

Exposure Draft of the Intellectual Property Laws Amendment Regulation 2017: Draft Explanatory Statement

November 2016



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Introduction

This Explanatory Statement accompanies an Exposure Draft of the Intellectual Property Laws Amendment Regulation 2017, which is proposed to implement a number of measures in the Intellectual Property Laws Amendment Bill 2017.

The proposed amendments in this Regulation assume that amendments in Schedules 1-3 of the *Intellectual Property Legislation Amendment (Single Economic Market and Other Measures) Regulation 2016* have come into effect, which is expected to occur on 24 February 2017.

IP Australia invites interested parties to make written submissions on the Exposure Draft Regulation and this draft Explanatory Statement by **22 January 2017**.

Written submissions should be sent to consultation@ipaaustralia.gov.au.

For accessibility reasons, please submit responses by email in Word, RTF, or PDF format.

The contact officer is Lisa Bailey, who may be contacted on (02) 6222 3695, or via lisa.bailey@ipaaustralia.gov.au.

DRAFT

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- IP Australia's Privacy Contact Officer details.

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Overview of Intellectual Property Laws Amendment Regulation 2017

Intellectual Property Legislation Amendment Regulation 2017

Issued by the Authority of the Minister for Industry, Innovation and Science

Designs Act 2003

Olympic Insignia Protection Act 1987

Patents Act 1990

Plant Breeder's Rights Act 1994

Trade Marks Act 1995

Intellectual Property Laws Amendment Bill 2017

Legislative Authority

Subsection 149(1) of the *Designs Act 2003* ('Designs Act'), section 76 of the *Olympic Insignia Protection Act 1987* ('OIP 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 Acts') provide that the Governor-General may make regulations prescribing matters required or permitted by the Acts to be prescribed, or necessary or convenient to be prescribed for carrying out or giving effect to the Acts.

The Intellectual Property Laws Amendment Bill 2017 ('Amendment Bill') will amend the Acts to streamline and align processes in the Acts, enable more electronic processing and to support small business.

The Acts do not specify any conditions that must be met before the power to make the Regulation may be exercised. The Amendment Bill will not alter this status.

The Regulation

The Intellectual Property Legislation Amendment Regulation 2017 ('Regulation') amends the *Designs Regulations 2004* ('Designs Regulations'), the *Olympic Insignia Protection Regulations 1993* ('OIP Regulations'), the *Patents Regulations 1991* ('Patents Regulations'), the *Plant Breeder's Rights Regulations 1994* ('PBR Regulations'), and the *Trade Marks Regulations 1995* ('Trade Marks Regulations'),—collectively 'the Regulations'—to prescribe matters required under the provisions of the Acts as amended by the Amendment Bill. The Regulation also amends the Regulations to align and streamline the processes for obtaining and maintaining IP rights.

Purposes of the Regulation

The various Parts in Schedule 1 to the Regulation amend the Regulations as follows:

Part 1—Renewals and terminology

- aligns the payment of the different fees for the renewal of rights and the continuation of applications, including standardising fees for payment in the six-month grace period following a due date.
- aligns terminology in the Trade Marks Regulations with that in the Patents Regulations and Designs Regulations.

Part 2—Examination, re-examination and reconsideration

- prescribes matters required for the re-examination of registered designs, patents and granted plant breeder's rights under new provisions inserted by Part 2 of Schedule 1 to the Amendment Bill.
- prescribes a fee for requesting revocation of a registered trade mark under a new provision inserted by Part 2 of Schedule 1 to the Amendment Bill.
- provides for the Registrar to revoke acceptance of an international registration designating Australia (on request) or to cease protection of a protected international trade mark (on request and payment of a prescribed fee).

Part 3—Extensions of time and protection of third parties

- prescribes the periods for filing applications for extensions of time under the new provisions inserted into the Acts by Part 3 of Schedule 1 to the Amendment Bill. These periods are two months from the applicant becoming aware of the need for the extension or the ceasing of the circumstances that prevented the relevant act being done in time.
- prescribes the period of one month for filing a notice of objection to a short extension (up to three months) under the new provisions.
- prescribes the fees payable for seeking extensions of time under the new provisions.
- amends the Trade Marks Regulations to make special provision for seeking extensions of time in opposition proceedings.

Part 4—Written requirements

- removes requirements for giving notice in writing, as a consequence of amendments to the Acts by Part 4 of Schedule 1 to the Amendment Bill. New provisions in the Acts 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.

Part 5—Filing requirements

- provide the consequences for evidence received by IP Australia that does not comply with a direction governing the filing of evidence, given under new sections inserted into the Acts by Part 5 of Schedule 1 to the Amendment Bill.
- make other amendments consequential on the inserting of new sections into the Acts by Part 5 of Schedule 1 to the Amendment Bill. The new sections provide comprehensively for approving means of filing documents and paying fees, and for giving directions for the filing of documents or evidence.

Part 6—Official Journal (Designs, OIP and Trade Marks Regulations only)

- replaces requirements to publish information in the Official Journals with requirements to publish information electronically in accordance with new sections inserted by Part 6 of Schedule 1 to the Amendment Bill. Some publication requirements in the Regulations are repealed altogether, owing to the requirements being set out in new sections of the Acts instead.
- provides for the period for opposing registration of a trade mark to commence on acceptance of the trade mark application, rather than on publication of acceptance having happened (item 312).

Part 7—Amendments of applications or other documents (Designs and Trade Marks Regulations only)

- prescribes the particulars in applications and other documents that could be directly amended by an applicant, or corrected by the Registrar, under the new provisions inserted by Part 7 of Schedule 1 to the Amendment Bill.

Part 8—Signatures (Patents Regulations only)

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

Part 9—Addresses and service of documents (Designs, Patents and Trade Marks Regulations only)

- repeals provisions for addresses for correspondence. The providing and use of these addresses can be handled by means of approved forms.
- 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 10—Examination of standard patent requests and specifications

- sets out the relevant periods for requesting examination of a patent application, as a consequence of amendments to the Patents Act by Part 11 of Schedule 1 to the Amendment Bill. New provisions in the Patents Act permit anyone (“a third party”) to request examination, not just the applicant
- sets out the fees that the third party and the applicant must each pay, and the consequences of not doing so in the relevant one or two-month period

Part 11—Requirements for patent documents

- replaces formality requirements in the Patents Regulations (including those in Schedule 3) with requirements to comply with new provisions inserted by Part 12 of Schedule 1 to the Amendment Bill. This includes new section 229, which enables the Commissioner to issue an instrument determining formality requirements (“s 229 instrument”).
- enables patent specifications to use graphics and/or photographs to describe inventions.

Part 12—Acceptance of trade marks applications

- prescribes a period of 9 months for acceptance of a trade mark application or an international registration designating Australia (“IRDA”).
- provides for acceptance to be deferred for 6 months while an applicant gathers evidence to address grounds for refusing the application or IRDA.
- repeals subregulations 4.12(3) and (4), so that the acceptance period can only be extended under section 224, and new sections 224B and 224C as inserted by Part 3 of Schedule 1 to the Amendment Bill.

Part 13—Registration of designs

- repeals references to the option of publishing rather than registering a design;
- repeals the period in which an application lapses if registration is not requested or the application is not withdrawn; and
- sets out the criteria for a subsequent request for registration to be allowed.

Part 14—Copies of design representations

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

Part 15—Amendment of registered trade mark due to inconsistency with international agreements

- sets out the opposition requirements to a request for amendment of a registered trade mark.

Part 16—Secretary’s role in the Plant Breeder’s Rights Regulations

- devolves the powers of the Secretary of the Department of Industry, Innovation and Science to the Registrar of Plant Breeder’s Rights.

Part 17—Application, transitional and saving provisions

- sets out the effects of the amendments, made by Schedule 1 to the Regulation, on actions undertaken pursuant to the Regulation.

Consultation undertaken on Regulation

In March and June 2015, IP Australia consulted the public on proposed changes to IP processes, including the expanded use of automated processes. A number of submissions were received, and several proposals were changed in light of those submissions.

Further public consultation on the draft text of the Regulation will occur between November 2016 and January 2017.

Regulation Impact Statement

The Office of Best Practice Regulation (‘OBPR’) has advised that no Regulation Impact Statement is required to be prepared for these amendments (OBPR ID 17502, 17566, 17569–70, 17572–3, 17575–6, 17580, 17583, 17734, 19009, 19242, 21007, 21155).

Commencement of the Regulation

As the majority of the items in the Regulation are intended to operate in conjunction with the equivalent items in the Amending Act, the policy for their commencement is the same. Accordingly, most Parts of the Regulation commence at the same time as the equivalent Part of the Amending Act.

The exceptions to this are Parts 8, 9, 14 and 18 which do not rely on changes to the Acts and do not require any prior planning from users of the IP system (and will not need prior notice of the start date of the change). These Parts commence the day after the Regulations are registered on the Federal Register of Legislative Instruments.

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

Attachment – Schedule 1

Part 1 Renewals and terminology

Part 1 of the Amendment Bill amends the IP legislation to align the renewal regimes and the terminology used for the status of IP rights across the four rights. The new legislation introduces a new renewal grace period for PBR applicants and requires the same terminology to be used for similar statuses and processes for consistency across the IP rights. The following amendments to the IP Regulations support those changes to the IP Laws.

Designs Regulations 2004

Item 1: Remove the option of early payment of renewal fees

[reg 4.09]

This item amends the Designs Regulations to prescribe the renewal period of a registered design required by section 47(2) of the Designs Act, as amended by item 1 of the Amendment Bill. The amendments also restrict early payment of renewal fees to 12 months before the fifth anniversary date. This is intended to discourage design owners from paying fees multiple years in advance. This prevents design owners from maintaining rights that no longer have any commercial benefit because the fees have already been paid. These amendments are intended to address two issues.

This item ensures that the renewal period is clearly identified, aligns the terminology used with that used for other IP Rights and encourages owners to only renew a registered design if it is commercially valuable to them.

Other aspects of the existing legislation are retained. The renewal period continues to include the six month grace period currently available under existing regulation 4.09. A late fee will continue to apply to encourage prompt payment.

Item 2: Payment of late fees during the grace period

[sch 4, item 5]

Item 2 amends the Design Regulations to more clearly set out the fee requirements for applications to renew registered designs. The fees are equivalent to what is currently listed under clause 1 of Schedule 4 (table item 5), however, the amended terminology brings the Design Regulations in line with the terminology used in other IP rights. This will help IP rights owners to understand the fee requirements and will simplify the IP system making it more accessible.

Patents Regulations 1991

Items 3 and 4: Remove the option of early payment of continuation fees

[reg 13.3]

These items amend regulation 13.3 of the Patents Regulations 1991 to prescribe the period for paying the continuation fee for a patent required by the amendments introduced by the Amendment Bill. Regulation 13.3 currently determines the date governing payment of continuation fees in respect of applications made

under section 79B or section 79C of the Patents Act (applications divided from a parent application known as divisional applications). The six month grace period for paying a continuation fee currently available under regulation 13.3 will remain. However, the amendments restrict early payment of continuation fees to 12 months before the relevant anniversary. This is intended to discourage patent applicants from paying continuation fees multiple years in advance and maintaining rights that no longer have any commercial benefit because the fees have already been paid.

A late fee will continue to apply to encourage prompt payment. These items ensure that the period for paying continuation fees applicable to divisional applications is clearly identified, align the terminology used with other IP Rights and encourages owners to only continue with a patent if it is commercially valuable to them.

Items 5 – 10: Remove the option of early payment of renewal fees

[reg 13.6]

These items amend regulation 13.6 of the Patents Regulations to prescribe the period for paying the renewal fee for a registered patent required by the amendments introduced by the Amendment Bill. The six month 'grace period' currently available to pay a renewal fee under regulation 13.6 will remain. However, the amendments restrict early payment of renewal fees to 12 months before the relevant anniversary. This is intended to discourage patent owners from paying renewal fees multiple years in advance. This prevents patent owners from maintaining rights that no longer bear any commercial benefit because the fees have already been paid.

A late fee will continue to apply to encourage prompt payment. These items ensure that the renewal period is clearly identified, align the terminology used with other IP Rights and encourages owners to only renew a granted patent if it is commercially valuable to them.

