

## **EXPLANATORY STATEMENT**

Issued by the authority of the Minister for Industry, Science and Technology

*Designs Act 2003*

*Patents Act 1990*

*Plant Breeder's Rights Act 1994*

*Trade Marks Act 1995*

*Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*

### **Legislative Authority**

Subsection 149(1) of the *Designs Act 2003* (Designs Act), subsection 228(1) of the *Patents Act 1990* (Patents Act), subsection 80(1) of the *Plant Breeder's Rights Act 1994* (Plant Breeder's Rights Act) and subsection 231(1) of the *Trade Marks Act 1995* (Trade Marks Act) (collectively, 'the principal Acts') provide that the Governor-General may make regulations prescribing matters required or permitted by those principal Acts to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to those principal Acts.

The *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018* ('the Act') amended the principal Acts to implement recommendations from the Productivity Commission's (PC) 2016 inquiry into Australia's intellectual property ('IP') system, streamline and align processes, and provide for other high priority IP law amendments.

The principal Acts do not specify any conditions that must be met before the power to make the Regulations may be exercised.

### **Purpose and Operation of the Regulations**

The *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* ('the Regulations') amends the *Designs Regulations 2004* (Designs Regulations), the *Patents Regulations 1991* (Patents Regulations), the *Plant Breeder's Rights Regulations 1994* (Plant Breeder's Rights Regulations), and the *Trade Marks Regulations 1995* (Trade Marks Regulations) (collectively 'the principal Regulations') to prescribe matters required under the principal Acts as amended by the Act. The Regulations also amend the principal Regulations to align and streamline some processes involved with obtaining and maintaining IP rights.

The various Parts in Schedule 1 to the Regulations amend the Plant Breeder's Rights, Trade Marks and Patents Regulations as follows:

Part 1—Plant Breeder's Rights (PBR) in essentially derived varieties (EDV)

- provides for administrative details regarding a new process for EDV declarations

Part 2—Period to apply for removal of trade marks from Register for non-use

- ensures the new time period provided for in subsection 93(2) of the Trade Marks Act also applies to international trade mark applications

Part 3—Notification of extension of standard patents relating to pharmaceutical substances

- makes a consequential amendment as a result of the repeal of section 76A of the Patents Act

The various Parts in Schedule 2 to the Regulations amend the principal Regulations as follows:

Part 1—Extensions of time

- prescribes matters for extensions of time for filing notices of intention to defend

Part 2—Written requirements

- removes requirements for giving notice in writing, as a consequence of new provisions in the principal Acts that permit notification by any means of communication (including by electronic means)
- requires the Registrar of Trade Marks to publish the fact of withdrawal of an application, notice or request in the Official Journal

Part 3—Filing requirements

- outlines the consequences for providing information to IP Australia when the information does not comply with a direction
- makes consequential amendments due to amendments to the principal Acts regarding the filing of documents and payment of fees

Part 4— Protection resulting from the international registration of a trade mark

- corrects references that relate to International Registrations Designating Australia (IRDAs)

Part 5—Signatures

- removes the requirements for two types of documents to be signed

Part 6—Addresses and service of documents

- repeals provisions that provide for addresses for correspondence
- removes requirements for serving or filing of documents that are inconsistent with

changes introduced by Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

Part 7—Requirements for patent documents

- replaces formality requirements in the Patents Regulations (including those in Schedule 3) with requirements to comply with new provisions in the Patents Act. This includes new section 229, which enables the Commissioner of Patents to issue an instrument determining formality requirements
- enables patent specifications to use graphics and/or photographs to describe inventions

Part 8—Acceptance of trade marks applications

- amends the Trade Marks Regulations to allow applicants that are granted an extension of time for acceptance of a trade mark to submit a request for deferment of acceptance during that extended period

Part 9—Copies of design representations

- replaces the requirement to file five copies of design representations with a requirement that at least one of each representation of the design be filed

Part 10—Amendments of registered trade mark due to inconsistency with international agreements

- reinstates procedures for conducting an opposition to amendments made to a registered trade mark to overcome an inconsistency with international agreements
- includes a small number of references that were inadvertently missed in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* relating to trade mark oppositions

Part 11—Secretary’s role in the Plant Breeder’s Rights Regulations

- transfers the powers of the Secretary of the Department of Industry, Innovation and Science to the Registrar of PBR

Part 12—Other amendments

- repeals the definition of Norfolk Island in Part 13 of the Trade Marks Regulations, as the reference is no longer correct

Part 13—Application, transitional and saving provisions

- sets out how the amendments in Schedules 1 and 2 to the Regulations will apply in certain circumstances; and saves the operation of any repealed provisions, as necessary

Details of the Regulations are set out in the [Attachment](#).

## **Consultation**

From November 2016 to February 2017, IP Australia sought public comment on proposed changes to IP processes through an exposure draft of the Intellectual Property Laws Amendment Bill 2017 and the Intellectual Property Laws Amendment Regulations 2017. Seventeen non-confidential submissions were received. However, legislative proposals in this exposure draft were put on hold until the Government had finalised its response to the Productivity Commission's report into Australia's IP arrangements.

Following the Government's response to the Productivity Commission's inquiry into Australia's IP arrangements, and taking into account feedback received during the consultation, IP Australia reprioritised the proposals from the exposure draft bill and regulations. Those proposals that were given high priority, along with the recommendations from the PC that were ready for immediate implementation, were included in a revised exposure draft bill and regulations.

Consultation on the revised exposure draft of the bill and regulations was then undertaken from October to December 2017. Nineteen non-confidential submissions were received. Minor amendments were made to Part 1 of Schedule 1 to the Regulations as a result of stakeholder feedback. The provisions relating to the innovation patent were also removed from the Bill and Regulations after the Government's decision to undertake further consultation targeted at better understanding the needs of innovative small-to-medium-sized enterprises.

Information on the progress of those proposals which were not included in the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Bill 2018 and Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018 is available on IP Australia's policy register.<sup>1</sup>

## **Regulatory Impact**

The Office of Best Practice Regulation 'OBPR' has advised that no Regulation Impact Statement is required to be prepared for the amendments. The OBPR reference numbers are provided below.

### Schedule 1

- Parts 1 to 3: 21654

### Schedule 2

- Part 1—Extensions of time: 17734
- Part 2—Written requirements: 17570
- Part 3—Filing requirements: 17573
- Part 4—Protection resulting from the international registration of a trade mark: 17734
- Part 5—Signatures: 17576

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<sup>1</sup> IP Australia Policy Register, accessible at: <https://www.ipaustralia.gov.au/policy-register>

- Part 6—Addresses and service of documents: 17734
- Part 7—Requirements for patent documents: 17578
- Part 8—Acceptance of trade marks applications: 17734
- Part 9—Copies of design representations: 17567
- Part 10—Amendments of registered trade mark due to inconsistency with international agreements: 21007
- Part 11—Secretary’s role in the Plant Breeder’s Rights Regulations: 19009
- Part 12—Other amendments: 17734

### **Commencement of the Regulations**

The commencement arrangements for each of the Parts of Schedules 1 and 2 are set out in the commencement table at Section 2 of the Regulations. The items in Parts 1 and 2 of Schedule 1 and Parts 2, 3, 6, 7, 10 and 11 of Schedule 2 to the Regulations are intended to operate in conjunction with the corresponding items in the Act, so the commencement provisions for the relevant items are aligned with the Act.

The commencement of Part 1 of Schedule 2 to the Regulations has been tied to Part 2 of Schedule 1 to the Act, despite the subject matter being unrelated, to ensure that it has the same delayed commencement period. This will mean that those changes in Part 1 of Schedule 2 will commence either on a day fixed by proclamation or six months after the day after Royal Assent. This ensures that both users of the IP system, and IP Australia, have sufficient time to plan for and implement these changes.

The items under Part 3 of Schedule 1, and Parts 4, 5, 8, 9, 12 and 13 of Schedule 2 to the Regulations do not require any prior planning from users of the IP system (and users do not need prior notice of the start date of these changes). The items under these Parts will commence the day after the Regulations are registered on the Federal Register of Legislation.

The Regulations are a legislative instrument for the purposes of the *Legislation Act 2003*.

Details of the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*

Section 1 – Name

This section provides that the title of the Regulations is the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*.

