

# EXPOSURE DRAFT



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## Trade Marks Amendment (Division of International Registrations and Other Measures) Regulations 2019

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I, General the Honourable Sir Peter Cosgrove AK MC (Ret'd), Governor-General of the Commonwealth of Australia, acting with the advice of the Federal Executive Council, make the following regulations.

Dated 2019

Peter Cosgrove  
Governor-General

By His Excellency's Command

Karen Andrews [**DRAFT ONLY—NOT FOR SIGNATURE**]  
Minister for Industry, Science and Technology

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EXPOSURE DRAFT



# EXPOSURE DRAFT

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## Contents

1	Name.....	1
2	Commencement .....	1
3	Authority.....	1
4	Schedules.....	1
<b>Schedule 1—Amendments relating to the division of international registration</b>		2
	<i>Trade Marks Regulations 1995</i>	2
<b>Schedule 2—Technical amendments</b>		7
	Part 1—General amendments	7
	<i>Trade Marks Regulations 1995</i>	7
	Part 2—Amendments substituting references to Protocol with references to Madrid Protocol	10
	<i>Trade Marks Regulations 1995</i>	10
<b>Schedule 3—Amendments relating to the Common Regulations</b>		11
	Part 1—General amendments	11
	<i>Trade Marks Regulations 1995</i>	11
	Part 2—Amendments substituting references to Common Regulations with references to Madrid Regulations	12
	<i>Trade Marks Regulations 1995</i>	12



# EXPOSURE DRAFT

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## 1 Name

This instrument is the *Trade Marks Amendment (Division of International Registrations and Other Measures) Regulations 2019*.

## 2 Commencement

- (1) Each provision of this instrument specified in column 1 of the table commences, or is taken to have commenced, in accordance with column 2 of the table. Any other statement in column 2 has effect according to its terms.

Commencement information		
Column 1	Column 2	Column 3
Provisions	Commencement	Date/Details
1. Sections 1 to 4 and anything in this instrument not elsewhere covered by this table	The day after this instrument is registered.	
2. Schedule 1	The day after the end of the period of 6 months beginning on the day this instrument is registered.	
3. Schedule 2, Part 1	The day after this instrument is registered.	
4. Schedule 2, Part 2	Immediately after the commencement of the provisions covered by table item 3.	
5. Schedule 3, Part 1	1 February 2020.	1 February 2020
6. Schedule 3, Part 2	Immediately after the commencement of the provisions covered by table item 5.	1 February 2020

Note: This table relates only to the provisions of this instrument as originally made. It will not be amended to deal with any later amendments of this instrument.

- (2) Any information in column 3 of the table is not part of this instrument. Information may be inserted in this column, or information in it may be edited, in any published version of this instrument.

## 3 Authority

This instrument is made under the *Trade Marks Act 1995*.

## 4 Schedules

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.

# EXPOSURE DRAFT

Schedule 1 Amendments relating to the division of international registration

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## Schedule 1—Amendments relating to the division of international registration

### *Trade Marks Regulations 1995*

#### **1 Regulation 17A.2 (definition of *date of international registration*)**

Repeal the definition, substitute:

*date of international registration* means:

- (a) for a trade mark that is the subject of a request made under Article 3ter(1) of the Madrid Protocol for extension to Australia of the protection resulting from the international registration of the trade mark—the date recorded in the International Register as the international registration date for the trade mark; or
- (b) for a trade mark that is the subject of a divisional IRDA that is taken, under paragraph 17A.35AD(5)(a), to be a request made under Article 3ter(1) of the Madrid Protocol for extension to Australia of the protection resulting from the international registration of the trade mark—the date of international registration of the trade mark that is the subject of the parent IRDA to which the divisional IRDA relates.

Note: Paragraph (b) of this definition may apply to a trade mark that is the subject of a divisional IRDA either:

- (a) where paragraph (a) of this definition applies to the trade mark that is the subject of the parent IRDA; or
- (b) where the parent IRDA is itself a divisional IRDA so that the date of international registration for the trade mark that is the subject of the parent IRDA has been determined by applying paragraph (b) of this definition.

#### **2 Regulation 17A.2 (definition of *date of recording*)**

Repeal the definition, substitute:

*date of recording* means:

- (a) for a trade mark that is the subject of a request made under Article 3ter(2) of the Madrid Protocol for extension to Australia of the protection resulting from the international registration of the trade mark—the date recorded in the International Register as the recordal date for the request; or
- (b) for a trade mark that is the subject of a divisional IRDA that is taken, under paragraph 17A.35AD(5)(b), to be a request made under Article 3ter(2) of the Madrid Protocol for extension to Australia of the protection resulting from the international registration of the trade mark—the date of recording of the parent IRDA to which the divisional IRDA relates.