Items 11 – 12: Payment of late fees during the grace period

[sch 7, items 211 and 212]

Items 11 and 12 amend the Patent Regulations to more clearly set out the continuation and renewal fees respectively. The fee amounts are equivalent to what is currently listed under clause 2 of Schedule 7 (table items 211 and 212). However, the amended terminology brings the Patent Regulations in line with the terminology used in other IP rights. This will help IP rights owners to understand the fee requirements and will simplify the IP system making it more accessible.

Plant Breeder's Rights Regulations 1994

Item 13: Introducing a grace period for paying the renewal fee

[reg 3AD]

This item inserts new regulation 3AD into the Plant Breeder's Rights Regulations to identify the period in which a renewal fee must be paid as required by the Amendment Bill.

PBR owners are currently unable to renew their right if they fail to pay their renewal fee by the relevant anniversary date. This item enables the introduction of a new six month renewal 'grace period' with associated late fees to align PBR with the other IP Rights. This will provide PBR owners with a renewal safety net to help avoid permanent loss of a valuable PBR right.

Consistent with the other IP rights, early payment of renewal fees will be restricted to 12 months before the relevant anniversary. This is intended to discourage PBR owners from paying renewal fees multiple years in advance and encourage owners to only renew a granted PBR if it is commercially valuable to them.

Item 14: Payment of late fees during the grace period

[sch 1, item 15]

Item 14 amends the Plant Breeder's Rights Regulations to clearly set out the renewal fees payable and to list the associated late fees payable during the new 'grace period'. The renewal fee is equivalent to the amount currently listed under clause 1 of Schedule 1 (table item 15). However, the amended terminology brings the Plant Breeder's Rights Regulations in line with the terminology used in other IP rights. The new late fee will help to ensure that PBR rights are promptly renewed without preventing the PBR owner from renewing the PBR after the anniversary date and permanently losing their right. This will help IP rights owners to understand the fee requirements and will simplify the IP system making it more accessible.

Trade Marks Regulations 1995

Items 15 – 26; 37 – 51: Refusal of Applications

[regs 4.8, 4.10, 4.12, 4.13, 4.14, 4.15A, 16.2, 17A.12, 17A.16, 17A.18, 17A.20, 17A.21, 17A.22, 17A.24, 17A.26, 17A.28, 17A.34, Subdivision 2 of Division 3]

These items amend several regulations to harmonise the terminology used across the IP rights. The amendments replace the term 'reject' with 'refuse' to align the terminology with the status used for applications in the patents and designs legislation where certain requirements are not met. The process for refusing an application, and for opposing registration, will not change.

Item 27: Removing the requirement to issue a notice of renewal

[reg 7.4]

This item repeals the regulation outlining the requirements which the Registrar needs to meet to notify the registered owner of a trade mark that a renewal request is due. This amendment corresponds with the proposed repeal of section 76 of the Trade Marks Act by the Amendment Bill. Currently the trade marks legislation, but not that of other IP rights, requires the Registrar to notify the owner that renewal of a trade mark is due, even if the notice is not needed or wanted. This increases administrative costs for customers and IP Australia. By repealing the requirement the administrative costs will decrease. However, IP Australia will continue to issue reminder notices to those customers that need or wish to receive them.

Items 28 – 36; 52 – 53: Cancellation of registration

[regs 8.1, 17A.55]

These items amend regulation 8.1 and 17A.55 of the Trade Marks Regulations as required by the proposed amendment to section 84 in the Trade Marks Act of the Amendment Bill. Currently, an owner of a registered trade mark may request that their trade mark be cancelled. The amendment to section 84 changes the terminology from 'request' to 'an offer to surrender registration' which could then result in cancellation. Regulation 8.1 outlines the circumstances in which the Registrar can cancel a trade mark and regulation 17A.55 outlines the effect of cancelling a registered trade mark. These amendments provide for greater consistency with the other IP rights, which use the term 'surrendered' to describe registered and granted rights that have been voluntarily given up by their owners.

Part 2 Examination, re-examination and reconsideration

This part amends the Regulations to:

- prescribe matters required by the new re-examination process as introduced by the Amending Act for registered designs, patents and granted plant breeder's rights;
- allow multiple reports and responses between the Commissioner and the patentee with a clear period of when re-examination ends;
- prevent re-examination and an opposition relating to the same patent from occurring concurrently; and
- improve the transparency of the processes for revoking acceptance of an IRDA and to cease protection for an international trade mark.

These amendments improve IP Australia's processes for reviewing IP rights applications and registrations by removing unnecessary differences between the IP rights and increasing transparency for each review process.

Designs Regulations 2004

Item 54: Ceasing of registration

[reg 4.09A]

This item inserts a new regulation to prescribe the period when ceasing of a registration occurs during the course of a re-examination. Subsection 48(1A) provides that the registration of a design ceases if at the end of the prescribed period the right owner has not filed a request for hearing, the Registrar remains satisfied that a ground for revocation has been made out and no relevant proceedings are pending. Regulation 4.09A prescribes the period to be at the end of six months from the Registrar's first notification, or three months from any later notification, whichever is the later. This is similar to the period prescribed in regulation 5.04 for examination, and provides right owners more time if new grounds for revocation are raised.

Item 55: Examination and re-examination

[Chapter 5, heading]

This item provides a new heading for Chapter 5 to reflect that it covers both the examination process and the new re-examination process.

Item 56: Examination

[Part 1, heading]

This item provides a new heading for the examination process to differentiate it from the new re-examination process.

Item 57: Re-examination

[regs 5.07A, 5.07B, 5.07C, 5.07D, 5.07E, 5.07F]

This item inserts a new Part 2 to provide regulations for the new re-examination process.

New regulation 5.07A prescribes the requirements for a re-examination request under section 68B. The request must be made in the approved form, and must set out the grounds on which the re-examination is sought (which may contain material in relation to the newness and distinctiveness of the registered design). This is similar to the requirements in regulation 5.01 in relation to requests for examination.

New regulation 5.07B sets out the grounds for revocation of a design. A prescribed ground as provided at paragraph 68C(2)(b) of the Act is that, under section 43 of the Act, the design should not have been registered. This mirrors regulation 5.02 in relation to revocation after examination.

New regulation 5.07C prescribes the period for disputing no ground for revocation under subsection 68D(3). A relevant party may file a statement within 30 days beginning on the date of the Registrar's notification. This provides parties with sufficient time to dispute the finding while ensuring the process is not prolonged unnecessarily.

New regulation 5.07D provides the requirements for amendments during re-examination, similar to the requirements for amendments during examination provided by regulation 5.05.

For the registered owner, the request for an amendment: must be in writing; must make it clear that an amendment of the Register is being requested; must set out the nature and extent of the proposed amendments; and must be accompanied by a substitute document or representation incorporating the proposed amendments, or a statement setting out the proposed amendments and the place at which each amendment is proposed to be made.

When dealing with the request for amendments, the Registrar must notify the registered owner if the request does not meet the above requirements, or the proposed amendments increase or alter the scope of the design under subsection 68E(6) of the Act. The Registrar must consider whether the ground for revocation would be removed by the amendments.

New regulation 5.07E prescribes the period for request for a hearing during re-examination under subsection 68G(1). The prescribed period is 6 months from the Registrar's first notification under subsection 68E(1), or 3 months from any *later* notification, whichever is the later. This aligns with the period prescribed in regulation 4.09A after which a registration may cease.

New regulation 5.07F prescribes the details of revocation of registration after re-examination that must be published by the Registrar under subsection 68G(3). The details are the registration number and the date on which the design was revoked.

Items 58 and 59: Material provided to Registrar

[regs 11.06, 11.10]

These items amend the regulations to account for the situation where the re-examination fee is not paid.

Item 60: Filing fee for re-examination

[sch 4, item 4A]

This amendment inserts a new fee item 4A for filing a request for re-examination. At present, when a subsequent examination is requested by a person both that person and the design owner pay a fee. This is inequitable because it is the person that requests re-examination that receives the benefit of re-examination, not the right owner. This amendment provides that the prescribed fee is payable in full by the person who makes the request. This aligns with the fees due for re-examination and revocation for the other IP rights.

Patents Regulations 1991

Items 61 - 73: Re-examination process

These items amend the Patents Regulations to prescribe matters required by the new re-examination process as introduced by the Amendment Bill. The new process allows multiple reports and responses between the Commissioner and the patentee, sets a clear period when re-examination ends and prevents a re-examination and an opposition in relation to the same patent from running in parallel.

Items 61 - 66: Opposition process

[regs 5.2, 5.16, 5.17, 5.19, 5.20]

These items amend the regulations in relation to oppositions as a consequence of the amendments to regulation 9.5 made by item 71 below. At present, there may be concurrent re-examination and opposition in relation to the same patent. In most cases it is more efficient to proceed as quickly as possible with an opposition process rather than complicate it with a concurrent re-examination. Therefore, under subsection 97(1) the Commissioner may choose to not commence re-examination of a standard patent where an opposition is pending. Paragraph 9.5(1)(c) as introduced by item 71 provides that a re-examination under subsection 97(1) of the Act must end on the day a person files a notice of opposition.

Item 61 removes a reference to the term re-examination from the definition of substantive opposition in regulation 5.2.

Item 62 removes from subregulation 5.16(3) the requirement for the Commissioner to not make an amendment to a statement of grounds and particulars where re-examination of the same specification is being conducted.

Item 63 removes from subregulation 5.17(1) the ability for an applicant to request the Commissioner to dismiss an opposition within one month of completion of a re-examination of the specification.

Item 64 repeals regulation 5.19 and therefore the power for the Commissioner to hear and decide an opposition where a re-examination of the specification has been completed.

Item 65 provides a more appropriate heading for regulation 5.20 as a consequence of the repeal of regulation 5.19 by item 64.

Item 66 amends paragraph 5.20(1)(c) to remove reference to regulation 5.19.

Item 67: Request for re-examination of complete specification

[reg 9.2]

This item provides a clearer wording and a more correct reference to the relevant section of the Act.

Items 68 - 70: Copy of report on re-examination

[reg 9.3]

Item 70 removes a provision that is irrelevant to the re-examination process.

Items 68 and 69 amend regulation 9.3 to provide an appropriate structure and reference to the current sections of the Act.

Item 71: Giving of copies of statement disputing report and when re-examination ends

[regs 9.4, 9.5]

This item requires the Commissioner to give of copies of reports and responses, and prescribes the period in which re-examination must be completed.

Regulation 9.3 provides that the Commissioner must give copies of re-examination reports regarding standard and innovation patents to the applicant or patentee, and a person other than the patentee who files a re-examination request. This provides transparency of the process for both patent types. Regulation 9.3 also removes the requirement for the Commissioner to give an opponent a copy of a re-examination report in relation to a standard patent, as a consequence of concurrent re-examination and opposition processes for the same patent no longer being possible.

Regulation 9.4 provides that if a person other than the patentee files a re-examination request, the Commissioner must give that person a copy of any statement filed under section 99 of the Act for standard patents or under section 101H of the Act for innovation patents in response to an adverse report. This provides transparency of the process to third parties in regards to both patent types.

Regulation 9.5 prescribes when re-examination ends for the purposes of subsections 97(3A) and 101G(1A). Currently, when re-examination ends is unclear and does not take into account all relevant events. New regulation 9.5 addresses this by prescribing that a re-examination for standard patents or innovation patents must end on any of the following occasions:

- (a) the day the Commissioner reports that there are no lawful grounds of objection to the specification;
- (b) the day when relevant proceedings have started;
- (c) the day a person files a notice of opposition;
- (d) the day the Commissioner notifies the applicant or the patentee of either: the period for hearing on written submissions; or the date, time and place of an oral hearing.
- (e) the day the court orders the Commissioner to end the re-examination;
- (f) the last day of the 6-month period from the date of the first re-examination report.

Condition (c) prevents unnecessary concurrent reviews from occurring. Similarly, condition (d) provides that re-examination ends with the setting of a hearing as the issues can be resolved through that process. Condition (e) provides the courts with the power to curtail a re-examination it has ordered.