Section 2 – Commencement

This section provides that a number of the provisions in the Regulations commence at the same time as corresponding Parts in the Act. In the Act this is a single day to be fixed by proclamation. However, if the provisions do not commence within the period of 6 months beginning on the day the Act receives the Royal Assent, they commence on the day after the end of that period. These provisions are:

- Schedule 1, Part 1 relating to PBR in essentially derived varieties
- Schedule 1, Part 2 relating to period to apply for removal of protected international trade marks from Register for non-use
- Schedule 2, Part 1 relating to extensions of time
- Schedule 2, Part 2 relating to written requirements
- Schedule 2, Part 3 relating to filing requirements
- Schedule 2, Part 6 relating to addresses and service of documents
- Schedule 2, Part 7 relating to requirements for patent documents
- Schedule 2, Part 10 relating to amendments of registered trade mark due to inconsistency with international agreements
- Schedule 2, Part 11 relating to Secretary's role in the plant breeder's rights regulations

The remaining provisions commence the day after the Regulations are registered. These provisions are:

- Schedule 1, Part 3 relating to notification of extension of standard patents relating to pharmaceutical substances
- Schedule 2, Part 4 relating to protection resulting from the intentional registration of a trade mark
- Schedule 2, Part 5 relating to signatures
- Schedule 2, Part 8 relating to acceptance of trade mark applications
- Schedule 2, Part 9 relating to copies of design representations
- Schedule 2, Part 12 relating to other amendments
- Schedule 2, Part 13 relating to application, transitional and saving provisions

### Section 3 – Authority

This section provides that the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* is made under the *Designs Act 2003*, the *Patents Act 1990*, the *Plant Breeder's Rights Act 1994*, and the *Trade Marks Act 1995*.

### Section 4 – Schedules

This section provides that each instrument that is specified in a Schedule to this instrument is amended or repealed as set out in the applicable items in the Schedule concerned, and any other item in a Schedule to this instrument has effect according to its terms.

### **Schedule 1—Responses to the Productivity Commission**

#### **Part 1—PBR in essentially derived varieties**

This Part amends the Plant Breeder's Rights Regulations to implement certain administrative details regarding the process for considering an application to declare that a non-PBR-protected variety is an EDV.

Part 2 of Schedule 1 to the Act implements a process for making an EDV declaration for a non-PBR-protected variety. To help ensure procedural fairness to all parties, the Act provides that the second breeder must be notified, details of the application for a declaration must be published, and any interested person must have an opportunity to be heard before a decision is made. The procedure for the publication and hearing processes is prescribed in the regulations.

#### *Plant Breeder's Rights Regulations 1994*

##### Item 1: PBR in essentially derived varieties

Regulations 3BA and 3BB provide the administrative procedures for the publication and hearing processes associated with an application for a declaration for a non-PBR-protected variety.

The *Plant Varieties Journal* (the Journal) is intended to be the public resource where anyone can obtain information about EDV applications that they may have an interest in. People notified under new subsection 41A(6) of the Plant Breeder's Rights Act, are notified that the application will be published in the Journal: see subsection 41A(7). Similarly, any other member of the public, such as an interested competitor, would be expected to monitor the Journal if they wished to be kept abreast of EDV applications of potential interest. As such, the requirement for the Registrar to publish the details of the application under new section 41B plays a key role in ensuring procedural fairness to all parties.

Under subsection 41B(1) of the Plant Breeder's Rights Act, the Registrar must publish a notification of the application for a declaration in the Journal, along with any prescribed information. Regulation 3BA prescribes additional information that must be published.

The Registrar must publish a description of both the initial variety and the second variety (paragraph 3BA(a)). This ensures that an interested person (e.g., a competitor in the plant industry) has sufficient information to be able to determine if an application for a declaration relates to a variety that they have an interest in.

The Registrar must publish details of both the applicant for a declaration and the person the applicant reasonably believes to be the breeder of the second variety (paragraph 3BA(b)). This ensures that an interested person has enough information to determine who is involved. In particular, the applicant for a declaration may incorrectly identify the second breeder on the application, so this publication provides the opportunity for others to be informed that this matter is in dispute.

The Registrar must publish any other relevant information that they possess (other than commercial-in-confidence information) (paragraph 3BA(c)).

The Registrar must also publish details for how an interested party can participate in the proceedings and the consequences if they fail to so participate (paragraph 3BA(d) and (e)). The consequences are that if the notified person does not participate in the proceedings the Registrar may draw an inference that is unfavourable to their interest in deciding the application for a declaration. This ensures that the notified person is aware that a failure to participate in proceedings or provide written or oral submissions may increase the likelihood that the Registrar makes a decision to make an EDV declaration. This provides an incentive for the notified person to participate if they have a genuine interest in how the matter is resolved.

Under subsection 41C(1) of the Plant Breeder's Rights Act the Registrar must give any interested person an opportunity to be heard. Regulation 3BB provides the administrative procedure for an interested person to provide information, under subsection 41C(4). Under subregulation 3BB(2), information is given by an interested person in accordance with their opportunity to be heard if they make a submission (written or oral), pay any prescribed fee, and comply with any other aspect of the regulation. Currently no fee is prescribed. The requirement to comply with other aspects of the regulation provides a consequence if an interested person does not comply with the hearing procedures and directions given in accordance with the subregulations below.

The Registrar decides how the interested person may be heard (subregulation 3BB(3)). The Registrar can request that the interested person provides written submissions. The Registrar can hear the person orally if the person requests a hearing or they can decide to hold a hearing on a particular date and notify the interested person to attend on that date. In any event, the Registrar must give at least 10 business days for the person to prepare.

The Registrar may convene an oral hearing (subregulation 3BB(4)), and manage the procedural aspects of the hearing (subregulations 3BB(5) and (6)). The Registrar may hold a hearing in-person or by telephone or other means. The Registrar can adjourn the proceedings and require the person to provide a summary of submissions beforehand. The Registrar also has a power to direct persons attending the hearing to ensure that the hearing operates efficiently and effectively. These provisions are largely based on the existing provisions governing hearings in regulations 22.22 to 22.24 of the Patents Regulations.

#### Item 2: Fees of essentially derived varieties application

This item amends the existing fee item for filing an application for a declaration to extend the fee to an application for a declaration for a non-PBR-protected second variety under the new subsection 41A(2). The amount of the fee remains the same.

### **Part 2—Period to apply for removal of protected international trade marks from Register for non-use**

This Part contains amendments to the Trade Marks Regulations to ensure the changes made to the period provided under subsection 93(2) of the Trade Marks Act in Part 3 of Schedule 1 to the Act will also apply to international trade marks filed through the system established under the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol). It also contains amendments to correct drafting errors in the Trade Marks Regulations.

#### *Trade Marks Regulations 1995*

#### Item 3: Cessation of protection

This item amends paragraph 17A.48D(2)(g) to correct a drafting oversight. The ‘filing date’ mentioned in this provision should refer to the filing date of an application for a trade mark, rather than to the filing date of the registration of the trade mark.

#### Item 4: Cessation of protection - incorrect reference

This item amends subparagraph 17A.48D(2)(g)(ii) to replace an incorrect reference to Article 3<sup>ter</sup> 2(2) with a reference to Article 3<sup>ter</sup> (2).

#### Item 5: Cessation of protection

This item adds a new paragraph to subregulation 17A.48D(2) of the Trade Marks Regulations.

Regulation 17A.48D provides for the application of Part 9 of the Trade Marks Act and Part 9 of the Regulations (Removal of trade mark from Register for non-use) to international applications filed through the Madrid Protocol.

Subregulation 17A.48D(2) clarifies how specific provisions in Part 9 of the Trade Marks Act and Regulations should be read in order to apply to international applications. New paragraph 17A.48D(2)(h) provides that a reference to ‘the date the particulars of the trade mark were entered into the Register under section 69’ should be taken to be a reference to ‘the date the trade mark became a protected international trade mark under regulation 17A.36’. These two dates are equivalent for the purposes of applying Part 9 of the Trade Marks Act and Regulations to international trade marks. This amendment will ensure the period for filing a non-use application is the same for domestic and international trade mark applications.

### **Part 3—Notification of extension of standard patents relating to pharmaceutical substances**

#### *Patents Regulations 1991*

##### Item 6: Prescribed acts

This item amends regulation 22.10AC as a consequence of the repeal of section 76A of the Patents Act by the Act. Regulation 22.10AC prescribes acts for the purposes of subsection 222A(7) of the Patents Act, which includes at paragraph 22.10AC(a) ‘lodging a return under section 76A’. This item repeals and replaces regulation 22.10AC with a new provision that does not include reference to section 76A.

### **Schedule 2—Other Measures**

#### **Part 1—Extensions of time**

This Part amends the Trade Marks Regulations to prescribe matters for extensions of time for filing a notice of intention to defend. This ensures that extensions of time are granted promptly when they are warranted, taking the public interest into account.

#### *Trade Marks Regulations 1995*

##### Items 1, 3, 5 and 7: Extensions of time for filing a notice of intention to defend

Section 52A of the Trade Marks Act provides that if a notice of opposition is filed, in accordance with section 52 of the Trade Marks Act, an applicant may file a notice of intention to defend. Failure to file a notice of intention to defend within the prescribed period, or that period as extended, will result in the application lapsing under section 54A of the Trade Marks Act.

Item 1 inserts new regulations 5.13A and 5.13B which set out how and when an application for an extension of time to file a notice of intention to defend (‘the extension application’) must be filed and under what circumstances the Registrar may grant the extension application.

New subregulation 5.13A(1) enables a person to apply for an extension of time for filing a notice of intention to defend under subsection 52A(1).