Note: Paragraph (b) of this definition may apply to a trade mark that is the subject of a divisional IRDA either:

- (a) where paragraph (a) of this definition applies to the trade mark that is the subject of the parent IRDA; or
- (b) where the parent IRDA is itself a divisional IRDA so that the date of recording for the trade mark that is the subject of the parent IRDA has been determined by applying paragraph (b) of this definition.

# EXPOSURE DRAFT

Amendments relating to the division of international registration **Schedule 1**

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## 3 Regulation 17A.2

Insert:

*divided goods or services*, in relation to a divisional request, has the meaning given by subregulation 17A.35AA(1).

*divisional international registration* of a trade mark means registration of the mark by the International Bureau in accordance with rule 27bis(4) of the Common Regulations.

*divisional IRDA* has the meaning given by subregulation 17A.35AD(4).

*divisional request* has the meaning given by subregulation 17A.35AA(1).

*parent goods or services*, in relation to a parent IRDA, has the meaning given by subregulation 17A.35AA(1).

*parent IRDA* has the meaning given by subregulation 17A.35AA(1).

*pending*, in relation to an IRDA, has the meaning given by regulation 17A.4A.

## 4 At the end of Division 1 of Part 17A

Add:

### 17A.4A Meaning of *pending*

An IRDA is *pending* from the time the Registrar receives from the International Bureau a notification of the IRDA until the earliest of one of the following:

- (a) if the IRDA is rejected in whole under subregulation 17A.24(3) and there is no appeal against the decision—the end of the period allowed for appeal;
- (b) if:
  - (i) the IRDA is rejected in whole under subregulation 17A.24(3); and
  - (ii) there is an appeal against the decision; and
  - (iii) the decision is affirmed on appeal;  
the affirmation of the decision;
- (c) protection in respect of all the goods or services listed in the IRDA is refused under paragraph 17A.34H(4)(b);
- (d) if protection in respect of all the goods or services listed in the IRDA is refused under regulation 17A.34N and there is no appeal against the decision—the end of the period allowed for appeal;
- (e) if:
  - (i) protection in respect of all the goods or services listed in the IRDA is refused; and
  - (ii) there is an appeal against the decision; and
  - (iii) the decision is affirmed on appeal;  
the affirmation of the decision;
- (f) the trade mark that is the subject of the IRDA becomes a protected international trade mark.

## 5 After Subdivision C of Division 3 of Part 17A

Insert:

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# EXPOSURE DRAFT

Schedule 1 Amendments relating to the division of international registration

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## Subdivision D—Divisional requests

### 17A.35AA Divisional requests

- (1) If:
- (a) a single IRDA (the *parent IRDA*) relating to the international registration of a trade mark in respect of certain goods or services (the *parent goods or services*) is made; and
  - (b) the parent IRDA is pending;

the holder of the parent IRDA may make another request (the *divisional request*) to create a divisional international registration of the trade mark in respect of some only (the *divided goods or services*) of the parent goods or services.

Note: For *holder*, see regulation 17A.2; for *pending*, see regulation 17A.4A.

- (2) A divisional request must be made to the International Bureau through the intermediary of the Trade Marks Office.
- (3) To avoid doubt, the parent IRDA may itself be a divisional IRDA.

### 17A.35AB Rules relating to divisional requests

A divisional request in relation to the international registration of a trade mark in respect of goods or services must:

- (a) be in the approved form; and
- (b) specify the following:
  - (i) the name of the holder of the parent IRDA to which the divisional request relates;
  - (ii) the address for service in Australia or New Zealand for the holder;
  - (iii) the number of the international registration of the trade mark that is the subject of the parent IRDA as accorded by the International Bureau;
  - (iv) the number of the parent IRDA in the Record of International Registrations as accorded by the Registrar;
  - (v) the goods or services to which the divisional request relates, grouped according to the appropriate classes described in Schedule 1;
  - (vi) the goods or services that are to remain in the parent IRDA, grouped according to the appropriate classes described in Schedule 1; and
- (c) be filed at the Trade Marks Office.

### 17A.35AC Registrar to perform the functions of the Office of the designated Contracting Party

If a divisional request is filed, the Registrar must:

- (a) perform the functions, under rule 27*bis* of the Common Regulations, of the Office of the designated Contracting Party (within the meaning of those Regulations) in relation to the divisional request; and
- (b) do so as soon as practicable after the divisional request is filed.



