



Intellectual Property Legislation Amendment Regulations 2011 (No. 1)¹

Select Legislative Instrument 2011 No. 62

I, PROFESSOR MARIE BASHIR, AC, CVO, Administrator of the Government of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following Regulations under the *Patents Act 1990*, the *Trade Marks Act 1995*, the *Designs Act 2003*, the *Plant Breeder's Rights Act 1994* and the *Olympic Insignia Protection Act 1987*.

Dated 12 May 2011

MARIE BASHIR
Administrator

By Her Excellency's Command

KIM CARR
Minister for Innovation, Industry, Science and Research

Contents

	1	Name of Regulations	3
	2	Commencement	3
	3	Amendment of <i>Patents Regulations 1991</i>	3
	4	Amendment of <i>Patents Regulations 1991</i>	3
	5	Amendment of <i>Trade Marks Regulations 1995</i>	4
	6	Amendment of <i>Designs Regulations 2004</i>	4
	7	Amendment of <i>Plant Breeder's Rights Regulations 1994</i>	4
	8	Amendment of <i>Olympic Insignia Protection Regulations 1993</i>	4
Schedule 1		Amendments of <i>Patents Regulations 1991</i> — general	5
Schedule 2		Further amendments of <i>Patents Regulations 1991</i> — Patent Cooperation Treaty	9
Schedule 3		Amendments of <i>Trade Marks Regulations 1995</i>	15
Schedule 4		Amendments of <i>Designs Regulations 2004</i>	20
Schedule 5		Amendment of <i>Plant Breeder's Rights Regulations 1994</i>	22
Schedule 6		Amendment of <i>Olympic Insignia Protection Regulations 1993</i>	23

1 Name of Regulations

These Regulations are the *Intellectual Property Legislation Amendment Regulations 2011 (No. 1)*.

2 Commencement

These Regulations commence on 1 July 2011.

3 Amendment of *Patents Regulations 1991*

- (1) Schedule 1 amends the *Patents Regulations 1991*.
- (2) The amendment of regulation 22.2EA of the *Patents Regulations 1991* made by item [7] of Schedule 1 applies in relation to request for leave to amend a complete specification:
 - (a) if:
 - (i) the request was made before the commencement of Schedule 1; and
 - (ii) on or after the commencement of Schedule 1, the Commissioner invites the person by whom the fee relating to the grant of leave is payable to pay the fee in accordance with regulation 22.2EA; or
 - (b) if the request is made on or after the commencement of Schedule 1.
- (3) The amendments made by items [8] to [10] of Schedule 1 apply in relation to a document filed on or after the commencement of Schedule 1.

4 Amendment of *Patents Regulations 1991*

- (1) Schedule 2 amends the *Patents Regulations 1991*.
- (2) The amendments made by items [5], [6], [8] to [12] and [14] of Schedule 2 apply in relation to an international application under the Patent Cooperation Treaty whose international filing date is on or after 1 July 2011.

- (3) The amendment made by item [7] of Schedule 2 applies in relation to an international application under the Patent Cooperation Treaty in respect of which:
 - (a) the applicant has performed the acts referred to in Article 22 or Article 39 of the Treaty on or after 1 July 2011; and
 - (b) an amendment under Article 19 or Article 34 of the Treaty was filed on or after 1 July 2009.
- (4) The amendment made by item [13] of Schedule 2 applies in relation to an international preliminary examination report under the Patent Cooperation Treaty which is completed in accordance with Rule 70.4 of the Treaty on or after 1 July 2011, irrespective of the international filing date of the relevant international application.

5 Amendment of *Trade Marks Regulations 1995*

Schedule 3 amends the *Trade Marks Regulations 1995*.

6 Amendment of *Designs Regulations 2004*

Schedule 4 amends the *Designs Regulations 2004*.

7 Amendment of *Plant Breeder's Rights Regulations 1994*

Schedule 5 amends the *Plant Breeder's Rights Regulations 1994*.

8 Amendment of *Olympic Insignia Protection Regulations 1993*

Schedule 6 amends the *Olympic Insignia Protection Regulations 1993*.