New subregulation 5.13A(2) provides the extension application must be made within three months from when the applicant was given a copy of the statement of grounds and particulars.

New subregulation 5.13A(3) provides that the extension application must be in the approved form and be accompanied by a declaration stating the relevant facts and circumstances.

New subregulation 5.13A(4) provides the limited grounds on which an extension may be sought. An applicant can only seek an extension on either or both of the following grounds: if an error or omission was made by the applicant (or their agent), the Registrar or an employee; or, if there were circumstances beyond the control of the person.

New subregulation 5.13B(1) allows the Registrar some discretion to refuse or grant an extension application under new subregulation 5.13A(1) – the Registrar may only grant the application if satisfied that it is justified.

New subregulation 5.13B(2) provides that the Registrar can only grant an extension application that is filed after the period provided in subregulation 5.13(1), i.e. one month after the applicant received the statement of grounds and particulars, if the Registrar is satisfied there is sufficient reason for the delay in making the application.

New subregulation 5.13B(3) requires the Registrar to decide the length of the extended period for filing a notice of intention to defend according to what is reasonable in the circumstances. These amendments ensure that later extension applications are granted only when they are warranted.

Item 3 inserts corresponding provisions (new regulations 9.15A and 9.15B) to prescribe matters relating to extension of time applications for filing the notice of intention to defend if there is an application to remove a trade mark from the Register for non-use.

Item 5 inserts corresponding provisions (new regulations 17A.34HA and 17A.34HB) to prescribe matters relating to extension of time applications for filing the notice of intention to defend when a person opposes the extension of protection to Australia from an international registration of a trade mark.

Item 7 inserts corresponding provisions (new regulations 17A.48QA and 17A.48QB) to prescribe matters relating to extension of time applications for filing the notice of intention to defend when a person applies for cessation of protection of a protected international trade mark for non-use.

#### Items 2, 4 and 6: References to extension of time

These items amend subregulations 9.15(3), 17A.34H(4) and 17A.48Q(3) to clarify that the period for filing the notice of intention to defend can be extended.

#### Items 8, 9 and 10: Prescribed acts and documents for extensions of time

Item 8 amends subregulation 21.28(1) to replace an incorrect reference to regulation 17.48P with a reference to regulation 17.48R.

Items 9 and 10 amend subregulation 21.28(2) to include a notice of intention to defend as a prescribed document.

#### Items 11 to 14: Fees for Extension Applications

These items amend item 6 in the fee table under Schedule 9 to include references to the new regulations related to extension applications for filing a notice of intention to defend (regulations 5.13A, 9.15A, 17A.34HA and 17A.48QA).

### **Part 2—Written requirements**

This Part amends the principal Regulations to:

- remove requirements for giving notice in writing, as a consequence of new provisions in the principal Acts that permit notification by any means of communication (including by electronic means)
- require the Registrar of Trade Marks to publish the fact of withdrawal of an application, notice or request in the Official Journal

The amendments will provide greater flexibility for IP Australia when communicating with customers (for example by allowing electronic communication).

#### *Designs Regulations 2004*

#### Item 15: Notice – minimum filing requirements

This item repeals regulation 3.03 as it is no longer required. Regulation 3.03 prescribes how a notice under section 24 of the Designs Act may be sent and the content of the notice. However, the requirement of giving written notice in section 24 of the Designs Act has been replaced by simply notifying the applicant. The information the ‘notification’ should contain is already provided by new subsections 24(2) and (3) of the Designs Act.

#### Items 16 to 33: Notification

Items 19, 29, 32 and 33 amend subregulations 5.03(2), 9.05(3), 11.23(2) and regulation 11.28 to replace ‘give notice’ with ‘notify’ or ‘notification’.

Notifications by the Registrar must be given in accordance with new section 144D of the Designs Act. This provides that notification can be provided by any means of communication, including electronically.

Item 26 amends subparagraph 5.04(b)(ii) to substitute ‘written notice’ with ‘a notification’ and item 23 amends subsection 5.03(8) to substitute ‘send a copy of the notice’ with ‘give a

copy of the notification'. These are consequential amendments as the requirement that the Registrar must 'give written notice' has been replaced by the requirement to 'notify' in regulations 5.03 and 5.04 as per the amendments to subsection 66(2) of the Designs Act.

The remaining items that amend the Designs Regulations in this Part replace the term 'notice' with the more general term 'notification'. This is consistent with changes in the Designs Act to give IP Australia more flexibility in communication means into the future.

#### *Patents Regulations 1991*

##### Items 34 to 37, 46, 47, 53 to 56: Notify

These items substitute the terms 'tell', 'advise' and 'inform' with 'notify', to use more modern and consistent drafting language.

Item 54 also amends subregulation 3.25H(1) to remove the requirement for a notice to be given 'in writing' when the Commissioner informs relevant persons about his or her decision on a certification request for micro-organisms. The Commissioner may instead 'notify' the relevant persons (by any means of communication including electronically) in accordance with new section 220A of the Patents Act.

##### Items 38 to 45, 57 and 58: Notification

Items 38 and 42 remove the requirement for the Commissioner to give the applicant notice 'in writing' about missing information in a filing. Items 57 and 58 remove the requirement for the Commissioner to notify the applicant 'in writing' of matters in relation to a hearing on an innovation patent. In these cases the Commissioner is now required to do so by 'notifying the applicant'. This is consistent with changes in the Patents Act to give IP Australia more flexibility in communication means into the future.

The remaining items are consequential amendments as a result of items 38 and 42.

##### Items 48 to 52: Notify

Items 48 and 50 remove the requirement for the Commissioner to give relevant persons a notice 'in writing' about certain decisions in respect of micro-organism samples. Instead, the Commissioner may 'notify' or 'invite' relevant persons (by any means of communication, including electronic).

Items 49, 51 and 52 make consequential amendments as a result of 'notice' being replaced with 'notification'.

#### *Plant Breeder's Rights Regulations 1994*

##### Items 59 and 60: Notify

These items remove the requirement for the Registrar to give notices about certain decisions to relevant persons in ‘written’ form. The Registrar may simply ‘notify’ relevant persons instead. Notifications may be given by any means of communication (including by electronic means) as provided by new section 72A of the Plant Breeder’s Rights Act. This is consistent with changes in the Plant Breeder’s Rights Act to give IP Australia more flexibility in communication means into the future.

#### *Trade Marks Regulations 1995*

##### Items 67 to 78, 87, 88, 90 to 105 and 107 to 110: Notify

These items remove the requirement for the Registrar to give a notice to relevant persons about certain decisions or events in written form. The Registrar may ‘notify’ the relevant persons instead, by any means of communication (including by electronic means), as provided by new section 214A of the Trade Marks Act. This is consistent with changes in the Trade Marks Act to give IP Australia more flexibility in communication means into the future.

Consequently all occurrences of ‘notice’ are replaced by ‘notification’ and all requirements for notifications to be in writing have been omitted.

##### Items 79 to 85 and 89: Notification

These items make consequential amendments as a result of ‘notice’ being replaced by ‘notification’ in the Trade Marks Act.

##### Item 86: Regulation 8.1A

This item repeals a redundant regulation because the provisions are set out in amended subsection 84A(4) of the Trade Marks Act.

##### Item 106: Notification of withdrawal of application etc.

This item replaces regulation 21.10 because the current regulation is unclear about who must be informed about a withdrawal of an application, notice or request. The amendment addresses this by inserting a requirement to publish the fact of the withdrawal in the Official Journal. This also has the benefit of aligning with the publication requirements for the other IP rights for withdrawals.

### **Part 3—Filing requirements**

This Part amends the principal Regulations to:

- outline the consequences for providing information to IP Australia when the information does not comply with a direction
- make consequential amendments due to amendments to the principal Acts regarding

the filing of documents and payment of fees

The amendments will align the processes across the principal Regulations.

*Designs Regulations 2004*

Items 111 to 113 and 117 to 119: Repeal of unnecessary provisions relating to document or evidence filing and the payment of fees

Under the Act, the Designs Act was amended such that the Registrar may direct, by published determination or direction, how documents or evidence can be filed and fees are paid. These amendments cover all forms of document or evidence filing and fee payment. As a result, these items amend the Designs Regulations by repealing provisions relating to the means or form by which documents or evidence can be filed and fees paid.

These items also make consequential amendments as a result of the repealed provisions to retitle the corresponding regulations appropriately.

Items 114 to 116: Publication of notices in the Official Journal

These items amend the Designs Regulations as a consequence of new sections 130A, 144A, 144B and 144C in the Designs Act. These sections require the Registrar, after determining the means of filing fees or the providing a direction as to the filing of documents or evidence, to publish a notice of his or her determination or direction in accordance with the regulations.

Consequently, items 114 to 116 introduce the requirement that publication must be in the Official Journal.

Items 120 and 121: Non-compliance in relation to form of filing of documents

These items amend the Designs Regulations as a consequence of new section 144B of the Designs Act. Section 144B allows the Registrar to direct the form in which documents are to be filed, but does not specify any consequences if the documents are not in the specified form.

