

EXPLANATORY STATEMENT

Issued by the Authority of the Minister for Industry and Science

Patents Act 1990

Trade Marks Act 1995

*Intellectual Property Laws Amendment (Regulator Performance) Regulations
2024*

The *Intellectual Property Laws Amendment (Regulator Performance) Regulations 2024* (the Regulations) amend the *Patents Regulations 1991* (Patents Regulations) and the *Trade Marks Regulations 1995* (Trade Marks Regulations) to implement and support the changes made to provisions of the *Patents Act 1990* (Patents Act) and *Trade Marks Act 1995* (Trade Marks Act) as amended by the *Intellectual Property Laws Amendment (Regulator Performance) Act 2023* (the Amending Act).

Legislative Authority

Paragraphs 228(1)(a) to (c) of the Patents Act provide that the Governor-General may make regulations, not inconsistent with that Act, prescribing matters required or permitted by the Patents Act to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to the Patents Act or for the conduct of any business relating to the Patent Office. Changes made to the Patents Regulations follow similar amendments to the Patents Act by the Amending Act, all of which have commenced.

Subsection 231(1) of the Trade Marks Act provides that the Governor-General may make regulations prescribing matters required or permitted by that Act to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to the Act or for the conduct of any business relating to the Trade Marks Office or a sub-office of the Trade Marks Office. Some of the amendments in the Regulations are dependent on the commencement of provisions in the Amending Act while others are made under provisions already in effect.

Changes made to regulations in Part 3A of the Trade Marks Regulations, made in Parts 3 and 4 of Schedule 1 to the Regulations, derive their authority from paragraph 231(1)(b) of the Trade Marks Act, which permits regulations to prescribe matters that are necessary or convenient for carrying out or giving effect to the Act. Part 3A of the Trade Marks Regulations allows customers to efficiently address issues relating to their trade mark before filing an application.

Changes to regulations 17A.25, 17A.33, 17A.37 and 17A.48G of the Trade Marks Regulations, made in Part 3 of Schedule 1 to the Regulations, derive their authority from subsection 189A(1) of the Trade Marks Act, which allows regulations to provide for matters necessary to enable the performance of obligations under the Madrid Protocol. The *Protocol Relating to the Madrid Agreement concerning the International Registration of Marks* (referred to in the Act as the Madrid Protocol) is an international agreement which provides for a system of international trade mark registrations.

The Parts of the Regulations that are made in reliance on a power that will not have commenced at the time these are made are Parts 1 to 3 of Schedule 1 to the Regulations, including item 3 which is to be made under new subsection 98(2) of the Trade Marks Act. Several items in Part 3 of Schedule 1 to the Regulations would be made under new regulation-making powers, inserted by Part 5 of Schedule 1 to the Amending Act.

The authority to make regulations to prescribe certain matters provided for by new regulation-making powers that would commence on 17 May 2024, relies on section 4 of the *Acts Interpretation Act 1901* (AIA). Section 4 of the AIA permits a power to be exercised after an Act is enacted but before it commences, because the regulations would be in effect at the same time, or after, the commencement of the relevant provisions in the Act.

The Patents and Trade Mark Acts specify no conditions that must be met before the power to make regulations may be exercised.

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

Purpose of the Regulations

The Regulations amend the Patents and Trade Marks Regulations to make technical improvements to Australia's IP rights system to streamline use of the system, correct minor inconsistencies and reduce legal uncertainty. These improvements were identified by IP Australia (which administers the patent and trade mark systems) as part of a 2021 whole-of-government review of regulator performance.

These changes complement and are consequential to recent amendments to the Patents and Trade Marks Acts by the Amending Act.

The Regulations amend the Trade Marks Regulations to:

- make consequential amendments following amendments to the grace periods for renewal of registration by the Amending Act;
- make consequential amendments following introduction of provisions enabling the restoration of certain trade marks to the Register by the Amending Act;
- make consequential amendments following updates to the form in which required information can be communicated to the public, including removing references to the Official Journal of Trade Marks, by the Amending Act;
- allow discontinued requests under the Assisted Filing Service to be revived in certain circumstances; and
- update the classification of goods and services to reflect the most recent terms under the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks*, to which Australia is a party.

The Regulations also make minor technical amendments to the Patents Regulations to remove spent transitional provisions, following similar amendments to the Patents Act by the Amending Act.

Details of the amendments can be found at [Attachment A](#).

Impact Analysis

The Office of Impact Analysis (OIA) has advised that an Impact Analysis is not required to be prepared for these amendments.