Schedule 1 **Amendments of *Patents Regulations 1991* — general**

(regulation 3)

[1] **Subregulation 12.1 (2)**

omit

prescribed court to which the application is made:

insert

Federal Court:

[2] **After subregulation 12.1 (2)**

insert

- (2A) For subparagraph (2) (a) (ii), the address for service must be an address that is mentioned in Rules made by the Federal Court for the service of the application, as in force from time to time.

Note In a transitional period after this subregulation commences, there may be different Rules made by the Federal Court to deal with suitable addresses for service in particular circumstances.

[3] **After subregulation 12.1 (3)**

insert

- (4) For subregulation (3), the applicant must serve the copy in accordance with Rules made by the Federal Court for the service of the application and declaration, as in force from time to time.

Note In a transitional period after this subregulation commences, there may be different Rules made by the Federal Court to deal with service in particular circumstances.

[4] Subregulation 12.2 (2)*omit*

A prescribed court

insert

The Federal Court

[5] Subregulations 22.10 (1) and (2)*substitute*

- (1) If provision is made in an approved form to state an address for service, the person completing the form must state:
 - (a) an address in Australia at which a document under the Act or these Regulations may be given to him or her personally or to the person specified in the form as his or her representative; or
 - (b) another 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.
- (2) A person may file notice of a change of his or her address for service to another address that complies with paragraph (1) (a) or (b).

[6] Subregulation 22.10AB (2)*substitute*

- (2) For paragraph 222A (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: <ol style="list-style-type: none">(a) is an SES employee of IP Australia; and(b) acts with the agreement of the Director General of IP Australia |

Item	Person
4	Another person who: <ul style="list-style-type: none"> (a) is an SES employee of IP Australia; and (b) acts with the agreement of the Deputy Director General of IP Australia
5	Another person who: <ul style="list-style-type: none"> (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 17AA of the *Acts Interpretation Act 1901*.

[7] Regulation 22.2EA

substitute and locate after regulation 22.2E

22.2EA Failure to pay: fee for grant of leave to amend specification (person invited to pay)

- (1) This regulation applies if:
 - (a) a fee mentioned in item 222A of Schedule 7 relating to a grant of leave to amend a complete specification is not paid when it is payable; and
 - (b) within 1 month after the fee first becomes payable, the Commissioner invites the person by whom the fee is payable to pay the fee within 2 months after the date on which notice of the grant of leave is published under subregulation 10.5 (2); and
 - (c) the fee is not paid within that period of 2 months.
- (2) The request for leave to amend the complete specification is taken not to have been filed.

[8] Schedule 3, paragraph 4 (2) (b)*substitute*

- (b) must show the drawings entirely within that margin and within an area of the sheet measuring 26.2 cm × 17.0 cm (the *useable surface*); and
- (c) must not contain a frame surrounding the drawings or the useable surface.

[9] Schedule 3, clause 6*omit***[10] Schedule 3, subclause 7 (3)***omit*

or double spaced

Schedule 2 Further amendments of
Patents Regulations 1991 —
Patent Cooperation Treaty
(regulation 4)

[1] Subregulation 1.4 (2)

omit

1 July 2010

insert

1 July 2011

[2] Schedule 2A, before Table of Provisions

omit

1 July, 2009 and 1 July, 2010.

insert

1 July, 2009, 1 July, 2010 and 1 July, 2011.

[3] Schedule 2A, Table of Provisions

omit

55.3 Translation of Amendments

insert

55.3 Language and Translation of Amendments and Letters

[4] Schedule 2A, Table of Provisions

omit

66.9 Language of Amendments

[5] Schedule 2A, Rule 12.2 (a)

substitute

(a) Any amendment of the international application shall, subject to Rules 46.3 and 55.3, be in the language in which the application is filed.

[6] Schedule 2A, Rule 48.2 (i)

substitute

(i) If the authorization by the receiving Office, the International Searching Authority or the International Bureau of a rectification of an obvious mistake in the international application under Rule 91.1 is received by or, where applicable, given by the International Bureau after completion of the technical preparations for international publication, a statement reflecting all the rectifications shall be published, together with the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2, as the case may be, and the front page shall be republished.