These items amend regulation 11.27, which provides the consequences of filing documents in a non-compliant form. The amendments specify that documents must, in addition to substantially complying with Schedule 2, be filed in accordance with a direction of the Registrar under section 144B of the Designs Act (if any).

Item 122: Non-compliance with the Registrar's direction in relation to filing evidence

This item amends the Designs Regulations as a consequence of new section 144C of the Designs Act. Section 144C allows the Registrar to direct the number of copies of evidence to be filed and the form and means by which evidence is to be filed, but does not specify any consequence if the evidence does not comply with the Registrar's directions.

This item introduces new regulation 11.27A, which provides a consequence for filing evidence that is not compliant with the Registrar's direction under the new section 144C of the Designs Act. It provides that the Registrar may treat non-compliant evidence as not having been filed, or may direct the person filing the evidence to correct the non-compliance.

#### Item 123: Costs

This item amends Schedule 4 to the Designs Regulations to replace references to 'approved means' with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 111 of this Part and the inclusion of the new definition of 'preferred means' in the Designs Act.

#### *Patents Regulations 1991*

#### Items 124 to 132 and 136: Repeal of unnecessary provisions relating to document or evidence filing and the payment of fees

Part 3 of Schedule 2 to the Act amended the Patents Act to enable the Commissioner to direct, by published determination or direction, how documents or evidence can be filed and fees paid. These amendments will cover all forms of document or evidence filing and fee payment. As a result, these items amend the Patents Regulations by repealing the provisions relating to the means or form by which documents or evidence can be filed and fees paid.

These items also retitle the corresponding regulations appropriately. In addition, item 131 repeals subregulation 22.12(1) and item 132 amends subregulation 22.12(2) as a consequence of new section 214C in the Patents Act.

#### Items 133 to 135: Non-compliance in relation to form of filing of documents

These items amend the Patents Regulations as a consequence of new section 214B of the Patents Act. Section 214B allows the Commissioner to direct the form in which documents may be filed, but does not specify any consequences if the documents are not in the specified form.

Item 134 amends regulation 22.15 which deals with the requirements for the filing of documents. The amendments provide that the English language documents must be in the form specified in a direction under section 214B of Patents Act (if any).

Items 133 and 135 make amendments to the title of regulations 22.15 and 22.16, respectively, to make it clear that the regulations deal with requirements for filing documents (regulation 22.15) and the consequence of documents not meeting filing requirements (regulation 22.16).

#### Item 137: Non-compliance with the Commissioner's direction in relation to filing evidence

This item amends the Patents Regulations as a consequence of new section 214C of the Patents Act. Section 214C allows the Commissioner to direct the number of copies of evidence to be filed and the form and means by which evidence is to be filed, but does not

specify any consequence if the evidence does not comply with the Commissioner's directions.

This item introduces new regulation 22.16A which provides a consequence for filing evidence that is not compliant with the Commissioner's direction under the new section 214C of the Patents Act. It provides that the Commissioner may treat non-compliant evidence as not having been filed, or may direct the person filing the evidence to correct the non-compliance. It also provides that if the Commissioner treats the evidence as not having been filed the Commissioner is to notify the person who filed the non-compliant evidence.

#### Item 138: Fees

This item replaces references to 'approved means' in Schedule 7 to the Patents Regulations with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 124 of this Part and the inclusion of the new definition of 'preferred means' in the Patents Act.

#### *Plant Breeder's Rights Regulations 1994*

#### Items 139 and 140: Repeal of unnecessary definition and provision relating to actions

Part 3 of Schedule 2 to the Act amended the Plant Breeder's Rights Act to enable the Registrar to make a determination as to how documents can be filed or fees paid. As a result, these items amend the Plant Breeder's Rights Regulations by repealing provisions relating to the 'approved means' of doing an action listed in Schedule 1, such as the payment of fees or the filing of documents.

#### Item 141: Table of fees

This item replaces references to 'approved means' in Schedule 1 to the Plant Breeder's Rights Regulations with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 139 of this Part and the inclusion of the new definition of 'preferred means' in the Plant Breeder's Rights Act.

#### *Trade Marks Regulations 1995*

#### Items 142, 143, 148 to 152, 154 to 156: Repeal of unnecessary provisions relating to document or evidence filing and the payment of fees

Part 3 of Schedule 2 to the Act amended the Trade Marks Act to enable the Registrar to direct, by published determination or direction, how documents or evidence can be filed and fees paid. These amendments cover all forms of document or evidence filing and fee payment. As a result, these items amend the Trade Marks Regulations by repealing provisions relating to the means or form by which documents or evidence can be filed and fees are paid.

These items also retitle or renumber the corresponding regulations appropriately. In addition, item 149 repeals subregulation 21.17(1) and item 150 amends subregulation 21.17(2) as a consequence of new section 213C into the Trade Marks Act.

Item 144: Requirements for filing documents

This item amends regulation 21.2, which requires that documents filed with the Trade Marks Office must comply with the requirements of Schedule 7 to the Trade Marks Regulations. Schedule 7 is repealed by item 156 of this Part and the Act introduced new section 213B into the Trade Marks Act to allow the Registrar to give a direction on the form in which documents may be filed. This item amends regulation 21.2 to specify some minimal filing requirements and require that documents must comply with directions issued by the Registrar under section 213B of the Trade Marks Act (if any).

Item 145: Consequences for documents not meeting filing requirements

This item amends the Trade Marks Regulations as a consequence of new section 213B of the Trade Marks Act. Section 213B allows the Registrar to direct the form in which documents may be filed, but does not specify any consequence if the documents are not in the specified form.

The item amends regulation 21.4 which deals with the consequences for documents not meeting filing requirements. It provides that the Registrar may treat a non-compliant document as not having been filed or direct the person filing the document to correct the non-compliance. It also provides that if the Registrar treats the evidence as not having been filed the Registrar is to notify the person who filed the non-compliant evidence.

Item 146: Removal of facsimile as a means of filing documents

Filing by facsimile has not been an approved means of filing documents with the Registrar since 2014, except in limited circumstances where both online services and other lodgement services are unavailable.

Subregulation 21.5 requires the marking of the date of receipt on documents when the Trade Mark Office receives them by means other than electronic filing or filing by facsimile. The reference to facsimile creates uncertainty by suggesting it is available as an approved means of filing documents in all circumstances. This item removes any ambiguity by removing the reference to 'facsimile' from subregulation 21.5(2). Filing by facsimile will still be available in limited circumstances where both online services and other lodgement services are unavailable.

Item 147: Non-compliance with the Registrar's direction in relation to filing evidence

This item amends the Trade Marks Regulations as a consequence of the introduction of section 213C of the Trade Marks Act by the Amendment Act. Section 213C allows the

Registrar to direct the form and means by which evidence may be filed, but does not specify any consequence if the evidence does not meet the filing requirements.

The item introduces new regulation 21.5A which deals with the consequences of filing evidence that does not comply with the Registrar's direction. It provides that the Registrar may treat non-compliant evidence as not having been filed, or may direct the person filing the evidence to correct the non-compliance. It also provides that if the Registrar treats the evidence as not having been filed the Registrar is to notify the person who filed the non-compliant evidence.

#### Item 153: Explanatory note regarding how fees are paid

This item adds a note to regulation 21.22 to direct the reader to the relevant subsections of the Trade Marks Act for details on how fees are to be paid to the Registrar.

#### Item 157: Fees

This item replaces the references to 'approved means' in Schedule 9 to the Trade Marks Regulations with references to 'preferred means'. These amendments are a consequence of the repeal of the definition of 'approved means' by item 142 of this Part and the inclusion of the new definition of 'preferred means' in the Trade Marks Act.

### **Part 4—Protection resulting from the international registration of a trade mark**

This Part amends the Trade Marks Regulations to replace a number of incorrect references that relate to international registrations designating Australia (IRDAs).

#### *Trade Marks Regulations 1995*

#### Items 158 to 184: References to IRDAs

These items correct a number of references to regulations that relate to IRDAs. In addition to updating references, items 165, 166, 167, 174, 175, 177, 178, 180 and 182 make some changes to the language of the regulations to clarify the meaning. The effects of the provisions are unchanged.

### **Part 5—Signatures**

This Part amends the Patents Regulations to remove the requirements for signing certain documents.

The amendments will streamline processes and will remove an unnecessary burden on applicants, patentees and opponents.

#### *Patents Regulations 1991*

#### Item 185: Request for patent of addition

This item amends paragraph 3.1(2)(g) to remove the need for patent applicants or patentees to sign the filed statement authorising another person to request a patent of addition.

Currently, if a request for a patent of addition is made by a person other than the applicant or patentee, then a statement authorising that person to make the request must be signed by the applicant or patentee and filed before acceptance. However, the requirement for a signature is unnecessary as the identity and authority of the person in question can be confirmed from other information in the documentation, and so places an undue burden on applicants for a patent of addition.