The OIA reference numbers are provided below:

- Part 1 – Consequential amendments relating to aligning renewal grace periods for trade marks: OBPR 44591
- Part 2 – Consequential amendments relating to restoration of trade marks to the Register: OBPR 44591
- Part 3 – Consequential amendments relating to powers allowing Registrar of Trade Marks to determine the form in which required information will be communicated under the Trade Marks Act: OBPR 44591
- Part 4 – Amendments to the Trade Marks Regulations to clearly allow Assisted Filing Service requests to be revived: OIA24-06379
- Part 5 – Update Nice Classification headings: OIA24-06377
- Part 6 – Application and transitional provisions: OBPR 44591, OIA24-06379
- Part 7 – Consequential amendments following the repeal of parts of Chapter 23 of the Patents Act: OBPR 44591

Consultation

IP Australia ran public consultation on the text of the Amending Act between 13 December 2021 and 14 January 2022 and no concerns were raised on the relevant proposals. All Parts except Parts 4 and 5 of the Regulations directly follow from and implement the changes in that Act. The Regulations align with the policy objectives in the Amending Act and no further public consultation was considered necessary.

An information paper outlining all proposals in these Regulations was circulated to IP Australia's Trade Marks and Designs Consultation Group (TMDCG) prior to a meeting of 12 March 2024. TMDCG members are drawn from the registered trade marks attorney profession, the legal profession, academia, industry and peak bodies. Stakeholders did not express any concerns.

Statement of compatibility with human rights

Subsection 9(1) of the *Human Rights (Parliamentary Scrutiny) Act 2011* requires the rule-maker in relation to a legislative instrument to which section 42 (disallowance) of the Legislation Act applies to cause a statement of compatibility to be prepared in respect of that legislative instrument. A statement of compatibility to meet that requirement is at [Attachment B](#).

Attachment A

Details of the *Intellectual Property Laws Amendment (Regulator Performance) Regulations 2024*

Section 1 - Name of Regulations

This section identifies the instrument as the *Intellectual Property Laws Amendment (Regulator Performance) Regulations 2024*.

Section 2 - Commencement

This section provides for the Regulations to commence on 17 May 2024.

Section 3 - Authority

This section provides that the *Intellectual Property Laws Amendment (Regulator Performance) Regulations 2024* is made under the *Patents Act 1990* and the *Trade Marks Act 1995*.

Section 4 - Schedule(s)

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 - Amendments

Part 1 – Renewal of registration

This Part of the Regulations makes consequential amendments following changes to grace periods for payment of a trade mark renewal fee made by Part 2 of the Amending Act. Together, these have the effect of aligning all grace periods for payment of a trade mark renewal fee to a consistent 6 months.

Trade Marks Regulations 1995

Item [1] – Subregulation 21.21(6)

This item amends subregulation 21.21(6) in the Trade Marks Regulations to align the time period for renewal with the new 6-month period provided for by the Amending Act.

Once registered, trade mark rights generally have effect from the filing or priority date, whichever is earlier. The duration of protection is 10 years from this date. This protection is renewable. If a trade mark is not renewed before the end of its 10-year term, there is a 6-month grace period in which the trade mark can be renewed for an extra fee. These renewals are handled under Division 2 of Part 7 of the Trade Marks Act.

Some trade marks do not become registered until more than 10 years after their filing or priority date. Once registered, these trade marks are effectively already 'overdue' for renewal. For these trade marks, renewals are handled under Division 3 of Part 7 of the Trade Marks Act.

Division 3 sets out that renewal fees must be paid within a prescribed period from when the trade mark application is entered in the Register of Trade Marks (the Register). If the renewal is not paid within the prescribed period, there is currently a 10-month grace period during which the trade mark can be renewed for an extra fee.

When amendments take effect, Part 2 of the Amending Act amends paragraph 80F(b), section 80G (heading) and paragraph 80G(1)(b) of the Trade Marks Act to provide for a new grace period of 6 months for the late payment of a renewal fee where a registration has been delayed for more than 10 years.

Item [2] – Clause 1 of Schedule 9 (table item 12, column headed “Matter”)

This item amends table item 12 in Clause 1 of Schedule 9. Table item 12 sets the fees for requesting registration renewal under paragraph 80G(1)(b) of the Trade Marks Act.

The amendment replaces the current reference to the 10-month period for renewal requests after the end of the prescribed period with that of the new 6-month period provided for by the changes in Part 2 of the Amending Act.