[7] Schedule 2A, Rule 49.5 (a)

substitute

(a) For the purposes of Article 22, the translation of the international application shall contain the description (subject to paragraph (a-bis)), the claims, any text matter of the drawings and the abstract. If required by the designated Office, the translation shall also, subject to paragraphs (b), (c-bis) and (e),

(i) contain the request,

(ii) if the claims have been amended under Article 19, contain both the claims as filed and the claims as amended (the claims as amended shall be furnished in the form of a translation of the complete set of claims furnished under Rule 46.5(a) in replacement of all the claims originally filed), and

(iii) be accompanied by a copy of the drawings.

[8] Schedule 2A, Rule 53.9

omit

(a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments

- (i) to be taken into account, in which case a copy of the amendments shall preferably be submitted with the demand, or

insert

(a) If amendments under Article 19 have been made, the statement concerning amendments shall indicate whether, for the purposes of the international preliminary examination, the applicant wishes those amendments:

- (i) to be taken into account, in which case a copy of the amendments and of the letter required under Rule 46.5(b) shall preferably be submitted with the demand; or

[9] Schedule 2A, Rule 55.3

substitute

55.3 Language and Translation of Amendments and Letters

(a) Subject to paragraph (b), if the international application has been filed in a language other than the language in which it is published, any amendment under Article 34, as well as any letter referred to in Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c), shall be submitted in the language of publication.

(b) Where a translation of the international application is required under Rule 55.2:

- (i) any amendment and any letter referred to in paragraph (a); and
- (ii) any amendment under Article 19 which is to be taken into account under Rule 66.1(c) or (d) and any letter referred to in Rule 46.5(b);

shall be in the language of that translation. Where such amendments or letters have been or are submitted in another language, a translation shall also be submitted.

(c) If an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall invite the applicant to submit the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

[10] Schedule 2A, Rule 62

substitute

Rule 62

Copy of the Written Opinion by the International Searching Authority and of Amendments under Article 19 for the International Preliminary Examining Authority

62.1 Copy of Written Opinion by International Searching Authority and of Amendments Made before the Demand Is Filed

Upon receipt of a demand, or a copy thereof, from the International Preliminary Examining Authority, the International Bureau shall promptly transmit to that Authority:

- (i) a copy of the written opinion established under Rule 43bis.1, unless the national Office or intergovernmental organization that acted as International Searching Authority is also acting as International Preliminary Examining Authority; and
- (ii) a copy of any amendment under Article 19, any statement referred to in that Article, and the letter required under Rule 46.5(b), unless that Authority has indicated that it has already received such a copy.

62.2 Amendments Made after the Demand Is Filed

If, at the time of filing any amendments under Article 19, a demand has already been submitted, the applicant shall preferably, at the same time as he files the amendments with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments, any statement referred to in that Article and the letter required under Rule 46.5(b). In any case, the International Bureau shall promptly transmit a copy of such amendments, statement and letter to that Authority.

[11] Schedule 2A, Rule 66.9

omit

[12] Schedule 2A, Rule 70.2 (c-bis)

substitute

(c-bis) If the claims, description or drawings have been amended but the replacement sheet or sheets were not accompanied by a letter indicating the basis for the amendment in the application as filed, as required under Rule 46.5(b)(iii), Rule 46.5(b)(iii) being applicable by virtue of Rule 66.8(c), or Rule 66.8(a), as applicable, the report may be established as if the amendment had not been made, in which case the report shall so indicate.

[13] Schedule 2A, Rule 70.16

substitute

70.16 Annexes to the Report

(a) The following replacement sheets and letters shall be annexed to the report:

- (i) each replacement sheet under Rule 66.8 containing amendments under Article 34 and each letter under Rule 66.8(a), Rule 66.8(b) and Rule 46.5(b) as applicable by virtue of Rule 66.8(c);
- (ii) each replacement sheet under Rule 46.5 containing amendments under Article 19 and each letter under Rule 46.5; and
- (iii) each replacement sheet under Rule 26.4 as applicable by virtue of Rule 91.2 containing a rectification of an obvious mistake authorized by that Authority under Rule 91.1(b)(iii) and each letter under Rule 26.4 as applicable by virtue of Rule 91.2;

unless any such replacement sheet has been superseded or considered reversed by a later replacement sheet or an amendment resulting in the cancellation of an entire sheet under Rule 66.8(b); and

- (iv) where the report contains an indication referred to in Rule 70.2(e), any sheet and letter relating to a rectification of an obvious mistake which is not taken into account pursuant to Rule 66.4bis.