#### Item 186: Withdrawal of opposition

This item amends subregulation 5.26(1) by removing the need for an opponent wishing to withdraw an opposition to sign the notice of withdrawal.

The requirement for a signature is unnecessary, as discussed at item 185 above, and places an undue burden on opponents.

### **Part 6—Addresses and service of documents**

This Part amends the Patents, Trade Marks and Designs Regulations to:

- repeal provisions that provide for addresses for correspondence
- remove requirements for serving or filing of documents that are inconsistent with changes introduced by Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*

These amendments will clarify and simplify the processes, remove inconsistencies and improve efficiency.

#### *Designs Regulations 2004*

#### Item 187: Service of documents

This item amends regulation 11.19 to repeal requirements to serve and file copies of notices and documents with other opposition parties or the Registrar. Subregulations 11.19(3) and (4) are no longer necessary as a consequence of amendments made regarding the service of opposition documents by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*, which removed the requirements for parties to serve documents on each other.

#### Item 188: Address for correspondence

This item repeals regulation 11.20 to remove the requirements for an address for correspondence. The address information required to contact applicants will be required by the approved form. This amendment simplifies the address requirements in the legislation.

### *Patents Regulations 1991*

#### Item 189: Address for service

This item repeals subregulation 22.10(4) to remove the requirement to file copies of notices and documents with the Commissioner. These requirements are no longer necessary as a consequence of amendments made regarding the service of opposition documents by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

#### Item 190: Address for correspondence

This item repeals regulation 22.10A to remove the requirement for an address for correspondence. The address information required to contact applicants will be required by the approved form. This amendment simplifies the address requirements in the legislation.

### *Trade Marks Regulations 1995*

#### Item 191: Service of documents

This item amends subregulation 8.4(3) to establish that it is the responsibility of the Registrar to give a copy of the opposition notice to the registered owner of the trade mark. This is consistent with the changes made regarding service of documents by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

## **Part 7—Requirements for patent documents**

This Part amends the Patents Regulations to:

- replace formality requirements in the Patents Regulations (including those in Schedule 3) with requirements to comply with new provisions in the Patents Act. This includes new section 229, which enables the Commissioner of Patents to issue an instrument determining formality requirements
- enable patent specifications to use graphics and/or photographs to describe inventions

The amendments will allow applicants to use colour drawings at a future date to better describe their inventions and will ensure the legislation remains aligned with Australia's international obligations.

### *Patents Regulations 1991*

#### Item 192: Provisional application – direction to meet formalities requirements

The Act has consolidated all requirements for patent applications and specifications in section 29 of the Patents Act. It also enables the Commissioner to prescribe the formalities requirements for a patent request in relation to complete applications and specifications in a

(non-legislative) instrument made under new section 229 of the Patents Act, rather than being set out in Schedule 3 to the Patents Regulations.

As a consequence, regulation 3.2 has been amended by this item to remove requirements for provisional specifications, which are now covered by the reference to subsection 29(4) of the Patents Act. It also renames the regulation to reflect its changed purpose.

Items 193 to 196: Complete application for standard patent—direction to meet formalities requirements

These items amend regulation 3.2A in light of the repeal of Schedule 3 to the Patents Regulations, consolidation of all requirements for patent applications and specifications in section 29 of the Patents Act and the introduction of section 229 to the Patents Act.

Item 193 substitutes a new heading to reflect the changed purpose of regulation 3.2A. Item 194 replaces subregulations 3.2A(1) to (3) with new subregulations 3.2A(1) and (2). This removes the formalities requirements, which are now provided for in new subsections 29(4A) and (4B) of the Patents Act, and introduces references to the requirements of those new subsections.

Items 195 and 196 make consequential changes to references in regulation 3.2A due to the repeal of subregulation 3.2A(3).

Item 197: Specifications—formalities check for innovation patents

Regulation 3.2B concerns the formalities requirements for innovation patents. As a consequence of the consolidation of the formalities requirements in section 29 of the Patents Act, this item replaces two paragraphs of subregulation 3.2B(1) to remove requirements from the regulations and instead reference new subsections 29(4A) and 29(4B) of the Patents Act.

Items 198 to 201: Specifications—formalities check for PCT applications

These items amend regulation 3.2C regarding the requirements for PCT patent documents, as a consequence of the changes to the formality requirements in the Patents Act.

Item 198 clarifies the wording of subregulation 3.2C(1) without changing its effect.

Item 199 amends subregulation 3.2C(3) to provide that the PCT application must comply with the formalities requirements set out in an instrument under new section 229 instead of in Schedule 3 to the Patents Regulations. Notably, the PCT application must “comply” with the formalities requirements determined in an instrument under section 229 of the Act, as opposed to “substantially comply” with the requirements of Schedule 3.

Items 200 and 201 amend subregulation 3.2C(4) to clarify the wording without changing its effect.

Items 202 to 206: Inclusion of graphics and photographs

These items amend regulations 3.3, 3.5 and 3.5AC, following changes made to the Patents Act to allow specifications to include graphics and photographs.

Items 207 and 208: PCT applications—prescribed requirements

The Act has consolidated all requirements for patent applications and specifications in section 29 of the Patents Act. The requirements for complete applications and specifications are now be set out in new subsections 29(4A) and (4B) of the Patents Act.

Regulation 3.5AD sets out the relevant prescribed requirements for PCT applications. Item 207 amends paragraph 3.5AD(a) to delete a reference to subsection 29(4) and replace it with references to new subsections 29(4A) and (4B). Item 208 removes paragraphs (c) and (d) in regulation 3.5AD. The requirements formerly set out in those paragraphs are now covered in new subsections 29(4A) and (4B) of the Patents Act.

This amendment ensures that PCT applications that enter the national phase in Australia will be required to meet the same formality requirements as non-PCT applications.

Item 209: Report of Commissioner—examination

This item amends regulation 3.18 as a consequence of changes made to subregulation 3.2C(3) by item 199. Regulation 3.18 prescribes those matters that the Commissioner must address in a patent report, in addition to those listed in subsection 45(1) of the Patents Act. This item amends paragraph 3.18(2)(f) to prescribe that the Commissioner must report on whether, to the best of his or her knowledge, the requirements of subregulations 3.2C(2) and (3) have been met in respect of a PCT application.

Item 210: Notice that specification is open to public inspection

This item amends paragraph 4.2(2)(c) to omit the reference to subregulation 3.2A(2) and substitute it with new subregulation 3.2A(1), as a consequence of changes made by item 194.

Item 211: Form of amendments

This item repeals subregulation 10.1(2) to remove the requirement for an applicant or patentee to file two copies of documents (or parts of documents) in instances where amendments have been requested by means of substituting a document or part of a document.

Item 212: Form of amendments

This item repeals paragraph 10.2(1)(a) to remove the reference to compliance with Schedule 3 to the Patents Regulations and replaces it with a reference to the formalities requirements as determined in an instrument made under new section 229 of the Patents Act.

Item 213: Documents other than specifications and abstracts

This item removes the reference in subregulation 22.16(2) to a document not substantially complying with Schedule 3 to the Patents Regulations, and replaces this with a reference to the formalities requirements as determined in an instrument under new section 229 of the Patents Act.

Item 214: Formality requirements for documents

This item repeals Schedule 3 to the Patents Regulations, in line with the changes to the Patents Act that move patent formality requirement provisions from the Patents Regulations to the Patents Act.

**Part 8—Acceptance of trade mark applications**

This Part amends the Trade Marks Regulations to allow applicants that are granted an extension of time for acceptance of a trade mark to also submit a request for deferment of acceptance during that extended period.

Items 215 and 216: Time period for requesting deferment of acceptance

These items amend paragraphs 4.13(1)(a) and 17A.21(1)(a) so that if an applicant is granted an extension of time for the acceptance of a trade mark, the applicant will also be able to submit a request for deferment of acceptance during that extended period.

This is not presently possible, as paragraphs 4.13(1)(a) and 17A.21(1)(a) limit requests for deferment of acceptance to the period prescribed in subregulations 4.12(1) and 17A.20(1), respectively.

As a result, requests for deferment may become due before the end of the acceptance period. This can cause confusion for applicants and third parties, as the status of a deferment application can become unclear. It can also result in additional administrative costs, as applicants may file speculative requests for deferment without knowing whether their extension of time under section 224 of the Trade Marks Act will be accepted, or may have to file two requests under section 224 (one to extend the time for acceptance, and another to extend the time to request deferment).

These items address this problem by aligning the period in which deferment must be requested with the acceptance period, whether or not the acceptance period has been extended under regulation 4.12 or 17A.20 or section 224 of the Trade Marks Act.

**Part 9—Copies of design representations**

This Part amends the Designs Regulations to replace the outdated requirement to file five copies of each design in an application because design applications are now filed electronically or scanned upon receipt.

## *Designs Regulations 2004*

### Items 217 and 218: Multiple copies of design representations

These items amend paragraphs 4.04(1)(f) and 4.05(1)(f) of the Designs Regulations to require at least one of each representation of the design be included in a design application, as opposed to five.