Part 2 – Restoration of trade mark to the Register

This Part makes consequential amendments following the introduction of provisions enabling the restoration to the Register of certain trade marks by Part 4 of the Amending Act. Together, these have the effect of enabling the restoration of a trade mark to registered status if an extension of time (EoT) is obtained to file evidence or request a hearing in an opposition to removal of the trade mark registration for non-use, and the opponent subsequently performs the required action within the extended time period.

Trade Marks Regulations 1995

Item [3] – Division 3 of Part 9

This item inserts new regulation 9.18A at the end of Division 3 of Part 9 of the Trade Marks Regulations to prescribe the circumstances in which a trade mark may be restored under the new provisions inserted by the Amending Act.

A party may apply for a trade mark to be removed from the Register for non-use. This removal application can be opposed, typically by the owner of the trade mark (the opponent). An opponent must present evidence in support, or request a hearing within a certain time period. If an opponent fails to take these steps, the application for non-use would be considered to be unopposed and the trade mark would be removed.

The opponent may request an EoT to extend the time periods prescribed for these steps. However, previously there was no provision to restore a trade mark to the Register if it was removed before said EoT was granted.

The Amending Act addresses this by inserting subsection 98(2) which requires restoration of a trade mark that was removed under section 97(1)(a) as a result of a person failing to do a thing prescribed by the Trade Mark Regulations, if the time for doing that thing was subsequently extended and the person did the thing in the new timeframe. New regulation 9.18A prescribes that a ‘thing’ referred to in paragraph 98(2)(b) is filing evidence in support in accordance with subregulation 9.16(3), or requesting a hearing in accordance with subregulation 9.17(1).

Part 3 – Official Journal etc.

This Part makes consequential amendments following changes in Part 5 of the Amending Act in relation to how information is made available to the public. These have the effect of enabling the Registrar of Trade Marks (the Registrar) to make information available in a flexible, modern and user-friendly way.

In particular, amendments to section 226 of the Trade Marks Act remove the requirement to maintain an Official Journal of Trade Marks (the Official Journal). Part 3 of the Regulations enables information previously contained in the Official Journal to be communicated via updatable online platforms, such as a computer database maintained by the Trade Marks Office or the IP Australia website.

Prior to the amendments contained in the Amending Act, the Trade Marks Act required that various information be ‘issued’, ‘published’, ‘notified’, ‘advertised’ and otherwise publicly advised in the Official Journal. Historically, the Official Journal was made available on the IP Australia website in a Portable Document Format (PDF). A new edition of this document is published daily and users would need to access each individual document to search for relevant information.

IP Australia also makes much of the required information available to the public via the Australian Trade Mark Search (ATMS) online computer database, maintained by the Trade Marks Office (a branch within IP Australia). ATMS is a more reliable, searchable and up-to-date single source of information for crucial dates and other required information relating to trade marks. Most stakeholders already favour using ATMS over the Official Journal.

Some information currently published in the Official Journal is not provided on the ATMS online search portal (for example where information is general rather than related to individual trade marks). This information is generally made available on IP Australia’s website, for example as an Official Notice or a non-legislative instrument. Again, this is more commonly used and a more user-friendly location of this information.

To prevent potential confusion and reduce redundancies, the Registrar will no longer be obliged to communicate the required information via the Official Journal. Other more suitable platforms, as detailed below, are prescribed as the means of

communicating required information.

The term 'computer database maintained by the Trade Marks Office' refers to a publicly-available database of information. Currently this database is the ATMS which can be accessed online, for free through the IP Australia website. However, this term is kept broad to allow for future changes to a different database platform or to allow for the database to be renamed or rebranded.

Also, to remove uncertainty and improve consistency in use of terms, the term 'advertise' is being replaced with 'publish'. The same approach was used in the Amending Act in amending sections 65 and 65A (heading), and paragraphs 65A(5)(a) and 83A(7)(a) of the Trade Marks Act.

Trade Marks Regulations 1995

Items [4, 5 and 48]

These items amend paragraphs 3A.3(3)(f) and 3A.3(3)(g) and subregulation 21.24B(3), to remove references to information being published, notified and/or advertised in the Official Journal, and provide that information will be published on the IP Australia website.

Items [6, 8, 11, 14, 17, 19, 20, 21, 23, 25, 27, 32, 33, 34, 35, 36, 38, 41 and 44]

These items amend subregulations 4.7(2) and 5.6(1), paragraph 7.1(1)(a), 8.4(2)(b), subregulation 9.8(1), paragraphs 16.3(2)(b), 16.3(2)(c), 16.3(3)(a), subregulation 16.3(4), subregulations 16.4(1), 16.4(3), 16.10(4), 16.10(5) and 16.12(2), paragraphs 17A.25(1)(a), 17A.25(2)(c), 17A.37(1)(a) and 17A.48G(1), and regulation 21.10, to remove references to information being published, notified and/or advertised in the Official Journal. Instead, these regulations now provide that information be published on a computer database maintained by the Trade Marks Office.