(b) Notwithstanding paragraph (a), each superseded or reversed replacement sheet referred to in that paragraph and any letter referred to in that paragraph relating to such superseded or reversed sheet shall also be annexed to the report where:

- (i) the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c);
- (ii) the relevant superseding or reversing amendment was not accompanied by a letter indicating the basis for the amendment in the application as filed and the report is established as if the amendment had not been made and contains an indication referred to in Rule 70.2(c-bis).

In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

[14] Schedule 2A, Rule 92.2 (a)

substitute

(a) Subject to Rules 55.1 and 55.3 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. However, where a translation of the international application has been transmitted under Rule 23.1(b) or furnished under Rule 55.2, the language of such translation shall be used.

Schedule 3 **Amendments of *Trade Marks Regulations 1995***

(regulation 5)

[1] Regulation 17A.2, definition of *Common Regulations*

omit

1 April 2007.

insert

1 September 2009.

[2] Paragraph 17A.25 (1) (b)

omit

[3] Paragraph 17A.25 (2) (a)

omit

rule 17 of

[4] Subregulation 17A.33 (3)

substitute

- (3) Despite subregulations (1) and (2), a requirement to serve a document on the holder, or to give the holder an opportunity to make written representations or to be heard, does not apply if no address for service of the holder is recorded in the Record of International Registrations.

[5] After subregulation 17A.48 (6)*insert*

- (6A) Despite subregulation (3), a requirement to serve a document on 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.

[6] After paragraph 17A.66 (3) (b)*insert*

- (ba) the address for service of the holder;

[7] After regulation 17A.73*insert***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, under regulation 17A.29, opposes the extension of protection in Australia to a trade mark that is the subject of an IRDA;
 - (f) a person who applies under subregulation 17A.48 (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.48 (1).

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 must be an address in Australia.
- (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):

‘(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.

[8] Subregulation 21.24B (2)

substitute

- (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

Item	Person
------	--------

- | | |
|---|--|
| 3 | Another person who: <ul style="list-style-type: none">(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: <ul style="list-style-type: none">(a) is an SES employee of IP Australia; and(b) acts with the agreement of the Deputy Director General of IP Australia |
| 5 | Another person who: <ul style="list-style-type: none">(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 17AA of the *Acts Interpretation Act 1901*.

Schedule 4 **Amendments of *Designs Regulations 2004***

(regulation 6)

[1] **Subregulations 11.19 (1) and (2)**

substitute

- (1) If provision is made in an approved form to state an address for service, the person completing the form must state:
 - (a) an address in Australia at which a document under the Act or these Regulations may be given to him or her personally or to the person specified in the form as his or her representative; or
 - (b) another 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.
- (2) A person may file notice of a change of his or her address for service to another address that complies with paragraph (1) (a) or (b).

[2] **Subregulation 11.33 (2)**

substitute

- (2) For paragraph 136A (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: <ol style="list-style-type: none">(a) is an SES employee of IP Australia; and(b) acts with the agreement of the Director General of IP Australia |

Item	Person
------	--------

- | | |
|---|--|
| 4 | Another person who: <ul style="list-style-type: none">(a) is an SES employee of IP Australia; and(b) acts with the agreement of the Deputy Director General of IP Australia |
| 5 | Another person who: <ul style="list-style-type: none">(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 17AA of the *Acts Interpretation Act 1901*.

Schedule 5 **Amendment of *Plant Breeder's Rights Regulations 1994***

(regulation 7)

[1] **Subregulation 3F (2)**

substitute

- (2) For paragraph 76A (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 |
| 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 17AA of the *Acts Interpretation Act 1901*.

Schedule 6 **Amendment of *Olympic Insignia Protection Regulations 1993***

(regulation 8)

[1] **Subregulation 6B (2)**

substitute

- (2) For paragraph 14A (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: <ul style="list-style-type: none"> (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: <ul style="list-style-type: none"> (a) is an SES employee of IP Australia; and (b) acts with the agreement of the Deputy Director General of IP Australia
5	Another person who: <ul style="list-style-type: none"> (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 17AA of the *Acts Interpretation Act 1901*.

Note

1. All legislative instruments and compilations are registered on the Federal Register of Legislative Instruments kept under the *Legislative Instruments Act 2003*. See <http://www.frli.gov.au>.