When filing a design application for registration an application must undergo formalities check, the requirements for which are set out in regulations 4.04 and 4.05. One of the requirements of the formalities check is that a design application includes five copies of each representation.

This requirement was useful when applications were filed on paper and quality of representations was lost through reproduction. However, design applications are now filed electronically or scanned upon receipt, and as such, multiple copies of representations are no longer necessary.

### **Part 10—Amendments of registered trade mark due to inconsistency with international agreements**

This Part amends the Trade Marks Regulations to:

- reinstate procedures for conducting an opposition to amendments made to a registered trade mark to overcome an inconsistency with international agreements
- include a small number of references that were inadvertently missed in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* relating to trade mark oppositions

## *Trade Marks Regulations 1995*

### Item 219: Amendment due to inconsistency with international agreements – opposition proceedings

Under section 83A of the Trade Marks Act, the owners of registered trade marks may request amendments to their trade marks on a number of specified grounds. One of the grounds for requesting an amendment is in circumstances where using the trade mark would be inconsistent with an obligation of Australia under an international agreement. Where Australia agrees to new international obligations, the owners of previously registered marks that would be affected by the new obligations can request amendments to remove the inconsistency.

The Trade Marks Act allows other persons to oppose amendments on certain grounds. Subsection 83A(4) of the Trade Marks Act enables any person to oppose the granting of an amendment of a registered trade mark due to inconsistency with international agreements, on

the ground that the resulting trade mark would be too similar to a registered trade mark being used by the person for the same type of goods or services.

Regulation 8.5 of the Trade Marks Regulations is intended to set out the process for this type of opposition. However, due to a drafting error in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*, regulation 8.5 still refers to regulations 5.7 to 5.17, which were amended so that they only apply to ordinary trade mark oppositions.

This item repeals regulation 8.5 and substitutes it with new regulations 8.5 to 8.8.

New regulation 8.5 provides that the Registrar may decide the opposition procedures and give directions to the registered owner who made the request for amendment, and the opponent.

New regulation 8.6 provides the procedures for conducting a hearing of the opposition under subsection 83A(4) of the Trade Marks Act, which are similar to those of regulation 6.9.

Subregulation 8.6(1) provides that the Registrar must hold a hearing on request in writing by either the registered owner or an opponent. Subregulation 8.6(2) provides that, at the Registrar's discretion, the hearing may be oral or by written submissions. Subregulations 8.6(3) to (5) set out requirements for the Registrar and the relevant parties for an oral hearing, and the consequences of failing to meet the requirements. Subregulation 8.6(6) provides that regulations 21.15 and 21.16, which relate to general hearing procedures, do not apply to oppositions under subsection 83A(4) of the Trade Marks Act.

New regulation 8.7 provides that the Registrar may give a direction in relation to an opposition under subsection 83A(4) of the Trade Marks Act. Subregulation 8.7(1) provides that the Registrar may give a direction on his or her own initiative, or when requested in writing by either the registered owner or an opponent.

Subregulations 8.7(2) to (4) set out the requirements that the Registrar must comply with if he or she gives a direction, these include: giving the relevant parties an opportunity to make representations about the direction; requiring that the direction must be consistent with the Trade Marks Act or Trade Marks Regulations; and notifying relevant parties of the direction as soon as practicable. These provisions are very similar to those of existing regulations 5.19, 6.10, 9.21, 17A.34Q, 17A.48W and 21.20F relating to other types of oppositions.

New regulation 8.8 provides that the Registrar must notify the relevant parties where an opposition under section 222 of the Trade Marks Act is dismissed or discontinued because security for the costs of the proceeding is not given by an opponent who neither resides nor carries on business in Australia.

#### Item 220: Conduct of proceedings

This item amends the note in regulation 21.14 to list all the provisions that govern the Registrar's power to direct parties for the different types of oppositions.

#### Item 221: Award of costs

This item amends Part 1 of Schedule 8 to the Trade Marks Regulations to provide that costs could be awarded for the time spent preparing and perusing notices of opposition filed under subregulation 8.4(1). This reference was inadvertently not included in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

#### Item 222: Fees for filing notices of opposition

This item includes a reference to section 83A of the Trade Marks Act in Schedule 9 to the Trade Marks Regulations to provide that there is a fee for filing a notice of opposition under section 83A. This was inadvertently not included in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

### **Part 11—Secretary’s role in the Plant Breeder’s Rights Regulations**

This Part amends the Plant Breeder’s Rights Regulations to transfer the powers, functions and obligations of the Secretary of the Department of Industry, Innovation and Science to the Registrar to reflect existing practice.

#### *Plant Breeder’s Rights Regulations 1994*

#### Items 223 to 229: Transfer of Secretary’s powers and obligations to the Registrar

These items amend regulations 3A, 3D and 5 of the Plant Breeder’s Rights Regulations to transfer the powers, functions and obligations of the Secretary of the Department of Industry, Innovation and Science to the Registrar of Plant Breeder’s Rights.

The Act transfers the powers, functions and obligations of the Secretary in the Plant Breeder’s Rights Act to the Registrar. In practice the Secretary’s powers are all delegated to the Registrar, so it is appropriate that the Registrar has such powers under the legislation. The equivalent powers, functions and obligations for the other IP rights all reside with the Commissioner of Patents or the Registrars of Designs and Trade Marks.

These amendments omit and repeal references to the ‘Secretary’ and, where appropriate, substitute the ‘Registrar’ in order to transfer the Secretary’s powers, functions and obligations to the Registrar.

Item 226 repeals regulation 3D in its entirety because it is no longer needed. It does not need to be replaced as regulation 3B already provides for the same matters in relation to the Registrar, namely it prescribes who the Registrar may delegate his or her functions to.

These amendments better align with the changes to the Plant Breeder’s Rights Act, with the other IP rights legislation, better reflect actual practice, and improve transparency.

## **Part 12—Other amendments**

This Part repeals the definition of Norfolk Island in Part 13 of the Trade Marks Regulations, which relates to the importation of goods infringing Australian trade marks, as the reference is no longer correct.

### *Trade Marks Regulations 1995*

#### Item 230: Repeal of definition of Norfolk Island

The repeal of the definition of Norfolk Island in regulation 13.1A was inadvertently overlooked when Schedule 3 to the Trade Marks Regulations was amended by the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016*. These amendments followed changes to the application of the *Customs Act 1901*, *Customs Regulation 2015* and *Customs (International Obligations) Regulation 2015* in Norfolk Island.

Due to the amendment of Schedule 3, the definition of Norfolk Island in 13.1A is incorrect and has been omitted by the Regulations. Customs seizure provisions relating to Norfolk Island are provided for in Schedule 3 to the Trade Marks Regulations.

## **Part 13—Application, transitional and saving provisions**

This Part amends the principal Regulations to:

- set out how the amendments in Schedules 1 and 2 to the Regulations will apply in certain circumstances; and
- save the operation of any repealed provisions, as necessary.

This Part clarifies how the transition from the existing legislative scheme to the new legislative scheme will occur. This includes where the amendments affect any IP applications or rights that were applied for or granted/registered under the old legislative scheme, but to which the new legislative scheme applies after commencement.

### *Designs Regulations 2004*

#### Items 231 and 232: Application, saving and transitional provisions

Item 231 repeals and substitutes the heading for Chapter 12 of the Designs Regulations “Application, saving and transitional provisions” to clarify the intent of this Chapter.

Item 232 inserts a new Part 3 into Chapter 12 to the Designs Regulations, which will govern the amendments to the Designs Regulations in Parts 2, 3 and 9 of Schedule 2 to the Regulations.

The transitional arrangements are included to ensure that a person undertaking an action, such as filing a document or submitting an application, is not unfairly advantaged or disadvantaged by the commencement of amendments.

Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Regulation 12.06 provides arrangements for the amendments made by Part 2 of Schedule 2 in relation to written requirements.

- Subregulation 12.06(1) specifies that those amendments made by Part 2 that substitute notice with notification, only apply to those notifications issued on or after Part 2 commences.
- Subregulation 12.06(2) provides that Chapter 5 in the Design Regulations, which relates to the examination of designs, continue to apply without amendments in relation to a notice given under 66(2) prior to the commencement of Part 2.
- Subregulations 12.06(3) and (4) provide that regulation 10.02 and 11.03, respectively, will continue to apply without amendment in relation to a notice given before the commencement of Part 2. These arrangements provide continuity in relation to a notice given prior to the commencement of Part 2.

Regulation 12.07 provides arrangements for the amendments made by Part 3 of Schedule 2 in relation to filing requirements.