If none of conditions (a) to (e) apply, condition (f) prescribes that re-examination ends at 6-months from

the Commissioner's first report. This provides the applicant or patentee with sufficient time to resolve issues during re-examination while avoiding the uncertainty caused to all parties by a prolonged process. Under subsections 100A(2), 101(2) and 101J(3) the Commissioner may not revoke a patent or refuse to grant a patent unless re-examination has ended. The 6-month period may be extended under section 223 of the Patents Act.

However, it is not intended that the applicant or patentee would be able to make no attempt to resolve the issues and still benefit from the full 6 month period. The applicant or patentee must be making progress to resolve the grounds of invalidity: if they do not make reasonable attempts to resolve the issue the Commissioner is likely to set a hearing date which will end re-examination.

New regulation 9.6 provides that a third party that requests re-examination has the right to participate in a revocation hearing. This provides a more transparent process and proper consideration of the issues.

Item 72: Commissioner to grant leave to amend

[reg 10.5]

This item inserts two paragraphs in the subregulation to allow the Commissioner to grant leave to amendments proposed during re-examination of a standard patent or an innovation patent. This provides an efficient process of dealing with amendments by clarifying that they may only be allowed if they would remove all lawful grounds of objection or for revocation.

Item 73: Review of decisions

[reg 22.26]

This item removes a review provision under regulation 5.19 that is repealed by item 64.

Plant Breeders Rights Regulations 1994

Items 74 – 75: Re-examination process

These items amend Plant Breeder's Rights Regulations 1994 to prescribe matters required for the new re-examination process as introduced by the Intellectual Property Laws Amendment Bill 2017.

Item 74: When re-examination ends

[reg 3AB]

This item inserts a new regulation to prescribe when re-examination ends for the purposes of subsection 49A(4). Regulation 3AB provides that a re-examination must end at the end of the earliest of the following days:

- (a) the day the Registrar issues a clear re-examination report;
- (b) the day the Registrar becomes aware that relevant proceedings have been started;
- (c) the day that the Registrar proposes to revoke the PBR in the plant variety;
- (d) either 6 months from the first re-examination report date; or if, after the first re-examination report, a test growing is required, 6 months from the next report made after the completion of that test growing.

Regulation 3AC prescribes that the grantee has 30 days from the date of an adverse re-examination report to file a statement disputing that report.

The above regulations ensure that issues are resolved in a timely manner and re-examination ends in a fixed time period.

The amendments ensure that issues are resolved in a timely manner and re-examination ends in a fixed time period. The 6 month period provides the grantee with sufficient time to address the issues raised by the Registrar, without avoiding the uncertainty caused to all parties by a prolonged process. Under subsection 50(1) (as amended), the Registrar may not revoke PBR unless re-examination has ended. The 6 month period may be extended under the new general extension of time provisions.

Item 75: Schedule Fees

[Sch 1, item 11]

This item replaces the old revocation request fee with the new re-examination request fee. The amount of the fee is unchanged. New item 11 of the table remains the same as old item 11(b), relating to the revocation of a declaration of essential derivation.

Trade Marks Regulations 1995

Items 76 – 78: Revocation of acceptance of an IRDA and ceasing protection of an international trade mark

These items improve the transparency of the processes for revocation of acceptance of an IRDA and ceasing protection for an international trade mark.

Item 76: Revocation of acceptance of an IRDA

[reg 17A.27]

This item introduces new provisions for the revocation of acceptance of an IRDA. These changes are similar to new subsections 38(3) to 38(7) in relation to accepted and registered trade marks as inserted into the Trade Marks Act by the Amendment Bill. Subregulation 17A.27(3) provides that a revocation may be on the Registrar's own initiative. Subregulation 17A.27(4) provides that a person may request revocation. The request must be in the approved form, and must set out the grounds on which the revocation is sought. If this is complied with, the Registrar must consider whether to revoke the acceptance.

Subregulations 17A.27(6) and (7) provide that the Registrar must notify the relevant parties of his or her decision whether to revoke acceptance or not. These amendments provide a more transparent process by requiring the Registrar to consider a properly made request and to notify all the relevant parties.

Item 77: Ceasing protection of an international trade mark

[reg 17A.42A]

This amendment sets out new requirements for the Registrar when exercising a power to cease protection of an international trade mark. Similar to subregulations 17A.23(3)-(7) added by item 76, new subregulations 17A.42A(5)-(9) prescribe that the *ceasing* of an international mark may be on the Registrar's own initiative or requested by a person. The rationale and intended operation of the provision is the same as for item 76.

Subsection 17A.42A(10) provides that the Registrar has no duty to consider whether or not to exercise a power to impose a condition or limitation, or to *amend*, a protected international trade mark, even if requested to do so. The Registrar only has to act on a properly made request to *cease* the mark.

Item 78: Schedule fees

[Sch 9, items 12A, 12B] This item introduces new fees for making a request to: revoke the registration of a national trade mark; or to cease a protected international trade mark. These fees reflect the service being provided to the person making the request.

Requests to revoke acceptance of a national application or of an IRDA do not incur a fee. Revocation at this stage is typically necessary due to errors made during the examination stage and so it is not appropriate to charge interested parties to address these.

Patents Regulations 1991

Items 79 - 83: Requests for hearing in relation to an examination report

[regs 9A.4, 13.4]

These items provide that, where an applicant requests a hearing in relation to an examination report, the request must be made before examination of the specification is completed.

The examination of a complete specification for an innovation or standard patent must be completed before the end of a number of periods set out in regulations 9A.4 and 13.4 respectively, whichever ends latest. Subparagraphs 9A.4(f) and 13.4(1)(g) provide that, if the Commissioner gives the applicant an opportunity to be heard in relation to a report, and the Commissioner makes a decision in relation to the report, examination ends at 3 months from the decision date. This provides the applicant with further time to respond to the Commissioner's decision. The practice is that requests for such hearings must be made before examination ends, however this is not reflected in the regulations. This creates uncertainty where a request for a hearing is made after examination is complete and the application has lapsed.

Items 79 and 82 insert new subparagraphs 9A.4(f)(ia) and 13.4(1)(g)(i) to provide that the applicant must request the hearing in relation to a report before the end of the examination period, as determined under another paragraph of regulation 9A.4 or 13.4 respectively. This provides certainty for third parties that a lapsed application will not be restored to deal with a hearing requested after examination is complete.

Items 80 and 83 are consequential upon items 262 and 268.

Item 81 amends paragraph 9A.4(f) to enable the Commissioner to set a period longer than three months before examination is completed. This enables the Commissioner to give the applicant more time if necessary to respond to any new grounds raised by the Commissioner.

Part 3 Extensions of time and protections of third parties

Part 3 to the Amendment Bill amends the extension of time provisions. The main changes are:

- repeal the 'despite due care' extension for patents;
- remove the discretion for all general extensions, for all rights. This will simplify the process and ensure compliance with the Patent Law Treaty and Patent Cooperation Treaty;
- require all requests for extensions to be filed within 2 months of the removal of the cause of the failure to comply, to ensure there are no unreasonable delays;
- improve the compensation for third parties that use inventions when a patent had lapsed or ceased, to reduce the burden on third parties acting in good faith;
- expand the protection against infringement for third parties that use a trade mark to include the period when the trade mark application had lapsed if it is later registered;
- introduce a streamlined process for short extensions, but provide IP Australia with the power to review and remake a decision on an extension of time;
- prevent applicants from obtaining consecutive short extensions for the same action;
- provide general extension of time provisions and corresponding third party protection for PBRs.

The following amendments to the IP Regulations support those changes to the IP Laws. Amended fee schedules are also provided to simplify and streamline the process for all four IP rights.

Designs Regulations 2004

Item 84: Reference to extension of time provisions in the Act

[reg 9.05]

This item amends the note under subregulation 9.05(5) to provide a more appropriate reference to the extension of time provisions in the Act.

Item 85: Matters relating to Extensions of time

[reg 11.13]

This item repeals current regulation 11.13 and inserts new regulations to prescribe matters required for the new extension of time provisions under the Designs Act as amended by the Amendment Bill.

Similar to current subregulation 11.13, new subregulation 11.13(1) requires an application for an extension of time to be made in the approved form. However, the amendments only require a declaration to be filed if it is required by the approved form. The intention is that a declaration would be required for applications seeking extensions longer than 3 months, but not for applications seeking short extensions of 3 months or less.

New subregulation 11.13(2) provides the prescribed period for making applications for extensions of time under paragraph 137A(2)(e) of the Act. The applicant must file an application within two months after

becoming aware of the error or omission, or after the circumstances that prevented the relevant act from being done in time, cease to exist. This ensures that applications for extensions are filed promptly while taking the public interest into account.

New subregulations 11.13(3) and (4) provide that a notice of objection (against an application for a short extension) and a notice of opposition (against an application for a long extension) must be made in the approved form and be filed within one month of publication. This is to prevent unreasonable delays from occurring.

Items 86 and 87: Fees for Extension applications

[sch 4, items 7 and 8]

Item 86 sets out the new fee schedule for applications for extension of time.

New fee item 7 prescribes fees payable where extension of time is sought because of an error or omission by the applicant. The new fee schedules are:

- Extensions of up to three months from the initial date the action was due will be charged a single set fee of \$100;
- Extensions beyond three months from the initial date the action was due will be charged an additional \$100 per month or part month in excess of three months.

As most requests for extensions are short extensions of three months or less, introducing a flat fee for this period will simplify the process for both applicants and IP Australia, and further benefit applicants by paying smaller fees for short extensions.

New fee item 8 continues to prescribe the set amount of \$100, if an extension of time is sought due to circumstances beyond the applicant's control.

No fees would be charged for extensions relating to an error or omission made by the Designs Office.

Item 87 inserts an example to demonstrate the fee calculation under fee item 7.

Patents Regulations 1991

Items 88, 93 and 94: References to the extension of time provisions in the Act

[regs 3.13A and 6.3]

This amendment includes new sections 223A to 223H as a consequence of the expansion of the extension of time provisions in the Act. These items replace the reference to section 223 with a more appropriate reference to Chapter 22.

Items 89 to 92: Matters relating to extensions of time of more than three months

[reg 5.10]

These items amend subregulations 5.10(2) to (4) to prescribe matters in relation to oppositions to extensions of time of more than three months.

Items 89 and 90 amend subregulation 5.10(2) which prescribes the period in which a person may file a

notice of opposition. Item 89 replaces the reference to subsection 223(6) with a reference to new subsection 223C(2) which enables a person to oppose the grant of a longer extension. Item 90 replaces the reference to subsection 223(4) with a reference to new subsection 223C(1) which sets out the requirement for the Commissioner to publish certain details of an application for a longer extension.

The time period for filing a notice of opposition will continue to be within 2 months from the day the details relating to the extension application are published in the Official Journal.

Item 91 repeals subregulation 5.10(3) as a consequence of introducing new section 223H of the Act which does not require third parties to apply for a licence to exploit a restored patent. Item 92 is consequential to item 91.

Item 95: References to the extension of time provisions in the Act

[reg 6.11]

This item replaces the reference to section 223 with references to the new extension of time provisions under sections 223A to 223C.

Items 96: Fees for Extension applications

[reg 22.2C]

This item is a consequential amendment to remove a reference to a fee item that is removed by amending item 101 below.

Item 97: Matters relating to Extensions of time

[reg 22.11]

This item repeals regulation 22.11 to prescribe matters required under the provisions of the Act as amended by Part 3 of the Amendment Bill. New regulation 22.11 prescribes:

- the period for making applications for extensions of time;
- the period for a notice of objection to be filed; and
- the circumstances for subparagraph 223H(1)(a)(ii) of the Act in relation to the protection of third parties.

This item also inserts new regulation 22.11A to prescribe relevant acts as defined in Schedule 1 to the Act.

Regulation 22.11 - Extensions of time

Period for making applications

Where an extension of time is sought because of an error or omission by the applicant, or circumstances beyond control, new paragraphs 22.11(1)(a) and (b) prescribe that the application must be filed within two months after the applicant becomes aware of the error or omission, or the circumstances that prevented the relevant act from being done within the certain time, cease to exist.