Item [7] - After regulation 4.11

This item inserts new regulation 4.11A after regulation 4.11 to provide for the amendments made to paragraph 34(b) of the Trade Marks Act by the Amending Act. Paragraph 34(b) now requires that the Registrar's decision to accept or reject a trade mark application for registration be published in accordance with the regulations. This new regulation provides that this information must be published on a computer database maintained by the Trade Marks Office.

Item [9] - After regulation 6.3

This item inserts new regulation 6.3A after regulation 6.3 as a result of the amendments made to subsection 65A(3) of the Trade Marks Act by the Amending Act. Subsection 65A(3) as amended provides that requests for amendment of a trade mark application, after particulars of the application have been published, be published in accordance with the regulations. New regulation 6.3 provides that this information must be published on a computer database maintained by the Trade Marks Office.

Items [10, 22, 24, 26, 28, 29, 46 and 49]

These items amend subregulation 6.6(1), paragraphs 16.3(3)(b), 16.3(4)(a), 16.4(1)(b), 16.4(3)(b), 16.5(2)(b), 21.20B(1) and 21.28(1)(q), to replace references to 'an advertisement' with references to 'a publication'.

Item [12] - At the end of Division 1 of Part 7

This item inserts new regulation 7.2A after regulation 7.2 as a result of the amendments made to subsection 71(a) of the Trade Marks Act by the Amending Act. Subsection 71(a) as amended provides that registration of a trade mark application be published in accordance with the regulations. New regulation 7.2 provides that this information must be published on a computer database maintained by the Trade Marks Office.

Item [13] - After regulation 8.3

This item inserts new regulation 8.3A after regulation 8.3 as a result of the amendments made to subsection 83A(3) of the Trade Marks Act by the Amending Act. Subsection 83A(3) as amended provides that requests for amendment of a registered trade mark due to inconsistency with any relevant obligation of Australia under an international agreement be published in accordance with the regulations. New regulation 8.3A provides that the information must be published on a computer database maintained by the Trade Marks Office.

Item [15] - Regulation 9.6

This item amends regulation 9.6 by inserting new subregulation 9.6(1) at the beginning of the current regulation, in order to accommodate the additional subregulation which is added to regulation 9.6 in the following item.

Item [16] - At the end of regulation 9.6

This item amends regulation 9.6 by inserting new subregulation 9.6(2) as a result of the amendments made to subsections 95(2) and (3) of the Trade Marks Act by the Amending Act. Subsections 95(2) and (3) as amended provide that notification of an application for removal of a trade mark from the Register for non-use must be published in accordance with the regulations. New subregulation 9.6(2) provides that this information must be published on a computer database maintained by the Trade Marks Office.

Item [18] - At the end of regulation 10.4

This item amends regulation 10.4 by inserting new subregulation 10.4(5) as a result of the amendments made to subsection 110(3) of the Trade Marks Act by the Amending Act. Subsection 110(3) as amended provides that the recording of an assignment or transmission of a registered trade mark to a new owner, and the registration of this party as the new owner, be published in accordance with the regulations. New subregulation 10.4(5) provides that this information must be published on a computer database maintained by the Trade Marks Office.

Item [30] - Regulation 16.7

This item repeals regulation 16.7 and substitute it with new regulation 16.7 as a result of the amendments made to paragraph 175(4)(b) of the Trade Marks Act by the Amending Act. Paragraph 175(4)(b) as amended provides that a decision by the Commission to not give a certificate in relation to a certification trade mark be published in accordance with the regulations. New regulation 16.7 provides that this matter must be published on a computer database maintained by the Trade Marks Office, and retains the requirement to include a statement to the effect that, subject to the *Administrative Appeals Tribunal Act 1975*, application may be made to the Administrative Appeals Tribunal (AAT) for the review of the decision to which the publication relates.

Item [31] - After regulation 16.7

This item inserts new regulation 16.7A after regulation 16.7 as a result of the amendments made to paragraph 176(3)(b) of the Trade Marks Act by the Amending Act. Paragraph 176(3)(b) as amended provides that a decision to accept or reject registration of an application for a certification trade mark be published in accordance with the regulations. New regulation 16.7A provides that this information must be published on a computer database maintained by the Trade Marks Office.