- Subregulation 12.07(1) provides the amendments made by 5.08, which relate to material provided to the Registrar, only apply in relation to the provision of material on or after the commencement of Part 3.
- Subregulations 12.07(2) and 12.07(5) provide that the repeal of regulation 11.01A, the amendments made by Part 3 to regulation 11.27, and the amendments to the fee tables only apply in relation to documents filed on or after the commencement of Part 3.
- Subregulations 12.07(3) and 12.07(6) provide that the repeal of 11.25(1) and insertion of 11.27A, which relate to the giving and filing of evidence, only apply in relation to evidence given or filed on or after the commencement of Part 3.
- Subregulation 12.07(4) provides that the amendment of 11.25(2) does not affect the validity of any requirement or permission given under that subregulation prior to the commencement of Part 3.

Regulation 12.08 provides arrangements for the amendments made by Part 9 of Schedule 2 in relation to the number of copies of design representations that must be filed. It provides that the amendments only apply to those design applications filed on or after commencement.

Items 233 and 234: Application, saving and transitional provisions

Item 233 repeals and substitutes the heading for Chapter 23 of the Patents Regulations to “Application, saving and transitional provisions” to clarify the intent of this Chapter.

Item 234 inserts a new Part 4 in Chapter 23 in the Patents Regulations, which will govern the amendments to the Patents Regulations in Parts 2, 3, 5 and 7 of Schedule 2 to the Regulations.

The transitional arrangements are included to ensure that a person undertaking an action is not unfairly advantaged or disadvantaged by the commencement of amendments.

Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Regulation 23.46 provides arrangements for the amendments made by Part 2 of Schedule 2 in relation to written requirements.

- Subregulation 23.46(1) specifies that those amendments made by Part 2 that substitute notice with notification only apply to those notifications issued on or after Part 2 commences.
- Subregulations 23.46(2) to (4) provide that previous regulations 3.5, 3.5A and 3.25 continue to apply in relation to notices provided before commencement.

Regulation 23.47 provides arrangements for the amendments made by Part 3 of Schedule 2 in relation to filing requirements.

- Subregulations 23.47(1), (2) and (4) to (6) specify that the repeal of subregulation 22.12(1) and regulation 22.2AA and the amendments made to regulations 5.3, 22.15, 22.16A and schedule 7 in relation to the filing or giving of evidence and the filing of documents only apply to evidence and documents filed or given on or after Part 3 commences.
- Subregulation 23.47(3) specifies that the amended subregulation 22.12(2) does not affect the validity of any requirement or permission under that subregulation before the commencement of Part 3.
- Subregulation 23.47(7) specifies that the amendments made to items 211, 212 and 214A of the table in clause 2 of Schedule 7 and repeal of regulation 22.2AA, which relates to the payment of fees, only applies to fees paid on or after commencement of Part 3.

Regulation 23.48 provides arrangements for the amendments made by Part 5 of Schedule 2 in relation to signatures.

- Subregulations 23.48(1) and (2) specify that the amendments made to paragraph 3.1(2)(g) and subregulation 5.26(1) only apply in relation to a request (in paragraph 3.1(2)(g)) and a notice of withdrawal (in subregulation 5.26(1)) that are made or filed on or after the commencement of Part 5.

Regulation 23.49 provides arrangements for the amendments made by Part 7 of Schedule 2 in relation to requirements for patent documents.

- Subregulations 23.49(1) and (2) provide that the amendments to regulations 3.2 and 3.2A, which relate to directions to meet formalities requirements, apply in relation to patent requests filed under subsection 29(1) of the Patents Act on or after commencement.
- Subregulations 23.49(3) provides that the amendments to regulations 3.2B, which relates to the formalities check for innovation patents, apply in relation to complete applications made on or after commencement.
- Subregulation 23.49(4) specifies that the amendment of regulations 3.2C and 3.18, in relation to formalities requirements for PCT applications, apply in relation to an applicant's compliance with the requirements of subsection 29A(5) of the Act on or after commencement of this Part regardless of when the PCT application was made. That is, the amendments apply to PCT applications that enter the national phase in Australia on or after commencement.
- Subregulation 23.49(5) provides that the amendment of regulation 3.5AD, which relates to requirements for PCT applications, apply in relation to PCT applications made on or after commencement.
- Subregulation 23.49(6) provides that the amendments of regulations 10.1 and 10.2, which relate to the form of amendments and consideration and dealing with requests for leave to amend, apply in relation to requests made under subsection 104(1) of the Patents Act on or after commencement.
- Subregulation 23.49(7) provides that the amendment of regulation 22.16, which relate to the consequences of certain documents not meeting filing requirements, apply in relation to documents received by the Patent Office on or after commencement.

#### *Plant Breeder's Rights Regulations 1994*

##### Item 235: Application, saving and transitional provisions

Item 235 inserts a new regulation 6 into the Plant Breeder's Rights Regulations, which will govern the amendments to the Plant Breeder's Rights Regulations in Parts 2, 3 and 11 of Schedule 2 to the Regulations.

The transitional arrangements are included to ensure that a person undertaking an action is not unfairly advantaged or disadvantaged by the commencement of amendments.

Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Subregulation 6(1) provides arrangements for the amendments made by Part 2 of Schedule 2 in relation to written requirements.

- Subregulation 6(1) specifies that those amendments made by Part 2 that substitute notice with notification, only apply to those notifications occurring on or after Part 2 commences.

Subregulation 6(2) provides arrangements for the amendments made by Part 3 of Schedule 2 in relation to filing requirements.

- Subregulation 6(2) specifies that those amendments made by Part 3 that repeal regulation 4A, and omit and substitute the terms approved means with preferred means in items 4 and 15 of the table in clause 1 of Schedule 1, only apply in relation to fees paid on or after Part 3 commences.

Subregulation 6(3) provides arrangements for the amendments made by Part 11 of Schedule 2 in relation to the Secretary's role in the Plant Breeder's Rights Regulations.

- Subregulation 6(3) specifies that those amendments made by Part 11 that a thing done by, or in relation to, the Secretary has the effect on or after commencement of Part 11 as if it had been done by, or in relation to, the Registrar.

### *Trade Marks Regulations 1995*

#### Items 236 and 237: Application, saving and transitional provisions

Items 236 repeals and substitutes the heading for Part 22 of the Trade Mark Regulations to "Application, saving and transitional provisions" to clarify the intent of the Part.

Item 237 also inserts new Division 4 in Part 22 of the Trade Marks Regulations, which will govern the amendments to the Trade Mark Regulations in Part 2 of Schedule 1 and Parts 1, 2, 3, 4, 8 and 10 of Schedule 2 to the Regulations.

The transitional arrangements are included to ensure that a person undertaking an action is not unfairly advantaged or disadvantaged by the commencement of amendments.

Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Regulation 22.18 provides arrangements for the amendments made by Part 2 of Schedule 1, which relate to the period an applicant can apply for removal of trade marks from the

Register for non-use. Regulation 22.18 specifies that the amendments made by Part 2 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<sup>ter</sup> (1) of the Protocol, if the date of international registration of the trade mark is on or after the commencement of Part 2, and
- (b) to a protected international trade mark that is the subject of a request for extension of protection to Australia made under Article 3<sup>ter</sup> (2) of the Protocol, if the date of recording of the request is on or after the commencement of Part 2.

Regulation 22.19 provides arrangements for the amendments made by Part 1 of Schedule 2 in relation to the filing of a notice of intention to defend.

- Subregulation 22.19(1) specifies that new regulation 5.13A applies in relation to a notice of intention to defend if the one month period the notice can be filed in, as specified by subregulation 5.13(1), ends on or after the commencement of Part 1.
- Subregulations 22.19(2) to 22.19(4) specify that regulations 9.15A, 17.34HA and 17A.48QA apply in relation to a notice of intention to defend if the one month period the notice can be filed in, as referred to in subregulations 9.15(1), 17.34H(1) and 17A.48Q(1), respectively, ends on or after the commencement of Part 1 and no application for an extension for time had been made under section 224 of the Act before commencement.

Regulation 22.20 provides arrangements for the amendments made by Part 2 of Schedule 2 in relation to written requirements.

- Subregulation 22.20(1) specifies that those amendments made by Part 2 only apply to notifications occurring on or after Part 2 commences.
- Subregulation 22.20(2) specifies that those amendments made by Part 2 that remove the requirements of reports being made in writing, as specified in regulations 4.8 and 4.10, only apply to those reports issued on or after Part 2 commences.
- Subregulations 22.20(3) to 22.20(6) specify that regulations 4.2, 6.1, 10.4 and 10.5, and 17A.59 as in force prior to the commencement of Part 2, will continue to apply on or after commencement of Part 2 in relation to notice given either under subregulation 4.2(2), 6.1(1), 10.5(1) and 17A.59(1)(b), respectively.
- Subregulation 22.20(7) specifies the repeal and substitution of regulation 21.10 applies to withdrawals occurring on or after the commencement of Part 2.

Regulation 22.21 provides arrangements for the amendments made by Part 3 of Schedule 2 in relation to filing requirements.