Objecting to extension

Subregulation 22.11(2) provides that the period for a notice of objection to be filed is one month from

publication of the details of an application for extension of time in the Official Journal. This only applies to short extensions of three months or less. For a formal opposition to an extension of time of more than three months, the period to file a notice of opposition continues to be two months from the publication, as prescribed by subregulation 5.10(2) as amended by items 89 and 90 above.

Protection of third parties

For subparagraph 223H(1)(a)(ii) of the Act, new paragraphs 22.11(3)(a) and (b) of the Regulation provide that the payment of a continuation or renewal fee is a prescribed relevant act, and the failure to pay the fee within a certain period is a prescribed circumstance. This ensures that the protection for third parties extends to the situation where a patent is restored after an extension of time for paying renewal fees is granted.

Regulation 22.11A - Relevant acts

This regulation prescribes relevant acts in relation to extensions of time. All acts except those prescribed continue to be extendable. The same exceptions previously prescribed under subregulation 22.11(4) are now provided under paragraphs 22.11A(a), (b) and (c).

Item 98: Regulation 22.21

[reg 22.21]

This item repeals regulation 22.21 as a consequence of the insertion of new provisions relating to the protection of third parties under subsections 41(5), (5A), (6), (6A), (7) and (8), 150(6), (6A), (7), (7A), (8) and (9); and section 223H of the Act and regulation 22.11A above as inserted by item 97.

Items 99 and 100: Consequential amendments

[reg 22.26]

These items are consequential to item 98 which repeals regulation 22.21.

Items 101 and 102: Fee items

[sch 7, item 2]

This item inserts new fees for extensions of time. The rationale and intended operation is the same as for items 86 and 87 above.

Plant Breeder's Rights Regulations 1994

Items 103 and 104: References to subsections and sections in the Act

[reg 3]

Item 103 is consequential to item 104 which repeals subregulation 3(2).

Item 105: Matters relating to Extensions of time

[reg 3H]

This item inserts new regulation 3H to prescribe matters for purposes of extension of time provisions introduced by the new law.

If a deadline is missed because of an error or omission of the applicant, or circumstances beyond the applicant's control, subregulation 3H(1) prescribes that the period for filing a request for extension is two months after the applicant becomes aware of the error or omission, or the circumstances that prevented the relevant act from being done within the certain time, cease to exist. This requirement is to ensure there are no unreasonable delays after the removal of the cause of the failure to comply.

As for Designs and Patents, if a person objects to the grant of an extension under subsection 76D(2) of the Act, subregulation 3H(2) prescribes one month beginning on the date of the details of an extension application is published for that person to file a notice of objection.

Items 106 to 120: References to the Act

[sch 1, items 1A – 2, 4, 6 – 10, and 12]

These items are consequential to item 4 which repeals subregulation 3(2), to clarify a number of references to the Act in Schedule 1 (Fees).

Items 121 and 122: Fees for Extension Applications

[sch 1, items 16 and 17]

These items set out the new fee schedule for applications for extensions of time, consistent with that introduced for the other IP rights.

Fee item 16 prescribes fees payable where an extension of time is sought because of an error or omission made by the applicant. Similar to the other IP rights, a flat fee of \$100 will apply for short extensions. For longer extensions that are beyond three months from the initial date the action was due, an additional \$100 per month or part month will be charged in excess of three months. Item 122 inserts an example demonstrate the fee calculation under item 16.

New fee item 17 prescribes a single set amount of \$100 if an extension of time is sought because of circumstances beyond the applicant's control. Consistent with the other IP rights, no fees will be charged for extensions relating to an error or omission made by the Registrar or by a person assisting the Registrar. In addition, no fees would be charged for requesting an extension to the period in which a detailed description must be filed under subsection 34(1) of the PBR Act (in accordance with new subsection 76C(3) of the Act).

Trade Marks Regulations 1995

Items 123, 127 and 132: References to the extension of time provisions in the Act

[regs 4.13, 17A.21, 21.11A]

These items amend subregulations 4.13(2) and 17A.21(2) and paragraph 21.11A(2)(f) to insert references that include the new extension of time provisions under sections 224B and 224C.

Items 124, 126, 129 and 131: Extensions for filing a notice of intention to defend

[regs 5.13A, 5.13B, 9.15A, 9.15B, 17A.34HA, 17A.34HB, 17A.48QA, 17A.48QB]

Item 124 inserts new regulations 5.13A and 5.13B to prescribe matters relating to applications seeking to extend the period for filing a notice of intention to defend, if a person opposes the registration of a trade mark by filing a notice of opposition.

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 prescribed period for making the extension application for filing a notice of intention to defend. An applicant must file the extension application within three months from when the applicant was given a copy of the statement of grounds and particulars. This ensures that extension applications are filed promptly while taking the public interest into account.

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 5.13(4) provides the grounds on which an extension may be sought. An applicant would be able to seek an extension 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) provides that the Registrar will have discretion in granting an extension application under new subregulation 5.13A(1).

New subregulation 5.13B(2) provides that for extension applications made beyond the one month period for filing the notice of intention to defend under subregulation 5.13(1), the Registrar must not grant the extension unless he or she is satisfied that there is sufficient reason for the delay in making the application. New subregulation 5.13B(3) enables the Registrar to decide the length of the extension according to the circumstances. These amendments ensure that later extension applications are granted only when they are warranted.

Item 126 inserts corresponding provisions (new regulations 9.15A and 9.15B) to prescribe matters relating to extension applications for filing the notice of intention to defend if there is an application to remove a trade mark from the Register.

Item 129 inserts corresponding provisions (new regulations 17A.34HA and 17A.34HB) to prescribe matters relating to extension 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 131 inserts corresponding provisions (new regulations 17A.48QA and 17A.48QB) to prescribe matters relating to extension applications for filing the notice of intention to defend when a person applies for cessation of protection of a protected international trade mark.

Items 125, 128 and 130: References to extension of time

[regs 9.15, 17A.34H, 17A.48Q]

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.

Item 136: Extensions of time for doing a relevant Act

[reg 21.25]

This item replaces regulation 21.25 to specify the period for making extension applications and the period for objecting to an extension application for three months or less. New subregulation 21.25(1) provides that an extension application must be filed within two months after the applicant becomes aware of the error or omission, or circumstances that prevented the relevant act from being done within the certain time, cease to exist.

New subregulation 21.25(2) requires that the notice of objection to an application for a short extension of three months or less must be filed within one month from the publication of the details of the application according to section 224B(1) of the Act (that is, on IP Australia's website or by any other electronic means).

Items 133 to 135: Notice of opposition

[reg 21.20B]

These items amend regulation 21.20B which specifies the period for filing a notice of opposition against an extension application for more than three months. A person must file a notice of opposition within one month from the day details relating to the extension application are published under new subsection 224C(1) of the Act. The amendments make appropriate references to the new extension of time provisions under section 224C.

Items 137 to 142: Prescribed acts and documents for extensions of time

[reg 21.28]

Items 137 and 140 amend regulation 21.28 to make appropriate references to the definition of a relevant act under subsection 6(1) of the Act.

Items 138 and 139 amend subregulation 21.28(1) to correct the references for filing evidence or requesting renewal.

Items 141 and 142 amend subregulation 21.28(2) to include a notice of intention to defend as a prescribed document.

Items 143 to 149: Fees for Extension Applications

[sch 9, Items 5A – 6, 8 – 9]

These items set out the new fee schedule for applications for extensions of time, consistent with that introduced for the other IP rights.

Fee item 5A prescribes fees payable where an extension of time is sought because of an error or omission made by the applicant or because of special circumstances. Similar to the other IP rights, a flat fee of \$100 will apply for short extensions. For longer extensions that are beyond three months from the initial date the action was due, an additional \$100 per month or part month will be charged in excess of three months. Item 149 inserts an example demonstrate the fee calculation under item 5A.

New fee item 5B prescribes a single set amount of \$100 if an extension of time is sought because of circumstances beyond the applicant's control. Consistent with the other IP rights, no fees will be charged for extensions relating to an error or omission made by the Registrar or by a person assisting the Registrar.

Items 144 to 147 amend table item 6 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).

Item 148 amends table item 8 under Schedule 9 to make a more appropriate reference to new subsection 224C(2) in the Act which relates to an opposition against the grant of an extension.

Item 149 inserts an example to demonstrate how the new fees should be calculated.

Part 4 Written requirements

This part amends the Regulations to:

- remove requirements for giving notice in writing, as a consequence of amendments to the Acts which provide for notification by any means of communication; and
- require the Registrar of Trade Marks to publish the fact of withdrawal of an application, notice or request.

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

Designs Regulations 2004

Item 150: Notice – minimum filing requirements

[reg 3.03]

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

Items 151 to 166: Notification

[regs 4.04, 4.05, 5.03, 5.04, 9.03, 9.05, 10.02, 11.03, 11.23, 11.28]

Item 159 amends subparagraph 5.04(b)(ii) to substitute ‘written notice’ with ‘a notification’. This is a consequential amendment as the Registrar must ‘give written notice’ is replaced by ‘notify’ the registered owner of a ground for revocation under section 66(2).

Items 153, 162, 165 and 166 amend subregulations 5.03(2), 9.05(3), 11.23(2) and regulation 11.28 to replace ‘give notice’ with ‘notify’ or ‘notification’. Notifications may be given in accordance with section 144D of the Act, that is, by any means of communication (including by electronic means). This provides more flexibility in the manner how the Registrar may give information or direct a person to do a thing.

The remaining items replace the term ‘notice’ with the more general term ‘notification’. This is consistent with the changes in the Designs Act to give IP Australia more flexibility in communication means into the future.

Patents Regulations 1991

Items 167 to 170, 177, 178, 184 to 187: Notify

[regs 3.2A, 3.2B, 3.2C, 3.4, 3.5A, 3.24, 3.5A, 3.24, 3.25H, 9.1, 9A.1]

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

Item 185 further 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 section 220A of the Patents Act.

Items 171 to 176, 188, 189: Notification

[regs 3.5, 3.5A, 9A.4, 13.4]

Items 171 and 174 remove the requirement for the Commissioner to give the applicant notice 'in writing' about missing information in a filing. Instead, the Commissioner is required to do so 'by notification to the applicant'.

Items 188 and 189 remove the requirement for the Commissioner to notify the applicant 'in writing' of matters in relation to a hearing on an innovation patent.

These changes remove unnecessary complexity and rigidity in communication means and give the flexibility in the manner the Commissioner may inform the relevant persons.

The remaining items are consequential amendments as a result of items 171 and 174.

Items 179 to 183: Notify

[regs 3.24, 3.25]

Items 179 and 181 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 means). This increases the flexibility in the manner the Commissioner may inform relevant persons.

Items 182 and 183 are consequent amendments to substitute "notice" with "notification".

Plant Breeder's Rights Regulations 1994

Items 190, 191: Notify

[regs 3A, 5]

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 section 72A of the Plant Breeder's Rights Act (as inserted by the Amendment Bill). This gives IP Australia more flexibility in how it gives information into the future.

Trade Marks Regulations 1995

Items 192 to 209, 219 to 234, 236, 237: Notify

[regs 4.2, 4.3, 4.8, 4.10, 4.11, 4.13, 4.14, 4.18, 6.1, 10.5, 11.3, 17A.18, 17A.19, 17A.21, 17A.22, 17A.25, 17A.59, 21.9]

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 section 214A of the Trade Marks Act. This gives the Registrar more flexibility in how he or she gives information into the future.

Consequently all occurrences of 'notice' are replaced by "notification".

Items 210 to 216, 218: Notification

[regs 7.5, 7.7 7.8, 10.5]

These are consequential amendments as a result of “notice” being replaced by “notification” in the Trade Marks Act.

Items 217: Repeal notice requirements

[reg 8.1A]

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

Item 235: Notification of withdrawal of application etc.

[reg 21.10]

The current regulation is unclear about who must be informed about a withdrawal. The amendment addresses this by inserting a requirement to publish the fact of the withdrawal in accordance with section 230A of the Trade Marks Act. This also has the benefit of aligning with the publication requirements for the other IP rights for withdrawals.

DRAFT

Part 5 Filing requirements

This part amends the Regulations to:

- outline the consequences for providing information to IP Australia when the information does not comply with a direction; and
- make consequential amendments due to amendments in the Act regarding the filing of documents and payment of fees.

The amendments will align the processes across the four main IP rights.