Item [37] - Subregulation 17A.33(1)

This item repeals and replaces subregulation 17A.33(1) which deals with the filing of a notice of intention to oppose acceptance of an International Registration Designating Australia (IRDA). The new subregulation stipulates that if the Register publishes acceptance of an IRDA on a computer database maintained by the Trade Marks Office, a person may oppose acceptance within 2 months of the date of publication.

Item [39] - Regulation 17A.48E

This item amends regulation 17A.48E by inserting a new subregulation 17A.48E(1) at the beginning of the current regulation, in order to accommodate the additional subregulation which is added to regulation 17A.48E by the following item.

Item [40] - At the end of regulation 17A.48E

This item amends regulation 17A.48E by inserting new subregulation 17A.48E(2) as a result of the amendments made to subsections 95(2) and (3) of the Trade Marks Act by the Amending Act. Subsections 95(2) and (3) as amended provide that notification of an application for removal of an IRDA from the Register for non-use must be published in accordance with the regulations. New subregulation 17A.48E(2) provides that this information must be published on a computer database maintained by the Trade Marks Office.

Item [42] - Paragraph 20A.19(1)(c)

This item amends paragraph 20A.19(1)(c) which deals with notification and

publication of decisions of Panel of Disciplinary Tribunal. This paragraph has been amended to require decisions of the panel to be published 'on the Trans-Tasman IP Attorneys website'.

The Panel of the Disciplinary Tribunal is constituted under regulation 20A.11. Regulation 20A.11 in turn refers to the definition of the Disciplinary Tribunal as the Trans-Tasman IP Attorneys Disciplinary Tribunal established by regulation 20.61 of the Patents Regulations 1991.

IP Australia provides Secretariat services to the Trans-Tasman IP Attorneys Board and the Disciplinary Tribunal, including maintaining the Trans-Tasman IP Attorneys website, where decisions of the Disciplinary Tribunal are published (this is separate to the IP Australia website).

Item [43] - After regulation 21.3

This item inserts new regulations 21.3A, 21.3B and 21.3C after regulation 21.3 as a result of amendments made to subsections 213A(3), 213B(3) and 213C(4) of the Trade Marks Act by the Amending Act.

Subsection 213A(3) as amended provides that a determination regarding the means for filing a document with the Trade Marks Office must be published in accordance with the regulations. New regulation 21.3A provides that this information must be published on the IP Australia website.

Subsection 213B(3) as amended provides that a determination specifying the form in which a document is to be filed under the Trade Marks Act must be published in accordance with the regulations. New regulation 21.3AB provides that this information must be published on the IP Australia website.

Subsection 213C(4) as amended provides that a determination giving a direction in relation to the filing of evidence in connection with a matter arising under the Trade Marks Act must be published in accordance with the regulations. New regulation 21.3AC provides that this information must be published on the IP Australia website.

Item [45] - After regulation 21.20A

This item inserts new regulation 21.20AA after regulation 21.20A as a result of the amendments made to subsection 224(5) of the Trade Marks Act by the Amending Act. Subsection 224(5) as amended provides that an application for an extension of time under subsection 224(2) or (3) for a period longer than 3 months must be published in accordance with the regulations. New regulation 21.20AA provides that this information must be published on a computer database maintained by the Trade Marks Office.

Item [47] - After subregulation 21.22(1)

This item amends regulation 21.22 by insertion of new subregulation 21.22(1A) after subregulation 21.22(1) as a result of the amendments made to subsection 223AA(3) of the Trade Marks Act by the Amending Act. Subsection

223AA(3) as amended provides that a determination relating to the means of paying a fee must be published in accordance with the regulations. New subregulation 21.22(1A) provides that this information must be published on the IP Australia website.

Part 4 – Extension of time for Assisted Filing Service

This Part amends the regulations to allow for extension of time (EoT) requests for discontinued Assisted Filing Service (AFS) requests, allowing these to be revived and further action taken.

The AFS provides customers with a preliminary assessment of the registrability of their proposed trade mark before they submit a formal application, and their trade mark is published on IP Australia's website.

Customers who intend to act on the result of their AFS assessment sometimes face difficulty meeting the 5-day timeframe prescribed by subregulation 3A.5(1) to take the next step of either converting their AFS request into a standard application or paying to amend their AFS request so it can be re-assessed. These requests subsequently discontinue under subregulation 3A.5(6).

While EoTs are available for many other trade mark actions, these are not currently available for AFS requests. If the 5-day timeframe is not met and the request discontinues, customers can either re-submit their AFS request or file a new standard application. Both options increase the total cost to the user and can delay the filing and registration of their trade mark.