# EXPOSURE DRAFT

Amendments relating to the division of international registration **Schedule 1**

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## **17A.35AD Effect of divisional international registration**

- (1) This regulation applies if:
  - (a) a divisional request is made under regulation 17A.35AA in respect of divided goods or services; and
  - (b) the International Bureau creates the divisional international registration for the divided goods or services as a result of that request; and
  - (c) the International Bureau notifies the Registrar of the creation of the divisional international registration in accordance with rule 27bis(4)(a) of the Common Regulations.

### *Effect of divisional international registration on parent IRDA*

- (2) Subject to subregulation (3), the parent IRDA is taken, from the day the International Bureau notifies the Registrar of the creation of the divisional international registration, not to include a request, made under Article 3ter(1) or (2) of the Madrid Protocol, for extension to Australia of the protection resulting from the international registration of a trade mark in respect of the divided goods or services.
- (3) Subregulation (2) does not apply if the parent IRDA to which the divisional request relates is not pending when the International Bureau notifies the Registrar of the creation of the divisional international registration.

Note: For *pending*, see regulation 17A.4A.

### *Creation of divisional IRDA*

- (4) The creation of the divisional international registration is taken to create an IRDA (a **divisional IRDA**) for the divided goods or services.
- (5) For the purposes of these Regulations, the divisional IRDA is taken to be:
  - (a) a request made under Article 3ter(1) of the Madrid Protocol for extension to Australia of the protection resulting from the international registration of a trade mark, if the parent IRDA is such a request; or
  - (b) a request made under Article 3ter(2) of the Madrid Protocol for extension to Australia of the protection resulting from the international registration of a trade mark, if the parent IRDA is such a request.
- (6) If:
  - (a) the parent IRDA claims a right of priority in respect of a good or service; and
  - (b) the divided goods or services include that good or service;then, for the purposes of these Regulations, the divisional IRDA is taken to include a claim for right of priority for the protection of the trade mark in respect of that good or service.
- (7) For the purposes of these Regulations, the notification of the creation of the divisional international registration is taken to be notification of an IRDA received by the Registrar from the International Bureau.

## **6 At the end of Division 2 of Part 22**

Add:

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# EXPOSURE DRAFT

**Schedule 1** Amendments relating to the division of international registration

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**22.13A Amendments made by Schedule 1 to the *Trade Marks Amendment (Division of International Registrations and Other Measures) Regulations 2019***

The amendments made by Schedule 1 to the *Trade Marks Amendment (Division of International Registrations and Other Measures) Regulations 2019* apply in relation to an IRDA that is pending (within the meaning of Part 17A of these Regulations) on or after the commencement of this regulation.

**7 Clause 1 of Schedule 9 (after table item 3)**

Insert:

- |    |   |   |
|----|---|---|
| 3A | Filing a divisional request under regulation 17A.35AA to create a divisional international registration of a trade mark in respect of divided goods or services | \$350 for each class of divided goods or services |
|----|---|---|

## Schedule 2—Technical amendments

### Part 1—General amendments

#### *Trade Marks Regulations 1995*

##### **1 Regulation 2.1 (definition of *international registration*)**

Omit “has the meaning given by regulation 17A.2”, substitute “has the meaning given by section 189A of the Act”.

##### **2 Regulation 2.1 (definition of *Madrid Protocol*)**

Repeal the definition, substitute:

*Madrid Protocol* has the meaning given by section 189A of the Act.

##### **3 Regulation 2.1 (definition of *protected international trade mark*)**

Omit “has the meaning given by regulation 17A.2”, substitute “has the meaning given by section 189A of the Act”.

##### **4 Regulation 8.3**

Omit “the grounds mentioned in subregulation 5.18(1)”, substitute “any of the grounds mentioned in regulation 4.15A”.

##### **5 Regulation 17A.1**

Omit “This Part”, substitute “For the purposes of section 189A of the Act, this Part”.

##### **6 At the end of regulation 17A.1**

Add:

- Note: Under subsection 189A(3) of the Act, regulations made for the purposes of section 189A:
- (a) may be inconsistent with the Act; and
  - (b) prevail over the Act (including any other regulations or other instruments made under the Act), to the extent of any inconsistency.

##### **7 Regulation 17A.2**

Before “*change of ownership*”, insert “In this Part:”.

##### **8 Regulation 17A.2 (definition of *Common Regulations*)**

Omit “1 September 2009”, substitute “1 February 2019”.