Designs Regulations 2004

Items 238 to 245: Repeal of unnecessary provisions relating to document filing

[regs 1.04, 5.08, 11.01, 11.25]

These items amend the Designs Regulations by repealing provisions relating to the means or form by which documents can be filed and fees paid.

Under the Amendment Bill, the Designs Act will be amended such that the Registrar may by published instrument direct how documents can be filed and fees paid. These amendments will cover all forms of document filing and fee payment. As a result, these provisions in the regulations are no longer necessary.

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

Items 246 and 247: Non-compliance in relation to form of filing of documents

[reg 11.27]

These items amend the Designs Regulations as a consequence of the introduction of section 144B of the Designs Act introduced by the Amendment Bill. Section 144B allows the Registrar to direct the form in which documents may be filed, but does not specify any penalty if the documents are not in the specified form.

As a result, these items amend regulation 11.27 which deals with the consequences of filing documents in an incorrect form, to require that documents must be filed in accordance with a direction of the Registrar under section 144B (if any). These items also remove the requirement that documents must comply with Schedule 2 of the regulations: substantive requirements for filing documents will now be provided for by instrument of the Registrar rather than in the regulations.

Item 248: Non-compliance in relation to form of filing of evidence

[reg 11.27A]

This item amends the Designs Regulations as a consequence of the introduction of section 144C of the Designs Act introduced by the Amendment Bill. Section 144C allows the Registrar to direct the form and means by which evidence may be filed, but does not specify any penalty if the evidence does not meet the filing requirements.

As a result, this item introduces new regulation 11.27A which deals with the consequences of filing evidence incorrectly. It requires that evidence must be filed in accordance with a direction of the Registrar under section 144C (if any). It further 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 249: Consequential amendments

[sch 4, items 1, 2 and 5]

This item is consequential to other amendments, and updates the reference in Schedule 4 to 'preferred means' in the light of the new definition in the Designs Act introduced in the Amendment Bill and the repeal of the definition of approved means per item 238.

Patents Regulations 1991

Items 250 to 258, 261, 262: Repeal of unnecessary provisions relating to document filing

[regs 1.3, 5.3, 22.1, 22.2AA, 22.12]

These items amend the Patents Regulations by repealing the provisions relating to means or form by which documents can be filed and fees paid.

Under the Amendment Bill, the Patents Act will be amended to enable the Commissioner to direct, by published instrument, how documents can be filed and fees paid. These amendments will cover all forms of document filing and fee payment. As a result, these provisions in the regulations are no longer necessary.

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

Items 259 to 261: Non-compliance in relation to form of filing of documents

[regs 22.15, 22.16]

These items amend the Patents Regulations as a consequence of the introduction of section 214B of the Patents Act introduced by the Amendment Bill. 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.

As a result, these items amend regulations 22.15 and 22.16 which deal with filing requirements and the consequences of not filing documents in a correct form, to require that documents must be filed in accordance with a direction of the Commissioner under section 214B (if any). Documents that do not comply with the filing requirements may be treated as never having been filed.

Item 263: Non-compliance in relation to form of filing of evidence

[reg 22.16A]

This item amends the Patents Regulations as a consequence of the introduction of section 214C of the Patents Act introduced by the Amendment Bill. Section 214C 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.

As a result, this item introduces new regulation 22.16A which deals with the consequences of filing

evidence incorrectly. It requires that evidence must be filed in accordance with a direction of the Commissioner under section 214C (if any). It further 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.

Item 264: Consequential amendments

[sch 7, items 201, 202, 203, 211, 212, 214A]

This item is consequential on other amendments and updates the note reference in Schedule 7 to 'preferred means' in the light of the new definition in the Act introduced in item 295 of the IP Laws Amendment Bill 2017 and the repeal of the definition of approved means (item 250 of this instrument).

Plant Breeder's Rights Regulations 1994

Items 265 and 266: Repeal of unnecessary provisions relating to document filing

[regs 3, 4A]

These items amend the Plant Breeder's Rights Regulations by repealing provisions relating to means or form by which documents can be filed and fees paid.

Under the Amendment Bill, the Plant Breeder's Rights Act will be amended to enable the Registrar to direct, by published instrument, how documents can be filed and fees paid. These amendments will cover all forms of document filing and fee payment. As a result, these provisions in the regulations are no longer necessary.

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

Item 267 Consequential amendments

[sch 1, item 4]

This item is consequential on other amendments, and updates to the reference in Schedule 1 to 'preferred means' in the light of the new definition in the Act introduced in the IP Laws Amendment Bill 2017 and the repeal of the definition of approved means (item 265 of this instrument).

Trade Marks Regulations 1995

Items 268, 269, 275 to 278, 280 to 282: Repeal of unnecessary provisions relating to document filing

[regs 2.1, 5.3, 9.3, 17A.30, 17A.48A, 21.17, 21.18, 21.21AA, 21.22, sch 7]

These items amend the Trade Marks Regulations by repealing provisions relating to means or form by which documents can be filed and fees paid.

Under the Amendment Bill, the Trade Marks Act will be amended to enable the Registrar to direct, by published instrument, how documents can be filed and fees paid. These amendments will cover all forms of document filing and fee payment. As a result, these provisions in the regulations including Schedule 7 are no longer necessary.

These items also make consequential amendments as a result of the repealed provisions to retitle or

renumber the corresponding regulations appropriately.

Item 270: Requirements for filing documents

[reg 21.2]

This item amends regulation 21.2 in the light of the repeal of Schedule 7 of the Trade Marks Regulations (item 282). Regulation 21.2 deals with the filing of documents, and previously provided that the documents must comply with Schedule 7. With the repeal of this schedule, amended regulation 21.2 provides minimal filing requirements that must be met by all documents filed with the Registrar. Substantive requirements for individual documents will be provided for under Section 213B of the Trade Marks Act introduced by the Amendment Bill.

Item 271: Non-compliance in relation to form of filing of documents

[reg 21.4]

This item amends the Trade Marks Regulations as a consequence of the introduction of section 213B of the Trade Marks Act introduced by the Amendment Bill. 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.

As a result, this item amends regulation 21.4 which deals with the consequences of filing documents in an incorrect form, to provide 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.

Item 272: Removal of facsimile as means of document filing

[reg 21.5]

Since 2014 filing by facsimile has not been an approved means to file documents with the Registrar, except in limited circumstances. Currently the Trade Marks Regulations create uncertainty by suggesting that filing by facsimile remains an option. This item removes any doubt by removing the reference to 'facsimile' in subregulation 21.5(2).

Item 273: Non-compliance in relation to form of filing of evidence

[reg 21.5A]

This item amends the Trade Marks Regulations as a consequence of the introduction of section 213C of the Trade Marks Act introduced by the Amendment Bill. Section 213C allows the Registrar to direct the form and means by which evidence may be filed, but does not specify any penalty if the evidence does not meet the filing requirements.

As a result, this item introduces new regulation 21.5A which deals with the consequences of filing evidence incorrectly. It requires that evidence must be filed in accordance with a direction of the Registrar under section 213C (if any). It further 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 279: Consequential amendment

[reg 21.22]

This item updates regulation 21.22 to provide a note for the reader indicating that the requirements for

how fees are to be paid are now provided for under the indicated provisions of the Trade Marks Act.

Item 283: Consequential amendments

[Sch 9, items 1, 3 and 10]

This item is consequential on other amendments and updates the reference in Schedule 9 to ‘preferred means’ in the light of the new definition in the Trade Marks Act introduced in the Amendment Bill and the repeal of the definition of ‘approved means’ (item 268 of this instrument).

DRAFT

Part 6 Official Journal

This part amends the Regulations to:

- replace the requirement to publish information in the Official Journals with requirements to publish information through IP Australia's website or by other electronic means; and
- provide for the commencement dates of certain periods to start when a particular event occurs (instead of when that event was advertised in the Official Journal).

These amendments are consequential to removing the requirement to maintain an Official Journal for designs and trade marks from the Acts. This will provide the Registrar with the flexibility to make information about IP rights available in the most appropriate way.

Designs Regulations 2004

Item 284: Definition of Official Journal

[reg 1.04]

This item removes the definition of *Official Journal*.

Items 285, 289 to 291: Publication of Notices

[regs 2.01, 3.15]

These items replace requirements to publish notices in the Official Journal with requirements to publish information in accordance with section 148A of the Act (that is, electronically).

Items 286 to 288, 294, 295, 300 to 305: Publication of information

[regs 3.04, 3.13, 4.11, 8.01, 9.04, 9.05, 11.14, 11.33]

These items are consequential amendments as a result of abolishing the Official Journal.

Items 288 and 294 also remove from the regulations certain requirements to publish information, as these requirements have been placed in the Designs Act by the Amendment Bill. The requirement to publish the number of a withdrawn design is specified in section 32 of the Designs Act. The requirement to publish a notice that an offer to surrender has been received is in subsection 50(2) of the Designs Act.

Item 300 replaces the requirement to publish a notice in the Official Journal about the Commonwealth's acquisition of a design with a requirement to publish this information in accordance with section 148A of the Designs Act. However, the requirement in paragraph 8.01(b) to publish this information in the *Commonwealth of Australia Gazette* remains because the significant nature of such an acquisition warrants wider publication.

Item 303 replaces the reference to the publication of a notice with a reference to the date of the publication. This is for the purpose of determining the period in which an opposition to an amendment must be filed.

Items 292, 297: Headings

[regs 4.08, 5.06]

Items 292 and 297 provide more appropriate headings for regulations 4.08 and 5.06, as the requirement to publish notices is replaced by the publication of details electronically.

Items 293, 296, 298, 299: Publication of notices

[regs 4.08, 4.13, 5.06, 5.07]

Items 293, 296, 298 and 299 substitute new subregulation 4.08(2), regulation 4.13, subregulation 5.06(2) and regulation 5.07 respectively to remove requirements that a notice must be published in the Official Journal. This provides consistency with subsections 45(4), 52(4), 67(3) and 68(3) of the Designs Act as amended by the Amendment Bill. The prescribed details to be published electronically in accordance with section 148A of the Designs Act remain unchanged.

Olympic Insignia Protection Regulations 1993

Item 306: Removal of the Official Journal of Designs

[reg 6B]

This item repeals subregulation 6B(3) as it is no longer required due to the abolishing of the Official Journal of Designs. Paragraph 14A(2)(b) of the Olympic Insignia Protection Act as amended by the Amendment Bill provides that a declaration must be published in accordance with section 14B (that is, on IP Australia's website or by other electronic means).

Trade Marks Regulations 1995

Items 307 to 309, 314 to 317, 319, 320, 328 to 333, 336, 339, 342, 355, 363, 369: Publication and Advertisement of Notices

[regs 3A, 4.7, 7.1, 8.4, 9.8, 16.3, 16.7, 16.10, 16.12, 17A.25, 17A.33, 17A.37, 17A.48G, 20A.19]

These items replace the requirements to publish a notice or advertise certain actions or events in the Official Journal with the new requirement to publish the facts or details in accordance with section 230A of the Trade Marks Act (that is, on IP Australia's website or by other electronic means).

Items 310, 311, 334, 335, 338, 341, 344 to 353, 357 to 362, 364 to 368: References to IRDAs

[regs 4.13, 4.14, 17A.21, 17A.22, 17A.25, 17A.36, 17A.39, 17A.42A, 17A.45, 17A.73, 17A.74]

These items correct a number of references to regulations that relate to IRDAs.

Item 312: Commencement of the Opposition period after acceptance

[reg 5.6]

This item provides that an opposition to registration of a trade mark must be filed within 2 months of acceptance of the application, not of the advertisement of acceptance. As the acceptance of an application

for registration will be promptly published in accordance with section 230A of the Trade Marks Act, rather than in a future edition of the Official Journal, it is simpler to have the opposition period commence from the acceptance date rather than the advertised date. As for designs, if the publication of information about a trade mark application is unreasonably delayed due to an error by IP Australia, an extension of time may be available under section 224 of the Trade Marks Act.

Items 313, 318, 321, 323, 325, 343: Publication of certain events

[regs 6.6, 16.3, 16.4, 17A.33]

These items replace in various regulations the date of advertising or publishing in the Official Journal with the day that details of the events are published in accordance with section 230A of the Trade Marks Act.