- Subregulation 22.21(1) and 22.21(4) specifies that the repeal of regulations 5.3, 9.3, 17A.30 and 17A.48A and subregulation 21.17(1), which relate to the filing of documents or the filing or giving of evidence, applies in relation to documents or evidence filed or evidence given on or after the commencement of Part 3.
- Subregulation 22.21(2) specifies that the repeal and substitution of regulations 21.2 and 21.4 and the repeal of regulation 21.18, which relates to the filing of documents, applies in relation to documents filed on or after the commencement of Part 3.
- Subregulation 22.21(3) specifies that the insertion of regulation 21.5A, which relates to the filing of evidence, applies in relation to evidence filed on or after the commencement of Part 3.
- Subregulations 22.21(5) and 22.21(6) specifies that the amendment of items 1, 3 and 10 in the table in clause 1 of Schedule 9 and the repeal of 21.21AA (in so far as it relates to those items) apply in relation to applications filed and fees paid on or after the commencement of Part 3.

Regulation 22.22 provides that the amendments made to subregulations 17A.36(2), (2A), (3), (3A), (4) and (6), which clarify references in the regulations that relate to IRDAs, apply in relation to the acceptance of an IRDA on or after the commencement of Part 4.

Regulation 22.23 provides that the amendments made to paragraphs 4.13(1)(a) and 17A.21(1)(a), which relate to requests for deferment of acceptance of a trade mark application or IRDA, respectively, only apply to requests made on or after the commencement of Part 8.

Regulation 22.24 provides arrangements for the amendments made by Part 10 in relation to amendments of registered trade marks due to inconsistency with international agreements. New regulations 8.5 to 8.8, the amendments of table items 5 and 6 in Part 1 of Schedule 8, and the amendment of item 8 of the table in clause 1 of Schedule 9, apply to requests for amendment referred to in subregulation 8.4(1) that are made on or after the commencement of Part 10.

## Statement of Compatibility with Human Rights

*Prepared in accordance with Part 3 of the Human Rights (Parliamentary Scrutiny) Act 2011*  
*Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018*

This Disallowable Legislative Instrument is compatible with the human rights and freedoms recognised or declared in the international instruments listed in section 3 of the *Human Rights (Parliamentary Scrutiny) Act 2011*.

### Overview of the Legislative Instrument

The *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Regulations 2018* ('the Regulations') makes amendments to the *Designs Regulations 2004*, the *Trade Marks Regulations 1995*, the *Plant Breeder's Rights Regulations 1994*, and the *Patents Regulations 1991* (collectively, 'the principal Regulations').

Most of the amendments under the Regulations are required to implement the *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018* ('the Act'). The Act amended the *Copyright Act 1968* (Copyright Act), *Designs Act 2003* (Designs Act), *Olympic Insignia Protection Act 1987* (Olympic Insignia Protection Act), *Patents Act 1990* (Patents Act), *Plant Breeder's Rights Act 1994* (Plant Breeder's Rights Act) and *Trade Marks Act 1995* (Trade Marks Act).

Schedule 1 to the Act gives effect to the Government's response to a number of recommendations from the Productivity Commission's public inquiry into Australia's intellectual property (IP) system.<sup>2</sup> Schedule 2 to the Act implements a number of measures to streamline and align the administration of the Australian IP system, and implement a number of other IP law measures.

The IP system is an important element of the economy because it promotes and incentivises investment in creativity, research and technology. The purpose of the Act is to make improvements to IP rights legislation to better meet these objectives.

The Regulations make a number of administrative changes to the principal Regulations as a result of changes made by the Act. They also streamline some processes involved with obtaining and maintaining IP rights.

The Regulations make the following amendments:

Schedule 1: Responses to the Productivity Commission

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<sup>2</sup> *Australian Government Response to the Productivity Commission Inquiry into Intellectual Property Arrangements*, August 2017, accessible at <https://www.industry.gov.au/innovation/Intellectual-Property/Pages/default.aspx>

- Part 1 provides administrative arrangements regarding a new process for essentially derived variety (EDV) declarations introduced into the Plant Breeder's Rights Act by the Act.
- Part 2 provides that the new time period specified in the Trade Marks Act for removal of trade marks for non-use also applies to international trade mark applications.
- Part 3 makes consequential amendments to the Patents Regulations following the repeal of section 76A in the Patents Act. Section 76A required patent holders who receive an extension of term under section 76 to provide the Department of Health with specified information about the cost of research and development (R&D), including information on Commonwealth funding.

#### Schedule 2: Other Measures

- Part 1 provides new provisions to allow for extensions of time for filing a notice of intention to defend in the Trade Marks Regulations.
- Part 2 removes the requirement for the Registrars of Designs, Trade Marks and Plant Breeder's Rights, and the Commissioner of Patents, to give certain notices in writing as a consequence of amendments to the principal Acts, and instead to permit notification by any means of communication. It also requires the Registrar of Trade Marks to publish the fact of withdrawal of an application, notice or request in the Official Journal.
- Part 3 amends the Designs, Trade Marks, Plant Breeder's Rights and Patents Regulations to provide consequences for filing documents with IP Australia that do not comply with directions, and makes consequential amendments due to amendments in the principal Acts regarding the filing of documents and payment of fees.
- Part 4 corrects a number of references in the Trade Mark Regulations relating to International Registrations Designating Australia (IRDAs).
- Part 5 removes the requirement for two types of documents to be signed.
- Part 6 repeals the requirement to provide an address for correspondence, and removes requirements for serving or filing of documents that are inconsistent with changes introduced by Schedule 3 to the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.
- Part 7 replaces formality requirements in the Patent Regulations (including those in Schedule 3) with requirements to comply with new provisions inserted in the Patents Act. This includes new section 229, which enables the Commissioner of Patents to issue a non-legislative instrument determining formality requirements. This Part also enables patent specifications to use graphics and/or photographs to describe inventions.
- Part 8 amends the Trade Marks Regulations to allow applicants that are granted an extension of time for acceptance of a trade mark to submit a request for deferment of acceptance during that extended period.
- Part 9 replaces the requirement to file five copies of design representations with a requirement that at least one of each representation of the design be filed.

- Part 10 reinstates procedures for conducting an opposition to amendments made to a registered trade mark to overcome an inconsistency with international agreements. It also includes a small number of references that were inadvertently missed in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)* relating to trade mark oppositions.
- Part 11 transfers the powers of the Secretary of the Department of Industry, Innovation and Science to the Registrar of Plant Breeder's Rights to reflect existing practice (noting that the Secretary has already delegated all powers to the Registrar).
- Part 12 repeals the definition of Norfolk Island in Part 13 of the Trade Marks Regulations, as the reference is no longer correct.
- Part 13 sets out how the amendments in Schedules 1 and 2 to the Regulations will apply in certain circumstances; and saves the operation of any repealed provisions.

### **Human rights implications**

This Disallowable Legislative Instrument engages with the following human rights:

- the **right to enjoy the benefits of scientific progress and its applications** – Article 15(1)(b) of the *International Covenant on Economic, Social and Cultural Rights* (ICESCR)
- the **right to the protection of interests resulting from one's scientific production** – Article 15(1)(c) of the ICESCR

### ***Right to enjoy scientific progress and right to protection of interests resulting from scientific production***

Article 15(1)(b) of the ICESCR recognises the right of everyone to enjoy the benefits of scientific progress and its applications. Article 15(1)(c) of the ICESCR recognises the right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary, or artistic production of which he or she is the author.

Part 1 of Schedule 1 to the Regulations amends the Plant Breeder's Rights Regulations to provide administrative arrangements for new EDV declarations for non-Plant Breeder's Right (PBR) protected varieties as introduced by the Act.

In circumstances where a PBR is granted in relation to a plant variety (the initial variety), and another variety (the second variety) has only minor changes to the initial variety, the Plant Breeder's Rights Act allows for the owner of the first variety to have the second variety declared as an essential derivation.<sup>3</sup> In these cases the initial breeder's PBR extends to the EDV. In practice, this means the owner of the second variety cannot exercise their rights in the second variety without the consent of the owner of the initial variety.

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<sup>3</sup> Section 4 defines an EDV as a plant variety that is predominantly derived from the initial variety, retains the essential characteristics that result from the genotype or combination of genotypes of the initial variety, and does not exhibit any important (as distinct from cosmetic) features that differentiate it from the first variety.

Previously, an EDV declaration could only be sought where an application for, or grant of, a Plant Breeder's Rights had been made in respect of the second variety. However, this allows the breeder of a second variety to avoid an EDV declaration being made by not filing a Plant Breeder's Rights application. This means that the second breeder is able to profit from the second variety despite their variety being largely derived from the first variety. This amendment provides the administrative arrangements, following the changes made to the Plant Breeder's Rights Act by the Act that closes this loophole.

This amendment promotes the rights of the original breeder/owner by ensuring their interests that result from their scientific production are protected.

### **Remaining parts do not raise any human rights issues**

These parts are Parts 2 and 3 of Schedule 1, and all of Schedule 2.

### **Conclusion**

This Disallowable Legislative Instrument is compatible with human rights as it does not raise any human rights issues.

**The Hon Karen Andrews MP**  
**Minister for Industry, Science and Technology**