##### **9 Regulation 17A.2**

Insert:

*date of effect* of the protection of a protected international trade mark has the meaning given by regulation 17A.4.

##### **10 Regulation 17A.2 (definition of *international registration*)**

Repeal the definition.

# EXPOSURE DRAFT

## Schedule 2 Technical amendments

### Part 1 General amendments

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#### 11 Regulation 17A.2

Insert:

*IRDA*: see *international registration designating Australia*.

#### 12 Regulation 17A.2

Repeal the following definitions:

- (a) definition of *priority date*;
- (b) definition of *protected international trade mark*;
- (c) definition of *Protocol*.

#### 13 Subregulations 17A.3(1) and (2)

Omit “priority date”, substitute “*priority date*”.

#### 14 Subregulation 17A.4(1)

Omit “date of effect”, substitute “*date of effect*”.

#### 15 Subregulation 17A.4(2)

Repeal the subregulation, substitute:

(2) If:

- (a) the request for extension of protection to Australia was in respect of a trade mark whose registration had also been sought in one or more Convention countries; and
- (b) the holder claimed a right of priority under regulation 17A.15 for protection of the trade mark in respect of particular goods or services in respect of which registration was sought in that country or in those countries; and
- (c) the trade mark is a protected international trade mark;

the *date of effect* of the protection of the trade mark in respect of the goods or services is:

- (d) if an application to register the trade mark was made in only one Convention country—the date on which the application was made in that country; or
- (e) if an application to register the trade mark was made in more than one Convention country—the date on which the earliest of those applications was made.

#### 16 Subdivision 1 of Division 3 of Part 17A (heading)

Omit “Subdivision 1”, substitute “Subdivision A”.

#### 17 Paragraph 17A.12(b)

Omit “Subdivision 2”, substitute “Subdivision B”.

#### 18 Subregulation 17A.15(2) (note)

Omit “Rule 9(4)(iv)”, substitute “Rule 9(4)(a)(iv)”.

# EXPOSURE DRAFT

Technical amendments **Schedule 2**  
General amendments **Part 1**

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**19 Paragraph 17A.16(1)(b)**

Omit “Subdivision 2”, substitute “Subdivision B”.

**20 Paragraph 17A.18(2)(b)**

Omit “Subdivision 2”, substitute “Subdivision B”.

**21 Paragraph 17A.20(1)(b)**

Omit “Subdivision 2”, substitute “Subdivision B”.

**22 Subdivision 2 of Division 3 of Part 17A (heading)**

Omit “Subdivision 2”, substitute “Subdivision B”.

**23 Subregulation 17A.34(1)**

Omit “Subdivision 2”, substitute “Subdivision B”.

**24 Subdivision 3A of Division 3 of Part 17A (heading)**

Omit “Subdivision 3A”, substitute “Subdivision E”.

**25 Subdivision 4 of Division 3 of Part 17A (heading)**

Omit “Subdivision 4”, substitute “Subdivision F”.

**26 Subdivision 1 of Division 5 of Part 17A (heading)**

Omit “Subdivision 1”, substitute “Subdivision A”.

**27 Subdivision 2 of Division 5 of Part 17A (heading)**

Omit “Subdivision 2”, substitute “Subdivision B”.

**28 Subdivision 3 of Division 5 of Part 17A (heading)**

Omit “Subdivision 3”, substitute “Subdivision C”.

# EXPOSURE DRAFT

Schedule 2 Technical amendments

Part 2 Amendments substituting references to Protocol with references to Madrid Protocol