Items 322, 324, 326, 327: Advertisement relating to the initial assessment of an application for a certification mark

[regs 16.3, 16.4, 16.5]

These items replace in various regulations reference to the advertising in the Official Journal of an initial assessment of an application for a certification mark with reference to the initial assessment itself. This better reflects that interested persons are responding to the initial assessment rather than to the advertisement of it.

Items 337, 340, 354: Publication of Acceptance of an IRDA

[regs 17A.25, 17A.36]

These items provide that where the Registrar decides to accept an IRDA the details to be published in accordance with section 230A must include the day of acceptance. Although this is already the Registrar's practice, this ensures that key information is made available.

Items 356, 371: Publication of information

[regs 17A.37, 20.28]

These items substitute references to a "notice" or "an advertisement" with the term "publication", consistent with the publication of information under section 230A of the Trade Marks Act.

Item 370: Consequential Amendments

[reg 21.24B]

Item 370 removes subregulation 21.24B(3) as it is no longer relevant as a result of abolishing the Official Journals.

Part 7 Amendments of applications or other documents

This part amends the Regulations to:

- specify which administrative details/particulars in an applicant's application can be changed without needing to have those changes reviewed by the Registrar; and
- specify the prescribed particulars which the Registrar is able to automatically correct.

The amendments will reduce the time and costs for making simple amendments to design and trade mark applications.

Designs Regulations 2004

Item 372: Amendment of prescribed particulars

[reg 3.08A]

This item inserts new regulation 3.08A to specify the administrative details that may be amended by the applicant without seeking leave from the Registrar. These details may also be amended by the Registrar automatically. These particulars are: the applicant's name; applicant's residential or postal address; the applicant's address for service of documents; any other contact details for the applicant; and the personal details of the applicant's agent. An automatic amendment may be made electronically or by notice in the approved form given to the Registrar.

Amendments to priority details or representation of a design are considered to be substantive amendments and so may not be amended automatically by the applicant or the Registrar. In addition, changes to the name of the mortgagee, licensee and assignee, even to correct the spelling, can directly affect the rights of a party and so do not fall into the category of amendments to administrative details.

Item 373: Documents accompanying the Design application

[reg 3.09]

This item amends paragraph 3.09(1)(b) to specify that the administrative particulars listed in new regulation 3.08A (the applicant's name; applicant's residential or postal address; the applicant's address for service of documents; any other contact details for the applicant; and the personal details of the applicant's agent) may be amended in any document accompanying a design application as well as the design application itself.

Trade Marks Regulations 1995

Item 374: Amendment of prescribed particulars

[reg 6.1A]

This item inserts new regulation 6.1A to specify the administrative details that may be amended by the applicant without seeking leave from the Registrar. These details may also be amended by the Registrar automatically. These particulars are: the applicant's name; applicant's residential or postal address; the applicant's address for service of documents; any other contact details for the applicant; and the personal details of the applicant's agent. The amendment provides that an automatic amendment may be made by

notice in the approved form given to the Registrar (in addition to the electronic approved means provided for under paragraph 27A(2)(a) of the Act).

Amendments to priority details or representation of a trade mark are considered to be substantive amendments and so may not be amended automatically by the applicant or the Registrar. In addition, changes to the name of the mortgagee, licensee and assignee, even to correct the spelling, can directly affect the rights of a party and so do not fall into the category of amendments to administrative details.

Item 375: Headings

[reg 6.1]

This item amends the heading for regulation 6.1 to better differentiate this provision from the new regulation 6.1A for self-amendments.

DRAFT

Part 8 Signatures

This part amends the Regulations to remove the requirement for signing certain documents.

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

Patents Regulations 1991

Item 376: Request for patent of addition

[reg 3.1]

This item amends paragraph 3.1(2)(g) by removing 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. This item streamlines the process for requesting a patent of addition by removing this requirement.

Item 377: 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 and so the provision places an undue burden on opponents. This item streamlines the process for withdrawing oppositions by removing this requirement.

Part 9 Address and service of documents

This part amends the Regulations to:

- repeal provisions that provide for addresses for correspondence, as this can be handled by means of approved forms; and
- remove requirements for serving or filing documents that are inconsistent with changes introduced by the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

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

Designs Regulations 2004

Item 378: Service of documents

[reg 11.19]

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. 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 379: Address for correspondence

[reg 11.20]

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 380: Address for service

[reg 22.10]

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 381: Address for correspondence

[reg 22.10A]

This item repeals regulation 22.10A 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.

Trade Marks Regulations 1995

Item 382: Service of documents

[reg 8.4]

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)*.

DRAFT

Part 10 Examination of standard patent requests and specifications

This part amends the Regulations to:

- permit anyone, not just the applicant, to request examination of a patent;
- outline the relevant periods for requesting examination of a patent application, as a consequence of amendments to the Patents Act by Part 11 of Schedule 1 to the Amendment Bill; and
- set out the fees that an applicant and third party must each pay when requesting the examination, and the consequences of non-payment in the one- or two-month period.

The amendments allow potential competitors to obtain certainty of their freedom to operate in the marketplace sooner than might otherwise be the case.

Patents Regulations 1991

Part 11 to the Amendment Bill amends the Patents Act to enable third parties to directly request examination of a patent application, rather than having to request that the Commissioner of Patents direct the applicant to request examination. The following amendments to the Patents Regulations support those changes to the Patents Act.

Items 383 and 384: Heading changes

[regs 3.15 and 3.16]

The amendments provide more appropriate headings for the relevant regulations.

Items 385 and 386: Requests for examination under subsection 44(2A)—prescribed period

[reg 3.16]

The Amendment Bill omits the reference in subsection 44(2) to the prescribed period for a request for examination. That prescribed period is now referenced in new subsection 44(2A).

In turn, item 385 repeals subregulation 3.16(2), with its outdated reference to subsection 44(2).

Item 386 then inserts new regulation 3.16A, prescribing new periods for the applicant to request an examination in response to a direction under new subsection 44(2A). The previous subregulation 3.16(2) did not include the later period of five years from filing and was therefore inconsistent with the period prescribed in subregulation 3.15(1) for requests for examination under subsection 44(1). The amendment also inserts a requirement that the request must be in the approved form.

Item 387: Requests for examination under subsection 44(3)

[reg 3.17]

Item 387 repeals the existing requirements in regulation 3.17 for third party requests for a direction (as well as how examination may be expedited), and substitutes new requirements for third party requests for

an examination. (Provisions for expediting examination are subsequently inserted by item 388, below.) Consistent with subregulation 3.15(1) and new regulation 3.16A (as proposed to be inserted), a third party request for examination must be filed within five years of the filing date of the complete application and must be in the approved form.

Item 388: Expedited examination

[reg 3.17AA]

Following item 387's repeal of existing rules about expedited examination, item 388 inserts a new regulation to provide how examination may be expedited. Where the applicant or another person requests examination, the applicant may request expedited examination.

Item 389: Consequential amendment

[reg 3.17B]

This item substitutes the current reference, consequential to the new regulation added by item 388.

Item 390: Consequential amendment

[reg 22.2C]

This item removes a reference in regulation 22.2C(1)(a) to table item 209 of Clause 2 of Schedule 7 ('table item 209'). This is because table item 209 is being repealed and replaced with new table items 209A and 209B (inserted by item 395, below).

Item 391: Requests for examination under subsection 44(3)—failure to pay

[reg 22.2E]

This item inserts a new regulation governing how failures to pay the new fees (new table items 209A and 209B of Clause 2 of Schedule 7) will be dealt with. If the third party does not pay the fee within the extra one month, the request is taken not to have been filed. If the applicant does not pay the fee within the extra two months, the application lapses. The additional one month period for the applicant to pay the fee (when examination is requested by a third party) is consistent with the period for innovation patents as prescribed by regulation 22.2D.

Item 392: Consequential amendment

[reg 22.2F]

This amendment substitutes the current reference, consequential to the new regulation added by item 391.

Item 393: Consequential amendment

[sch 7, items 204 and 205]

This is a consequential amendment to the description of the fees for filing a request for examination (table items 204 and 205 of Clause 2 of Schedule 7), to clarify which provisions relate to filing such requests.

Items 394 and 395: Requests for examination under subsection 44(3)—fees

[sch 7, items 209 – 209B]

Item 394 repeals the old fee for a request for examination under subsection 44(3)—that is, it repeals table item 209 in Clause 2 of Schedule 7 to the Regulations.

Item 395 introduces new fees for such requests (new table items 209A and 209B in Clause 2 of Schedule 7 to the Regulations). Under the new fee structure, the two parties will each be required to pay half of the examination fee each, because they both benefit from examination.

DRAFT

Part 11 Requirements for patent documents

This part amends the regulations to:

- move existing formality requirements for patent documents from the Patents Regulations into the Act and to provide the Commissioner with a new instrument-making power for determining further formality requirements; and
- enable patent specifications to use graphics and/or photographs to describe inventions;
- the amendments allow applicants to use colour drawings at a future date to enable applicants to better describe their inventions and will ensure IP Australia is consistent with its international obligations.

Patent Regulations 1991

Item 396: Provisional application—direction to meet formalities requirements

[reg 3.2]

This item substitutes a new regulation 3.2 as a consequence of changes to the Patents Act which move existing formalities requirements for patent documents from the Patents Regulations into the Act, and which also provide a new instrument-making power to the Commissioner of Patents to determine further formalities requirements.

Items 11(1) to 11(18) in Schedule 3 to the Patent Regulations currently set out the formal requirements for drawings in patent specifications. One of these requirements is that the drawings are to be in black and white rather than colour. However, colour drawings and photographs are better able to convey information in certain situations and the cost and reliability of colour imaging has improved. Recognising this, the PCT Union intends to amend the PCT Rules to allow colour drawings to be filed in international applications. It is not certain when the Rules will be changed and what the exact requirements will be.

Item 420 in the *Amendment Bill* consolidates all the requirements for patent applications and specifications in section 29. It also enables the Commissioner of Patents to prescribe the formalities requirements for these documents in an instrument made under new section 229, rather than in Schedule 3 to the Regulations. This instrument will include the requirements for colour drawings at a future date.

As a consequence, this item removes from regulation 3.2 requirements that are now covered in subsection 29(4), refers to the requirements for provisional specifications in that subsection and renames the regulation to reflect its changed purpose.

The availability of colour drawings will ensure that IP Australia is consistent with its international obligations and will enable applicants to better describe their inventions.

Items 397–400: Complete application for standard patent—direction to meet formalities requirements

[reg 3.2A]

These items amend regulation 3.2A as a consequence of the changes to the formality requirements in the Patents Act.

Item 397 substitutes a new heading to reflect its changed purpose.

Item 398 substitutes new subregulations 3.2A(1) and (2). This removes the formalities requirements which are now covered in new subsections 29(4A) and (4B), and introduces references to the requirements of those new subsections.

Items 399 and 400 make consequential changes to references.

Item 401: Specifications—formalities check for innovation patents

[reg 3.2B]

As a consequence of the changes to the formality requirements in the Patents Act, item 401 substitutes two paragraphs of subregulation 3.2B(1) regarding the formality check requirements for an innovation patent. This item removes requirements from the regulation that are now covered in section 29 and clarifies that innovation patent requests and complete specifications for innovation patents must comply with the new subsections 29(4A) and (4B).

Items 402–405: Specifications—formalities check for PCT applications

[reg 3.2C]

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

Item 402 clarifies the wording of subregulation 3.2C(1) without changing its effect.

Item 403 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 Regulations.

Items 404 and 405 amend subregulation 3.2C(4) to clarify the wording without changing its effect.

Items 406–410: Consequential amendments

[regs 3.3, 3.5, 3.3AC]

These items amend various regulations as a consequence of allowing specifications to include graphics and photographs.

Items 411 and 412: PCT applications—prescribed requirements

[reg 3.5AD]

Amendments to the *Amendment Bill* (made by item 420 of that Bill) consolidate all the requirements for patent applications and specifications in section 29. The requirements for complete applications and specifications—formerly at section 29(4)—will now be set out in new subsections 29(4A) and (4B).