Importantly, allowing EoTs for these requests would not impact the trade mark rights of other customers or trade mark owners. AFS assessments do not provide customers with any legal rights against third parties unless and until the requester chooses to convert the AFS to a formal trade mark application. Legal rights take effect from the date of paying the final conversion fee, which is a means of filing that application under paragraph 4.1(1)(b).

Trade Marks Regulations 1995

Item [50] – Subregulation 3A.5(1)

This item amends subregulation 3A.5(1) so that a reference to the period for performing the actions described in paragraphs (a) and (b) includes that period as extended under new regulation 3A.7. This item is consequential to the change to permit extensions of time for that period (see next item).

This addition works with new regulation 3A.7 to make it clear that the requester of an AFS request that has been discontinued under subregulation 3A.5(6) is able to perform the actions described in subregulation 3A.5(1) in the extended period.

Item [51] – At the end of Part 3A

This item inserts new regulations 3A.6 and 3A.7 at the end of Part 3A of the Trade

Marks Regulations, allowing the 5-day period to be extended in certain circumstances.

New subregulation 3A.6(1) allows requesters of AFS requests that have discontinued under subregulation 3A.5(6) to request an extension of time to perform the actions allowed under subregulation 3A.5(1). This essentially 'revives' the AFS request so that the required actions could be performed.

Subregulation 3A.6(2) allows an application for an EoT to be made within 2 months after the end of the period of 5 working days after the requester is informed by the Registrar of his or her opinion under subregulation 3A.4(2). This time limit reduces the risk to the requester that the outcome of their converted standard application might differ from that of the preliminary AFS assessment – for example, because someone else files an application for the same or a similar trade mark in the intervening period between the Registrar's opinion and the request being converted to a standard application.

Subregulation 3A.6(3) requires that the application be in an approved form and accompanied by a declaration stating the facts and circumstances forming the basis for the grounds for making the application.

Subregulation 3A.6(4) prescribes the grounds for making this application. Acceptable grounds for this request are: an error or omission on the part of the requester, their agent, the Registrar or an employee; circumstances beyond the control of the requester; or special circumstances that justify an extension. These grounds are similar to grounds for EoTs for other time periods in the trade marks legislation, and are adapted from the standard EoT grounds in section 224 of the Trade Marks Act.

New subregulation 3A.7(1) prescribes that the Registrar may grant an application for an extension of time if the Registrar is satisfied that the grounds set out in the application justify the extension.

Subregulation 3A.7(2) requires the Registrar to decide a reasonable length for this extended period depending on the circumstances of the request.

Subregulation 3A.7(3) limits the number of times that the Registrar may grant a request for extension to no more than one time for any AFS request. This means that should the requester not perform the actions allowed under subregulation 3A.5(1) within the extended time period, the request will again discontinue at the expiry of this time period, and they are not be able to extend the time period again. This provision is intended to prevent repeated requests for extensions of time which would further delay the final resolution of the request.

This decision does not warrant a merit review, as the impacts of the decision would be sufficiently limited that the costs of review could not be justified.¹

¹ See, in particular, paragraphs 4.56 and 4.57 of Administrative Review Council 1999, *What decisions should be subject to merit review?* Accessed 18 March 2024 at <<https://www.ag.gov.au/legal-system/administrative-law/administrative-review-council-publications/what-decisions-should-be-subject-merit-review-1999>>.

The costs to the requester of a merits review of a decision not to grant an AFS EoT would be disproportionate to any potential benefits. For the requestor, seeking such a review would almost certainly be more expensive than making a new AFS request (currently \$200 per class) or standard trade mark application (currently \$250 per class). By contrast, the current application fee for the Administrative Appeals Tribunal is \$3,374, and does not include the costs of fees for legal representation before the Tribunal. Seeking merits review would also considerably delay the commencement of legal rights in the trade mark, should the requester choose not to progress a new application while they wait for review of the decision, as AFS requests themselves do not have legal protection until they are converted into and filed as a standard application. As such, even if the review were to find in favour of a requester, the delay and cost involved likely outweighs any potential benefit to that requester.

It would represent an inappropriate allocation of resources for the government to provide for and engage in merits review of such decisions.

Item [52] – Regulation 4.2A

This item amends regulation 4.2A by inserting additional text at the end of the current regulation to acknowledge that the time period mentioned in this regulation may have been extended under new regulation 3A.7.

