other documents about the trade marks work that the appointed attorney may reasonably require; or
  (c) money held by the former attorney:
    (i) on behalf of a client; or
    (ii) that has been paid by a client in relation to services not yet performed for the client.

(2) A person commits an offence if the person:
  (a) is a former attorney; and
  (b) is given a notice under subregulation (1); and
  (c) fails to comply with the notice.

  Penalty: 5 penalty units.

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(3) It is a defence to a prosecution for an offence against subregulation (2) if the former attorney is prevented or hindered from complying with a request in the notice by:

(a) a circumstance mentioned in Part 2.3 of the *Criminal Code*; or

(b) any other circumstance that the relevant Panel Chair reasonably considers is an impediment to the defendant complying with the summons.

Note: A defendant bears an evidential burden in relation to the question of whether he or she has a reasonable excuse (see section 13.3 of the *Criminal Code*).

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Division 6—Returning to Register of Trade Marks Attorneys

20A.22 Restoring name to Register of Trade Marks Attorneys

(1) This regulation sets out circumstances in which the Designated Manager must restore to the Register of Trade Marks Attorneys the name of an incorporated trade marks attorney that has been removed from the Register of Trade Marks Attorneys under:
  (a) regulation 20A.6, 20A.7 or 20A.8; or
  (b) subsection 157A(7) of the Act.

(2) The Designated Manager must restore the name if:
  (a) the attorney requests the Designated Manager, in the form approved by the Designated Manager, to restore the name; and
  (b) the request includes:
    (i) the name of each trade marks attorney director of the company; and
    (ii) evidence that the company is a registered company under the *Corporations Act 2001*; and
    (ii) evidence that the company has adequate and appropriate professional indemnity insurance; and
  (c) the request is made:
    (i) if the name was removed under regulation 20A.7—on or before 1 September of the year that the name was removed from the Register of Trade Marks Attorneys, or within a further period that the Designated Manager allows; or
    (ii) in any other case—within 3 years after the name was removed from the Register of Trade Marks Attorneys; and
  (d) the attorney pays:
    (i) the annual registration fee for the year the reinstatement is made; and
    (ii) the fee mentioned in item 39 of Schedule 9.

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Part 21—Miscellaneous

Division 1—Applications and other documents

21.1 Compliance with instructions on approved forms

If:

(a) an application, notice, request or declaration 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, request or declaration 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 Requirements for filing documents

(1) A document that is required to be in an approved form and that is filed must be in English and be legible.

(2) If any other document is filed:

(a) the document must be in English, be in the form (if any) specified in a direction under section 213B of the Act and be legible; or

(b) the following apply:

(i) the document (the ***original document***) must be filed with a document (the ***translated document***) that is a translation of the original document into English;

(ii) the original document must be filed with a certificate of verification;

(iii) the translated document must be in the form (if any) specified in a direction under section 213B of the Act and be legible.

(3) Subregulation (2) does not apply in relation to an application mentioned in paragraph 4.11(1)(a), 5.18(2)(a) or 17A.19(1)(a).

Note: Regulations 4.11, 5.18 and 17A.19 have specific rules about applications filed in trade marks offices (however described) of Convention countries.

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.

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(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 Consequences for documents not meeting filing requirements

(1) If a document received for filing at the Trade Marks Office does not comply with the Act or the regulations, or is not in accordance with whichever approved form is applicable, the Registrar may treat the document:

(a) as not having been filed and notify the person, including in the notification a statement indicating how the document does not comply with the Act or the regulations or is not in accordance with the approved form; or

(b) as having been filed, but direct the person to do such things as are necessary to ensure that the document does comply with the Act or the regulations or is in accordance with the approved form.

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.

(2) If the Registrar gives a direction under paragraph (1)(b) and the person does not comply with the direction within the period specified in the direction, the Registrar may treat the document as not 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 (if any) provides a facility for the receipt of documents (other than documents filed electronically), when the Trade Marks Office or sub-office (if any) 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 (if any) 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.

21.5A Consequences for evidence not meeting filing requirements

(1) If, in relation to evidence received at the Trade Marks Office, a person does not comply with a direction under section 213C of the Act, the Registrar may treat the evidence:

(a) as not having been filed and notify the person, including in the notification a statement indicating how the direction has not been complied with; or

(b) as having been filed, but direct the person to do such things as are necessary to ensure that the direction is complied with.

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(2) If the Registrar gives a direction under paragraph (1)(b) and the person does not comply with the direction within the period specified in the direction, the Registrar may treat the evidence as not having been filed.

21.6 Declarations

(1) A declaration required or permitted by the Act or these Regulations must be in an approved form.

Note: Declaration forms in the approved form are available on the IP Australia website at www.ipaustralia.gov.au.

(2) A declaration in the form of a statutory declaration, required or permitted to be given to a person mentioned in subregulation (3), may be given to the person in an electronic form by a means of electronic communication approved by the Registrar.

Note: A declaration that is not in the form of statutory declaration may also be given in an electronic form by means of an electronic communication: see section 11 of the *Electronic Transactions Act 1999*.

(3) For subregulation (2), the following persons may be given declarations, including statutory declarations, in electronic form by electronic means:

(a) the Registrar of Trade Marks;

(b) the Designated Manager;

(c) in relation to a Panel of the Disciplinary Tribunal—the Panel Chair;

(d) the Board.

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.

21.7A Service by post

Service by post is a prescribed means by which a document may be served on, or given or sent to, a person for the purposes of paragraphs 215(6)(a) and (b) of the Act.

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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 notify the person that the person is required 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 Notification of withdrawal of application etc.

If an application, notice or request is withdrawn in accordance with regulation 21.9, the Registrar must advertise the withdrawal in the Official Journal.

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.

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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.

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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 Award of costs

(1) For section 221 of the Act, if a matter is mentioned in these Regulations as a matter attracting the award of costs, costs may be awarded:
  (a) in accordance with Schedule 8; or
  (b) if the Registrar has a discretionary power in relation to the award of costs—as the Registrar considers appropriate.

(2) The costs must be taxed, allowed and certified by an employee appointed by the Registrar.

(3) The Registrar may review the taxation of costs by the employee.

(4) In this regulation:

costs does not include the costs mentioned in paragraph 105(2)(b) of the Act.

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.

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(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: Regulations 5.19, 6.10, 8.7, 9.21, 17A.34Q, 17A.48W and 21.20F deal with directions as to procedure in opposition proceedings.

21.15 Opportunity to be heard by Registrar

(1) This regulation applies if the Act or these Regulations provide for a person to be heard by the Registrar.

(2) The Registrar may give the person an opportunity to be heard by:
  (a) asking the person for written submissions; or
  (b) notifying the person that on request to the Registrar, the person may be heard by way of an oral hearing on a date, and at a time and place, determined by the Registrar; or
  (c) notifying the person of the date, time and place of an oral hearing.

(3) A request for a hearing must be in an approved form.

(4) The Registrar is not bound by the rules of evidence, but may be informed on any matter that is before the Registrar in a way that the Registrar reasonably believes to be appropriate.

(5) The Registrar may decide a matter if each person that is a party to the matter:
  (a) notifies the Registrar that the person does not want to be heard; or
  (b) does not file written submissions if requested under subregulation 21.16(1); or
  (c) does not request an oral hearing after being notified under paragraph (2)(b); or
  (d) does not attend an oral hearing if notified under subregulation 21.16(2).

(6) In the circumstances mentioned in subregulation (5), the Registrar may make a decision by reference to relevant information that is held in the Trade Marks Office.

(7) If the Registrar makes a decision in any of the circumstances mentioned in subregulation (5), the Registrar must notify each party of the Registrar's decision.

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21.16 Written submissions and oral hearings

Written submissions

(1) If the Registrar decides that a person may be heard by way of written submissions, the Registrar must:
  (a) notify the person of the period in which the submissions must be filed (being at least 10 business days); and
  (b) determine the matter after considering the written submissions; and
  (c) notify the person of the Registrar's decision in relation to the matter.

Oral hearings

(2) If the Registrar decides that a person may be heard by way of an oral hearing, the Registrar must give notification of the date, time and place of the hearing to the person at least 10 business days before the day the hearing is to begin.

(3) The Registrar may adjourn an oral hearing from time to time or from place to place by notifying the person.

(4) The Registrar may hold an oral hearing in which:
  (a) a person appears in person; or
  (b) a person participates by telephone or other means of telecommunications that the Registrar reasonably allows.

(5) In addition to the Registrar's other powers, the Registrar may direct a person to provide a written summary of submissions.

(6) An oral hearing must be conducted with as little formality and technicality, and as quickly, as the requirements of the Act, these Regulations and a proper consideration of the matters before the Registrar, allow.

(7) Subject to these Regulations, the Registrar may give a direction that is reasonably necessary for the conduct of the hearing.

(8) The Registrar must notify a person who appears at the hearing of the Registrar's decision in relation to the matter.

21.17 Giving of oral evidence

(2) The Registrar may require a person who has made a declaration that is filed in any proceedings before the Registrar 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.

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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.

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Division 2A—Extensions of time

21.20A Definitions

In this Division:

notice of opposition means a notice filed under subregulation 21.20B(1).

party means an applicant or opponent.

Note: The definitions of the following terms are in section 6 of the Act:
(a) applicant;
(b) approved form;
(c) file;
(d) month;
(e) person.

21.20B Notice of opposition

(1) For subsection 224(6) of the Act, a person may oppose a request for an extension of time by filing a notice of opposition in an approved form within one month from the advertisement of the request for the extensions in the *Official Journal* under subsection 224(5) of the Act.

(2) The Registrar must give a copy of the notice to the applicant.

21.20C Notification and opportunity to make representations

(1) This regulation applies if:
(a) a party makes a request to the Registrar under this Division; or
(b) the Registrar proposes to make a decision on the Registrar's own initiative under this Division.

(2) The Registrar must:
(a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
(b) for paragraph (1)(b)—notify the parties of the proposed decision.

(3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:
(a) in writing; or
(b) at a hearing; or
(c) by other means that the Registrar states in the notification.

(4) The Registrar must notify the parties of the Registrar's decision.

21.20D Practice and procedure

The Registrar may:

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(a) decide the practice and procedure to be followed in an opposition to which this Division applies; and
(b) direct the parties accordingly.

21.20E Hearing

(1) The Registrar:
(a) must hold a hearing of the opposition if requested by a party in writing; or
(b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(2) The hearing may, at the Registrar's discretion, be:
(a) an oral hearing; or
(b) by written submissions.