## Part 2—Amendments substituting references to Protocol with references to Madrid Protocol

### *Trade Marks Regulations 1995*

#### 29 Amendments of listed provisions—Madrid Protocol

References to Protocol to be substituted with references to Madrid Protocol			
Item	Provision	Omit	Substitute
1	Regulation 17A.2 (definition of <i>date of international registration</i> )	Protocol	Madrid Protocol
2	Regulation 17A.2 (definition of <i>date of recording</i> )	Protocol	Madrid Protocol
3	Regulation 17A.2 (definition of <i>International Register</i> )	Protocol	Madrid Protocol
4	Regulation 17A.2 (definition of <i>international registration designating Australia</i> )	Protocol	Madrid Protocol
5	Regulation 17A.2 (definition of <i>Office of origin</i> )	Protocol	Madrid Protocol
6	Paragraphs 17A.4(1)(a) and (b)	Protocol	Madrid Protocol
7	Subregulation 17A.6(2) (note)	Protocol	Madrid Protocol
8	Paragraph 17A.7(1)(a)	Protocol	Madrid Protocol
9	Subregulation 17A.8(1)	Protocol	Madrid Protocol
10	Subregulation 17A.8(2) (note)	Protocol	Madrid Protocol
11	Subregulations 17A.10(1) and (3)	Protocol	Madrid Protocol
12	Subregulation 17A.16(2)	Protocol	Madrid Protocol
13	Subregulation 17A.16(3) (note)	Protocol	Madrid Protocol
14	Subregulation 17A.35B(8) (definition of <i>limitation</i> )	Protocol	Madrid Protocol
15	Regulation 17A.40 (note)	Protocol	Madrid Protocol
16	Subregulation 17A.41A(8) (definition of <i>limitation</i> )	Protocol	Madrid Protocol
17	Subregulation 17A.42(2)	Protocol	Madrid Protocol
18	Regulation 17A.47 (note)	Protocol	Madrid Protocol
19	Subparagraphs 17A.48D(2)(g)(i) and (ii)	Protocol	Madrid Protocol
20	Paragraph 17A.51(a)	Protocol	Madrid Protocol
21	Division 8 of Part 17A (note to heading)	Protocol	Madrid Protocol
22	Regulation 17A.60 (note)	Protocol	Madrid Protocol
23	Paragraphs 17A.66(2)(e) and (3)(f)	Protocol	Madrid Protocol
24	Subregulation 17A.69(3)	Protocol (wherever occurring)	Madrid Protocol
25	Paragraphs 22.18(a) and (b)	Protocol	Madrid Protocol

# EXPOSURE DRAFT

Amendments relating to the Common Regulations **Schedule 3**  
General amendments **Part 1**

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## Schedule 3—Amendments relating to the Common Regulations

### Part 1—General amendments

#### *Trade Marks Regulations 1995*

##### **1 Regulation 17A.2 (definition of *Common Regulations*)**

Repeal the definition.

##### **2 Regulation 17A.2**

Insert:

*Madrid Regulations* means the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as in force on 1 February 2020.

# EXPOSURE DRAFT

Schedule 3 Amendments relating to the Common Regulations

Part 2 Amendments substituting references to Common Regulations with references to Madrid Regulations

## Part 2—Amendments substituting references to Common Regulations with references to Madrid Regulations

### *Trade Marks Regulations 1995*

#### 3 Amendments of listed provisions—Madrid Regulations

References to Common Regulations to be substituted with references to Madrid Regulations			
Item	Provision	Omit	Substitute
1	Regulation 17A.2 (definition of <i>Contracting Party of the holder</i> )	Common Regulations	Madrid Regulations
2	Regulation 17A.2 (definition of <i>divisional international registration</i> )	Common Regulations	Madrid Regulations
3	Subregulation 17A.6(3)	Common Regulations	Madrid Regulations
4	Subregulation 17A.8(2) (note)	Common Regulations	Madrid Regulations
5	Regulation 17A.14A (note)	Common Regulations	Madrid Regulations
6	Subregulation 17A.15(2) (note)	Common Regulations	Madrid Regulations
7	Subregulation 17A.16(1)	Common Regulations	Madrid Regulations
8	Paragraph 17A.25(2)(a)	Common Regulations	Madrid Regulations
9	Subregulation 17A.32(2)	Common Regulations	Madrid Regulations
10	Paragraph 17A.35AC(a)	Common Regulations	Madrid Regulations
11	Paragraph 17A.35AD(1)(c)	Common Regulations	Madrid Regulations
12	Subregulations 17A.35B(2) and (3)	Common Regulations	Madrid Regulations
13	Paragraph 17A.35B(5)(b)	Common Regulations	Madrid Regulations
14	Subregulations 17A.41A(2) and (3)	Common Regulations	Madrid Regulations
15	Paragraph 17A.41A(5)(b)	Common Regulations	Madrid Regulations
16	Paragraph 17A.50(3)(c)	Common Regulations	Madrid Regulations
17	Paragraph 17A.54(5)(b)	Common Regulations	Madrid Regulations
18	Regulation 17A.57	Common Regulations	Madrid Regulations
19	Subregulation 17A.58(1)	Common Regulations	Madrid Regulations
20	Subregulation 17A.58A(1)	Common Regulations	Madrid Regulations
21	Paragraph 17A.59(1)(a)	Common Regulations	Madrid Regulations
22	Paragraphs 17A.66(2)(e) and (3)(f)	Common Regulations	Madrid Regulations
23	Subregulation 17A.69(3)	Common Regulations (wherever occurring)	Madrid Regulations