Consequently, item 411 amends the Regulations at paragraph 3.5AD(a), deleting an outdated reference to section 29(4) and replacing it with references to new subsections 29(4A) and (4B).

Regulation 3.5AD sets out prescribed requirements for PCT applications. This amendment ensures that PCT

applications that enter the national phase in Australia will meet the same formality requirements as non-PCT applications.

Item 412 removes paragraphs (c) and (d) in regulation 3.5AD. The requirements formerly set out in those paragraphs are now covered in new subsection 29(4) of the Act.

Item 413: Report of Commissioner—examination

[reg 3.18]

Section 45 of the Act sets out the matters which a patent examiner must address in an examination report. In addition to the specific matters listed in the Act, paragraph 45(1)(d) establishes that other matters may be prescribed in the Regulations. These are prescribed in regulation 3.18.

Item 413 now amends paragraph 3.18(2)(f) to clearly prescribe that an examiner must report on whether, to the best of the Commissioner's knowledge, the requirements of subregulations 3.2C(2) and (3) have been met in respect of a PCT application.

Subregulations 3.2C(2) and (3) require an applicant to provide an Australian address for service, the inventor's name, and a certificate of verification for a translated application; and requires that the Schedule 3 requirements have been substantially met.

Item 414: Notice that specification is open to public inspection

[reg 4.2]

This item omits the reference to subregulation 3.2A(2) and substitutes it with new subregulation 3.2A(1), as a consequence of changes made by item 398.

Item 415: Form of amendments

[reg 10.1]

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 cases where amendments have been requested by means of substituting those documents or parts.

Item 416: Form of amendments

[reg 10.2]

This item repeals paragraph 10.2(1)(a) to remove the reference to compliance with Schedule 3 to the Regulations, and replaces it with a reference to substantial compliance with the formalities requirements as determined in an instrument made under new section 229 of the Act. This is in line with the changes to the Patents Act which shift patent formality requirement provisions from the Regulations to the Act.

Item 417: Documents other than specifications and abstracts

[reg 22.16]

This item removes the reference in subregulation 22.16(2) to a document not substantially complying with Schedule 3 to the Regulations, and replaces this with a reference to non-compliance with the requirements

as determined in an instrument under new section 229 of the Act. This is in line with changes to the Patents Act which shift patent formality requirement provisions from the Regulations to the Act.

Item 418: Schedule 3—Formal requirements for documents to be filed

[sch 3]

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

DRAFT

Part 12 Acceptance of trade mark applications

This part amends the regulations to:

- prescribe a period of nine months for acceptance of a trade mark application or an IRDA;
- provide for acceptance to be deferred for six months while an applicant gathers evidence to address grounds for refusing the application or IRDA; and
- remove the ability to get 'easy' extensions of the acceptance period, and instead provide that the acceptance period can be extended only under the general extension of time provisions.

The amendments will simplify the extension system, ensure that extensions are granted only where warranted, and speed up the resolution of trade mark applications, thereby increasing certainty in the market.

Trade Marks Regulations 1995

Items 419–423 and 436: Reduced acceptance time period

[regs 4.8, 4.10, 4.12, 17A.20]

These items amend subregulations 4.12(1) and 17A.20(1) of the Trade Marks Regulations, to reduce the prescribed period for the acceptance of a trade mark from 15 months to nine months from the date of issue of the first examination report.

When a trade mark application is examined, a report is provided to the applicant detailing the examiner's issues with the application. If an adverse examination report is made, the applicant is given the opportunity to address the issues in the report within a prescribed period. If the issues are resolved the application is accepted, if they are not the application will lapse. Currently the prescribed period is 15 months from the date of the first examination report.

Australia has one of the longest acceptance times in the world. The 15 month period was originally intended to account for delays in postal communication with overseas contacts. However, this is no longer necessary as communication can be conducted electronically. The great majority of issues are resolved within six months. The 15 month timeframe is also longer than that allowed for patents and designs, which are 12 months and six months respectively.

The long acceptance timeframe leads to lengthy periods of marketplace uncertainty during which the public and competitors do not know whether an applicant is actively pursuing registration of the trade mark or has left it unresolved in the system.

The amendment remedies these problems by reducing the 15 month period for acceptance to nine months (in subregulations 4.12(1) and 17A.20(1)). This will streamline the system, improve certainty for third parties and be more consistent with the effective acceptance period in other jurisdictions.

A small percentage of applicants genuinely need more than nine months to resolve their applications, due to the need to gather evidence or due to unforeseen circumstances. Such applicants will still have deferment of acceptance and extensions of time available under sections 36 and 224 (respectively) of the Trade Marks Act.

Paragraphs 4.8(1)(b), 4.10(2)(b) and 4.12(1)(b), which provide for the Registrar's obligation to report grounds for rejection, will also be amended. These paragraphs will now refer to the provisions allowing additional grounds for rejection regarding certification and defensive marks respectively under section 177 and 187 of the Trade Marks Act. This will make the new acceptance period of nine months applicable in the examination processes for these types of marks as well.

Item 424 and 437: Consequential amendments

[regs 4.12 and 17A.20]

These items are consequential on items 421, 423 and 438. These items amend subregulations 4.12(2) and 17A.20(2) to refer to the new nine month acceptance period.

Items 425 and 438: Removal of easy extensions to the acceptance period

[regs 4.12 and 17A.20]

These items repeal subregulations 4.12(3)-(4) and 17A.20(3)-(4) of the Trade Marks Regulations, so that an applicant is no longer able to request an 'easy' extension of time to the prescribed period for acceptance of a trade mark application.

When a trade mark application is examined and an adverse report is provided to the applicant, the applicant is given the opportunity to address the issues in the report within a prescribed period. There are multiple mechanisms for extending the prescribed acceptance period. Under the current legislation, trade mark applicants can readily obtain a six month extension to the acceptance timeframe without having to provide reasons (a so-called 'easy' extension of time). The acceptance period can also be deferred under section 36 and extended under section 224 of the Trade Marks Act.

The availability of easy extensions unnecessarily prolongs the prosecution of trade mark applications. As discussed above, the current extended period for acceptance, which includes the standard 15 months plus up to an additional six months of 'easy' extensions, is no longer necessary. The long acceptance period creates marketplace uncertainty. The different time periods and opportunities to extend the acceptance period also complicate the trade marks system. Furthermore, a trade mark is the only IP right where an 'easy' extension is available for the acceptance period.

The amendments remedy these problems by removing the option for applicants to obtain an 'easy' extension of time. This would streamline the system, improve certainty for third parties and align trade marks with other IP rights.

The small percentage of applicants who genuinely need more time than the standard acceptance period to resolve their applications will still have deferment of acceptance and extensions of time available under sections 36 and 224 (respectively) of the Trade Marks Act.

As a result of repealing subregulations 4.12(3) and 17A.20(3), note 1 under regulation 4.12 and note 1 under regulation 17A.20, which refer to the repealed subregulations, will be removed.

Consequential on items 421 and 436, note 2 under regulation 4.12 and note 2 under regulation 17A.20, will also be removed.

Items 428 and 441: Drafting clarifications

[regs 4.13 and 17A.21]

These items will amend subregulations 4.13(2) and 17A.21(2) to update the references to regulation 4.12 as a whole (instead of just subregulation 4.12(1)).

Items 429 and 442: Consequential amendments

[regs 4.13 and 17A.21]

These items will amend subregulations 4.13(2) and 17A.21(2) to remove respective references to repealed subregulations 4.12(4) and 17A.20(4).

Item 449: Consequential amendments

[sch 9, item 5]

This item is consequential on items 425 and 438. Item 5 of schedule 9 establishes a fee for filing an extension under subregulation 4.12(3) or regulation 17A.20. As a result of repealing subregulations 4.12(3), and 17A.20(3), the fee will no longer be required. This item will therefore repeal the fee.

Items 427 and 440: Deferment of acceptance

[regs 4.13 and 17A.21]

These items amend Trade Marks Regulations 4.13 and 17A.21 by inserting new subregulations 4.13(1A) and 17A.21(1A) to expand the grounds for an applicant to request deferment of acceptance. These items relate to the deferment provision available in cases where the Registrar proposes to reject the application because the trade mark does not sufficiently distinguish the applicant's goods or services from those of others (Trade Marks Act sections 41 or 177).

Items 421, 423 and 436 amend the period for acceptance for a trade mark application to nine months from the first adverse report by the Registrar. Sometimes an applicant needs more time to gather evidence of use to overcome a ground for rejection. Currently, an applicant can request deferment of acceptance of trade mark application for up to 6 months under section 36. This is available if an applicant is seeking to establish honest concurrent use or prior use (subsections 44(3) or 44(4)).

However, in some cases, applicants need to acquire evidence to overcome a ground for rejection under section 41 (ie, on the ground that the trade mark does not distinguish the applicant's goods or services from those of others). Similarly, an applicant may need more time to gather evidence to overcome a subsection 177(1) ground for rejection (ie, on the ground that the certification trade mark does not distinguish certified goods or services from non-certified goods or services). However, there is no current provision for an applicant to request deferment of acceptance on these grounds.

These items address the problem by expanding the grounds for which applicants can request a deferment of acceptance, to include deferment for the purposes of gathering evidence under sections 41 or 177. This will ensure that applicants who genuinely need more time to collect the evidence necessary to prosecute their trade marks are able to do so.

Applicants will continue to be able to request deferment of acceptance for the purposes of gathering evidence to overcome a section 44 ground for rejection.

Items 430 and 443: Consequential amendments

[regs 4.14 and 17A.22]

These items are consequential on items 427 and 440.

Paragraph 4.14(1)(a) refers to deferment under subregulation 4.13(1). Paragraph 17A.22(1)(a) refers to deferment under subregulation 17A.21(1). As a result of the new provisions to allow deferment of acceptance to address rejections under sections 41 and 177, these paragraphs will also need to refer to the new subregulations.

To that end, these items amend paragraphs 4.14(1)(a) and 17A.22(1)(a) to also refer to the new deferment provisions under new subregulations 4.13(1A) and 17A.21(1A) respectively.

Items 431–432 and 444–445: Consequential amendments

[regs 4.14 and 17A.22]

These items are consequential on items 427 and 440.

Paragraphs 4.14(2)(b) and 17A.22(2)(b) make the end of a deferment period dependent on when the Registrar is reasonably satisfied that there are no longer grounds for rejecting the application under subsection 44(1) or (2) of the Act. As a result of deferment being available to address rejections under sections 41 and 177, the end of the deferment period now needs to refer to these sections.

These items therefore amend paragraphs 4.14(2)(b) and 17A.22(2)(b) to refer to sections 41 and 177 of the Act. This will ensure that the end of the deferment period is the same regardless of the ground relied upon.

Items 433–435 and 446–448: Consequential amendments

[regs 4.14 and 17A.22]

These items are consequential on items 427 and 440.

Paragraphs 4.14(3)(b) and 17A.22(3)(b) provide that, if acceptance is deferred because the applicant is seeking to satisfy the Registrar relating to matters mentioned in subsection 44(3) or 44(4) of the Act (subparagraph 4.13(1)(c)(ii) and 17A.21(1)(c)(ii) respectively), then the end of the deferment period is six months from the date of commencement of deferment.

Paragraphs 4.14(4) and 17A.22(4) provide that if acceptance of an application is deferred as a result of the operation of more than one of the provisions of paragraph 4.13(1)(c) and subregulation 4.13(2) and paragraph 17A.21(1)(c) and subregulation 17A.21(2) respectively, the deferment period ends in accordance with the relevant provision of subregulation (3) under which the deferment period ends later or last, as the case requires.

Paragraphs 4.14(5)(b) and 17A.22(5)(b) refer to notifying the applicant in writing of the end of a deferment period and the last day of the relevant period if acceptance is deferred under subregulation 4.13(1) or subregulation 17A.21(1) respectively.

As a result of the new provisions to allow deferment of acceptance to address rejections under sections 41 and 177(1), these paragraphs now need to refer to the new paragraphs that allow deferment on these grounds. This will ensure that the end of the deferment period is the same regardless of the ground relied upon.

These items will therefore amend paragraphs 4.14(3)(b), 17A.22(3)(b), 4.14(4), 17A.22(4), 4.14(5)(b) and 17A.22(5)(b) to include reference to the new paragraphs 4.13(1A) and 17A.21(1A) as appropriate.