(3) If the Registrar decides on an oral hearing:
(a) the Registrar must notify the parties of the date, time and place of the hearing; and
(b) the opponent must file a summary of submissions at least 10 business days before the hearing; and
(c) the applicant must file a summary of submissions at least 5 business days before the hearing.

(4) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (3) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

(5) The Registrar must:
(a) decide the opposition; and
(b) notify the parties of the Registrar's decision.

21.20F Registrar may give direction

(1) The Registrar may give a direction in relation to an opposition to which this Division applies:
(a) if requested by a party in writing; or
(b) on the Registrar's own initiative.

(2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.

(3) A direction must not be inconsistent with the Act or these Regulations.

(4) The Registrar must notify the parties of the direction as soon as practicable.

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21.20G Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.

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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 Comptroller-General of Customs, the Registrar or Comptroller-General of Customs must not do the act until the fee has been paid.

(2) Subject to subregulation (3), if:

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(a) a fee is payable in respect of the doing of an act by a person other than the Registrar or the Comptroller-General of Customs; 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 the failure to pay the fee.

Note: ***File*** has the meaning given by section 6 of the Act.

(3) If the Registrar or the Comptroller-General of Customs 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.

Note: See subsection 223(2C), and section 223AA, of the Act for the means of paying a fee to the Registrar.

(2) A fee payable under Part 13 of the Act must be paid to the Comptroller-General of Customs. The fee must be paid in accordance with a direction given by the Comptroller-General of Customs 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 Comptroller-General of Customs 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.

21.23A Exemption from fees

The Registrar may exempt specified classes of persons from the payment of the whole or a part of a fee specified in Schedule 9 if the Registrar is reasonably satisfied that the exemption is justified, having regard to all the circumstances.

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

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(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 (if any) 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 table sets out prescribed persons.

Item	Person
1	The Director General of IP Australia
2	The Deputy Director General of IP Australia
3	Another person who: (a) is an SES employee of IP Australia; and (b) acts with the agreement of the Director General of IP Australia
4	Another person who: (a) is an SES employee of IP Australia; and (b) acts with the agreement of the Deputy Director General of IP Australia

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Item	Person
5	Another person who: (a) is an SES employee of IP Australia; and (b) acts with the agreement of another SES employee of IP Australia

Note: ***SES employee*** is explained in section 34 of the *Public Service Act 1999*. That meaning is applied generally to Commonwealth legislation by section 2B of the *Acts Interpretation Act 1901*.

(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.

21.28 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;

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(c) making a divisional application for the registration of a trade mark under subsection 45(1) of the Act;
(f) filing evidence under regulation 5.14, 9.16, 17A.34J or 17A.48R;
(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;
(aa) a notice of intention to defend under subsection 52A(1) of the Act;
(b) a notice of opposition to which section 96 of the Act or subregulation 17A.32(1), regulation 17A.48F or subregulation 21.20B(1) applies;
(ba) a notice of intention to defend under subregulation 9.15(1), 17A.34H(1) or 17A.48Q(1);
(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 definition of ***Convention country*** in subsection 6(1) of the Act, the following countries are prescribed:
(a) a foreign country that is a signatory to the Paris Convention for the Protection of Industrial Property of 20 March 1883, as in force from time to time;
(b) a foreign country that is a full member of the World Trade Organization.

Note 1: For signatories to the Paris Convention for the Protection of Industrial Property, see www.wipo.int.

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Note 2: For full members of the World Trade Organization, see www.wto.org.

(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.

21.33 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 by notification to the person require him or her:

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(a) to perform the act; or
(b) file the document; or
(c) to produce the evidence;

that is specified in the notification.

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 AAT 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) subregulation 20.29(3) (imposing a condition when restoring attorney’s name to Register of Trade Marks Attorneys);
(iii) regulation 20.31 (‘returning to the Register in other circumstances’); or
(ba) the Designated Manager under the following provisions:
(i) regulation 20.14B (suspending registration for serious offence);
(ii) regulation 20A.8 (failing to maintain professional indemnity insurance); or
(bb) a Panel of the Disciplinary Tribunal under regulation 20A.18 (decision of Panel of Disciplinary Tribunal); or
(c) a Panel of 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 Panel of Disciplinary Tribunal’);
(ii) regulation 20.44 (‘penalties—professional misconduct’);
(iii) regulation 20.45 (‘penalties—unsatisfactory professional conduct’);

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(iv) regulation 20.46 (‘finding that attorney was unqualified at time of registration’);

(v) regulation 20.47 (‘finding that registration obtained by fraud’).

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Part 22—Application, saving and transitional provisions

Division 1—General

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.

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(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.

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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 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.

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(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 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.

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Division 2—Amendments made by particular instruments

22.9 Amendments made by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

(1) The amendments of these Regulations made by the items of Part 2 of Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* apply as set out in the following table.

Transitional provisions

Item	Column 1 The amendments made by:	Column 2 apply in relation to:
1	all items of Part 2	the matters referred to in subitem 32(7) of Schedule 3 to the *Intellectual Property Laws Amendment (Raising the Bar) Act 2012*
2	items 10 to 30	an opposition proceeding commenced by the filing of a notice of intention to oppose on or after 15 April 2013 However, if: (a) an application was advertised before 15 April 2013; and (b) a notice of intention to oppose is filed on or after 15 April 2013; the reference in subregulations 5.6(1), 9.8(1), 17A.33(1) and 17A.48G(1) to 2 months is taken to be a reference to 3 months Also, if: (a) an opposition proceeding was commenced before 15 April 2013; and (b) a document or evidence was not served in relation to the opposition proceeding before 15 April 2013; and (c) the document or evidence is required to be served on or after 15 April 2013; then: (d) a requirement in Part 5, 6 or 9, Subdivision 3 of Division 3 of Part 17A, Subdivision 3 or Subdivision 4 of Division 5 of Part 17A, as in force immediately before 15 April 2013, for a party to serve a document or evidence on a person is taken to be a requirement to file the document or evidence; and (e) a reference to a document or evidence having been served is taken to be a reference to the document or evidence having been filed; and (f) the Registrar must give a copy of the document or evidence to the person; and (g) if: (i) under Part 5, 6 or 9, Subdivision 3 of Division 3

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Transitional provisions		
Item	**Column 1** **The amendments made by:**	**Column 2** **apply in relation to:**
		of Part 17A, Subdivision 3 or Subdivision 4 of Division 5 of Part 17A, as in force immediately before 15 April 2013, a period for the person to do an action was calculated from the date that a party served the document or evidence; and (ii) the Registrar does not give the document or evidence to the person on the filing date; the Registrar must extend the period for the person to do the action by a number of days equal to the number of days between when the document or evidence was filed and when the Registrar gave the document or evidence to the person
3	item 11 (new regulation 5.3), item 14 (new regulation 9.3), item 16 (new regulation 17A.30) and item 17 (new regulation 17A.48A)	an opposition proceeding commenced before 15 April 2013
4	item 11 (new regulation 5.17), item 13 (new regulation 6.9), item 14 (new regulation 9.20), item 16 (new regulation 17A.34M), item 17 (new regulation 17A.48V) and item 18 (new regulation 21.20E)	an opposition proceeding commenced before 15 April 2013 in which the Registrar has not set a hearing date, or issued a notice of hearing to the parties, before 15 April 2013 However: (a) a reference in regulation 5.17 to paragraph 5.8(3)(b) or subregulation 5.8(4) is taken not to apply; and (b) a reference in regulation 5.17 to regulation 5.14 is taken to be a reference to regulations 5.7 to 5.13 as in force immediately before 15 April 2013; and (c) a reference in paragraph 6.9(1)(a) to a party requesting a hearing is taken to include the conditions set out in subregulations 5.14(1) and (2) as in force immediately before 15 April 2013; and (d) a reference in regulation 9.20 to regulation 9.10 is taken not to apply; and (e) a reference in regulation 9.20 to regulation 9.16 is taken to be a reference to regulation 9.4 as in force immediately before 15 April 2013; and (f) a reference in regulation 17A.34M to regulation 17A.34B or 17A.34H is taken not to apply; and (g) a reference in regulation 17A.34M to regulation 17A.34J is taken to be a reference to regulation 17A.33 as in force immediately before 15 April 2013; and (h) a reference in regulation 17A.34M to

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Regulation 22.9

Transitional provisions		
Item	**Column 1** **The amendments made by:**	**Column 2** **apply in relation to:**
		regulation 17A.34N is taken to be a reference to regulation 17A.34 as in force immediately before 15 April 2013; and (i) a reference in regulation 17A.48V to regulation 17A.48K is taken not to apply; and (j) a reference in regulation 17A.48V to regulation 17A.48R is taken to be a reference to subregulation 17A.48(5) as in force immediately before 15 April 2013; and (k) a reference in paragraph 21.20E(1)(a) to a party requesting a hearing is to include the conditions set out in subregulations 5.14(1) and (2) as in force immediately before 15 April 2013; and (l) regulation 5.14, as in force immediately before 15 April 2013, is taken not to apply
5	item 11 (new regulation 5.15), item 14 (new regulation 9.18), item 16 (new regulation 17A.34K), item 17 (new regulation 17A.48T) and item 24 (Schedule 9, new item 6)	an opposition proceeding commenced before 15 April 2013 in which an extension of time is requested for a period that commences on or after 15 April 2013 However: (a) a reference in subregulation 5.15(1) to regulation 5.14 is taken to be a reference to regulations 5.7 to 5.13 as in force immediately before 15 April 2013; and (b) a reference in subregulation 9.18(1) to regulation 9.16 is taken to be a reference to regulation 9.4 as in force immediately before 15 April 2013; and (c) a reference in subregulation 17A.34K(1) to regulation 17A.34J is taken to be a reference to regulation 17A.33 as in force immediately before 15 April 2013; and (d) a reference in subregulation 17A.48T(1) to regulation 17A.48R is taken to be a reference to subregulation 17A.48(5) as in force immediately before 15 April 2013; and (e) paragraph 5.15(1)(a) and subparagraph 5.15(3)(c)(i), as in force immediately before 15 April 2013, are taken not to apply

(2) The amendment of these Regulations made by item 41 of Schedule 4 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* applies in relation to a charge that:

(a) is laid against a registered trade mark attorney on or after 15 April 2013; and

(b) alleges the commission of a serious offence.

(3) The amendments of these Regulations made by item 95 of Schedule 6 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013*

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(No. 1) apply in relation to a hearing for which the Registrar issues a hearing notice, or an invitation to be heard, on or after 15 April 2013.