Subregulation 4.1(b) provides for AFS requests that have been submitted as trade mark applications under paragraph 3A.5(1)(b). Regulation 4.2A makes clear that such requests are considered to be filed as applications only if the Registrar is satisfied that all fees have been paid in respect of the application during the relevant time period. This amendment provides that the relevant period is the period of 5 working days mentioned in subregulation 3A.5(1), or that period as extended under regulation 3A.7.

Part 5 – Nice Classification

This item updates the class headings listed in Schedule 1 to the Trade Marks Regulations to reflect those in the *Twelfth Edition of the International Classification of Goods and Services* (Nice Classification), which came into effect on 1 January 2024.

Schedule 1 to the Trade Marks Regulations currently reflects the class headings in the Tenth Edition of the Nice Classification, which came into effect on 1 January 2016. Trade marks are registered with reference to the specific goods or services in relation to which they are intended to be used. The Nice Classification is an international standard providing guidance on the grouping of goods and services into numbered classes which are described in short descriptions known as ‘class headings’.

Updating the class headings to reflect the latest edition of the Nice Classification helps Australia meet its obligations under the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks* (Nice Agreement) which requires the Trade Marks Office to include in its

official documents the classes of the goods or services of registered trade marks.

Trade Marks Regulations 1995

Item [53] – Part 1 of Schedule 1 (table items 1 to 11)

This item repeals and replaces the headings for classes 1 to 11.

Item [54] Part 1 of Schedule 1 (table items 13 to 34)

This item repeals and replaces the headings for classes 13 to 34.

Item [55] - Part 2 of Schedule 1 (table items 35 to 38)

This item repeals and replaces the headings for classes 35 to 38.

Item [56] - Part 2 of Schedule 1 (table item 40)

This item repeals and replaces the headings for class 40.

Item [57] - Part 2 of Schedule 1 (table item 42)

This item repeals and replaces the headings for class 42.

Item [58] - Part 2 of Schedule 1 (table items 44 and 45)

This item repeals and replaces the headings for classes 44 to 45.

Part 6 – Application and transitional provisions

This Part amends the Trade Marks Regulations to set out how the amendments in Parts 1 to 4 of Schedule 1 to the Regulations apply in certain circumstances and save the operation of any repealed provisions, as necessary.

Trade Marks Regulations 1995

Item [59] – In the appropriate position in Part 22

This item inserts a new Division 6 in Part 22 of the Trade Marks Regulations to set out transitional provisions for Parts 1 to 4 of Schedule 1 to the Regulations.

New regulation 22.26 makes transitional arrangements for the amendments in Part 1 of Schedule 1 to the Regulations.

As with the changes in Part 2 of the Amending Act (see item 9 of Schedule 1 to that Act), new regulation 22.26 provides that the previous grace period as in force immediately before commencement will continue to apply for a trade mark entered in the Register under section 69 of the Trade Marks Act prior to commencement. The new grace period in amended subregulation 21.21(6) and table item 12 of Schedule 9 applies only to trade marks entered into the Register following commencement.

These transitional arrangements prevent the new, shorter grace period applying to any trade marks which were registered prior to commencement.

New regulation 22.27 makes transitional arrangements for the amendments in Part 2 of Schedule 1 to the Regulations.

As with the changes in Part 4 of the Amending Act (see item 16 of Schedule 1 to that Act), new regulation 22.27 provides that the new provisions restoring a trade mark to the Register only apply to a trade mark removed from the Register after commencement. The new regulation 9.18A, as inserted by Part 4 of these Regulations applies to a trade mark removed from the Register under paragraph 97(1)(a) of the Act after commencement.

These transitional arrangements ensure that no trade mark removed prior to commencement is affected by the changes.

New regulation 22.28 makes transitional arrangements for the amendments in Part 3 of Schedule 1 to the Regulations.

Part 3 of the Regulations provides for the publication of information on certain online locations rather than the previous Official Journal, following the removal of the requirement to maintain an Official Journal from section 226 of the Trade Marks Act by Part 5 of the Amending Act.

As with the changes in Part 5 of the Amending Act (see item 40 of Schedule 1 to that Act), new regulation 22.28 provides for the circumstances in which the amendments regarding publishing information apply. This information is presented in tabular form.

In general terms, new regulation 22.28 provides that the amendments made by Part 3 of Schedule 1 to the Regulations apply to actions taken after commencement of this Part. In some cases, where it is appropriate, the new provisions also apply when certain actions occurred prior to commencement but had not yet been published at the time of commencement.

In particular, table items 1, 4 to 7, 14, 16 to 18, and 20 to 22 in new regulation 22.28 provide that the amendments made by substantive items 4, 5, 9, 10, 12 to 14, 16, 17, 38, 40, 41, 43, and 45 to 48 apply in relation to the various things referred to in those items (requests, applications, registrations, decisions, determinations or directions) if these things occur or are made after commencement of this Part.