Items 426 and 439: Time period for requesting deferment of acceptance

[regs 4.13 and 17A.21]

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

This is not presently possible, because paragraphs 4.13(1)(a) and 17A.21(1)(a) limit requests for deferral to the period prescribed for acceptance of a trade mark application by 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 result in confusion for applicants and third parties, as the status of an application for deferment can become unclear. It can also result in additional red tape and costs, as applicants may have to file speculative requests for deferment without knowing whether their extension of time under section 224 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 amending the period for filing a request for deferment to include the whole acceptance period, including where this has been extended under section 224. This will ensure that the applicant has to file only one section 224 request, and will increase certainty for applicants and third parties about the time periods for acceptance of trade marks.

Part 13 Registration of designs

This part amends the Regulations to remove the option for applicants to request publication of a design within the prescribed period. Removing this option will simplify the application process for designs and minimise the likelihood of an application unintentionally lapsing because a request for publication was not filed within the prescribed period.

Part 14 to the Amendment Bill amended the Designs Act to remove the option for applicants to request publication. The following amendments to the Designs Regulations support those changes to the Designs Act. These items amend the requisite sections of the Designs Regulations to remove references to publication and ensure that references to the prescribed period refer to the correct amended provisions in the Designs Act.

Upon or after filing a design application, an applicant may request either publication or registration of the design.¹ A design application lapses if a request is not made within the prescribed period, which is typically six months from the priority date.² The option of publication was provided as a way for applicants to make a design public and thereby prevent others from obtaining certification for the same design. However, to date very few applicants have requested publication.

Requiring applicants to request registration imposes an administrative burden on the great majority of applicants and on IP Australia, who processes the requests, and may result in the unintended lapsing of applications.

The amendments address these problems by removing references to the option of publication and ensuring that references to the prescribed period refer to the correct amended provisions in the Designs Act³. This will help simplify the application process and thereby reduce the administrative burden and the likelihood of applications unintentionally lapsing.

Designs Regulations 2004

Items 450, 451, 453 - 456, 459, 460: Design applications

[regs 3.02, 3.13, 3.15, 4.01, 8.02; Chapter 4, headings]

These items remove references to publication and the provisions that govern the publication of designs. This is a consequence of the amendments to the Designs Act that remove the option for applicants to request publication of a design.

Item 452: Period within which application lapses

[reg 3.14]

This item substitutes regulation 3.14 to prescribe the period before a design application lapses under the new law. The old regulation 3.14 prescribed the period for the purposes of the repealed paragraphs 33(1)(a) and (b) of the Designs Act. New subsection 33(1) relates to lapsing of design applications due to

¹ Section 35(1), Designs Act 2003.

² Section 33(1), Designs Act 2003; Regulation 3.14, Designs Regulations 2003.

³ See regulation 3.14, Designs Regulations.

applicants' failures to respond to the Registrar's notification under section 41 within a prescribed period. New regulation 3.14 prescribes this period to remain at two months from the date of the first notification, the same as existing paragraph 3.14(2)(a).

Item 457: Requests for registration

[reg 4.01]

This item removes references to repealed provisions of the Designs Act.

Item 458: Later requests for registration in respect of more than one design

[regs 4.02, 4.03]

This item substitutes regulation 4.02 to provide when a request for registration of a relevant design may be allowed for the purposes of section 36. The conditions remain unchanged – because of an error or omission, or a request is made before any design disclosed in the application is registered.

The removal of regulation 4.03 is a consequential amendment as section 38 of the Act, which the regulation was intended for, has been repealed.

Item 461: Formal requirements

[sch 2, note after heading]

This item is a consequential amendment to remove a reference to regulation 4.15, which was repealed by item 459.

Part 14 Copies of design representations

This part amends the Regulations to replace the outdated requirement to file multiple copies of each design disclosed in an application, so that at least one proper representation of each design would only be required to pass the formalities check. This is because design applications are now filed electronically or scanned upon receipt.

Designs Regulations 2004

Items 462 - 463: Multiple copies of design representations

[regs 4.04, 4.05]

These items amend paragraphs 4.04(1)(f) and 4.05(1)(f) of the Designs Regulations to replace the requirement to file five copies of each representation of each design disclosed in a design application with a requirement to file at least one representation of each design.

When filing a design application, the applicant must include a representation, or information that appears to be a representation, of each design.⁴ Upon or after filing a design application, the applicant may request registration of the design,⁵ following which the representations undergo a formalities check.⁶ One of the requirements of the formalities check is the application includes five copies of each representation of each design disclosed in the application.⁷

This requirement was useful when applications were filed on paper and quality was lost through document reproduction. However, design applications are now filed electronically or scanned upon receipt. Therefore, representations are able to be reproduced without loss of quality and multiple copies are no longer necessary.

The amendments address this by replacing the requirement for multiple copies with a requirement that the design application include at least one proper representation of each design in order to pass the formalities check.

⁴ Paragraph 3.01(c), Designs Regulations.

⁵ See s 35(1), Designs Act.

⁶ Paragraph 39(2)(a) or 40(2)(c), Designs Act.

⁷ See paragraphs 4.04(1)(f) and 4.05(1)(f), Designs Regulations.

Part 15 Amendment of registered trade mark due to inconsistency with international agreements

This part amends the Regulations to:

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

Trade Marks Regulations 1995

Items 464 – 467: Oppositions to amendments of registered trade marks due to inconsistency with international agreements

These items reinstate provisions to set out the process for oppositions to amendments to registered trade marks, where the amendment has been requested to overcome an inconsistency with Australia's international obligations.

The owners of registered trade marks may request amendments to their marks. One of the grounds for requesting an amendment is where using the trade mark in relation to the registered goods or services 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 legislation 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 trade mark registered being used by the person for the same type of goods or services.

Regulation 8.5 of the Trade Mark 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. These regulations are no longer relevant, so there are currently no provisions on the process for this type of opposition.

Item 464 reinstates clear procedures for conducting such oppositions. The procedures are very similar to those in place for other oppositions to amendments of trade marks. The remaining items insert a small number of references that were missed in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

Item 464: Amendment due to inconsistency with international agreements – opposition proceedings

[regs 8.5-8.8]

This item sets out the practice and procedure for oppositions to amendments due to inconsistency with international agreements.

Regulation 8.5 provides that the Registrar may decide the opposition procedures and accordingly direct the registered owner who made the request for amendment, and any opponent who filed a notice of opposition.

Regulation 8.6 provides the procedures for conducting a hearing of the opposition under subsection 83A(4) of the Act, and is similar to that of existing 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) and (4) set out the requirements on the Registrar and the relevant parties for an oral hearing, and the consequences of failing to do so. Subregulation 8.6(5) provides the obligations on the Registrar to decide and notify relevant parties of the opposition decision. Subregulation 8.6(6) provides that regulations 21.15 and 21.16, which relate to general hearing procedures, do not apply in relation to an opposition to amendments due to inconsistency with international agreements under subsection 83(4) of the Act.

Regulation 8.7 provides that the Registrar may give a direction in relation to an opposition under subsection 83A(4) of the 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)-(4) set out the requirements that the Registrar must comply with if he or she gives a direction, including: giving the relevant parties an opportunity to make representations about the direction; requiring that the direction must be consistent with the Act or 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.

Regulation 8.8 provides that the Registrar must notify the relevant parties where an opposition under section 222 of the 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 465: Conduct of proceedings

[reg 21.14]

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

Item 466: Award of costs

[sch 8, Part 1, items 5 and 6]

This item provides that costs could be awarded for the time spent preparing and perusing notices of opposition filed under regulation 8.4(1). This reference was inadvertently not included in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

Item 467: Fees for filing notices of opposition

[sch 9, item 8]

This item provides that there is a fee for filing a notice of opposition under section 83A, which was inadvertently not included in the *Intellectual Property Legislation Amendment (Raising the Bar) Regulation 2013 (No. 1)*.

Part 16 Secretary's role in the Plant Breeder's Rights Regulations

This part amends the Regulations to transfer the powers, functions and obligations of the Secretary of the Department of Industry, Innovation and Science to the Registrar of PBR to reflect existing practice. This will better align PBR legislation with the other IP rights legislation

Plant Breeder's Rights Regulations 1994

Items 468 – 474: Devolution of Secretary's powers and obligations to the Registrar

[regs 3A, 3D, 5]

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

The Intellectual Property Laws Amendment Bill 2017 amends the PBR Act to devolve the powers, functions and obligations of the Secretary to the Registrar of PBR. 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 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.⁸ These amendments better align the PBR Act with the other IP rights legislation, better reflect actual practice and improve transparency.

⁸ See regulation 3D, PBR Regulations; Subregulations 3A(1)-(4), 5(1)-(5), PBR Regulations; Paragraphs 3A(3)(a) and 5(4)(a), PBR Regulations; Schedule Fees, Item 16, PBR Regulations.

Part 17 Application, transitional and saving provisions

This part amends the regulations to:

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

This part will clarify exactly how the transition from the existing legislative scheme to the new legislative scheme will occur. This will include where they 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 will apply after commencement.

Designs Regulations 2004

Items 475 – 476: Application, saving and transitional provisions – Intellectual Property Laws Amendment Regulations 2017

[Chapter 12]

These items repeal and substitute the heading for Chapter 12 and insert a new Part 3 in Chapter 12 of the Designs Regulations, which will govern the transitional arrangements for Schedule 1. These items provide a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement. Note that where no specific application, transitional or savings provision is inserted here, it is expected that the general rules in section 7 of the *Acts Interpretation Act 1901* would apply.

The transitional arrangements are included to ensure that a person who had undertaken an action, for example submitting an application or providing a notice, under the regulations that were in force directly before commencement is not unfairly disadvantaged or advantaged by the amendment. This is also applicable to parties who undertake an action after commencement. Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Patents Regulations 1991

Items 477 - 478: Application, saving and transitional provisions – Intellectual Property Laws Amendment Regulations 2017

[Chapter 23]

These items repeal and substitute the heading for Chapter 23 and insert a new Part 4 in Chapter 23 in the Patents Regulations. Part 4 in Chapter 23 will govern the transitional arrangements for Schedule 1.

These items provide a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement. Note that where no specific application, transitional or savings provision is inserted here, it is expected that the general rules in section 7 of the *Acts Interpretation Act 1901* would apply.

The transitional arrangements are included to ensure that a person who had undertaken an action (for example submitting an application or providing a notice) under the regulations that were in force directly before commencement, is not unfairly disadvantaged or advantaged by the amendment. This is also

applicable to parties who undertake an action after commencement. Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Plant Breeder's Rights Regulations 1994

Item 479: Application, saving and transitional provisions – Intellectual Property Laws Amendment Regulations 2017

[reg 6]

This item inserts a new regulation which will govern the transitional arrangements for Schedule 1.

This item provide a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement. Note that where no specific application, transitional or savings provision is inserted here, it is expected that the general rules in section 7 of the *Acts Interpretation Act 1901* would apply.

The transitional arrangements are included to ensure that a person who had undertaken an action (for example, payment of fees) under the regulations that were in force directly before commencement, is not unfairly disadvantaged or advantaged by the amendment. This is also applicable to parties who undertake an action after commencement. Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

Trade Marks Regulations 1995

Items 480 – 481: Application, saving and transitional provisions – Intellectual Property Laws Amendment Regulations 2017

[Part 22]

These items repeal and substitute a new heading and insert a new Division 3 in Part 22 of the Trade Marks Regulations, which will govern transitional arrangements for Schedule 1.

These items provide a breakdown of the transitional arrangements by clarifying the application of the amendments and providing for the saving of any repealed provisions that may be required to operate after commencement. Note that where no specific application, transitional or savings provision is inserted here, it is expected that the general rules in section 7 of the *Acts Interpretation Act 1901* would apply.

The transitional arrangements are included to ensure that a person who had undertaken an action, for example filing an application or providing a notice, under the regulations that were in force directly before commencement is not unfairly disadvantaged or advantaged by the amendment. This is also applicable to parties who undertake an action after commencement. Where necessary to finalise existing applications or other actions, the operation of repealed provisions is saved.

DRAFT

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