22.10 Amendments made by the *Customs and Other Legislation Amendment (Australian Border Force) Regulation 2015*

(1) An instrument in force under subregulation 13.5(1) immediately before 1 July 2015 has effect on and after that day as if it were an instrument of the Comptroller-General of Customs in force under that subregulation.

(2) A notification under subregulation 17A.42E(1) before 1 July 2015 is taken on and after that day to have been a notification under that subregulation to the Comptroller-General of Customs.

(3) A fee paid before 1 July 2015 to the Customs CEO as mentioned in subregulation 21.22(2) is taken on and after that day to have been a fee paid to the Comptroller-General of Customs.

(4) A direction of the Customs CEO that was in force under subregulation 21.22(3) immediately before 1 July 2015 continues in force on and after that day as if it were a direction of the Comptroller-General of Customs.

(5) An advice or notification by the Customs CEO under regulation 21.23 before 1 July 2015 is taken on and after that day to have been an advice or notification under that regulation by the Comptroller-General of Customs.

22.11 Amendments made by the *Trade Marks Amendment (Fees) Regulation 2016*

The amendments of Schedule 9 made by items 2 and 3 of the *Trade Marks Amendment (Fees) Regulation 2016* apply in relation to an AFS request that is submitted on or after the commencement of those items.

22.12 Amendments made by the *Intellectual Property Legislation Amendment (Fee Review) Regulation 2016*

Despite the repeal of item 9 of Schedule 9 by Part 4 of Schedule 1 to the *Intellectual Property Legislation Amendment (Fee Review) Regulation 2016* (the ***amending Regulation***), that item continues to apply in relation to the registration of a trade mark of a kind mentioned in that item if the application for registration was filed before the commencement of the amending Regulation.

22.13 Amendment made by Schedule 5 to the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*

The amendment of these Regulations made by item 1 of Schedule 5 to the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016* applies in relation to an IRDA if notification

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of the IRDA is received by the Registrar from the International Bureau on or after commencement of that item.

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Division 3—Transitional provisions for Schedule 4 to the Intellectual Property Laws Amendment Act 2015 and Schedule 2 to the Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016

22.14 Definitions

In this Division:

commencement day means the day on which Schedule 4 to the *Intellectual Property Laws Amendment Act 2015* commences.

old Patents regulations means the *Patents Regulations 1991* as in force immediately before the commencement day.

old regulations means these Regulations as in force immediately before the commencement day.

22.15 Transitional—registration as a trade marks attorney

(1) This regulation is made for item 84 of Schedule 4 (the ***amending Schedule***) to the *Intellectual Property Laws Amendment Act 2015*.

(2) For paragraphs 84(1)(c) and (d) of the amending Schedule, 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 a statement of experience as mentioned in subregulation (3) of this regulation that satisfies the Designated Manager that the applicant's level of competency in trade marks law and practice is sufficient to warrant the applicant becoming a registered trade marks attorney; and
  (c) be accompanied by a declaration signed by the applicant that the applicant:
    (i) has not, in the 5 years preceding the application, been convicted of an offence mentioned in subregulation (4) of this regulation; and
    (ii) is not under sentence of imprisonment for an offence mentioned in subregulation (5) of this regulation; and
  (d) be accompanied by the fee mentioned in item 28 of Schedule 9.

(3) For paragraph (2)(b), the statement of experience must:
  (a) set out details of the applicant's experience in the following activities in the 5 years preceding the application:
    (i) searching trade marks records;
    (ii) preparing, filing and prosecuting trade marks applications in relation to Australia and New Zealand;
    (iii) preparing, filing and prosecuting trade marks applications in relation to other countries and organisations, particularly countries and

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organisations that are regarded as major trading partners with Australia and New Zealand;

(iv) providing advice on the validity and infringement of trade marks; and

(b) contain a declaration, signed by the applicant, that the details of the applicant's experience set out in the statement of experience are true and correct; and

(c) be accompanied by evidence of such experience.

Note: Examples of major trading partners for subparagraph (3)(a)(iii) are as follows:

(a) European Union;
(b) Japan;
(c) People's Republic of China;
(d) Republic of Korea;
(e) United States of America.

(4) An offence against any of the following Acts is a prescribed offence for paragraph 84(1)(e) of the amending Schedule:

(a) the Act;
(b) the *Designs Act 2003*;
(c) the *Patents Act 1990*.

(5) An offence of dishonesty, whether committed in Australia or New Zealand and whether committed before or after the commencement day, for which the maximum penalty is imprisonment for at least 2 years is a prescribed offence for paragraph 84(1)(f) of the amending Schedule.

22.16 Continuation of certain disciplinary proceedings—individuals

(1) This regulation applies if:

(a) before the commencement day disciplinary proceedings had been commenced against a registered trade marks attorney by the Professional Standards Board for Patent and Trade Marks Attorneys under Part 8 of Chapter 20 of the old Patents regulations (as that Part applied to the registered trade marks attorney because of Division 6 of Part 20 of the old regulations); and

(b) the proceedings had not been completed before the commencement day.

(2) Despite the amendments and repeals made by Schedule 2 to the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*, on and after the commencement day:

(a) Part 8 of Chapter 20 of the old Patents regulations (as that Part applied to a registered trade marks attorney because of Division 6 of Part 20 of the old regulations) continues to apply in relation to the proceedings; and

(b) the appointment of the person constituting the Patents and Trade Marks Attorneys Disciplinary Tribunal conducting the proceedings is continued in force for the purpose of completing the proceedings; and

(c) for the purposes of the proceedings, references in Part 8 of Chapter 20 of the old Patents regulations (as that Part applied to the registered trade

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marks attorney because of Division 6 of Part 20 of the old regulations) to the Professional Standards Board for Patent and Trade Marks Attorneys are taken to be references to the Trans-Tasman IP Attorneys Board.

22.17 Continuation of certain disciplinary proceedings—incorporated trade marks attorneys

(1) This regulation applies if:

(a) before the commencement day disciplinary proceedings had been commenced against an incorporated trade marks attorney under Division 5 of Part 20A of the old regulations by the Professional Standards Board for Patent and Trade Marks Attorneys; and

(b) the proceedings had not been completed under the old regulations before the commencement day.

(2) Despite the amendments and repeals made by the Schedule 2 to the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*, on and after the commencement day:

(a) Division 5 of Part 20A of the old regulations continues to apply in relation to the proceedings; and

(b) the appointment of the person constituting the Patents and Trade Marks Attorneys Disciplinary Tribunal conducting the proceedings is continued in force for the purpose of completing the proceedings; and

(c) for the purposes of the proceedings, references in Division 5 of Part 20A of the old regulations to the Professional Standards Board for Patent and Trade Marks Attorneys are taken to be references to the Trans-Tasman IP Attorneys Board.

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Division 4—Amendments made by the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018

22.18 Amendments made by Part 2 of Schedule 1

The amendments made by Part 2 of Schedule 1 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply to an application for cessation of protection that relates to:

(a) a protected international trade mark that is the subject of a request for extension of protection to Australia made under Article 3*ter* (1) of the Protocol, if the date of international registration of the trade mark is on or after the day this Part commences; and

(b) a protected international trade mark that is the subject of a request for extension of protection to Australia made under Article 3*ter* (2) of the Protocol, if the date of recording of the request is on or after the day this Part commences.

22.19 Amendments made by Part 1 of Schedule 2

(1) Regulation 5.13A applies in relation to a notice of intention to defend that is required to be filed within the period referred to in subregulation 5.13(1) if the end of that period is on or after the commencement of Part 1 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*.

(2) Regulation 9.15A applies in relation to a notice of intention to defend that is required to be filed within the period referred to in subregulation 9.15(1) if:

(a) the end of that period is on or after the commencement of Part 1 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*; and

(b) no application had been made under section 224 of the Act before that commencement to extend the time for filing that notice.

(3) Regulation 17A.34HA applies in relation to a notice of intention to defend that is required to be filed within the period referred to in subregulation 17A.34H(1) if:

(a) the end of that period is on or after the commencement of Part 1 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*; and

(b) no application had been made under section 224 of the Act before that commencement to extend the time for filing that notice.

(4) Regulation 17A.48QA applies in relation to a notice of intention to defend that is required to be filed within the period referred to in subregulation 17A.48Q(1) if:

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(a) the end of that period is on or after the commencement of Part 1 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*; and

(b) no application had been made under section 224 of the Act before that commencement to extend the time for filing that notice.

22.20 Amendments made by Part 2 of Schedule 2

(1) The amendments of regulations 4.2, 4.3, 4.11, 4.13, 4.14, 4.18, 6.1, 6.4, 7.5, 7.7, 7.8, 8.1, 10.4, 10.5, 11.3, 17A.18, 17A.19, 17A.21, 17A.22, 17A.25, 17A.59, 21.9, 21.16 and 21.33 made by Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to notifications occurring on or after the commencement of that Part.

(2) The amendments of regulations 4.8 and 4.10 made by Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to reports given on or after the commencement of that Part.

(3) Regulation 4.2, as in force immediately before the commencement of Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, continues to apply on and after that commencement in relation to a notice given under subregulation 4.2(2) before that commencement.

(4) Regulation 6.1, as in force immediately before the commencement of Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, continues to apply on and after that commencement in relation to a notice given under subregulation 6.1(1) before that commencement.

(5) Regulations 10.4 and 10.5, as in force immediately before the commencement of Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, continue to apply on and after that commencement in relation to a notice given under subregulation 10.5(1) before that commencement.

(6) Regulation 17A.59, as in force immediately before the commencement of Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, continues to apply on and after that commencement in relation to a notice given under paragraph 17A.59(1)(b) before that commencement.

(7) The repeal and substitution of regulation 21.10 made by Part 2 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to withdrawals occurring on or after the commencement of that Part.

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Regulation 22.21

22.21 Amendments made by Part 3 of Schedule 2

(1) The repeal of regulations 5.3, 9.3, 17A.30 and 17A.48A made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to documents or evidence filed on or after the commencement of that Part.

(2) The repeal and substitution of regulations 21.2 and 21.4, and the repeal of regulation 21.18, made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to documents filed on or after the commencement of that Part.

(3) Regulation 21.5A, as inserted by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, applies in relation to evidence filed on or after the commencement of that Part.

(4) The repeal of subregulation 21.17(1) made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to evidence given on or after the commencement of that Part.