Table items 2 to 3, 8 to 13, 15, and 19 in new regulation 22.28 provide that the amendments made by substantive items 6 to 8, 11, 18 to 37, 42, 44 and 49 in Part 3 of Schedule 1 to the Regulations apply in relation to the various actions referred to in those provisions (requests, applications, assessments, recordings, registrations, decisions or determinations, and withdrawals) if these occur or are made after commencement of this Part, *or* if these occur or are made prior to commencement but have not yet been published at the time of commencement.

This is because these items relate to matters where the action and publication of that

action are separate. For example, items 19 to 29 and 49 apply in relation to publication of an initial assessment, which can either be made before or after commencement, but has not been published prior to commencement. As the amendments relate to publication, rather than the substantive assessment itself, it is appropriate that the method of publication may change after commencement. In many cases, these changes are also timed to commence in alignment with changes to related provisions in the Trade Marks Act by the Amending Act.

New regulation 22.29 makes transitional arrangements for the amendments in Part 4 of the Regulations.

Part 4 of the Regulations enables a discontinued AFS request to be 'revived' in certain circumstances, by way of extending the time for undertaking certain tasks. New regulation 22.29 specifies that the amendments to regulations 3A.5 and 4.2A, and the new regulations 3A.6 and 3A.7, as changed and/or added by Part 4 of Schedule 1, apply to an AFS request for which the Registrar has formed an opinion under subregulation 3A.4(1) if this opinion is formed on or after commencement, or if this opinion is formed prior to commencement but the Registrar has not yet informed the requester under subregulation 3A.4(2) at the time of commencement.

These transitional arrangements ensure that the changes do not impact AFS requests where the Registrar informed the requestor of their opinion prior to commencement. The changes apply if a request is amended under subregulation 3A.5(2) and, after commencement, the Registrar assesses the *amended* AFS request and informs the requester of their new opinion under subregulation 3A.4(2).

Part 7 Spent provisions

This Part amends the Patents Regulations to repeal transitional provisions which have had no effect from February 2022. This follows similar amendments that were made to the Patents Act by Part 6 of the Amending Act, which repealed several transitional and savings provisions related to the *Patents Act 1952* (the 1952 Act).

Patents Regulations 1991

Item [60] – Regulation 1.3

This item repeals the definition of 'former patents Regulations' in regulation 1.3. This definition is only referred to in regulations 23.3, 23.4, 23.8, and 23.10. As these regulations are repealed under this instrument (see below), this definition is no longer necessary. This item is machinery in nature with no impact on administration of Australia's patent system.

Item [61] – Regulations 23.2 to 23.26

This item repeals regulations 23.2 to 23.26 (noting there are no regulations between 23.18 and 23.25).

Part 1 of Chapter 23 of the Patents Regulations includes several transitional provisions to ensure that patents granted under the 1952 Act would continue to be

treated in the same way after the 1952 Act was repealed. The last patent protected under the 1952 Act expired in February 2016, and the 6-year statutory limitations period on actions for infringement expired in February 2022. This has rendered regulations 23.2 to 23.18, and 23.25 to 23.26 redundant, as there are no longer any patent rights to which these provisions apply. This item is machinery in nature with no impact on administration of Australia's patent system.

Attachment B

Statement of Compatibility with Human Rights

Prepared in accordance with Part 3 of the Human Rights (Parliamentary Scrutiny) Act 2011

Intellectual Property Laws Amendment (Regulator Performance) Regulations 2024

This 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 (Regulator Performance) Regulations 2024 amends the *Trade Marks Regulations 1995* and the *Patents Regulations 1991* to reduce unnecessary regulatory burden, enabling IP Australia to act as an efficient regulator and engage with customers in a modern and flexible way. Amendments include:

- Consequential amendments relating to aligning renewal grace periods for trade marks
- Consequential amendments relating to restoration of trade marks to the Register
- Consequential amendments relating to powers allowing Registrar of Trade Marks to determine the form in which required information will be communicated under the Trade Marks Act
- Amendments to the Trade Marks Regulations to allow an extension of time for Assisted Filing Service requests
- Update Nice Classification headings
- Specifying application and transitional provisions
- Consequential amendments following the repeal of parts of Chapter 23 of the Patents Act

Human rights implications

This Legislative Instrument does not engage any of the applicable rights or freedoms.

Conclusion

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

The Hon Ed Husic MP, Minister for Industry and Science