(5) The amendments of items 1 and 3 of the table in clause 1 of Schedule 9, and the repeal of regulation 21.21AA (so far as it relates to those items), made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to applications filed on or after the commencement of that Part.

(6) The amendment of item 10 of the table in clause 1 of Schedule 9, and the repeal of regulation 21.21AA (so far as it relates to that item), made by Part 3 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to fees paid on or after the commencement of that Part.

22.22 Amendments made by Part 4 of Schedule 2

The amendments of subregulations 17A.36(2), (2A), (3), (3A), (4) and (6) made by Part 4 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to acceptance of an IRDA on or after the commencement of that Part.

22.23 Amendments made by Part 8 of Schedule 2

(1) The amendment of paragraph 4.13(1)(a) made by Part 8 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to a request made on or after the commencement of that Part.

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(2) The amendment of paragraph 17A.21(1)(a) made by Part 8 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to a request made on or after the commencement of that Part.

22.24 Amendments made by Part 10 of Schedule 2

(1) Regulations 8.5 to 8.8, as inserted by Part 10 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*, apply in relation to requests for amendment referred to in subregulation 8.4(1) that are made on or after the commencement of that Part.

(2) The amendments of table items 5 and 6 in Part 1 of Schedule 8 made by Part 10 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* apply in relation to requests for amendment referred to in subregulation 8.4(1) that are made on or after the commencement of Part 10 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*.

(3) The amendment of item 8 of the table in clause 1 of Schedule 9 made by Part 10 of Schedule 2 to the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* applies in relation to requests for amendment referred to in subregulation 8.4(1) that are made on or after the commencement of that Part.

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Division 5—Amendments made by the Intellectual Property Laws Amendment (Fee Amounts and Other Measures) Regulations 2020

22.25 Amendments made by the *Intellectual Property Laws Amendment (Fee Amounts and Other Measures) Regulations 2020*

The amendments of items 14 to 20 of the table in clause 1 of Schedule 9 to these Regulations made by the *Intellectual Property Laws Amendment (Fee Amounts and Other Measures) Regulations 2020* apply in relation to a hearing if:

(a) the request for the hearing is made on or after 1 October 2020; or

(b) if no request is made for the hearing—the Registrar notifies a person under subregulation 21.16(1) or (2) in relation to the hearing on or after 1 October 2020.

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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 for lighting
5	Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; 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; 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; automatic vending machines
8	Hand tools and implements (hand operated); cutlery; side arms; razors
9	Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus
10	Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials

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Item number (Class number)	Class of goods (Class heading)
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; jewellery, precious stones; horological and chronometric instruments
15	Musical instruments
16	Paper and cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks
17	Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal
18	Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas and parasols; 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; unworked or semi-worked bone, horn, ivory, whalebone or mother-of-pearl; shells; meerschaum; yellow amber
21	Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware
22	Ropes and string, nets; tents, awnings and tarpaulins, sails; sacks; padding and stuffing materials (except of paper, cardboard, rubber or plastics); raw fibrous textile materials
23	Yarns and threads, for textile use
24	Textiles and substitutes for textiles; bed covers; 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; decorations for Christmas trees
29	Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats

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Item number (Class number)	Class of goods (Class heading)
30	Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice
31	Agricultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables; natural plants and flowers; live animals; foodstuffs for animals; malt
32	Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages
33	Alcoholic beverages (except beers)
34	Tobacco; smokers' articles; matches

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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

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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

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Schedule 3—Modifications of Part 13 of the Act (Norfolk Island)

Note See regulation 13.7.

1 After section 131

Insert:

131A Definitions

In this Part:

Customs Act 1901 (NI) means the *Customs Act 1901* in its application to Norfolk Island in accordance with the *Norfolk Island Customs Ordinance 2016*.

designated owner, in relation to goods imported into Norfolk Island, means:

(a) the person identified as the owner of the goods on the entry made in relation to the goods under section 68 of the *Customs Act 1901* (NI); or

(b) if no such entry exists—the person determined to be the owner of the goods under section 133A of the Act.

2 Paragraph 133(1)(b)

Omit "*Customs Act 1901*", substitute "*Customs Act 1901* (NI)".

3 Section 133A

Omit "*Customs Act 1901*", substitute "*Customs Act 1901* (NI)".

3A Section 133A (note)

Omit "section 6", substitute "section 131A".

3B Subsection 134(1) (note)

Repeal the note, substitute:

Note 1: For ***designated owner*** see section 131A.

Note 2: For ***objector*** see section 6.

3C Subsection 134A(1) (note)

Repeal the note, substitute:

Note 1: For ***designated owner*** see section 131A.

Note 2: For ***objector*** and ***seized goods*** see section 6.

3D Subsection 135(2) (note)

Repeal the note, substitute:

Note 1: For ***designated owner*** see section 131A.

Note 2: For ***seized goods***, ***objector*** and ***notified trade mark*** see section 6.

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3E Subsection 136(1) (note)

Repeal the note, substitute:

Note 1: For ***designated owner*** see section 131A.

Note 2: For ***seized goods*** see section 6.

3F Subsections 136C(1) and 136D(1) (note)

Repeal the note, substitute:

Note 1: For ***designated owner*** see section 131A.

Note 2: For ***objector*** and ***seized goods*** see section 6.

3G Section 136E (note)

Repeal the note, substitute:

Note 1: For ***designated owner*** see section 131A.

Note 2: For ***seized goods*** see section 6.

3H Subsection 137(3) (note)

Repeal the note, substitute:

Note 1: For ***designated owner*** see section 131A.

Note 2: For ***seized goods*** see section 6.

5 Section 140

Omit "of the Commonwealth", substitute "in force in Norfolk Island".

8 Further amendments—Norfolk Island

The following provisions are amended by omitting each mention of "Australia" and substituting "Norfolk Island":

(a) section 131;

(b) subsection 133(1);

(c) paragraph 134(4)(a);

(d) subparagraph 136C(2)(b)(ii);

(e) section 143.

9 Section 144

Repeal the section.

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Schedule 4—Modifications of Part 13 of the Act (Christmas Island)

Note See regulation 13.8.

1 After section 131

Insert:

131A Definitions

In this Part:

Comptroller means the Comptroller of the Indian Ocean Territories Customs Service.

designated owner, in relation to goods imported into Christmas Island, means the person identified as the owner of the goods on the entry made in relation to the goods under subsection 68(2) or (3) of the *Customs Act 1901* of Christmas Island.

2 Paragraph 133(1)(b)

After "*Customs Act 1901*", insert "of Christmas Island".

3 Section 133A

After "*Customs Act 1901*", insert "of Christmas Island".

4 Section 140

Omit "of the Commonwealth", substitute "in force in Christmas Island".

5 Further amendments—Christmas Island

The following provisions are amended by omitting each mention of "Australia" and inserting "Christmas Island":

(a) section 131;
(b) subsection 133(1);
(c) paragraph 134(4)(a);
(d) subparagraph 136C(2)(b)(ii);
(e) section 143.

6 Further amendments—Comptroller

The following provisions are amended by omitting each mention of "Comptroller-General of Customs" and inserting "Comptroller":

(a) sections 131 and 132;
(b) section 133, including the heading;
(c) sections 134 to 137;
(d) section 139, including the note;

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(e) sections 140 to 143.

7 Further amendments—Territory of Christmas Island

The following provisions are amended by omitting each mention of "Commonwealth" and inserting "Territory of Christmas Island":

(a) section 133;
(b) subsection 134(5);
(c) section 135;
(d) subsection 136A(1);
(e) section 136E;
(f) paragraph 137(3)(b);
(g) section 139, including the heading;
(h) section 142, including the heading.

8 Section 144

Repeal the section.

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Schedule 5—Modifications of Part 13 of the Act (Cocos (Keeling) Islands)

Note See regulation 13.9.

1 After section 131

Insert:

131A Definitions

In this Part:

Comptroller means the Comptroller of the Indian Ocean Territories Customs Service.

designated owner, in relation to goods imported into Christmas Island, means the person identified as the owner of the goods on the entry made in relation to the goods under subsection 68(2) or (3) of the *Customs Act 1901* of Cocos (Keeling) Islands.

2 Paragraph 133(1)(b)

After "*Customs Act 1901*", insert "of the Cocos (Keeling) Islands".

3 Section 133A

After "*Customs Act 1901*", insert "of the Cocos (Keeling) Islands".

4 Section 140

Omit "of the Commonwealth", substitute "in force in the Cocos (Keeling) Islands".

5 Further amendments—the Cocos (Keeling) Islands

The following provisions are amended by omitting each mention of "Australia" and inserting "the Cocos (Keeling) Islands":

(a) section 131;
(b) subsection 133(1);
(c) paragraph 134(4)(a);
(d) subparagraph 136C(2)(b)(ii);
(e) section 143.

6 Further amendments—Comptroller

The following provisions are amended by omitting each mention of "Comptroller-General of Customs" and inserting "Comptroller":

(a) sections 131 to 132;
(b) section 133, including the heading;
(c) sections 134 to 137;
(d) section 139, including the note;

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(e) sections 140 to 143.

7 Further amendments—Cocos (Keeling) Islands

The following provisions are amended by omitting each mention of "Commonwealth" and inserting "Cocos (Keeling) Islands":

(a) section 133;
(b) subsection 134(5);
(c) section 135;
(d) subsection 136A(1);
(e) section 136E;
(f) paragraph 137(3)(b);
(g) section 139, including the heading;
(h) section 142, including the heading.

8 Section 144

Repeal the section.

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Schedule 6–Offices of persons to whom registrar may delegate

(regulation 19.2)

Executive level 2

Executive level 1

Executive level 1—Examiner of Trade Marks

APS level 6—Examiner of Trade Marks

APS level 5—Examiner of Trade Marks

APS level 4—Examiner of Trade Marks

APS level 3—Examiner of Trade Marks

APS level 6

APS level 5

APS level 4

APS level 3

APS level 2

APS level 1

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Schedule 8—Costs, expenses and allowances

(subregulation 21.13(3))

Part 1—Costs

Item	Column 1 Matter	Column 2 Amount
1	Notice of intention to oppose	$200
2	Statement of grounds and particulars	$200
3	Receiving and perusing statement of grounds and particulars	$130
4	Notice of intention to defend	$200
5	Notice of opposition filed under subregulation 6.6(1), 8.4(1) or 21.20B(1)	$200
6	Receiving and perusing a notice of opposition filed under subregulation 6.6(1), 8.4(1) or 21.20B(1)	$130
7	Evidence in support	$700
8	Receiving and perusing evidence in support	$300
9	Evidence in answer	$700
10	Receiving and perusing evidence in answer	$210
11	Evidence in reply	$350
12	Receiving and perusing evidence in reply	$130
13	Preparation of cases for hearing	$525
14	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
15	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
16	Counsel fees for attendance at a hearing	$300 an hour, but not more than $1,350 a day

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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.

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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.

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Schedule 9—Fees

Note: See regulation 21.21.

1 Table of fees

The following table sets out fees that are payable in relation to matters specified in the table.

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 one or more of the classes provided for by subregulation 3.1(1) (not including submission of an AFS request as an application as mentioned in paragraph 3A.5(1)(b) of these Regulations):	
	(a) by preferred means:	
	(i) if the goods or services are specified in the application by using the official goods and services pick list;	$250 for each class
	(ii) otherwise;	$400 for each class
	(b) by another means	$450 for each class
2	Filing an application to register 2 or more trade marks, in respect of goods or services in one or more of the classes provided for by subregulation 3.1(1), as a series under section 51 of the Act:	
	(a) by preferred means:	
	(i) if the goods or services are specified in the application by using the official goods and services pick list;	$400 for each class
	(ii) otherwise;	$550 for each class
	(b) by another means	$600 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;	$600 for each class
	(b) any other case	$450 for each class
5	Filing an application for an extension of a period under subregulation 4.12(3) or regulation 17A.20	$100 for each month or part of a month for which the extension is sought
5A	Filing an application under subsection 224(2) of the Act:	
	(a) for an extension of time on a ground specified in paragraph 224(2)(a) of the Act; or	$100 for each month or part of a month for which the extension is sought
	(b) for an extension of time on a ground specified in paragraph 224(2)(b) of the Act	$100

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Item	Matter	Fee
5B	Filing an application under subsection 224(3) of the Act for an extension of time on a ground specified in paragraph 224(3)(b) of the Act	$100 for each month or part of a month for which the extension is sought
6	Filing an application for an extension under regulation 5.9, 5.13A, 5.15, 9.11, 9.15A, 9.18, 17A.34C, 17A.34HA, 17A.34K, 17A.48L, 17A.48QA or 17A.48T	$150 for each month or part of a month for which the extension is sought
7	Filing a notice of intention to oppose the registration of a trade mark, as mentioned in regulation 5.6	$250
8	Filing a notice of opposition to the granting of a request for the amendment of an application for registration of a trade mark, as mentioned in regulation 6.6	$250
9	Filing a notice of opposition to the granting of a request for an amendment in relation to a registered trade mark, as mentioned in regulation 8.4	$250
9A	Filing a notice of intention to oppose an extension of protection in Australia to a trade mark that is the subject of an IRDA, as mentioned in regulation 17A.33	$250
9B	Filing a notice of opposition to an extension of time for more than 3 months, as mentioned in regulation 21.20B	$250
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:	
	(a) fee paid by preferred means;	$400 for each class
	(b) fee paid by another means	$450 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 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 one or more of the prescribed classes:	
	(a) fee paid by preferred means;	$400 for each class
	(b) fee paid by another means	$450 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 one or more of the prescribed classes:	
	(a) fee paid by preferred means;	$400 for each class
	(b) fee paid by another means;	$450 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 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 for non-use under section 92 of the Act	$250
13A	Filing an application for cessation of protection for non-use under Subdivision D of Division 5 of Part 17A	$250

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Item	Matter	Fee
14	Filing a request for a hearing	$400
15	Being heard by the Registrar:	
	(a) if the hearing is in person;	The sum of: (a) $800, less any amount paid under item 14 in relation to the hearing; and (b) $800 for each day, or part of a day, (if any) of the hearing other than the first day
	(b) if the hearing is not in person, but is by some means other than written submissions;	The sum of: (a) $600, less any amount paid under item 14 in relation to the hearing; and (b) $600 for each day, or part of a day, (if any) of the hearing other than the first day
	(c) if the hearing is by means of written submissions only	$400, less any amount paid under item 14 in relation to the hearing
16	The Registrar making a decision in proceedings before the Registrar, if no party to the proceedings has: (a) filed a request for a hearing; or (b) been heard by the Registrar	$400
21	Request for not more than 3 documents relating to a single trade mark application, a single trade mark registration or a single AFS request	$50 for each document
22	Request for 4 or more documents relating to a single trade mark application, a single trade mark registration or a single AFS request	$200 for each request
23	If a request is made for documents as mentioned in item 21 or 22—request that the documents be supplied by means of expedited dispatch	$20 for each request for documents
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	$250
29	Annual registration of a trade marks attorney	$400

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Item	Matter	Fee
30	Annual registration fee payable for combined registration as a trade marks attorney and patent attorney	$600
31	Applying to be restored to the Register, as authorised by regulation 20.14	$300
32	Submitting an AFS request under regulation 3A.3 Note: After: (a) an AFS request has been submitted under regulation 3A.3 and the fee specified in this item has been paid; and (b) the AFS request has been assessed under regulation 3A.4; the AFS request may be submitted under paragraph 3A.5(1)(b) as an application for registration under Part 4 of the Act, by payment of the fee specified in item 35 of this table.	$200 for each class of goods or services to which the AFS request relates
33	Amending an AFS request under subregulation 3A.3(5) for the purpose of adding one or more classes of goods or services	$200 for each additional class
34	Amending an AFS request under regulation 3A.5:	
	(a) if the amendment is for the purpose of adding one or more classes of goods or services and paragraph (c) does not apply;	$200 for each additional class
	(b) if the amendment is to significantly change the graphical representation of the trade mark and paragraph (c) does not apply;	$150 for each class of goods or services to which the AFS request relates
	(c) if the amendment is both: (i) for the purpose of adding one or more classes of goods or services; and (ii) to significantly change the graphical representation of the trade mark	The sum of (a) $200 for each additional class; and (b) $150 for each class of goods or services to which the AFS request relates, other than the additional classes
35	Submitting, as mentioned in paragraph 3A.5(1)(b), an AFS request as an application for registration of a trade mark in respect of goods or services in one or more of the classes provided for by subregulation 3.1(1)	$130 for each class
36	Applying for registration as an incorporated trade marks attorney	$350
37	Annual registration of an incorporated trade marks attorney	$400
38	Annual registration fee payable for combined registration as an incorporated trade marks attorney and an incorporated patent attorney	$600
39	Applying to be restored to the Register of Trade Marks Attorneys, as authorised by regulation 20A.22	$300

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Endnotes

Endnote 1—About the endnotes

The endnotes provide information about this compilation and the compiled law.

The following endnotes are included in every compilation:

Endnote 1—About the endnotes
Endnote 2—Abbreviation key
Endnote 3—Legislation history
Endnote 4—Amendment history

Abbreviation key—Endnote 2
The abbreviation key sets out abbreviations that may be used in the endnotes.

Legislation history and amendment history—Endnotes 3 and 4
Amending laws are annotated in the legislation history and amendment history.

The legislation history in endnote 3 provides information about each law that has amended (or will amend) the compiled law. The information includes commencement details for amending laws and details of any application, saving or transitional provisions that are not included in this compilation.

The amendment history in endnote 4 provides information about amendments at the provision (generally section or equivalent) level. It also includes information about any provision of the compiled law that has been repealed in accordance with a provision of the law.

Editorial changes
The *Legislation Act 2003* authorises First Parliamentary Counsel to make editorial and presentational changes to a compiled law in preparing a compilation of the law for registration. The changes must not change the effect of the law. Editorial changes take effect from the compilation registration date.

If the compilation includes editorial changes, the endnotes include a brief outline of the changes in general terms. Full details of any changes can be obtained from the Office of Parliamentary Counsel.

Misdescribed amendments
A misdescribed amendment is an amendment that does not accurately describe how an amendment is to be made. If, despite the misdescription, the amendment can be given effect as intended, then the misdescribed amendment can be incorporated through an editorial change made under section 15V of the *Legislation Act 2003*.

If a misdescribed amendment cannot be given effect as intended, the amendment is not incorporated and "(md not incorp)" is added to the amendment history.

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Endnote 2—Abbreviation key

ad = added or inserted

am = amended

amdt = amendment

c = clause(s)

C[x] = Compilation No. x

Ch = Chapter(s)

def = definition(s)

Dict = Dictionary

disallowed = disallowed by Parliament

Div = Division(s)

ed = editorial change

exp = expires/expired or ceases/ceased to have effect

F = Federal Register of Legislation

gaz = gazette

LA = *Legislation Act 2003*

LIA = *Legislative Instruments Act 2003*

(md) = misdescribed amendment can be given effect

(md not incorp) = misdescribed amendment cannot be given effect

mod = modified/modification

No. = Number(s)

o = order(s)

Ord = Ordinance

orig = original

par = paragraph(s)/subparagraph(s) /sub-subparagraph(s)

pres = present

prev = previous

(prev…) = previously

Pt = Part(s)

r = regulation(s)/rule(s)

reloc = relocated

renum = renumbered

rep = repealed

rs = repealed and substituted

s = section(s)/subsection(s)

Sch = Schedule(s)

Sdiv = Subdivision(s)

SLI = Select Legislative Instrument

SR = Statutory Rules

Sub-Ch = Sub-Chapter(s)

SubPt = Subpart(s)

underlining = whole or part not commenced or to be commenced

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Endnote 3—Legislation history

Number and year	FRLI registration or gazettal	Commencement	Application, saving and transitional provisions
341, 1995	6 Nov 1995	1 Jan 1996 (r 1.2)	
3, 1996	25 Jan 1996	r 9: 1 Jan 1996 (r 1.1) Remainder: 25 Jan 1996 (r 1)	—
184, 1996	21 Aug 1996	21 Aug 1996 (r 1)	—
272, 1996	11 Dec 1996	r 3: 1 Jan 1997 (r 1.1) Remainder: 11 Dec 1996 (r 1)	—
346, 1997	9 Dec 1997	r 3 and 4: 1 Feb 1998 (r 1.2) r 5 and 6: 1 Jan 1998 (r 1.1) Remainder: 9 Dec 1997 (r 1)	r 3
258, 1998	12 Aug 1998	12 Aug 1998 (r 2)	—
265, 1998	26 Aug 1998	r 5: 1 Nov 1998 (r 2.1) Remainder: 26 Aug 1998 (r 2.2)	—
343, 1998	22 Dec 1998	22 Dec 1998 (r 2)	—
346, 1998	22 Dec 1998	27 Jan 1999 (r 2)	—
153, 1999	14 July 1999	14 July 1999 (r 2)	—
186, 1999	1 Sept 1999	r 1–3 and Sch 1: 1 Sept 1999 (r 2(1)) Remainder: 6 Sept 1999 (r 2(b))	—
196, 1999	10 Sept 1999	10 Sept 1999 (r 2)	—
350, 1999	22 Dec 1999	22 Dec 1999 (r 2)	—
33, 2001	1 Mar 2001	11 July 2001 (r 2)	—
185, 2001	5 July 2001	5 July 2001 (r 2)	—
247, 2001	14 Sept 2001	r 1–3 and Sch 1: 19 Sept 2001 (r 2(a)) Remainder: 1 Jan 2002 (r 2(b))	—
173, 2002	11 July 2002	Sch 3: 11 July 2002 (r 2(a)) Sch 6: 1 Sept 2002 (r 2(b))	—
318, 2002	19 Dec 2002	19 Dec 2002 (r 2)	—
214, 2003	21 Aug 2003	24 July 2003 (r 2)	—
24, 2004	26 Feb 2004	11 Mar 2004 (r 2)	—
194, 2004	1 July 2004	1 July 2004 (r 2)	—
52, 2005	29 Mar 2005 (F2005L00759)	r 1–3 and Sch 1: 30 Mar 2005 (r 2(a)) Remainder: 3 Apr 2005 (r 2(b))	—

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Endnote 3—Legislation history

Number and year	FRLI registration or gazettal	Commencement	Application, saving and transitional provisions
211, 2005	16 Sept 2005 (F2005L02660)	3 Oct 2005 (r 2)	—
355, 2006	15 Dec 2006 (F2006L03971)	Sch 4: 1 Mar 2007 (r 2)	—
356, 2006	18 Dec 2006 (F2006L03976)	r 1–4 and Sch 1: 19 Dec 2006 (r 2(a)) Remainder: 1 Jan 2007 (r 2(b))	r 4
40, 2007	23 Mar 2007 (F2007L00650)	r 9, 10, Sch 6 and 7: 27 Mar 2007 (r 2(a), (c)) Sch 8: 1 Apr 2007 (r 2(b))	r 9, 10
122, 2008	23 June 2008 (F2008L02119)	r 5 and Sch 2: 1 July 2008 (r 2)	r 5
279, 2008	19 Dec 2008 (F2008L04588)	Sch 3: 1 Jan 2009 (r 2)	—
150, 2009	26 June 2009 (F2009L02472)	Sch 3: 1 July 2009 (r 2)	—
332, 2009	27 Nov 2009 (F2009L04297)	Sch 2: 12 Dec 2009 (r 2)	—
248, 2010	15 Oct 2010 (F2010L02682)	16 Oct 2010 (r 2)	—
62, 2011	16 May 2011 (F2011L00773)	Sch 3: 1 July 2011 (r 2)	—
217, 2011	29 Nov 2011 (F2011L02480)	Sch 1 (items 5.1–5.3): 27 Dec 2011 (r 2(a)) Sch 2 (items 2.1–2.9): 1 Jan 2012 (r 2(b))	—
66, 2012	14 May 2011 (F2012L01031)	Sch 2 (items 1–15): 1 July 2012 (s 2(a)(iii)) Sch 2 (item 15): 1 Oct 2012 (s 2(b))	s 4
31, 2013	18 Mar 2013 (F2013L00479)	Sch 3 (items 10–30), Sch 4 (items 30–48, Sch 5 (items 2–4), Sch 6 (items 87–99) and Sch 7 (items 3, 4): 15 Apr 2013 (s 2)	—
88, 2015	19 June 2015 (F2015L00852)	Sch 3 (items 4, 5) and Sch 5 (items 15–31): 20 June 2015 (s 2(1) (items 4, 6)	—
90, 2015	19 June 2015 (F2015L00854)	Sch 2 (items 200–218): 1 July 2015 (s 2(1) item 2)	—

Name	Registration	Commencement	Application, saving and transitional provisions
Trade Marks Amendment (Fees) Regulation 2016	6 May 2016 (F2016L00694)	7 May 2016 (s 2(1) item 1)	—
Intellectual Property Legislation Amendment (Fee Review) Regulation 2016	19 Aug 2016 (F2016L01306)	10 Oct 2016 (s 2(1) item 1)	—

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Endnote 3—Legislation history

Name	Registration	Commencement	Application, saving and transitional provisions
Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016	14 Nov 2016 (F2016L01754)	Sch 2: 24 Feb 2017 (s 2(1) item 2) Sch 4 (items 3–10), Sch 5 and Sch 6 (items 1–8): 15 Nov 2016 (s 2(1) items 3, 4)	—
Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018	16 Oct 2018 (F2018L01435)	Sch 1 (items 3–5) and Sch 2 (items 1–14, 61–110, 142–157, 191, 219–222): 24 Feb 2019 (s 2(1) items 3, 5–7, 9, 12) Sch 2 (items 158–184, 215, 216, 230, 236, 237): 17 Oct 2018 (s 2(1) items 8, 11, 14)	—
Intellectual Property Laws Amendment (Fee Exemptions) Regulations 2020	12 June 2020 (F2020L00703)	Sch 1 (item 2): 13 June 2020 (s 2(1) item 1)	—
Intellectual Property Laws Amendment (Fee Amounts and Other Measures) Regulations 2020	7 Aug 2020 (F2020L00997)	Sch 1 (items 50–79): 1 Oct 2020 (s 2(1) item 1)	—
Instruments Update (Autumn 2024) Regulations 2024	14 Mar 2024 (F2024L00297)	Sch 2 (items 32–41): 11 Apr 2024 (s 2(1) item 1)	—
Statute Law Amendment (Prescribed Forms) Regulations 2024	15 Mar 2024 (F2024L00294)	Sch 1 (items 61, 62): 20 Mar 2024 (s 2(1) item 1)	—

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Endnote 4—Amendment history

Provision affected	How affected
Part 1	
r 1.1	rs No 258, 1998
r 1.2	rep LIA s 48D
Part 2	
r 2.1	am No 346, 1998; No 33, 2001; No 247, 2001; No 66, 2012; No 31, 2013; No 88, 2015; F2016L01306; F2016L01754; F2018L01435; F2020L00997; F2024L00297
r 2.2	ad 2001 No 247
	am 2011 No 217
r 2.3	ad No 31, 2013
Part 3A	
Part 3A	ad 2005 No 211
Division 1	
r 3A.1	ad 2005 No 211
r 3A.2	ad 2005 No 211
	rep F2016L01306
Division 2	
r 3A.3	ad 2005 No 211
r 3A.4	ad 2005 No 211
r 3A.5	ad 2005 No 211
	am F2020L00997
Part 4	
r 4.1	am 2005 No 211
r 4.2	am No 211, 2005; No 40, 2007; F2018L01435
r 4.2AA	ad 2007 No 40
r 4.2A	ad 2005 No 211
r 4.3	am No 40, 2007; F2018L01435
r 4.4	am No 31, 2013
r 4.5	am 1997 No 346
r 4.6	am 1999 No 196
r 4.7	am 1996 No 184; 2007 No 40; No 31, 2013
r 4.8	am F2018L01435
r 4.10	am F2018L01435
r 4.11	am F2018L01435
r 4.13	am No 33, 2001; No 40, 2007; No 31, 2013; F2018L01435
r 4.14	am No 186, 1999; No 33, 2001; No 31, 2013; F2018L01435
r 4.15	am 2001 No 33; No 31, 2013; F2016L01754
r 4.15A	ad 2001 No 33
	am 2005 No 52

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Endnote 4—Amendment history

Provision affected	How affected
r 4.16	rep 2007 No 40
r 4.17	am 2002 No 318
	rep 2007 No 40
r 4.18	am F2018L01435
Part 5	
Part 5	rs No 31, 2013
Division 1	
r 5.1	rs No 31, 2013
r 5.2	am 2003 No 214
	rs No 31, 2013
	am F2020L00997
r 5.3	rs No 31, 2013
	rep F2018L01435
r 5.4	rs No 31, 2013
Division 2	
Subdivision A	
r 5.5	rs No 31, 2013
	rs F2020L00997
r 5.6	rs No 31, 2013
r 5.7	rs No 31, 2013
r 5.8	rs No 31, 2013
r 5.9	rs No 31, 2013
r 5.10	am 2001 No 247
	rs No 31, 2013
r 5.11	rs No 31, 2013
r 5.12	rs No 31, 2013
Subdivision B	
r 5.13	rs No 31, 2013
r 5.13A	ad F2018L01435
r 5.13B	ad F2018L01435
Subdivision C	
r 5.14	rs No 31, 2013
r 5.15	rs No 31, 2013
Division 3	
r 5.16	rs No 31, 2013
Division 4	
r 5.17	rs No 31, 2013
Division 5	
r 5.18	ad 2005 No 52
	rs No 31, 2013

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Endnote 4—Amendment history

Provision affected	How affected
r 5.19	ad 2005 No 52
	rs No 31, 2013
r 5.20	ad No 31, 2013
Part 6	
Division 1	
Division 1 heading	ad No 31, 2013
r 6.1	am F2018L01435
r 6.4	am F2018L01435
Division 2	
Division 2	ad No 31, 2013
r 6.5	ad 2007 No 40
	rs No 31, 2013
r 6.6	ad 2007 No 40
	rs No 31, 2013
r 6.7	ad No 31, 2013
r 6.8	ad No 31, 2013
r 6.9	ad No 31, 2013
r 6.10	ad No 31, 2013
r 6.11	ad No 31, 2013
Part 7	
Division 1	
Division 1 heading	ad 2001 No 247
r 7.1	am No 31, 2013 (md)
r 7.2	am 2007 No 40
Division 2	
Division 2 heading	ad 2001 No 247
r 7.5	am F2018L01435
Division 3	
Division 3	ad 2001 No 247
r 7.6	ad 2001 No 247
r 7.7	ad 2001 No 247
	am F2018L01435
r 7.8	ad 2001 No 247
	am F2018L01435
Part 8	
r 8.1	am F2018L01435
r 8.1A	ad 2007 No 40
	rep F2018L01435
r 8.3	ad 2005 No 52
	am F2020L00997

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Endnote 4—Amendment history

Provision affected	How affected
r 8.4	ad 2010 No 248
	am F2018L01435
r 8.5	ad 2010 No 248
	rs F2018L01435
r 8.6	ad F2018L01435
r 8.7	ad F2018L01435
r 8.8	ad F2018L01435
Part 9	
Part 9	rs No 31, 2013
Division 1	
r 9.1	am 1996 No 3
	rs 2007 No 40; No 31, 2013
r 9.2	am 1999 No 186; 2007 No 40
	rs No 31, 2013
	am F2020L00997
r 9.3	rs No 31, 2013
	rep F2018L01435
r 9.4	am 2007 No 40
	rs No 31, 2013
Division 2	
r 9.5	ad No 31, 2013
r 9.6	ad No 31, 2013
Division 3	
Subdivision A	
r 9.7	ad No 31, 2013
	rs F2020L00997
r 9.8	ad No 31, 2013
r 9.9	ad No 31, 2013
r 9.10	ad No 31, 2013
r 9.11	ad No 31, 2013
r 9.12	ad No 31, 2013
r 9.13	ad No 31, 2013
r 9.14	ad No 31, 2013
Subdivision B	
r 9.15	ad No 31, 2013
	am F2018L01435
r 9.15A	ad F2018L01435
r 9.15B	ad F2018L01435
Subdivision C	
r 9.16	ad No 31, 2013

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Endnote 4—Amendment history

Provision affected	How affected
r 9.17	ad No 31, 2013
r 9.18	ad No 31, 2013
Division 4	
r 9.19	ad No 31, 2013
Division 5	
r 9.20	ad No 31, 2013
Division 6	
r 9.21	ad No 31, 2013
r 9.22	ad No 31, 2013
r 9.23	ad No 31, 2013
Part 10	
r 10.1	am No 247, 2001
r 10.4	am F2018L01435
r 10.5	am F2018L01435
Part 11	
r 11.1	am No 66, 2012
r 11.3	am F2018L01435
Part 13	
r 13.1A	ad No 31, 2013
	am No 90, 2015; F2018L01435
r 13.1	rs 2001 No 247; No 31, 2013
r 13.2	am 1999 No 186
	rs No 31, 2013
r 13.3	ad No 31, 2013
r 13.4	ad No 31, 2013
	am No 90, 2015
r 13.5	ad No 31, 2013
	am No 90, 2015; F2024L00294
r 13.3	am 1999 No 186
renum r 13.6	No 31, 2013
r 13.6	am No 90, 2015
r 13.4	
renum r 13.7	No 31, 2013
r 13.5	
renum r 13.8	No 31, 2013
r 13.6	
renum r 13.9	No 31, 2013
Part 16	
r 16.2	rs 2007 No 40
r 16.6	am F2024L00297

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Endnote 4—Amendment history

Provision affected	How affected
r 16.7	am No 31, 2013
r 16.10	rs 2007 No 40
	am No 31, 2013
r 16.10A	ad 2001 No 247
	am 2007 No 40
r 16.11	am 2007 No 40
r 16.12	ad 2007 No 40
Part 17	
r 17.2	ad 2001 No 33
Part 17A	
Part 17A	ad 2001 No 33
Division 1	
r 17A.1	ad 2001 No 33
r 17A.2	ad 2001 No 33
	am 2001 No 247; 2007 No 40; 2011 No 62; F2020L00997
r 17A.3	ad 2001 No 33
r 17A.4	ad 2001 No 33
	am 2007 No 40
Division 2	
r 17A.5	ad 2001 No 33
r 17A.6	ad 2001 No 33
	am F2020L00997
r 17A.7	ad 2001 No 33
r 17A.8	ad 2001 No 33
	am F2020L00997
r 17A.9	ad 2001 No 33
	am 2007 No 40
r 17A.10	ad 2001 No 33
	am 2007 No 40
Division 3	
Subdivision 1	
r 17A.11	ad 2001 No 33
r 17A.12	ad 2001 No 33
r 17A.13	ad 2001 No 33
r 17A.14	ad 2001 No 33
	am 2007 No 40; F2016L01754
r 17A.14A	ad 2007 No 40
	am F2020L00997
r 17A.15	ad 2001 No 33
	am F2020L00997

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Endnote 4—Amendment history

Provision affected	How affected
r 17A.16	ad No 33, 2001
	am F2016L01754; F2020L00997
r 17A.17	ad No 33, 2001
	am F2016L01754
r 17A.18	ad No 33, 2001
	am F2018L01435
r 17A.19	ad No 33, 2001
	am F2018L01435
r 17A.20	ad No 33, 2001
r 17A.21	ad No 33, 2001
	am No 40, 2007; No 31, 2013; F2018L01435; F2024L00297
r 17A.22	ad No 33, 2001
	am No 31, 2013; F2018L01435; F2024L00297
r 17A.23	ad No 33, 2001
r 17A.24	ad No 33, 2001
r 17A.25	ad No 33, 2001
	am No 62, 2011; F2018L01435; F2020L00997
r 17A.26	ad No 33, 2001
r 17A.27	ad No 33, 2001
	am No 40, 2007
Subdivision 2	
r 17A.28	ad No 33, 2001
	am No 40, 2007; No 31, 2013
Subdivision 3 heading	rep No 31, 2013
Subdivision C	
Subdivision C	ad No 31, 2013
r 17A.29	ad No 33, 2001
	rs No 31, 2013
r 17A.30	ad No 33, 2001
	am No 247, 2001
	rs No 31, 2013
	rep F2018L01435
r 17A.31	ad 2001 No 33
	am 2006 No 356
	rs No 31, 2013
r 17A.32	ad 2001 No 33
	rs No 31, 2013
	am F2020L00997
r 17A.33	ad 2001 No 33
	am 2007 No 40; 2011 No 62

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Endnote 4—Amendment history

Provision affected	How affected
	rs No 31, 2013
	am No 88, 2015
r 17A.34	ad 2001 No 33
	am 2007 No 40
	rs No 31, 2013
r 17A.34A	ad No 31, 2013
r 17A.34B	ad No 31, 2013
	am No 88, 2015
r 17A.34C	ad No 31, 2013
r 17A.34D	ad No 31, 2013
r 17A.34E	ad No 31, 2013
r 17A.34F	ad No 31, 2013
r 17A.34G	ad No 31, 2013
r 17A.34H	ad No 31, 2013
	am No 88, 2015; F2016L01754; F2018L01435
r 17A.34HA	ad F2018L01435
r 17A.34HB	ad F2018L01435
r 17A.34J	ad No 31, 2013
r 17A.34K	ad No 31, 2013
r 17A.34L	ad No 31, 2013
r 17A.34M	ad No 31, 2013
	am No 88, 2015
r 17A.34N	ad No 31, 2013
r 17A.34P	ad No 31, 2013
r 17A.34Q	ad No 31, 2013
r 17A.35	ad No 33, 2001
	rs No 31, 2013
Subdivision 3A	
r 17A.35A	ad No 40, 2007
r 17A.35B	ad No 40, 2007
	am F2020L00997
Subdivision 4	
r 17A.36	ad No 33, 2001
	am No 40, 2007; No 88, 2015; F2018L01435
r 17A.37	ad No 33, 2001
	am F2016L01754
r 17A.38	ad No 33, 2001
	am No 40, 2007
Division 4	
r 17A.39	ad No 33, 2001

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Provision affected	How affected
	am No 40, 2007; No 88, 2015; F2018L01435
r 17A.40	ad No 33, 2001
Division 5	
Subdivision 1	
Subdivision 1 heading	ad No 40, 2007
r 17A.41	ad No 33, 2001
r 17A.41A	ad No 40, 2007
	am F2020L00997
r 17A.42	ad No 33, 2001
	am No 247, 2001
Subdivision 2	
r 17A.42A	ad No 40, 2007
	am F2018L01435
r 17A.42B	ad No 40, 2007
	am F2016L01754
r 17A.42C	ad No 40, 2007
r 17A.42D	ad No 40, 2007
r 17A.42E	ad No 40, 2007
	am No 90, 2015
r 17A.42F	ad No 40, 2007
	am No 31, 2013
Subdivision 3	
Subdivision 3 heading	ad No 40, 2007
r 17A.43	ad No 33, 2001
	am No 40, 2007
r 17A.44	ad No 33, 2001
	am No 40, 2007
r 17A.45	ad No 33, 2001
	am No 247, 2001; No 356, 2006; No 40, 2007; F2018L01435
r 17A.46	ad No 33, 2001
r 17A.47	ad No 33, 2001
Subdivision 4 heading	ad No 40, 2007
	rep No 31, 2013
Subdivision D	
Subdivision D	ad No 31, 2013
r 17A.48	ad No 33, 2001
	am No 247, 2001; No 356, 2006; No 40, 2007; No 62, 2011
	rs No 31, 2013
r 17A.48A	ad No 31, 2013
	rep F2018L01435

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Endnote 4—Amendment history

Provision affected	How affected
r 17A.48B	ad No 31, 2013
r 17A.48C	ad No 31, 2013
r 17A.48D	ad No 31, 2013
	am F2018L01435
r 17A.48E	ad No 31, 2013
r 17A.48F	ad No 31, 2013
r 17A.48G	ad No 31, 2013
r 17A.48H	ad No 31, 2013
	am F2016L01754
r 17A.48J	ad No 31, 2013
r 17A.48K	ad No 31, 2013
r 17A.48L	ad No 31, 2013
r 17A.48M	ad No 31, 2013
r 17A.48N	ad No 31, 2013
r 17A.48P	ad No 31, 2013
r 17A.48Q	ad No 31, 2013
	am F2018L01435
r 17A.48QA	ad F2018L01435
r 17A.48QB	ad F2018L01435
r 17A.48R	ad No 31, 2013
r 17A.48S	ad No 31, 2013
r 17A.48T	ad No 31, 2013
r 17A.48U	ad No 31, 2013
r 17A.48V	ad No 31, 2013
r 17A.48W	ad No 31, 2013
r 17A.48X	ad No 31, 2013
r 17A.48Y	ad No 31, 2013
r 17A.48Z	ad No 31, 2013
Division 6	
r 17A.49	ad No 33, 2001
r 17A.50	ad No 33, 2001
	am No 247, 2001; F2016L01754; F2020L00997
Division 7	
r 17A.51	ad No 33, 2001
r 17A.52	ad No 33, 2001
	am No 40, 2007
r 17A.53	ad No 33, 2001
	am No 40, 2007
Division 8	
r 17A.54	ad No 33, 2001

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Provision affected	How affected
	am F2020L00997
r 17A.55	ad No 33, 2001
Division 9	
r 17A.56	ad No 33, 2001
	am No 247, 2001
r 17A.57	ad No 33, 2001
	am No 247, 2001; F2020L00997
r 17A.58	ad No 33, 2001
	am No 247, 2001; F2020L00997; F2024L00297
r 17A.58A	ad No 247, 2001
	am F2020L00997; F2024L00297
r 17A.59	ad No 33, 2001
	am No 247, 2001; F2018L01435; F2020L00997
r 17A.60	ad No 33, 2001
	am No 247, 2001
Division 10	
r 17A.61	ad 2001 No 33
	am 2012 No 66
r 17A.62	ad 2001 No 33
r 17A.63	ad 2001 No 33
r 17A.64	ad 2001 No 33
r 17A.65	ad 2001 No 33
Division 11	
r 17A.66	ad 2001 No 33
	am 2011 No 62; F2020L00997
r 17A.67	ad 2001 No 33
r 17A.68	ad 2001 No 33
r 17A.69	ad 2001 No 33
	am F2020L00997
r 17A.70	ad 2001 No 33
r 17A.71	ad 2001 No 33
r 17A.72	ad 2007 No 40
r 17A.73	ad 2007 No 40
	am F2018L01435
r 17A.74	ad No 62, 2011
	am F2016L01754; F2018L01435
Part 19	
r 19.1	am 1999 No 186; No 31, 2013
r 19.2	rs 1998 No 258

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Endnote 4—Amendment history

Provision affected	How affected
Part 20	
Part 20	ad 1998 No 346
	rs 2008 No 122
Division 1	
r 20.1A	ad No 31, 2013
r 20.1	ad No 346, 1998
	am No 185, 2001
	rs No 122, 2008
	am No 31, 2013; F2016L01754
Division 2	
r 20.2	ad 1998 No 346
	rs 2008 No 122
r 20.3	ad 1998 No 346
	am 2002 No 173
	rs 2008 No 122
	am 2009 No 150; 2012 No 66
r 20.4	ad 1998 No 346
	rs 2008 No 122
r 20.5	ad 1998 No 346
	rs 2008 No 122
r 20.6	ad No 346, 1998
	rs No 122, 2008
	am F2016L01754
r 20.7	ad 1998 No 346
	am 2002 No 173
	rs 2008 No 122
r 20.8	ad1998 No 346
	am 2002 No 173; 2002 No 318
	rs 2008 No 122
	am 2009 No 150
r 20.9	ad 1998 No 346
	am 1999 No 153; 2002 No 173; 2002 No 318
	rs 2008 No 122
r 20.10	ad 1998 No 346
	rs 2008 No 122
r 20.11	ad No 346, 1998
	rs No 122, 2008
	am F2016L01754
Division 3	
r 20.12	ad 2008 No 122

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Endnote 4—Amendment history

Provision affected	How affected
Division 4	
r 20.13	ad 2008 No 122
Division 5	
Division 5 heading	rs No 31, 2013
r 20.14	ad 2008 No 122
	am No 31, 2013; No 88, 2015
Division 5A	
Division 5A	ad No 31, 2013
r 20.14A	ad No 31, 2013
r 20.14B	ad No 31, 2013
Division 6	
r 20.15	ad No 122, 2008
	am No 88, 2015; F2016L01754
Division 7	
r 20.16	ad 2008 No 122
Part 20A	
Part 20A	ad No 31, 2013
Division 1	
r 20A.1	ad No 31, 2013
r 20A.2	ad No 31, 2013
Division 2	
r 20A.3	ad No 31, 2013
r 20A.4	ad No 31, 2013
Division 3	
r 20A.5	ad No 31, 2013
Division 4	
r 20A.6	ad No 31, 2013
r 20A.7	ad No 31, 2013
r 20A.8	ad No 31, 2013
Division 5	
Subdivision A	
r 20A.9	ad No 31, 2013
r 20A.10	ad No 31, 2013
	am F2016L01754
Subdivision B	
r 20A.11	ad No 31, 2013
	rs F2016L01754
r 20A.11A	ad F2016L01754
r 20A.11B	ad F2016L01754
r 20A.11C	ad F2016L01754

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Provision affected	How affected
r 20A.11D	ad F2016L01754
r 20A.12	ad No 31, 2013
	am F2016L01754
r 20A.13	ad No 31, 2013
	am F2016L01754
r 20A.14	ad No 31, 2013
	am F2016L01754
r 20A.15	ad No 31, 2013
	am F2016L01754
r 20A.16	ad No 31, 2013
	am F2016L01754
r 20A.17	ad No 31, 2013
	am F2016L01754
r 20A.18	ad No 31, 2013
	am F2016L01754
r 20A.19	ad No 31, 2013
	am F2016L01754
r 20A.20	ad No 31, 2013
	am F2016L01754
r 20A.21	ad No 31, 2013
	am F2016L01754
Division 6	
r 20A.22	ad No 31, 2013
Part 21	
Division 1	
r 21.1	am No 66, 2012
r 21.2	am No 343, 1998; No 332, 2009
	rs F2018L01435
r 21.3	am No 343, 1998
r 21.4	am No 211, 2005
	rs F2018L01435
r 21.5	am No 31, 2013; F2018L01435
r 21.5A	ad F2018L01435
r 21.6	am No 346, 1998; No 150, 2009
	rs No 66, 2012
	am F2016L01754
r 21.7A	ad F2016L01754
r 21.9	am F2018L01435
r 21.10	rs F2018L01435
r 21.11A	ad No 40, 2007

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Provision affected	How affected
Division 2	
r 21.13	am No 247, 2001; No 214, 2003
	rs No 31, 2013
r 21.14	am No 88, 2015; F2018L01435
r 21.15	rs No 31, 2013
r 21.16	rs No 31, 2013
	am F2018L01435
r 21.17	am F2018L01435
r 21.18	rep F2018L01435
Division 2A	
Division 2A	ad No 31, 2013
r 21.20A	ad No 31, 2013
r 21.20B	ad No 31, 2013
r 21.20C	ad No 31, 2013
r 21.20D	ad No 31, 2013
r 21.20E	ad No 31, 2013
r 21.20F	ad No 31, 2013
r 21.20G	ad No 31, 2013
Division 3	
r 21.21	am No 265, 1998; No 247, 2001; No 173, 2002; No 66, 2012; F2020L00997
r 21.21AA	ad No 66, 2012
	rep F2018L01435
r 21.21A	ad No 40, 2007
	am No 88, 2015; No 90, 2015
r 21.22	am No 343, 1998; No 186, 1999; No 90, 2015; F2018L01435
r 21.23	am No 186, 1999
	rs No 211, 2005
	am No 40, 2007; No 90, 2015
r 21.23A	ad F2020L00703
r 21.24	am No 214, 2003
r 21.24A	ad No 40, 2007
	am No 31, 2013
r 21.24B	ad No 40, 2007
	am No 62, 2011; No 217, 2011
r 21.24C	ad No 40, 2007
r 21.26	rep No 31, 2013
r 21.27	rep No 31, 2013
r 21.28	am No 186, 1999; No 247, 2001; No 52, 2005; No 211, 2005; No 40, 2007; No 122, 2008; No 31, 2013; No 88, 2015; F2018L01435
r 21.29	am No 186, 1999; No 31, 2013

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Provision affected	How affected
r 21.30	rs No 346, 1998
r 21.32	rep No 88, 2015
r 21.33	am F2018L01435
r 21.35	ad No 346, 1998
	am No 122, 2008; No 31, 2013 (md); F2016L01754
Part 22	
Part 22 heading	rs F2018L01435
Division 1	
Division 1 heading	ad No 31, 2013
r 22.1	am No 3, 1996
r 22.2	am No 346, 1997
r 22.4	am No 3, 1996
r 22.6	ad No 3, 1996
r 22.7	ad No 346, 1998
	am No 66, 2012
r 22.8	ad No 346, 1998
	am No 66, 2012
Division 2	
Division 2	ad No 31, 2013
r 22.9	ad No 31, 2013
r 22.10	ad No 90, 2015
r 22.11	ad F2016L00694
r 22.12	ad F2016L01306
r 22.13	ad F2016L01754
Division 3	
Division 3	ad F2016L01754
r 22.14	ad F2016L01754
r 22.15	ad F2016L01754
r 22.16	ad F2016L01754
r 22.17	ad F2016L01754
Division 4	
Division 4	ad F2018L01435
r 22.18	ad F2018L01435
r 22.19	ad F2018L01435
r 22.20	ad F2018L01435
r 22.21	ad F2018L01435
r 22.22	ad F2018L01435
r 22.23	ad F2018L01435
r 22.24	ad F2018L01435

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Endnote 4—Amendment history

Provision affected	How affected
Division 5	
Division 5	ad F2020L00997
r 22.25	ad F2020L00997
Schedule 1	
Schedule 1	am No 272, 1996; No 247, 2001; No 356, 2006; No 217, 2011; F2016L01754
Schedule 3	
Schedule 3	am No 186, 1999
	rs No 31, 2013
	am No 90, 2015; F2016L01754
Schedule 4	
Schedule 4	am No 186, 1999
	rs No 31, 2013
	am No 90, 2015; F2016L01754
Schedule 5	
Schedule 5	am No 186, 1999
	rs No 31, 2013
	am No 90, 2015; F2016L01754
Schedule 6	
Schedule 6	am No 3, 1996
	rs No 258, 1998
Schedule 7	
Schedule 7 heading	rs No 343, 1998
Schedule 7	am No 343, 1998; No 88, 2015
	rep F2018L01435
Schedule 8	
Schedule 8	am No 346, 1998; No 186, 1999; No 355, 2006; No 31, 2013; F2018L01435
Schedule 9	
Schedule 9 heading	rs F2016L01306
Schedule 9	am No 3, 1996
	rs No 346, 1997
	am No 265, 1998; No 346, 1998; No 33, 2001; No 247, 2001
	rs No 173, 2002
	am No 211, 2005; No 355, 2006; No 40, 2007; No 122, 2008
	rs No 66, 2012
	am No 31, 2013; No 88, 2015; F2016L00694; F2016L01306; F2018L01435; F2020L00997
	ed C46
Schedule 10	am No 3, 1996
	rs No 272, 1996; No 346, 1997

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Provision affected	How affected
	am No 258, 1998; No 343, 1998; No 350, 1999; No 173, 2002; No 318, 2002; No 24, 2004; No 194, 2004; No 52, 2005; No 40, 2007; No 279, 2008; No 66, 2012
	rep No 31, 2013

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